

Nominet UK Dispute Resolution Service

DRS 2127

wishboneash.co.uk

Decision of Independent Expert

1. PARTIES:

Complainant: Mr Andrew Powell

Address: 81 Park Road
Wath Upon Deane
Rotherham
South Yorkshire

Postcode: S63 7LE

Country: GB

Complainant's Authorised Representative: Mr Patrick Cantrill
Walker Morris Solicitors

Respondent: Mr Martin Turner

Address: Tall Timbers
8 Beech Lane
Guildford
Surrey

Postcode: GU2 4ES

Country: GB

Respondent's Authorised Representative: None

2. DOMAIN NAME:

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

3. PROCEDURAL BACKGROUND:

- 3.1 The Complaint was received in full by Nominet on 12th October 2004. Nominet validated the Complaint and notified the Respondent of the Complaint on 15th October 2004. A Response was received on 9th November

2004 and forwarded to the Complainant. A Reply was filed on 22nd November 2004.

- 3.2 The dispute was not settled by informal mediation and on 30th December 2004, the Complainant paid the fee to obtain the Expert Decision pursuant to paragraph 21 of the Nominet UK Dispute Resolution Procedure.
- 3.3 On 5th January 2005, Nick Gardner, the undersigned (“the Expert”), confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an Expert in this case. He requested that Nominet draw to the attention of the parties the fact that he was familiar with the group Wishbone Ash, had seen them perform during the 1970s and owned one album by them. He indicated that if either party objected to his appointment, he would decline to determine the dispute. These matters were communicated to the parties who did not object to Mr Gardner's appointment. Mr Gardner confirmed that there were no other matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.
- 3.4 This dispute is to be determined in accordance with Nominet's Dispute Resolution Services Policy and Procedure. Both the Policy and the Procedure were updated in September 2004 to Version 2. According to Nominet's rules, Version 1 of both the Policy and Procedure apply to all disputes filed between September 2001 and 24th October 2004, with Version 2 applied to disputes filed on or after 25th October 2004. Accordingly, this dispute falls to be determined in accordance with Version 1 of the Policy ("the Policy") and Version 1 of the Procedure (the “Procedure”).

4. OUTSTANDING FORMAL/PROCEDURAL ISSUES (IF ANY):

None.

5. THE FACTS:

- 5.1 The facts set out below do not appear to be in dispute.
- 5.2 Wishbone Ash was a rock group formed in England in the late 1960s. The original members of the group comprised both the Complainant and the Respondent, together with a Mr David (Ted) Turner and a Mr Steve Upton.
- 5.3 The Group enjoyed considerable success in the 1970s. It was signed to a major record label (MCA/Universal) in 1970 and was awarded the "Best New Group" award by the UK music press in 1971/2 and "Album of the Year" in 1973/4. The Respondent left the group in 1980 (although the Complainant says that the Respondent last played with the group in 1991) . There have been various other changes of personnel from time to time, but the group has been in existence continuously. The only member of the current group who was one of the original founders is the Complainant. He has been a member of the group throughout its existence. The group has continued to perform and record – the evidence established this is on a significant scale – it is not

disputed that on average it plays live around 175 times a year

- 5.4 In 1998 the Complainant registered the trade mark "Wishbone Ash" as a Community Trade Mark under the registration number 742684.
- 5.5 In 1994 the Complainant registered the domain name www.wishboneash.com which has been used since that date for a website devoted to the activities of the group.
- 5.6 In 1998 the Respondent registered the Domain Name. He subsequently established a web site at the Domain Name which relates to the group and its activities,. As this decision considers in some detail matters concerned with this web site it is referred to below as the "Web Site".

6. THE PARTIES' CONTENTIONS:

Complainant

- 6.1 The Complainant says that nowadays he operates the group as a sole trader under the name Wishbone Ash. He says he founded the group "with others" in the late 1960s.
- 6.2 The Complainant says that he operates the website at the wishboneash.com domain name which is the official website of the group and which provides information and details about the group's activities to both fans and those interested in booking the group.
- 6.3 The Complainant says that the Respondent left the group in 1991 and the only connection that he has had thereafter was a tour in 1996 where he was "invited by the Complainant on a sub-contract basis". The Complainant says that the Web Site is presented as the official website on search engines and is used for selling "unofficial merchandise using the mark of the group" and "as promotion for the Respondent's career outside the band".
- 6.4 The Complainant says the Web Site became operational in 2000.
- 6.5 The Complainant also says that the use by the Respondent on the Web Site of an e-mail address of wishboneashukonline@hotmail.com is also misleading and encourages the view that the Web Site is the official website of the group.
- 6.6 The Complainant says that these matters have led to many instances of confusion by not only fans, but other parties who play a key role in ensuring the success of the group. Various e mails are exhibited as evidence of this confusion (see below).
- 6.7 The Complainant says that the Web Site is not up-to-date and as a result misleads promoters and venue managers and is damaging the interests of the group. The Complainant states that "there is a general failure on the Offending Website [the Complainant's designation of the Web Site] to recognise the

continuity of the band and its ongoing activities as "Wishbone Ash".

- 6.8 The Complainant relies upon the case of *Byford –v- Oliver and Dawson* as establishing that the goodwill accumulated over the years in the name of a group will vest in the group as it is presently constituted.
- 6.9 The Complainant also objects to the standard of photography contained on the website operated at the Domain Name and the content of various postings on this website which he describes as misreporting and says that it puts "a negative spin" on the activities of the group, particularly when visitors to the Web Site will believe it is an official website. The Complainant says as a result of these activities he is suffering damage.

Respondent

- 6.10 The Response that has been filed comprises a "bullet point" summary of disputed matters of fact together with 10 appendices. This documentation is not, in all respects, easy to follow. For present purposes it seems to the Expert that the substantive points made by the Respondent are as set out below.
- 6.11 The Respondent says that he has used the Domain Name in connection with a genuine offering of goods or services before being aware of the Complaint. In this respect the Respondent says he is within one of the criteria which demonstrate that his registration of the Domain Name is not abusive (see below).
- 6.12 He also says that he has been commonly known by the Domain Name or is legitimately connected with a mark which is identical or similar to the Domain Name and he is making fair use of it. In this respect the Respondent says he is within a further one of the criteria which demonstrate that his registration of the Domain Name is not abusive (see below).
- 6.13 The Respondent says that there are "at least two separate organisations in existence to exploit differing aspects of Wishbone Ash". He says that the Complainant concentrates on live shows while he "maintains public awareness of the 1970-1980 and 1987-1991 periods of Wishbone Ash – the commercially successful periods".
- 6.14 He says that the Complainant has improperly registered the trade mark "contrary to extant agreements". No details are provided of what these agreements are said to be (the Complainant disputes in the Reply that any such agreements exist).
- 6.15 The Respondent denies that his website has ever been promoted as "official". He admits that a metatag describing the site as such was erroneously written into the site by the original designer, but says that this has since been removed.
- 6.16 The Respondent disputes the Complainant has an exclusive right to use the group's name. He says that either the name and the trade mark is his intellectual property or, at best, the Complainant is entitled to a 25% share (in relation to the original group) or a 20% share (in relation to a subsequent line

up of the group) of the rights held by the group in the name.

- 6.17 The Respondent says that he will be challenging the trade mark registration and that the Complainant is not entitled to monopolise the name for his benefit.
- 6.18 The Respondent says that he has worked professionally on Wishbone Ash material and been involved in occasional live appearances throughout the last 20 years to the benefit of the Complainant.
- 6.19 The Respondent disputes that the group in its current form is "primarily UK based". He says that the Complainant's address is that of an agent and that the Complainant is an American citizen and based in the United States. He says that only the bass player in the current group resides in the UK.
- 6.20 The Respondent says that given the group's long history and his own substantial and continuing involvement he has a legal right to use the group's name and the Complainant is bullying him and is attempting to monopolise a name and reputation which the Respondent did much to establish.
- 6.21 The Respondent says that he has an ongoing business and many contacts throughout the music scene who, knowing of his involvement with the group, communicate through him at the Domain Name. He says that the occasional misdirection occurs, but he has made every effort to be reasonable in forwarding e-mail and rectifying any possible cause of confusion. He says that similarly the wishboneash.com site receives e-mail which is intended for him, but that is forwarded to him in a similar manner.
- 6.22 The Respondent also says that he wishes to dispute the wishboneash.com domain name.
- 6.23 The Response includes 10 appendices, some of which he says are "crucial to the case". This material comprises a substantial amount of documentation, much of it in the form of e-mails or printouts of postings to websites. A significant proportion of this material is expressed in intemperate terms and ventilates accusations and counter-accusations as to who has said what about various matters associated with the group. The material also contains correspondence which purports to be based on legal advice and involves various threats and counter-threats of legal action. Whilst the Expert has reviewed this material, he does not find it necessary to consider its contents further in any detail, save to the extent that specific matters are expressly referred to below.

7. DISCUSSION AND FINDINGS:

- 7.1 It is apparent from the above description that at the heart of this dispute is an underlying issue and dispute between a member and a former member of a rock group as to rights and interests arising in respect of the name of the group. It is not however the function of this procedure, or the role of the Expert, to

determine as between the Complainant and the Respondent who has what rights in the name "Wishbone Ash". That is a matter which, if necessary, the parties would need to litigate in court.

- 7.2 However a central part of the Complainant's case and the way it has been framed is the proposition that "the goodwill accumulated over the years will vest in the band as currently constituted". The Complainant relies in particular on the case of Byford –v- Oliver and Dawson [2003] ENHC 295 CH 25 February 2003 as authority for this proposition.
- 7.3 This case is a decision by Mr Justice Laddie in the High Court (on appeal from the Trade Marks Registry) as to whether trade mark registrations in respect of the word "SAXON" had been made in bad faith, having regard to the factual history of the heavy metal group of that name, and the activities of various present and past members of that group.
- 7.4 Having reviewed the decision it does not appear to the Expert that it is necessarily authority for the proposition advanced by the Complainant.
- 7.5 In particular (at paragraph 19 of Mr Justice Laddie's Judgment):

"In my view, Mr Foley's views as to ownership of the name SAXON and the goodwill associated with it are not correct. There is no dispute that the group was a partnership at will in the 1980's. The name and goodwill were assets of the partnership. All the partners have or had an interest in those and all other assets of the partnership, but that does not mean that they owned the assets themselves. Absent a special provision in the partnership agreement, the partners had an interest in the realised value of the partnership assets. On dissolution of the original partnership, which is what happened when Mr Dawson departed in 1985, he and all the other partners were entitled to ask for the partnership assets to be realised and divided between them in accordance with their respective partnership shares. But none of them "owned" the partnership assets. In particular, none of them owned the name SAXON or the goodwill built up under it. The position would be very different if all the members of the original group had been performing together, not as partners, but as independent traders. In such a case, each may well have acquired a discreet interest in the name and reputation which he could use against third parties but not against the other owners. An example of this is Dent –v- Turpin (1861)2 J&H 139. Similarly, when Mr Oliver left in 1995, the then partnership dissolved. He had an interest in the realisation of that partnership's assets, but he did not own in whole or in part the partnership name and goodwill."

and (at paragraphs 25 and 26)

"Absent special facts such as existed in Burchell, the rights and obligations which arise when a group of musicians, performing in a band as a partnership, split up can be explained as follows. It is convenient to start by considering the position when two, entirely unrelated bands perform under the same name. The first performs from, say, 1990 to 1995 and the second performs from 2000 onwards. Each will generate its own goodwill in the name under which it performs. If, at the time that the second band starts to perform, the reputation and goodwill of the first band still exists and has not evaporated with the passage of time (see Ad-Lib Club –v- Granville [1972] FSR 256) it is likely to be able to sue in passing off to prevent the second group from performing under the same name (see Sutherland –v- V2 Music [2002] EWHC 14 (Ch), [2002] EMLR 28]. On the other hand, if the goodwill has disappeared or been abandoned or if the first band acquiesces in the second band's activities, the latter band will be able to continue to perform without interference. Furthermore, whatever the relationship between the first and second bands, the latter will acquire separate rights in the goodwill it generates which can be used against third parties (see Dent –v- Turpin and Parker & Son (Reading) Ltd –v- Parker [1965] RPC 323). If the first band is a partnership, the goodwill and rights in the name are owned by the partnership, not the individual members, and if the second band were to be sued, such proceedings would have to be brought by or on behalf of the partnership. The position is no different if the two bands contain common members. If, as here, they are partnerships at will which are dissolved when one or more partners leave, they are two separate legal entities."

- 7.6 The case also makes clear that carrying out the legal analysis is in any event dependent upon the specific facts and circumstances that pertained at the relevant times.
- 7.7 In these circumstances, save as set out below, the Expert declines to make any finding as to rights in the name Wishbone Ash, or the ownership of the goodwill arising out of the activities of the group. The Expert does not accept the Complainant's submission that he owns the entire goodwill in the name "Wishbone Ash". The parties will have to resolve these issues elsewhere.
- 7.8 So far as the Policy is concerned the Complainant has to show that he has Rights in the Domain Name. Rights are defined as "Rights includes but is not limited to rights enforceable under English law". The Expert is satisfied that the Complainant passes this relatively low threshold. In particular the Expert notes that (i) the Complainant is the registered proprietor of a trade mark which is identical to the Domain Name (although his entitlement to this mark is disputed by the Respondent); and (ii) that he says that in recent years the group has been run by him as a sole trader (which does not appear to be disputed by the Respondent).

- 7.9 Accordingly the Complainant establishes that the Policy is potentially applicable. The question that then has to be answered is whether the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.10 An Abusive Registration under the Policy is defined as a domain name which either:-
- 7.10.1 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
- 7.10.2 has been used in a manner which took unfair advantage of, or was unfairly detrimental to, the Complainant's Rights.
- 7.11 As far as the Expert can determine, no allegation is made by the Complainant that the act of registering the Domain Name was itself an act which took an unfair advantage of, or was unfairly detrimental to, the Complainant's Rights. If this is not the case, the Expert would in any event have concluded that, on a balance of probabilities, the mere registration of the name by a person who had been a long term member of the group was not in itself taking unfair advantage of, nor was it unfairly detrimental to, the Complainant's Rights.
- 7.12 The clear thrust of the Complaint and the Reply is that the Domain Name constitutes an Abusive Registration under paragraph 1(ii) of the Policy, i.e. because of the manner in which it has been used and in particular the contents of the Web Site.
- 7.13 Accordingly the Expert concludes that the central question in this Complaint is whether, on a balance of probabilities, the Web Site has been operated in such a manner as to take unfair advantage of, or be unfairly detrimental to, the Complainant's Rights.
- 7.14 The matters relied upon by the Complainant, although set out at length, boil down to the following complaints:-
- 7.14.1 the contents of the Web Site are not kept up-to-date with the Group's activities;
- 7.14.2 the Web Site is used to sell unauthorised merchandise;
- 7.14.3 the Web Site inaccurately promotes itself as the "official website for Wishbone Ash";
- 7.14.4 the e-mail address that appears on the web site of wishboneashukonline@hotmail.com reinforces this impression;
- 7.14.5 the content of the Web Site is inaccurate;
- 7.14.6 the photography on the Web Site is out of date;
- 7.14.7 the Web Site contains material including a fan forum which contains commentary about Wishbone Ash and its activities which is expressed in negative terms.

- 7.15 It is perhaps surprising, and unhelpful, that nowhere in the evidence that has been filed are there any copies of any content from the Web Site. The question of whether an Expert in determining a complaint of this kind, should himself review a web site online is not straightforward. There is an obvious risk the contents of the site may have changed and the Expert cannot be sure that what he is seeing corresponds to the site at the time of the Complaint. Although the Expert has looked at the Web Site on line he declines to make any findings based on that review, and relies solely on the material that is filed as evidence in this Complaint.
- 7.16 In these circumstances the Expert declines to make any finding about those aspects of the Complaint directed at the subjective content of the Web Site, such as the photography being out of date. The Expert is doubtful that matters such as this could in any case amount to "taking unfair advantage", but in any event the Expert does not have sufficient information on this particular case to conclude whether or not such allegations are well founded.
- 7.17 The Expert is not persuaded that the e-mail address concerned is a significant factor. It is an address in the form of a "hot mail" account which does not, to the Expert, give any particular suggestion that it is an "official" e-mail account of the group.
- 7.18 So far as the Policy is concerned the Complainant's Complaint is in substance that the Respondent's activities fall within paragraph 3 a (ii) of the Policy – "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 by, or connected with the Complainant".
- 7.19 The evidence that is filed as demonstrating that third parties have been confused is relatively limited. It comprises:
- 7.19.1 an e mail of 18 August 2004 from a German promoter. This e mail is addressed to an individual at the Complainant's solicitors. In it the promoter says the Web Site is causing some confusion and is irritating fans.
- 7.19.2 An e mail of 12 August 2004 from the group's current UK agents which complains about the site and states that they constantly have to placate promoters who think the site is official and complain that it does not contain up to date information.
- 7.19.3 A handful of e mails addressed to wishboneashukonline@hotmail.com. These seem to be either casual enquiries about booking the group or purely social e mails where individuals are seeking to renew contact with group members. These emails have presumably come into the Complainant's possession because of the Respondent's practice of forwarding any e-mail sent to the email address on the Web Site which is for other members of the group.
- 7.20 In circumstances where the Web Site has been established since 2000 it is difficult to see that this is significant evidence of real confusion. The emails from the German promoter and the UK agents have clearly been written

specifically for use in this procedure and the Expert views them as of limited assistance. The remaining material is at best de minimis. Overall it is hard to reconcile the Complainant's case that the Web Site is "extremely disruptive and potentially ruinous for the reputation of the Band and the success of their events" with the wide spread activity that the group have been undertaking, given the length of time the Web Site has been in existence.

- 7.21 Were it to be the case that the Web Site was inaccurately describing itself as the "official" site of the group a stronger case might be made out. However it is not alleged that there is any visible content on the Web Site to this effect. What is alleged (and appears to be accepted) is that at one stage a meta tag to this effect was contained within the Web Site. Such a tag will not be visible to a normal viewer but may be indexed by search engines which may then list the Web Site by reference to such a description.
- 7.22 It appears to be common ground that this meta tag has been removed. The Respondent says that the meta tag was originally included without his knowledge by the site's technical designer, and he arranged its removal when he became aware of it. The Expert views this account as somewhat unlikely but without the benefit of a detailed enquiry into the facts, and hearing the relevant witnesses, the Expert is unable to resolve the question of whether or not the inclusion of this meta tag took place with the knowledge of the Respondent.
- 7.23 A further matter relied upon is a specific complaint about arrangements for the promotion of a particular concert at Warwick Castle in 2004. The Expert is not able in a procedure of this nature to resolve what seems to be a clear conflict of factual evidence about what actually happened.
- 7.24 So far as the Respondent is concerned the Expert accepts that he "is legitimately connected with a mark which is identical or similar to the Domain Name" – he was a founding member of the group. Accordingly the Respondent is within paragraph 4(a)(i)B of the Policy.
- 7.25 The Expert also accepts on the evidence that before being informed of this dispute the Respondent had used the Domain Name "in connection with a genuine offering of goods or services". In this context the Expert takes the view that "genuine" relates to a real offering as opposed to a "window dressing" which seeks to legitimise an otherwise illegitimate registration. It is not disputed that the Respondent has been providing materials relating to the group Wishbone Ash from the Web Site. The Expert notes that the Complainant says that the goods offered via the Web Site are "unofficial". This is in substance a complaint which involves the respective rights in the name "Wishbone Ash" and the Complainant's disputed trade mark registration, all of which are matters to be resolved elsewhere. So far as the Policy is concerned the Expert is satisfied that the Respondent is also within paragraph 4(a)(i)A of the Policy.
- 7.26 The Expert does not believe the nationality or residence of the Complainant are of any relevance. The status of the domain name "wishboneash.com" is not a matter for Nominet, the Policy or this Expert.

- 7.27 If the Complainant's central contentions as to ownership of the name Wishbone Ash, the goodwill in that name, and the corresponding registered Community Trade Mark are correct, various consequences in terms of trade mark law may follow – all of these matters are however matters for a court with appropriate jurisdiction. So far as the Policy is concerned the Expert concludes that the operation of the Web Site at the Domain Name by a person who was a founder member of the group, and who has had a long standing association with the group, is not something which, on the available evidence, amounts to the registration being an Abusive Registration. Accordingly the Expert concludes, on the balance of probabilities, that the Complainant has Rights, within the meaning of the Policy, but has not established that the registration of the Domain Name is Abusive.
- 7.28 The Complaint fails. No action is needed to implement the decision.

Nick Gardner

20th January 2004