

NOMINET-UK DISPUTE RESOLUTION SERVICE

BETWEEN:

CAME AUTOMATION LIMITED

Complainant

-and-

CAMEO ELECTRIC GATES LIMITED

Respondent

DECISION OF INDEPENDENT EXPERT

Appointment

1. I was appointed, by a letter dated the 12th July 2002 to decide, under the DRS Procedure, a complaint of Abusive Registration. I am required to give my decision by the 26th July 2002.

Terminology

2. In this Decision:
 - “Nominet” means Nominet-UK
 - “the DRS Procedure” means Nominet’s current dispute resolution procedure
 - “the Policy” means Nominet’s current dispute resolution policy
 - “the Domain Name” means the domain name "cameautomation.co.uk"

Materials

3. I have been provided with the following materials:
 - (1) Dispute History
 - (2) Complaint
 - (3) Standard correspondence between Nominet UK and the parties
 - (4) Register entry for cameautomation.co.uk
 - (5) Nominet WHOIS query result for cameautomation.co.uk

- (6) Printout of website at cameautomation.co.uk
- (7) Copy of Nominet UK's Policy and Procedure.

The Complaint

4. The Complainant asserts that the Domain Name in the hands of the Respondent is an "Abusive Registration".
5. The terms of the Complaint dated the 24th May 2002 and which is signed by a Mr. Baker, so far as material, are as follows:

"I established my business and registered the name "Came Automation Limited" at companies house on 30 June 1992. I have invested a great deal of my time and over £100,000 in promoting and advertising the name Came Automation in the interval since then. The respondents formed a new company called Cameo in 1995 and changed their company name from Cameo to Came United Kingdom around 1999. I understand that the respondents registered the domain name www.cameautomation.co.uk about two years ago. I was slow to take up use of the internet but now my business is suffering because we have no access using our registered name. I have offered to buy the domain name "cameautomation.co.uk" from the respondents but I have not had a reply. I am in a similar line of business to the respondents and believe that the respondents registered the domain name www.cameautomation.co for the sole purpose of creating confusion by attracting my customers to their website, which is www.cameuk.com. The registration is an abusive registration because the respondents have repeatedly used the name to bring my business to their website. On two occasions I instructed my lawyers to write to the respondents to require the domain name www.cameautomation.co.uk not to be used for "passing off" as my business. On each occasion the respondents have complied temporarily, but each letter costs me money. The registration is a blocking registration because I am being denied use of the domain name for my legitimate business purposes. I

have no access to the internet for a website or for email using a domain name that my customers will recognise”.

Response

6. No Response has been provided by or on behalf of the Respondent. The complaint not being challenged, therefore, I am entitled to, and will, assume that the facts asserted in the complaint are true. Indeed there is no reason to doubt the veracity of those asserted facts.

Jurisdiction

7. Under paragraph 2a of the Policy a Respondent is required to submit to proceedings if a Complainant asserts to Nominet in accordance with the DRS Procedure 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”.*
8. Under paragraph 2b of the Policy a Complainant is required to prove both these elements on the balance of probabilities.

Rights

9. Paragraph 1 of the Policy defines “Rights” as including “*rights enforceable under English law*”. This definition is subject to a qualification which is not material.
10. In English law a company registered under the Companies Act 1985 does have rights in respect of its registered name. Section 26(1) of that Act prohibits the registration of a company in a name which is the same as a name already appearing in the index of names kept by the Registrar of Companies. A name registered in contravention of that prohibition may be compulsorily changed within 12 months of the date of registration –

see Section 28(2) of that Act. The company which first registered the name is entitled to invoke this jurisdiction.

11. The Complainant's full name is "Came Automation Ltd". The Domain Name does not include the word "Ltd", and therefore it is not identical to the Complainant's name. Nevertheless it is "similar" to it and I so find.
12. It is to be observed that the Complaint provides some basis for an alternative ground for finding that the Complainant has "Rights" in the Domain Name. I refer to the fact that on past occasions the Complainant has, through solicitors, complained to the Respondent of "passing off", and the Respondent has, at least temporarily, responded by modifying its conduct. However, there is a dearth of information before me as to the basis for the alleged "passing-off", and in the light of my finding as set out in paragraph 11, it is unnecessary for me to reach any decision on this alternative ground. In particular I do not need to decide whether the material provided would be sufficient to establish, on the balance of probabilities, that the Complainant has rights over its name which would substantiate a passing-off action at common law.

Abusive Registration

13. 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;*"
14. The Policy provides:
 - "3.2 Evidence of Abusive Registration**

- a A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*
- 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.*
- b. Failure on the Respondent's part to use the Domain Name for the purposes of e-mail or a web-site is not in itself evidence that the Domain Name is an Abusive Registration.*
- 4 *How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration***

- a A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:*
- i. Before being informed of the Complainant's dispute, the Respondent has:*
- A used or made demonstrable preparations to use the Domain Name or a Domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;*
- B been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
- C made legitimate non-commercial or fair use of the Domain Name; or*
- ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it.*
- b. Fair use may include sites operated solely in tribute to or criticism of a person or business, provided that if:*
- i. the Domain Name (not including the first and second level suffixes) is identical to the name in which the Complainant asserts Rights, without any addition; and*
- ii. the Respondent is using or intends to use the Domain Name for the purposes of a tribute or criticism site without the Complainant's authorisation.*
- then the burden will shift to the Respondent to show that the Domain Name is not an Abusive Registration”.*

15. Some of the factors referred to in paragraph 3.2a of the Policy are plainly not made out.
Thus:

- (1) the factor in (i)A can be disregarded because the Respondent has not accepted the Complainant's offer to buy the Domain Name;
 - (2) there is no material which would establish the factors in (iii) or (iv).
16. Similarly, there is no material which would establish the factors referred to in a ii or iv to paragraph 4 of the Policy.
17. On the basis of the material before me the chronology is:
 - (1) the Complainant has been trading under its name since 30th June 1992;
 - (2) the Respondent came into existence in 1995;
 - (3) the Respondent adopted the name "Came United Kingdom" around 1999;
 - (4) the Respondent registered the Domain Name on the 23rd June 2000.
18. The Complainant asserts that it is "*in a similar line of business to the respondents*", though I have not been told what that business is, nor what the scale or geographical boundaries of its operations are.
19. In the present context, it is significant that past complaints by solicitors have resulted in at least temporary compliance with requests that the site should not be used for "passing off". I conclude from this, on the balance of probabilities, that the Respondent perceived that there was some public recognition which associated the name "Came Automation" with "Came Automation Limited" and its business, and that that recognition associated the name with the Complainant's business more readily than with the Respondent's business.
20. In the light of the conclusion expressed in the last paragraph, and the absence of any other explanation as to why the Respondent adopted the name "Came United Kingdom" and the Domain Name, I conclude, again on the balance of probabilities, that the Respondent registered the Domain Name primarily for the purpose of confusing people into believing that the Domain Name is registered to, operated or authorised by, or

otherwise connected with the Complainant. I doubt whether the Respondent's prime purpose was to "*unfairly disrupt*" the Complainant's business: I suspect that the prime purpose was to benefit the Respondent's business.

21. There is no material before me to establish that, before being informed of the Complainant's dispute, the Respondent had, to quote again from paragraph 4 of the Policy,

"B been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

C made legitimate non-commercial or fair use of the Domain Name;"

Thus, whilst I have no reason to doubt that the Respondent has used the Domain Name (and indeed the name under which it now trades) in connection with the genuine offering of goods or services, the factor referred to in paragraph 4 a (i) of the Policy is not made out.

22. It seems to me that there is scant evidence that the Respondent's use of the Domain Name has actually "*confused people or businesses into believing that that name was registered to, operated, or authorised by, or otherwise connected with the Complainant*". However, the matters referred to in paragraph 19 above indicate a recognition that there was a risk of this occurring, and indeed, my conclusion, as expressed in paragraph 20 above, is that that confusion was intended. In my judgment that is sufficient to establish an Abusive Registration.

23. I do not consider that the complaint that the registration was a "blocking" one is made out. The material before me suggests that the Domain Name was registered primarily to benefit the Respondent and not to act as a "block" to the Complainant. If the Respondent had not itself made use of the site for its business, different conclusions might have been drawn.

Decision

- 24. For the reasons given above, I find that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

- 25. The Complainant has requested the transfer of the Domain Name. On the basis of the material before me I consider that that is an appropriate remedy and accordingly that the Domain Name should now be transferred to the Complainant, as it requests.

Signed.....

David Blunt QC

23rd July 2002