

NOMINET UK DISPUTE RESOLUTION SERVICE

DRS 00145

VISTA COMPUTER SERVICES LIMITED

- AND -

ANKOSTUFF LIMITED

RE: VISTACOMP.CO.UK

*Decision of Independent Expert*

**Parties:**

Complainant: Vista Computer Services Limited

Address: Valency House  
Batchworth Lane  
Northwood  
Middlesex HA6 3HD  
United Kingdom

Represented by: Mr David Hansel  
Memery Crystal  
31 Southampton Row  
London WC1B 5HT  
United Kingdom

Respondent: AnkoStuff Limited  
20-22 Bedford Row  
London WC1R 4JS  
United Kingdom

Represented by: Mr. Robin Tobin, director

**Domain Name:**

Vistacomp.co.uk

## **Abbreviations used in this decision:**

<b>Abbreviation</b>	<b>Definition</b>
The Domain Name	vistacomp.co.uk
The .com Domain Name	vistacomp.com
Vista Intl.	Vista International, a US company, parent company of the VISTA UK
Vista UK	Vista Computer Services Limited, the Complainant
Anko	AnkoStuff Limited, the Respondent
The .com Website	<a href="http://www.vistacomp.com">Http://www.vistacomp.com</a>
AnkoStuff's Website	<a href="http://www.anko.co.uk">Http://www.anko.co.uk</a>
DRS	Nominet UK's Dispute Resolution Service
DRS Policy	Nominet UK's Dispute Resolution Service Policy

## **Procedural Background:**

1. The Complaint was lodged with Nominet on 6th December 2001. Nominet validated the Complaint and notified AnkoStuff of it on 11th December, 2001 and informed AnkoStuff that it had 15 working days within which to lodge a Response. A Response was lodged by AnkoStuff on 3rd January 2002, within the time period allowed. A Reply was lodged by Vista UK on 15th January 2002, within the time period allowed.
2. Mediation was apparently attempted, but failed. I have not been provided with any details of the mediation process. Accordingly, on 4th February 2002, Vista UK 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”).
3. On 5th February 2002, Kirsten Houghton, the undersigned, (“the Expert”) confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

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

4. None.

### **The Facts:**

#### *The Parties - the Complainant*

5. VISTA UK is a UK subsidiary of VISTA Intl., an American company founded in 1977 and which is said to have built up a substantial reputation and goodwill as a worldwide provider of software services and solutions in the book publishing industry to its international customer base from offices in the UK, mainland Europe, North America and the Asia-Pacific region. Both companies trade as and are now referred to as "Vista".
6. Vista UK was incorporated on 14 May 1992, and is said to be a wholly-owned subsidiary of Vista Intl. Vista UK was formed to market and sell Vista Intl's services and solutions in the UK. Vista UK has offices in Buckinghamshire and employs 60-70 staff.
7. Vista UK's turnover was £5.4 million in 1998-1999, £6.6 million in 1999-2000 and is estimated to be £7.2 million in 2000-2001.
8. Vista Intl and Vista UK (and an Australian subsidiary) market their services and solutions at The .com Website, which has been open since 1997. The .com Domain Name was registered on 21 April 1995 on behalf of "Vista Computer Services", in Buckinghamshire, which I take to be Vista UK acting on behalf of itself and the other Vista group companies.

#### *The Parties - the Respondent*

9. AnkoStuff is newly formed company, incorporated in August 2001. It asserts that it has as its purpose the development and marketing of publishing management solutions primarily to small to medium sized publishers both in the UK and the US.

10. Although AnkoStuff itself is new, its employees and shareholders have apparently been in the business of the provision of publishing management solutions and other services (both on a freelance basis and as in-house employees) largely but not exclusively for legal publishers over the course of a number of years.
  
11. The extent of AnkoStuff's business is not clear, and no trading, marketing or budget information has been provided. I have seen some evidence to the effect that AnkoStuff has advertised its services on e-mail bulletins issued by "theBookseller.com".

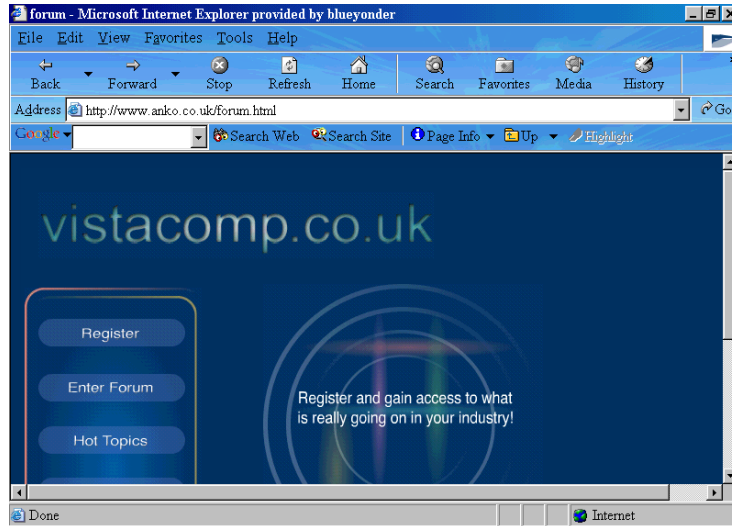
### *Chronology*

<b>Date</b>	<b>Event</b>
/ /77	Vista Intl. Founded in the US
16/3/90	"VISTA" registered as a trademark for class 9 services (no. 1210742)
14/5/92	Vista UK incorporated
6/7/94	"VISTA" registered as a trademark for class 16 services (no. 1231798)
13/7/94	Trademarks 1210742 and 1231798 assigned to Vista UK
21/4/95	.com Domain Name registered by one of the Vista entities (contact address on the "whois" search is at the UK offices)
/ /97	The .com Website opened by Vista Intl and Vista UK
4/7/00	Mr. Tobin registers anko.co.uk
3/8/01	AnkoStuff incorporated
15/10/01	Mr. Iorio, said to be from Corporate Investment Int'l, contacts AnkoStuff for information by e-mail,
25/10/01	AnkoStuff seeks pricing information from Vista
31/10/01	Mr. Tobin e-mails Fintan Fitzpatrick of Vista UK informing him that AnkoStuff would like to use images of Vista's products in its marketing material and asking for "any specific objections"
1/11/01	Mr. Martin Puttock of Vista UK e-mails Mr. Tobin asking him to telephone him.
1/11/01	Mr. Tobin contacts Mr. Puttock of Vista UK by telephone from a restaurant asking to use images of Vista products in its marketing material
2/11/01	Mr. Tobin sends Mr. Puttock an e-mail confirming his request of the previous day
9/11/01	E-mail and Letter Memory Crystal to AnkoStuff concerning alleged

<b>Date</b>	<b>Event</b>
	libellous material and material reproduced in breach of copyright on AnkoStuff's Website
10/11/01	AnkoStuff register the Domain Name using Fasthosts The Domain Name is used to direct users to AnkoStuff's Website
11/11/01	Mr. Tobin replies to Memery Crystal in the following terms: <p>"...However, to assist your client and the publishing community in general, we are intending to provide a forum (<a href="http://www.vistacomp.co.uk">http://www.vistacomp.co.uk</a>) for a constructive exchange of views for your clients customers as well as, of course, very generously giving your client some free additional exposure. We may then all accurately gauge whether phrases that your client takes the inaccurate view are directed solely at them are 'fair and true' or not. AnkoStuff Limited will follow the consensus view from that forum. We hope to get the forum up and running in the course of the next few weeks."</p>
14/11/01	Letter Memery Crystal to AnkoStuff: <p>"We note that on 10th November 2001 you registered the Domain Name. The only plausible reason for you having registered the Domain Name is that you did so in bad faith. This is identical to our client's long registered top level domain name and you have no right to register it. It is liable to cause confusion and mislead our client's existing and prospective customers into believing the Website is owned or licensed by our client. Furthermore, you are seeking to gain an unfair advantage by an increased number of "free" website hits and exposure to potential new customers. Accordingly any use by you of the Dornain Name will constitute an actionable passing off.</p> <p>Our client is prepared to pay £100 to a charity of its choice and to prepare all necessary forms for the Domain Name to be transferred to it. Kindly confirm whether or not you will consent to such an assignment."</p>
15/11/01	E-mail AnkoStuff to Memery Crystal: <p>"With specific reference to the issue of the domain name (<a href="http://vistacomp.co.uk">vistacomp.co.uk</a>) for which AnkoStuff Limited holds the registration. There is no intention to in anyway be associated with your client and its products, indeed the thought is more than a little embarrassing to us, so we will remove the reference which takes users to our own temporary site.</p> <p>We do however take issue with your ridiculous suggestion that we had no right to do so. It was a currently unregistered name and we registered it -as we think you will find we are perfectly entitled to do. We have clearly explained the purpose for this registration, so we will not repeat ourselves here. Your clients, of course, were perfectly entitled to register the domain but chose not to do so. If you wish to take this matter further then we suggest you follow the agreed procedure for such disputes. If your clients wishes to purchase this particular domain from us, in order to attempt to avoid the dispute process then, we suggest that they tender an offer which we will, of course, consider on its commercial merit at any such time.</p> <p>We look forward to hearing from you that this matter is now at a close, in default you have our address for service, we strongly suggest you either use t or allow us to get on with the running of our business."</p> <p>At some point, the Domain Name is directed to the Red Cross website.</p>

Date	Event
4/12/01	<p data-bbox="414 246 702 282">Exchange of e-mails:</p> <p data-bbox="414 302 821 338">Memery Crystal to AnkoStuff:</p> <p data-bbox="414 353 1361 439">"In a last attempt to settle this matter amicably, our client maintains its offer to pay £100 to a charity of your choice, and will prepare the documentation necessary to transfer the ownership of the Domain Name from AnkoStuff Limited to Vista Computer Services Limited.</p> <p data-bbox="414 454 1361 517">In addition, our client offers you a sum equal to your out-of-pocket costs directly associated with acquiring or using the Domain Name.</p> <p data-bbox="414 533 1361 595">In relation to what you say as to establishing a forum for your marketing, we would strongly suggest you first take legal advice in order to avoid infringing any rights of our client."</p> <p data-bbox="414 611 821 647">AnkoStuff to Memery Crystal:</p> <p data-bbox="414 663 1361 792">"With reference to our previous e-mail communications, I think I made it quite clear that the eventual purpose of this domain name is as a forum for publishers to exchange views etc regarding their requirements for publishing solutions. We undertake to do no more than host the forum, i.e. no marketing material, links, logos and so forth. This is surely for the benefit the whole publishing industry including of course your client.</p> <p data-bbox="414 808 1361 871">Indeed, in that spirit, we immediately, once you had notified us, as to the possible confusion that may ensue, removed the redirect to our own site.</p> <p data-bbox="414 887 1361 1016">However, in the interests of settling this now prolonged distraction1 we will agree to transfer the domain to your client for a sum approximating (as far, of course, as one can) the satisfaction and enjoyment we would be giving up. We estimate this sum to be £7,500 + VAT. Together with £500 to a charity of our choice. We will canvas, our staff and let you know the consensus on the charity.</p> <p data-bbox="414 1032 1361 1086">Once, we have had notification that we are in receipt of cleared funds the IPS tag will be released to your client."</p>
10/12/01	<p data-bbox="414 1102 1361 1164">The Domain Name by now directs users to the "Dilbert Comic Strip Archive" at <a href="http://www.unitedmedia.com/comics/dilbert/archive">http://www.unitedmedia.com/comics/dilbert/archive</a></p>
17/12/01	<p data-bbox="414 1189 1361 1296">Offensive e-mail AnkoStuff to Memery Crystal indicating that the correspondence has been shown to publishers, distributors, employees of (Vista Intl) and journalists here and in the US.</p>
27/12/01	<p data-bbox="414 1321 1361 1464">Offensive e-mail from Mr. Tobin to Memery Crystal referring to Mr. Tom Henson as "young Tom", "Tommy Boy" and "a bit of a knob about things"; threatening to take correspondence to "the pub with our friends from Clifford Chance, Denton Hall, the Law Society etc.</p>
4/2/02	<p data-bbox="414 1480 1361 1585">E-mail AnkoStuff to Nominet indicating that Mr. Tobin and "Tim" have accepted an offer from a 3rd party for the Domain Name and requesting a transfer.</p>

<b>Date</b>	<b>Event</b>
5/2/02	The Domain Name by now directs users to a "forum" "home page" in AnkoStuff's Website at <a href="http://www.anko.co.uk/forum.html">http://www.anko.co.uk/forum.html</a>



All buttons currently link to The .com Website.

### **The Parties' contentions:**

#### *Complainant:*

12. **Relevant rights:** For the purposes of the DRS Policy Scheme, "rights" are defined as including but not limited to rights enforceable under English Law. Vista UK relies upon both its reputation and goodwill and upon certain UK trademarks in the name "Vista" in order to establish Rights in respect of a name or a mark which is identical or similar to the Domain Name which entitles it to the protection offered by the DRS.
  
13. In addition to the matters set out in Paragraphs 5 to 8 above, Vista UK asserts that it spends very substantial sums annually promoting its services and solutions. Vista UK places great value on the relationships it builds with customers, industry associations and other technology leaders. It participates in publishing industry communities such as the Book Industry Council, Book Industry Study Group and international standards bodies and is a sponsor of the British Book Award for Supply Chain Performer of the Year.

14. Vista's customers include some of the largest publishers in the world such as HarperCollins, Holtzbrinck Publishers, Macmillan and divisions of Reed Elsevier and Wolters Kluwer. This has established Vista as a company with a strong reputation and an established and well-known goodwill worldwide.
15. I have been provided with see testimonials given by Vista's customers, press releases, evidence of media coverage and case studies, all of which are exhibited as part of the .com Website.
16. Vista UK asserts that part of that reputation and goodwill attaches to and is derived from the .com Domain Name and the .com Website and that it relies on the .com Domain Name and the .com Website to attract business.
17. In the Complaint, no attempt is made by Vista UK to attribute any particular element of these assertions to Vista UK itself. However, I am satisfied that, in practice, little distinction is drawn between the US, UK and Australian companies so far as marketing and reputation is concerned, since they sell the same product range, and that any good will which attaches to the .com Domain Name and the .com Website attaches to each of the companies equally.
18. Vista UK is the registered proprietor of two trade marks for the word "VISTA" in the UK. Trade Mark Registration Number 1210742 registered on 16 March 1990 is for goods and services listed in class 9 and Trade Mark Registration Number 1231798 registered on 13 May 1994 is for goods and services listed in class 16.
19. I accept that Vista UK has rights, enforceable under English Law, in the word "Vista" by reason both of its reputation and goodwill and its trademarks.
20. However, the Domain Name is a combination of Vista UK's trademark with the addition of the suffix "comp" to it. Accordingly, I must determine whether Vista UK has acquired by reputation and goodwill rights in the word "vistacomp" which could be protected at English Law, or whether the word



"vistacomp" is sufficiently similar to Vista, in which Vista UK undoubtedly has rights, to enable Vista UK to fall within the class of persons intended to be protected by the DRS.

21. I have considered the decisions of the experts in DRS 00068 (nokiagsm.co.uk) and DRS 00058 (nokiaringtones.co.uk). In my view, whilst the suffix "comp" cannot be said to be "purely descriptive" (since it is actually meaningless, although is probably intended to be an abbreviation of the word "computers"), the operative part of the Domain Name is identical to Vista UK's trademark name, and accordingly, I find that the Domain Name is sufficiently similar to protected name for the purposes of Clause 2(a)(i) of the DRS Policy.

22. In addition, I also find that Vista UK has rights enforceable at English Law, by reason of reputation and build-up of good will since 1997, in the name "vistacomp". It seems to me that the use of this word as a name for an operative website, in a field (publishing) which is familiar with and to some extent now depends on internet access and products, is analogous to the use of a "*nom de plume*" and that, accordingly, Vista UK would probably be entitled to enforce its right to the word in order to prevent passing off in appropriate circumstances.

23. ***Abusive Registration:*** Vista UK must establish, on the balance of probabilities, that the Domain Name, in the hands of AnkoStuff, is an abusive registration. Abusive Registration is defined in the DRS 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."

24. Clause 3 of the DRS Policy sets out a non-exhaustive list of factors to which I may have regard in determining whether the registration of the Domain Name is abusive in the hands of AnkoStuff:

- (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..."

25. Vista UK asserts that this registration is abusive in the hands of AnkoStuff in the following ways:

- (a) AnkoStuff has registered the .co.uk Domain Name primarily for the purposes of selling, renting or otherwise transferring the .co.uk Domain Name to VISTA or to a competitor of VISTA, for valuable consideration in excess of AnkoStuff's documented out-of-pocket costs directly associated with acquiring or using the .co.uk Domain Name.

***Support:***

- (i) VISTA's offer of 14 November 2001 was declined by AnkoStuff who in its reply of 15 November 2001 stated that, 'If your clients wishes (sic) to purchase this particular domain from us, in order to attempt to avoid the dispute process then, we suggest that they (VISTA) tender an offer which we will, of course, consider on its commercial merit at any such time.'
- (ii) VISTA's further offer of 4 December 2001 included an offer to pay AnkoStuff's documented out-of-pocket costs directly associated with acquiring or using the .co.uk Domain Name.

- (iii) This was also declined by AnkoStuff who requested payment of the sum of £7,500 plus VAT together with the payment of £500 to a charity of AnkoStuff's choice.
  - (iv) This is, Vista UK asserts, clear evidence of an intention by AnkoStuff to derive financial gain from the registration of the .co.uk Domain Name.
- (b) AnkoStuff has registered the .co.uk Domain Name as a blocking registration against a name or mark in which VISTA has Rights.

***Support:***

- (i) When AnkoStuff registered the .co.uk Domain Name, it knew of the existence of VISTA's Rights. AnkoStuff comments in its e-mail of 15 November 2001 in relation to the .co.uk Domain Name that, 'It was a currently unregistered name and we registered it – as we think you will find we are perfectly entitled to do.....Your clients of course, were perfectly entitled to register the domain but chose not to do so.'
- (ii) VISTA is considering creating a localised version of the VISTA website to promote the VISTA brand in the UK.
- (iii) AnkoStuff's registration of the .co.uk Domain Name is a blocking registration preventing VISTA from using the .co.uk Domain Name as an address for its proposed UK website and setting up e-mail addresses for its employees at @vistacomp.co.uk.
- (iv) AnkoStuff's e-mails of 11 and 15 November 2001 both indicate that AnkoStuff's employees are receiving e-mail at @vistacomp.co.uk.

- (c) AnkoStuff has registered the .co.uk Domain Name primarily for the purpose of unfairly disrupting VISTA's business.

***Support:***

- (i) AnkoStuff's business and AnkoStuff's Website appear to be in the very early stages of development. On AnkoStuff's Website AnkoStuff's mission statement boldly declares that it intends 'to produce cross platform solutions which reflect the way publishing actually works and are within the reach of all'. AnkoStuff's Website refers to services and solutions that AnkoStuff is developing. However, these services and solutions are not yet available for sale and there is little indication as to when they will be.
- (ii) It is submitted that AnkoStuff has illegitimately used the .co.uk Domain Name as part of its overall strategy to enhance awareness of its "coming to market" which has unfairly disrupted VISTA's business for the following alternative reasons:-
- (A) the individuals behind AnkoStuff have clearly worked in the publishing industry and are aware of VISTA's Rights. Their awareness that VISTA had already registered the .com Domain Name and consequently that registration of the .co.uk Domain Name would contravene VISTA's Rights is evidence that the registration was made to disrupt VISTA's business and amounts to an abusive registration.
- (B) The .co.uk Domain Name was registered on behalf of AnkoStuff the day after VISTA first raised the issue of the contents of AnkoStuff's Website. The registration was clearly made to disrupt VISTA's business in retaliation to Memery Crystal's letter of 9 November

2001 and/or was pre-planned to cause maximum disruption.

- (C) The .co.uk Domain Name was directly linked to AnkoStuff's Website. Thus, Internet users using the .co.uk Domain Name were taken to AnkoStuff's Website directly. Following Memery Crystal's letter of 14 November 2001 the .co.uk Domain Name re-directed Internet users to the International Red Cross website at <http://www.redcross.org>. AnkoStuff admitted that it was responsible for the direct link to AnkoStuff's Website in its e-mail of 15 November 2001 when it stated that, 'There is no intention to in anyway (sic) be associated with your client and its products, indeed the thought is more than a little embarrassing to us, so we will remove the reference which takes users to our own temporary site.'
- (D) This diverting action is evidence that AnkoStuff registered the .co.uk Domain Name primarily for the purpose of unfairly disrupting the business of VISTA. VISTA's current and potential customers may mistakenly access AnkoStuff's Website when typing in "www.vistacomp.co.uk" in error instead of "www.vistacomp.com". This gives AnkoStuff an unfair advantage by an increased number of "free" website hits and exposure to new customers by attracting Internet users to AnkoStuff's Website for commercial gain. Further, AnkoStuff may inadvertently intercept e-mail designed to go to VISTA. AnkoStuff can still re-direct VISTA's current and potential customers from the .co.uk Domain Name to AnkoStuff's Website at any time while they own the .co.uk Domain Name.

- (E) AnkoStuff stated in its e-mail of 30 October 2001 that ‘they intend to aggressively market our solutions and would like to use some images generated from your (VISTAs) publishing solutions as a comparison’. This indicates that AnkoStuff registered the .co.uk Domain Name to obtain leverage with VISTA to encourage a prospective business arrangement in bad faith.
  - (F) This is further demonstrated in AnkoStuff’s reply of 15 November 2001 when AnkoStuff suggests it will listen to offers of ‘commercial merit’ to sell the .co.uk Domain Name and its counter-offer of 4 December 2001. This disrupts VISTA’s business as VISTA waste time, energy and financial resources dealing with matters arising from the infringement of VISTA’s Rights.
- (d) VISTA believes that AnkoStuff is using the .co.uk Domain Name in a way which has confused people or businesses into believing that the .co.uk Domain Name is registered to, operated or authorised by, or otherwise connected with VISTA.

***Support***

- (i) As outlined above, AnkoStuff directly linked the .co.uk Domain Name to AnkoStuff’s Website which advertises competing services and solutions. This direct link is liable to confuse people or businesses into believing that the .co.uk Domain Name was registered to, operated by or authorised by, or otherwise in connection with VISTA.
- (ii) AnkoStuff’s continued ownership of the .co.uk Domain Name also confuses people or businesses into believing that the .co.uk Domain Name is registered to, operated by or authorised by, or otherwise connected with VISTA. There is a likelihood that

AnkoStuff will re-direct the .co.uk Domain Name to AnkoStuff's Website while they are registered owners of it.

- (iii) VISTA's trade marks are distinctive of the services and solutions that VISTA sell. The use of the word "VISTA" in the .co.uk Domain Name means that the .co.uk Domain Name is similar to VISTA's trade marks. AnkoStuff purports to offer the same services and solutions and compete in the same market as VISTA.

*Respondent:*

26. AnkoStuff's Response centres on 4 arguments:

- (a) Concerning the timing of the registration:
- (b) Concerning its intention to set up a forum as a service for the publishing industry
- (c) Denying any intention to make a commercial gain from the registration and
- (d) Asserting that Vista UK and Memery Crystal's actions are indicative of a threatening and bullying approach to those who threaten and aspire to compete in the same market.

27. I annex AnkoStuff's submissions to this Decision because they are difficult to distil into a series of answers to the complaints made. However, in summary, AnkoStuff asserts that:

- (a) This is not an abusive registration as there has been no intentional infringing of Vista UK's rights.
- (b) it would very much wish to be left with the domain as registered in order to produce a forum and resource for the entire publishing industry which will of course benefit Vista UK and would have no

direct or indirect commercial benefit for AnkoStuff, indeed would be a drain on its resources.

- (c) This complaint is simply a strand of Vista UK's attempt to hamper the coming to market of product in competition to that of its clients.

### **Discussion and Findings:**

28. *Selling or transfer the Domain Name* I do not consider that Vista UK has established on the balance of probabilities that the "primary" purpose behind AnkoStuff's registration of the Domain Name was in order to sell or transfer it for profit to Vista UK or a third party. For the reasons set out below, it appears to me that the primary purpose behind the registration was either to block Vista UK's own registration, or the mischievous and unfair use of the Domain Name by AnkoStuff to the detriment of Vista UK and its parent and sister companies.
29. I do however note the fact that AnkoStuff refused to agree to transfer the Domain Name to Vista UK despite the offer to pay the out of pocket expense, prepare the paperwork and make a modest charitable donations and that it indicated at an early stage that it was only prepared to consider transfer if a proposal of commercial merit was made, and then only for £7,500 together with a charitable donation of £500.
30. I also note that, apparently, Mr. Tobin and his business partner "Tim" appear to have agreed to sell or transfer the Domain Name to a 3rd Party over the course of the weekend of 2-3rd February 2002, during the course of the DRS Procedure and in contravention of clause 12 the DRS Policy. AnkoStuff and its directors, especially Mr. Tobin, are, or should be, aware of the contents of the DRS Policy, as they were sent it on 11th December 2001.
31. Whilst I do not consider that these facts prove on the balance of probabilities that the *primary* object of the registration was to transfer for profit, I do



consider that the above are evidence of abuse of the registration in the hands of AnkoStuff.

32. **Blocking Registration:** The registration is clearly a "blocking" registration and the circumstances outlined above indicate that AnkoStuff, probably opportunistically, acquired it as such.
33. AnkoStuff's assertion in its Response that it registered the Domain Name because Vista UK's name was "in the forefront of their minds" and they were aware of Vista UK's alleged intention to create a vistacomp.co.uk website of their own, supports this conclusion.
34. The term "blocking registration" is not defined in the DRS Policy and no element of "primary purpose" is required in order to satisfy the test set out in Clause 3(a)(1)(B), however, in the light of the chronology, it is my conclusion that one of the primary purposes behind the registration was to block Vista UK's ability to do so. It is proper, in my view, to regard this as a factor suggesting abuse.
35. I should say that I have attached no weight to Vista UK's assertion that it intends to set up a UK-specific website in reaching this decision. It seems to me on the evidence I have seen that, at the very highest, that is a possible future development, rather than a concrete development. In addition, I can find no evidence which suggests that AnkoStuff were actually informed of this by Vista UK or Memery Crystal prior to 10th November 2001, and, in the circumstances, I treat the assertion referred to in Paragraph 33 above as an admission of the blocking motive behind the registration.
36. Whilst this registration is, clearly, a blocking registration, I would not without more, find that the registration was clearly abusive in the hands of AnkoStuff. However, the tone and content of AnkoStuff's correspondence, its attempts to sell the Domain Name to Vista UK and/or a 3rd Party, its linking the Domain Name directly to its own site (as to which I note that the Domain Name again directs the use to the AnkoStuff Website), the link to the cartoon site, and the

frankly incredible explanations for these activities (based on allegations of "naivety") given in the Response, all persuade me that the registration is abusive in the hands of AnkoStuff:

37. ***Unfair disruption of Vista UK's business:*** It is asserted by Vista UK that the primary purpose of the registration was to unfairly disrupt its business. AnkoStuff's response is that its primary purpose was, and remains, the creation of a legitimate, non-profit making, open forum for the publishing business.
38. I reject AnkoStuff's contention. It is plain from the contemporaneous correspondence that the true intention behind the registration of the Domain Name was to gain some advantage over Vista UK in the negotiations which had resulted from the allegation of libel and breach of copyright which had been made by Memery Crystal on behalf of Vista UK, and to raise a threat of publication of further material, critical, and possibly libellous, to Vista UK, on the internet. It would be a fair inference from the tone and offensive language used in AnkoStuff's correspondence that the material which might appear if published would not be fairly or accurately represented.
39. I do not consider that AnkoStuff had (or has) any genuine intention to launch such a forum, and the suggestion that it would do so was mischievous. I note that, as at today's date, a page has appeared on the AnkoStuff Website purporting to be such a forum, but I consider that attempt at post-event legitimisation to be a sham.
40. In addition, AnkoStuff's admissions in correspondence that it has broadcast the facts of this dispute to Vista UK's customers and others connected with the publishing industry etc., also support the allegation that AnkoStuff's true intention is to seek to promote its own business by unfairly denigrating Vista and its product.
41. ***Confusion:*** I do not accept that Vista UK has proved on the balance of probabilities that the Domain Name has been used in a way which has confused people into believing that the Domain Name was connected with the

Defendant. Evidence of actual confusion is required to satisfy the test, and none has been provided.

42. *Use as a forum:* Discussion and criticism can, obviously, be fair use of a Domain Name. However, where the domain name is identical to the Domain Name in which the Complainant asserts rights, and the Complainant's permission has not been obtained, the burden of proving that the use is not abusive shifts to the Respondent, in accordance with Clause 4(b) of the DRS Policy.
43. If AnkoStuff really intended to set up a forum "for the publishing industry", it would have no need to do so under the name "vistacomp". In choosing a name which is identical to one in which Vista UK has Rights, in my view, even though the expressed purpose of the proposed forum was not to be critical of one "business" but rather of a generic business, AnkoStuff, in my view, falls foul of the spirit of this provision and, whilst not formally reversing the burden of proof, it does not appear to me that AnkoStuff has provided any legitimate reason for the registration of the Domain Name, or any convincing evidence of its intention to use it legitimately.
44. I reject the assertion that Vista UK or Memery Crystal are seeking unfairly to bully or threaten AnkoStuff on its entry to the market. I do not express any opinion concerning the original allegations of libel or breach of copyright, but it does appear to me that AnkoStuff deliberately incited the current dispute about the Domain Name in retaliation. In the light of AnkoStuff's obviously provocative attitude, it appears to me that the conduct of Vista UK and Memery Crystal has been a measured and entirely proper response to AnkoStuff's actions.

## **Decision**

45. In light of the foregoing findings, namely that Vista UK 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 AnkoStuff, is an Abusive Registration, the

Expert directs that the Domain Name, vistacomp.co.uk, be transferred to Vista UK.

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KIRSTEN HOUGHTON

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Date

## **The Response**

Complaint No.: 000145 Vista Computer Services Limited v AnkoStuff Limited 1)

Background - Company AnkoStuff Limited ('the company') is relatively newly formed company (see annex 1) and has as its purpose the development and marketing of publishing management solutions primarily to small to medium sized publishers both in the UK and the US. Although the company itself is new, the employees and shareholders have been in the business (both on a freelance basis and as in-house employees) of the provision of publishing management solutions and other services largely but not exclusively for legal publishers over the course of a number of years. Contrary to the statement in the complainants form ('AnkoStuff's Website refers to services and solutions that AnkoStuff is developing ... these services and solutions are not yet available for sale') our solutions are developed and are offered for sale (from end November 2001), see annex 2. 2) Background - Contact Between The Parties Our first contact with the complainant was on 15/10/2001 when we received an e-mail from Luke Lorio, the marketing manager of Vista (see annex 3, exhibit 1) posing as a potential customer asking for more details of our solutions. Our next contact was on the 25/10/2001 when we e-mailed the complainant to request some information on behalf of a client (see annex 3, exhibit 2) Thereafter, as a result of a number of failed attempts to illicit information on behalf of a client, we decided that a small part of our marketing strategy would be to highlight the inability of the complainant, Trilogy Computers Limited and Schilling A/S (fellow publishing solution providers) to respond to potential customers. We also at this time became aware that our now completed solution made those of our competitors look extremely 'old fashioned and out of touch'. We received advice that we could publish on our web site what were in effect comparative examples of database output, as copyright was extremely difficult in this area - the actual content was that of the publisher and the document in question had as it's very purpose the broadest dissemination possible of the information contained within it. And there was no intent to infringe the rights of the complainant and its fellow solution providers in the software itself. Notwithstanding our advice, we decided as a courtesy to the complainant to check whether they had any specific objections to our use of an such image (see annex 3, exhibit 3). In reponse to our e-mail, we received a phone call from a Martin Puttock (the European Sales Director for

the complainant), unfortunately, we were unable to take the call at the time, but I e-mailed him the next day to ask what his objections were (see annex 3, exhibit 4). In response we received a letter dated 9/11/2001 alleging that we had both defamed and breached the copyright of the complainant (see annex 3, exhibit 5). Our advice was that there was no defamation but in any event we slightly amended the text on our web site (see annex 4) to ensure that there could be no possible defamatory intent. Again our advice was that any copyright infringement was highly questionable and as the complainant's solicitor had not made out any specific argument that related to the actual infringement they alleged then we were perfectly justified in leaving the web site as it was. The complainant's solicitors letter of 9/11/2001, did however, set us thinking that perhaps this was a pattern of behaviour for the complainant and perhaps explained why the publishing solutions market is generally acknowledged to be under serviced. As a result, we decided to set up a forum for publishers and other industry companies and organisations to air their views on publishing technology and related issues. To that end we registered the domain in question as having just received the letter from their solicitor's their name was in the forefront of our minds and we assumed that as it was available despite the complainants assertion that it was considering a .co.uk site that this couldn't actually be the case as they had been in business for many years and hadn't bothered to register the domain previously. Indeed, we take issue with the assertion in their complaint's form that they are considering building a localised web site at the domain as any company in that situation, as a first measure, makes sure that the domain in question is currently available. The proposed forum as repeatedly stressed in the correspondence (see annex 3, exhibits 6, 11, 13, and 14) is not intended as a marketing vehicle for AnkoStuff Limited and will contain no references, logos etc. to AnkoStuff Limited or its solutions. Indeed, we invited the complainant to participate in the forum to underline that this is purely intended as a service to the publishing industry and in, no, way, shape or form to be of commercial benefit to ourselves. We also stress that the domain was not registered with the intent of commercial gain from any sale - we at no time approached the complainant offering to sell the domain - we simply asserted that in a hypothetical situation where the complainant having not exercised the option to register the domain during the course of many years suddenly felt the urge to do so we would wish to be compensated for the effort spent/satisfaction forgone from the running of the forum. It is and always has been the case that we would very much like

to not sell the domain but go ahead to use it as previously mentioned and hopefully benefit the wider publishing community. There is no intent to pass ourselves off as the complainant or gain from misdirections to our own web site as soon as it was pointed out that the redirection from vistacomp.co.uk to our site could be misconstrued and upon taking advice, we immediately redirected that domain's traffic to the Red Cross site. Indeed, as the complainant points out in the complaint form, we would indeed be very embarrassed to be associated with the complainant and its solutions as we have invested a great deal of time, energy and resource into the development of products which we believe to be incomparably superior and at a fraction of the cost. We have never used the e-mail addresses at vistacomp.co.uk nor is there any intention to do so these were simply quoted in an e-mail to the complainant largely we are sorry to say for our own amusement as we simply didn't take the complaints seriously particularly as the correspondence although marked urgent was clearly nothing of the sort, for example, we received correspondence on 15/11/2001 marked 'urgent' (see annex 3, exhibit 7) to which we replied by return. We then heard nothing further until 4/12/2001. The Issue Of Abusive Registration This was not an abusive registration. AnkoStuff Limited is a very new company so the idea that it registered the domain or otherwise acquired it in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the rights of a company which claims to be the largest in its particular market (we have to take the complainant's word for this as there has been no evidence of market share provided) must be quite clearly nonsense. We accept that due to our naivety the domain did redirect to our site. But as soon as this had been pointed out we corrected it immediately. Currently the domain redirects to the complainant's site and this will be the case until the initial work on the proposed forum is completed. So save for that incident and our misguided humour at including e-mail addresses which gave the false impression that we were receiving e-mail at the domain there has been and certainly will not be any attempt to take unfair advantage of or to be unfairly prejudicial to the complainant's rights. We certainly do not wish to gain monetarily from the domain, please note the complainant approached us and we simply responded in an attempt to put them off in order that we could keep the domain and continue work on the forum. For whatever reason the complainant and its solicitors have decided that the way to compete in the publishing solutions market is to threaten and bully those who aspire to enter. It is clear from the correspondence (see annex 3 generally) that the complainant's

solicitors have simply intended to stifle the coming to market of competing product. This in effect has amounted to little more than harassment as none of the complainant's allegations have ever been substantiated. But, please note that they are still continuing to look to issue further unsubstantiated allegations as we see them every day come on to our site (see annex 5). We confirm that the IP address 213.235.8.251 resolves to an address within the Memery Crystal domain of memerycrytsal.com. To be blunt, it is our view that this complaint is simply part of the same process. In Conclusion • This is not an abusive registration as there has been no intentional infringing of the complainant's rights. • We would very much wish to be left with the domain as registered in order to produce a forum and resource for the entire publishing industry which will of course benefit the complainant and would have no direct or indirect commercial benefit for AnkoStuff, indeed would be a drain on our resources. • This complaint (as evidenced by the correspondence at annex 3) is simply a strand of the complainant's attempt to hamper the coming to market of product in competition to that of it's clients.