

## DISPUTE RESOLUTION SERVICE

DRS 08218

### Decision of Independent Expert

Applied Minds, Inc.

and

Applied Minds Limited

#### 1. The Parties:

Complainant: Applied Minds, Inc.

Address: Mr Daniel Hillis, Agent  
1209 Grand Central Avenue  
California  
Glendale  
Los Angeles

Postcode: 91201  
Country: US

Respondent: Applied Minds Limited

Address: Paul McKee  
48 New Brighton Road  
Emsworth  
Hants

Postcode: PO10 7QR  
Country: GB

#### 2. The Domain Name(s):

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

### **3. Procedural History:**

The Complaint was submitted to Nominet on 2 February 2010. On 3 February 2010, Nominet validated and notified the Complaint to the Respondent. The Respondent was informed in the notification that it had 15 working days, that is, until 24 February 2010 to file a response to the Complaint.

On 25 February 2010 the Respondent filed a Response. On 4 March 2010 the Complainant filed a Reply to the Response. The case proceeded to the mediation stage. On 25 March 2010 Nominet notified the parties that mediation had been unsuccessful and invited the Complainant to pay the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy"). On 29 March 2010, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 31 March 2010.

On 31 March 2010 the Expert was notified by Nominet that the Respondent's representative had filed a non-standard submission. Pursuant to paragraph 13 of the Procedure, the Expert has considered that submission.

### **4. Factual Background**

The Complainant, Applied Minds Inc., is a Delaware, USA corporation incorporated on 11 February 2000 which provides technology, design, research and development and consulting services. It is the owner of (1) US trademark registration no. 2631412 for the word mark APPLIED MINDS plus design, registered on 8 October 2002 in class 42; (2) US trademark registration no. 2897550 for the word mark APPLIED MINDS, registered on 26 October 2004 in classes 35 and 42; (3) Community Trade Mark registration no. 004896321 for a figurative mark containing the words "applied minds, inc.", registered on 17 January 2007 in class 42; and (4) Community Trade Mark registration no. 004896346 for the word mark APPLIED MINDS, registered on 30 January 2007 in classes 35 and 42. The Complainant is also the registrant of the domain name appliedminds.com, registered on 13 February 1998.

The Respondent, Applied Minds Limited, is a UK company incorporated in England and Wales under company no. 5127989 on 14 May 2004 which provides independent consultancy in the semantic web, ontologies and next generation knowledge management. The Respondent registered the Domain Name on 21 June 2004.

## **5. Parties' Contentions**

### **Complaint**

The Complainant's co-founder, Daniel Hillis, is internationally known for his work with computers, including his founding of Thinking Machines in 1983, as well as his work in developing the "MetaWeb", a next generation form of the semantic web. A Google search for Mr. Hillis results in 25,100 hits.

The Complainant describes its services as including "software development" and "algorithms". It is the originator of the MetaWeb. It has established substantial rights in connection with its US and Community trademark registrations, and as an internationally well-known, innovative company that offers services in connection with computer systems and software.

The Respondent maintains a website that describes its services as including the semantic web, ontologies and next generation knowledge management together with various forms of IT consultancy including legacy database analysis, domain specific languages, semantic web, and technical architecture. These are all areas in which the Complainant presently offers its services and in which it has continuously offered its services since being founded in 2000. The founder of the Respondent, Paul McKee, admits to a long term of endeavour in the area of computer architecture, including knowledge management and the semantic web and it is unlikely that he would not have heard of the Complainant and Mr Hillis.

The Complainant has asked the Respondent to cease and desist its use of the term APPLIED MINDS. After receipt of a communication from the Complainant, the Respondent modified its website homepage but this continues to use the Complainant's trade marks. There can be no doubt to the public that the Domain Name is related to the Complainant as the services and fields of endeavour are identical. The Respondent refers to the Metaweb, as originated by the Complainant, on its website. The confusion engendered by the Domain Name is inescapable. Visitors to the website associated with the Domain Name would understand that the Respondent is somehow related to the Complainant, for example as a European branch, even though there is no connection at all.

The Respondent continues to trade off the Complainant's goodwill and the Complainant will suffer a diminution of value in its goodwill unless the Domain Name is transferred. The Domain Name is an Abusive Registration because it takes unfair advantage of the goodwill established by the Complainant, to the unfair detriment of the Complainant's rights. It is unfair in that it allows an unrelated company to trade on the Complainant's goodwill in an area where the Complainant and its founder, are well known. It is inherently unfair because it allows an opportunistic and unrelated usurpation of both an established business identity and registered trademarks associated with that entity, where these rights and uses were established more than four years before the Respondent registered the Domain Name and where the

Complainant at that time had a US trademark registration and a pending US trademark application.

## **Response**

The Respondent is a British limited company that was registered on 14 May 2004. By September 2005, revenues were sufficient that the Respondent had to be registered for VAT. The Domain Name was registered on 21 June 2004 and construction of a website commenced. Throughout 2004 and the early part of 2005, the Respondent conducted research on the semantic web and next generation web technologies. Work was performed on using database metadata in order to drive Ontology development. The results of this work were published on the website associated with the Domain Name in the middle of May 2005, well before the Complainant filed its application for a community trade mark in 2006 which was ultimately granted in 2007.

The Complainant's own documentation shows that their use of MetaWeb technologies was not initiated until July 2005, months after the Respondent's website was published. It is possible that the Complainant used the ideas of the Respondent in developing the MetaWeb concept. The Respondent has been discussing Semantic Technologies on its web pages in a time frame predating anything that the Complainant seems to have done.

## **Reply**

The establishment of the Respondent postdates that of the Complainant by 4 years. The Respondent registered the Domain Name more than 6 years after the Complainant registered the identical name in the .com top level domain. The Respondent's work in new web technologies does not predate the work of Mr Hillis whose work is the subject, in part, of PCT patent application WO 2002/084590 which was published on 24 October 2002, nearly three years prior to Respondent's publication. The Respondent has acknowledged the Complainant's trade mark registrations some of which have been in effect since 8 October 2002, nearly 2 years before the Respondent was established.

Years before the Respondent's entry into the identical field of endeavour, the Complainant had established its company, its domain name, its trade marks, and had published its work in a field, acknowledged by the Respondent in their Response, that is identical to that of the Complainant. It tests the imagination to see how the Respondent could not have been aware of the Complainant's name and activities when it chose to register the Complainant's name as its own for use in connection with its website. Surely, the Respondent would have performed an availability search before registering its domain, noticed the Complainant's long standing previous registration, and, in the exercise of reasonable care, would have determined to select another name to avoid the likelihood that their use would be confusingly similar to that of the Complainant. Instead, without regard to such confusion, or perhaps to trade on the Complainant's goodwill, Respondent selected a domain name that it identical to the Complainant's in an identical field of endeavour.

## **Non standard submission of the Respondent**

The Respondent has relied on paragraph 13(b) of the DRS Procedure in filing a non-standard submission. Paragraph 13(a) of the Procedure provides, in part, that:-

*The Expert will not be obliged to consider any statements or documents from the Parties which he or she has not received according to the Policy or this Procedure or which he or she has not requested.*

By way of exception to that general principle, a party may file a non-standard submission accompanied by:-

*a brief explanation of why there is an exceptional need for the non-standard submission.*

In this case, the Respondent contended that the reply given by the Complainant contained a number of misleading statements, allegations, additional material and cast doubt on statements made by the Respondent. The Expert resolved to consider the full submission, in which the Respondent made the following further assertions:-

The Domain Name is a British domain name registered in support of a British company unrelated to the Complainant which is a US corporation.

The patent application produced by the Complainant shows work on something called the "Knowledge Web" which is nothing to do with and does not deal with the technologies discussed by the Respondent on its website. The Respondent does not claim any ownership of semantic web technologies, but rather to have knowledge of them and the ability to provide consultancy and advice.

The Respondent did not have prior knowledge of the Complainant's trade mark registrations. It became aware of the Complainant's community trade mark upon the initial contact from the Complainant in 2009. The Respondent had never heard of the Complainant before this. The Respondent spent many months in 2004 and 2005 researching the state of the art in semantic processing and the Complainant did not show up at any time. By the submission of the Complainant's documents it is clear that it did not start its work in semantics until July 2005 and does not appear to have published any work until 2007.

## **6. Discussions and Findings**

### **Preliminary**

It is worth stating at the outset of the discussion that the Expert has been presented by the parties with a range of complex and disputed facts, in particular, those which relate to the types of business in which the parties are

engaged and whether or not there is any overlap between their services. It is not the function of the Policy to determine complex questions of fact, particularly where these are disputed. Such a determination would usually require the presentation of detailed oral argument and evidence, together with cross-examination, all of which would entail a procedure much fuller, more complicated and more expensive than a complaint under the Policy should be. That said, in the present case the Expert has nevertheless attempted to address the factual issues based upon the parties' contentions and the documentary evidence which they have produced.

### **General**

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely 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**

Paragraph 1 of the Policy provides that Rights means "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

In the present case, the Complainant has produced evidence that it is the owner of the registered trade marks numbered (1), (2) and (4) for the word mark APPLIED MINDS noted in the Factual Background section above. The Expert notes for completeness that although the Complainant cited Community Trade Mark registration no. 004896321, numbered (3) in the Factual Background section, it failed to provide a copy of this in its supporting documentation, instead providing a copy of an application for a different Community Trade Mark which has not yet proceeded to grant. The Expert has confirmed the existence of registration no. 004896321 by visiting the OHIM website, adopting the approach of the expert in *Chivas Brothers Limited v. David William Plenderleith* (DRS 00292). In any event, given the number of suitable trade marks cited by the Complainant, its failure to provide a copy of the relevant entry in respect of one of these is not of any particular consequence.

The Expert finds that the Complainant has proved to the satisfaction of the Expert, on balance of probabilities, that it has Rights in a name which is identical to the Domain Name, white space being impermissible in a domain name, and the first (.uk) and second (.co) levels of the Domain Name being disregarded for the purposes of comparison as is customary in cases under the Policy.

### **Abusive Registration**

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 has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;*

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. These include paragraph 3(a)(ii):-

*Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which 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;*

Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration including paragraph 4(a)(i):-

*Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has:*

- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;*

It is now well established in cases under the Policy that knowledge by the Respondent of the Complainant and/or its rights at the relevant time is normally a pre-requisite for a domain name to constitute an Abusive Registration. In other words, when registering the domain name in issue the respondent registered it with that knowledge and/or when commencing the use of which complaint is made the respondent had that knowledge. This requirement was specifically identified in the Appeal Panel decision in *Verbatim Limited v. Michael Toth* (DRS 4331) and subsequently endorsed in the Appeal Panel decision in *Whistle Blowers Press Agency Ltd and*

*Commercial and Legal Services (UK) Ltd v. Ketts News Service Ltd* (DRS 07066) where the Appeal Panel held:-

*Ordinarily, some level of respondent knowledge of the complainant or its rights at time of registration (or commencement of the offending use) of the domain name is a necessary pre-requisite to getting a successful complaint off the ground.*

The Respondent in the present case has denied that it had any such knowledge of the Complainant's activities either when it registered the Domain Name in June 2004 or when it published its website (and thereby commenced the current use complained of) in around May 2005 (referred to collectively in the remainder of this decision as "the relevant dates"). In dealing with a similar denial on the part of the respondent in *Whistle Blowers*, the Appeal Panel stated:-

*Accordingly, if the Respondent is speaking the truth when it says that it was unaware of the existence of the Complainants and/or their rights in respect of WHISTLE BLOWERS when it registered the Domain Name and then when it first started making use of the Domain Name to connect to a website providing commercial services in respect of whistle blowers, the Complaint does not get off first base.*

Accordingly, it is necessary for the Expert to consider carefully the Complainant's contentions on the state of the Respondent's knowledge at the relevant dates, together with the supporting evidence which it has submitted, and to examine any relevant responses by the Respondent to the issues raised, as the Complaint is likely to stand or fall on this point.

The Complainant makes the following submissions which the Expert considers are relevant to this question:-

1. The Complainant's co-founder has an international profile and his work in new web technologies (including that of a published patent application) predates that of the Respondent.
2. The Complainant is an internationally well-known, innovative company that offers services in connection with computer systems and software.
3. The Complainant has continuously offered services in the same field as the Respondent since being founded in 2000.
4. It is unlikely that the Respondent would be unaware of the Complainant and its founder given that the Respondent's founder admits to a long term of endeavour in the area of computer architecture, including knowledge management and the semantic web.
5. The Complainant maintained a US trade mark and had already registered its domain name appliedminds.com by the time that the Respondent registered the Domain Name.



6. An availability search conducted at the point of registration of the Domain Name would have disclosed the Complainant's own domain name registration.

As far as supporting evidence for the above contentions is concerned, the Complainant has not provided the Expert with any material relating to the extent of its business and/or its fame or notoriety at the relevant dates. Those items which it has produced are mostly of recent date, and are as follows:-

1. Annex 6, a description of the Complainant's services which appears to have been extracted from the Complainant's website;
2. Annex 7, the Complainant's entry on the online encyclopaedia 'Wikipedia';
3. Annex 8, an entry from Wikipedia relating to MetaWeb Technologies Inc., a spinoff company from the Complainant founded in July 2005;
4. Annex 9, an entry from the website of MetaWeb Technologies Inc.; and
5. Annex 10, a Wikipedia entry relating to the Complainant's co-founder, Mr Hillis.

Each of these entries has a date stamp of 2 February 2010. None assists with the central question outlined above. In any event, had any of this material contained suitable evidence the Expert would nevertheless have viewed it with a degree of scepticism given that it is not from entirely independent sources; it is either generated by the Complainant, or by its related companies, or has been extracted from Wikipedia - a website which allows Internet users to create and edit encyclopaedia entries.

Annex 7 does contain references to two articles about the Complainant which were themselves prepared by independent third parties and which were published in quite close proximity to the relevant dates, the first being from Wired.com dated 21 June 2005 and the second being from the New York Times dated 30 May 2005. The Expert decided to review these items for completeness in terms of paragraph 16 of the Procedure which provides:-

*The Expert may (but will have no obligation to) look at any web sites referred to in the Parties' submissions.*

Although each of these articles was published close to the relevant dates there is nothing in either which would lead the Expert to conclude on balance of probabilities that the Respondent would have been aware of the Complainant at that time. While the MetaWeb is mentioned in passing in the Wired.com article, nothing is stated regarding the international fame of the Complainant, for example. Furthermore, the Expert does not believe that the personal profile of the Complainant's co-founder, Mr Hillis, however internationally known he himself might be, provides support to the Complainant's case on its own. While the fame of its co-founder might have led to notoriety on the part of the Complainant by the relevant dates, the

Complainant does not provide evidence as to whether or how this was the case.

The Complainant asserts that as the Respondent claims to be skilled in the semantic web he must have had knowledge of the Complainant on the basis of its co-founder Mr Hillis's work on the MetaWeb. The Respondent points out, with reference to the Complainant's Annexes, that the MetaWeb appears to have been initiated in July 2005, well after the Respondent registered and put the Domain Name to its current use. In reply, the Complainant produces an application by it, Mr Hillis and another for a patent relating to the "knowledge web" dating from 2002.

The Expert finds it rather surprising that the Complainant should rely on the MetaWeb as something of which the Respondent ought to have been aware at the time of registration or commencement of the use of the Domain Name when, according to the Complainant's own evidence, this appears to have begun life as a spinoff from the Complainant company into a different company, Metaweb Technologies, Inc., which was founded in July 2005 and which, according to its Wikipedia page, "operated in stealth mode until 2007". The brief mention of the MetaWeb in the Wired.com article dates from 21 June 2005. Clearly on no view could the Respondent have been alerted to the existence of the Complainant by virtue of the MetaWeb, based upon the evidence that is before the Expert.

With regard to the patent which the Complainant has produced, it is evident from this that the Complainant and its co-founder were working with something called the "knowledge web" in 2002 but the Complainant has not provided the Expert with any further information as to whether or how this technology relates to the services promoted by the Respondent on its website and how exactly this ought to lead to any conclusion that the Respondent must have been aware of the Complainant at the relevant dates.

The Complainant asserts that a US trade mark search would have disclosed the existence of the Complainant to the Respondent. The Respondent does not address this point directly other than to state that its only intent was to conduct trade in the UK and Europe. The Expert accepts the Respondent's contention that it was not intending to trade in the US and as such it is reasonable to infer that it would not necessarily have conducted trade mark searches in that territory. Equally, at the relevant dates the Complainant had yet to file its Community trade mark and nothing would have been disclosed by a search in the appropriate register.

The Complainant asserts that an availability search on the Complainant's domain name appliedminds.com would have led the Respondent to an awareness of the Complainant. It is certainly possible that the Respondent might have been alerted to the existence of the Complainant when checking availability for the Domain Name, by virtue of the fact that the Complainant had registered the identical second level name in the .com top level some four years earlier. The question for the Expert is whether this is more probable than not on the evidence before him.

The Appeal Panel in *Whistle Blowers* were faced with a very similar submission that the identity of the complainant would have been revealed to the respondent via the Whois at the point of registration of the contested domain name. However, the complainant's domain at the relevant time was not a '.com' but a '.uk.com'. The Appeal Panel found that as this was a less commonly used domain for a UK based business than a '.co.uk' or a '.com' domain it was not prepared to infer that it (and thereby the complainant's existence) would necessarily have been readily identified.

By contrast, the Expert in the present case is faced with a '.com' domain. It might be possible therefore to look at this question on the basis perhaps alluded to by the Appeal Panel in *Whistle Blowers*, namely that a '.com' domain, being a reasonably popular option for a UK based business, may lead to an inference that it would have been readily identifiable to the Respondent. However, the Expert considers that there is more to the question in the present case than the relative popularity of top level domains.

The Respondent states that it founded a British company, intending to conduct trade in the UK and Europe, and expressly denies knowledge of the Complainant. In the Expert's view it is not implausible that the Respondent, in the circumstances described, would have looked no further than the availability of the Domain Name, being a UK country code top level domain. Clearly not every prospective registrant desires or prefers the '.com' top level domain. Furthermore, it is perfectly possible for a prospective domain name registrant to apply for the registration of a .uk domain name without making, or being required to make, any alternative enquiries. Some registrars, as part of the registration process of the Domain Name, would have automatically provided the Respondent with the information that the '.com' variant was already registered, although by no means all registrars follow this practice. Accordingly, and taking the Respondent's denial into consideration, the Expert is unwilling to find that it is more probable than not that the Respondent checked availability on both .com and .co.uk variants of its chosen name - and that it then went further to investigate the owner of the .com domain or to visit its website - and was thereby aware of the Complainant at the point of registration of the Domain Name.

It has not escaped the Expert's notice that, if the Respondent's denial of knowledge is to be accepted, there remains a rather curious coincidence which must be addressed, namely that the Respondent, operating in substantially the same field as the Complainant, should have selected exactly the same name, APPLIED MINDS, for its Domain Name. The name can hardly be regarded as predominantly descriptive of the parties' services, and therefore particularly liable to selection by entities providing such services. This contrasts with the situation in *Whistle Blowers* where the respondent had selected the term 'whistleblower' for the provision of commercial services in respect of whistle blowers. That said, it is not the first time that the Expert has seen such a coincidence occur on the Internet in entirely genuine circumstances, due in most part to the finite nature of suitable names and expressions in the English language. While coincidences of this nature must inevitably raise some suspicion, the Expert does not believe that this is, on its own, capable of leading to a conclusion on balance of probabilities that the

Respondent must have selected his Domain Name because it was the same name as that of the Complainant, of whom the Respondent had become aware at the relevant dates. In the Expert's view, something stronger than coincidence or suspicion is required in order to tip the balance of probabilities in the Complainant's favour and this is lacking in the present case.

Considering all of the submissions and supporting documentation put forward by the Complainant together with the Respondent's submissions and supporting documentation, as outlined above, the Expert finds that there is insufficient evidence to establish on the balance of probabilities that the Complainant's activities under the name or mark APPLIED MINDS at the relevant dates were such that the Respondent must have known of the Complainant or its activities. Accordingly, the Expert finds that the Complainant has failed to prove that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The Complainant asserts that confusion will arise because "the names of the companies are identical, their domain names (except for the geographic extension) are identical, and their product offerings are identical". This is worthy of additional comment. The Expert appreciates that the Complainant has genuine concerns arising from the Respondent's use of an identical name in connection with the same or similar goods and services. Although the Complainant does not make an express submission to this effect, the Expert believes that the Complainant's concern is effectively that the actions of the Respondent may constitute either trade mark infringement or passing off. If the Expert is correct in that assumption (which in any event does not affect the decision on Abusive Registration) the manner in which the Appeal Panel addressed similar concerns of the complainant in *Whistle Blowers* bears repeating, namely that questions of trade mark infringement and passing off are not issues to be resolved in Nominet DRS proceedings and that:-

*The mere fact that registration and/or use of a domain name may constitute trade mark infringement or passing off does not necessarily mean that the domain name is an Abusive Registration under the Policy.*

## 7. Decision

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is identical to the Domain Name but has not proved that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that no action be taken with regard to the Domain Name.

**Signed** .....  
Andrew D S Lothian

**Dated** 19 April, 2010 .....