

# **DISPUTE RESOLUTION SERVICE**

**D00013278**

## **Decision of Independent Expert**

The University of Durham

and

Mr Amit Matalia

### **1. The Parties**

Complainant: The University of Durham  
The Palatine Centre  
Stockton Road  
Durham  
County Durham  
DH1 3LE  
United Kingdom

Respondent: Mr Amit Matalia  
15 Moreall Meadows  
Coventry  
CV4 7HL  
United Kingdom

### **2. The Domain Name**

cem11plus.co.uk ('the Domain Name')

### **3. Procedural History**

Nominet checked that the complaint dated and received on 10 September 2013 complied with its UK Dispute Resolution Service ('DRS') Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint, inviting him to file a response. That response was received on 30 September. On 4 October, the Complainant offered a reply to the response.

Nominet attempted to resolve the dispute by informal mediation. When that failed, it advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 17 October.

On 17 October 2013 I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

Both parties then asked to make further statements, beyond the complaint, response and reply that are part of the DRS standard process. The Procedure says (paragraph 13):

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.

Any communication with us intended to be passed to the Expert which is not part of the standard process...is a 'non-standard submission'. Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission. We will pass this explanation to the Expert, and the remainder will only be passed to the Expert at his or her sole discretion.

The Respondent's request to make a further statement reflected his taking issue with the Complainant's reply. The explanatory paragraph read:

I wish to make a very short non-standard submission in connection to point 4 of the reply which introduced new information that was very misleading and arguably false and totally irrelevant to the case in question. In these proceeding, the reference to an ex-parte super-injunction which is not between the Complainant and Respondent was not appropriate and highly abusive. This creates an exceptional circumstance and the need for a short response in this case of reverse domain hijacking. The response will be short due to the nature of the interim super-injunction which is not open to discussion for legal reasons.

I agreed to view that further statement. I also invited the Complainant to comment on it – an invitation that the Complainant accepted.

The Complainant's request to make a further statement was supported by an explanatory paragraph in the following terms:

I wish to make a non-standard submission in support of case 13278 in light of further evidence which the University has been able to compile following submission of the University's latest response. The University is of the opinion that the evidence attached to this email counters many of Mr Matalia's claims in defence of this case, and provides further clarification as to the problems the University has experienced in respect of [www.cem11plus.co.uk](http://www.cem11plus.co.uk) and Mr Matalia's actions through this site.

Having read that explanation by the Complainant, I declined to view the further statement and said I would set out my reasons for that in this decision. It seemed to me that the Complainant was seeking to put forward extra evidence that should have been part of the original complaint. As the *Experts' Overview* makes clear (section 5.9), the chance to make a further statement is not intended as an opportunity for parties to improve their case simply by expanding on their original submissions. I contrasted that with the Respondent's further statement, which sought to address a point which only arose in the Complainant's reply and that therefore could not reasonably have been dealt with at the response stage.

As this decision was being finalised, the Respondent asked to make a second further statement. The explanatory paragraph read

I wish to make a non-standard submission to reveal to the Expert the domain names the Complainant has been registering (after [cem11plus.co.uk](http://cem11plus.co.uk) was registered and live) that are similar to [cem11plus.co.uk](http://cem11plus.co.uk) and resolving to its own web sites.

Having viewed that explanation I declined to accept the second further statement. As with the Complainant's further statement, this seemed to me no more than an attempt to advance additional evidence that could have been put forward within the standard process.

#### 4. Factual Background

I have visited the web site to which the Domain Name resolves and the Complainant's web site at cem.org. From the complaint, the response, the reply, the Respondent's further statement, the Complainant's comments on that statement, those visits and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Centre for Evaluation and Monitoring (CEM) was established over thirty years ago. Within the last twenty years it has been acquired by the Complainant, becoming a department of the University. CEM is now one of the largest independent providers of educational assessment and monitoring systems in the world. CEM's assessments are used in more than fifty countries, in relation to over one million children.

Through CEM, the Complainant delivers paper and computer-based services to schools, trusts and local authorities in the UK. Those services include '11 plus' tests for ten and eleven-year old children, as part of the selection process for grammar school entry. In an attempt to ensure that testing is as fair as possible and does not rely on excessive preparation, the Complainant does not make any practice materials available commercially.

The Complainant says it has invested considerable time and money to build up the reputation of CEM and that, as a result, the CEM name is associated internationally with excellence in school entrance testing services.

In November 2012 the Complainant registered, as a trade mark, a logo with the letters 'CEM' in capitals, a distinctive star bursting above the 'M' and the words 'Centre for Evaluation and Monitoring'. The effective date of the registration was 4 May 2012. Trade mark registrations for 'CEM' and 'CEM Centre for Evaluation and Monitoring' followed in August 2013, with an effective date of 8 February that year.

The Respondent registered the Domain Name on 3 January 2013. It resolved to a web site providing information and materials relating to 11 plus tests. Later, sample questions and a shop selling mock exams, lessons and word lists were added.

In early November 2013, the home page at the Domain Name began with the following text:

**The 11+ information site providing Children's Educational Material for the 11+ (CEM 11+TM), covering 11+ and 10+ grammar school entrance exams.**

The cem11plus.co.uk web site provides advice and information about 11 plus exams and Children's Educational Material for the 11+. The CEM 11+™ site includes advice on how to prepare for 11plus exams and material suitable for preparation. This is NOT the official web site of CEM Centre for Evaluation & Monitoring® or the University of

Durham® and this site has no connection or association with either organisation. The CEM Centre for Evaluation & Monitoring® does NOT sell any preparation material to the public nor does it endorse any products and it does not deal directly with the public.

The Respondent has also registered other domain names, including elevenplus.co.uk, elevenplusexams.co.uk and 11plus.co.uk.

## **5. Parties' Contentions**

### *Complaint*

The Complainant says it has rights in the name 'CEM' and that the Domain Name is an abusive registration for reasons that fall into two broad categories: the Respondent seeks to

- (1) trade off the back of the Complainant's reputation, in order to sell educational materials. It does so in part by confusing web site visitors into believing that the Domain Name is connected with the Complainant.
- (2) disrupt the business of CEM and the University of Durham and damage their good name and the reputation of the testing services provided by the Complainant, using the web site at the Domain Name to
  - (i) publish what the Respondent believes to be confidential testing material
  - (ii) encourage parents to take school entrance tests outside their home catchment areas.

### *Response*

The Respondent says that this is not an abusive registration for the following reasons.

- (1) He is not trading off the back of the Complainant's reputation, or relying on any confusion:
  - (i) the Domain Name is being used for a web site established to promote a business legitimate in its own right and to support a genuine offering of goods and services.
  - (ii) '11 plus' is a descriptive term for an exam used in selection for grammar schools. 'CEM' is an acronym used for various terms, many in education. The combination ('CEM11plus') was coined by the Respondent.

(iii) when the Domain Name was registered, the Complainant did not have registered rights in the letters 'CEM' alone. According to the UK Intellectual Property Office:

The mark the University owns is a logo with the words incorporated into the logo, they do not have the ultimate protection over the word CEM, they have protection for their logo (with 'limited' protection over the words) as the logo is seen as the distinctive element to the mark within their area of goods/services stated.

Only subsequently did the Complainant apply for trade mark registration of 'CEM' alone. The claiming of rights here by the Complainant is retrospective and unfair.

(iv) many educational establishments use the abbreviation 'CEM'. The Respondent has used the terms 'CEM 11+' and 'CEM11plus' in his web sites since 2010.

(v) there is no evidence of confusion (and the likelihood of such confusion is reduced because the Domain Name suffix is .co.uk, whereas the Complainant's own web site is, and would be expected to be, reached through a domain name that ends .org):

- the Complainant is not known as 'CEM 11+' or 'CEM11plus'. A Google search for 'CEM11plus' results in a first page hit for the Domain Name, but searching on 'CEM' will return, on the first page, neither a link to a company providing information or services to the public relating to the 11 plus nor the Domain Name.
- the Respondent uses the letters 'CEM' to stand for 'Children's Educational Material'.
- the Respondent has arranged disclaimers on the web pages at the Domain Name, making clear that the web site has no connection with the University of Durham or the Centre for Evaluation and Monitoring.

(vi) in any event, there could be legitimate fair use of a domain name that incorporates someone else's trade mark even if it did cause confusion. For a domain name to be an abusive registration, there needs to be something 'morally reprehensible' about the Respondent's behaviour (and, by implication, there has not been).

(2) The Respondent has no intention of disrupting the Complainant's business. In particular:

(i) he is not illegitimately reproducing material in which the Complainant has copyright. It is simply that the Complainant reuses

tests and that test material then inevitably gets into the public domain in time to be viewed by prospective candidates.

(ii) encouraging the taking of school entrance tests outside the candidate's local catchment area is allowable and in any case the Complainant's views about that are irrelevant to the present dispute.

(iii) even if one element of the Complainant's case were accepted, that the Respondent is trying to take advantage of the Complainant's reputation, it would be counterproductive for the Respondent to disrupt its business.

In any event

(iv) the Complainant does not trade with the public, so there can be no financial consequences associated with business 'lost' from members of the public and therefore no risk of business disruption.

The Respondent makes a number of other points in his *Response*, as follows.

(3) The Complainant has a history of aggressively threatening the Respondent for trade mark infringement. Given that the Complainant only registered rights in 'CEM' in August 2013, the earlier threats amount to harassment. Effectively, the Complainant is acting in bad faith.

(4) Running for completeness through the DRS Policy's non-exhaustive list of factors that may be evidence that a domain name is, or is not, an abusive registration, the Respondent says that none of the factors that might point to an abusive registration applies. Of the factors that might point to the Domain Name's not being an abusive registration, the Respondent says the following are relevant here:

(i) he has been using the Domain Name in connection with a genuine offering of goods and services.

(ii) he has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

(iii) he has made legitimate non-commercial or fair use of the Domain Name. (The Respondent says he used the term 'CEM 11+' on CoolCleverKids.co.uk some three years earlier.)

(iv) the Domain Name is descriptive of what is available at the web site to which it resolves: children's educational material for the 11 plus.

(5) It would not be appropriate for a university to use a .co.uk domain or for the Domain Name to be transferred to it.

*Reply*

In its reply, the Complainant touches on all three main areas of dispute. (The numbering here relates to the numbering in the *Complaint* and *Response* sections above.)

(1) The Respondent's claim that 'CEM' stands for 'Children's Educational Material' is undermined by the disclaimer he added to the web site at the Domain Name in January 2013, to the effect that 'CEM11+' stands for 'Child Education Methods for the 11+'. In the Complainant's view, the Respondent is making up terms to fit the acronym in an attempt to construct a defence against a claim that his use of 'CEM' is infringing the Complainant's rights. That conclusion is supported by the fact that, in January 2013, the Respondent's web site referred to the Complainant as 'CEM' and to the Complainant and its examination material as 'CEM 11+ tests'.

(2) On the question of disruption, the Complainant has copies of materials in which it holds the copyright, taken directly from the web site at the Domain Name (with the Complainant's copyright acknowledged). Evidence of disruption to the Complainant's business includes legal action being taken by Warwickshire County Council (one of the Complainant's customers), following the Respondent's publishing of some of the testing material supplied to the Council by the Complainant.

(3) Through its legal team, the Complainant has contacted the Respondent on four occasions – three times by letter and once by email. That does not constitute harassment.

#### *Respondent's further statement*

The Respondent's further statement focuses on the reference made by the Complainant, in its reply, to the legal action between the Respondent and Warwickshire County Council. The Respondent says that that action, to which the Complainant is not a party, is irrelevant. The case has not yet been heard anyway. It must be disregarded.

In the Respondent's view, the raising of the issue is further evidence of bad faith, in that the Complainant is colluding with Warwickshire County Council in a case of reverse domain name hijacking.

The further statement also contains some claims about Warwickshire County Council's motive for its legal action. I do not set out those claims here, for reasons explained below.

#### *Complainant's comments on that further statement*

The Complainant says that the legal action being taken by Warwickshire County Council was offered as evidence of disruption to the Complainant's business – through the Respondent's behaviour towards the Complainant's customers.



In the Complainant's view, while the Respondent has personal issues with Warwickshire County Council, there is nothing especially significant about this particular one of the Complainant's customers – it was highlighted only in offering an example of the Respondent's causing disruption to the Complainant's business.

## **6. Discussion and Findings**

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

- it has rights in respect of a name or mark which is identical or similar to the Domain Name; and that
- the Domain Name, in the hands of the Respondent, is an abusive registration.

### *Rights*

I accept that the Complainant has been using the acronym 'CEM' for many years. The Respondent says that, on the Complainant's own case, it has been known as 'CEM Centre' or the 'Centre for Evaluation and Monitoring' and that it has not therefore been referred to as 'CEM' alone. He points out that the trade mark registration that preceded registration of the Domain Name provided only limited protection for the acronym 'CEM'. I accept that the Complainant does not have exclusive rights over 'CEM'. Nevertheless, it seems to me clear that, at the time the Domain Name was registered, the Complainant had established both unregistered rights and at least limited registered rights in the name 'CEM'.

'11 plus' is a generic term for a type of school entrance exam, related to the Complainant's field of activity.

The Domain Name is 'cem11plus.co.uk'. Ignoring the .co.uk suffix as simply a generic feature of the domain name register, that Domain Name comprises a name in which the Complainant has rights and a generic term related to its business.

I conclude that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name.

### *Registration*

As defined by the Policy, an abusive registration is a domain name which:

- 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

- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights.

At the heart of this dispute is the use of the term 'CEM'. I accept that the Complainant took some time to establish even limited registered rights over 'CEM' (and that there may be many educational establishments with names that fit the abbreviation 'CEM') but it is clear that it had at least unregistered rights in 'CEM' at the point the Domain Name was registered. At the same time, I find the Respondent's explanation for his choice of domain name unconvincing. The Complainant draws attention to the inconsistency: at one point, the Respondent says that he uses 'CEM' to stand for 'Child Education Methods'; at another, he says it stands for 'Children's Educational Material'. I think the more probable reason the Respondent chose to include 'CEM' in the Domain Name was to refer to the Complainant or to testing materials supplied by the Complainant.

The fact that it was the Respondent who assembled the phrase 'CEM 11plus', and that he has been using it for several years, therefore has to be viewed alongside the likelihood that the 'CEM' it refers to is the Complainant. It seems clear to me that the Respondent set out to use the Domain Name to attract internet users looking for help and advice in relation to 11 plus tests supplied by the Complainant.

The extent to which that could disrupt the Complainant's business may be debatable. The Respondent is not competing with the Complainant, in a narrow sense. On the other hand, I do not accept that, because the Complainant does not trade with the public, it has no business to disrupt: whatever the commercial arrangements and whoever its customers, on a wider view it is evidently in the business of supplying testing materials. Its reputation is important and obviously could be affected by the use of the Domain Name for a web site related to its activities.

The potential for confusion is even clearer. If 'CEM' is taken to refer to the Complainant or its testing materials, '11 plus' is a naturally complementary descriptor. The Respondent concedes that a Google search for 'CEM 11 plus' would return a first page hit for the Domain Name. He says that searching on 'CEM' in Google will not return the Domain Name (or any company providing information or services to the public relating to the 11 plus) on the first page. But that does not seem to me to eliminate the reasonable likelihood of confusion.

I accept that the Respondent has put highly visible disclaimers on the web site to which the Domain Name resolves. But by then it is too late. If internet users are looking for the Complainant and end up at the web site at the Domain Name, there has been 'initial interest confusion'. As the *Overview* says (section 3.3):

the overwhelming majority of Experts view [such confusion] as a possible basis for a finding of Abusive Registration, the vice being that

even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)...However, the activities of typosquatters are generally condemned...as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity.

That seems to me squarely the position here: the Respondent has attached, as an appendage to the Complainant's name, a word (or, in this case, the phrase '11 plus') appropriate to the Complainant's field of activity.

I have considered the Respondent's claim that the Complainant has been acting in bad faith. I have observed two parties arguing their cases vigorously but I have not seen evidence of bad faith and, specifically, I do not regard the actions of the Complainant as constituting what the Policy refers to as 'reverse domain name hijacking'.

I can now deal with the other points made during the course of the dispute.

I accept that the Respondent is using the Domain Name in connection with a genuine offering of goods and services, but that is not conclusive of the character of the registration because that use must not take unfair advantage of the Complainant's rights.

I do not accept that the claiming of rights here by the Complainant is retrospective and unfair. In my judgement, the Complainant's registered rights were preceded for many years by unregistered rights.

It does not seem to me to help the Respondent's case that the Domain Name suffix is .co.uk, whereas the Complainant's own web site is, and would perhaps be expected to be, reached through a domain name that ends .org. The expectations of internet users here are far from certain and the generic suffix to a domain name is less significant than the distinctive main element.

It is conceivable that there could be legitimate fair use of a domain name that incorporates someone else's trade mark even if it did cause confusion. The *Overview* acknowledges as much (section 4.7). The Respondent argues that, for the Domain Name to be an abusive registration, there would need to have been something 'morally reprehensible' about his behaviour. But I think in this case it is possible to take a view, without any elaborate moral weighing, about

whether the registration has taken unfair advantage of the Complainant's rights.

It seems clear to me that copyright material has been published on the web site at the Domain Name. The Complainant's copyright appears to have been acknowledged, though it remains the case that the reproduction was without the Complainant's approval.

The Complainant says that the use of the Domain Name to publicise advice about the taking of tests out of a candidate's local catchment area is evidence that the registration is being used to disrupt its business. That is a moot point, but the Respondent would be on firmer ground if there were no reasonable prospect of confusing the vehicle for that advice with a web site connected with the Complainant. I have already concluded that such confusion is possible.

I agree with the Respondent's implication that, though the Complainant's two arguments are not presented as alternatives, they must be: if the Respondent seeks to take advantage of CEM's reputation, it follows that it is not in his interests to damage that reputation; equally, if the Respondent has set out to damage CEM's good name, that would hardly be consistent with his taking advantage of that good name. But, whatever the Respondent's motives, it remains true that there is significant potential for both confusion and disruption.

The Policy says (paragraph 4 a i C) that one factor that may be evidence that a domain name is not an abusive registration is that there has been legitimate non-commercial or fair use of it. The Respondent suggests there has, because he used the term 'CEM 11+' on CoolCleverKids.co.uk some three years earlier. But the suggestion relates to the phrase not the Domain Name. Whether the Domain Name has had legitimate non-commercial or fair use is for me to decide here.

The Respondent also says that the Domain Name is descriptive of what is on offer at the web site ('Children's Educational Material for the 11+'). But the Policy (paragraph 4 a ii) acknowledges that the Respondent needs to be making fair use of a Domain Name that is descriptive – and, again, that is for me to decide.

I attach no significance to the evidence before me about the legal action being taken by Warwickshire County Council. As the Respondent notes, the case has not yet been heard and, in any event, the Complainant is not a party to the action. The Respondent regards the case as irrelevant to the question before me. I agree and, on that basis, I decline to discuss the points raised by the Respondent in his further statement and I draw no inferences, either way, from any of the evidence relating to this legal action.

The underlying question here is whether the registration or use of the Domain Name has taken unfair advantage of or been unfairly detrimental to the Complainant's rights. It seems to me that, in choosing a name that is likely to

be taken to refer to the Complainant (especially given the addition of the phrase '11 plus') and establishing a web site to receive internet traffic likely, in part, to have been attracted by the Complainant's reputation, the Respondent's registration and use of the Domain Name has taken advantage of the Complainant's rights – and done so in a way that is unfair.

The Respondent says that it would not be appropriate for a university to use a .co.uk domain and that therefore, in any event, the Domain Name should not be transferred to the Complainant. I acknowledge that the .co.uk second level domain is intended for use by commercial enterprises, but that does not strike me as inevitably incompatible with the holding of the Domain Name by the Complainant.

## **7. Decision**

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the Domain Name be transferred to the Complainant.

**Mark de Brunner**

**9 November 2013**