

NOMINET-UK DISPUTE RESOLUTION SERVICE

B E T W E E N :

JACKSON-STOPS AND STAFF

Complainant

- and -

MICHAEL JACKSON STOPS FANZINE

Respondent

DECISION

Appointment

1. I was appointed, by a letter dated the 29 November 2001 to decide, under the DRS Procedure, a complaint of Abusive Registration. I am required to give my decision by the 20 December 2001.

Terminology

2. In this Decision:-
 - “Nominet” means Nominet-UK
 - “the DRS Procedure” means Nominet’s dispute resolution procedure
 - “the Policy” means Nominet’s dispute resolution policy
 - “the Web-site” means the website registered by the Respondent viz <http://www.jacksonstops.co.uk>
 - “the Domain Name” means the disputed Domain Name.

The Domain Name

3. The response to a WHOIS query executed on the 31 October includes the following:-

Domain Name: JACKSONSTOPS.CO.UK
Registered For: Michael jackson stops fanzine

Domain Registered By: FIBRANET
Registered on 18-Jun-2000
Record last updated on 28-Jun-2000.

The Complainant

4. The Complainant is Jackson-Stops and Staff of 25 Nicholas Street, Chester, Cheshire CH1 2NZ.

The Respondent

5. I have been provided with the registrant's business name, which is "*Michael jackson stops fanzine*". The identity of the person or entity using this business name is unclear to me, but the e-mail address of the registrant's administrative contact is michaeljacksonstopsfanzine@ireland.com, the administrative contact being named as "*Mark Martin*".

The Complaint

6. The Complainant alleges that
 - (1) the Domain is identical or similar to a name in which it has Rights
 - (2) the Domain name in the hands of the Respondent is an Abusive Registration.

7. In support of this allegation the Complaint asserts:-
 - (1) Jackson-Stops is a long established family name therefore they have right to the name.
 - (2) Jackson Stops have 14 versions of the name registered.
 - (3) Jackson Stops has a 1st class long established reputation for Estate Agency and associated activities.
 - (4) Clients viewing jacksonstops.co.uk will be confused (some may be offended) by the material content displayed under this domain name registration.

- (5) The site displayed could damage and disrupted (sic) Jackson Stops reputation more importantly lose them business.
- (6) This must be termed “Abusive Registration” as the name has no connection with or to g@yman.com.

Further Information

8. I requested the Complainant to provide further information:
 - (1) as to the Right which it claimed; and
 - (2) as to the 14 versions of the name which had been registered.

9. Under cover of a letter to Nominet dated the 11 December 2001 the Complainant provided:
 - (1) the list of the 14 registered Domain names which is set out in the Appendix to this Decision
 - (2) a note from Andrew G.H. Froude, FRICS, Chairman of the Jackson-Stops and Staff Consortium.

10. The note includes the following information:-

“The use of the name of Jackson-Stops Staff is controlled by the JSS Consortium. The latter was formed in 1992 by an Agreement dated 23rd October 1992. At that time the Founder Members of the Consortium acquired the business of Jackson-Stops & Staff Limited from the Jackson-Stops family, shareholders and others.

There are currently 26 offices trading as Jackson-Stops & Staff all under the control of the JSS Consortium so far as the use of the name is concerned.

I attach an extract from the Consortium Agreement which covers the use of the name. If any further evidence is required as to our exclusive right to control the use of the name and the conduct of any business undertaken

thereunder I will need to enlist the assistance of our Solicitor to deal with any such request. I obviously hope this will not be necessary.”

The Respondent’s Response

11. The Respondent has not made any Response to the original Complaint nor has it responded to or commented upon the further information referred to above.

12. Paragraph 2 of the DRS Procedure provides Nominet with a discretion as to which of a number of specified means of communication it will adopt in relation to the parties to a dispute brought under the Policy. Paragraph 2(e) provides that:

“Except as otherwise provided in this Procedure or as otherwise decided by us or if appointed, the Expert, all communications provided for under this Procedure shall be deemed to have been received:

 - i if sent by facsimile, on the date transmitted; or*
 - ii if sent by first class post, on the second Day after posting; or*
 - iii if sent via the Internet, on the date that the communication was transmitted; and*
 - iv where communications are received by more than one method, at the earliest date received:*

and, unless otherwise provided in this Procedure, the time periods provided for under the Policy and this Procedure shall be calculated accordingly.”

13. In my judgment I am entitled to assume, in the absence of any information to the contrary, that both the Complaint and the further information referred to above have been sent by Nominet to the Respondent and also that they have been received by the Respondent when deemed to have been so received in accordance with paragraph 2(e) of the Procedure. In the present case there is no such contrary information, and accordingly I make the assumptions referred to in the last sentence.

14. Since paragraph 15 of the DRS Procedure requires a Respondent to submit a response within the time limited (i.e. 15 days) and the Respondent has not done so, the Respondent is in default. 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 or any request by us or the Expert, the Expert will draw such inferences from the Party’s non compliance as he or she considers appropriate.”

There being no explanation of the default, no question of there being any “*exceptional circumstances*” can arise.

Jurisdiction and Principles

15. 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.”*

16. Under paragraph 2b of the Policy a Complainant is required to prove both these elements on the balance of probabilities.

17. Paragraph 1 of the Policy defines:-

(1) “Rights” as including “rights enforceable under English law”. This definition is subject to a qualification which is not material.

(2) “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;*"

18. Paragraph 3 of the Policy is in the following terms:-

“3 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.*"

Rights

19. As stated above, "*Rights*" includes "*rights enforceable under English law*". I am satisfied that the Jackson-Stops Staff Consortium has such rights in the name of Jackson-Stops and Staff.

20. The uncontradicted evidence before me is that the name has a long established reputation for estate agency and associated activities. I accept and find as a fact that this is so. Even without that evidence it is a fact of which, in my judgment, a court would take judicial notice even if no evidence were adduced to prove it. That established reputation would give rise to rights over the name in that it would be an actionable wrong for any person to use that name in such a manner as to lead to the belief that his services or business were the services or business of the persons entitled to make use of the benefit of that name.

21. It is also plain that the registrant of the Domain Names set out in the Appendix to this Decision has contractual rights in respect of those names, since such registrations will necessarily be based on contract.

22. It would have been helpful to have been provided with copies of the contractual provisions which
 - (1) defined "*the Name*" referred to in paragraph 6.1 of the Consortium Agreement,
 - (2) assigned to the Consortium the right to use the family name Jackson-Stops and Staff
 - (3) identified the members of the Consortium entitled to use the name.

23. Nevertheless I consider that I am entitled to make use of my knowledge of business and commercial practices and to recognize that the transfer of the right to

use the name inevitably would have been fundamental to the acquisition of the business of Jackson-Stops and Staff Limited. Furthermore I am entitled to and do infer that the Complainant, whose address is in Chester, is an entity within the Consortium, and is one which is entitled under the Consortium Agreement to make use of the name.

24. My conclusion, therefore, is that the Complainant has Rights in the name “Jackson-Stops and Staff” and in the abbreviated versions “Jackson-Stops” or “jacksonstops”. Further, those names are, as the case may be, either similar or identical to the Domain Name, so that the matters which a Complainant must establish (if a Complaint is to succeed) under paragraph 2 a i of the Policy are established.

The Web-site

25. Visitors to the Web-site would not in fact find any material in any way relevant to the business of estate agency. Instead they would find a site called g@ymen.com The Ultimate Network for Men, advertising “INSTANT ACCESS!!!” and “HARDCORE movies ..”.
26. I have no doubt that the registration of the Domain Name for this site could result in
- (1) A person or business seeking to access one of the Complainant’s web-sites [seven of which, I infer, had been established before the registration of the Domain Name] and accessing the Web-site by mistake, might well be offended or in any event might well desist from any further attempt to find the Complainant’s Web-sites.
 - (2) A person who was not already familiar with the Complainant’s business (and there will be such people) would get an entirely jaundiced and erroneous view of the nature of the Complainant’s business.

Abusive Registration?

27. As appears from paragraph 17 above an Abusive Registration is:

“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;”

28. The Domain Name was first registered on the 18 June 2000. The Complainant’s “Rights” existed in advance of this date (I am not overlooking the fact that the registration of seven of the Complainant’s web-site addresses post-dated that date).

29. It might be thought that the words “*in a manner*” in the first limb of the definition of Abusive Registration have the effect that the mere fact of a registration could not by itself be Abusive. However the non-exhaustive list of factors which may be evidence of an Abusive Registration shows that the mere fact of a registration can be Abusive if it is accompanied by an improper motive or objective.

30. I have come to the conclusion that the registration with which this Complaint is concerned falls foul of both limbs of the definition of an Abusive Registration. For reasons which I explain in more detail below, I consider that the Domain Name:

(1) was registered in a manner which, at the time when the registration took place, was unfairly detrimental to the Complainant’s Rights; and

(2) has been used in a manner which was unfairly detrimental to the Complainant’s Rights.

31. In the context of the material before me the only serious candidates from the non-exhaustive list of factors which may be evidence of an Abusive Registration are those set out at paragraph 3 a i C, and 3 a ii. The list is set out at paragraph 18 above.
32. The Complainant has not asserted that the Domain Name was registered “*primarily for the purpose of unfairly disrupting the business of the Complainant*” [paragraph 3 a i C of the non-exhaustive list]. However the Respondent has not advanced any explanation as to why the Domain Name was chosen. It is difficult to think of any reason why, if the Respondent wished to advertise its business, it could not have chosen some name which was not the well-known name of another well-known business. In the absence of any explanation from the Respondent I draw the inference that for some reason or other the Domain Name was registered by the Respondent primarily for the purpose of unfairly disrupting the business of the Complainant. Such disruption might be foreseen to occur in the manner described in paragraph 26 above. On the basis of the existence of the factor referred to in paragraph 3 a i C therefore I find that the registration falls foul of the first limb of the definition of Abusive Registration.
33. The factor referred to in paragraph 3 a ii is not in fact established because I have been provided with no evidence that the use of the Domain Name by the Respondent actually “*has confused*” people or businesses into believing that that Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
34. However, I consider that the likelihood of confusion and the potential for disruption or detriment to a Complainant business arising out of the use of a Domain Name is capable of amounting to an Abusive Registration even though there is no evidence that any particular person has actually been confused and the criteria of paragraph 3 a ii do not in terms apply. In the present case I consider that the content of the Web-site is such as to have amounted to a use of the

Domain Name which was unfairly detrimental to the Complainant's Rights. The unfairness and the detriment arise from the potential for the occurrences which I have described in paragraph 26 above, and from the fact that no reason has been advanced by the Respondent to show that there is a legitimate reason for registering the Domain Name for the use to which it has been put.

Conclusion

35. The Complaint of Abusive Registration has been established to my satisfaction. There are no applications for the Domain Name registration to be suspended, transferred or amended. In the absence of any alternative proposal the appropriate solution is for the registration to be cancelled, and I order and direct that this should be done.

Signed

David Blunt QC

17 December 2001

APPENDIX

Domain Name	Registered Authority	Date Registered
jackson-stops.co.uk	Entweb	1997
jackson-stops.info	Entweb	12/10/2001
jackson-stops.uk.co	Entweb	12/10/2001
jackson-stops.org.uk	Entweb	7/2/2000
jackson-stops.net	Entweb	4/2/2000
jackson-stops.org	Entweb	7/2/2000
jackson-stops.uk.com	Entweb	7/2/2000
jackson-stops.uk.net	Entweb	30/6/2000
jackson-stops.gb.com	Entweb	7/2/2000
jackson-stops.eu.com	Entweb	30/6/2000
jackson-stops.com	Vianetworks	15/9/1997
jacksonstops.info	Entweb	12/10/2001
jacksonstops.uk.co	Entweb	12/10/2001
jacksonstops.org.uk	Entweb	12/10/2001
jacksonstops.net	Entweb	30/6/2000
jacksonstops.org	Entweb	30/6/2000
jacksonstops.uk.com	Entweb	30/6/2000
jacksonstops.uk.net	Entweb	30/6/2000
jacksonstops.gb.com	Entweb	30/6/2000
jacksonstops.eu.com	Entweb	30/6/2000