

**NOMINET UK DISPUTE RESOLUTION SERVICE**

**DRS 00074**

**DECISION OF INDEPENDENT EXPERT**

**1. Parties**

Complainant	:	Televes UK Ltd
Address	:	Unit 11, Hill Street Industrial Estate Cwmbran Gwent
Postcode	:	NP44 7PG
Country	:	UK
Respondent	:	Adam Barrington
Address	:	370 Jessop Road Stevenage Herts
Postcode	:	SG1 5ND
Country	:	UK

**2. Domain Name**

televes.co.uk (“the Domain Name”)

**3. Procedural Background**

The Complaint was lodged with Nominet on 29 October 2001. Nominet validated the Complaint and notified the Respondent on 2 November 2001 and informed the Respondent by post and e-mail that he had 15 working days within which to respond to the Complaint. The Respondent failed to respond. Mediation was therefore not possible. Nominet so informed the Complainant and Respondent on 28 November 2001, and on 11 December 2001 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On 19 December 2001 Robert Elliott, 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**

The Respondent has not submitted a Response to Nominet in time (or at all) in compliance with paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”).

The Complainant, in its letter of 7 December 2001, purported to expand upon its Complaint in the respects which are detailed below in section 6. Paragraph 13 of the Procedure provides inter alia that “The Expert will not be obliged to consider any statements or documents from the Parties which he or she has not received according to the Policy or this Procedure or which he or she has not requested.” The Complainant’s submissions in its letter of 7 December 2001 were not made in accordance with the Policy. Nevertheless, and bearing in mind that the Complainant appears not to have had professional representation in making its Complaint, the Expert proposes to consider those further submissions as set out below. At the Expert’s request, and in accordance with paragraph 13 of the Procedure which also permits the Expert to request further documents or statements from the parties, Nominet sent the Respondent a copy of those further submissions on 20<sup>th</sup> December 2001 by post and by e-mail, and invited him to comment by 4<sup>th</sup> January 2002. The Respondent has failed to do so.

The Complaint in this matter is thin, and the evidence in support is scant. In preparing his Decision, the Expert has himself conducted some limited research into publicly available records, namely an inspection of the Complainant’s parent company’s website, an on-line search of the UK Trade Marks Registry in respect of the mark TELEVES, a WHOIS search in respect of the domain name “aerialsystems.com”, and an inspection of the website at [www.aerialsystems.com](http://www.aerialsystems.com). The Expert has also had regard to the decision of the expert in respect of the domain name [blakeaerials.co.uk](http://blakeaerials.co.uk) which is referred to in section 5 below. Although the Expert is directed by paragraph 16a of the Procedure to “decide a complaint on the basis of the Parties’ submissions, the Policy and the Procedure”, the Expert considers that he may have regard to readily available public records in reaching his Decision in an appropriate case when such material appears likely to be relevant and has therefore done so in this case.

Paragraph 15b of the Procedure provides, inter alia, that “If, in the absence of exceptional circumstances, a Party does not comply with any time period set down in the Policy or this Procedure, the Expert shall proceed to a Decision on the Complaint.”

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, the Expert will draw such inferences from the Party’s non compliance as he or she considers appropriate”.

There is no evidence before the Expert to indicate the presence of exceptional circumstances. The Expert will therefore proceed to a Decision on the

Complaint notwithstanding the absence of a Response. The inferences which have been drawn from non-compliance are explained below.

## 5. **The Facts**

The Complainant is Televes UK Limited. The Complainant states that it is a subsidiary of Televes SA, and has been trading in the United Kingdom since 23 September 1988. No further details are given in the Complaint about the Complainant's business. A search on the Televes SA website (found at [www.televes.com](http://www.televes.com)) reveals that Televes SA, a Spanish company, was apparently founded in 1958, and has grown, as a group, to "an annual turnover of in excess of 70M USD", with over 500 employees. The website also identifies the Complainant as its United Kingdom sales and marketing outlet.

The Complainant's parent company's activity (or perhaps that of its group) is described on its website as "R&D, design, manufacturing, quality control, and the sales and marketing of all products for the reception and distribution of TV signals."

The Complaint describes the Complainant's parent company, Televes SA, as the owner of the "televes brand". The Complaint refers to a registered trade mark for "televes" but does not provide a copy, identify the owner, or detail the goods or services covered, save as "Class 9 International". An on-line search of the UK trade marks registry confirms that the mark TELEVES is registered in Class 9 in the name of Televes SA, in respect of "Telephonic and telecommunication apparatus; radio and television apparatus; television and sound aerials; apparatus for detecting and amplifying, recording, transmission or reproduction of sound or images; parts and fittings included in Class 9 for the aforesaid goods." The registration was last renewed in October 1992 and appears current.

The Domain Name was registered on 16 February 2000. Nothing is provided in the Complaint about the proprietor, Adam Barrington. Nominet has provided his contact details. The Expert notes, however, that a Mr Adam Barrington, with the same contact details, was also the Respondent to a similar complaint to this one, by Blake Aerials Limited (DRS 00049) in which the Expert appointed concluded by a Decision dated 3<sup>rd</sup> December 2001 that the registration of the domain name in question "blakeaerials.co.uk" was an Abusive Registration. The domain name in that case was pointed to the site [www.aerialsystems.com](http://www.aerialsystems.com) (as to which see below). The operator of the [www.aerialsystems.com](http://www.aerialsystems.com) site, a customer of the complainant (a manufacturer of radio and television aerials), appears to have denied any connection between the operator of the site and the Respondent.

In early 2001 it would appear from the documents annexed to the Complaint that accessing the website through the Domain Name led to a message that the website was under construction. No contemporaneous record of the site at that time has been provided. However, although this information is not contained in the Complaint, at the time of the Complaint, and as at 14<sup>th</sup>

December 2001, the Domain Name pointed to a site operated under the name of “Aerial Systems” ([www.aerialsystems.com](http://www.aerialsystems.com)). Aerial Systems describe themselves as “TV FM Satellite Aerial Specialist”, but do not provide contact details on the website other than a telephone number. They claim to be “the UK’s largest independent installers of TV/FM aerial equipment and Sky Satellite systems as well as many other different services.” There is no indication of their corporate identity although the “Company” is said to have been established in 1967.

An Internet Names Worldwide WHOIS search for aerialsystems.com shows the proprietor as “Aerial Systems/Adam Barrington”, the registration date being 15 February 2000. The contact address given is the same as the Respondent’s.

On 9 January 2001 the Respondent e-mailed Mr Botas of the Complainant as follows: “televes.co.uk Are you still interested in the above domain name? I am considering offers made by another company. Are you interested in making an offer?” The Expert has not been provided with details of any previous discussions or correspondence between the parties.

## **6. The Parties Contentions**

### **Complainant**

The original Complaint is short and the relevant part is as follows: “Mr Adam Barrington has registered the domain televes.co.uk without any authorization from our company. Our clients think it is ours and we are getting e-mails lost because our UK customers think that it belongs to us. Some months ago he sent me an e-mail trying to sell it to us. As you can appreciate this situation is very uncomfortable.” The Complaint is signed by the Managing Director of the Complainant, Hugo Botas.

Three e-mails are attached to the Complaint, apparently from customers trying to access the televes.co.uk website in January/February 2001, believing it to be associated with the Complainant, but complaining that they were receiving a “site under construction” message.

On 7 December 2001 the Complainant wrote to Nominet, enclosing payment of the required fee for the appointment of an Expert. The letter was signed by Mr Botas. The letter indicated “the arguments we put forward to have the domain TELEVES.CO.UK cancelled from its current holder is now based in four issues:

1. Televes was registered in the UK’s Patent Office, Trade Marks Registry on 1<sup>st</sup> May 1987 and renewed 27<sup>th</sup> August 1992, no 1250881. In other words, the name cannot be used without our approving it.
2. We have received complaints from clients because they are trying to use the web TELEVES.CO.UK thinking it belongs to us, and they get something totally different. This is creating a lot of confusion in our

trade. (I have sent to you copies of e-mail sent to us from various companies.)

3. Because some clients are automatically associating TELEVES.CO.UK with us some confidential e-mails are getting lost; some people associate that web with our e-mail address (I have clients supporting this, details will be provided if need it).
4. When you call the people using that domain, they give the wrong information over the telephone, sometimes saying that they are us or they work for us (attached is one recent proof sent to us by a client) and probably even worse things that we do not know about it.”

The attachment referred to in paragraph 4 was not in fact attached, but has subsequently been provided throughout Nominet at the Expert’s request. It is an e-mail dated 13<sup>th</sup> November 2001 from Jennifer Coulson (apparently from “Merseyside Satellite”) to Mr Botas and reads as follows: “How come Televes.co.uk has been hijacked by a satellite and aerial installation company who masquerade as your installers? Try contacting them as a private individual and listen to their reaction when asked if they are Televes. Interesting ..... or am I just unlucky?”.

Although the Complainant’s letter of 7 December 2001 refers to cancellation, the Complaint itself seeks transfer of the Domain Name to the Complainant.

### **Respondent**

The Respondent has not responded.

## **7. Discussion and Findings**

### **General**

The Complainant must prove its case to the Expert on the balance of probabilities (paragraph 2.b, Policy). It must prove two elements: firstly that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; secondly that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Both “Rights” and “Abusive Registration” are defined in paragraph 1 of the Policy.

### **Complainant’s Rights**

The Complainant is not the registered proprietor of the UK registered trade mark TELEVES: the proprietor is its parent company Televes SA. Nevertheless it appears from that company’s website that the Complainant has at least a licence to use the mark and name within the United Kingdom, and to do so on behalf of and with the parent company’s consent.

“Rights” as defined in the Policy “includes, but is not limited to, rights enforceable under English law”. The Complainant, has not addressed itself to

the question of how it, rather than its parent, has rights in the TELEVES name. Nor has it submitted material which might commonly have been made available in such circumstances, such as evidence of its own reputation, goodwill, and promotional expenditure. However, such material as is available suggests that the Complainant has traded under its existing name in the United Kingdom since 1988, and will undoubtedly have acquired a trade reputation in that time. Therefore, the Expert considers that the Complainant on the basis of the material in its Complaint (which has not been contested by the Respondent), and on the basis of the publicly available material, has established on the balance of probabilities that it has rights in the TELEVES name or mark which would be enforceable under the English Common Law action of passing off.

### **Comparison of the Complainant's Rights and the Domain Name**

The Expert finds that the Complainant has rights in respect of a name or mark, which is identical to the Domain Name. The first and second level suffixes (“.co” and “.uk”) are purely functional parts of the Domain Name, and are essentially irrelevant to a comparison of the name/mark and the Domain Name, which are otherwise identical.

### **Abusive Registration**

The Policy (paragraph 3) contains a non-exhaustive list of factors which may be evidence of an Abusive Registration. Although the Complaint is not specifically addressed to any of those factors, to the Expert the following appear to be in issue:

- A** Circumstances indicating that the Respondent has registered 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 (paragraph 3.a.i.A of the Policy); and
- B** 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 (paragraph 3.a.ii of the Policy).

As to A, the evidence submitted by the Complainant is very thin, but at the same time it is unchallenged by the Respondent. The Complaint itself refers to an attempt by the Respondent to sell the Domain Name to the Complainant. It attaches the e-mail of 9 January 2001 from Adam Barrington (see 5 above) which refers to “offers made by another company”, and asks whether the Complainant is interested in making an offer.

The Expert's view is that, even uncontradicted, such evidence does not demonstrate the necessary primary purpose for the registration to be found to be an Abusive Registration on this ground alone. There is no evidence as to the level of offer being sought, and no explanation of the circumstances leading to the e-mail from Mr Barrington of 9 January 2001. Without such evidence, to draw any firm conclusions in the absence of other evidence which could have been provided, would be unwarranted speculation.

It is apparent from the WHOIS search in respect of the domain name aerialsystems.com that Mr Barrington (the Respondent), and the trading entity Aerial Systems are connected in some way (the denial of any connection reported in the blakeaerials.co.uk decision appears unsupportable particularly in light of the similarities between that matter and this case). Aerial Systems apparently trades in a field which is very close to the Complainant's or the Complainant's customers. The Domain Name was apparently registered one day after the aerialsystems.com domain and the Domain Name now points to the site attached to that domain. The TELEVES mark or name does not appear to the Expert to be in any way descriptive or in common usage within the United Kingdom otherwise than to describe the goods sold by the Complainant, and registration of the Domain Name would therefore appear likely to have been in the knowledge that the TELEVES brand name was owned by the Spanish company Televes SA and used by its group. However, without any clear evidence of an intention on the part of the Respondent to register the Domain Name primarily for the purposes of selling for valuable consideration in excess of out-of-pocket cost, any suspicions concerning the Respondent's motives do not, in the Expert's view, add to the evidence put forward by the Complainant in this respect.

As to B, the Complainant's evidence is again very thin. The three e-mails from what appear to be customers of the Complainant in January and February 2001 are essentially irrelevant for the purposes of considering the nature of the Respondent's use of the Domain Name. They demonstrate frustration at finding a site under construction, but the "confusion" is caused, it seems to the Expert, solely by the similarity of the Domain Name and the Complainant's trading name, combined (perhaps) with an assumption that the Domain Name belongs to the Complainant. There is nothing to show how such an assumption arose, and nothing to link it to the Respondent other than its proprietorship of the Domain Name.

The original Complaint refers to e-mails being lost, but gives no other details. Again, this bare assertion cannot be regarded as evidence of use by the Respondent which is intended to confuse.

The Complainant's letter to Nominet of 7 December 2001 adds to the Complaint in some respects. It is a document which had not originally been seen by the Respondent, and which is outside the Policy or the Procedure. However, the Respondent has specifically been given a further opportunity to comment upon it and its attachment, and has not done so.

Paragraph 2 of the letter appears to repeat the Complaint, and cross-refers to the e-mails already discussed above. This therefore does not add to the Complaint in any meaningful way.

Paragraph 3 of the letter essentially repeats the bare assertion of the e-mails being lost, and although evidence is said to be available, none is produced. It is not the role of the Expert to conduct an enquiry. Although the Expert has power to ask for further statements or documents from the Parties (paragraph 13a of the Procedure), he/she is not obliged to do so, and in the Expert's view, even in the case of a Party apparently without professional assistance in preparing the Complaint, it should only be in exceptional cases that a Party should be invited to produce evidence which could easily have been produced at the time of the Complaint.

Paragraph 4 of the letter (and its attachment), however, introduce a new element which is missing from the original Complaint, and which potentially has a considerable bearing on the factor set out at paragraph 3.1.ii of the Policy. The assertion is of deliberately confusing use of the Domain Name which, if proven, would clearly take the registration within the bounds of paragraph 3.1.ii of the Policy. The e-mail from the customer, Merseyside Satellite is a little cryptic, but nevertheless to the Expert clearly intends to report an intention by Aerial Systems to confuse customers by leading them to believe that Aerial Systems are authorized installers of the Complainant's products, and therefore connected with the Complainant. As has already been indicated, there appears to be a clear link between Aerial Systems and the Respondent (see the WHOIS search on "aerialsystems.com", and also the similar facts revealed in the blakeaerials.co.uk. Decision).

The Respondent chose not to respond to the Complaint (which did not make these specific assertions). However, he has also not responded to the specific invitation to comment upon the letter of 7<sup>th</sup> December 2001 and its attachment. Although, as has already been noted, such submissions by the Complainant were not made in accordance with the Policy, they are clearly relevant to the question which the Expert has to determine. The Expert is satisfied that the Respondent has had sufficient opportunity to comment on such matters, had he wished to do so. Therefore, the Expert proposes to rely on such matters in reaching his decision.

The Expert considers that, in the absence of any response, the facts asserted in paragraph 4 of the letter of 7<sup>th</sup> December 2001 and its attachment are proven on the balance of probabilities. In the light of these matters, and in the light of the similar facts revealed in the "blakeaerials.co.uk" decision, the Expert therefore concludes that the Domain Name is being used by the Respondent in a way which has confused people or businesses into believing that the Domain Name is operated or authorized by or otherwise connected with the Complainant.

In the light of this conclusion, both on its own and taken with the other material referred to above, the Expert finds that the Domain Name is an Abusive Registration.



8. **Decision**

The Expert finds that the Complainant has Rights in the name TELEVES, that the name in which the Complainant has rights is identical to the Domain Name, and that the Domain Name is an Abusive Registration in the hands of the Respondent.

The Complainant seeks transfer of the Domain Name to the Complainant. This seems to the Expert to be the appropriate remedy in the light of the foregoing findings and the Expert therefore directs that the Domain Name televes.co.uk be transferred to the Complainant.

**Robert G. Elliott**

**10<sup>th</sup> January 2002**