

Nominet UK Dispute Resolution Service

DRS 00292

**NOKIA CORPORATION v. SYED MAHMOOD, NAQI JAWAD,
TAQI JAWAD**

Decision of Independent Expert

1. Parties:

Complainant: Nokia Corporation
Address: P.O.Box 226
Nokia Group
Postcode: 00045
Country: FI

Respondent: Saeed Mahmood, Naqi Jawad, Taqi Jawad
Address: 371 Green Street
London
Postcode: E13 9AU
Country: GB

2. Domain Name:

Nokia.me.uk (“the Domain Name”)

3. Procedural Background:

The complaint was entered into Nominet’s system on 12 March 2002. Nominet validated the complaint and informed the Respondent (I will refer to the Respondent in the singular, notwithstanding that three names are recorded as Registrant) on 18 March 2002, noting that the Dispute Resolution Service had been invoked and that the Respondent had 15 working days (until 11 April 2002) to submit a Response. A “Response” (see section 6, below) was received on 11 April 2002 and forwarded to the Complainant on 12 April 2002 with an invitation to the Complainant to make any further submission in reply to the Response by 19 April 2002. The Complainant did not file a Reply. In accordance with Nominet’s practice I have not been provided with any of the materials, records or correspondence generated during the Informal Mediation stage which followed, though I infer that it did not result in a mediated compromise agreement. On 16 May 2002 the Complainant was 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 21 May 2002.

On 24 May 2002 Nominet invited me to provide a decision in this case and, following confirmation to Nominet that I knew of no reason why I could not properly accept the invitation to act in this case and of no matters which ought to be drawn to the attention of the parties which might appear to call into question my independence and/or impartiality, Nominet duly appointed me as Expert with effect from 28 May 2002.

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

None.

5. The Facts:

The Complainant, Nokia Corporation is a body incorporated under the laws of the Republic of Finland. It is a global manufacturer and provider of mobile telecommunications goods and services, with a significant trading presence in the United Kingdom. It is the proprietor of a large number of UK and Community trade mark registrations, dating back to February 1993, comprising or including the designation 'NOKIA'.

The Nominet WHOIS search with which I have been provided shows that the Domain Name, nokia.me.uk, was registered on behalf of the Respondent on 15 January 2002.

There is currently no website accessible under the URL <http://www.nokia.me.uk>.

6. The Parties' Contentions:

Complainant:

The Complainant requests that the Domain Name be transferred to it on the basis of the following submissions:

"Nokia.me.uk Nominet UK's Dispute Resolution Policy is applicable to this .me.uk dispute by reference to the General Rules for .me.uk where it is stated that those rules are "incorporated by reference into the Rules for the .uk Domain and form part of the contract of registration".

"1. The relevant part of the domain name is "NOKIA" which is clearly identical to various trademarks registered by the Complainant (please see copies of the certificates in Annex 1). It should be noted that the Client has spent a lot of money and effort in order to build this brand and that as a result, the NOKIA brand is today a well-known mark all around the world, including the UK and has gained a substantial reputation as a world leader in the mobile communication industry.

"2. The Domain Name, in the hands of the Respondent is an Abusive Registration. This, because the name was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainant's Rights.

"There are several circumstances in this case that make the Respondent's registration of nokia.me.uk an abusive registration. In order to correctly explain these reasons, it is important to give the Expert a brief description of the background to this case.

“The Domain Name nokia.me.uk was registered by the Respondent on January 15th, 2002. In order to try to solve the matter in an amicable way, the Complainant sent the Respondent a letter, informing him of their rights to the name and asking him to transfer the name, offering to reimburse him any reasonable expenses he may have had when registering the domain name (please see a copy of the letter in Annex 2). The Respondent wrote back claiming that he registered the domain name in question because his nickname is “Nokia”. However, he also offered the domain name for sale by asking Nokia to provide him with an offer that he could consider (please see a copy of the letter in Annex 3).

“Against this background, the Complainant would like to state the following.

“The Complainant acknowledges that the .me.uk Second Level Domain is intended for personal use and that Domain Name registrations made under .me.uk are expected to be made for natural persons. However, the NOKIA brand must be considered to be a well-known mark in any markets, including the UK. It is highly unlikely therefore, that the Respondent has selected the domain name without having knowledge of the Complainant’s use of the mark NOKIA. Not only must he have had the Complainant’s mark in mind when he registered the domain name but he must also have been aware of the deception and confusion that would inevitably follow if he used the domain name. Especially taking into account that the word "NOKIA" is neither generic nor descriptive, and the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to apply for or use any domain name incorporating any of those marks.

“In order to find out a bit about the background of this registration, the Complainant carried out some research. As a result we found that, on the same occasion, not only had the Respondent registered nokia.me.uk but also several other famous trademarks under the .me.uk domain. These names include domain names such as sony.me.uk, bmw.me.uk, vodafone.me.uk, orange.me.uk and nissan.me.uk. For a complete list of these registrations and the registration details, please see Annex 4). Based on these findings, the Complainant argues that the Respondent is engaged in a pattern of making Abusive registrations, under Para 3iii) of the Policy.

“However, the Complainant acknowledges the fact that Para 3iii) can only be referred to in combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration. To this extent, we would like to put the expert’s attention to the last sentence in the Respondent’s letter discussed above, where the Respondent offers the domain name for sale to the Complainant depending on what kind of offer the Complainant would give him (please see a copy of the letter in Annex 3). When interpreting the Respondent’s intent with such a letter and what kind of offer he was hoping for it is important to keep in mind that the Complainant had already offered to cover all reasonable costs he would have had with regards to the registration of the domain name in question. Furthermore, it is unlikely that the Respondent registered the name in question because his nickname was NOKIA, especially as one can see the clear pattern as discussed above, where he has registered so many famous trademarks within the same period of time. Taking all these circumstances into account it follows that we are of the opinion that the offer made by the Respondent in his letter shows that the respondent registered the Domain Name in question primarily for the purpose of selling, renting or otherwise transferring the Domain Name to the Complainant for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the name (para 3i A of the Policy).

“Furthermore, in combination with the given statements, the Complainant thinks that it is important to point out that the Respondent does not use nokia.me.uk or any of the other names for the purposes of e-mail or websites. This, even if it is not in itself evidence of

Abusive Registration, must in this case be seen together with the other circumstances, as supporting the discussion of Abusive Registration.

“In conclusion, by referring to the discussion above, it is clear that the registration of nokia.me.uk made by the Respondent under such circumstances as mentioned above took unfair advantage of the Complainant’s famous trademark and should therefore be characterized as being an Abusive Registration, as stated in Para 2 a ii of the Policy.”

Respondent:

In response, the Respondent sent an email dated 11 April 2002 to Nominet, copied to the Complainant, stating:

“We are in communication with [*the Complainant*] for the transfer of the domain name of www.nokia.me.uk on the terms of their offer to pay the registration fee for the domain name.

“If they (nokia) pay the registration charges for the domain name, we will then transfer this to them. In the case of failure of any settlement with them, we will then proceed with our answer to you. I hope this matter will be resolved quickly.”

This communication has been treated as the Response for the purposes of this Complaint.

Complainant’s Reply

The Complainant did not file a Reply.

7. Discussion and Findings:

General observations regarding the ‘me.uk’ Second Level Domain

The Domain Name is registered in the ‘.me.uk’ domain. As this is the first Expert Decision dealing with such a domain name, I will make a few general observations about the regime under which such domain names are registered and maintained.

‘me.uk’ is the most recent Second Level Domain to be introduced by Nominet. It commenced operation at midnight on 14 January 2002. It is different from the ‘.co.uk’ and ‘org.uk’ domains with which the Dispute Resolution Service is more usually concerned in the sense that it is governed by a special set of rules, currently published at <http://www.nominet.org.uk/meuk/rules.html>. Rules 1 to 7 read as follows:

“General

“1. The rules for the .me.uk Second Level Domain ("SLD") as amended from time to time are incorporated by reference into the Rules for the .uk Domain (the "Rules"), and form part of the contract of registration.

“2. Where a conflict exists between the Rules and the rules for the .me.uk SLD, the rules for the .me.uk SLD shall have precedence.

“Scope

“3. The .me.uk SLD is intended to provide a personal namespace within the .uk Top Level Domain. It is anticipated that registrants will be natural persons who have an association with the UK.

“4. Any entity may register in the .me.uk SLD provided the registration complies with the Nominet UK terms and conditions, the Rules and the rules for the .me.uk SLD, in each case as amended from time to time.

“5. No limitation is placed on the number of names that may be applied for on behalf of a single entity.

“6. Nominet will take no action with regard to the registration or use of a Domain Name unless such registration or use conflicts with the Nominet UK terms and conditions, the Rules including the rules for the .me.uk SLD, or Nominet UK's Dispute Resolution Policy and Procedure, in each case as amended from time to time.

“7. There shall, without exclusion, be a sufficient demonstration of an abusive registration if the registrant is not a natural person and cannot demonstrate that they registered the domain name with the agreement at the time of a specific natural person, and that the domain name was a reasonably faithful representation of that person's legal name.”

On first reading, one could be forgiven for believing that ‘.me.uk’ domain name registrations are only available to natural persons (as opposed to legal persons such as corporations). This is indeed the ‘mission statement’ set out in Rule 3.

However, on closer inspection of the Rules as currently drafted, it is apparent that Rule 3 is little more than a ‘mission statement’: Rule 4 provides that *any entity* may register a .me.uk domain name; and Rules 1 and 6 provide that the specific .me.uk Rules apply *in addition to* – rather than in substitution for – Nominet’s terms and conditions, the Rules for the .uk TLD and Nominet UK's Dispute Resolution Policy and Procedure.

The net effect of these cross references and incorporations by reference is that under the Nominet Dispute Resolution Service, ‘.me.uk’ domains fall to be treated in the same manner as ‘.co.uk’ and ‘org.uk’ domain names, save for the additional impact of Rule 7 (which I deal with below under the penultimate sub-heading in the ‘Abusive Registration’ section).

Requirements which must be satisfied in order for the Complaint to succeed

Paragraph 2 of the Policy requires that, in order for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy (and subject to Rule 7 of the ‘.me.uk’ Rules).

These matters must be affirmatively proven by the Complainant, notwithstanding the failure by the Respondent in this case to set out in his Response “*any grounds the Respondent wishes to rely upon to rebut the Complainant's assertions ... including any relevant factors set out in paragraph 4 of the Policy*” as required under paragraph 5(c)(ii) of the Procedure. The effect of the Respondent’s default is rather that, under paragraph 15(c) of the Procedure, (there being no exceptional circumstances in this case) I am required to draw such inferences from the Respondent’s non-compliance as I consider appropriate.

Complainant's Rights

I have been provided with the registration details of numerous United Kingdom and European Community registered trade marks and I am amply satisfied on the evidence before me that the Complainant has Rights in the designation NOKIA.

I am further satisfied that this name is identical to the Domain Name (ignoring, as I am required to do, the first and second level suffixes).

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 are set out in Paragraph 3(a) of the Policy. A non-exhaustive list of countervailing factors are set out in Paragraph 4(a) of the Policy. I consider that the factors under paragraphs 3(a)(i)(A), 3(a)(iii) and 4(a)(i)(B) are those which bear upon the arguments put forward in the present case. I will deal with each of those factors in turn before considering the application of Rule 7 of the '.me.uk' Rules.

- Paragraph 3(a)(i)(A) of the Policy

Under paragraph 3(a)(i)(A), it is indicative of Abusive Registration if the Respondent has registered or otherwise acquired the Domain Name 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.

Under this paragraph the Complainant seeks to rely upon the Respondent's email dated 4th February 2002 wherein an offer of reimbursement of registration fees was rejected and the counter-offer "*if you are still interested to buy this name give us your offer and some time so we can decide*" put forward. This interchange must be viewed in the context of the Respondent's Response by email dated 11 April 2002 wherein it is stated "*If they (nokia) pay the registration charges for the domain name, we will then transfer this to them. In the case of failure of any settlement with them, we will then proceed with our answer to you. I hope this matter will be resolved quickly*". It is evident that no such settlement has been reached, however I must not and do not speculate as to why that might be so.

I am mindful of the danger of construing the Respondent's express representations as if they were the only evidence of his intentions. In my view, the Domain Name is compelling evidence in itself. In this connection I am put in mind of the approach of Jonathan Sumption QC sitting as a Deputy Judge of the High Court in BT v One In A Million [1998] F.S.R. 265 as approved by Aldous LJ on appeal ([1999] F.S.R. 1):

“There is only one possible reason why any one who was not part of the Marks & Spencer Plc group should wish to use such a domain address, and that is to pass himself off as part of that group or his products off as theirs. Where the value of a name consists solely in its resemblance to the name or trade mark of another enterprise, the Court will normally assume that the public is likely to be deceived, for why else would the Defendants choose it? In the present case, the assumption is plainly justified. As a matter of common sense, these names were registered and are available for sale for eventual use. Some one seeking or coming upon a website called <http://marksandspencer.co.uk> would naturally assume that it was that of the Plaintiffs.

...

The point is that the names are only saleable to Marks & Spencer and blocking their use by Marks & Spencer is only a useful negotiating tactic on the footing that they are names which it is dangerous for Marks & Spencer to allow to remain out of their control.”

It was open to the Respondent in his Response to refute the inference that he only obtained the Domain Name in order to sell it back to the Complainant, and set out and substantiate any alternative case. He has not done so and subject only to the considerations which may arise under paragraph 4(a)(i)(B) of the Policy (with which I deal below) there is nothing to weigh against the inference that the Respondent did indeed register the Domain Name for purposes falling within paragraph 3(a)(i)(A).

- Paragraph 3(a)(iii) of the Policy

Under paragraph 3(a)(iii) of the Policy, it is indicative of Abusive Registration if, 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.

‘Abusive Registration’ is a defined term under the Policy. However if I were to construe paragraph 3(a)(iii) as being restricted in its application to other registrations which have been formally adjudged to be Abusive (with a capital ‘A’) in previous Nominet DRS Decisions, in my view that would deprive the paragraph of any practical effect save in the most extreme of cases. As a matter of common sense I decline to do so.

Turning to the facts, the Complainant has pointed out that at around the same time that the Respondent registered the Domain Name, he also registered *vodafone.me.uk*, *orange.me.uk*, *virgin.me.uk*, *bmw.me.uk*, *nissan.me.uk* and *sony.me.uk*. As Lady Bracknell might have put it, to have registered one domain name corresponding to the brand name of a major mobile telecommunications company may be regarded as a misfortune; to register two looks like carelessness. To register four – plus the trade marks of two prominent automobile companies and a major electronics company – looks very much like abusive registration. Given the prominence and renown of the brand names SONY, BMW, VODAFONE, ORANGE, VIRGIN and NISSAN, and the inherent improbability of all such names being registered innocently, I am satisfied on the balance of probabilities that the Respondent is engaged in a pattern of making abusive registrations.

I wish to make it clear that my decision on this point is based solely on the submissions and evidence before me in this Complaint and is in no way formally binding upon future Experts who may be called upon to adjudicate upon whether the names *vodafone.me.uk*, *orange.me.uk*, *virgin.me.uk*, *bmw.me.uk*, *nissan.me.uk* or *sony.me.uk* were registered abusively under the terms of the Policy.

- Paragraph 4(a)(i)(B) of the Policy

Under paragraph 4(a)(i)(B), it is indicative of non-Abusive Registration if the Respondent has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

The Respondent has not raised this ground in his Response, though a claim to this effect was contained in the Respondent's email dated 4 February 2002 and included in the papers accompanying the Complaint: *"I have registered this name because my Name is NAQI and my nickname is nokia. As .me.uk is to register for names and personalities on first come first served basis so I do not think at all that we violated any trade mark."*

In isolation this suggestion is not beyond the bounds of possibility; but by parity of reasoning to that set out above in relation to paragraph 3(a)(iii) of the Policy its credibility is stretched beyond breaking point when it is considered in the context of the Respondent's other domain name registrations. I doubt that the Respondent is quite so polynomial as to attract the nicknames 'Vodafone', 'Orange', 'Virgin', 'BMW', 'Nissan' and 'Sony'. I infer that this is the most likely reason why the 'nickname' defence was not formally asserted in the Response and I attach little weight to it.

- Rule 7 of the me.uk Rules

Rules 2 and 7 of the me.uk Rules are worth setting out once more, this time with emphasis added:

"2. Where a conflict exists between the Rules and the rules for the .me.uk SLD, the rules for the .me.uk SLD shall have precedence."

*"7. There shall, without exclusion, be a sufficient demonstration of an abusive registration **if** the registrant is *not a natural person* **and** cannot demonstrate that they registered the domain name with the *agreement* at the time of a specific *natural person*, **and** that the domain name was a *reasonably faithful representation* of that person's legal name."*

As a matter of construction, it appears to me that the effect of these two Rules is as follows:

- where the three cumulative requirements of Rule 7 are present, the Registration is conclusively deemed to be Abusive, regardless of the factors set out at paragraphs 3 and 4 of the Policy; but
- where one or more of the three requirements of Rule 7 are absent, abusiveness must be judged under the usual provisions of the Policy.

I can foresee that many interesting points may arise in future Decisions regarding the application of this Rule, but none of them arise in this case. The Respondent is a natural person, Rule 7 therefore falls at the first hurdle and I derive no assistance from the me.uk Rules in determining whether or not the Domain Name is an Abusive Registration.

- Conclusion

The considerations set out in paragraphs 3 and 4 of the Policy are illustrative and non-exhaustive. The ultimate question for my consideration is whether, on the evidence as a

whole, the Complainant has discharged the burden of proving that the Domain Name (i) was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights or (ii) has been used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's Rights. For the reasons set out above I have little hesitation in concluding that the Complainant has discharged the burden under limb (i).

Accordingly I conclude that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

8. Decision:

Having concluded 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 determines that the Domain Name, nokia.me.uk, should be transferred to the Complainant.

Philip Roberts

June 6th, 2002
Date