

# Nominet UK Dispute Resolution Service

**DRS 0238**

**GOVIA Limited -v- Keith Painter**

**Decision of Independent Expert**

## **Parties:**

### **Complainant's Details**

Complainant: GOVIA Limited  
Address: 3rd Floor  
41 - 51 Grey Street  
Newcastle upon Tyne  
Tyne & Wear  
Postcode: NE1 6EE  
Country: GB

### **Respondent's Details**

Respondent: Mr Keith Painter  
Address: 301 Redford Close  
Feltham  
Middlesex  
Postcode: TW13 4TH  
Country: GB

## **Domain Name:**

newsouthernrailway.co.uk ("the Domain Name")

## **1. Procedural Background:**

The complaint was lodged with Nominet on 7 February 2002. Nominet validated the complaint and notified the Respondent of the complaint by letter and by email addressed to [postmaster@newsouthernrailway.co.uk](mailto:postmaster@newsouthernrailway.co.uk) on 8 February 2002 and informed the Respondent that he had 15 days within which to lodge a Response. No response was received from the Respondent by 4 March 2002. The Complainant was informed accordingly on 5 March 2002 and invited to pay the fee to obtain an Expert Decision pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy"). The fee was duly paid on 5 March 2002.

On 7 March 2002, Nominet invited the undersigned, Andrew D S Lothian ("the Expert"), to provide a decision on this case and, following an indication from the Expert that he wished to disclose circumstances which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality, Nominet duly notified the parties of this and gave them until 4.00pm on 11 March 2002 to respond. The Complainant indicated it was happy for the Expert to continue. No response was received from the Respondent within the deadline. Nominet duly appointed the Expert with effect from 12 March 2002.

## **2. 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 its Rights and the existence of an Abusive Registration.

Paragraph 13a of the Procedure entitles the Expert to request further statements or documents from the parties. In the present dispute the Expert has had to consider whether or not to request further evidence from the Complainant. The Expert takes the view that where (as in this matter) a party's case has been prepared with the assistance of professional advisers, it is appropriate for the Expert to assume that all relevant matters have been placed before him in the first instance and that it is not necessary to request further information. Nevertheless, in taking this line the Expert was faced with a lack of evidential detail in an aspect of the case which appeared likely to be easily addressed by the carrying out a brief investigation of publicly available materials. It was therefore necessary to determine as a preliminary matter whether an expert is entitled to conduct such an investigation.

Although paragraph 16(a) of the Procedure provides that the Expert will decide a complaint on the basis of the Parties' submissions, the Policy and the Procedure, the Expert takes the view that he is not precluded by anything in the Policy or the Procedure from carrying out an investigation of publicly available materials to clarify or test the submissions of either party (though equally the Expert is not obliged to make any such investigations nor to make a party's case out for them). The Expert notes that this situation has arisen before in a decision under the Policy and Procedure in the case of *APC Overnight -v- M+J Couriers* (DRS 00192). In that matter no evidence was provided of any registered trade mark in the name of the Complainant and the appointed expert chose to conduct his own search of The Patent Office online trade mark database to determine whether there were any records of such a registration. Equally, in *Televés -v- Adam Barrington* (DRS 00074) the appointed expert considered, amongst other sources, material on the Complainant's website which had not been included in submissions and additionally took the view that he might "have regard to readily available public records in reaching his Decision in an appropriate case when such material appears likely to be relevant...".

Accordingly, in the particular circumstances of the present case, the Expert considered that he was entitled to conduct the brief investigation described in section 5 below.

### **3. The Facts:**

1. The Complainant was formed in 1996 as a joint venture between Go-Ahead Group plc, a UK publicly listed company with a listing on the London Stock Exchange and Via-GTI, a French public transport operator, to bid for UK rail franchises. The Complainant has won two such rail franchises: Thameslink in 1997 and South Central/New Southern Railway in 2000.
2. South Central/New Southern Railway's turnover for 1999-2000 was £296 million. It employs almost 3,000 people and carries over 50 million passengers each year. Its geographical area of operations is South London, Surrey and Sussex.
3. On 25 May 2000 Go Ahead Group plc issued a press release ("the original release") announcing the Complainant's bid to win the South Central rail franchise. The original release was titled "GOVIA CREATE THE NEW SOUTHERN RAILWAY - THE WELCOMING NETWORK" and its text makes five separate mentions of the expression "New Southern Railway" in connection with the bid. The original release was distributed to the media,

relevant Members of Parliament and other interested parties, such as local authorities. Press coverage of the subject matter of the original release appeared in the rail trade press, provincial newspapers and local radio and television.

4. The Complainant spent approximately £50,000 promoting the "New Southern Railway" bid.
5. The Domain Name was registered by the Respondent on 20 October 2000.
6. On 24 October 2000, the Shadow Strategic Rail Authority announced in a press release ("the subsequent release") that the Complainant was the preferred bidder for the South Central rail franchise. The subsequent release stated that the Complainant planned to brand the relative services as the 'New Southern Railway'.
7. The solicitors acting for the Complainant wrote to the Respondent on 10 April 2001 drawing his attention to the Complainant's alleged rights in the mark "NEW SOUTHERN RAILWAY" and requesting the transfer of the Domain Name. The Respondent did not reply to this letter.
8. The Domain Name in its fourth level [www.newsouthernrailway.co.uk](http://www.newsouthernrailway.co.uk) currently points to a registration service provider's 'parking page' on the worldwide web.

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

##### **Complainant:**

The Complainant's submissions are as follows:

1. The Domain Name is identical or similar to the name or mark "NEW SOUTHERN RAILWAY" in which the Complainant asserts it has rights.
2. The Complainant asserts that the Domain Name in the hands of the Respondent is an Abusive Registration.
3. The Complainant claims rights in respect of the "NEW SOUTHERN RAILWAY" mark extending from 25 May 2000 (the date of the original release).
4. The Complainant submits that following the original release, which contained details about its bid and information about the proposed trading name, it became public knowledge that the Complainant's intended name for the South Central franchise, should it be successful in being awarded that franchise, was "New Southern Railway". Consequently, the Complainant asserts that it acquired goodwill and reputation in the name "New Southern Railway".
5. The Complainant states that the Respondent's registration of the Domain Name is damaging to the Complainant's rights since the Respondent is holding himself out as associated with or connected to New Southern Railway or the Complainant and that the misrepresentation made by the Respondent is likely to cause confusion in the minds of the public.

6. The Complainant asserts that the Respondent's registration of the Domain Name constitutes an Abusive Registration since it was registered in a manner which, at the time when the registration took place, took unfair advantage of and was unfairly detrimental to the Complainant's rights. The Complainant submits that there are a number of factors that are evidence that the Domain name is an Abusive Registration, namely:
  - (a) the registration of the domain name creates a registry entry which constitutes a representation that the Respondent is connected or associated with the name registered and thus the owner of the goodwill in the name. The Complainant states that it did not ask the Respondent to register the Domain Name, nor did it give the Respondent permission to register the Domain Name. It submits that that there is no obvious reason why the Respondent might be said to have been justified in registering the Domain Name.
  - (b) there are circumstances indicating that the Respondent registered the Domain Name as a blocking registration against a trade mark in which the Complainant has rights, namely that the Respondent registered the Domain Name in anticipation of the announcement of the Strategic Rail Authority knowing that the Complainant would want to register the Domain Name. The Complainant submits that the result is that the Complainant has been prevented from reflecting its "NEW SOUTHERN RAILWAY" mark in the United Kingdom country-code domain name "newsouthernrailway.co.uk".
  - (c) that the registration of the Domain Name was effected primarily for the purpose of unfairly disrupting the Complainant's business since the Complainant wishes to register its "NEW SOUTHERN RAILWAY" mark as a domain name and use it to promote itself on the Internet.
  - (d) there are circumstances that indicate that the Respondent is engaged in a pattern of making Abusive Registrations in that on 15 October 2000 the Respondent registered the domain name newsouthernrailway.com. The Complainant states that it did not ask the Respondent to register this domain name, nor did it give the Respondent permission to register it. It submits that that there is no obvious reason why the Respondent might be said to have been justified in registering this domain name.
7. The Complainant states that before being informed of the Complainant's dispute, the Respondent had not used the Domain Name and therefore, the Respondent cannot be said to have made a legitimate, non-commercial or fair use of it. The Complainant also submits that it is not aware of any 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 and services. The Complainant asserts that if the Respondent has done so, the proper time to reveal this information to the Complainant was during pre-action correspondence and no such information was provided, nor was it alleged that the Respondent has been commonly known by the Domain Name or legitimately connected with a mark which is identical or similar to the Domain Name.
8. The Complainant states that as the Respondent is not using the Domain Name it is not necessary to consider whether it is generic or descriptive.

**Respondent:**

The Respondent has not responded.

**5. 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 paragraph 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**

For the purposes of paragraph 2a(i), the Expert finds that the mark in which the Complainant asserts it has rights is identical to the domain name and for this purpose disregards the second and top levels of the domain name (.co.uk).

The Policy defines Rights as including but not limited to, rights enforceable under English law (excluding names that are wholly descriptive of the Complainant's business).

The Complainant's submissions on the question of its Rights are relatively short and focus on its asserted goodwill and reputation in the mark "NEW SOUTHERN RAILWAY". The Complainant submits that such goodwill and reputation extend from 25 May 2000 being the date of the original release which first mentions the mark.

Do the Complainant's submissions demonstrate the existence of Rights which would be recognised by the Policy? Under English law the owner of business goodwill and reputation has a property right that can be protected by an action in passing off. To be protected the owner must establish goodwill or reputation in the relevant goods or services in the minds of the purchasing public by association with the identifying 'get-up' (such as a brand name, logo or trade description) so that the purchasing public identify this 'get-up' as distinctive of the goods and services concerned. Such 'protectable goodwill' has been held to exist even if there has been no actual trading provided that the relevant marketplace recognises the 'get-up' and its distinctiveness, for example as a result of pre-trading publicity or advertising. It is just such goodwill which the Complainant is asserting here by way of its submission that its Rights extend from the date of the announcement of the bid, clearly at a time when no trading was taking place under the asserted mark.

Protection has been denied under the law of passing off to words which are merely descriptive on the grounds that these lack distinctiveness and the Policy itself provides that a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business. The words 'New Southern

Railway' are descriptive of the Complainant's business to some extent and are not made up or so-called 'fancy' words. However, (a) there is no hard and fast rule that descriptive words cannot bear goodwill and (b) the words in this case are not *wholly* descriptive of the Complainant's business. The Expert takes the view that the combination and use of the words here is not particularly generic and bears sufficient distinctiveness to overcome this hurdle.

The Policy is silent as to the date by which the Complainant must have acquired the Rights which it asserts. In the view of the Expert it is sufficient for the purposes of paragraph 2a(i) of the Policy for the Complainant to show that it has Rights as at the date of submission of its complaint. In this particular matter, the Complainant does not in fact offer any submission as to the date on which its asserted Rights came into existence, other than the phrase "extending from 25 May 2000".

The Complainant submits that the original release gave information about the proposed trading name "New Southern Railway". While the Expert does not find any specific statement that this was to be the chosen name (compare, for example, the subsequent release of 24 October 2000 referring to the Complainant's plan to "brand the services...as the 'New Southern Railway.'") it is likely that the use of the name throughout the original release in a style whereby the first letter of the three words is capitalised would leave the reader in little doubt of the Complainant's ultimate intention. Nevertheless, the goodwill claimed by the Complainant cannot exist automatically as at 25 May 2000. Goodwill has to be built up over a period of time and it is therefore necessary to consider what was done with the original release and what followed its dissemination.

The Complainant submits that the original release was disseminated to the media, relevant Members of Parliament and other interested parties such as local authorities. This, it is said, gave rise to press coverage in the rail trade press, provincial newspapers and local radio and television, and in support of this submission the Complainant has produced press cuttings from the Croydon Post, East Grinstead Courier and New Civil Engineer. Each of the cuttings post-dates the subsequent release and indicates in express terms that the rail service was to become known as the New Southern Railway.

The Complainant further submits that it spent approximately £50,000 promoting the "New Southern Railway" bid. The Complainant could have been more specific here concerning whether the amount mentioned was the entire rail franchise bid costs, the cost of public relations services or advertising and how much in any event was spent promoting the New Southern Railway identity as part of the bid and to whom. Promotion largely to Members of Parliament and to the Shadow Strategic Rail Authority would not assist the Complainant in proving that it had acquired goodwill in the marketplace as a result of this activity.

On balance, the Expert is satisfied that sufficient information has been produced to prove that as at the date of submission of the complaint, the Complainant has rights in the mark New Southern Railway. In particular, the press cuttings demonstrate that within the marketplace for rail services it was widely accepted and understood, at least following the subsequent release, that the Complainant had adopted the New Southern Railway trading style.

## **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."

In light of the Complainant's own submission that the Domain Name is not being used, paragraph 1(a)(i) must form the basis of its case.

In considering this paragraph together with the Complainant's submissions the Expert is immediately presented with a difficulty. While it is possible for the Expert to find that the Complainant has Rights for the purposes of paragraph 2a(i) by considering the position as at the date of bringing of this complaint, it is necessary for the purposes of paragraph 1(a)(i) to know what the situation was 'at the time when the registration...took place'.

In the Expert's view this paragraph of the Policy requires that the Rights must exist (and in the present case, therefore, that the alleged goodwill and reputation must have been built up) by the date of registration of the disputed Domain Name. However, the Complainant has provided scant evidence as to the point at which its Rights came into existence. In particular, while there are press cuttings to support the Complainant's position following the subsequent release, the Complainant has produced no evidence, other than submissions, of the build-up of goodwill between the date of the original release and 20 October 2000, the date of registration of the Domain Name. The Expert is not assisted on this point by any of the evidence produced by the Complainant showing the extent of goodwill and reputation after the latter date.

In the absence of any contradiction by the Respondent the Expert would be entitled to accept the submissions of the Complainant concerning this five month period. These are that press coverage appeared (no dates are mentioned and it is equally possible that this could refer to coverage of the subsequent release) and that approximately £50,000 was spent promoting the bid. The latter submission has already been criticised in the section discussing the Complainant's Rights above. The Complainant goes on to state that it soon became public knowledge that the Complainant's intended name for the South Central Franchise...was "New Southern Railway". These submissions are somewhat inconclusive and lacking in supportive evidential detail to which the Complainants must have access, which would demonstrate the build-up of alleged goodwill.



It should have been possible for the Complainant to produce copies of press coverage during the 'missing' five month period showing whether it was, as submitted, well known at the date when the Domain Name was registered that New Southern Railway was the proposed or adopted trading style of the Complainant. It should also have been possible for the Complainant to produce some evidence supporting its submission that as the Rail Authority's announcement approached it was "widely anticipated by observers that the Complainant would be successful in its bid." Such evidence would perhaps have indicated the kind of material which the Respondent might have had access to at the date of registration and the state of any constructive knowledge of the Complainant's position on his part.

Given the Complainant's submission of the wide dissemination of the original release and on the assumption that material concerning the five month gap in the evidence was likely to be easily available, the Expert conducted a very brief Internet search. This produced an article on a website named [thisiseastbourne.co.uk](http://thisiseastbourne.co.uk) dated 3 August 2000 describing the Complainant's then bidding activities as "a challenge it has branded 'The New Southern Railway'" and an article dated 4 September 2000 from the Guardian newspaper reporting speculation that the Complainant might win the relevant franchise. The former article is mirrored on a range of other local news websites. Each of these articles is supportive of the Complainant's assertions and indeed readily available. It seems odd that the Complainants did not see fit to produce them or similar material directly.

On the basis of the readily available public material referred to above coupled with the Complainant's submissions, the Expert finds that the Complainant's Rights were in existence at the date when the Domain Name was registered. It is then necessary to consider whether the registration of the Domain Name took unfair advantage of or was unfairly detrimental to those Rights. The Complainant has provided detailed submissions in this regard under a series of headings which the Expert will consider in turn.

### **Misrepresentation within the Registry database**

The Complainant submits that the registration of the Domain Name by the Respondent without entitlement or permission from the Complainant gave rise to an entry on the register which would constitute a representation to persons who consult the register that the Respondent is connected or associated with the name registered and thus the owner of the goodwill in the name. This is not a factor mentioned in the list of factors which might be evidence that the Domain Name is an Abusive Registration found in paragraph 3 of the Policy. While that list of factors is non-exhaustive, the Expert is not persuaded that this submission of the Complainant in itself constitutes evidence of Abusive Registration.

Even if, as the Complainant submits, there is no obvious reason for the registration of the Domain Name which apparently gives rise to a representation of the kind indicated, the Expert doubts that persons are in the habit of consulting the Nominet registry database with a view to establishing who is the definitive owner of goodwill in a name. In any event, given the many and varied ways that domain names are registered, including for example the client/agent basis on which some domains are taken and that fact that registrations are often made for new brands in which at the time of registration goodwill has yet to be built up, the registry database does not have this purpose or provide this function and in the Expert's view it should not be taken as constituting a representation to others of goodwill or reputation.

## **Blocking Registration**

The Complainant's submission here reflects the terms of paragraph 3(a)(i)(B), namely evidence that there are circumstances indicating that the Respondent has registered the Domain Name as a blocking registration against a name or mark in which the Complainant has Rights.

The Complainant submits that the Respondent registered the Domain Name in anticipation of the announcement by the Shadow Strategic Rail Authority and knowing that the Complainant would want to register the Domain Name. The Expert views the manner in which the dates fall, the prior existence of goodwill in the name coupled with speculation that the Complainant was likely to be successful in its bid as significant here. Equally, although it is not an express submission of the Complainant under this heading, the Expert considers the fact that the Respondent effected an identical domain name registration in the .com top level domain space as supportive of the notion that the steps taken by the Respondent are indicative of an intention to block the Complainant. Consequently, the Expert takes the view that on the face of it the registration was a blocking registration and that there is a case for the Respondent to answer on this point.

## **Disruption of the business of the Complainant**

The terms of paragraph 3(a)(i)(C) in the non-exhaustive list of factors provides that it may be evidence of Abusive Registration if there are circumstances indicating that the Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant.

The Complainant submits that the Respondent's actions have disrupted the business of the Complainant since the Complainant would have liked to have registered and used the Domain Name to promote New Southern Railway on the Internet and that the Respondent registered the Domain Name in anticipation of the announcement from the Strategic Rail Authority. The Expert accepts that there are circumstances indicating that the Respondent's actions will have caused unfair disruption to the Complainant's business. However, no evidence has been presented indicating that the Respondent registered the Domain Name *primarily* for that purpose. All that the Complainant provides of assistance is an assertion that there is no apparent legitimate reason for the registration. The Expert therefore does not accept the submissions of the Complainant on this point.

## **Engagement in a Pattern of Making Abusive Registrations**

Paragraph 3(a)(iii) of the Policy provides that it may be evidence of Abusive Registration where 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.

The Complainant here makes submissions concerning the registration by the Respondent of the domain name newsouthernrailway.com on 15 October 2000 and produces the relative WHOIS report in support of an assertion that this activity, together with the registration of the Domain Name which is the subject of the

complaint, particularly in light of the timing of the registrations, constitutes engagement in a pattern of making Abusive Registrations.

The Expert believes that it is stretching the point too far to suggest that the registration of the same name as that complained of in another top level domain, even given the timing here, constitutes a *pattern* of making Abusive Registrations. It does however constitute evidence of an intention to block the Complainant from reflecting its mark in two popular top level domains as referred to above.

### **Use of the Domain Name**

Under this head, the Complainant anticipates argument from the Respondent demonstrating that the Domain Name is not an Abusive Registration. In particular, the Complainant seeks to answer any points the Respondent might make in accordance with paragraph 4 of the Policy. The Expert does not require to address these issues here in light of the fact that there is no reply from the Respondent and that the submissions do not have any other effect on the Complainant's case that the registration is an Abusive Registration.

The Complainant has been fulsome in its legal argument but somewhat less so in the supportive evidence presented. Nevertheless, the Expert finds sufficient evidence of the blocking nature of the registration (and the detrimental effect upon the Complainant's Rights) to give rise to an arguable case that the Domain Name is an Abusive Registration.

The Respondent has not provided any reply to the Complainant's assertions. The Policy provides an opportunity to the Respondent to demonstrate that the Domain Name is not an abusive registration both in terms of the list of factors which are provided in paragraph 4 and (as this list is non-exhaustive) in terms of any other relevant submissions which the Respondent might choose to make. The Respondent has chosen not to take up that opportunity and there is no information before the Expert which adequately addresses or contradicts the arguable case of the Complainant.

The Expert therefore finds that the Complainant has proved on the balance of probabilities that the Domain Name is an Abusive Registration as defined in paragraph 1(i) of the Policy on the ground that at the time when the registration took place it was unfairly detrimental to the Complainant's Rights.

### **Remedy**

Paragraphs 10(a) of the Policy and 17(c) of the Procedure anticipate 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 remedy sought by the Complainant is the transfer of the Domain Name and this is accordingly the most appropriate disposal of the case.

## **6. Decision:**

In light of the foregoing finding that the Domain Name is an Abusive Registration the Expert directs that the Domain Name newsouthernrailway.co.uk be transferred to the Complainant.

\_\_\_\_\_ 21 March 2002

**Andrew D S Lothian**

**Date**