

DISPUTE RESOLUTION SERVICE

DRS 06284

Decision of Appeal Panel

Rayden Engineering Ltd

and

Diane Charlton

1. The Parties:

Complainant/Appellant:

Rayden Engineering Limited
Wentworth House
Wentworth Street
Ilkeston
Derbyshire
DE7 5TF

Respondent:

Diane Charlton
22 Wentworth Street
Ilkeston
Derbyshire
DE7 5TF

2. The Domain Name(s):

<rayden-engineering.co.uk>
<rayden-engineering.org.uk>

3. Procedural Background

A Complaint in respect of <rayden-engineering.co.uk> and <rayden-engineering.org.uk> (the "Domain Names") under Nominet UK's Dispute Resolution Service Policy ("the Policy") was received from the Complainant and forwarded to the Respondent by Nominet on 5 November 2008. A Response was received from the Respondent on 21 November 2008 and the Complainant lodged a Reply on 1 December 2008.

On 22 January 2009 Victoria McEvedy was appointed as Independent Expert to determine the dispute in accordance with Nominet's Procedure for the conduct of proceedings under the Dispute Resolution Service (the "Procedure"). She confirmed to Nominet that she was independent of the parties and knew of no facts or circumstances that might call into question her independence in the eyes of the parties.

By her decision dated 12 February 2009 the Expert found that the Complainant had Rights (as defined in the Policy) in a name or mark that was identical or similar to the Domain Names; but that in the hands of the Respondent the Domain Names were not Abusive Registrations (as so defined). Accordingly she dismissed the Complaint and thereby directed that no action be taken in respect of the Complaint.

A Statement of the Complainant's Intention to Appeal was received by Nominet on 13 February 2009. The Appeal Notice was received by Nominet and forwarded to the Respondent on 26 February 2009. An Appeal Notice Response was lodged by the Respondent on 10 March 2009.

On 20 March 2009 an Appeal Panel of three Experts (the "Panel") was appointed to determine the Appeal, comprising Ian Lowe as Chairman together with Nick Gardner and Claire Milne. All three Experts confirmed that they were independent of the parties and knew of no facts or circumstances that might call into question their independence in the eyes of the parties.

Paragraph 10a of the Policy provides that "The appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters". We have therefore approached this Appeal as a reconsideration of the merits based on the submissions of the parties. However, since we have reached a different view from the original Expert in a number of respects, we summarise the reasoning of the Expert below.

4. Factual Background

The Complainant is a family owned engineering business that was established in 1979. It was incorporated as Rayden Engineering Limited in April 1996. It has operated a website at www.raydenengineering.com since May 2000 and registered the domain name <raydenengineering.co.uk> in July 2006. It supplies engineering services to the pipe welding and manufacturing industries.

The Respondent lives in a house neighbouring the Complainant's premises. The parties are engaged in what appears to be a bitter dispute over the Complainant's use of an adjoining piece of land.

According to the Nominet Whols database, the Domain Names were registered on 22 March 2008. At the date of the Complaint the Domain Names both resolved to a website at www.councilanddeveloper.net where the Respondent publishes details of her allegations against the Complainant and the local authority.

5. The Parties' Contentions

Complainant

The Complainant's contentions - distilled from the original Complaint and the Reply to the Response to the Complaint - are as follows.

Rights

The Complainant claims to have established common law rights in respect of the name Rayden Engineering as a result of its trading under that name for over 29 years. The

business was unincorporated from 1979 but incorporated as Rayden Engineering Limited in 1996. "Rayden" is derived from the name of the founder of the business, Richard Hayden.

The Complainant adduced evidence of its prestigious customer base of national and international companies; its turnover now standing at around £10 million per year; its accreditation by various national bodies; coverage in the trade press; and its local reputation as an employer of some 100 staff. The Complainant also relied on its online usage of the name through its websites at www.raydenengineering.com since 2000 and more recently www.raydenengineering.co.uk.

Abusive Registration

The Respondent registered the Domain Names and has used them in order to further her long running campaign of harassment against the Complainant which is disrupting its business.

The Respondent has no connection with the business of the Complainant. She is a close neighbour of the Complainant and is using the Domain Names in a way that confuses Internet users looking for the Complainant into believing that the Domain Names are registered, operated or authorised by, or otherwise connected with the Complainant. As a result of issues that have arisen through her close proximity to the Complainant's premises, the Respondent has been engaged in a negative publicity campaign against the Complainant since February 2007. She has written to local newspapers and regularly posts allegations and malicious comments about the Complainant and its staff on various websites, including www.councilanddeveloper.net, to which the Domain Names resolve, which is maintained for the sole purpose of airing the Respondent's grievances and unsubstantiated allegations against the Complainant and the local council.

Many of the comments are highly offensive and defamatory. They cause damage to the Complainant and to Mr Hayden personally and are deeply offensive. Among other things, the Respondent alleges that:

- the Complainant illegally took possession of a parcel of land in collusion with the local council by bribing the council not to intervene;
- the Complainant has caused flood damage to the Respondent's home;
- the Complainant illegally uses CCTV cameras to observe families in Wentworth Street in an inappropriate manner;
- the directors of the Complainant have treated aged local residents in an unnecessarily cruel and vindictive manner.

The Complainant is adamant that the allegations of fraud and corruption are totally unfounded and that it conducts itself properly and takes its responsible role in the community very seriously.

The Respondent is using the Domain Names in a way that confuses, and has confused, visitors searching for the Complainant into believing that the Domain Names are registered, operated or authorised by, or otherwise connected with the Complainant as set out in paragraph 3(a)(ii) of the Policy. The Respondent's registration of the Domain Names is designed to attract parties who are legitimately interested in the Complainant's activities and business and divert them to the Respondent's website. When 'Rayden Engineering' is typed into the 'Google' search engine, the Domain Names appear in the first 15 hits.

The use of the Complainant's name in the Domain Names suggests that the link will lead to a legitimate Rayden Engineering website. This is acknowledged in the head text of the front page of the Respondent's website, which reads "Welcome to www.councilanddeveloper.net In association with www.rayden-engineering.co.uk and www.rayden-engineering.org.uk. If you are looking for Rayden Engineering Ltd and have come to this site instead then please try again!"

The Complainant claims that various members of the public and some of its employees have contacted the Complainant to express their concern and gives details of a number of customers who have expressed their confusion and negative reaction to the website. Once visitors arrive at what they will believe to be the Complainant's authentic website, they are exposed to malicious, unfounded, and inaccurate statements intended to cause embarrassment to the Complainant and damage its reputation.

The Complainant has been forced to spend considerable time reassuring its customers that the statements are untrue. However, it has only been able to do so in respect of customers who have raised the issue. There may be many more customers who have not contacted the Complainant, some of which may have believed the Respondent's false allegations. The Complainant may well have lost business as a result of the abusive registration. The Complainant avers therefore that the Respondent registered the Domain Names for the purpose of unfairly disrupting the business of the Complainant, which comprises a further indication of abusive registration under paragraph 3(a)(i)(C) of the Policy.

Although the DRS Policy states that fair use 'may' include sites operated solely in criticism of a person or business, criticism sites are not automatically considered fair. The registration of a website will not usually be considered fair where the exact trade name of the Complainant is registered without any qualification or addition. The registration of a website will not be considered fair when the 'criticism' is untrue, or where such criticism goes beyond reasonable critical comment and becomes unfair abuse. The registration of a website will not be considered fair when the registration unfairly takes advantages of the rights of the Complainant or where it disrupts the business of the Complainant, including through 'initial interest confusion'.

The Respondent has used the Complainant's full trade name in the Domain Names. Previous Nominet decisions state that the use of an identical trade name will in almost all cases be considered to be an unfair use and unfairly detrimental to a complainant's Rights. The Complainant relies on *Moss and Coleman Solicitors v Rick Kordowski* (DRS 04198), where the Expert decided that a respondent's right to criticise did not extend to registering a domain name identical to the complainant's trade name.

Furthermore, the decision of the Appeal Panel in the *guidestar.co.uk* case (DRS 02193) sets out the basis of dealing with 'protest sites' where the name used is identical to a name in which a complainant has rights. The Appeal Panel commented that "*registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned...Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy.*"

In *Clydesdale Conservatories v Desmond Lawton* (DRS 3161), the Expert decided that a domain name identical to a complainant's trading name is inherently likely to cause confusion. The Expert noted that such impersonation is unnecessary for the purposes of criticism, and that such registrations will not be fair under any circumstances, stating "*it is the Respondent's choice of Domain Name which is identical to the Complainant's trading name that falls foul of the Policy, not the Respondent expressing his views about the Complainant.*"

In the current case, the registration of the Domain Names was unnecessary for the purposes of criticism. When the Domain Names were registered, the Respondent controlled a website under a different name, www.councilanddeveloper.net, on which allegations about the Complainant are posted. The Domain Names were not registered to host the criticism website, but merely to divert further traffic to an existing criticism site. By registering Domain Names identical to the Complainant's trading name for this purpose, the Respondent hoped to attract Internet traffic seeking the Complainant's website. This takes unfair advantage of the Complainant's Rights in its trade name, and falls outside the idea of 'fairness' envisaged by paragraph 4b of the Fair Use Policy.

In deciding the *Harmonkardon* dispute (DRS 00193), the Expert concluded that there was no situation in which the registration of a domain name identical to a trade name could be

considered legitimate. The Expert commented that *"In the hands of the Respondent the Domain Name constitutes a threat hanging over the head of the Complainant and there are many obvious and potentially damaging uses to which the Domain Name could be put."* Because of the acrimony the Respondent feels for the Complainant in this instance, the Domain Names will only ever be held by her for purposes of making mischief and causing disruption to the Complainant.

The Respondent argues that the disclaimer posted on the Website prevents confusion on the part of visitors. The disclaimer is actually posted on a separate domain www.councilanddeveloper.net which the Domain Names merely divert Internet traffic to. The Respondent states further that 'initial interest confusion' does not apply in this case. The Complainant disagrees.

The Domain Names were selected by the Respondent to achieve the maximum impact in terms of initial interest confusion. The primary purpose for the Respondent's choice of Domain Names is to divert as many Internet users as possible who seek information about the Complainant to the Respondent's criticism website. The inflammatory nature of the website has the effect that people are intrigued by its contents. The Complainant's customers have in fact been drawn to the Domain Names while searching for 'Rayden Engineering' for legitimate business reasons, and the customers have gone on to read the allegations.

The Complainant finds further support for a complaint based on initial interest confusion in *Terry Forsey v Xi Software Limited* (DRS 4113), where the Expert stated that *"it is clear that the Domain Name is identical to the trading name of the Complainant, such that by its adoption the Respondent could reasonably be said to be impersonating the Complainant. Visitors to the website associated with the Domain Name will be expecting to find the Complainant's site rather than the Respondent's, regardless of whether any such confusion might subsequently be dispelled by critical content. In that sense the Domain Name in the hands of the Respondent can reasonably be seen as inherently likely to lead to confusion. It is therefore the Expert's view that the Domain Name has been used in a manner which is unfairly detrimental to the Complainant's Rights."*

In contrast, the Complainant points out that the *Joi devivre Holidays* case represented an unusual departure from previous decisions in finding that a domain name registered to host a criticism site under an identical name to the Complainant's business was permissible.

The Complainant therefore maintains that the Respondent's registration of the Domain Names does not fall within the scope of the fair use contemplated by paragraph 4b of the Policy.

Respondent

The Respondent emphasises that the Domain Names were registered for the sole purpose of highlighting the Complainant's conduct and airing the Respondent's grievances. This is in accordance with paragraph 4(b) of the Policy that recognizes that "Fair Use may include sites operated solely in tribute or criticism of a person or business". The registrations are not abusive as envisaged by paragraph 4(a)(i) C of the Policy as the Domain Names were not acquired for the purpose of unfairly disrupting the business of the Complainant but for the sole purpose of highlighting the Complainant's conduct.

Although the Complainant avers that the sole motive behind the registration of the Domain Names is to divert confused legitimate business interests away from the Complainant's own website at www.raydenengineering.com, search engines do list his website. Furthermore, when search engines list the web sites at the Domain Names, the short entries against the listings make it patently obvious that there is no connection, authorization or ownership of the website by the Complainant and that the Domain Names clearly lead to a criticism website of the Complainant's conduct. They are extremely unlikely to cause even "initial interest confusion" among individuals or businesses genuinely seeking the Complainant's website.

The Respondent relies on the decisions of Nominet experts in

DRS 05122 *joiedevivreolidays.co.uk* and DRS 4285 *knightslettings.co.uk*, both of which concerned criticism web sites but the complaints failed.

Although the Complainant alleges the web site has caused financial loss and damage it has failed to submit any evidence to support this contention.

The Respondent gives details of the nature of her grievances against the Complainant and of the basis for her criticism of its conduct. She suggests that the Complainant's real grievance is both that her criticism web sites appear in the top 15 Google and Yahoo search engine results and its objection to the actual content of the criticism website. However, the DRS is not the correct forum for a complaint concerning the contents of a web site. If, as the Complainant states in the Complaint, the website contains "abusive, malicious, unfounded, unsubstantiated, offensive and defamatory allegations damaging to the Complainant's reputation" then the Complainant has had every opportunity to obtain redress through readily available civil and criminal legislative remedies.

The DRS is not the correct forum for a complaint concerning allegations of harassment. The Complainant has chosen not to pursue legal redress for perceived injury to reputation through the appropriate channels as the Complainant is more than well aware of the plethora of substantial documentary evidence in support of the website's allegations concerning the Complainant's conduct. The Respondent admits that the content of the web site is shocking but maintains that the Complainant's malicious campaign of harassment toward its residential neighbours has been equally shocking. Her website does not tarnish the Complainant's name as it is the activities of the Complainant that tarnish his name, not the reporting of them.

The Respondent does not consider the Domain Name registrations to be abusive under Paragraph 4 (a)(i) C as the website is not about unfairly disrupting the Complainant's business but about the reporting of the Complainant's own conduct, which led to the website's inception and the registration of the Domain Names.

The Respondent considers that she has made legitimate, non-commercial, fair use of the Domain Names.

6. Expert's Decision

The original Expert's decision in this case can be found at:

http://www.nominet.org.uk/digitalAssets/34451_rayden-engineering.co.uk__1.pdf.

On the issue of Rights, the Expert held that the Complainant clearly had common law rights in the name Rayden Engineering arising from its extensive use of the name in trade over some 30 years. Since hyphens were to be disregarded for the purpose of assessing similarity, the Expert held that the Domain Names were identical to the name in which the Complainant had Rights.

On the question of abusive registration, however, she found in favour of the Respondent. She considered that the key factors of those listed in paragraphs 3 and 4 of the Policy as potentially evidencing whether the Domain Names were Abusive Registrations, relied on by the parties, were paragraphs 3aiC, 3aii, 4aiC and 4b, namely:

- 3aiC Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant;
- 3aii Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way that has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

- 4aiC that before being aware of the Complainant's cause for complaint (not necessarily the "complaint" under the DRS), the Respondent has made legitimate non-commercial or fair use of [the Domain Name]; and
- 4b Fair use may include sites operated solely in tribute to or in criticism of a person or business.

The Expert suggested that the fair use factor in the Policy was intended to borrow from the law of trade marks such that uses that were not "use in trade" or "use in commerce" or "use in a trade mark sense" were permitted. This included what she termed "nominative use" of a trademark – to call someone by their name or say something about them – rather than to compete with them in business. She considered that the Respondent was not using the Complainant's name in a trade mark sense but was using it simply to name and describe and then complain about the Complainant.

The Expert noted that the Policy says at paragraph 4b that fair use may include sites operated solely in tribute or criticism of a person and considered that this was intended to enshrine the right to use domain names for nominative purposes in these ways. She did not consider that previous decisions under the ICANN UDRP or under the Nominet DRS that suggested that you cannot rely on fair use if you register another's name as a domain name unadorned – without adding "sucks" or something else to distinguish the resulting website as a gripe site – were consistent with the Policy.

She considered that the Respondent's use of the Domain Names was "paradigm fair use" and that the Respondent's use of disclaimers on her site avoided any impersonation. The Expert did not accept that the Respondent had registered the Domain Names to disrupt the Complainant's business and considered that the Policy required more than mere initial interest confusion. Any confusion would in any event be trumped by the Respondent's fair use.

7. Appeal Submissions

Complainant/Appellant

The Complainant's contentions in the Appeal are set out in its Appeal Notice reproduced below in full:

1. The Domain Names are identical to the Complainant's established business name. The Respondent registered the Domain Names to attract further visitors to a website which criticises the Complainant. The Expert considers this to be "paradigm fair use". The Complainant considers, on the basis of the DRS Policy ("the Policy") and in reliance on previous DRS decisions, that it amounts to paradigm unfair use.

Fair use under paragraphs 3 and 4 of the Policy

2. Paragraph 4(b) of the Policy states that fair use may include criticism sites - but not that the registration of a domain name for this purpose will automatically amount to fair use. The Policy does not state that paragraph 4 will take precedence over, or 'trump' paragraph 3. The proper approach, in considering whether a registration is abusive, is to balance the factors in paragraph 4 against the factors in paragraph 3.

3. The Expert suggests that criticism sites will automatically constitute 'fair use', which implies that no such balancing is needed. The Expert states that, even if confusion had occurred, this would be 'trumped' by the Domain Names' use as non-commercial criticism sites in line with paragraph 4(b).

Registration of an identical name for criticism purposes

4. The registration of a domain name identical to that of a complainant, for the purpose

of criticising that complainant, will in almost all cases amount to impersonation and will be unfair. This is supported by numerous decisions, including **DRS 3161**, **DRS 4198**, and more recently **DRS 5371**. Although these cases do not have precedent value, they should not be entirely ignored or discounted. Under paragraph 10(c) of the Policy, Appeal decisions do have persuasive value to experts in future decisions.

5. The Appeal decisions in **DRS 02193** and **DRS0389** both state that the deliberate selection of an identical domain name for the purposes of criticism amounts to impersonation and will not be fair use under the Policy. Yet, without any open consideration of these authorities, the Expert states that the previous decisions supporting the idea of impersonation should be resisted, as the idea “offends the right to nominative use”.

Nominative use

6. The Expert contends that nominative use will always be fair, because of the position in trade mark law. The Policy is not trade mark law, and it does not state that anything is ‘always fair’. In any case, the Complainant does not accept that the use of its mark as a domain name is mere nominative use.

7. A domain name is as much a badge of origin as a company letterhead. If the Respondent had registered www.raydenengineeringisdestroyingtheworld.co.uk this would be nominative use. If the Respondent used the mark ‘Rayden Engineering’ on her otherwise-named site to make reference to the Complainant, this too would be nominative use. Use of the mark as a domain name, however, is functionally equivalent to putting ‘McDonalds’ and the golden arches logo on the outside of a building – people will automatically assume whatever they find inside is the product of the McDonalds chain. Even if that assumption is shortly rebutted, the confusion has occurred and the damage is done.

Initial interest confusion

8. The idea behind ‘initial interest confusion’ has become an established approach to domain name disputes. Numerous decisions (including Appeal decisions) have used it to apply the Policy to confusion occurring in relation to domain names. The Expert, however, decides that this approach should not be applied to the Policy, because it is “widely regarded in trade mark law as overreaching and wrong”.

9. If the Decision is correct in finding that impersonation and initial interest confusion are irrelevant and invalid, then significant numbers of decisions have been decided incorrectly. The approach of the experts in those decisions must have been flawed, and “overreaching and wrong”. The Complainant does not think this can be the case. All Nominet complainants should be entitled to rely on consistency from the experts in their approach to the Policy.

Defamation proceedings

10. The Expert considers it ‘highly significant’ that no libel proceedings have been brought by the Complainant. There is no explanation as to why this may be ‘highly significant’, but it is clear that the Decision was significantly influenced by this irregular consideration. The inference is that the Expert believed that the Respondent’s version of events ‘must be true’ - and consequently that the registration ‘must be fair’.

11. Page 5 of the Decision states that “the DRS is not a forum for determining allegations of defamation or trade mark infringement or passing off and is concerned only with Abusive Registrations”. The existence or otherwise of proceedings are irrelevant to the issue of whether a domain name has been registered abusively. It is outside the remit of a Nominet expert to make any judgment on the existence or strength of any claim in defamation. No such judgment should have been allowed to influence the Decision.

12. In any case, the Expert has no means of knowing what the intentions of the Complainant are in relation to defamation proceedings, nor whether proceedings have been issued or are being prepared. The Complainant is still within the limitation period which applies to defamation in respect of all contents published on the Domain Names, which were first registered on 20th March 2008.

13. The DRS is promoted as a quicker, cheaper alternative to litigation. The Complainant has availed itself of this quicker, cheaper remedy to protect itself against a hostile party that has hijacked its name. It is grossly unfair that the experts representing the very body that offers the more streamlined alternative should punish the Complainant for not taking the more expensive and cumbersome route.

Conclusion

14. The Complainant considers that the use of its mark for criticism can only be an abusive registration. It arrives at this understanding on the basis of the Policy as interpreted in the majority of previous decisions, including Appeal decisions. The Complainant requests that the Decision be overturned and that the Domain Names be transferred to its control.

Respondent

The Respondent does not accept that the Complainant can properly rely on the Nominet Appeal decisions in DRS 02193 *guidestar.co.uk* and DRS 0389 *scoobydoo.co.uk*. She points to the decision of the Expert in DRS 05122 *joiedevivreholidays.co.uk* in which the Expert stated that the decision in *scoobydoo* when quoted out of context could be misleading as numerous factors had to be considered. In *joiedevivreholidays*, unlike the *scoobydoo* Appeal, the Respondent had not attempted impersonation, had not sought to make profit and did not jeopardise the Complainant's goodwill and reputation.

She also relied on DRS 4285 *knightslettings.co.uk* in which the complaint failed since the Expert concluded that "unlike the situation in *guidestar* there is no evidence that the Respondent has ever used the name for other than a complaint site. The site is solely and simply "in criticism" of the Complainant."

In both *guidestar* and *scoobydoo*, the registrant used identical domain names for web sites which sold goods and services in competition with the Complainants' own goods and services. The Experts found this to be unfair advantage through impersonation. In *scoobydoo*, the public believed they were entering official site to purchase merchandise. In *guidestar* the Experts found "It was not exclusively a protest site" as it diverted to another site selling goods and services in competition with Complainant.

In both *joiedevivreholidays* and *knightslettings* the registrants used identical domain names to names in which the complainants had rights, but they were not taking advantage of initial interest confusion by impersonation to profit from trade-mark use and the complaints were dismissed.

Unlike the decisions the Complainant relies on, the domain names in this Complaint lead to a criticism web site which makes no attempt to impersonate or sell goods and services in direct competition with the Complainant.

So far as initial interest confusion is concerned, the results of Internet searches listing the Respondent's website include descriptions of the website which make it clear that the site is not connected to, authorised by or operated by the Complainant and is obviously one of criticism. Furthermore, upon entry to the web site there is a bold red title, disclaimer and opening paragraph outlining the dispute with the Complainant. The content of the web site makes it clear there is no attempt at impersonation and that it is a criticism site of the Complainant's conduct.

To paraphrase the respondent in WIPO Case Number: D2007 - *stephencleeve.com*, "The website does not tarnish the Complainant's name as it is the activities of the Complainant that tarnish his name, not the reporting of them."

8. Discussion and Findings:

General

The Complainant is required under clause 2b of the Policy to 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 Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

"Rights" are defined in the Policy and in the Procedure. Rights "includes, but is not limited to, rights enforceable under English law".

The Respondent does not contest the submission on the part of the Complainant that it has Rights in the name RAYDEN ENGINEERING. It has carried on business under that name over some 30 years and it is not disputed that as a result it has established a substantial national and international reputation and goodwill in the name. We readily accept that the Complainant has sufficient common law rights in the name RAYDEN ENGINEERING to give rise to Rights under the Policy.

It is well-established that hyphens (and the <.co.uk> suffix) are to be disregarded for the purpose of assessing similarity.

Accordingly, we are satisfied that the Complainant has Rights in a name which is identical to the Domain Names.

Abusive Registration

Factors to be considered

Paragraph 1 of the Policy defines "Abusive Registration" as a Domain Name which either:

- i was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3 of the Policy. These include:

- 3ai Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - C. for the purpose of unfairly disrupting the business of the Complainant; and
- 3aia 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; and

On the other hand, paragraph 4 of the Policy sets out a list of factors that may be evidence that the Domain Name is not an abusive registration, including:

- 4ai Before being aware of the Complainant's cause for complaint (not necessarily the "complaint" under the DRS), the Respondent has
 - C. made legitimate non-commercial or fair use of the Domain Name;
- 4b Fair use may include sites operated solely in tribute to or in criticism of a person or business.

The issues and previous relevant cases

This Appeal raises three key issues:

- 1 The legitimacy of including a name in which a third party has Rights as part of a domain name registered for use in connection with a website that is critical of or raises protests against the third party;
- 2 The significance of the domain name being essentially identical to the name in which the third party has Rights;
- 3 The relevance of the nature of the content of the website.

There has been a number of previous decisions of Experts under the Policy directed at the legitimacy of protest or tribute sites which use a domain name identical to that of the Complainant. Some relevant decisions are

- Cases where the Expert upheld the Complaint: DRS 3161 (clydesdaleconservatories.co.uk); DRS 4198 (mossandcoleman.co.uk); DRS 5371 (martinhealer.co.uk); DRS 3655 (ryanair.org.uk); DRS 3665 (jrrolkein.co.uk)
- Cases where the Expert rejected the Complaint: DRS 4285 (knightslettings.co.uk); DRS 5122 (joiedevivreholidays.co.uk)
- Cases where the Expert rejected the Complaint but an Appeal Panel upheld the Complaint: DRS 0389 (scoobydoo.co.uk); DRS 2193 (guidestar.co.uk).

Whilst the Panel has reviewed all of these cases it notes that many of them turn on their own facts: for example, the fact that the site in question may also have had at least an element of commercial use. By paragraph 10c of the Policy, previous Appeal decisions are of persuasive value and the Panel has had due regard to the above Appeal decisions (see below). In the present case the Panel considers it appropriate to set out the reasons for its decision based upon the underlying principles which it considers are applicable.

Paragraph 4 of the Policy specifically contemplates that a domain name may not be an Abusive Registration if it is legitimately and fairly used for a web site that is operated solely in tribute to or in criticism of a person or business (see paragraphs 4aiC and 4b recited above). In doing so, the Policy must contemplate that the domain name used for that purpose will comprise a name which is identical or similar to a name or mark in which the Complainant has Rights under the Policy. Unless the Complainant establishes that it has such Rights then the question of whether the domain name is an Abusive Registration does not arise.

Accordingly, there is in our view no doubt that the Policy does contemplate circumstances in which it will be legitimate for a domain name to be registered for use in connection with a protest site where the domain name comprises a name that is "identical or similar" to a name or mark in which the complainant has Rights. The Policy does not, however, explicitly address the question whether any distinction is to be drawn between those cases where the domain name is essentially identical to the Complainant's trade mark (eg <trademark.com> or <trade-mark.co.uk>), or confusingly similar to the trade mark, and those where the domain

name includes a modifier or variant from which it is obvious that the domain name is associated with a protest site (eg <trademarksucks.com> or <trademarkisintentondestroyingtheworld.co.uk>).

We consider that there is a limit to how much significance can be placed on the content of the protest website by an Expert. As countless Experts and Appeal Panels have remarked, the DRS is intended to be a relatively simple, low cost and efficient system for resolving domain name complaints. The system does not contemplate a detailed analysis of factual disputes or the forensic weighing up of conflicting accounts. There is limited scope for adducing witness evidence or for the Expert to test the truthfulness of the evidence being presented in cases where it is bitterly contested. Protest sites classically carry personal, emotive versions of events, often expressed in deliberately shocking or vitriolic terms intended to attract attention to the cause. The statements may well be libellous in legal terms, but it is unlikely to be possible or appropriate for the Expert to determine in the context of the paper based DRS whether the statements are in fact true so that the defence of justification would be available.

Although an Expert may in many cases form an impression as to whether the views expressed on a protest site are justified or true, we do not consider that in general the legitimacy of the use of a particular domain name should turn on such a judgement. There may, however, be occasional cases where the use of the domain name is so obviously offensive or immoral that an Expert could conclude that a submission of fair use could not be maintained. Equally, there could be exceptional cases where the use of the domain name for criticism is so obviously justified that a submission of fair use appears reasonable. As we explain below, the Panel does not feel that this case is of such an exceptional nature.

The issue at the heart of this case is the registration of the Complainant's identical name – Rayden Engineering – as a domain name for the purposes of pointing to a protest site. This question has been the subject of much debate not only in Expert and Appeal decisions under the Nominet DRS but also in Panel decisions under the ICANN Uniform Dispute Resolution Policy (the "UDRP").

In the Nominet Appeal case DRS 02193 (guidestar.co.uk), the Appeal Panel stated that:

"Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is.

Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy. Various decisions under the DRS Policy have condemned such practices including the following:

"In the view of the majority of the Panel, in the context of a tribute site, the vice is in selecting a domain name, which is not one's own name, but which to one's knowledge is identical to the name of another, which one has selected precisely because it is the name of that other and for a purpose which is directly related to that other. For a tribute or criticism site, it is not necessary to select the precise name of the person to whom one wishes to pay tribute or criticise. In this case the domain name could have been 'ilovescoobydoo.co.uk', for example.

Taking the Domain Name in these circumstances arguably amounts to impersonation of the owner of the name or mark. Substantial numbers of people will have visited the Respondent's website (the Respondent admits to a total of over 37,000 visitors to his site) believing that they were visiting the site of the Complainant, a phenomenon sometimes referred to as 'initial interest confusion'. Prior to the posting of the disclaimer, those visitors might well not have been disabused. The fact that the Respondent was selling

official merchandise may have encouraged those visitors in their belief that they were visiting an authorised/licensed site. Notwithstanding the Respondent's denial of any advantage, the Panel is of the view that on the balance of probabilities there must have been an advantage to the Respondent of some kind. Whether or not that 'advantage' has led to financial gain is irrelevant. The question is as to whether the advantage he has taken has been fair."
[Appeal decision DRS 00389 – scoobydoo.co.uk]

The current case

The Respondent registered the Domain Names for the avowed purpose of directing them to a web site operated by her at www.councilanddeveloper.net (the "**Website**"). There she publishes details of her complaints and criticism of the Complainant and of Mr Hayden, and of those she regards as being culpable in the events which she seeks to highlight, such as the planning authorities.

The essence of an Abusive Registration under the Policy is that the domain name was registered or has been used in a manner that has taken unfair advantage of or has been unfairly detrimental to the complainant's Rights. Here it is clear, first, that the Respondent registered the Domain Names so that Internet users would be attracted to visit the Website because of the Domain Names; with the precise intention that she would thereby increase the number of people that would be confronted with her views on the Complainant and those associated with the Complainant including Richard Hayden. She has used domain names that are no more than the trading names of the Complainant without any indication that they lead to a protest site. In effect the Respondent is posing as the Complainant in order to attract members of the public to the site.

We accept on the evidence before us that the Respondent genuinely holds the views that are expressed on the site, and that those views arise out of a dispute between the Respondent and the Complainant. Beyond this, the merits of that dispute are not an issue that we can determine. We also accept that the site carries a clear disclaimer that would immediately alert visitors to the site that it was not the web site of Rayden Engineering. There is no evidence of any commercial use associated with the site.

We do not agree with the point made by the Respondent that the Complainant's failure to commence civil proceedings for defamation or the like is in some way a matter of significance we should take into account. The Expert in her decision said she regarded this as "highly significant". We disagree – the law of defamation is notoriously complex and litigation is likely to be expensive and uncertain. We do not believe that Complainants should in general be subject to an adverse inference if they seek to invoke a complaint under the Policy but have not also initiated civil proceedings. Furthermore, in our view, the question whether a criticism site using an identical name is or is not Abusive does not turn on whether the contents of that site are defamatory in law.

The Respondent has deliberately used the Complainant's trade mark as a designation for her protest site without adding any additional component that would identify it as such. She is thereby creating a likelihood of confusion with the Complainant and attracting Internet users who would not knowingly follow a "...sucks" link. The Respondent does not argue, and there is no scope for maintaining, that the Domain Names are intended to refer to anything or anyone but the Complainant.

We note the Respondent's argument that an Internet user would quickly realise that the website it had reached had no connection with Rayden Engineering. As reflected in the <scoobydoo.co.uk> appeal decision cited above, the majority view amongst Nominet Experts is that where a registrant registers or uses a domain name so as to take advantage of "initial interest confusion", which causes a user to visit a website expecting it to have some connection with a well-known name comprised in or constituting the domain name, he takes unfair advantage of the Rights in the name. By the time the user reads the disclaimer, or

realises from the content of the Website that it is not what he was looking for, the damage is done and the advantage sought by the Respondent is achieved.

In her appeal notice response, the Respondent disputes the Complainant's analogy of putting 'McDonalds' and the golden arches logo on the outside of a building – and the assertion that people will automatically assume that whatever they find inside is the product of the McDonalds chain. The Complainant pointed out that even if that assumption were shortly rebutted, the confusion would have occurred and the damage been done. In contrast, the Respondent suggests that this is rather a case where the McDonalds logo is displayed on a derelict building with clear descriptions prior to entry that it is not McDonalds. In such a case, would people still be confused into assuming that fast food was available inside the building?

We are hesitant about attempting to draw an analogy ourselves, but do suggest that a more apt one is where the Respondent erects a sign post on the road leading to the Complainant's premises reading simply "Rayden Engineering" and pointing down a side street. Those turning down the side street would shortly come across a prominent stand with banners and posters promulgating the Respondent's complaints and protests about the Complainant's activities. Those arriving there would quickly realise that they had come to the wrong place. Some would tut impatiently about the fact that they had been fooled and turn around and go back to continue their search for the Complainant's premises; but others might decide simply to carry on and find another engineering company; others still might pause and read the material on the stand – that they would not otherwise have read – and possibly think less of the Complainant as a result of reading what was there. The result is that damage is done by the misdirection, which leads people to the stand which they would not otherwise have arrived at.

In our view this is unlikely to be fair use of the misleading sign. Further, it is no answer either to rely on the fact that in some cases it is apparent from the way in which Internet search results are displayed that the website listed may not be the one in which the searcher is interested. The additional text is largely unpredictable and it may not in fact be obvious what the listed website comprises. Furthermore, those using Internet searches are accustomed to all sorts of useless material being displayed and may well simply focus on the domain name comprised in the listed website address. In addition, initial interest confusion also extends to Internet users who simply type in a likely URL comprising the trade mark and thereby have no such opportunity to be put off visiting the site.

The Respondent suggests that there is a distinction to be drawn in this case because she is not interested in either the Complainant or Mr Hayden or his business activities but only in the Complainant's conduct. She is not a competitor of the Complainant. Nevertheless, she clearly seeks to draw adverse attention to the Complainant. Her website is intended to influence those who are not already aware of her criticisms of the Complainant. Those looking for a website under a domain name identical to the name of the Complainant are most likely to be customers of the Complainant or potential customers or those having some business with the Complainant. The Respondent's intention must be to cause such people – who unintentionally arrive at her protest site – to become aware of her views as to the Complainant and its activities and, presumably, as a result, to act in a way they might not otherwise have done.

The argument has been advanced that any restriction on the Respondent using the Domain Names in this way amounts to curtailing the right of free speech – the right of the Respondent to make her protest. Any assessment of such a freedom involves balancing such rights with the rights of those affected by it – in this case the right of the Complainant to enjoy its rights and property in its trade name. Depriving the Respondent of her use of the Domain Names does not deprive her of her right to free speech.

Here it is open to the Respondent to carry on her campaign using a domain name that does not trespass on the Complainant's rights in its trade name in this way – either by using a different domain name altogether or by using one which includes a modifier such that the domain name is not confusingly similar to the Complainant's trade mark or one that made it quite apparent that the domain name was not associated with the Complainant but was being

used for the purposes of a protest site. Indeed the Complainant accepts in its Appeal Notice that a name such as "raydenengineeringisdestroyingtheworld.co.uk" would be "nominative use" and hence not objectionable under the Policy.

Such a name might, of course, be less successful in drawing the Respondent's criticism to the attention of customers of the Complainant. The Panel has considered whether the Respondent's protest is so exceptionally and plainly justified that its promulgation to the Complainant's customers could amount to a fair use of the identical name. As discussed earlier in this decision, the Panel is not in a position to investigate the merits of the protest in detail, and the evidence provided does not lead us to conclude in this case that the protester's rights to advertise her cause to the Complainant's customers should outweigh the Complainant's rights in its name.

We do not consider that the Respondent's use of the Domain Names is mere "nominative use". The Respondent has not simply used the Complainant's trade mark to refer to the Complainant by name or to identify the Complainant. The Respondent has used a name identical to the Complainant's trade mark as Domain Names to direct Internet users to her protest website.

Overall, for the reasons given, we consider that the Domain Names have been used by the Respondent in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights in the name RAYDEN ENGINEERING and that the Domain Names, in the hands of the Respondent, are therefore Abusive Registrations.

9. Decision

Accordingly, we find that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Names in the hands of the Respondent are Abusive Registrations. We therefore determine that the appeal against the Expert's decision be allowed and that the Domain Names be transferred to the Complainant Rayden Engineering Limited.

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Ian Lowe – Chairman

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Nick Gardner

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Claire Milne

29 April 2009