

Nominet UK Dispute Resolution Service

DRS 0172

Merlinroute Limited –v- Simon Oliver

Decision of Independent Expert

1. **Parties:**

Complainant: *Merlinroute Limited*
Address: *68 High street*
Eaton Bray
Dunstable
Bedfordshire
Postcode: *LU6 2DP*
Country: *GB*

Respondent: *Simon Oliver*
Address: *31 Frankton Close*
Matchborough West
Redditch
Worcestershire
Postcode: *B98 0HJ*
Country: *GB*

2. **Domain Name:**

Lorientrust.org.uk (“the Domain Name”)

3. **Procedural Background:**

The Complaint was lodged with Nominet on 20th December 2001. Nominet validated the Complaint and notified the Respondent of the Complaint on 9th January 2002 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent responded on 9th January 2002 and a copy of the response was forwarded to the Complainant on 10th January 2002 with an invitation to the Complainant to make any further submission in reply

to the Response by 17th January 2002. The Complainant replied to the Response on 14th January 2002 and a copy of this was sent to the Respondent on 16th January 2002.

The dispute was not resolved by mediation and was referred for a decision by an Independent Expert following payment by the Complainant of the required fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

David Flint, 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):

None

5. The Facts:

Complainant:

1. "The company Merlinroute Ltd t/a the Lorien Trust was incorporated with companies house on the 6th March 1995 as a private company. Company registration number 03029544. Prior to the formation of Merlinroute Ltd in 1995, the Managing Director and owner of MerlinRoute Limited was the chairman of the Lorien Trust limited by guarantee which was formed in late 1991 until its transference to the new company Merlinroute Ltd in 1995. Registration with Data protection registrar from 30 June 1995 Reg no. A2408089 Merlinroute Ltd t/a the Lorien Trust
2. All property and intellectual rights of the Lorien Trust are owned by Merlinroute Ltd, as stated in several of our publication with all Copyrights and Trademarks included. The Live role play (LRP) hobby which Merlinroute is heavily involved with is known by the Lorien Trust name far more than Merlinroute Ltd. All information from how to contact the company, to all customer payments are made to the Lorien Trust. Hundreds of Internet references also refer to Merlinroute and the events run as the Lorien Trust. Other sources of further proof of Lorien Trust name use are the company bank details. Bank account for Merlinroute Ltd is trading as the Lorien Trust and all payments are made payable to the Lorien Trust.
3. The respondent, who himself runs the LRP company Mindlib, has been a customer of the Lorien Trust for many years and at one point was also a volunteer member of staff enabling him access to information

and publications constantly mentioning the name 'the Lorien Trust'. Payments he has made as a customer have been payable to the Lorien Trust. Therefore he has clear knowledge of the fact that Merlinroute runs and use the name the Lorien Trust for its business. In addition enclosed is the back of the Respondents booking form for last years events, signed and showing that his cheque was made payable to the Lorien Trust."

Respondent

1. "The complainant has made no attempt to contact me directly on this matter, with a view to making a deal, or else they would have found out that there is no problem. The registration is not abusive, for the following reasons. At the time of the registration there was a discussion on a public forum relating to the lack of online resources for the game with Merlinroute as the official source. Out of curiosity I looked to find out if any of the obvious domains had been registered. Finding that none of them had I concluded that either they planned to use other domain names, or they were being slow on the uptake. I registered the .co.uk and .org.uk names because I knew that Merlinroute has made many bitter enemies in its short life, and that any one of them could make trouble for them by registering the names.
2. Since registering the names I have made no use of them except to put up a single page with the intent of criticising Merlinroute for not having a website. I did not promote the site in any way, and in all that time I have received just two emails, which now appear to have been falsified in an attempt to obtain evidence of abuse. I responded to both with helpful information because I did not want Merlinroute to suffer from either the spread of false information or the lack of a response. By refraining from identifying myself I avoided gaining anything from the transactions. I did not make any attempt to gain materially or otherwise from my ownership of the site except for a flippant reply to a question from Stuart Maher. At the time I knew perfectly well that I would never be asked to participate in the web site design as the complainant has, in the past, made sure that my participation in the company as a volunteer member of staff came to an abrupt end, and it is therefore highly unlikely to be resumed. If the whole of that conversation had been reported, it would include the fact that I said I had another use for the site, and that this use was "nothing bad". I would like to keep lorientrust.org.uk for the aforementioned purpose.
3. The site will be run by me as an individual, and not by Mindlib which is not linked to the site in any way other than that my personal email address, which uses that domain, was used on the registration. I will happily put a prominent disclaimer and hyperlink on the page to redirect people to the Merlinroute site, as an assurance that no-one will mistake the site for an official one."

6. The Parties' Contentions:

Complainant:

The substance of the Complaint is short and reads as follows: -

"The Domain Name in dispute is identical or similar to a name or mark in which the Complainant has Rights.

The Domain Name in the hands of the Respondent is an Abusive Registration."

Respondent:

The substance of the Response is short and reads as follows: -

"As a guarantor of the original Lorien Trust charitable trust I feel I have as much right as anyone to that suffix [org.uk], under section 4.b.ii of [the] policy, which is, after all, the only use to which I have put the site so far.

I will happily put a prominent disclaimer and hyperlink on the page to redirect people to the Merlinroute site, as an assurance that no-one will mistake the site for an official one."

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

In this case the first limb of that task is straightforward. The Complainant is the proprietor of trade mark rights in the name Lorien trust. The Domain name comprises the name Lorien Trust and the suffix <.org.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.

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

Abusive Registration

This leaves the second limb. 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."

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. There being no suggestion that the Respondent has engaged in a pattern of making Abusive Registrations and there being no suggestion that the Respondent has given to Nominet false contact details, the only potentially relevant 'factors' in paragraph 3 are to be found in subparagraphs i and ii, which read 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."

The Expert interprets “as” in sub-paragraph i. B as being synonymous with “for the purpose of”. Were it to be interpreted otherwise all domain name registrations would inevitably constitute “blocking registrations” for any later arrival wishing to use the name in question.

The Complainant asserts:

“When the Lorien Trust attempted to register the domain [name] that [is] under dispute it was found that [it was] already registered.”

On the Expert’s interpretation of the relevant sub-paragraph (see above), this submission of the Complainant is not good enough. It does not follow that, because the Domain Name is in fact blocking the Complainant from doing what it wants to do, the Respondent registered the Domain Name to achieve that purpose.

However the Complainant had its staff make further enquiries which disclosed as follows:

“I asked a member of my staff to contact the respondent by email, enquiring why he had registered these names. The respondent replied “just those two – call it an investment, as I would like to become a web site developer, I thought I might be able to persuade the LT to let me join the design team if I owned the most appropriate domains. Has it worked?” to which we responded “No”. This demonstrates the respondent acquired the domain name[.] under dispute with the intention of transferring or allowing the Lorien Trust to use [it] for consideration in the form of a job to further his career.”

The Respondent stated:

“I did not make any attempt to gain materially or otherwise from my ownership of the site except for a flippant reply to a question from Stuart Maher. At the time I knew perfectly well that I would never be asked to participate in the web site design as the complainant has, in the past, made sure that my participation in the company as a volunteer member of staff came to an abrupt end, and it is therefore highly unlikely to be resumed. If the whole of that conversation had been reported, it would include the fact that I said I had another use for the site, and that this use was “nothing bad”.”

In an e-mail to Nominet of 4th February 2002, the Respondent stated:

“My reply to Stu Maher was facetious in intent and tone, and not the truth which I was attempting to hide from Merlinroute. The truth is that I want to use the domain as a pressure group aimed at maintaining the original intent of the Lorien Trust (Limited by Guarantee, of which I was a guarantor) to be answerable to the players. This is clearly within the allowed uses for a domain registration, under section 4(b) and not abusive.”

This e-mail was sent to Nominet at 18:27 on the 4th February 2002, the final day of the period for Informal Mediation under the Policy. No similar suggestion had been made prior to this time and, indeed, the statement is in direct contradiction of the statement made by the Respondent in his Response of 9th January 2002.

The expert does not consider that the fact that an argument was not advanced in a Response but at a later stage in the Proceedings to be fatal to its introduction but the fact that the evidence sought to be introduced by a Party is materially different to previous evidence must be a factor requiring to be taken into account. If the Dispute Resolution System is to be effective, given its relatively short time scale, it is imperative that both parties make full and accurate disclosure of their position at an early stage.

The Complainant makes the following further submissions/allegations:

1. “When logging onto the sites on the Internet we were confronted with a picture of a cockerel with an email forwarding box to enquiries@lorientrust.co.uk. This raised concerns that there is a serious risk of confusion that the respondent will be connected with the Lorien Trust. At a LRP event held on the 24th November 2001, run by another company using the rules of the Lorien Trust. The respondent informed a member of Lorien Trust staff who was in attendance that he had received a number of enquiries relating to the Lorien Trust which he would forward on, this was not forthcoming. Regardless of whether this enquires were passed on or not, it is clear that some of our customers and/or potential customers are associating this site with the Lorien Trust. This indicates that the respondent is using the domain name in a way, which has caused confusion leading people to believe that the name is registered to, operated by, or authorised by, or otherwise connected with the Lorien Trust.
2. Various testing messages were sent to the enquiry address. On the 18th December 2001 a response was forthcoming to a message sent on 17th December 2001

which gave no indication that the sites were not connected to Merlinroute Ltd. t/a the Lorien Trust. Indeed by stating that the enquiry would be forwarded to the relevant person within the Lorien Trust and that action would be taken i.e. the person would “be in touch” gives the impression that the site is connected to the Lorien Trust and thus that the respondent is passing himself off as such. Adding to this is the reply that has been posted on to [] (leader of the Jackals) who is a volunteer staff member from (document six and seven above). Which states it has come from the LT (an abbreviation we often use for the Lorien Trust). If this staff member had not been informed to the contrary they also would be under the impression that the e.mail had come from the Lorien Trust office. Again causing confusion.”

Having regard to the background of the parties, including their involvement in the original Lorien Trust Limited (Limited by Guarantee) and the trading activities between the Respondent and the Complainant, the Expert finds the test of paragraph 3 a.i.C to be met.

The Domain Name comprises in essence a distinctive made up name. It is identical to the Complainant’s trading name. Some time prior to the making of the registration the Respondent was working for the Complainant as a volunteer. The Complainant did not ask the Respondent to register the Domain Name and did not give the Respondent permission to register the Domain Name. In the hands of the Respondent the Domain Name constitutes a threat hanging over the head of the Complainant. While it is not impossible to think of uses to which the Domain Name may be put, which could cause little or no damage to the Complainant, there are many obvious and potentially damaging uses to which the Domain Name could be put. The circumstances surrounding this registration understandably give the Complainant no comfort.

In the view of the Expert the Respondent clearly has a case to answer on the basis that in registering the Domain Name the Respondent took unfair advantage of the Complainant’s rights.

It is here that paragraph 4 of the Policy has a part to play. Paragraph 4 of the Policy is headed “How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration”. The onus is ordinarily upon the Complainant to prove what needs to be proved (for the exception see paragraph 4b), but where the Expert has found that the Complainant has made out a prima facie case and that the Respondent has a case to answer, the Respondent must have an answer. Here there is no answer. In other cases it may be that the circumstances will be such that the Expert will feel able to suggest a reasonable answer, but that is not this case.

As the Respondent makes much of the fact that he was the Guarantor of a previous business trading under the name "Lorien Trust", the Expert has considered this point. The original company traded from 1991 to 1995 when it was wound up. At that point the Complainant commenced a business under the name "Lorien Trust". From the WHOIS record produced to the Expert, it appears that the Domain Name was not registered until 28 September 2001. No evidence has been produced by the Respondent to indicate why he suddenly became concerned with his "rights" in the Domain Name some 6 years after the demise of the Guarantee Company.

The Expert considers that, in appropriate circumstances, the fact that a person were a guarantor of a business could of itself give that person the necessary rights to deflect a challenge under the Policy. However, such a guarantee obligation would require to be real and substantial having regard to the business being guaranteed. A £1 guarantee to an organisation such as the original Lorien Trust Limited by Guarantee is not such an obligation and does not, in the opinion of this Expert, provide its granter with any rights in the name of the 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 identical 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, lorientrust.org.uk, be transferred to the Complainant.

David Flint

3rd March 2002
Date