

Nominet UK Dispute Resolution Service

DRS 00192

APC Overnight Limited -v- M+J Couriers

Decision of Independent Expert

1. Parties:

Complainant: APC Overnight Limited
Unit 201 Axxcess 10 Business Park
Bentley Road South
Darlaston
West Midlands

Post Code: WS10 8LQ

Country: GB

Respondent: M+J Couriers
Unit 21 Apple Business Centre
Frobisher Way
Taunton
Somerset

Postcode: TA2 6BB

Country: GB

2. Disputed Domain Name:

apc-overnight.co.uk

3. Procedural Background:

A complaint ("the Complaint") was received in full by Nominet on 15 January 2002. Nominet forwarded the Complaint to the Respondent on 16 January 2002 and notified them that they had 15 working days (i.e. until 6 February 2002) to respond. The Respondent failed to respond. Mediation not therefore being possible Nominet notified the Complainant that the Complaint would be referred to an independent expert upon payment of the requisite fee. The Complainant paid the fee on 8 February 2002 for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Policy ("the Policy").

On 19 February 2002 and in accordance with paragraph 9 of the Nominet Dispute Resolution Service Procedure ("the Procedure") I, Simon Chapman, ("the Expert") confirmed to Nominet that I was impartial and independent but wished to disclose certain circumstances as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties. The disclosure was in the following terms:-

"...I circulated all fee-earners within Laytons to ascertain whether anyone had acted either for or against the Complainant or Respondent. I have as a result of that e-mail been notified that the Dispute Resolution Department of Laytons Guildford acted against Alternative Parcels Company Limited in a multi-party action last year. I am advised that APC Overnight may be linked to that company. I am not in possession of any further information regarding the dispute.

I have personally had no dealings for or against APC Overnight Ltd or Alternative Parcels Company Limited and the involvement of the Dispute Resolution Department concluded before I joined the firm in November last year.

In the circumstances, whilst I do not feel that I have any personal conflict, you may wish to either refer the matter to another expert or seek the approval of the parties to my appointment."

Nominet forwarded the disclosure to the parties on 19 February 2002 inviting their comments by 4pm on 20 February 2002. On 19 February 2002 a representative of the Complainant responded to Nominet in the following terms:-

"With reference to your fax this morning, I am pleased to confirm that we are happy for Simon Chapman to act in this case."

No response to the disclosure has been received from the Respondent.

I was subsequently appointed by Nominet on 22 February 2002 and my decision is due by no later than 8 March 2002.

4. Outstanding Formal/Procedural Issues:

The Respondent has not submitted a Response to the Complaint. From the papers that have been submitted by Nominet to me it is apparent that efforts have been made to send the Complaint to the Respondent by fax, post and e-mail.

With regard to the former, the message report shows that the recipient received the fax at 16.04 on 16 January 2002 and that all pages sent were received. The recipient fax number is the same as that for the Administrative Contact of the Domain Name held by Nominet on its records.

Nothing amongst the papers indicates that the letter sent by Nominet has been returned. The e-mail sent to the Respondent would not appear to have been successfully received as the documentation which I have indicates that it could not be delivered.

When registering a UK domain name applicants agree to be bound by Nominet's Terms and Conditions. Clause 2.3 of those terms and conditions provides that:-

"You must inform us promptly of any change in your registered details, and those of your Agent if applicable. It will be your responsibility to maintain and update any details you submit to us and to ensure that your details are up to date, and accurate. In particular, it is your responsibility directly or by your Agent to ensure that we have your full and correct postal address."

In addition paragraph 2(e) of the Procedure states that:-

"Except as otherwise provided in this Procedure or as otherwise decided by us or if appointed, the Expert, all communications provided for under this Procedure shall be deemed to have been received:

- i. if sent by facsimile, on the date transmitted; or*
- ii. if sent by first class post, on the second Day after posting; or*
- iii. if sent via the Internet, on the date that the communication was transmitted; and*
- iv. where communications are received by more than one method, at the earliest date received;*

and, unless otherwise provided in this Procedure, the time periods provided for under the Policy and this Procedure shall be calculated accordingly."

In light of the above it is my view that Nominet has done everything that it is obliged to do to bring the Complaint to the attention of the Respondent.

The question that must now be addressed, is what is the consequence of the Respondent not submitting a response?

The Procedure envisages just such a situation and provides in Paragraph 15 that:-

- "b. If, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint..."*
- c. If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate."*

I am unaware of any exceptional circumstances as referred to above and as such believe it appropriate to proceed to a Decision, and will draw such inferences from the Respondent's failure to respond as I think appropriate.

The matter of a Respondent failing to respond was dealt with in some detail in the *Eli Lilly and Company -v- David Clayton* decision (15/11/01), where the appointed expert put forward a number of reasons why a respondent might fail to serve a response namely, nothing useful to say, not received the complaint, gone away, or failed to keep contact details up to date. The expert in that decision went on to say that:-

"Generally, the absence of a Response from the Respondent does not, in the Expert's view, entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit"

In my opinion that is the correct interpretation of the Procedure as will be apparent from the comments set out below.

5. The Facts:

I repeat below the complete extent of the facts as set out in the Complaint. No further documentation was provided by the Complainant. For the reasons set out below I am unable to accept that the facts as stated are correct.

"This domain was registered while the respondent was a member of a network of independent businesses known as "APC Overnight". A request was made for the domain name to be transferred to ourselves and the respondent verbally agreed to do this, but it was never done. The respondent is no longer a member of the network and a further informal request to transfer the domain name has been rejected. Until recently, anyone visiting the website www.apc-overnight.co.uk was redirected to M&J Couriers own web site www.mj-couriers.co.uk. APC Overnight is a trademark of APC Overnight Ltd."

From the file of papers submitted to me by Nominet, it is apparent that the Domain Name was registered by the Respondent on 31 December 1997. In addition, on 16 January 2002, an MSN search was conducted to ascertain where the Domain Name was directed, the result of which was a statement that "We can't find "www.apc-overnight.co.uk"".

6. The Parties Contentions:

Complainant

The Complainant submits that the Disputed Domain Name is identical or similar to a name or mark in which it has rights and that in the hands of the Respondent it is an Abusive Registration.

The Respondent's requested remedy is that the Disputed Domain Name be transferred.

No detailed argument in support of the Complainant's assertion that it has rights in an identical or similar mark or its belief that the registration is abusive have been put forward.

Respondent

As stated above the Respondent has not responded.

7. Discussion and Findings

General

To succeed in this Complaint the Complainant must, in accordance with Paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that (1) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and (2) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

Burden

The absence of a response from the Respondent does not mean that the Respondent is deemed to have no answer to the Complaint, but rather the Complainant must still make out its case to the Expert on the balance of probabilities. Where a Respondent does not avail himself/herself of the opportunity to respond to the Complaint it might be said that the Complainant's task is all the easier, but as I have previously indicated, notwithstanding the absence of a Response, it is still incumbent on the Expert to assess the admissibility, relevance, materiality and weight of the evidence as presented in the Complaint (see Paragraph 12b of the Procedure).

In the present dispute the Complainant has chosen not to file any documentary evidence in support of its Complaint. Whether an Expert can rely upon the Complaint itself as evidence has been previously considered in *Blue Martini Software Limited -v- Prophesysoft* (3/12/01). In that dispute the appointed expert concluded that it could be relied upon because the Procedure requires Complainants to complete and sign a statement certifying that "*The information contained in this complaint is to the best of the Complainant's knowledge true and complete. This complaint is not being presented in bad faith and the matters stated in this complaint comply with the Procedure and applicable law*" (see paragraph 3(b)(ix) of the Procedure).

I am in agreement with the conclusion that was reached by the appointed expert in that case. However in the present dispute, the declaration in the above terms which is set out at the foot of the Complaint on the copy which appears in the file of papers that has been provided to me by Nominet is un-signed. In those circumstances I am of the opinion that a declaration as required by the Procedure has not been made.

I should point out that a signature of the Complainant's representative does appear on the first page of the Complaint Form. However given (a) what I believe to be a very important requirement to assert the truth of the evidence in the Complaint and (b) the defects that have become apparent to me in that evidence (which I deal with below) I am not minded to overlook this omission or accept that the signature on the front page of the Complaint can be treated as a signature for the purposes of the declaration.

In the absence of a declaration it is simply not possible for me to assess the truthfulness or otherwise of the evidence contained in the Complaint and as such I must disregard it. The effect of doing so is that the Complainant is deemed not to have submitted any evidence in support of its Complaint and in those circumstances I do not find that the Complainant has discharged its burden of establishing Rights or that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore fails. When reaching this conclusion I have had to balance on the one hand the "technical" nature of a complainant omitting to sign the required declaration, and on the other the significant damage that could be caused to a respondent's business in the event that a domain name were cancelled, suspended, transferred or otherwise in circumstances where the facts stated were not truthful. I conclude that the interests of a respondent in such circumstances are greater.

I am mindful that paragraph 13 of the Procedure entitles Experts to request further statements or documents from the Parties and that this might be interpreted as allowing me to seek from the Complainant a further copy of the Complaint with the declaration properly completed. I have doubts that such an interpretation is correct or desirable and in any event, for the reasons set out below, I have concluded that there would be no benefit to the Complainant if I were to do so.

The Complaint has thus far failed on a technical ground. So that the Complainant is not put to unwarranted further expenditure by having to submit another Complaint I set out below my thoughts on the Complaint in the hypothetical circumstances of the declaration having been completed.

Complainant's Rights

As indicated above, the Complainant has asserted that it has Rights in a name or mark which is identical or similar to the Domain Name.

The first (.uk) and second (.co) levels of the Domain Name should be discounted for the purposes of comparison as being of a generic nature.

Similarly I am of the view that the hyphen should be discounted. I am of the opinion that the Domain Name apc-overnight is identical or similar to APC Overnight, that being the name or mark in which the Complainant claims Rights.

In support of its contention that it has Rights, the Complainant has stated that APC Overnight is its trade mark. The definition of "Rights" is set out in the Policy as *"includes, but is not limited to, rights enforceable under English Law"*. Under English Law rights in a name/mark are protected by registered trade marks, or unregistered rights such as the entitlement to bring a claim for passing off to protect the goodwill arising from that name/mark.

With regard to the former, the Complainant has not provided any details of any registered rights. I have conducted a search of The Patent Office online trade mark database to see whether there were any records of such a registration. The result of that search was that I could find no record of the Complainant having any registered rights in the name/mark APC Overnight. However the search did reveal one registration for the name/mark, registered as a logo, with the proprietors details recorded as The Alternative Parcels Company Limited. I have no information to confirm whether this company is associated with the Complainant or whether it has granted rights in the trade mark to the Complainant. My findings serve only to illustrate further how important it is to complete the declaration in the Complaint.

I must therefore conclude that the Complainant does not have rights in a registered trade mark for the name APC Overnight.

Turning to passing off, for the Complainant to be able to assert rights, it must prove that (a) it has sufficient goodwill in the name APC Overnight, (b) that there is a misrepresentation by the Respondent likely to make the public believe that the goods or services of the Respondent are associated with those of the Complainant, and (c) that such misrepresentation has or will cause damage to the Complainant.

The Complainant has provided no evidence of the extent of its use other than stating that APC Overnight is its trade mark. Without any evidence to show the extent of that use I am not able to determine whether such use has created sufficient goodwill to support a passing off claim.

Whilst I think that it is reasonable for an expert to conduct a limited amount of research from publicly available records to ascertain information to assist with the determination of a complaint, as was the case with the database search referred to above, I believe that experts must be cautious in doing so as the accuracy of such records at the time of determining a complaint cannot be guaranteed. It is for this reason that I have chosen not to review Companies House records or the Complainant's own website. I acknowledge that for the Procedure to be effective it must be as user friendly as possible and capable of being utilised without professional

advice if so desired, however in my view and subject to the Experts entitlement to call for further documents, the collation and preparation of evidence in support of a complaint or response must fall to the parties and not the expert.

The definition of Rights is non-exhaustive because it includes but is not limited to, rights enforceable under English Law. I am unaware of any further rights claimed by the Respondent or which in my opinion subsist.

For the reasons set out above, I find that the Complainant has failed to establish that it has Rights in respect of a name or mark which is identical or similar to the Domain Name. The Complaint therefore fails.

Because of the registration held by The Alternative Parcels Company Limited for APC OVERNIGHT and the content of my disclosure, I have gone on to set out my thoughts on whether the Complainant could have successfully proven that the registration of the Domain Name is Abusive had it been able to establish Rights under the registered trade mark referred to above.

Abusive Registration

An Abusive Registration is defined in Paragraph 1 of the Policy as a Domain Name which either:-

- “i was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR*
- ii has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights”.*

Under (i) above it is critical that abusive conduct should be present at the time of registration. As I have indicated above, the Domain Name was registered on 31 December 1997, some year or more prior to the registration of APC OVERNIGHT as a trade mark. Even if a claim is made to Rights pre-existing the registration, the Complainant states in the Complaint that the Respondent was part of a network of businesses trading under the style “APC Overnight” at the time the Domain Name was registered and does not allege that the Respondent had no entitlement to do so.

I do not therefore find that there was an Abusive Registration under Paragraph 1(i).

The ground set out in Paragraph 1(ii) is not so restrictive. A non-exhaustive list of factors which may be evidence of an Abusive Registration are set out in Paragraph 3. They are:-

- “i* *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:*
 - A.* *primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*
 - B.* *as a blocking registration against a name or mark in which the Complainant has Rights; or*
 - C.* *primarily for the purpose of unfairly disrupting the business of the Complainant;*
- ii.* *Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;*
- iii.* *In combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations; or*
- iv.* *It is independently verified that the Respondent has given false contact details to us.*

The Complainant has not directed its contentions to any particular factor or factors and I therefore address each one in turn.

Selling etc - There is no evidence to suggest that the Respondent has ever attempted to transfer the Domain Name other than to the Complainant, and no allegation is made that such offer to transfer was on the basis of consideration, valuable or otherwise.

Blocking – Under this heading, the Domain Name must have been acquired to block the Complainant from acquiring the Domain Name. In the present Complaint there is no evidence to support such a claim, and indeed the Complainant itself asserts that the Respondent was part of a network of businesses trading under the name/mark APC Overnight. In that respect the Respondent appears (in the absence of any evidence from the Complainant) to have had an entitlement to register the Domain Name, and in those circumstances I do not accept that the Domain Name was registered or otherwise acquired as a blocking registration.

Unfair Disruption – Paragraph 3 states that for this factor to succeed the registration must have been primarily for the purpose of disruption. I have seen nothing in the papers before me which evidences such an intention.

Confusion – Evidence required under this head is that of actual confusion. The Complainant asserts that the Respondent has been directing the Domain Name to its own website. However, there is no claim or evidence

that the public has been confused into believing that they are dealing in some manner or means with the Complainant.

Pattern of Abuse – No evidence of any further registrations in the hands of the Respondent has been provided.

False Contact Details – Again no evidence is provided under this head.

The factors contained in Paragraph 3 of the Policy, is as referred to above, non-exhaustive. However the Complainant has not put forward any additional factors, and from the papers that I have, I am not aware of any additional evidence that would support a finding that the Domain Name has taken “unfair advantage” or was “unfairly detrimental” to the Complainant’s Rights.

8. Decision:

For the reasons set out above, in my opinion the Complainant has failed to prove on the balance of probabilities that (i) it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and (ii) the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore fails.

Simon Chapman

25 February 2002