

DISPUTE RESOLUTION SERVICE

D00014142

Decision of Independent Expert

Department for Transport

and

Andrew Brown

1. The Parties:

Complainant: Department for Transport
Great Minster House
Horseferry Road
London
SW1P 4DR
United Kingdom

Respondent: Andrew Brown
145-157 St John Street
London
EC1V 4PW
United Kingdom

2. The Domain Name(s):

dvlauk.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

13 November 2014 10:37 Dispute received
13 November 2014 11:39 Complaint validated
13 November 2014 11:54 Notification of complaint sent to parties
02 December 2014 01:30 Response reminder sent
05 December 2014 10:51 No Response Received
05 December 2014 10:52 Notification of no response sent to parties
17 December 2014 01:30 Summary/full fee reminder sent
18 December 2014 14:36 Expert decision payment received

4. Factual Background

I find the following facts as proved based on the evidence and submissions made by the Complainant and which form the basis for my Decision:

- i. The Complainant is a government body entitled the “Driver and Vehicle Licensing Agency” since 1990 and commonly referred to by its initials as “DVLA”.
- ii. Its function is the processing and maintenance of the records kept of vehicles and drivers together with drivers’ endorsements, disqualifications and medical conditions.
- iii. The Complainant has as of 7 February 2003 secured trade mark protection for its popular name, “DVLA”, including UK trade mark 2297001.
- iv. The Complainant has since May 2004 maintained webpages under the gov.uk domain which provide various online services for drivers.
- v. The Respondent registered the Domain Name on 4 March 2011.
- vi. As at the date of writing this Decision, the webpage to which the Domain Name resolves in fact displays the message included as Annex 1 to this Decision.

5. Parties’ Contentions

The Complaint as submitted is in two versions: one is a short version and the second is a fuller version referring to various annexes. However, that fuller version does not have all of the various Annexes as described. I questioned of Nominet by email dated 11 January 2015 whether I had a full set of documents, and Nominet confirmed to me by email of the following day both that I had a copy of everything that had been submitted to Nominet and also that the Respondent had had access to the same material.

While the fuller Complaint does not have all five of the Annexes it refers to, there are two documents included in the Complaint which correlate to two of those Annexes: these are a copy of UK trade mark 2297001 (but not of UK trade mark 2297000 also referred to in the Complaint) which would have been Annex 3 and also a copy of the letter to the Respondent from the Complainant dated 6 August 2014 which would have been Annex 2.

Having satisfied myself that these documents, incomplete as they are, were available to the Respondent, I decided to proceed with the Complaint on the basis of the submissions and evidence actually available.

The Complainant submitted as follows:

- i. The parties are not connected and the Respondent has no licence from the Complainant and no legitimate interest in registering or using the Domain Name.
- ii. At the time of registration, the Complainant had already enjoyed registered UK trade mark rights for at least 8 years.
- iii. "DVLA" is well-known as an abbreviation referring exclusively to the Complainant, and there is a risk of confusion by consumers.
- iv. It appears that the Domain Name has been registered in order to suggest to consumers that there is a connection between the parties.
- v. The website to which the Domain Name resolves included, as at the date of the Complaint, some pages offering services for sale, including filling in forms and checking them for errors or omissions; these services are offered especially with regard to applications for provisional driving licences, for the replacement of lost, stolen, or damaged driving licences, for the renewal of driving licences and for the change of addresses on driving licences.
- vi. The Respondent's website contained a number of disclaimers, but a disclaimer cannot legitimise breach of the Complainant's Rights given that consumers may be initially confused.
- vii. The Domain Name is confusingly similar to the Complainant's trade mark, and the addition of a geographical indication ("uk") can be disregarded.
- viii. The Domain Name could be mistaken by consumers for the service offered by the Complainant.
- ix. The Respondent has not shown any reason why it should want to acquire or use the Domain Name.
- x. The Domain Name was registered with the intention of disrupting the Complainant's business.
- xi. The Respondent registered the Domain Name in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- xii. The Domain Name is therefore an Abusive Registration.

The Respondent did not respond.

6. Discussions and Findings

Any complainant in the Nominet DRS procedure must prove, on the balance of probabilities, that he has Rights and that the respondent's registration or continued registration of a domain name, is an "Abusive Registration". I shall look at both of these concepts in order.

Rights

“Rights” are defined in the DRS Policy as *“rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”*.

Under paragraph 2(a) of the DRS Policy, a complainant must show that it *“has Rights in respect of a name or mark which is identical or similar to the Domain Name”*.

As observed above, the Complainant has failed to provide all of its Annexes to its Complaint. However, it has provided one UK trade mark registration, which is undoubtedly a “Right” for the purposes of the DRS Policy. A complainant under the DRS Policy typically has a low threshold to pass when establishing that it has Rights. It is not necessary to have the evidence of the UK trade mark not annexed to the Complaint, nor to have any further evidence of goodwill attaching to the trade mark “DVLA” such as would support an action in passing off: the single trade mark provided as evidence by the Complainant is sufficient to show that the Complainant has “Rights”.

Furthermore, given the fact that the Domain Name includes the very letters making up the Complainant’s trade mark, the only difference being the addition of “uk”, I am satisfied that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

Abusive Registration

The DRS Policy defines an 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;”*

Paragraph 3 of the DRS Policy sets out some examples of what can amount to evidence of an Abusive Registration; however, the introductory words to that paragraph say that the factors there listed are a non-exhaustive list and I do not take the list of factors as some sort of comprehensive code.

In fact, reading through the various factors listed in paragraph 3, none of them strictly speaking applies to this situation: this is not least because the Complainant failed to supply actual evidence of use by the Respondent as opposed to making some statements about it in its Complaint. Taking into account the Complainant’s submissions, especially its submissions about the

chargeable services in respect of various services to do with assisting with applications to the Complainant, that would amount to evidence that the Domain Name was registered “for the purpose of unfairly disrupting the business of the Complainant” (see DRS Policy paragraph 3(a)(i)(C)). It would furthermore amount to evidence that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people into believing that the Domain Name is operated or authorised by, or otherwise connected with, the Complainant (see DRS Policy paragraph 3(a)(ii)).

In the specific circumstances of this case, taking account of the abridged contents of the Complaint, it is not necessary to rely on the strict words of paragraph 3, but more desirable to go back to the definition of Abusive Registration, especially the first limb. The question I am therefore asked to decide on is whether, as the time of registration, that registration “took unfair advantage of or was unfairly detrimental to the Complainant’s Rights”. I take account of the following factors: first, the Domain Name includes the very four letters comprising the Complainant’s Rights; secondly, the only distinction is the addition of “uk”; thirdly, the Complainant is a UK government body well known by the first four letters of the Domain Name and, finally, there is no other obvious meaning to be given to the four letters “DVLA”. Therefore, it seems to me that the registration of the Domain Name is, on the balance of probabilities, an Abusive Registration. The circumstances of the similarity between the Domain Name and the Complainant’s Rights suggest a strong risk of confusion in the minds of the public.

Paragraph 4 of the DRS Policy contains a non-exhaustive list of factors which may show that the registration is not an Abusive Registration. The Respondent has not provided any response, but I have nonetheless examined the Complainant’s submissions and evidence to ascertain whether the Respondent could in fact avail itself of any of the factors there listed. I have come to the conclusion that it cannot. More generally, given that the list is non-exhaustive, I have concluded that there are no factors indicating that the Domain Name is not an Abusive Registration.

7. Decision

I find that the Complainant has Rights identical to the Domain Name and that the holding of the Domain Name by the Respondent is an Abusive Registration.

I direct that the Domain Name be transferred to the Complainant.

Signed: Richard Stephens

Dated: 15 January 2015

Annex 1

12/01/2015

403 Forbidden

Forbidden

You don't have permission to access / on this server.

Additionally, a 404 Not Found error was encountered while trying to use an ErrorDocument to handle the request.