

Nominet UK Dispute Resolution Service

DRS 00160

Foot Anstey Sargent –v– Adrian Cameron

Decision of Independent Expert

1. Parties:

Complainant: Foot Anstey Sargent
Address: 21 Derry's Cross
Plymouth
Devon
Postcode: PL1 2SW
Country: GB

Respondent: Mr Adrian Cameron
Address: 54 Molesworth Road
Plymouth
Devon
Postcode: PL5 1PD
Country: GB

2. Domain Name:

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

3. Procedural Background:

The Complaint, dated December 12, 2001, was received by Nominet on December 14, 2001. Nominet validated the Complaint and notified the Respondent of the Complaint on December 17, 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 January 14, 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 January 22, 2002, Martin Campbell-Kelly, 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.

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

The Respondent has not submitted a Response to Nominet in time (or at all) in compliance with paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”).

Paragraph 15b of the Procedure provides, inter alia, that “If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in this Policy or the Procedure, the Expert will proceed to a Decision on the complaint.”

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 and notwithstanding the absence of a Response.

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

Paragraph 15c of the DRS 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." The Expert is not aware of any exceptional circumstances in this case and so will draw inferences as appropriate.

5. The Facts:

The Complainant is a legal-services firm formed as a consequence of a merger between Anstey Sargent & Probert and Foot & Bowden in February 2000.

A WHOIS query print-out in the paper file before the Expert indicates that the Domain Name footansteysargent.co.uk was registered in the name of the Respondent on February 18, 2000.

The Complainant wrote to the Respondent on November 29, 2001 requesting transfer of the Domain Name footansteysargent.co.uk to the Complainant. The Respondent did not reply. A copy of the letter is annexed to the complaint.

6. The Parties’ Contentions:

Complainant:

The substance of the Complaint is as follows:

- 1 The Complainant is a firm formed as a consequence of a merger between Anstey Sargent & Probert and Foot & Bowden in February 2000. The name of the firm, Foot Anstey Sargent, was well publicised prior to that date. The Complainant has built up a considerable reputation in the name Foot Anstey Sargent and the registration of the Domain Name is a clear infringement of its intellectual property rights.
- 2 After an unstated interval of time subsequent to the Domain Name registration, one of the partners of the Complainant firm, Mark Lewis, spoke to the Respondent and “was

informed that he [the Respondent] had hoped to make some profit out of the registration, and it was even indicated that the respondent may have registered other firms names.”

- 3 The Complainant wrote to the Respondent on November 29, 2001, subsequent to Mr Lewis’s conversation with the Respondent. In the letter it was stated that the Respondent had registered the domain names footansteysargent.co.uk and footansteysargent.com. The Complainant offered, “[w]ithout prejudice (save as to costs)” to refund the Respondent’s registration fees and other recieved expenses provided that, by the close of business on December 7, 2001:
 - i The Respondent transferred ownership of both domain names to the Complainant
 - ii The Respondent confirmed he had not registered any other domain names “which will or are likely to infringe our intellectual property rights”
 - iii The Respondent confirmed he would not infringe the complainant’s intellectual property rights in the future.
- 4 The Complainant states that no response to this letter had been received by December 11, 2001, the day before their lodging of the complaint.

Respondent:

The Respondent has not responded

7. Discussion and Findings:

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of 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 and, secondly, that 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 trades under the name Foot Anstey Sargent. The Complainant has not provided any verifiable proof that it has rights in the name Foot Anstey Sargent (such as a company registration number on the Complainant’s letter head, or a trademark registration number). However, the Expert accepts the assertion that the Complainant has such rights.

The Domain Name comprises the name footansteysargent and the suffix <.co.uk>. In assessing whether or not a name or mark is identical or similar to a domain name, it is appropriate to discount the domain suffix, which is of no relevant significance and wholly generic. It is also appropriate to discount upper-case letters which URLs treat identically, and spaces which are not permitted in URLs.

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

Abusive Registration

Paragraph 1 of the Nominet Dispute Resolution Service Policy defines an 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.

No assertion has been made that the Domain Name has been used, or is in active use, for example for e-mail or as a web-site, hence (ii) above does not apply. The Complainant therefore has to demonstrate that (i) above applies; that is, that at the time the registration was made the Respondent took unfair advantage of the Complainant's Rights. There is some vagueness as to timing in the Complaint. The Respondent registered the Domain Name on February 18, 2000, while the Complainant asserts that the firm Foot Anstey Sargent was created in February, without stating the day of the month. However, the name "footansteysargent" is so unique and particular, that the Expert finds is highly improbable that it could have been registered before the name of the new firm was publicised and registered, and therefore accepts that the Respondent took unfair advantage of 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. Because the Complainant has not claimed that the Respondent has actively used the domain name, sub-section ii does not apply. It has not been alleged that the respondent gave false contact details, so sub-section iv also does not apply. This leave subsections i and iii below:

- 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;
- 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;

Taking each of these four factors in turn:

With respect to i(A) above, the Complainant has asserted that in conversation it "was informed that he [the Respondent] had hoped to make some profit out of the registration." While this motive in the respondent may seem plausible, no evidence other than this conversation is presented. Nor is evidence of an explicit offer to sell the Domain Name presented.

With respect to i(B) above, the Expert finds that the name "footansteysargent" (or, indeed, variations such as foot-anstey-sargent) so unique and particular that they are plainly ones in which the Complainant, Foot Anstey Sargent, has Rights.

With respect to i(C) above, no assertion has been made that the Respondent has disrupted, or plans to disrupt, the Complainant's business.

With respect to iii above, the Complainant has asserted that in conversation it "was informed that he [the Respondent] had hoped to make some profit out of the registration, and it was even indicated that the respondent may have registered other firms names." The Expert finds this plausible, but the evidence is insufficient.

While, on the balance of probability i(A), i(B) and iii of the above four factors apply, it is only necessary that one of the conditions should apply for the Expert to decide in favour of the Complainant. The Expert finds that i(B) applies.

Although the Respondent has not responded, the Expert wishes to consider whether it is possible that the registration could be non-Abusive. It should be noted that "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" (the Policy, section 3b). Section 4 of the Policy states how the respondent may demonstrate that the Domain Name is not an Abusive Registration. Sub-section 4a gives a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive registration 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.

Taking each of these factors in turn:

With respect to i(A) and i(C) above, the Domain Name is not in active use, and no evidence is available that it ever has been or that preparations have been made for its use.

With respect to i(B) above, there is no evidence that the Respondent has any connection with the Complainant's mark or trade-name.

With respect to ii above, the Domain Name could not be described as generic by any stretch of imagination.

The Policy sub-section 4b does, however, include as fair-use a site operated "solely in tribute or criticism", under certain conditions stated. Because the Domain Name is not in active use, sub-section 4b cannot apply.

The Expert therefore finds that none of the possible responses available in section 4 of the Policy could apply, either for lack of evidence or because the Domain Name is not in active use in a fair-use manner.

In the view of the Expert, the Respondent has taken unfair advantage of the Complainant's Rights in two respects:

- 1 The registration prevents the Complainant from using the URL www.footansteytarget.co.uk, which is likely to be the initial guess of an Internet user seeking the Complainant's web-site.
- 2 The Respondent could at some time in the future use the Domain Name for purposes detrimental to the Complainant's business, or could sell it to a competitor or third party for purposes detrimental to the Complainant's business.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy on the basis that it was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainant's Rights.

8. Decision:

In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is similar (and identical in the context of URL syntax) to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, footansteytarget.co.uk, be transferred to the Complainant.

Martin Campbell-Kelly

Date