

Royal Marines -v- O'Neil

Nominet UK Dispute Resolution Service

Decision of Independent Expert

1. Parties

Complainant: Royal Marines

Address: Corps Secretary, HMS Excellent, Whale Island, Portsmouth, Hants

Postcode: PO2 8ER

Country: Great Britain

Respondent: Neil O'Neil

Address: Morgas Beechwood Close, Burwash, East Sussex

Postcode: TN19 7BS

Country: Great Britain

2. Domain Name:

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

3. Procedural Background:

The Complaint was submitted to Nominet on 16 May 2002, and was received by Nominet on 20 May 2002, and was sent to the Respondent by post on 21 May 2002 by Nominet, informing the Respondent that he had 15 working days, i.e. until 13 June 2002, in which to respond to the Complaint. On the same date, a copy of the Complaint was also sent to O'Neil at his email address at neil@compulab.co.uk.

On 24 May 2002, Nominet received a Response from the Respondent. On the same date, Nominet sent a copy of the Response to the Complainant, the Royal Marines. Nominet informed the Respondent that the Complainant had five working days, i.e. until 31 May 2002, in which to file a Reply. On 28 May 2002, Nominet received a

Reply from the Complainant and sent a copy to the Respondent on the same date. Both parties were informed by Nominet that the next stage in the Dispute Resolution Service was Informal Mediation. On 21 June 2002, Nominet informed the Complainant that it had not been possible to achieve a Resolution of the Complaint by Informal Mediation. Nominet informed the Complainant that the next step in the Dispute would be to refer the matter for an Expert Decision if the Complainant paid a fee of £750 plus VAT within ten working days of receipt of that letter. The Complainant duly paid the fee within the relevant time limit and the matter was duly referred to Nick Rose, the undersigned, (“the Expert”) for an Expert Decision.

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

I am satisfied that all outstanding procedural issues have been dealt with satisfactorily.

5. The Facts

The Royal Marines, the Complainant, is a Regiment in the British Army. The Domain Name, royalmarines.co.uk, was registered on 6 December 1999 for “Neil O’Neil”, the Respondent. The Respondent also gave his name and home address as the Administrative Contact and Billing Contact. As at the date of this Decision, the following is displayed at the address www.royalmarines.co.uk:

“THIS IS A NEW FREE PUBLIC SERVICE SITE

There may be many of you out there aspiring to become Royal Marines, but do you know the full story? We request that you send your questions here and we will try and get them answered. This site will act as an FAQ for would-be Marines.

On the other hand, you may BE or have BEEN a Royal Marine and have something to say based on your experience. Let us hear what you have to say, positive or negative. In time you may be able to answer the questions posted here. All communications (questions and answers) will be kept 100% anonymous.

It’s your site now, so use it. All questions, answers and opinions should be sent to:

faq@roymarines.co.uk”.

The Expert should also add that, among the papers sent to the Expert by Nominet, there is a copy of a printout of the website at www.royalmarines.co.uk as at 21 May 2002. The information displayed on that date, is very different to the information displayed as at today’s date. On 21 May 2002, the domain name “royalmarines.co.uk” was said to be available “*NOW to buy, rent or use free of charge*”. The homepage also stated:

“Live sites for sale:

e-sex.org (adult)

screenplays.co.uk

restaurant-guide.net

katies.org (adult)”.

6. The Parties contentions:

Complainant:

The Complaint contends that it has rights in the name “Royal Marines”. It does not say what those rights are. There is an allegation that the domain name in the hands of the Respondent is an Abusive Registration. Again, it does not say why. The Complainant then submits that *“The Royal Marines consists of 6,000 men and are Britains Commandos and a part of the Royal Navy. The name “Royal Marines” has been “owned” by them for 200 years and the title was bestowed upon them by George IV, the reigning monarch at that time. The Royal Marines served in both World Wars and in every operation undertaken by the British government since WW2. Their name is nationally recognised and a household name in UK and many former Colonies such as Australia and New Zealand. We submit therefore that the title “Royal Marines” is exclusive to the Royal Marines Secretariat.”*

The Expert does not know if this last sentence is correct. No documents have been submitted as evidence in support of the fact that any rights in the title “Royal Marines” is owned by the Royal Marines Secretariat. The Complainant does not say that the Complainant, or anybody else, owns any registered trade mark rights in “The Royal Marines”. However, the Expert has conducted a trade mark search and the Expert notes that on 11 January 2002 the Secretary of State for Defence applied to register “The Royal Marines” and “Royal Marines” as trade marks, in various classes, and this application is pending. It appears therefore that, if this application succeeds, the Secretary of State for Defence will own registered trade mark rights in “The Royal Marines”. It may well be that the Secretary of State for Defence is the government department which currently owns unregistered rights in “The Royal Marines”. The Expert does not know, nor has he been told, of the relationship between “The Royal Marines Secretariat” and the Secretary of State for Defence. The Expert is not, therefore, satisfied that the Royal Marines Secretariat is the body which owns any rights in the name “Royal Marines”.

In relation to the issue of Abusive Registration, nothing is said in the Complaint at all as to why this is an Abusive Registration. The Complainant has merely asserted exclusive rights in the title “Royal Marines” and that is all. The correct declaration has been made, the Complainant has confirmed that the information contained in the Complaint is, to the best of his knowledge, true and complete. The Expert assumes, therefore, if the Complainant believed that this information was complete, the Complainant had no other information to assert as to whether or not this was an Abusive Registration. No documentary evidence has been filed in support of the Complaint.

Respondent

The Respondent sent his Response on 22 May 2002 by email to Nominet. The Respondent contends that the Royal Marines already have a website at www.royal-navy.mod.uk/static/pages/141.html. The Expert has had a look at this website and this assertion is correct. The Respondent asserts that all the armed forces have the “.mod.uk” extension, which is exclusive to their use. The Respondent also asserts that the Royal Marines have registered the domain name “royalmarines.org.uk” although there is no live website yet at this address. The Respondent asserts that the Royal Marines is not a registered trade mark, nor is it a commercial concern, and therefore the Royal Marines can have no commercial rights in the .co.uk domain name. The Respondent denies purchasing the domain name to bring the Royal Marines into disrepute. The Respondent said that he has offered use of the domain name free of charge, with free webhosting and free email to the Royal Marines, 45 Commando Regiment, and the Respondent attaches an email in support of that assertion. The Expert will return to that email below. He says that his original idea for the domain name was to allow ex-Marines to have their say anonymously about life in the Royal Marines, as a service to “*would be*” Marines in the hope that they would make an informed choice before signing up. The Respondent said that this was partly because a friend of his fought in the Falklands War. He says that this had been a low priority on his “*to do list*”, but that he was able to initiate the site and that it is his full intention to do so within the next 24 hours if the Complaint is pursued.

The Respondent then goes on to say that the domain name was originally for sale for a very modest sum, as an investment, before he or anybody else developed the site. He says that he has now moved it from being up for sale and will take whatever action is necessary to protect his right to the domain name, including litigation.

The Respondent then states that “royalmarines.org” is currently being used by an organisation for ex-Marines and is, therefore, not an active part of the Royal Marines. He therefore, claims that a precedent has already been set. The Expert assumes that the Respondent means that a precedent has been set for other domain names being registered which make use of the title “Royal Marines”, for legitimate purposes, and

which has not been challenged by the Complainant. The Expert has looked at the website at www.royalmarines.org and this assertion is correct. This appears to be a site containing information about the Royal Marines, which allows for views and information about the Royal Marines to be exchanged, and is not in any way connected to the Complainant.

The Respondent then asserts that the domain name “royalmarines.com” is also up for sale and he suggests that this sets another precedent. Again, this assertion is correct and the Expert does not know whether or not the Complainant has made any objection to the Registrant of this domain name.

The Respondent asserts that “royalmarines.net” is owned by a design company and that “royalmarines.info” is registered to a private individual in London. There are no active websites at these addresses and the Expert does not know if the Complainant has raised any objection to these domain names.

The Respondent states that he purchased this domain name with an idea in mind, or as an investment, and not with any intention of discrediting the Royal Marines or with a view to extorting money from them. The Respondent then asks that Nominet should not bully him into handing over this domain name and makes an appeal on behalf of free speech.

The Respondent attaches to his Reply an email from him to “hughgallacher@aol.com” dated 29 March 2002. This is in reply to an email from Hugh Gallacher to the Respondent in which Hugh Gallacher says that he would like to use the site as an information base for friends and families of 45 Commando Royal Marines who are currently deployed on operational duties in Afghanistan. Mr Gallacher says that the site would be used to give a regular update on Unit activities, and inform relatives on casualty procedures and general welfare information. Mr Gallacher says that he wants free usage. In reply the Respondent, who appears to be on first name terms with Mr Gallacher, says that he believes this is a great reason for using the site and that he will provide free hosting and free email addresses. The Respondent informs Mr Gallacher that there will be some simple conditions for use of the site, including a condition that there should be no illegal activity conducted on the site, for example, pornography. The Respondent also asks that there is a link to say that the site is being provided free of charge by the Respondent’s company. The Expert does not know the identity of the Respondent’s company. In a p.s., the Respondent states: “*Best of luck to our boys and may they return safely.*”

The Complainant’s Response to the Respondent’s Reply

In an email on 28 May 2002, the Complainant sent a Response to Nominet. The Complainant said that it does not have a website, and that the site mentioned in the

Reply is the Royal Navy site with the Royal Marines added to it. The email is from Christopher Shae of the Intellectual Property Rights Group at “MOD Abbeywood”. Mr Shae says that “*“We” have produced a Royal Marines Regimental Site and that “we” feel that “we” should be allowed to use the royalmarines.co.uk domain name.*” He says that the Royal Marines trade mark name has been applied for and that other names with the name Royal Marines will be looked at after the findings of the tribunal.

Mr Shae does not identify the “*Royal Marines Regimental Site*” which he refers to.

The Respondent’s Reply to the Complainant’s Response

In an email on 29 May 2002, the Complainant responds to Mr Shae’s email. The Respondent submits that the Complainant has a legal entitlement to “royalmarines.mil”. He also submits that Mr Shae would be able to obtain “royalmarines.mod.uk”. He suggests that in order to register a trade mark “*you*” must be “*trading*”. He also suggests that any registration of a trade mark after a domain name has been assigned, would not give the Complainant any retrospective rights in the domain name.

Further Response from the Complainant to the Respondent’s Reply

On 30 May 2002, Mr Shae sent by email to Nominet a document headed “Reply to Mr O’Neil’s Counter Statement”. In this Reply, Mr Shae sought to address each of Mr O’Neil’s submissions in turn. In summary, Mr Shae made the following points:

- (a) The average member of the public, when searching for official information about the Royal Marines, would often not consider using the specialist suffix “.mod.uk”, and would be confused into thinking that the domain name “royalmarines.co.uk” would be registered by the Complainant.
- (b) There is a pending trade mark application and the Complainant has passing off rights in the name “Royal Marines”. It is submitted that the reputation in the name “Royal Marines” vests in the Secretary of State for Defence, being the legal personification of the Royal Marines.
- (c) The Complainant uses the name “Royal Marines” for both commercial and non-commercial purposes and examples are given. It is submitted that illustrative evidence of the Royal Marines training activities can be found at the following sites: www.royalmarinesofficialsite.co.uk; www.royalmarinesbands.co.uk; www.royalmarinesmuseum.co.uk.
- (d) The Complainant submits that any registration of a company name incorporating the words “Royal Marines” would infringe the unregistered trade

mark rights held by the Royal Marines in that name, and that such a company name would also offend against the Company and Business Names Regulations 1981.

- (e) It is submitted that the Respondent's admission that his registration was an "*investment*" is evidence of an Abusive Registration as it demonstrates an intention to profit by way of sale or renting of the domain name.
- (f) The Complainant states that the Respondent is still proposing to sell the domain name as it was still being advertised for sale on 29 May 2002 on the website. The Complainant states that 494 other domain names are listed for sale at this website.
- (g) The Complainant submits that even if the site was used as a site relating to the Royal Marines, the domain name would still be an Abusive Registration as it would be likely to cause confusion or disrupt the Complainant's business for the reasons mentioned above.
- (h) It is submitted that even if the Respondent was to change the use of his website, during the course of these proceedings, to include information about the Royal Marines, then that should be given no weight in evidence.
- (i) The Complainant submits that it is concerned about the use of its name by other third parties and that it does not acquiesce to any unauthorised use of its name and also submits that such use is not relevant to this Complaint.
- (j) Finally, the Complainant denies any attempt to bully the Respondent.

7. Discussion and Findings

General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of the name or mark identical or similar to the Domain Name; and
- (ii) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

Evidence

The Complainant has chosen not to file any documentary evidence in support of its Complaint. Further, the Complaint itself provides little information in support of the assertion that the Complainant owns rights in the title “Royal Marines” and provides no grounds in support of the allegation that this is an Abusive Registration.

Whether an Expert can rely upon the Complaint itself as evidence has been previously considered in *Blue Martini Software Ltd v Propheesysoft* (3/12/01). In that Dispute, the appointed Expert concluded that it could be relied upon, provided a Certifying Statement was made, and in this case it has been made. The Expert agrees with the conclusion reached by the appointed Expert in that case.

The Complaint is plainly defective under paragraph 3 of the Dispute Resolution Procedure. It does not state why the Domain Name should be considered to be an Abusive Registration in the hands of the Respondent, nor discuss any applicable aspects of paragraph 3 of the Policy and provides little justification for filing the Complaint, and does not attach any documentary evidence relied upon, including, in this case, even the pending trade mark application. No evidence was provided about the Complainant’s website, nor about other websites and domain names concerning, or including, the title “Royal Marines”.

However, the Expert has to consider to what extent this has been rectified by the very full Response filed by the Complainant to the Respondent’s Reply. The Expert believes that the Response dated 30 May 2002, has rectified some of the problems with the Complaint, but not all of them. The Complainant has still failed to file any of documentary evidence. However, the Response does at least set out reasons why the Complainant believes this to be an Abusive Registration, and more information is provided as to why the Complainant believes it has rights in the title “Royal Marines”.

The Complainant’s Rights

As indicated above, the Complainant has asserted that it has rights in the title “Royal Marines”. This is identical or similar to the Domain Name, discounting the first (.uk) and second (.co) levels of the Domain Name.

There are no registered Rights. The Complainant is the Royal Marines Secretariat and the Expert is not satisfied that the Royal Marines Secretariat owns any unregistered rights in the title “Royal Marines”. It may well be that the Secretary of State for Defence owns unregistered rights in this title, but the Secretary of State for Defence is not the Complainant. Indeed, in his Response to the Respondent’s Reply, Mr Shae asserts that it is the Secretary of State for Defence who owns passing off rights in the “Royal Marines” title, but no information is provided as to the relationship between

the Complainant (the Royal Marines Secretariat) and the Secretary of State for Defence.

For these reasons, the Expert finds that the Complainant has failed to establish that it has rights in respect of the name or mark which is identical or similar to the Domain Name. The Complaint, therefore, fails.

Abusive Registration

An Abusive Registration is defined in paragraph 1 of the Policy 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.

Under (i) above, it is crucial that abusive conduct should be present at the time of Registration.

As the Expert has set out above, there are a number of other domain names which include the title "Royal Marines" which have been registered by other Registrants, and which are wholly unconnected to the Complainant or the Secretary of State for Defence. When the Respondent registered this Domain Name the Expert believes he was aware of such other domain names and that he genuinely believed that the Complainant did not have any exclusive right to ownership of all domain names which included the title "Royal Marines". The Expert, therefore, finds that this was not an Abusive Registration under paragraph 1(i) of the Policy.

The grounds set out in paragraph 1(ii) of the Policy are not so restrictive. A non-exhaustive list of factors which may be evidence of an Abusive Registration are set out in paragraph 3 of the Policy. They are:

- 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 dependently verified that the Respondent has given false contact details to us.

The Complaint itself did not direct its contentions to any of the above factors. However, some of these factors were addressed in the Complainant's Response to the Respondent's Reply. The Expert will, therefore, address each one in turn.

Selling, etc.

There is evidence to suggest that the Respondent has attempted to sell or rent the Domain Name other than to the Complainant. Indeed, the Respondent in his Reply confirms that he "*bought this domain with an idea in mind or as an investment*". The Expert assumes that a reference to "*an investment*" means that he had in mind that one possibility was to sell the Domain Name. Plainly, there were many other domain names being sold from this website as on 21 May 2002. He also confirms that the Domain Name was up for sale because he states "*I have now moved it from being up for sale...*". However, the Expert is satisfied that this was only one possibility, and that even if the Domain Name was for sale, the Respondent had it in mind to sell it to another Royal Marine or ex-Royal Marine as an information site for Royal Marines.

The Expert finds the Respondent's email exchange with Hugh Gallacher on 29 March 2002 to be compelling evidence. Mr Gallacher said that he wanted free usage of the site as an information base for friends and families of 45 Commando Royal Marines currently deployed on operational duties in Afghanistan. The Respondent's email reply was that this was a great reason for using the site and that he would provide free hosting and free email addresses. He does appear to have been excited by the prospect of Mr Gallacher's use of the website. This email exchange was, of course, several

weeks before the Complaint was filed. The Expert is, therefore, satisfied that the Respondent did not register or acquire the Domain Name “primarily” for the purpose of selling, renting or transferring the Domain Name. This may have been one possibility, but the Expert believes that the Respondent registered the Domain Name “primarily” for the purpose of using the website himself, or having someone else use the website, to exchange information about the Royal Marines.

Confusion

Evidence required under this is that of actual confusion. However, there is no claim or evidence that the public has been confused into believing that they have been dealing with, or communicating with, the Complainant’s official website.

Pattern of Abuse

There is evidence of other domain names being sold by the Respondent at this website, which the Expert has already referred to. Some of the domain names appear to be for adult websites. However, there is no evidence that any other party owns rights in any of the domain names being sold and, therefore, there is no evidence that any of the other domain names being sold are, in fact, Abusive Registrations.

The factors contained in paragraph 3 of the Policy are non-exhaustive. However, the Complainant has not put forward any additional factors and the Expert is not aware of any additional evidence that would support the finding that the Domain Name has taken “unfair advantage” or was “unfairly detrimental” to the Complainant’s rights.

It is also the case that the Respondent may demonstrate in his Response that the Domain Name is not an Abusive Registration. Paragraph 4 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration as follows:-

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:
 - i. Before being informed of the Complainant’s dispute, the Respondent has:
 - A used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;

- B been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
 - C made legitimate non-commercial or fair use of the Domain Name; or
- ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it.

The Expert believes that, before being informed of the Complainant's Dispute, the Respondent had made demonstrable preparations to use the Domain Name in connection with a genuine information site about the Royal Marines.

Paragraph 4 of the Policy does not include (in the non-exhaustive list of factors), any use being made of the Domain Name since receipt of the Complainant's Complaint. However, this is a non-exhaustive list, and the Expert believes in this case that he can take account of the use of the Domain Name which is currently being made by the Respondent. The use which is currently being made is that of an information site about the Royal Marines, and this is consistent with all the other evidence which has been filed concerning the Respondent's intentions.

Other Matters

The Expert has considered what would happen if a new Complaint was filed by the Secretary of State for Defence, either before or after the trade mark application has been registered, claiming registered or unregistered rights in the mark "Royal Marines", and what would happen if this new Complaint complied with the Policy in setting out grounds and evidence in support of the Complaint.

In the Expert's view, any new Complaint would also fail. Plainly, there is at least one other website providing information about the Royal Marines. The Expert can understand why current or ex-Royal Marines would want to have such an information website. The Expert believes that this is fair use of a domain name which incorporates the title "Royal Marines". The Royal Marines do have an official website at www.royalnavy.mod.uk. The Expert does not believe that the public will be confused into believing that all domain names which include the title "Royal Marines" will all have an official connection to the Secretary of State for Defence. The Expert believes that, at the time of the Registration of this Domain Name, the Respondent intended to either use the Domain Name himself as an information site for Royal Marines, or to sell or rent the Domain Name to another current or ex-Royal Marine who would use it for similar purposes.

8. Decision

For the reasons set out above, in the Expert's opinion, the Complainant has failed to prove on the balance of probabilities that:

- (i) it has Rights in respect of the 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.

The Complaint, therefore, fails.

Nick Rose

15 July 2002