

# Nominet UK Dispute Resolution Service

**DRS 000049**

## **Blake Aerials Limited –v- Adam Barrington**

### Decision of Independent Expert

#### **1. Parties:**

Complainant: Blake Aerials Limited  
Address: 177/183 Rutland Road  
Sheffield  
Yorks

Postcode: S3 9PT  
Country: GB

Respondent: Mr Adam Barrington  
Address: 370 Jessop Road  
Stevenage  
Herts

Postcode: SG1 5ND  
Country: GB

#### **2. Domain Name:**

blakeaerials.co.uk (“the Domain Name”)

#### **3. Procedural Background:**

The Complaint was lodged with Nominet on October 11, 2001. Nominet validated the Complaint and notified the Respondent of the Complaint on October 15, 2001 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent failed to respond. Mediation not being possible in those circumstances, Nominet so informed the Complainant and on November 11, 2001 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On November 19, 2001, Andrew Lothian, the undersigned, (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as

expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

On November 19, 2001 the Expert requested a further statement on abusive registration from the Complainant together with additional supporting documentation. A response to this request was received from the Complainant on November 26, 2001 providing additional supporting documentation “the Supporting Documentation” but no further statement.

#### **4. Outstanding Formal/Procedural Issues (if any):**

In terms of paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”) the Respondent is required to submit a response to Nominet. In this case no such response has been received.

In terms of paragraph 15b of the Procedure the Expert will proceed to a Decision on the complaint if, in the absence of exceptional circumstances, a party does not comply with any time period laid down in the Procedure or the Dispute Resolution Service Policy (“the Policy”).

There is no evidence before the Expert to indicate the presence of exceptional circumstances; accordingly, the Expert will now proceed to a Decision on the Complaint notwithstanding the absence of a Response.

Paragraph 15c of the Procedure provides that “ If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure . . . . . , the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate.”

In light of the absence of a Response in this case it is necessary for the Expert to consider whether to draw any special inferences from the Respondent’s non-compliance with paragraph 5a of the Procedure.

There are many reasons why a Respondent may not provide a Response and the Procedure does not require the Expert to speculate upon these. In the view of the Expert, if the Respondent does not submit a response the principal inference that can be taken is that he has simply not availed himself of the opportunity to demonstrate that the Domain Name is not an Abusive Registration. This does not affect the primary requirement upon the Complainant on whom the burden of proof rests to demonstrate Abusive Registration.

#### **5. The Facts:**

The Complainant is a UK Limited Company. It has been in business under the name of Blake Aerials Limited for over thirty years and manufactures and supplies radio and television aerials and brackets to UK and overseas customers.

On May 20, 1997 the Complainant registered the third level domain name Blake-aerials.co.uk. It currently carries on business through a website at <http://www.blake-aerials.co.uk> and receives orders from its international customers by email to that domain.

The Respondent registered the third level Domain Name BlakeAerials.co.uk on August 8, 2000. The fourth level domain www.blakeaerials.co.uk currently redirects browsers to a website at <http://www.aerialsystems.com>.

On October 2, 2001 the Complainant sent an email to the Respondent requesting a response from the Respondent concerning his registration of a similar name and seeking to resolve the issue amicably. The Respondent did not reply.

## **6. The Parties' Contentions:**

### **Complainant:**

The Complainant's contentions are as follows:

1. The Complainant's company name is Blake Aerials Limited. The company has traded under that name for thirty years. A copy of the Complainant's application for a trading account, dated April 16, 1971, has been produced in the Supporting Documentation. The Complainant has operated the domain name blake-aerials.co.uk for approximately five years and has a website at www.blake-aerials.co.uk. The Complainant produces a copy of the Nominet WHOIS query result for Blake-aerials.co.uk in the Supporting Documentation showing a registration date of May 20, 1997.
2. Two months prior to the lodging of the Complaint, the Complainant's domain name was de-tagged by the Complainant's Internet Service Provider. During the period that the Complainant's domain name was inactive due to the de-tagging, customers of the Complainant discovered the existence of the Domain Name blakeaerials.co.uk and sent email to it in an attempt to email the Complainant as the site 'did not error'. This caused, in the submission of the Complainant, a 'major confusion' which is 'still ongoing'.
3. The web domain www.blakeaerials.co.uk links to a website at www.aerialsystems.co.uk, a website belonging to a customer of the Complainant. The Complainant has contacted its customer who has told the Complainant that it knows nothing about the Domain Name or how it comes to point to their website. The Complainant speculates that the Respondent may be a former employee of their said customer.
4. The Complainant has emailed the Respondent to invite him to discuss the matter and the Respondent has not replied. A copy of the email, dated October 2, 2001, has been provided in the Supporting Documentation.
5. The Complainant contends that the confusion is causing commercial damage to its business, especially to its overseas business which relies heavily on email communication. The Complainant produces a copy of its Value Added Tax EC Sales list for the period April 1 to June 30, 2001, showing EC sales to Ireland and France of a substantial amount, in the Supporting Documentation.

### **Respondent:**

The Respondent has not responded.

## **7. Discussion and Findings:**

### **General**

In terms of paragraph 2b of the Policy the primary onus is on the Complainant to prove to the Expert on balance of probabilities each of the two elements set out in para 2a of the Policy, namely that:

- (i) The Complainant 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.

### **Complainant's Rights**

The Policy defines Rights as including but not limited to, rights enforceable under English law (excluding names of a purely descriptive character).

What kind of rights, in terms of the Policy definition, would the Complainant have to show in a name or mark? Obviously if the Complainant has reflected a name in a UK registered trade mark, or can establish that it is the owner of sufficient business goodwill associated with an unregistered name or mark such that it could protect it by action of passing off, these would amount to rights enforceable under English law which the Expert can consider. Furthermore, the categories of Rights are not closed as the definition does not limit the Expert exclusively to English legal rights.

Unfortunately the Expert has been provided with little information to support the Complainant's assertion of Rights. In the absence of any submission it must be presumed that the Complainant does not have a registered trade mark. The Complainant has provided some evidence, albeit scant, of business goodwill which it has in the unregistered mark 'Blake Aerials'. The Expert is prepared to accept that the Complainant's thirty year trading history and the evidence of its substantial overseas trade in the form of the quarterly Value Added Tax EC Sales list are persuasive as far as its Rights are concerned. There are of course no contradictory assertions from the Respondent.

Is the name or mark identical or similar to the Domain Name? The first and second levels of this Domain Name (the .co and .uk) can be discounted as being of a generic nature. It is therefore the third level (blakeaerials) which falls to be considered. It is appropriate to discount the fact that the Domain Name contains no space between the words 'Blake' and 'Aerials' as this has no significance and in any event results from the fact that spaces, in contrast to the dash or hyphen, may not be used in domain names.

Consequently, the Expert finds that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name.

### **Abusive Registration**

Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "Abusive Registration" 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."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy.

Paragraph 3(a)(i) calls for 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;

In the Expert's view Paragraph 3(a)(i) requires the Complainant to provide evidence regarding the purpose for which the Respondent registered or otherwise acquired the Domain Name. In the present proceedings the Complainant has not provided any such evidence and this is perhaps understandable given the Complainant's contention that neither it nor its customer knows anything of the Respondent or the purposes for which the Domain Name was registered.

The Complainant's submissions regarding the de-tagging of its own domain name are of no particular import other than to explain how the Complainant and its customers discovered the existence of the Respondent's Domain Name. Similarly the Complainant's speculation as to the past employment of the Respondent is not of any assistance to the Expert.

Paragraph 3(a)(ii) of the Policy calls for 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. In contrast to paragraph 3(a)(i), this paragraph focuses on the use to which the Respondent has put the Domain Name rather than the purpose for which he registered it.

The Complainant's submissions are similarly focused upon use. The Complainant submits that the Domain Name links to a website whose main address is <http://www.aerialsystems.co.uk>. While the word 'links' might imply that a website merely contains a hyperlink, the Expert accepts that the Complainant intended it to mean that when the Domain Name is entered into a web browser the browser is redirected to the website at <http://www.aerialsystems.co.uk>. The Complainant also submits that email was sent by its customers to the Domain Name although there is no indication as to whether that email was received by or bounced from the Domain Name. The Expert accepts that on balance these submissions disclose that the Domain Name is being 'used' (in the ordinary sense of being pointed to a website and/or using email exchange facilities).

The Complaint is rather scant in its detailing of the circumstances complained of and the Expert is only provided with limited supporting information. The Complainant has simply stated that email was wrongly sent by its customers to the Domain Name causing a 'major confusion' which is 'still ongoing'. Can this be taken as the kind of circumstances contemplated in paragraph 3(a)(ii)? Clearly, on the Complainant's submission, businesses have been confused into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant. For the Complainant to show that this constitutes evidence of Abusive Registration within the meaning of the paragraph such confusion must result from the Respondent's *use* of the name. The only evidence before the Expert as to use is the Respondent's pointing or redirection of the Domain Name to <http://www.aerialsystems.co.uk>.

Had the website at <http://www.aerialsystems.co.uk> disclosed no apparent connection with the business of the Complainant it would have been difficult to accept that the Complainant had an arguable case in terms of paragraph 3(a)(ii). However, the fact that the Domain Name has been pointed to the website of a customer of the Complainant, who appears from that website to be in the business of aerial supply and fitting, is in the Expert's view sufficient evidence that the Respondent's use has led to the confusion of the Complainant's customers. While this confusion, even on the Complainant's submissions, was exacerbated by the technical failure of the Complainant's own domain name, there would have been no confusion if the Respondent had not used the Domain Name as he did.

The Complainant goes on to submit that the confusion has caused it commercial damage. This is not a matter which the Complainant is required to prove under the terms of the Policy, although the categories of evidence of Abusive Registration are not closed. Commercial damage may indicate use which has been unfairly detrimental to the Complainant's Rights in terms of paragraph 1(ii) of the Policy. However, in the present proceeding it would appear that the commercial damage submitted by the Complainant resulted more directly from the de-tagging of its own domain name rather than from the actions of the Respondent, so the Complainant cannot show unfair advantage or detriment on the grounds of commercial damage. Nevertheless, the Expert is satisfied that the pointing of the Domain Name to the Complainant's customer and the resultant confusion were unfairly detrimental to the Complainant's Rights.

The Complainant has therefore made out an arguable case that the Domain Name is an Abusive Registration.

The Policy does not restrict the factors which may be evidence that the Domain Name is an Abusive Registration to those specified in paragraph 3, but considering paragraphs 3(a)(iii) and (iv) of the Policy for the sake of completeness, the Expert notes that the Complainant's case does not contain any submission that the Respondent is engaged in a pattern of making Abusive Registrations nor that the Respondent has supplied false details to Nominet.

It is at this point that the Expert would consider factors put forward by or on behalf of the Respondent which might be evidence that the Domain Name is not an Abusive Registration. Paragraph 4 of the policy lists some such factors. As with paragraph 3, the Policy does not restrict the possible factors exclusively to those listed in paragraph 4.

In providing no response the Respondent has not offered any such factors and has not availed himself of the opportunity to address or contradict the submissions of the Complainant. The Expert is satisfied that the Complainant has made out an arguable case, a case which requires an answer from the Respondent. No answer has been given. The Complainant has offered evidence that the Respondent was invited by email to provide an explanation for his use of the Domain Name and failed to do so. The Respondent has been afforded a formal

opportunity to provide an explanation during the course of this proceeding and has not done so.

Looking at the circumstances from the Respondent's point of view, his use of the Domain Name is unusual to say the least, in that he has pointed a domain name he has registered to the website of a company which, in the Complainant's submission, knows of no reason for such conduct. In the absence of a Response the Expert is only able to look for a patent or obvious answer for the Respondent's conduct. The Expert cannot find any such answer from the facts disclosed in this proceeding.

The Expert therefore finds that the Domain Name is an Abusive Registration as defined in paragraph 1(ii) of the Policy on the ground that it has been used in a manner which was unfairly detrimental to the Complainant's rights.

### **Remedy**

The remedy sought by the Complainant in this proceeding is 'Suspended asap with the potential to transfer'. Paragraph 17(c) of the Procedure anticipates a decision by the Expert that the Domain Name registration be cancelled, suspended, transferred or otherwise amended, or that the *status quo* be maintained.

The Complainant's submissions disclose a relatively long history (in Internet terms) of successful trading under its own domain name. What the Complainant takes issue with in the present proceeding is the confusion arising from the Respondent's use of his Domain Name. In the Expert's view the most appropriate disposal of this case is for registration of the Domain Name to be suspended so that it cannot be used to perpetuate the confusion, rather than to order the transfer of the Domain Name to the Complainant.

### **8. Decision:**

The Expert directs that the registration of the Domain Name, blakeaerials.co.uk, be suspended for the duration of the period for which it is currently registered, and thereafter cancelled.

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Andrew D S Lothian

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Date