

Nominet UK Dispute Resolution Service

DRS 00161

Ufi Limited v iNET Learning Limited

Decision of Independent Expert

**1. Parties**

Complainant: Ufi Limited  
Address: Dearing House  
1 Young Street  
Sheffield  
Postcode: S1 4UP  
Country: GB  
Respondent: iNET Learning Limited  
Address: 2 Leicester Way  
Eaglescliffe  
Stockton on Tees  
Postcode: TS16 0LP  
Country: GB

**2. Domain Names**

mylearndirect.co.uk  
letslearndirect.co.uk  
yourlearndirect.co.uk

("the domain names")

**3. Procedural Background**

The complaint was notified to Nominet on 12 December 2001 and received in full by Nominet on 17 December 2001. Nominet checked that it complied with the Nominet UK Dispute Resolution Service Policy ("the Policy") and the Procedure for the conduct of proceedings under the Dispute Resolution Service ("the Procedure"). Nominet notified the Respondent of the Complaint on 17 December 2001, and informed the Respondent that it had 15 days within which to lodge a response. The Respondent failed to respond. In accordance with paragraph 5 d of the Procedure,

therefore, Nominet notified the parties that an Expert would be appointed on receipt from the Complainant of the applicable fees.

Under Paragraph 21 c of the Procedure, the Complainant had 10 days, from receipt of notice from Nominet that an Expert was to be appointed, to pay the fees. That 10 day period expired on 28 January 2002. On 28 January the complainant sent a cheque by recorded delivery to Nominet for a decision of an Expert in accordance with paragraph 6 of the Policy. The Complainant also sent a copy of the cheque by fax, on the understanding (based on a telephone conversation with Nominet) that this would meet the deadline. The Complainant offered, if its understanding was incorrect, to arrange for the cheque to be delivered by courier the same day. The cheque arrived at Nominet's offices on 29 January 2002. As the Complainant's intention to proceed with the complaint were clear, and it confirmed its payment of the fee within the 10 days allowed by the Procedure, Nominet did not deem the complaint to be withdrawn under Paragraph 21 c of the Procedure.

On 1 February 2002, Mark de Brunner ("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 or impartiality.

#### **4. Outstanding Formal/Procedural Issues**

Paragraph 5 of the Procedure requires the Respondent to submit a response to Nominet within 15 days of the start of proceedings under the Dispute Resolution Service.

Paragraph 15b of the Procedure provides, among other things, that if, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or the Procedure, the Expert will proceed to a decision on the complaint. There is no evidence before the Expert to indicate the presence of exceptional circumstances.

Under paragraph 15 c if, in the absence of exceptional circumstances, a party does not comply with any provision in the Policy or the Procedure, the Expert will draw such inferences from the party's non-compliance as he or she considers appropriate. Here, the Expert draws no special inferences from the absence of a response to the complaint. But there are two important, linked, principles (see *Eli Lilly and Company v David Clayton*: DRS 0001) underpinning the approach to the decision in cases where the Respondent has forgone the opportunity to bring out evidence that a domain name is not an abusive registration:

(i) on the one hand, the Complainant's assertions of fact are not to be accepted as fact simply because the absence of a response leaves them unchallenged. The requirement of paragraph 12 b of the Procedure remains, and it is for Expert to determine the admissibility, relevance, materiality and weight of the evidence. The next following section reflects those assertions that the Expert accepts as facts.

(ii) on the other hand, where the Complainant makes out a prima facie case, the Respondent has a case to answer. If there is no answer, the complaint will ordinarily succeed.

## **5. The Facts**

The Complainant provides distance learning programmes throughout the UK under the brand LEARNDIRECT. It operates a website at the URL [www.learndirect.co.uk](http://www.learndirect.co.uk), runs a telephone helpline, and licenses use of the name LEARNDIRECT to educational institutions offering its training courses. On 18 October 1999, the Complainant applied to have LEARNDIRECT registered as a Community Trade Mark for, among other things, training and teaching services, and the provision of on-line education facilities. The application was successful.

The website was launched in March 2000 and now receives over 1 million hits a month. The helpline opened in November 1999 and now receives an average of 135,000 calls a month.

The Respondent offers training services through a contact telephone number. It registered the domain names mylearndirect.co.uk and letslearndirect.co.uk on 19 June 2001, and the domain name yourlearndirect.co.uk on 21 June 2001.

There was initially a webpage at mylearndirect.co.uk. Traffic to letslearndirect.co.uk and yourlearndirect.co.uk, on the other hand, was simply redirected to another website – one that was either owned by or associated with the Respondent.

On 7 September 2001, through its solicitors, the Complainant wrote to the Respondent drawing attention to its rights in the trade mark LEARNDIRECT and requesting transfer of the domain name mylearndirect.co.uk.

The webpage at mylearndirect.co.uk was taken down, but traffic to that URL was redirected to the same site as traffic to letslearndirect.co.uk and yourlearndirect.co.uk.

In subsequent correspondence the Respondent agreed to transfer all three domain names to the Complainant. It did not, however, effect the transfer.

## **6. The Parties' Contentions**

### *Complainant*

The Complainant's contentions can be summarised as follows.

(i) The use of the trade mark LEARNDIRECT as the brand component of the URL for the website, and the oral use of the trade mark for the helpline, has established LEARNDIRECT as one of the best known brands in the education and training sector. The Complainant has built up a substantial reputation and goodwill in the trade mark.

(ii) On the website, and in promotional material for the website and helpline, the Complainant has adopted a distinctive style for the word LEARNDIRECT. The mylearndirect.co.uk homepage was strikingly similar to the Complainant's website, because of the colour, style and font of the word MYLEARNDIRECT. Adoption of the brand and visual style by another training provider could not be accidental.

(iii) The Respondent has used the domain name mylearndirect.co.uk in a way which has confused people into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. A complaint to the LEARNDIRECT helpline came from a member of the public who had dealt with the Respondent under the misapprehension that the Respondent was the Complainant or was connected with the Complainant.

(iv) The registration of the domain names by the Respondent was an attempt either to leech business from the Complainant, or unfairly to disrupt the Complainant's business.

(v) The Respondent's agreement to transfer the domain names supports the Complainant's view of the Respondent's possible motives.

(vi) The failure by the Respondent to effect the transfer as agreed is further evidence of its bad faith.

### *Respondent*

The Respondent has not responded.

## **7. Discussion and Findings**

### *General*

To succeed in this complaint the Complainant must prove to the Expert, on the balance of probabilities, that

- (i) the Complainant has rights in respect of a name or mark which is identical or similar to the domain names; and
- (ii) the domain names, in the hands of the Respondent, are abusive registrations.

### *Complainant's Rights*

The Complainant has registered LEARNDIRECT as a trade mark. The Respondent has not at any stage sought to challenge the Complainant's rights in respect of the mark LEARNDIRECT. The Expert therefore accepts, on the balance of probabilities, that the Complainant has rights in respect of the mark LEARNDIRECT.

The domain names which are the subject of proceedings, however, are mylearndirect.co.uk, letslearndirect.co.uk and yourlearndirect.co.uk. The mark in which the Complainant has rights is identical to none of the domain names. But is it

similar to them? The domain names all contain LEARNDIRECT. It seems to the Expert that MY, LETS and YOUR are prefixes that – so far as they have an effect at all - increase the emphasis on LEARNDIRECT. On any reasonable view, they do not render LEARNDIRECT and the domain names dissimilar. There is evidence that the domain name mylearndirect.co.uk has been confused with the mark LEARNDIRECT. It seems reasonable to infer that other people have found mylearndirect.co.uk, letslearndirect.co.uk and yourlearndirect.co.uk similar to learndirect.co.uk. The Expert finds that the Complainant has rights in respect of a mark which is similar to the domain names at issue.

### *Abusive Registration*

The Dispute Resolution Service rules define an 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.

The Policy contains a non-exhaustive list of factors that may be evidence that the domain name is an abusive registration.

There is no evidence that the Respondent registered the domain names primarily for the purpose of transferring them to the Complainant for valuable consideration in excess of its costs in acquiring or using the domain names. Indeed the Respondent appeared to be willing to transfer the names for a nominal fee.

Nor is there evidence that these were blocking registrations against a mark in which the Complainant has rights. If they had been intended as blocking registrations, they would presumably have been slightly out of position: the Complainant had already registered a domain name identical to its trade mark.

The Complainant has not sought to prove that the Respondent is engaged in a pattern of making abusive registrations

There is no suggestion that the Respondent has given false contact details.

Within the non-exhaustive list there are however two factors that may be directly relevant: circumstances indicating that the Respondent

- (i) has registered the domain name primarily for the purpose of unfairly disrupting the business of the Complainant; or
- (ii) 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.

These are essentially the claims of the Complainant.

Evidence has been submitted that the homepage at the URL [mylearndirect.co.uk](http://mylearndirect.co.uk) was altered to look 'strikingly similar' to the Complainant's home page. This is disputed in correspondence between the parties preceding the complaint to Nominet, but the Expert accepts that the style of the letters making up the name MYLEARNDIRECT is indeed very similar to the style that the Complainant has adopted for the word LEARNDIRECT. There may be reasons for that which would not justify the claim that the registration of the domain names by the Respondent, operating a business in the same field as the Complainant, was an attempt unfairly to disrupt the Complainant's business or – by confusing people - to leech business from the Complainant. But no such reasons have been suggested.

It could perhaps be argued that since the homepage before alteration was not 'strikingly similar' to the Complainant's homepage, the registration was not primarily for the purpose of unfair disruption. But the Expert would not accept that argument, on the basis that taking time to give effect to a purpose does not, of itself, change the purpose.

The Complainant says that the adoption of its brand and visual style by another training provider could not be accidental. It was intended to confuse. As rendered in the non-exhaustive list (of factors that might be evidence that a domain name is an abusive registration), the question is not one of intention but whether confusion has in fact occurred. The Complainant has submitted evidence that at least one person was confused into believing that the domain name [mylearndirect.co.uk](http://mylearndirect.co.uk) was connected with the Complainant. It seems reasonable to infer that others were confused too. The Expert accepts that people have been confused.

It seems to the Expert, therefore, that

- (i) an arguable case has been made out that [mylearndirect.co.uk](http://mylearndirect.co.uk) was registered primarily for the purpose of unfairly disrupting the business of the Complainant
- (ii) the Respondent was using the domain name in a way which confused people into believing that the domain name is connected with the Complainant.

So much for [mylearndirect.co.uk](http://mylearndirect.co.uk). What about [yourlearndirect.co.uk](http://yourlearndirect.co.uk) and [letslearndirect.co.uk](http://letslearndirect.co.uk)? Their position is less clear-cut. But it is possible to draw conclusions from the circumstances of registration. They were registered at the time of or very soon after the registration of [mylearndirect.co.uk](http://mylearndirect.co.uk). Like [mylearndirect.co.uk](http://mylearndirect.co.uk), the names are variations on [learndirect.co.uk](http://learndirect.co.uk). Like later traffic to [mylearndirect.co.uk](http://mylearndirect.co.uk), traffic to both URLs was directed to a site owned by or associated with the Respondent. The Expert infers that the circumstances of [mylearndirect.co.uk](http://mylearndirect.co.uk)'s registration colour the registration of [yourlearndirect.co.uk](http://yourlearndirect.co.uk) and [letslearndirect.co.uk](http://letslearndirect.co.uk)

The Complainant claims that the Respondent's agreement to transfer the domain names supports the Complainant's view of the Respondent's possible motives. It

seems to the Expert that the agreement to transfer the domain names could point equally to the absence of any motive unfairly to disrupt the business of the Complainant. Accordingly, the Expert draws no inference from the point.

The Complainant goes on to suggest that the failure by the Respondent to effect the transfer as agreed is further evidence of its bad faith. There may be circumstances in which general evidence of bad faith is a factor that may suggest a registration is abusive. But in this case it seems to the Expert unhelpful to speculate about whether the Respondent's inaction indicates bad faith generally or, if it does, what light that might throw on the nature of the domain name registration. We simply do not know why the transfer was not, in the event effected.

The onus is on the Complainant to prove that the domain names are abusive registrations. Where the Complainant shows that there is a case to answer, and no answer is given, the Complainant's case will ordinarily succeed. Here there is a case to answer: there is clear evidence of confusion and an arguable case that the Respondent registered the domain names primarily for the purpose of unfairly disrupting the Complainant's business. The Expert therefore concludes, on the balance of probabilities, that the domain names, in the hands of the Respondent, are abusive registrations.

## **8. Decision**

The Expert finds that the Complainant has rights in respect of a mark which is similar to the domain names, and that the domain names, in the hands of the Respondent, are abusive registrations.

In the light of those findings, the Expert directs that the domain names [mylearndirect.co.uk](http://mylearndirect.co.uk), [letslearndirect.co.uk](http://letslearndirect.co.uk) and [yourlearndirect.co.uk](http://yourlearndirect.co.uk) be transferred to the Complainant.

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**Mark de Brunner**

**17 February 2002**