

Nominet UK Dispute Resolution Service

DRS 00267

Elite Promotions -v- Creative Talent Management

Decision of Independent Expert

1. Parties:

Complainant: Elite Promotions
Address: 4 St Michaels Walk
Newtonhill
Aberdeen
Aberdeenshire
AB39 3GZ
Country: UK

Respondent: Creative Talent Management
Address: 310 Queens Road
Aberdeen
Country: UK

2. Domain Name:

elite-speakers.co.uk

3. Procedural Background:

A brief chronology is as follows:

| | |
|-------------------|---|
| 25 February 2002: | Complaint lodged with Nominet electronically |
| 28 February 2002: | Hardcopies received by Nominet |
| 5 March 2002: | Nominet forwarded complaint to Respondent |
| 8 March 2002: | Response lodged electronically and forwarded to Complainant |
| 15 March 2002: | Reply lodged electronically, hardcopies received and forwarded to Respondent |
| 27 March 2002: | Nominet informed the Complainant that mediation had failed |
| 9 April 2002: | Complainant sent fee for expert decision together with additional statement and documents |
| | |

On 16 April 2002 I, Adam Taylor, the undersigned, confirmed to Nominet that I knew of no reason why I could not properly accept the invitation to act as expert in this case and further confirmed that I knew of no matters that ought to be drawn to the attention of the parties which might appear to call into question my independence and/or impartiality.

On 23 April 2002, I requested certain further statements and documents. In response, both parties submitted further statements and documents on 29 April and 3 May 2002.

4. Outstanding Formal/Procedural Issues:

Paragraph 13b of the Nominet Dispute Resolution Service Procedure (“the Procedure”) states: “In addition to the complaint, the response and if applicable the reply and any appeal, the Expert may request further statements or documents from the Parties. The Expert will not be obliged to consider any statements or documents from the Parties which he or she has not received according to the Policy or this Procedure or which he or she has not requested.”

The Complainant sent an additional statement in the form of a letter dated 9 April 2002. I decided to admit this late submission because its primary purpose was to submit evidence which did not exist at the date of the Complainant’s reply. I requested that the Respondent be given an opportunity to comment on this submission.

Further, both parties were apparently under the mistaken impression that I would automatically have access to the statements and documents in another complaint under Nominet’s Dispute Resolution Service (“DRS”). The Respondent also seemed to think that it would have an opportunity to provide evidence concerning alleged passing off by the Complainant, saying in the response: “We are happy to provide that evidence to one of your independent experts”.

I am mindful that the onus is on parties to include all relevant evidence with their submissions. However, given that neither party appeared to be professionally assisted, I requested that:

1. both parties submit any statements or documents from the other DRS cases that they considered relevant; and
2. the Respondent submit any evidence concerning alleged passing off by the Complainant that it considered relevant and that the Complainant be allowed to comment.

Both parties submitted extensive further statements and documents in response. Under paragraph 13b of the Procedure I am not obliged to consider that portion of the material – in fact the bulk of the submissions - that was outside the ambit of the requests. I have, however, read it all and, although I do not deal specifically with it below, there is nothing there that caused me to alter the conclusion I had otherwise reached.

5. The Facts:

The Complainant

“Elite Promotions”, named as the Complainant, is a business name used by John and Kathleen Anderson. I will treat the Complainant as comprising those two individuals.

The Complainant has traded as “Elite Promotions” in Aberdeen and the surrounding area for 13 years. The Complainant carries on business as an entertainment agency supplying all forms of entertainment and claims to specialise in the supply of after-dinner speakers and personalities.

The Complainant’s main website is at www.elite-promo.co.uk.

The Respondent

According to the complaint, “Creative Talent Management”, named as the Respondent, is one of a number of business names under which a Mr Dominic Morley has traded in the last three years. The others are said to include: “Celtic Promotions, The Entertainment Company, Live Entertainment Services, Stag Entertainments, Speakers UK, 5i Studio and Artistic Talent Management.”

An undated press release (with Dominic Morley as first contact) appended to the complaint and taken from a website at <http://5i-studio.com> states:

“Artistic Talent Management PLC comprising of Live Entertainment Services, Celtic Promotions, Speakers UK and 5i-Studio, the Computing, Internet and New Media Company and headed by prominent Aberdeen entrepreneur Dominic Morley ...”

The release further states in a note to editors:

“Artistic Management Holdings PLC specialise in managing and investing in creative talent. They own, or invest in companies such as, Speakers UK, the leading online celebrity and speakers consultancy, Celtic Promotions, the world leading provider of Celtic Music, Live Entertainment Services Ltd, a corporate events and hospitality company, and 5i-Studio.com, a recently launched computing internet and new media company.”

Alleged use of metatags in 1999

In July 1999, the Complainant complained to Mr Morley that internet searches for the Complainant brought up certain of Mr Morley’s sites.

In a 22 July 1999 posting to a “UK Legal” newsgroup appended to the reply, Mr Morley stated:

“I work in a competitive business and it is becoming quite common for people to put in names of their competitors in their keywords. The names are not trademarked. Is this legal? I suppose it can’t be passing off as they are not claiming to be the same business and the name does not appear on the webpage..”

Appended to the complaint is a printout of an Alta Vista search against the words “elite corporate hospitality”. It is dated “29th July 99” (in handwriting). The first three results, so far as material, are:

1. **sports speakers**

Elite Promotions, specialists in entertainment and corporate hospitality. Have a ...
URL: www.users.zetnet.co.uk/celtic/Businessspeakers.htm

2. **sports speakers**

Elite Promotions, specialists in entertainment and corporate hospitality. Have a ...
URL: www.users.zetnet.co.uk/celtic/sportingspeakers.htm

3. **Enquiries**

Elite Promotions, The specialists in entertainment and corporate hospitality. Have a ...
URL: www.elite-promo.co.uk/enquiries.htm”

In a 1999 “UK Legal” newsgroup posting appended to the reply, Mr Morley refers to “www.users.zetnet.co.uk/celtic” as being one of his websites.

Appended to the complaint in DRS 00266 (see below) is an undated printout headed (in manuscript) “Celtic Promotions source page”. This includes the following meta description:

“<META NAME=“description” CONTENT=“Elite Promotions, specialists in entertainment and corporate hospitality. Have a LOOK!”>”

According to the complaint, Mr Morley denied using metatags to achieve the above search results but they thereafter reverted to “the original format”. The Complainant took legal advice and decided to take no further action.

elite-promotions.co.uk

On 14 November 1999 “elite-promotions.co.uk” was registered in the name of “Live Entertainment Services”. According to the complaint the domain was parked at that time with an offer to sell or rent.

Appended to the complaint is a printout of a webpage (at www.users.totalise ...) as of 3 October 2000 stating that the domain “Elite Promotions” was owned by Live Entertainment Services Ltd and offering it for sale or rent. The contact email is “sales@elite-promotions.co.uk”. A copyright notice states that the fee to save or print the page was £1000.

The complaint asserts that the website at www.elite-promotions.co.uk diverted to Mr Morley’s website for Speakers UK but does not specify when this happened or the precise url diverted to.

Appended to the complaint are top 10 search results from five different engines against the words “elite promotions” dated 3 February 2002. Three engines brought up the url www.elite-promotions.co.uk with the title “Live Entertainment Services”. In two of these the descriptive text stated: “CLICK HERE FOR FREE DOMAINS”.

Two engines brought up results in first place comprising the title “Elite UK Speakers”, identical descriptive text and, in the one case where the url was displayed, “www.speakers-uk.com”. These two listings appeared to be paid for.

On 23 February 2002 the Complainant complained to Nominet under the DRS concerning elite-promotions.co.uk (DRS 00266). An email from Dominic Morley to Nominet dated 22 March 2002 states that the allegation of “abusive registration” was categorically denied. It also says that the domain expired in November 2001 and that there was no objection to it being cancelled. When I checked on 30 April 2002, the website at www.elite-promotions.co.uk resolved to a website of the Complainant.

elite-speakers.co.uk (the domain in issue here)

On 13 January 2002, the Respondent registered elite-speakers.co.uk in the name “Creative Talent Management”.

The file supplied by Nominet includes a 4 March 2002 print out of the home page of a website at www.elite-speakers.com, to which www.elite-speakers.co.uk had been diverted. The navigation bar displays links to “ELITE SPEAKERS”, “ABOUT”, “CONTACT” and “ENQUIRY”. The site is prominently branded “ELITESpeakers” and includes a copyright notice “Copyright © 2002 ELITESpeakers”.

When I visited the website at www.elite-speakers.co.uk on 17 April 2002, the home page stated: “Welcome to Elite Speakers, the source for after dinner speakers, motivational speakers and business speakers”, followed by further promotional text.

The complaint says that an internet search for “Elite Speakers” will go either to Mr Morley’s “Speakers UK” site or a “page not displayed”. However, no supporting evidence is provided. Appended to the complaint is a search against “Elite Speakers UK” dated 5 February 2002 (in manuscript) where the first seven results (the only ones included) do not appear to show any sites connected with Mr Morley.

elitespeakers.co.uk

On 4 February 2002 the Complainant registered elitespeakers.co.uk in the name “Elite after Dinner”. According to the response, the Complainant pointed this domain to a list of speakers at the Complaint’s website at www.elite-promo.co.uk.

6. The Parties’ Contentions:

Complaint:

1. The Complaint has built up a good reputation both locally and further afield in the name “Elite Promotions”.
2. In July 1999 the Complainant and other agencies took legal action against Mr Morley following complaints about diversion of internet enquiries to Mr Morley’s sites.
3. Live Entertainment Services [the former registrant of “elite-promotions.co.uk”] did little or no business and was merely used as a tool to divert internet enquires intended for the Complainant.
4. The domain elite-speakers.co.uk was purchased with the sole intention of diverting enquiries meant for the Complainant to the Mr Morley’s site or to give the impression that Elite Promotions no longer existed.
5. None of Mr Morley’s trading names bear any resemblance to “Elite Promotions”.
6. The Complainant registered elitespeakers.co.uk as it was expanding the after-dinner section of its business. As a result of previous experiences it searched against the name and was “horrified” to find that two weeks earlier Mr Morley had bought “elite-speakers.co.uk”.
7. Other agents throughout the UK are again preparing to take action against him.
8. Mr Morley should no longer be allowed to use any name with any connection to Elite, Elite Speakers or Elite Promotions.

Response:

1. The Complainant has never traded as “Elite Speakers” and is known neither as elite speakers or elite after dinner.
2. The Complainant is not, as it claims, Scotland’s recognised market leader in the supply of sporting celebrities, television personalities and after-dinner speakers.

3. The Respondent invested time, effort and capital in creating a worthwhile professional site at www.elite-speakers.co.uk and it launched “EliteSpeakers” in January 2002.
4. The Complainant’s registration of elitespeakers.co.uk on 4 February 2002 was abusive and constitutes passing off.
5. Many of the facts alleged in the complaint are irrelevant or wrong.
6. “Live Entertainment Services Ltd” and “Creative Talent Management Ltd” are separate companies, Mr Morley is a director of both and that the shareholdings are substantially different. [The response is purportedly submitted on behalf of Creative Talent Management Ltd.]
7. Mr Morley personally registered neither elite-promotions.co.uk or elite-speakers.co.uk.

Reply:

1. The individual concerned pleaded innocence in relation to accusations of “passing off” by another agency.
2. He has posted no fewer than 443 messages to the UK Legal newsgroup asking for legal advice on subject such as passing off, keywords and metatags.
3. His “it wasn’t me” statement was not relevant.
4. The domain name elite-speakers.co.uk was bought with the sole purpose of causing confusion to internet users. The individual concerned knew that the Complainant traded as Elite Promotions and that it specialised in after dinner speakers.

Further Statement of Complainant:

The Complainant has submitted without comment a letter from the Trade Marks Registry dated 24 March 2002. That letter states that the result of examination of the Complainant’s application for registration of the mark “ELITE PROMOTIONS (and Device)” was that the requirements for registration appeared to be met and the application would now go forward to publication, for opposition purposes.

Further Statement of Respondent:

Insofar as relevant to the request:

1. The Complainant’s new trade mark application was submitted after registration of elite-speakers.co.uk.
2. In any case the application was for a pictorial representation with word element. Even if granted, the Complainant would not get a trade mark for the words “elite promotions”, “elite” or “elite speakers”.

7. Discussion and Findings:

General

To succeed in this Complaint the Complainant has to prove in accordance with paragraph 2 of the Nominet Dispute Resolution Service Policy (“the Policy”) on the balance of probabilities, first, that 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 elite-speakers.co.uk and, second, that that domain name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the Policy).

Complainant’s Rights

Does the Complainant have rights in the name “Elite Promotions”?

Paragraph 1 of the Policy defines rights as including, but not being limited to, rights enforceable under English law (but excluding names or terms which are wholly descriptive of a complainant’s business).

There is no registered trade mark. In view of my conclusion below, it is unnecessary to consider whether the Complainant’s trade mark application or the letter from the Trade Marks Registry is evidence of rights.

The name “Elite Promotions” consists of a laudatory word “Elite” and a descriptive word “Promotions”. To establish goodwill in this name sufficient to mount a passing off action, the Complainant would have to show that the name had become distinctive through use ie that a significant number of people had come to associate the name with the Complainant’s business.

The Respondent rejects the Complainant’s alleged claim that it is Scotland’s recognised market leader in the supply of sporting celebrities, television personalities and after-dinner speakers. No such claim is made in the complaint but in any case that is not the issue here.

The Complainant’s claim in the complaint is that it has built up a good reputation in the name both locally and further afield. There is no supporting evidence. However, I think it reasonable to infer from the fact that the Complainant has traded as “Elite Promotions” for 13 years, a fact not specifically denied by the Respondent, that the name has become distinctive of the Complainant’s business in Aberdeen and the surrounding area.

I also take into account my conclusion below that the Respondent used the name “Elite Promotions” (with the initial letters of each word capitalised) in the meta descriptions of one of its websites in order to attract those looking for the Complainant through search engines. Such use of the name by the Respondent presupposes that the Complainant’s business is known and identified by that name.

I find that the Complainant has common law rights in the name “Elite Promotions”.

Is the name “Elite Promotions” similar to the domain name “elite-speakers.co.uk” (disregarding the .co.uk suffix, the hyphen and the lack of capitalisation in the domain name)?

Both names include the word “Elite”. While it is a relatively common laudatory word, I have concluded above that “Elite Promotions” has become distinctive of the Complainant. “Elite” is the first, and dominant, word in that name as well as in the name “Elite Speakers”.

The words “promotions” and “speakers” are subsidiary descriptive words. They are on the face of it dissimilar. However, I take into account the fact that the Complainant’s services under the name “Elite Promotions” include the supply of after-dinner speakers (notwithstanding that the extent of this part of its business is unclear). Indeed, I think it reasonable to infer that a significant number of persons looking for the Complainant but with

an imperfect recollection of its name may well key in “Elite” plus a word descriptive of the Complainant’s services such as “speakers”.

It is also relevant that, as I conclude below, the Respondent registered the domain elite-speakers.co.uk to attract business intended for the Complainant on the basis of its similarity to the Complainant’s name.

Weighing up these factors, I find that on balance the name “Elite Promotions” is similar to the domain name “elite-speakers.co.uk”.

I conclude that the Complainant has rights in a name “Elite Promotions” which is similar to the domain name “elite-speakers.co.uk”.

Abusive Registration

Is elite-speakers.co.uk, 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.”

In assessing whether elite-speakers.co.uk is an abusive registration, I draw no distinction between the activities of Mr Morley and the various businesses connected with him.

In some cases it is unclear whether or not those businesses are carried on through limited companies. Indeed, the response appears to imply that elite-promotions.co.uk and elite-speakers.co.uk were / are owned by limited companies despite the fact the names in the register do not include the “limited” suffix. In my view none of this matters. I conclude from the evidence as a whole that Mr Morley controls all of the connected businesses, whether incorporated or not.

Similarly, nothing turns on the identity of the person who actually registered any particular domain. There is no suggestion that such person acted without authority.

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. However, I do not think it necessary to have recourse to those.

I should say first that I place no weight on the Complainant’s assertion that other agencies made similar complaints or took legal action against Mr Morley in July 1999 or more recently. The only evidence is a letter from After Dinner Speakers UK Ltd dated 15 March 2000 saying that it was consulting lawyers with a view to taking legal action against Mr Morley concerning his alleged use of their trading name. That does not prove anything. Nor is there any evidence that the Complainant itself took legal action at any point.

However, the following factors convince me that elite-speakers.co.uk is an abusive registration.

First, it is clear from the facts outlined above under the heading “Alleged use of metags in 1999” that around July 1999 Mr Morley incorporated the Complainant’s name “Elite Promotions” (with the first letter of each word capitalised) in the meta descriptions on one of

his websites. The purpose can only have been to attract to that website those looking for the Complainant in search engines.

(The 3 February 2002 searches against “Elite Promotions” bringing up apparently paid listings with the title “Elite UK Speakers” and url “www.speakers-uk.com” also raise at least a question mark about possible more recent use of the Complainant’s name to attract search engine hits. However this evidence is not as clear and I do not place particular weight on it)

Second, I take into account the registration of elite-promotions.co.uk – effectively identical to the Complainant’s name. The only evidence of use is that it was apparently diverted to a page offering it or sale. There is no evidence supporting the Complainant’s assertion that this domain was diverted one of Mr Morley’s websites.

However, the Respondent had not suggested any genuine purpose for registration of elite-promotions.co.uk and indeed it is difficult to see what genuine purpose there could be. Whether or not the intention was to divert the Complainant’s business, I am satisfied that it was an abusive registration.

Third, in light of the history outlined above, I think it reasonable to infer that the Respondent registered elite-speakers.co.uk with a view to attracting business intended for the Complainant. The evidence leads to the conclusion that the Respondent chose the word “Elite” because that was the dominant part of its competitor’s name and because its combination with the word “Speakers”, which described part of the Complainant’s business (albeit the Respondent’s as well), was similar to the Complainant’s name.

Why else would the Respondent choose a name including the word “Elite”? There is no evidence of any pre-existing genuine business with a name containing that word. Given the history, it is difficult to believe that the Respondent chose the word “Elite” on its own merits and without reference to the Complainant. In my view the offering of services at www.elite-speakers.co.uk under the brand “ELITESpeakers” cannot be said to be genuine.

While there is no evidence that business has in fact been diverted from the Complainant, the Respondent’s intention to do so is sufficient.

In my view nothing turns on the registration of elitespeakers.co.uk by the Complainant a few weeks later.

I find that on the balance of probabilities the domain name elite-speakers.co.uk is an abusive registration in that it was registered and has been used in a manner which took unfair advantage of the Complainant’s rights in its name.

Remedy

The Complainant seeks cancellation, and not transfer, of elite-speakers.co.uk.

8. Decision:

The domain name elite-speakers.co.uk should be cancelled.

Adam Taylor

Date