

Nominet UK Dispute Resolution Service

**DRS 00444**

**BlissWorld Limited and BlissWorld LLC -v- Blissworld**

Decision of Independent Expert

**1. Parties**

Complainant: BlissWorld Limited and BlissWorld LLC  
Address: 843 Finchley Road  
London  
Postcode: NW11 8NA  
Country: GB

Respondent: Blissworld  
Address: Blissworld  
Second Floor  
Wah Fong House  
Wanchai  
Postcode:  
Country: Hong Kong

**2. Domain Name**

blissworld.co.uk (“the Domain Name”)

**3. Procedural Background**

The Complaint was lodged with Nominet on 12 June 2002. Nominet validated the Complaint on 13 June 2002. On the same day, Nominet attempted to contact the Respondent and to inform him that he had 15 (working) days within which to lodge a response. Messages were sent by email (to both available email addresses) and by post. No “undeliverable” messages were received, and neither was there any response. On 9 July Nominet again tried to contact the Respondent via email (this time to one email address only) and by post informing him that as no response had been received, and mediation was therefore impossible, the Complainant would be given the option of paying for an expert decision. Again, there was no indication of messages having been undeliverable and no response was received.

On 19 July 2002 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 22 July 2002 Claire Milne, the undersigned, (“the Expert”) confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

#### **4. Formal/Procedural Issues**

In this case not only has no response been received, but there is no evidence that the Registrant has actually received any communications from either Nominet or BlissWorld. If he in fact received nothing, then he could not respond, and to call him a Respondent would be misleading. To avoid misleading in this way, from here on I shall refer to him as the Registrant rather than as the Respondent.

No “exceptional circumstances” (Paragraph 15b of the Procedure) are known to the Expert which would justify any further delay in deciding the case.

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

The Complaint in this case is quite long. Its substance (that is, minus supporting annexes) is reproduced in full at 6 below, for ease of reference in the discussion. As already explained, there has been no response. In brief summary, the facts of the case appear to me to be as follows.

- a. The Complainant has been running Bliss health spas in the USA since 1996. Since 1997 it has operated the website at <http://www.blissworld.com> as a complement to its physical business. By January 2002, this had generated over 200,000 page requests and sales of over \$19,000 from UK-based customers.
- b. In April and May 1999 the Complainant registered at the UK Patent Office the trademarks Bliss (in multiple classes), Laboratoire Remede, and BlissLabs. In late 2001 it registered the further trademarks Fruithie and Crystal Clearing. A logo showing the word “bliss” in lower case sans-serif italic white script, within a round grey background with seven bubbles arising from the “i”, was also registered.
- c. On 9 February 2000 the Complainant registered the UK company name BlissWorld Ltd.
- d. On 18 October 2000 the Registrant registered with Nominet (through the UK ISP WebFusion) the domain name blissworld.co.uk. He gave his name simply as Blissworld, with a Hong Kong postal address and a hotmail email address. He also supplied a UK mobile phone number for administrative and billing contacts.
- e. On 25 October 2001, Eleanor Bradley of Nominet wrote to Jane Mutimear of Bird and Bird (BlissWorld’s solicitors for this case), presumably in response to an earlier enquiry that has not been provided to me. This letter provided the Hong Kong postal address for the Registrant of blissworld.co.uk. It also suggested contacting the host ISP to find the registrant of another domain name, bliss.co.uk, whose registration predated Nominet.
- f. On 26 November 2001 the Complainant opened a spa at 60 Sloane Avenue, London SW3. For a period before and after this event, its plans, products and services received coverage in the UK press, and especially in the fashion and beauty press. The table below summarises salient points from copies of articles and items supplied as Annex 1 to the Complaint. Even before this coverage, Bliss Spa had for some years enjoyed a high profile in the UK health and beauty industry, as is testified by the beauty editors of several magazines.

	<b>Periodical</b>	<b>Date</b>	<b>Article or item title</b>	<b>Mentions including Bliss</b>
1	Vogue	August 2001	bliss me quick	Bliss spas, Bliss Spa, Bliss, QuickBliss, BlissLondon
2	You Magazine	18 Nov 2001	get blissed	Bliss London, Bliss, Rhythm & Bliss CD, blisscertificate, <a href="http://www.blissworld.com">www.blissworld.com</a>
3	Evening Standard Magazine	2 Nov 2001	Take me to heaven in my lunch hour	BlissSpa, BlissLondon, Bliss, BlissOut <a href="http://www.blissworld.com">www.blissworld.com</a>
4	unidentifiable	?	Give us the democratic day spa!	Bliss
5	Hello!	19 Mar 2001	Bliss triple oxygen facial	Bliss, Bliss Spa, BlissLondon
6	Tatler	April 2002	Tales from the powder room	The Fully Loaded Facial at Bliss
7	Glamour	April 2002	(favourable mention of)	“Marcia Kilgore for founding Bliss, the glamorous spa”
8	Evening Standard Magazine	15 Feb 2002	She’s got the look	Blissspa
9	Glamour	March 2002	competition	Spa day at BlissLondon offered as a prize
10	Elle	March 2002	10 things to cheer you up	Rosy Toes Pedicure from Bliss London
11	Telegraph Magazine	9 Feb 2002	Lovin’ it – what to buy your sweetheart?	Bliss Spa massage kit
12	Now	13 Feb 2002	Bliss goes British	Bliss, Bliss London
13	Marie Claire Health & Beauty	Dec - Jan 2002	Stateside treatments	Bliss, Quick Bliss, Bliss Spa London, Bliss New York
14	Marie Claire	March 2002	Does it really work? The hangover massage	Bliss Spa, Bliss New York, Bliss
15	Elle	Feb 2002	What we saw at the London Spa launch	None
16	InStyle	Feb 2002	Pure bliss	Bliss, Bliss Basic Facial, Bliss London, <a href="http://blissworld.com">blissworld.com</a>
17	Sunday Times Style	30 Dec 2001	I will spend less time having more done in the salon	Bliss
18	Daily Mail	7 Jan 2002	BlissLondon Triple Oxygen Treatment	None beyond title
19	Sunday Times Style	6 Jan 2002	Wellbeing hot list	Rhythm & Bliss, a jazz CD from Bliss London
20	Elle Decoration	Feb 2002	Blissful bathing	Bliss Spa, Bliss London, <a href="http://www.blissworld.com">www.blissworld.com</a>
21	Deco details	Feb 2002	Make a splash	Rhythm & Bliss from BlissLondon, <a href="http://www.blissworld.com">www.blissworld.com</a>
22	Daily Telegraph	10 Dec 2001	Spice up your seasonal senses	Bliss, BlissLabs Lower Body Blaster Lotion
23	Elle	January 2002	Juice Boosters	Bliss London, Carrot and Ginger Bliss Fruthie
24	Time Out	12 Dec 2001	Spas in their eyes – the secret of Bliss’s success	Bliss Spa, Bliss
25	Sunday Times Style	9 Dec 2001	Total wellbeing	Bliss, BlissLondon, <a href="http://www.blissworld.com">www.blissworld.com</a>
26	Glamour	Dec 2001	Everything you always wanted to know about salons and spas	Bliss spas

27	Daily Mail Weekend	29 Dec 2001	We can't get through the week without...	Bliss London
28	Hello!	11 Dec 2001	The beautiful people	BlissLondon
29	Heat	8 Dec 2001	Bliss party	Bliss spa, Bliss T-shirt, Bliss' Ginger Rub Massage
30	Daily Telegraph	23 Oct 2001	BlissLondon – the closest you'll get to experiencing celebrity heaven	BlissLondon, Miss Bliss, Bliss, BlissLabs
31	Centurion	Oct 2001	Bliss spa, London	Bliss, Bliss Rosy Toes foot lotion
32	Times	19 Nov 2001	the ultimate Bliss	Bliss, Bliss57, BlissLondon, Blissage, blissworld.com, BlissOut, Blissertificate
33	Telegraph Magazine	1 Nov 2001	Sheer Bliss	Bliss, the Blissworld website, British Bliss
34	Sunday Telegraph Magazine	9 Sept 2001	Beauty Notebook	BlissLondon, QuickBliss, Bliss57, Bliss spa, Bliss

- g. On 27 October 2001 Bird and Bird searched for the name Blissworld at the Hong Kong Business Registration Office and found nothing. Around this time also they carried out a Hong Kong company search, which revealed a company called Blissworld Company Limited originally registered on 13 September 1984, with a different Hong Kong address from that of the Registrant. (The Complainant says that this company was dissolved on 27 September 1996. No evidence has been provided for this but I am prepared to accept it as fact).
- h. On 29 October 2001 Simon Hughes of Bird and Bird tried to email the Registrant (at the address [mail@blissworld.co.uk](mailto:mail@blissworld.co.uk)) and obtained a “successful delivery notification” but no reply.
- i. On 5 November 2001 Simon Hughes of Bird and Bird wrote to the Registrant at the Hong Kong postal address and by email, requesting the transfer of [blissworld.co.uk](http://blissworld.co.uk) to his client. Again the email elicited a “successful delivery notification” but no reply. The postal package was sent by registered post from Bird and Bird’s Hong Kong office in Citibank Tower. The Post Office was unable to deliver it, and returned it to Bird and Bird, accompanied by a form with a cross by the explanation “insufficient address” (other options being “address unknown”, “not occupied”, “moved, new address unknown”, “no such address”, and “moved, redirection service not arranged by addressee”).
- j. On 31 December 2001 the website at [www.blissworld.co.uk](http://www.blissworld.co.uk) was explored. The contents of most pages were recorded and have been supplied to me as evidence. On visiting the website myself in late July 2002 I found an almost identical situation. The site’s “home page” consists of a file list which is clearly not intended to be a public interface. The files include:
- A “welcome page” headed “blissworld, made with thought”, announcing the intention of offering a wide range of goods and services, including the clothing mentioned below, and also (for example) website design, entertainment and furniture (but not health or beauty treatments or preparations). The page makes it clear that the site is still under development, with updates planned during December 2000.
  - photographs of young females (with Western features) modelling articles of clothing, which are described and priced (in US\$) as if they were being offered for sale.

- a logo showing the word “bliss” in a lower case uncial font, with white lettering against a flattened oval dark background, crescents and stars at left and right and the dot of the “i” replaced by a fantasy head.
- A “contact us” form and the following records of messages apparently received: “well its half there” (twice), “bolluxs”, “I would like to contact the domain owner of blissworld.co.uk. Please contact me at your earliest convenience at the address above. Best Regards, Terrance Young ([terranceyoung@cs.com](mailto:terranceyoung@cs.com))”
- A visitor counter, which read 150 on 10 December 2001, 159 on 31 December 2001 and 162 on 23 July 2002.

### **The Parties’ Logos**





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

The Complaint is reproduced below in full. No response has been received.

This Complaint is based on the following grounds:

### **The Complainants' rights**

1. The Complainants are BlissWorld LLC, a Delaware Limited Liability Company, of 50, Washington Street, Brooklyn, New York, USA and its wholly-owned subsidiary, BlissWorld Limited of 843 Finchley Road, London, NW11 8NA (together the "Complainant").
2. The Complainant is the owner of the BLISS health spas in New York. The first spa was opened in 1996 and has become a famous and fashionable health spa frequented by many celebrities. In 1999 a second Bliss Spa was opened in New York, and on 26 November 2001 a spa was opened in the UK (in London). For around 18 months prior to the UK launch, there was considerable publicity concerning BlissWorld's proposal for the London spa and the Complainant received wide-spread press coverage. See Annex 1 for examples of such publicity and coverage. Testimony from beauty editors of several of the leading UK magazines are contained at Annex 2. These were gathered in relation to a previous dispute concerning 'bliss' prior to the Complainant's launch in the UK.
3. Since 1997 the Complainant has operated a website under the domain name blissworld.com. The website can be found at <http://www.blissworld.com>. This is the online site for the spas, detailing the services available at the spas and offering online appointment confirmation and cancellation as well as the sale of various associated products.
4. In advance of opening a spa in the UK, BlissWorld LLC set up BlissWorld Limited on 9 February 2000 to operate as its UK arm. The UK spa is owned and operated by BlissWorld Limited. A copy of the brief company details from the Companies House website is enclosed at Annex 3.
5. The Complainant is the proprietor of four UK registered trade marks for BLISS. Copies of the trade mark details from the Patent Office website are enclosed at Annex 4.
6. As a result of the Complainant's use of the blissworld.com website promoting its spas and beauty treatment products, the Complainant has built up substantial reputation and goodwill in the mark 'blissworld' in the UK. The Complainant's records indicate that between May 2001 and January 2002, 237,105 requests for pages on the blissworld.com website originated from the UK. Further, up until around January 2002, sales amounting

to US\$19,745.80 were made to UK-originating customers from the blissworld.com website.

7. Attached as Annex 5 are search results from the search engine google.com where searches for "blissworld" or "bliss world" returned the Complainant's website as the first few hits, followed by various websites discussing the Complainant's website and business. In addition, the first two websites returned by MSN Search after typing "blissworld" alone into the browser bar are pages from the Complainant's website (see Annex 6). Therefore, even a cursory internet search would reveal that "blissworld" is an online brand of the Complainant.

### **Abusive registration**

8. The domain name the subject of this Complaint, www.blissworld.co.uk (the "Domain Name"), was registered on 18 October 2000 by the Respondent. The contact details that the Respondent provided (and which were provided by Nominet to the Complainant's solicitors - see Annex 7) are Blissworld, 2nd Floor, Wah Fong House, Wonchai, Hong Kong. A contact email address provided on the website is mail@blissworld.co.uk.
9. On 29 October 2001 a test email was sent to mail@blissworld.co.uk requesting that the recipient respond, acknowledging that the email had been received (enclosed at Annex 8). Although the email delivery subsystem report shows that the email was delivered (enclosed at Annex 9), there was no response to the email.
10. The Complainant's solicitors, Bird & Bird, wrote to the Respondent by email on 5 November 2001 requesting the transfer of the domain name to the Complainant (enclosed at Annex 10). Although the email delivery subsystem report shows that the email was delivered (enclosed at Annex 11), there was no response to the email. Bird & Bird also attempted to have the letter delivered simultaneously by courier to the address given by the Respondent to Nominet as its contact address. Delivery was impossible as the courier company could not locate the building. Unfortunately there is no receipt from the courier company used; Bird & Bird are informed that courier receipts in Hong Kong are only provided following a successful delivery. Bird & Bird then attempted on 6 November 2001 to have the letter delivered by registered post from within Hong Kong. The letter was returned due to the address being insufficient. A copy of the returned envelope with a return receipt is enclosed at Annex 12.
11. Paragraph 3(a)(iv) of Nominet's Dispute Resolution Service Policy states that one factor evidencing that a registration is abusive is where 'it is independently verified that the Respondent has given false contact details to us'. The return receipt from the Hong Kong Post Office provides such independent verification. Further, the Respondent is obliged under paragraph 3.4 of the Nominet Terms and Conditions (issue 2 - 10 July 1997), by which it is bound, to 'promptly notify Nominet UK of any change to its registered details'. It has clearly not done so and is in breach of its contract with Nominet. It appears that the contact details given by the Registrant were either incorrect at the time they were given or have not been updated when they subsequently became incorrect. Further, clause 7.3 of the Nominet Terms and Conditions (issue 2 - 10 July 1997) gives Nominet the power to cancel or suspend the registration of a domain name in exceptional circumstances. Nominet's being unable to contact the Registrant is an exceptional circumstance justifying the exercise of Nominet's powers to cancel the registration.
12. A company search was carried out in Hong Kong in October 2001. This returned one company called Blissworld Company Limited which was dissolved on 27 September 1996. This does not appear to be the Registrant, and the registered address does not match that which Nominet has provided. Copies of the search results are attached as Annex 13.

13. A Hong Kong business registration search was also carried out in October 2001 - every business whether owned by an individual or a registered company must obtain a business registration certificate from the Inland Revenue Department to be able to carry on a business in Hong Kong. No records were returned. Copies of the search results are attached as Annex 14.
14. The Respondent does not seem to have any trade or premises in the UK and does not seem to have any connection with the UK. Some of the files, when opened, have products (clothes) offered in US dollars (see Annex 15 for printouts of the Respondent's website confirming this).
15. The webpage found at [www.blissworld.co.uk](http://www.blissworld.co.uk) appears to be incomplete or defective. It displays an index of the website files rather than a homepage, as one would expect. The dates of the files show that most of the files were last modified on 6 December 2000. Copies of the pages which were accessible from the website as at 31 December 2001 are enclosed as Annex 16. Although some of the text on the website suggests that the site was set up to go live after Christmas 2000, this does not appear to have occurred (see Annex 17): "We will be taking secure online Credit Card Ordering, with all the latest "nifty software" after Xmas, so to see all the latest gear and get Ordering, click the link! We will be adding our Environmental, Green, Kids and Hemp range on the 1/12/2000" (<http://members.tripod.co.uk/blissworld/index%20www.blissworld.co.uk.htm>)
16. The registration of the Domain Name by the Respondent takes unfair advantage of the rights of the Complainant. At the time of registration, the Respondent would have known of the Complainant's use of "blissworld" and, even if rudimentary searches had been carried out, would have known of the Complainant's plans to open a spa in the UK. The combination of the words "bliss" and "world" to form "blissworld" does not amount to normal descriptive usage of those words. If the word "bliss" were being used in a descriptive (and grammatically correct) sense in relation to "world", then the domain name would logically be "blissfulworld.co.uk". The Complainant is extremely concerned that by registering a UK domain name with the same name as the Complainant the public may believe that the Respondent is, or is associated with, the Complainant. This is particularly worrying for the Complainant now that the UK spa has opened.
17. Further, UK residents wishing to book treatments in the UK spa or find out more about it and know that the spa's website is "blissworld" are likely to type in "blissworld.co.uk" into their browser to try to access the Complainant's website. They will instead reach the Respondent's web pages. This disrupts the business of the Complainant and acts to block the Complainant from using the domain name "blissworld.co.uk", in which the Complainant has rights. Further, as the Respondent's website appears to be defective, the website visitor will not easily realise that it is not the Complainant's website but may assume that the Complainant's site is defective, which will reflect badly on the Complainant. Annex 18 is a witness statement from Krishna Montgomery, UK Marketing Manager of BlissWorld Limited, detailing some of the comments which have been made to her by people who have attempted to access the Complainant's website via [blissworld.co.uk](http://blissworld.co.uk) and who have been confused into thinking that the Respondent's website is in fact the Complainant's or that the two sites are connected in some way.
18. Entering "blissworld.co.uk" into the browser does not lead to an error message or to a page which makes it clear that the site is not functional. Instead, it leads to a page which appears as though it could be functional but is incomplete or has not been properly implemented. If potential customers of the Complainant believe that the Complainant has set up something so unprofessional, it will reflect badly on the Complainant and will damage its reputation and goodwill.



19. Despite the statement "next update 10th Dec 2000" at <http://members.tripod.co.uk/blissworld/index%20www.blissworld.co.uk.htm> (see Annex x), the site appears to have remained static and the online ordering has not gone live. On the same page the site claims to be the "official website of Bliss clothing, Shoes and Accessories."
20. On 10 December 2001, several of the links contained in the website file list referred to at paragraph 17 resolved to an error page on Lycos Tripod. An example of the page reached is at Annex 19. On 15 March 2002, several of the links contained in the website file list referred to at paragraph 17 resolved to a search results page at <http://www.tripod.lycos.co.uk>. An example of the page reached is attached as Annex 20. On 10 June 2002, clicking onto the "Parent Directory" link in the website file list referred to at paragraph 17 resolved to the Lycos Tripod Website Building Services home page, a copy of which is at Annex 21. This suggests that the site has been abandoned.
21. The Domain Name is therefore being used (or has been abandoned and left) in such a manner that may confuse the public. In addition, the Complainant is likely to suffer damage to their reputation and goodwill in the UK.
22. The Complainant therefore requests that the Domain Name be transferred from the Respondent to the Complainant.

## **7. Discussion and Findings**

For the Complaint to succeed, according to paragraph 2 of the Policy, the Complainant must prove to the Expert that on the balance of probabilities:

- 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 as defined in paragraph 1 of the Policy.

### **Complainant's Rights**

The Complainant's registration on 9 February 2000 of the UK company name BlissWorld Ltd (Complaint para 4) is sufficient to establish to my satisfaction that the Complainant does indeed have rights in this name. The statistics for UK-based usage of the blissworld.com website, quoted in para 6, provide evidence of knowledge of the name among a certain sector of the UK public.

A large quantity of additional evidence has been supplied (Complaint para 2) which does not seem to me to be relevant to this issue, as it relates to the name "Bliss" standing alone or in combination with various other words (see summary table above). Apart from the company name, the only use of the combination "blissworld" in the evidence supplied appears to be in the domain name blissworld.com, which as already mentioned is known to some people in the UK. This evidence is however relevant to understanding the Complainant's motivation for bringing the Complaint. I shall return to this point in section 8 c).

## **Abusive Registration**

This leaves the second question raised above, that is, whether the Domain Name, in the hands of the Respondent, is 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.”

The Complainant has put forward three arguments why this should be regarded as an abusive registration. Below I paraphrase these.

### **Arm (i) argument – at the time of registration**

The first argument, relating to (i) above, is that at the time of registration the Registrant either was aware, or should have been aware, of the Complainant’s rights in the name BlissWorld in the UK, and that his use of it is therefore taking unfair advantage of these rights. Further, in paras 12 to 14 and 16 the Complainant appears to be arguing that the Registrant has no rights in the name blissworld, and no legitimate reason to register blissworld.co.uk. Evidence is:

- possibly, though this is not cited explicitly, the extensive coverage given to Bliss in the UK press (the Complainant claims that this started some 18 months before the launch, that is, around March 2000, although the earliest article provided dates from August 2001), and Blissworld’s reputation among UK beauty editors (Complaint para 2)
- the fact that searching for blissworld on common search engines immediately leads to [www.blissworld.com](http://www.blissworld.com). (Complaint paras 7 and 16. There is also a claim here that “rudimentary searches” at the time of registration would have led the Registrant to know of the Complainant’s plans to open a spa in the UK. No evidence is supplied for this claim, and in fact what is supplied tends to suggest the opposite – the Google and MSN search pages that are reproduced, dated December 2001, include no obvious reference to the UK launch even though it had taken place within the previous month. I therefore discount this point.)
- the negative results of the company and business searches carried out in Hong Kong, and the Registrant’s lack of a clear link with the UK or clear intention to trade in the UK (website prices being given in \$US)

### **Arm (ii) argument – use of the domain name**

The second argument, relating to (ii) above, is that the way the domain name has been used has been unfairly detrimental to the Complainant's rights.

Cited in support of this argument is:

- the poor and apparently unfinished state of the website (Complaint paras 15, 18 to 20)
- complaints from two or three journalists and 5-10 customers that they have been unable to access Bliss services through blissworld.co.uk (Complaint paras 17, 21) and in consequence have been frustrated
- the fact that the Complainant has been unable to develop their UK business “in the normal way” using blissworld.co.uk

### **Contact details argument**

The last argument is quite separate, and relates not to the Policy but to the Terms and Conditions. These state at 2.3:

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.

and at 8.7:

(Nominet) may cancel or suspend the registration of a Domain Name ... if we receive independent verification that you have provided grossly inaccurate, unreliable or false registrant contact details.

The Complainant contends (Complaint paras 8 to 11) that the failure to obtain any reply from the Registrant, and in particular the inability of a courier to find the building and the Post Office to deliver a package to him, amount to independent verification of false contact details as referred to above, and that accordingly Nominet should cancel the registration.

### **What has actually happened?**

Before I comment on the arguments above, I feel it would be helpful to give my own view of the probable situation. It seems to me very clear that in late 2000 the Registrant of blissworld.co.uk intended to set up a business based on that domain name, and took some initial steps to that end, which he shortly afterwards abandoned. This much, I think, would be agreed by the Complainant.

I also find it highly probable that at the time of registration the Registrant was not aware of the existence of Bliss Spas; and, even if he had heard of this company, that he would have been unaware of their intention to set up a UK branch. This may have been common knowledge in the UK beauty industry in October 2000, but it was not widely publicised in the general UK press at that time, let alone elsewhere (and I see no reason to question the

Registrant's then being based in Hong Kong). I have already commented on this fact not being obvious in internet searches even in December 2001.

In para 16 the Complainant seems to be suggesting that the Registrant must have copied the name "blissworld" from them. I am of the opposite opinion. As already explained, I think it improbable that before trying to register this name he would even have heard of the Complainant. I believe it is much more probable that the Registrant invented the name "blissworld" for himself independently, or somehow "inherited" it from the earlier Hong Kong company of that name. The term "bliss" is common in translations of Chinese religious texts and is used in several Hong Kong company names (found in an interrogation of the online telephone directory). The term "world" is of course also common, and the combination "blissworld" is not so extraordinary that it is implausible that different people should think of it independently.

Having decided to register a name including "blissworld", he may well have come across blissworld.com and the associated company, but have decided that they were irrelevant to his ambitions as they were operating in another area of business and in a different top-level domain – and not, physically, in the UK. This would, in my view, have been a reasonable conclusion to draw. In any event, it seems obvious to me that the Registrant had no intention of trading on the back of the better known firm, or indeed of obstructing their business. In support of this view I cite the complete lack of relation between the two businesses – one in health and beauty treatments, the other in clothing – and between their styles, their logos being entirely different.

We have discussed the Registrant's choice of the name "blissworld". But why .co.uk? The most probable course of events, I feel, is that having thought of a business and a name, he tried to register blissworld.com, found it taken and went for a "next best" internationally accessible domain name of blissworld.co.uk, which was available. Alternatively he may have had ideas of trading in the UK, or simply found the UK a natural choice given Hong Kong's history.

Like many small business startups, his plans seem to have come to nothing, at any rate for the time being. He has also been hard to reach. We do not know whether or not he has received emails (confirmation of message delivery is not, of course, any guarantee of an individual actually having received that message). We do know that the postal address originally supplied has been found insufficient – this may be, for example, because of a lack of room number on the floor mentioned – and it is of course possible that he has moved office and omitted to inform Nominet. I find the most probable explanation to be that, his blissworld business venture having been put aside, he has abandoned use of both the website and the email addresses associated with this venture.

### **Discussion of abusive registration**

I turn now to each of the Complainant's arguments in relation to abusive registration.

### **Arm (i) – at the time of registration**

As regards the first, I find it improbable beyond belief that the Registrant would have chosen to register blissworld.co.uk in October 2000 in the expectation of either benefiting from or disrupting the business of the Complainant. He would have had no knowledge of the Complainant's intention of setting up in the UK. His website makes no reference whatever to the Complainant or to the Complainant's line of business. If he had wished to do any harm to the Complainant, or to take advantage of their reputation, then there would have been much more obvious ways of achieving this. There is no evidence of the Registrant's intent having been unfair.

Furthermore, the Complainant was not active in the UK at the time of registration. No advantage or detriment (whether fair or unfair) could possibly have come about until a year later.

There are suggestions in the Complaint that the Registrant had no right to the name blissworld, and that when registering the name he failed to exercise due care to avoid infringing the Complainant's rights.

In relation to the first, we are ignorant of any relation between the earlier Hong Kong Blissworld Company and the Registrant. The earlier use of the name (from 1984) certainly predates the Complainant's use of it. The Registrant does not seem to have made any formal claim to the name either in Hong Kong or in the UK. However, his attempt to trade under the unregistered name Blissworld seems to me legitimate.

As for exercising due care to avoid infringing the Complainant's rights, it appears that there are two steps that in principle he could have taken at the time of registration but probably did not take:

- he could have searched more deeply on the Bliss company, or maybe even contacted them, to find out about their future expansion plans and whether they were thinking of setting up in the UK
- he could have searched UK company registrations for the name Blissworld, in which case he would have found the Complainant's registration

The first seems to me clearly above and beyond the call of duty. The warranties in Nominet's terms and conditions refer to knowingly infringing a third party's existing intellectual property, not to second-guessing their expansion plans.

It would be less unreasonable to expect applicants for Nominet's domain names to search the UK companies register; however this is still not an obvious thing for an overseas based small business person to think of doing (and I can see no relevant advice to applicants on Nominet's website). In fact, had he explored this matter thoroughly (and followed up by examining Bliss's registered trademarks) he would have discovered that their lines of business, while wide-ranging, did not include the clothing market which was his first target, and might reasonably have concluded that there was no problem

I therefore reject arm (i) of abusive registration: at the time of registration, there can have been no unfair advantage or detriment.

### **Arm (ii) – use of the domain name**

Looking now at arm (ii) and the Complainant's second argument, we must consider whether since registration the domain name has been used in a way which has taken unfair advantage of or been unfairly detrimental to the Complainant's rights. Here, the position is a little less clear cut.

From late 2001 on, the Registrant may have become aware of the Complainant's UK business, either through his normal activities or through receiving emails from Nominet and the Complainant. I cannot see, however, that his choosing to retain the name when it had coincidentally become valuable to someone else amounts to unfair behaviour.

Incidentally, the fact that he has not offered to sell the name in my view is strong evidence of his not having received any communication on the subject. Most small business people would spot such an opportunity if it came into their field of vision.

As the website has been inactive, he cannot have not derived any advantage from the matching name. The Complainant points to detriment that they have suffered. I accept that there has been some detriment, but in my view it is minor in the context of the Complainant's business. They have pointed themselves to the success of the .com site even for UK customers. Many companies trade internationally on .com sites, sometimes offering customers different pages depending on their home country. And in any case, I cannot regard the detriment, whatever its size, as unfair. I therefore reject arm (ii) of abusive registration.

### **Contact details**

This leaves the question of whether Nominet should cancel the registration because of false or out-of-date contact details. The term "false" implies an intention to mislead, and there is no evidence of such an intention. All we know about the address is that it is inadequate. It is possible that the address is also out of date, but here we have no evidence in either direction. The terms and conditions give Nominet discretion to cancel a registration in case of failure to keep contact details up to date; they do not require cancellation. It seems to me that it would be disproportionate for Nominet to use its discretion to cancel a registration where an address has simply proven inadequate and may or may not have changed, but there is no other irregularity or problem with the registration.

There is perhaps an implicit suggestion that the registration should be transferred because the Registrant is currently making no use of it whereas the Complainant has a clear use in mind. Were this suggestion to be made, I should reject it. It is not in keeping with the policy, and it would be unfair – we have no knowledge of what other plans the Registrant may have for the domain name.

I therefore reject the Complainant's third line of argument. Overall, I do not find the registration abusive and the Complaint fails.

## **8. Further comments**

I would like to make a few further observations on this case.

- a. It cannot have escaped the Complainant's notice that the registration falls due for renewal in October 2002, which is now only a few months off. This event should provide the opportunity for the Complainant either to negotiate with the Registrant (should he get in touch at that point) or to register the domain name themselves, if the Registrant allows it to lapse.
- b. I note that, despite their stated long-held intentions of becoming established in the UK, the Complainant did not investigate availability of the domain name until shortly before launch. It was open to them to register it before the Registrant did. In fact the situation seems to have been quite symmetrical – both the Complainant and the Registrant being overseas enterprises wishing to establish a UK web presence. The Complainant appears to believe that being the larger and more successful of the two entitles them to the name. However, Nominet's rule is first-come, first-served.
- c. In this case it is necessary for me to consider whether the Complaint was brought in bad faith. Certainly, I find the Complainant's accusations of unfairness towards an unknown other ill-founded, and their recourse to third-party proceedings premature. However, the press-cutting evidence provided influences me in this matter. Plainly, the Complainant is deeply immersed in and dedicated to the health spa business. Their natural belief in their own reputation has been bolstered by the considerable coverage afforded by the UK beauty press. In such circumstances it is easy to imagine one's reputation to be bigger and better than it really is, and one's rights accordingly more extensive (and others' rights more limited). I can believe that the Complaint was brought in this genuine, though mistaken, frame of mind. Accordingly I do not make a finding of bad faith.
- d. Lastly, I note that the UK mobile phone number that the Registrant supplied to Nominet has still not been used in any of these attempts to contact him. He may have supplied this in the hope that it would be used should postal communications prove inadequate. Nominet's procedures do clearly state that communications will be written, but they have discretion to use the phone as well.

## **9. Decision**

In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name but that the Domain name is not an Abusive Registration, the Expert decides against the Complainant. No action is to be taken.

\_\_\_\_\_ 8 August 2002  
Date

Claire Milne