

DISPUTE RESOLUTION SERVICE

D00016968

Decision of Independent Expert

Mythe Software Limited

and

Garth Piesse

1. The Parties:

Complainant: Mythe Software Limited
Mythe Cottage Farmhouse
Atherstone Road, Ratcliffe Culey
Atherstone
Leicestershire
CV9 3QW
United Kingdom

Respondent: Mr Garth Piesse
PO Box 181
Palmerston North
4440
New Zealand

2. The Domain Name:

mythe.uk (hereinafter “the Domain Name”).

3. Procedural History:

The Complaint was submitted to Nominet on 18 January 2016. On 19 January 2016, Nominet validated the Complaint and notified it to the Respondent. The Respondent was informed in the notification that he had 15 working days, that is until 9 February 2016, to file a response to the Complaint.

On 8 February 2016 the Respondent filed a Response. The Complainant did not file a Reply to the Response and the case proceeded to the mediation stage on 22 February 2016. On 23 February 2016, 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 9 March 2016, Nominet notified the Respondent that the Complainant had not paid the expert decision fee and provided the Respondent with the option of making payment pursuant to paragraph 8(b) of the Procedure. On 11 March 2016, the Respondent paid the fee for an expert decision. On 14 March 2016, 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 17 March 2016.

4. Factual Background

The Complainant is a private limited company incorporated in England and Wales under company number 08828341 on 31 December 2013. The Complainant was originally named Symtex Software Limited from its incorporation date until 24 March 2014, when it changed its name to Mythe Software Limited. On 25 January 2016, following the initial stages of compulsory strike-off procedure, the Complainant filed accounts for a dormant company made up to 31 December 2014.

The Complainant registered the Domain Name (together with <mythe.co.uk>, which is not the subject of the present proceeding) under the registrant name of SYMTEX on 31 August 2014. The expiry date of the Domain Name was 31 August 2015 but the Complainant did not renew it and eventually it returned to the pool available for registration.

The Respondent is a private individual based in New Zealand and is a dealer in domain names. The Respondent registered the Domain Name on 1 December 2015 (along with <mythe.co.uk>). The Respondent then listed the Domain Name for sale with a domain name broker.

On or about 13 January 2016, the Complainant made contact with the Respondent's domain name broker to enquire about the Domain Name. On 14 January 2016, the broker replied stating that the Domain Name was appraised in the sum of 5,000 United States Dollars ("USD"). The Complainant responded stating that the

valuation was fanciful because the Domain Name had been acquired opportunistically after its expiry. The broker then replied on 15 January 2016 suggesting that the Complainant make a counter-offer. The Complainant replied that the Domain Name was purchased speculatively for profit and seeking transfer. Thereafter, the broker responded to the Complainant, “Mythe is French for Myth, a very generic word that could be used in multiple industry sectors” and invited the Complainant to take matters up with its registrar if it did not renew the Domain Name. The Complainant took issue with this response, stating that the Domain Name was a “.uk” and not a “.fr” domain and asking how it applied to the Respondent’s industry sector. At this point the correspondence between the Complainant and the Respondent’s broker appears to have ceased.

5. Parties’ Contentions

Complainant

The Complainant submits that it operates as the UK business “Mythe Software Limited” and explains that it was previously the registrant of the Domain Name. It adds that due to a prolonged period of ill health it was unable to respond or react to expiry notices regarding the Domain Name which then lapsed and was acquired by the Respondent for the purpose of selling or renting.

The Complainant contends that the Respondent’s offer to sell the Domain Name blocks the Complainant from using a name which it should be able to use. The Complainant claims a clear right to continue using the Domain Name “above that of the persons who have registered this for the purpose or [*sic*] profiteering”. The Complainant argues that the nameservers to which the Domain Name is delegated, which contain the words “buy” and “sell” are indicative of the fact that the Domain Name was registered solely for the purpose of sale and profit from sale.

The Complainant submits that the Respondent has provided a fee to transfer ownership of the Domain Name to the Complainant and states that this contravenes paragraph 3(a)(i)(A) of the Policy. The Complainant also asserts that the Respondent has registered the Domain Name as a blocking registration against a name in which the Complainant has rights “as a trading business with the name Mythe Software”.

Respondent

The Respondent disputes that the Complainant has acquired any rights in the term “Mythe”, asserting that the Complainant has failed to produce any evidence of (1) trading by reference to the name or (2) recognition of the name by the purchasing trade/public as indicating the Complainant’s services. The Respondent adds that the likelihood is that the Complainant has never traded under the name, referring to Google searches and pointing to the Companies House information for the Complainant, both of which the Respondent says show no sign of actual trading

activity. The Respondent observes that the Complainant could only have traded as “Mythe” for a very short period in 2015, noting that the earliest date would be January 2015 and referring to the prolonged period of ill health mentioned by the Complainant covering the period when the Domain Name expired, at some point before the Respondent acquired it in December 2015. The Respondent adds that the Domain Name was never archived on <archive.org> and that there are only two results for <mythe.co.uk>, neither of which reference any use by the Complainant.

The Respondent submits that the Complainant should not be allowed to correct a failure to prove Rights by providing new information or evidence in a reply, under reference to paragraph 6(b) of the Procedure.

On the topic of Abusive Registration, the Respondent asserts that the Complainant must satisfy the Expert that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or commencement of an objectionable use thereof. The Respondent submits that he is in the business of buying, selling and monetising generic domain names and refers to paragraph 4(d) of the Policy noting that such activities are lawful in themselves. The Respondent explains that he had become aware that the Domain Name and <mythe.co.uk> were on a list of domains which were about to “drop” and assumed that the previous owner(s) no longer wanted them. The Respondent adds that he thought they were potentially attractive because they reflected a French generic term meaning “myth”, noting that the Respondent owns many other domain names consisting of a single generic French word, registered since 2004.

The Respondent notes that it has won each of the seven previous disputes under the DRS in which it has been a party and that it has consistently been found to have registered generic domain names, for the purpose of resale, which do not cut across third party rights. The Respondent asserts that he was unaware of the Complainant upon registration of the Domain Name (noting that as a New Zealand resident he has even less reason to be so aware) and that there is no reason why the Respondent could have known of the Complainant, adding that the Complainant only came to his attention when it approached to discuss a purchase of the Domain Name.

The Respondent submits that in any event knowledge of the Complainant alone would not have been enough in the case of a dictionary word and that the Complainant would also have to show intent to target the Complainant’s rights but has failed to do so. The Respondent asserts that there is nothing objectionable about offering such a domain name for sale if it was not primarily acquired for the purpose of sale to the Complainant or to block the Complainant.

The Respondent seeks a finding of Reverse Domain Name Hijacking on the basis that the Complainant has reviewed the Policy (based on its having cited various Policy provisions), must be aware of the need to prove significant trading activity, has given the impression that it has actively traded under the name “Mythe” yet according to the evidence has never traded thereunder in any meaningful way or used the

Domain Name. The Respondent contends that this is an attempt to mislead the Expert and constitutes RDNH.

6. Discussions and Findings

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 does not claim any specific enforceable rights but appears to rely upon the fact that it operates a UK limited company, the name of which contains the word “Mythe”. Paragraph 1.7 of the Expert’s Overview document (Version 2) poses the question as to whether a company name registration (*per se*) gives rise to a right within the definition of Rights and notes the consensus among the expert panel that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose, a view to which the present Expert subscribes. In these circumstances, the Expert finds that the Complainant does not have Rights within the meaning of the Policy purely by virtue of the fact that it operates a company named “Mythe Software Limited”.

The Complainant could perhaps have demonstrated Rights by virtue of an unregistered trade mark right (see the discussion at paragraph 2.2 of the Expert’s Overview) but has failed to provide any evidence as to its use of the name. It would have had to show such use for a not insignificant period and to a not insignificant degree together with evidence that its name is recognised by the purchasing trade/public as indicating its goods or services. It has provided no such evidence.

The Expert accepts the Respondent's case that on the basis of the date of change of name of the Complainant and the Complainant having filed dormant accounts for the period to 31 December 2014 the likelihood is that at best the Complainant has only traded under its present name for a short period. In any event, it has chosen not to produce evidence of the extent of such trading and the Expert accepts that the Respondent's searches are illustrative of the fact that no such evidence is readily available online.

Although the requirement to demonstrate Rights is a low threshold, it is nevertheless one that a complainant must cross by way of providing at least the necessary minimum of relevant submissions and evidence. The Complainant in the present case has failed to do so and accordingly the Complaint fails.

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. 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.

Having found that the Complainant has failed to demonstrate Rights within the meaning of the Policy, the Expert need go no further. If no Rights have been demonstrated, the Domain Name cannot have been registered, acquired or used in a manner which takes unfair advantage of or is unfairly detrimental to such Rights. However, for the sake of completeness and because it may be of assistance in assessing the Respondent's request for a finding of Reverse Domain Name Hijacking, the Expert will briefly address the Parties' cases on Abusive Registration on the hypothetical basis that the Complainant had been able to prove Rights to the Expert's satisfaction.

The essence of the Complainant's case is that the Respondent is engaged in "profiteering" by having registered a domain name which the Complainant had dropped and by offering this for sale. The Complainant asserts that this runs contrary to paragraph 3(a)(i)(A) of the Policy. The Respondent points out however, correctly in the Expert's view, that this paragraph does not simply require a complainant to show circumstances indicating that the respondent acquired the Domain Name

primarily to sell it, but primarily to sell it *to the complainant or to a competitor of the complainant*. This requires a showing that the Respondent had the requisite knowledge of the Complainant's Rights coupled with an intent to target these, the effect of which was to take unfair advantage of or cause unfair detriment to those Rights. Similarly, the Complainant's case in terms of paragraph 3(a)(i)(B) of the Policy that the Respondent primarily registered the Domain Name as a blocking registration against a name or mark in which the Complainant has Rights also requires the Respondent to demonstrate such knowledge and intent.

In the present case, there is nothing before the Expert to indicate why the Respondent might be expected to have known of the Complainant, particularly given the lack of evidence of any trading history on the Complainant's part. Furthermore, as the Appeal Panel in Maestro International, Inc v. Mark Adams (DRS 4884) noted, "knowledge...only gets the Complainant part of the way. When the trade mark in question is a dictionary word, there has to be something more than knowledge of the trade mark to justify a finding of Abusive Registration". The dictionary word concerned in that case, "maestro", was an English word but the Expert does not consider that the above proposition is much different in the case of a French word or indeed a word in any other language, other than the fact that it may be easier in some cases to show the existence of a secondary meaning denoting a trade mark in the case of a non-English word. In any event, the Complainant in the present case has failed to show the "something more" contemplated by the Appeal Panel in Maestro.

Turning to the Response, the Expert notes that the Respondent explains that he is a dealer in generic domain names who seeks to register lapsed domains with a view to their resale at a profit. Paragraph 4(d) of the Policy notes that trading in domain names and holding a large portfolio are of themselves lawful activities, adding that the expert will review each case on its merits. In the present case, the Expert considers it to be particularly significant that the Respondent has been able to provide evidence showing that its portfolio contains domain names featuring at least 90 French words, inclusive of the Domain Name and <mythe.co.uk>, which have been acquired over a period from 2004 to date. This is a substantive explanation for the Respondent's conduct and is not "fanciful" as the Complainant puts it in the correspondence. It strikes the Expert as entirely supportive of the notion that in "drop catching" and registering the Domain Name and in making this available for general sale the Respondent had no abusive intent within the framework of the Policy and was merely furthering his lawful business activity of trading in generic domains.

In these circumstances, the Expert finds that the Domain Name is not an Abusive Registration in the hands of the Respondent.

Reverse Domain Name Hijacking ("RDNH")

Paragraph 1 of the Procedure defines RDNH as "using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name".

The Respondent requests a finding of RDNH primarily on the basis that the Complainant has misled the Expert regarding its claim to have actively traded. This claim stems from a single submission in the Complaint, namely "...in contradiction of DRS Policy 3.A.i.b - the registrant is blocking registration against a name which we have rights as a trading business with the name Mythe Software and as such should be entitled to continue using the domain mythe.uk". It is worth noting that what is claimed in this sentence is that the Complainant is "a trading business". Even in its own submissions, the Respondent itself accepts the possibility that the Complainant may have traded, stating "If the Complainant actually traded, this can only have been for a very short period of time in 2015". In these circumstances, it has not been demonstrated to the Expert's satisfaction that the Complainant has necessarily set out to mislead the Expert on this topic with a view to depriving the Respondent of the Domain Name. On the other hand, the Complainant does appear to have misunderstood what it needed to show in terms of the Policy and the fact that, even if it has traded or is currently trading, this alone does not entitle it to claim Rights under the Policy.

It appears to the Expert both from the correspondence between the Parties and the Complaint itself that the Complainant was operating under the genuinely held but wholly misconceived belief that its company name, on its own or perhaps coupled with the prior registration of the Domain Name, in some way entitled the Complainant to a finding that it had Rights within the meaning of the Policy. Equally, it appears that the Complainant failed to appreciate that the Respondent was engaged in the legitimate activity of trading in generic domain names; it is evident that the Complainant found the Respondent's explanation that it registered generic dictionary words in French as ".uk" domain names to be incredible, or in the Complainant's words, "ridiculous and fanciful".

The Respondent appears to have little sympathy with the Complainant's predicament. However, for his part, the Expert can appreciate how the Complainant jumped to the conclusion that the Respondent's initial explanation as to how it came by the Domain Name was somewhat swiftly manufactured or contrived, given that the Complainant is presumably unfamiliar with the world of domain name investment, had allowed its domain name to lapse through the misfortune of ill health and had then discovered that it was held by a third party who sought a premium for its transfer. Although, as is demonstrated by the Respondent's collection of French dictionary word domain names dating back to 2004, the Complainant's belief was mistaken, the Expert does not consider that it necessarily follows that the Complaint itself was most likely to have been brought in bad faith.

The Expert does not know whether the Respondent shared the list of other French word domain names in its portfolio with the Complainant before it provided this to the Expert along with the Response. Had the Respondent done so during the Parties' earlier correspondence, and provided evidence of that fact to the Expert when requesting RDNH, the Expert might have regarded the Complainant's actions in

persisting with its Complaint with greater suspicion and indeed might have considered the Complainant's motivations to be less than honourable.

As matters stand, however, the Expert considers that it is more likely than not that the Complainant simply felt aggrieved by having lost the Domain Name and indeed that it genuinely thought its company name was being targeted and held to ransom by the Respondent. Having failed to appreciate some of the finer detail of the Policy, the Complainant also mistakenly believed that this provided it with a remedy in the circumstances of this case.

In Liquidator of Officestar Ltd v. Mr Garth Piesse (DRS16678), a case involving the present Respondent, the expert stated "Findings of Reverse Domain Name Hijacking under the DRS are rare and, in general, do not result merely from complainants presenting poorly supported or injudicious submissions; there commonly needs to be evidence of more nefarious motives at play." The present Expert agrees with that observation. Such nefarious motives are not apparent to the Expert on the face of the present record.

Accordingly, the Expert takes the view that while it is regrettable that the Respondent in the present case has been put to the time, expense and inconvenience of answering the Complaint, the element of bad faith is not present in the Complainant's use of the DRS. In these circumstances, the Expert declines to make a finding of RDNH.

7. Decision

The Expert finds that the Complainant has failed to prove that it has Rights in a name or mark which is identical to the Domain Name or to prove 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 29 March, 2016