

# Nominet UK Dispute Resolution Service

**DRS 00080**

## **Scottish Police Federation -v- Rolf Carlin**

### Decision of Independent Expert

#### **1. Parties:**

Complainant: Scottish Police Federation  
Address: 5 Woodside Place  
Glasgow  
Postcode: G3 7QF  
Country: GB

Respondent: Mr Rolf Carlin  
Address: The Old Manse  
38 Alloa Road  
Carron  
Falkirk  
Stirlingshire  
Postcode: FK2 8EP  
Country: GB

#### **2. Domain Name:**

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

#### **3. Procedural Background:**

The complaint was lodged with Nominet on 5 November 2001. On 7 November 2001 Nominet validated the complaint and notified the Respondent of the complaint by letter and email, at the same time informing him that he had 15 days within which to lodge a response.

On 8 November 2001 the Respondent telephoned Nominet to make an enquiry in connection with the complaint. However, he failed to submit a response. Mediation not being possible in those circumstances, Nominet so informed the Complainant and on 3 December 2001 the Complainant paid Nominet the appropriate fee for a decision of an expert in accordance with paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

On 6 December 2001 Adam Taylor, 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 that ought to be drawn to the attention of the parties which might appear to call into question his independence and/or impartiality.

On 13 December 2001 the Expert requested a further statement and supporting documents from the Complainant concerning the rights claimed in the name “Scottish Police Federation”. This request was made in accordance with paragraph 13a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”). The Expert directed that the Respondent be given an opportunity to respond to any further such statement.

On 18 December 2001 a further statement and supporting documents were received from the Complainant in response to this request.

No response to the further statement was received from the Respondent.

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

The Respondent has not submitted a response to the complaint to Nominet in time (or at all) in compliance with paragraph 5a of the Procedure.

The Expert has seen the copy communications from Nominet to the Respondent and has no reason to doubt that the Respondent has been properly notified of the complaint in accordance with paragraph 2 of the Procedure. Indeed the Respondent telephoned Nominet with an enquiry concerning the complaint the day after it was sent to him and is therefore aware of it.

Paragraph 15b of the Procedure states that “If, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint.”

There is no evidence of exceptional circumstances and the Expert will now proceed to a decision on the complaint.

The lack of a response does not entitle the Complainant to the equivalent of a default judgment. The Complainant must still prove its case to the required degree. The Expert will evaluate the Complainant’s evidence on its own merits and draw reasonable inferences from it in accordance with paragraph 12b of the Policy: “The Expert shall determine the admissibility, relevance, materiality and weight of the evidence.”

Further, 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 ... the Expert, the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate.” The Expert draws such inferences from the Respondent’s non-compliance as are specified below.

#### **5. The Facts:**

Section 1 of the Police Act 1919 established the Complainant (“a Police Federation for Scotland”) to represent members of the police forces of Scotland in all matters affecting their welfare and efficiency other than questions of discipline (later relaxed in respect of

representation in certain disciplinary proceedings) and promotion. The Federation was to be independent of any body or person outside the police service. Section 2 of the 1919 Act made membership of trade unions unlawful for members of the police force.

Various later Acts, including section 44 of the Police Act 1964 and section 59 of the Police Act 1996, provided for the continuation of the “Police Federation for Scotland”.

In fact the Complainant calls itself the “Scottish Police Federation”. It is not clear whether the Complainant has done so from day one but the Expert infers from the available evidence that it has used and been known by that name for many years.

The Complainant says that it is consulted at national (British) level by government in the form of the Home Office and other departments and at Scottish level by the Justice Department, and other organs of the Scottish Executive, as well as by a range of extra-parliamentary bodies. The consultation extends to matters which have a wider ambit than the activities and role of police officers, for example a proposed Right to Information Act.

The Complainant communicates regularly with the Police Advisory Board for Scotland (a statutory body advising the Secretary of State for Scotland on general questions concerning the police in Scotland), the Police Negotiating Board for the United Kingdom (a statutory body for negotiation of various issues between members of the police and police authorities), the Staff Side Committee (a subcommittee of the Police Negotiating Board) and the Police Arbitration Tribunal (whose basis is not specified but which is said to consist of arbitrators appointed by the Prime Minister).

In performance of its statutory duties the Complainant participates in a welfare service for serving and former police officers suffering physical, psychological, emotional and financial difficulties. It provides advice and assistance including legal representation for police officers in many areas such as disciplinary proceedings, entitlement to pension and state benefits, financial advice, employment issues and pursuing or defending court proceedings. The Complainant also carries out research into health and safety issues such as the effect of sleep deprivation in shift patterns and it provides a range of training for police representatives.

On 12 April 2000 the Respondent registered the Domain Name.

The Respondent is unconnected with the Complainant.

The Respondent also registered the domain names “scottishpolicefederation.com”, “scottishpolicefederation.org” and “scottishpolicefederation.net”. The Complainant does not say when but “whois” searches by the Expert show that it was on 17 August 2001.

A printout dated 7 November 2001, included in the bundle of papers supplied by Nominet to the Expert, shows the website at [www.scottishpolicefederation.co.uk](http://www.scottishpolicefederation.co.uk) diverting to the parking page of a domain registration company.

When checked by the Expert on 19 December 2001, “scottishpolicefederation.com”, “scottishpolicefederation.org” and “scottishpolicefederation.net” all diverted to similar parking pages.

There is no evidence of any communications between the parties in relation to the Domain Name.

## **6. The Parties’ Contentions:**

**Complaint:**

The Complaint is short and the relevant part reads as follows:

- “ 1. The Scottish Police Federation was established as an official body by the Police Act 1919. The respondent has no connection with the organisation.
2. It is our view that Mr. Rolf Carlin’s registration of scottishpolicefederation.co.uk, (and scottishpolicefederation.com, scottishpolicefederation.net, and scottishpolicefederation.org.) are abusive registrations from the point of view of paragraph 3.B of the DRS Policy “as a blocking registration against a name or mark in which the complainant has Rights” and also paragraph 3.C.iii, “the respondent is engaged in a pattern of making abusive registrations”. We realise that our dispute over the .com, .net, and .org registrations will require to be taken up via the ICANN UDRP, however we cite these registrations as evidence of a pattern of abuse.”

**Response:**

The Respondent has not responded.

**Further Statement of Complainant:**

The Complainant submitted a further statement in response to the Expert’s request for clarification of the rights claimed in the name “Scottish Police Federation”. The Complainant’s further contentions, so far as they relate to the request, are:

1. The Complainant has exclusive rights in the name “Scottish Police Federation” by virtue of its own nature and constitution. Under English law and its Scottish equivalent, the Complainant has a right to prohibit persons or organisations unconnected with the Complainant from using the name “Scottish Police Federation”, apart from any rights relating to “passing off”.
2. The name “Scottish Police Federation” was bestowed upon the Complainant by the Police Act 1919 and by implication the exclusive right to use that name was also bestowed. Only the organisation created by statute has the right to use the name.
3. There is a public interest and a public policy argument whereby persons unconnected with the Complainant should be prohibited from using its name. There is scope for serious harm to any member of the Complainant or external body relying on advice purportedly given by the Complainant but actually given by someone else using the name “Scottish Police Federation”.
4. The Complainant has generated substantial goodwill in the name “Scottish Police Federation” both in relation to its own members and to members of organisations with which it deals. That goodwill could be seriously prejudiced by careless comments made by any other person or organisation using the name.
5. The rights claimed are enforceable under English law, in particular by injunction prohibiting use of the name or display or information using that name.

**Response to the Complainant’s Further Statement:**

The Respondent has not responded to the Complainant’s further statement.

## **7. Discussion and Findings:**

### **General**

To succeed in this Complaint the Complainant has to prove to the Expert in accordance with 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, second, 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**

Paragraph 1 of the Policy defines rights as including, but not being limited to, rights enforceable under English law (but excluding names or terms which are wholly descriptive of a complainant's business).

What kind of rights in the name "Scottish Police Federation" must the Complainant demonstrate here?

Clearly a UK registered trade mark would suffice but none is relied upon.

Under English law, rights in a name are also enforceable in a "passing off" action where the complaining party has, amongst other things, acquired goodwill in that name. Such rights are based not on registration but on use.

The Complainant clearly has sufficient rights under the Policy if it can demonstrate goodwill in the name "Scottish Police Federation" as would entitle it to maintain a passing off action in respect of the name (subject to the English law issue mentioned below). In the Expert's view it does not need to show that such an action would succeed against the Respondent, simply that it has the goodwill that is an essential (though not the only) requirement of passing off.

Although passing off was originally concerned with trading activities, organisations such as the Law Society, the Institute of Chartered Accountants of England & Wales and the British Medical Association have been held entitled to take passing off actions. Kerly on Trademarks and Tradenames (13<sup>th</sup> edition) says at paragraph 14-42: "It is clear that a professional association of sufficient standing may sue to prevent others imitating ... its name ..."

The evidence of the Complainant's extensive activities under its name for many years satisfies the Expert that it has goodwill in the name "Scottish Police Federation" as would entitle it to maintain a passing off action in respect of the name.

If the Complainant has goodwill in England or Wales, then the rights are probably "enforceable under English law" for the purposes of the Policy and automatically caught by the Policy's inclusive definition of "rights". The evidence of the Complainant's engagement with national government suggests that there is goodwill in England.

However, it is not necessary to decide this. Even if the Complainant's rights are technically not enforceable under English law, the Expert's view is that equivalent rights in Scotland nevertheless suffice under the Policy given that the Dispute Resolution Service is concerned with domain names denoting the United Kingdom.

Nor is it necessary to decide whether the Complainant has rights in the name “Scottish Police Federation” independent of passing off.

The name “Scottish Police Federation” is identical to the Domain Name. The domain suffix can be disregarded for comparison purposes.

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

### **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.”

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.

The Complainant relies first on the factor in paragraph 3a.i.B:

- “ i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name: ...
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; ...”

As was stated in *Eli Lilly and Company v David Clayton* (DRS 0001), the issue here is whether the Respondent registered the Domain for the purpose of blocking the Complainant.

The Complainant gives no reasons in the complaint in support of its assertion of a blocking registration and, as is common in default cases, there is no direct evidence of the Respondent's purpose. However, the Expert can draw reasonable inferences from the available evidence.

The Expert notes:

1. The Domain Name is so closely connected to the Complainant that it is difficult to conceive of a genuine purpose that anyone not connected with the Complainant could have for registering it. (One exception is perhaps intended use as a criticism or even a tribute website but there is no such evidence here, the Respondent would not need four domain names for that purpose and in any case the burden would then shift to the Respondent under paragraph 4b of the Policy as the Domain Name is identical to the Respondent's name).
2. The Respondent is not connected with the Complainant and the Complainant has not consented to the Respondent's registration of the Domain Name.
3. The Respondent, who provided a Scottish address on registration, clearly had the Complainant in mind when he registered the Domain Name.

4. The Respondent does not appear to have used the Domain Name for the purpose of a website although he registered it as long ago as April 2000. (Paragraph 3b of the Policy prevents this fact alone constituting evidence of abusive registration but that does not stop it being taken into account in conjunction with other evidence).
5. The Respondent has registered three other domain names comprising the name “Scottish Police Federation”: scottishpolicefederation.com, scottishpolicefederation.org and scottishpolicefederation.net. The Respondent does not appear to have used those domain names for the purposes of websites.
6. The Respondent has not taken up the opportunity provided by these proceedings to explain his purpose in registering the Domain Name.

Possibly the Respondent hoped that, if he sat on the name for long enough, the Complainant would eventually come along and buy it from him for a substantial sum. Or perhaps the Respondent had a grudge against the Complainant.

But, whatever his ulterior motive, the six numbered points listed above taken together suggest to the Expert that the Respondent’s dominant purpose at the time of registration was to stop the Complainant doing whatever it may have wanted to do with the Domain Name.

These six points are therefore circumstances indicating that the Respondent registered the Domain Name for the purpose of blocking the Complainant against a name in which it has rights.

The Complainant has established the factor in paragraph 3a.i.B.

The Complainant also relies upon the factor in paragraph 3a.iii:

- “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”

The Expert is satisfied that the Respondent’s registration of the three other domain names comprising the Complainant’s name constitutes a pattern of making abusive registrations. The other five numbered points listed above taken together are additional circumstances indicating that the Domain Name is an abusive registration.

The Complainant has established the factor in paragraph 3a.iii.

The Expert is satisfied that those two factors are evidence that the Domain Name is an abusive registration in the sense that it was registered in a manner which took unfair advantage of the Complainant’s rights in its name.

Paragraphs 3a.i.B and 3a.iii are, however, merely part of a non-exhaustive list of factors. Even if those two specific factors had not been proven, the Expert is in any case satisfied that the six numbered points listed above taken together are themselves evidence that the Domain Name is such an abusive registration.

There is no evidence that the Domain Name is not an abusive registration, either from the Respondent or otherwise on the record.

The Expert finds that on the balance of probabilities the Domain Name is an abusive registration in that it was registered in a manner which took unfair advantage of the Complainant's rights in its name.

### **Remedy**

The Complainant seeks "to have the domain name cancelled i.e. put beyond registration, or failing that transferred to the complainant."

Paragraph 10a of the Policy anticipates a decision that the Domain Name may be "cancelled, suspended, transferred or otherwise amended".

Neither cancellation nor suspension would put Domain Name beyond registration. Cancellation would make it available for registration by anyone. Suspension would render the Domain Name unusable but it would stay registered in the name of the Respondent.

In the Expert's view this Domain Name should be transferred to the Complainant's control.

### **8. Decision:**

The domain name scottishpolicefederation.co.uk should be transferred to the Complainant.

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Adam Taylor

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Date