

DISPUTE RESOLUTION SERVICE

D00017490

Decision of Appeal Panel

Jockey Club Racecourses Limited

and

MONETA COMMUNICATIONS LIMITED

1. The Parties:

Complainant: Jockey Club Racecourses Limited
75 High Holborn
London
WC1V 6LS
United Kingdom

Respondent: MONETA COMMUNICATIONS LIMITED
Tower House,
Parkstone Road
Poole
Dorset
BH15 2JH
United Kingdom

2. The Domain Name(s):

cheltenham-festival.co.uk

3. Procedural History

17 May 2016	Dispute received
18 May 2016	Complaint validated
18 May 2016	Notification of complaint sent to parties
7 June 2016	Response reminder sent
9 June 2016	Response received

9 June 2016	Notification of response sent to parties
14 June 2016	Reply received
14 June 2016	Notification of reply sent to parties
14 June 2016	Mediator appointed
17 June 2016	Mediation started
11 July 2016	Mediation failed
11 July 2016	Close of mediation documents sent
13 July 2016	Expert decision payment received
11 August 2016	Full expert decision issued
25 August 2016	Appeal statement of intent
26 September 2016	Appeal notice
13 October 2016	Appeal response
27 October 2016	Appeal panel appointment

As indicated above Philip Roberts, Claire Milne and David King (collectively, "**the Panel**") were appointed by Nominet to hear this appeal on 27 October 2016. Each of us has made a statement to the Nominet Dispute Resolution Service in the following terms:

"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, that 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."

4. The Nature of This Appeal

This appeal is brought by Moneta Communications Limited ("**the Appellant**") against the full expert decision ("**the Decision**") of Ms Dawn Osborne ("**the Expert**") dated 9 August 2016. The Decision resulted from a complaint brought by the lead Complainant Jockey Club Racecourses Limited ("**the Jockey Club**").

As the Complaint was filed between 29 July 2008 and 30 September 2016, version 3 of the Nominet Dispute Resolution Service Policy ("**the Policy**") and version 3 of the Nominet Dispute Resolution Service Procedure ("**the Procedure**") applied to the dispute and continue to apply to this appeal.

Paragraph 10.a. of the Policy provides that: "*The appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters*". The

Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits. Accordingly it is not necessary for the Panel to scrutinise the anatomy of the Expert's Decision in any detail, save to note that the Expert found: (i) that the Jockey Club had Rights in respect of a registered mark which was similar to the Domain Name; and (ii) that the Domain Name, in the hands of the Appellant, was an Abusive Registration. On the strength of these findings the Expert directed that the Domain Name, cheltenham-festival.co.uk, be transferred to the Jockey Club.

5. Formal and Procedural Issues

Paragraph 18c of the Procedure provides as follows:

"An appeal notice should not exceed 1000 words, should set out detailed grounds and reasons for the appeal, but shall contain no new evidence or annexes."

The Appellant filed two versions of its appeal notice, one of which complied with the 1000 word limit and one which did not. The non-compliant version does not contain any additional substantive grounds and no compelling justification has been put forward by the Appellant as to why the Panel should accept it.

Accordingly the Panel will decide the appeal on the basis of the compliant version of the appeal notice.

6. The Facts

The Domain Name was registered on 8 July 2004 in the name of 'Danny Campbell', by reference to 'UK Public (sic) Limited Company' registration number 5208625. This company registration number corresponds to the Appellant, of which Mr Campbell (formally cited as a co-respondent to the DRS complaint) is a director. The Panel will treat the Domain Name as having effectively been registered and used by the Appellant at all material times.

The Jockey Club is a horseracing body which traces its origins back to 1750. It has for many years organised race meetings in the UK and as at the date of the complaint owned a portfolio of 15 racecourses including Cheltenham, Aintree, Epsom Downs and Newmarket. It is the largest racecourse group in the UK by turnover, attendances and contributions to prize money.

The Cheltenham Festival is the name of a race meeting which has taken place in Cheltenham since the nineteenth century. It is common ground between the parties that the Jockey Club owns unregistered rights and goodwill in the designation 'Cheltenham Festival' in respect of organising horse racing events and related services.

The Jockey Club also owns the following trade mark registrations referred to in the evidence:

- UKTM registration 2001402 (FESTIVAL / THE FESTIVAL) in Class 41;
- EUTM registration 13895412 (THE CHELTENHAM FESTIVAL) in Classes 35, 41 and 43; and
- EUTM registration 13895529 (CHELTENHAM FESTIVAL) in Classes 35, 41 and 43.

The UK mark is relied on explicitly in the Complaint. The two EU marks, which each attained registration on 9 October 2015, are not directly cited in the Complaint despite being more similar to the Domain Name. They are however cited in the

Jockey Club's 'warning letter' mentioned at paragraph 3 of the Complaint and annexed (as Exhibit 9) to the Response.

7. The Parties' Contentions

- *The Complaint*

In its Complaint the Jockey Club put forward the following material contentions:

The Jockey Club acquired unregistered trade mark rights (in the nature of goodwill) in the marks CHELTENHAM FESTIVAL, CHELTENHAM and FESTIVAL which pre-date the registration of the Domain Name. Statistics supporting the very venerable usage of these terms in the course of trade in the UK were set out in the Complaint. The figures cited in a press cutting dated April 2001 (at Exhibit 8, page 5) following a cancellation of the Festival demonstrate its commercial significance:

"Its insurers now face a claim of £8m for the loss of the showcase meeting. ... The Cheltenham cancellation will cost the betting industry an estimated £100m. The festival attracts 200,000 spectators to Prestbury Park and is worth £10m to the local economy."

The Jockey Club summarised its case on unregistered rights in five bullet points, set out below:

- The Jockey Club has put time, effort and money into the development of its brand.
- As a result of this investment the Jockey Club has acquired a considerable established goodwill in the trade names CHELTENHAM, CHELTENHAM FESTIVAL or FESTIVAL / THE FESTIVAL.
- As a result of its trading goodwill, visibility and good name in the market, the Jockey Club has acquired a strong and demonstrable reputation in the trade names CHELTENHAM, CHELTENHAM FESTIVAL or FESTIVAL / THE FESTIVAL, for horse racing events of exceptional quality.
- All of the above has happened over the course of nearly two centuries before the Domain Name has been registered by the Appellant.
- Furthermore, there is misrepresentation as well as damages as explained below ... relating to the Abusive Registration.

The Jockey Club relied upon its ownership of UK trade mark registration 2001402 registered in class 41 in respect of "*Provision of steeplechasing and national hunt racing facilities; organising steeplechase and national hunt race meetings*" and exhibited the evidence relied upon to prove acquired distinctive character to the satisfaction of the UK IPO.

On becoming aware of the Domain Name, the Jockey Club sent the Appellant a 'warning letter' on 9 November 2015 regarding the Domain Name (and other domains) alleging infringement of the Jockey Club's intellectual property rights. It claims that no contact with the Appellant before that letter had been authorised by the Jockey Club.

The Jockey Club alleged that the Domain Name is identical to CHELTENHAM FESTIVAL and similar to (THE) FESTIVAL / CHELTENHAM and that the Domain Name would be understood by consumers visiting the Appellant's website as referring to the Jockey Club.

The Jockey Club noted that its rights in these terms pre-dated the registration of the Domain Name by nearly 200 years and that the Appellant was 'fully aware' of the Jockey Club's rights, goodwill and reputation when registering the Domain Name, relying on the fact that the Appellant's web site features detailed content about the Cheltenham Festival and is used to promote bets.

The Jockey Club concluded its complaint by alleging that the Appellant's site: (i) was liable to confuse consumers into believing that the website (with manifestly inadequate disclaimers) is hosted or endorsed by the Jockey Club; (ii) demonstrated that the Appellant intended to free-ride on the Jockey Club's reputation, diverting to itself traffic intended for the Jockey Club and benefiting from increased affiliate betting revenues without the need to invest in building its own reputation; and/or (iii) caused detriment to the Jockey Club through the potential risk of false information or inferior odds.

- The Response

In its Response the Appellant disputed many of the allegations made by the Jockey Club. It started by setting the scene, noting that horse racing and betting have long enjoyed a symbiotic relationship: each depends on the other.

The Appellant pointed out that it is not itself a bookmaker, rather it used the Domain Name for over a decade to host an affiliate site, providing: comparisons of odds, breaking news, statistics, analysis, racing cards and free tips in relation to horse racing, including the Cheltenham Festival race. It is one of the UK's leading sports betting affiliates, operating a network of specialist websites covering football, golf, tennis, cricket, rugby and horse racing since 2004.

Racing and betting are popular and represent a significant contribution to the UK economy, through taxation and the statutory Horseracing Betting Levy. There is some 'commercial tension' between the Jockey Club and bookmakers, but the former benefits indirectly from the latter's income via contributions to the Levy. In this sense the Jockey Club 'needs' sites like the Appellant's.

The Appellant provided a series of witness statements directed to the proposition that punters cannot bet on a race unless bookmakers and affiliate sites are allowed to refer to the name of the race. It proffered a list of domain names which are said to support this proposition.

The Appellant relied upon and exhibited the inter party correspondence from November 2015, namely the 'warning letter' cited in the Complaint, and the Appellant's response. As noted above, the warning letter lists two EU trade mark registrations in addition to the UK trade mark registration relied upon in the Complaint. The Appellant relied upon further correspondence relating to another domain name: aintree-grand-national.net.

Further the Appellant relied on two separate incidents of contact by or on behalf of the Jockey Club, in February 2011 (by Terry Hollingshead of Affiliate Future, a marketing company) and in August 2014 (by Michaela Wain of the Jockey Club). The exchange of emails between Michaela Wain and Danny Campbell was relied upon in particular as an example of the Jockey Club's tacit approval, or at least its conspicuous failure to object, to the use of the Domain Name by the Appellant.

As regards the requirement for the Jockey Club to prove Rights, the Appellant explicitly accepted the first, third and fourth bullet points set out in the Complaint and reproduced above. That is to say, it accepted:

- The Jockey Club has put time, effort and money into the development of its brand.
- ...
- As a result of its trading goodwill, visibility and good name in the market, the Jockey Club has acquired a strong and demonstrable reputation in the trade names CHELTENHAM, CHELTENHAM FESTIVAL or FESTIVAL / THE FESTIVAL, for horse racing events of exceptional quality.
- All of the above has happened over the course of nearly two centuries before the Domain Name has been registered by the Appellant.
- ...

The other bullet points were disputed. In particular the Appellant did *not* accept that the Jockey Club owned goodwill, reputation or exclusive rights in relation to 'betting information and affiliate services'. The fact that the Appellant could not lay claim to exclusivity in relation to 'all goods and services' was said to be demonstrated by the existence of other Cheltenham festivals e.g. a design festival and a bible festival.

The Appellant reiterated that it provided an affiliate website under the Domain Name providing links to betting sites and advice on racing; it did not organise or put on race meetings or related facilities for this, and made it clear on its website that it was an unofficial site. It provided a link to the Jockey Club's own website, as approved by the Jockey Club.

The Appellant placed emphasis on the fact that the provision of horse race meetings and related facilities is a service different in nature from betting and affiliate services, and adduced witness statement evidence to this effect. Accordingly the use of the Domain Name was not a misrepresentation and would not cause confusion.

The Appellant claimed that its Domain Name and site was making use of the words 'Cheltenham Festival' in a fair and descriptive manner in order to identify the race so that potential punters could easily find information and compare odds online. It considered that this was in accordance with honest commercial practices in the industry and did not give rise to any unfair advantage or detriment.

The Appellant accepted that the Jockey Club owned the cited UK trade mark registration for FESTIVAL / THE FESTIVALS in class 41 but emphasised the limited

coverage of its specification. It accepted that the evidence filed at the IPO by the Jockey Club showed that the mark(s) were distinctive in relation to that narrow range of services, but no more.

The Appellant denied that the mark FESTIVAL / THE FESTIVAL is similar or strongly similar to the Domain Name, but neither admitted nor denied the similarity between CHELTENHAM FESTIVAL and the Domain Name.

As regards the content of its website the Appellant drew attention to the difference in subject matter when compared with the Jockey Club's website, the fact that the Appellant's site did not feature the Jockey Club's logos or other branding, the presence of disclaimers (which have been consistently present, contrary to the Jockey Club's suggestion of recent adoption) and the lack of complaint by the Jockey Club for a number of years.

The Appellant said that its intention was to help punters identify the best bets for the Cheltenham Festival. It had no intention nor need to benefit from the Jockey Club's goodwill in relation to horse racing, or any perceived relationship therewith.

The Appellant denied the suggestion that it would supply false information or inferior odds on its website and hence any risk of tarnishment of the Jockey Club's reputation. If anything the Jockey Club would stand to benefit from the Appellant's activities.

- The Reply

The Reply sought to clarify the role of Michaela Wain and the context and significance of her contact with the Appellant in August 2014.

The Jockey Club accepted that Ms Wain was employed in a 'general admin position', but contended that Ms Wain *did* object to the content of the website and *did not* approve it. It claimed that Ms Wain did not have authority to give such consent and instead 'objected to the fullest extent allowed by her capacity'. The Jockey Club relied on the absence of any written co-existence agreement or other proof of express consent by the Jockey Club.

- The Appeal Notice

The Appeal Notice asks that the Decision be overturned and that the Domain Name be permitted to remain in the hands of the Appellant, on the basis of the following material grounds:

First the Appellant notes that the only *registered* Right relied upon by the Jockey Club is UK trade mark registration no. 2001402. The Expert is said to have been wrong to conclude that 'FESTIVAL' / 'THE FESTIVAL' were similar to the Domain Name: she should have concluded that the marks are dissimilar.

Second the Expert is said to have failed to take into account the alleged dissimilarity between the services in issue (affiliate/bookmaking vs organisation of race meetings).

Third the Expert is criticised for her assessment of the Jockey Club's unregistered Rights. The thrust of the Appellant's appeal is that, according to the classic trinity of passing off, it was insufficient for the Jockey Club to prove goodwill in the designation CHELTENHAM FESTIVAL, it must also prove misrepresentation and damage before it can be said to own *enforceable* Rights. The Appellant contends that if the Expert had taken these elements into consideration she would have held that the Jockey Club did not enjoy relevant Rights.

Fourth the Expert is said to have overlooked the issue of whether implied consent was granted by the Jockey Club by virtue of the Wain correspondence (the Appellant asserts that "*It has been established in case law that consent can be implied or explicit*" for the purposes of s.9(1) of the Trade Marks Act 1994). Alternatively it is contended that the same correspondence should be characterised as acquiescence and/or estoppel.

Fifth the Appellant contends that it was not "for the Expert" to assess the likelihood of confusion "of her own volition"; alternatively that she wrongly equated her finding of the *foreseeability* of confusion with the requisite *likelihood* of confusion. It is said that she could not have reached this conclusion if she had given adequate weight to the absence of any identified instance of confusion during twelve years of co-existence.

Sixth the Expert is said to have arrived at the conclusion of unfair advantage and detriment without explanation and without any consideration of the relevant market and the context in which the Domain Name was used.

- The Appeal response

The Jockey Club submits that there is no substance in the appeal and that the Expert was justified in the conclusions she reached on the basis of the evidence before her and on the basis of the concessions made by the Appellant in its original Response.

The Jockey Club suggests that the Appellant has failed to distinguish between the legitimacy of a bookmaking/affiliate business model on the one hand and the legitimacy of using the Domain Name for the purposes of a website carrying on that business on the other hand. The Jockey Club does not dispute that the Appellant operates a legitimate business model, nor does it dispute that the Appellant should be able to refer to the 'Cheltenham Festival' honestly and descriptively in order to provide comparisons of odds, breaking news, statistics, analysis, racing cards and free tips *in relation to the race meeting at Cheltenham organised by the Jockey Club*.

What the Jockey Club does object to is the use of the unadorned designation CHELTENHAM FESTIVAL as a Domain Name, which it maintains will provide the Appellant "with an extra bit of credibility by positioning it confusingly close to" the Jockey Club. Consumers will be led to believe that the Appellant's site is owned by

or endorsed by the Jockey Club when this is not the case; and even if those consumers are disabused of this notion relatively quickly, their valuable custom has already been snared by the Appellant for conversion into potential affiliate revenues.

As regards the Wain correspondence, the Jockey Club denies that this is capable of amounting to consent, acquiescence and/or estoppel, on the basis previously set out in its Reply.

8. Discussion and Findings

General

Pursuant to paragraph 2 of the Policy, the Jockey Club must prove, on the balance of probabilities, that:

- i. it 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 Appellant, is an Abusive Registration.

Each of these 'limbs' of paragraph 2 is dealt with in turn below.

Rights

As the Appellant correctly points out, "Rights" are defined in the 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".

The Jockey Club claims to own two different species of 'Rights': registered rights and unregistered rights.

The registered right relied upon is UKTM registration 2001402 (FESTIVAL / THE FESTIVAL) in Class 41. The validity of this registration has not been disputed by the Appellant.

The unregistered rights relied upon are "unregistered trade mark rights in the marks CHELTENHAM FESTIVAL, CHELTENHAM and FESTIVAL" in the nature of goodwill sufficient to found a common law action for passing off in English law.

The following propositions are common ground between the parties, having been alleged in the Complaint and admitted in the Response:

- The Jockey Club has put time, effort and money into the development of its brand.
- As a result of its trading goodwill, visibility and good name in the market, the Jockey Club has acquired a strong and demonstrable reputation in the

trade names CHELTENHAM, CHELTENHAM FESTIVAL or FESTIVAL / THE FESTIVAL, for horse racing events of exceptional quality.

- All of the above has happened over the course of nearly two centuries before the Domain Name was registered by the Appellant.

Moreover the evidence of use of these names adduced by the Jockey Club is not disputed by the Appellant.

In a typical DRS complaint these three bullet points alone would amply satisfy the requirement that the complainant prove 'Rights' under paragraphs 2i of the Policy. However the Appellant is insistent that *"this is not a typical Domain Name Complaint"*. The Panel therefore turns to consideration of the Appellant's contentions in relation to the 'Rights' limb, which comprise in essence: (i) that the Jockey Club's registered rights are not 'identical or similar to the Domain Name' and (ii) that neither the registered rights nor unregistered rights are 'enforceable by the [Jockey Club], whether under English law or otherwise'.

The Panel regards the first of these contentions - essentially that FESTIVAL and CHELTENHAM-FESTIVAL are not 'similar' - as fairly finely balanced.

Version 2 of the *Dispute Resolution Service - Experts' Overview*, published November 2013 ("**the Overview**") poses the question at paragraph 2.3: What is meant by "identical or similar" in paragraph 2(a)(i) of the Policy?

That question is answered in the Overview with the observation that, compared with the equivalent UDRP drafting, the *"wording of the Policy is broader and less restrictive, which matches the reality that the first hurdle (i.e. proving the existence of rights in a relevant name or mark) is intended to be a relatively low-level test. Issues relating to confusion are best addressed under the second hurdle. The objective behind the first hurdle is simply to demonstrate a bona fide basis for making the complaint."*

On this purposive reading of 'similar' the Panel concludes, on balance, that UKTM registration 2001402 relied upon by the Jockey Club is in respect of a name or mark which is not dissimilar to the Domain Name. On the basis of the evidence of contextual use before the Panel the Jockey Club has at least a bona fide basis for asserting its rights in this connection.

In any event this issue becomes far more straightforward when the Jockey Club's EU trade mark registrations are taken into account. This Panel must decide the case *"on the basis of the Parties' submissions, the Policy and this Procedure"* (Procedure paragraph 16a). The Panel takes the view that the "Parties' submissions" encompasses the exhibited documentation, thereby including the references to the EU trade mark registrations cited in the Jockey Club's warning letter. These registered Rights are owned by the Jockey Club and are plainly similar to the Domain Name:

- EUTM registration 13895412 (THE CHELTENHAM FESTIVAL) in Classes 35, 41 and 43; and
- EUTM registration 13895529 (CHELTENHAM FESTIVAL) in Classes 35, 41 and 43.

The second of the Appellant's contentions in relation to 'Rights' goes not to the *existence* of the Jockey Club's rights but is instead said to go to the *enforceability* of those rights. The Appellant submits that any such rights as are owned by the Jockey Club are not enforceable against the Appellant - due to such matters as the alleged dissimilarity between the services in issue, the alleged lack of misrepresentation and damage, alleged acquiescence and so forth.

This is a misreading of the requirement for a complainant to prove 'enforceable' rights, which confuses the two limbs of the paragraph 2 of the Policy ('Rights' vs 'Abusive Registration').

Guidance as to the kind of evidence required in order to prove Rights is given in paragraphs 2.2 and 2.3 of the Overview. For example, paragraph 2.2 points out: "*If the right arises out of a trade mark or service mark registration, a copy of the registration certificate or print-out from the registry database will suffice ...*". In order to prove Rights a complainant is not required to prove that his registered trade mark is enforceable against, or infringed by, any particular person. It is simply enough to show that it is validly registered; and likewise for proof of ownership of goodwill.

Accordingly the considerations which are said by the Appellant to diminish or extinguish the enforceability of the Jockey Club's rights (similarity of services, misrepresentation, damage, acquiescence, etc.) are of little or no relevance to the first limb analysis. They are much more relevant to the second limb of the test and they are addressed in their proper context below under the heading of Abusive Registration.

The only remaining objections raised by the Appellant are that (i) there are other festivals (of more modest prominence) which take place in Cheltenham and that (ii) some of the Jockey Club's evidence postdates the registration of the Domain Name. These statements are true but do not carry a great deal of weight in the light of the evidence of the scale of the Jockey Club's usage and the admissions made by the Appellant (in particular the admission of use "over the course of nearly two centuries before the Domain Name was registered").

For these reasons the Panel finds that the Jockey Club has, and had as at the date of registration of the Domain Name, unregistered Rights in respect of the name CHELTENHAM FESTIVAL. That name is self-evidently very closely similar to the Domain Name.

In summary, the Panel is satisfied on the basis of the evidence before it and the admissions made in the Response that the Jockey Club has proven to the requisite standard that it has 'Rights' (both registered and unregistered) in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

Under the Policy, "*Abusive Registration means 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 Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Jockey Club has not explicitly relied on any of the factors listed in this paragraph, instead preferring to concentrate its submissions on the elements of the primary definition of Abusive Registration set out above, namely unfair advantage and detriment. The factor most closely resembling the Jockey Club's submission is 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 sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. Again the Appellant has not cited specific sub-paragraphs in support of its case, but it is plain that the following passages are pertinent:

"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;*
 - B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
 - C. made legitimate non-commercial or fair use of the Domain Name;*
- or*

ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it;

...

e. Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:

- i. the nature of the Domain Name;*
- ii. the nature of the advertising links on any parking page associated with the Domain Name; and*
- iii. that the use of the Domain Name is ultimately the Respondent's responsibility."*

It is regrettable that, rather than directing their submissions to the specific factors identified under paragraphs 3 and 4 of the Policy, the parties have chosen to concentrate upon legal issues such as whether or not the Appellant's acts constitute trade mark infringement or passing off, and whether the Jockey Club's acts or omissions amount to estoppel, acquiescence or laches.

As the Overview and numerous decisions have been at pains to point out, disputes under the DRS are decided by reference to the terms of the Policy, not the general law. The English law concepts of passing off and registered trade mark infringement are not completely congruent with the test incorporated in the domain name registration contract for Abusive Registration, and the parties would be well advised not fritter away their word limits with verbatim quotations from the Trade Marks Act 1994 and citations of case law relating thereto.

The principal question arising under sub-paragraph 3(a)(ii) of the Policy is the likely impact upon 'people or businesses' of the Domain Name itself and of the use which has been made of the Domain Name by the Appellant.

The Domain Name was registered in 8 July 2004 and the Panel has been provided with a number of screenshots illustrating the appearance of the site published by reference to that Domain Name over the intervening years.

According to paragraph 3.3 of the Overview, the question for the Panel is: will an Internet user seeing the Domain Name or the site to which it is connected be likely to believe that it is registered to, operated or authorised by, or otherwise connected with the Jockey Club? The Overview goes on to give the following guidance:

'Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant."

...
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) ... The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration."

Attention should also be drawn to the DRS Appeal decision in [GuideStar UK -v- Wilmington Business Information Limited](#) (DRS 02193) in which the Panel stated:

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

First, the Domain Name itself. It is "cheltenham-festival.co.uk". The hyphen does no more than confirm to the reader how to split up the letters up into two words, and as noted above the .co.uk suffix can be disregarded. The Domain Name thus consists of little more than the unadorned words CHELTENHAM FESTIVAL i.e. a name in which the Jockey Club is acknowledged to have built up, over 200 years, a strong and demonstrable reputation for horse racing events of exceptional quality. In the Panel's view it is highly likely that an Internet user seeing the Domain Name is likely to believe that it is registered to, operated or authorised by, or otherwise connected with the Jockey Club.

Second, the use which has been made of the Domain Name. In this connection the Appellant contends that any likelihood of confusion is precluded by (i) the on-screen disclaimers; (ii) the dissimilarity between the services offered under the Domain Name and the services offered by the Jockey Club; and (iii) common practice in the bookmaking / affiliate industry.

In the Panel's view the overall visual first impression given by the contents of the Appellant's website is that it is operated or authorised by, or otherwise connected with the organisers of the Cheltenham Festival. The largest and most prominent words are 'CHELTENHAM FESTIVAL'. A reader would have to study the front page of the site for some time and in some detail before he or she will be disabused of that first impression. In particular the disclaimers are markedly less prominent and frequent than the references to 'CHELTENHAM FESTIVAL'.

It is true that the Appellant does not organise steeplechases and national hunt race meetings, but in the Panel's view this does not materially assist the Appellant in demonstrating the absence of a likelihood of confusion. The Appellant's website is all about horse racing. The featured photographs are of jockeys riding horses and kissing trophies. It is hard to follow the Appellant's reasoning that its services are dissimilar to horse racing when it has gone to such lengths to demonstrate that horse racing and bookmaking are inextricably linked and mutually dependent. They are, accordingly to the parlance of the European Union Intellectual Property Office, complementary.

The Appellant's suggestion that it is common, fair, honest, accepted practice for bookmakers or related affiliate sites to use the unadorned names of famous horse races as domain names, engages the factors under paragraph 3 and 4 of the Policy - that is to say, it is put forward by the Appellant and its witnesses both as a reason why consumers would not be confused and as a 'fair use' justification.

Unfortunately for the Appellant, this suggestion is not substantiated on the evidence before the Panel. The desultory "List of urls including event names and venues", provided by the Appellant as Exhibit 6 to the Response, is if anything detrimental rather than helpful to the Appellant's case on this issue: it consists of

43 URLs, 39 of which include a clear indication of the purpose of the website (such as “tips” or “betting”), and only 4 of which show names of races without any such indication. The Panel is similarly unimpressed with the succession of witnesses for the Appellant who observe that it is common practice for bookmakers, when quoting odds, to identify the race for which those odds are quoted. Doubtless this is correct; but it does not follow that it is common practice to register and use a domain name which is virtually identical to the race name.

The evidence before the Panel suggests that the Ladbrokes website offers various bets in relation to the Cheltenham Festival, as do the William Hill website, the bet365 website and the Coral website. The reason that the Jockey Club does not complain about the references to the Cheltenham Festival on these websites is that they are clearly operated by an identified third party, namely Ladbrokes, William Hill, bet365 and Coral respectively.

The same cannot be said of the Appellant's website. In the Panel's view the Domain Name and associated website go beyond the implicit representation "this is a website containing information pertaining to the Cheltenham Festival" - they make the implicit representation: "this is the Cheltenham Festival website".

The Appellant places reliance on the fact that the Jockey Club has not put forward any specific instances of visitors being misled by its website, despite having been active for twelve years. This is said to demonstrate the absence of a likelihood of confusion. The Panel has taken this consideration into account but does not consider that it outweighs the evidence as to the inherent likelihood of confusion. The absence of evidence of confusion is just as likely to be attributable to the fact that the visitors in question may be indifferent or oblivious to the underlying misrepresentation, or unaware to whom they should report it.

The bigger question arising out of the 12 year delay between registration and complaint is whether the Jockey Club's action or inaction over that period has altered the position. The Appellant invokes a number of different legal doctrines: implied consent, acquiescence, estoppel, laches. None of these doctrines feature explicitly in the Policy, and no limitation period is provided for. However the relationship between these doctrines and the test for Abusive Registration under the DRS has been explored in a number of DRS decisions, most recently by the Appeal Panel in Lucasfilm Ltd., LLC -v- Abcissa.com Limited (DRS 15788), the relevant passages of which are excerpted below with emphasis added:

"As a starting point in relation to this issue the Panel notes that the Policy itself says nothing about delay, nor does it contain any provisions requiring a Complaint to be brought within a specific time limit after the date of registration of a domain name. The Expert's Overview also contains no guidance on this issue. The Panel also notes that as a matter of English law delay per se would not prevent an action to restrain ongoing acts of trade mark infringement.

*... The circumstances in which delay and other related considerations may operate as a defence to litigation are considered further below. **Overall however the Panel considers that, where the use complained of is***

ongoing, then delay alone should not automatically preclude a complaint being brought.

*It is nevertheless the case that the list of factors which may lead to a finding that a domain name is not an Abusive Registration, as set out in paragraph 4 of the Policy, is said to be non-exhaustive. **The Panel concludes that in principle, depending upon the relevant facts, this means that it is open to the Panel to reach a finding that whilst delay does not automatically bar an action, delay in a specific case might be such as to mean that an otherwise Abusive Registration is acceptable. Whether in the particular circumstances of a given case that is the position would depend upon individual facts.***

*This approach seems to the Panel consistent with that adopted in *Emirates v. Michael Toth (DRS 08634)*, an appeal decision concerning the Domain Name <emirates.co.uk>. In that case the Panel stated:*

“The Panel accepts that there may be a case for delay or acquiescence amounting to a defence to a complaint under the Policy but is not at all satisfied that this is such a case. The delay is not such as to prejudice the proper consideration of the issues. Even if the Respondent could properly claim to have acted on the assumption that the Complainant had no objection to his registration and use of the Domain Name, we do not consider that he has suffered any unfair prejudice as a result of the delay. As we have found, he cannot be said to have developed a proper business under the Domain Name or a “genuine offering of goods or services” in the sense of paragraph 4aiA of the Policy. Rather, its use has been for click-through traffic and as a place holder for a valuable domain name. The Panel finds that the Respondent has not in reality developed a business under the Domain Name in the belief that the Complainant had no objection to his using it or with the encouragement of the Complainant.”

... By way of ‘cross-check’, the Panel has considered whether the facts of the case would be such as to support a defence based on laches or acquiescence if a Court had found that the use of the 2003 Domain Names amounted to trade mark infringement or passing off, and was considering whether the delay and associated circumstances were such as to preclude the granting of an order requiring the Respondent to transfer the Domain Name.”

*Laches is an equitable doctrine under which delay can bar a claim for equitable relief, even where there has been a finding of liability. It was discussed in some detail by the House of Lords (the then highest court in the UK, subsequently replaced by the Supreme Court) in a celebrated case about an individual’s claim for a share of the musical copyright in the song “A Whiter Shade of Pale”, which was brought 38 years after the song was first released: *Fisher v Brooker and others* [2009] UKHL 41. Lord Neuberger,*

who gave the lead opinion (with which the other four judges agreed), stated the following at paragraph 64:

*“Although I would not suggest that it is an immutable requirement, **some sort of detrimental reliance is usually an essential ingredient of laches**, in my opinion. In *Lindsay Petroleum Co v Hurd* (1874) LR 5 PC 221, 239, the Lord Chancellor, Lord Selborne, giving the opinion of the Board, said that laches applied where “it would be practically unjust to give a remedy”, and that, in every case where a defence “is founded upon mere delay ... the validity of that defence must be tried upon principles substantially equitable.” He went on to state that **what had to be considered were “the length of the delay and the nature of the acts done during the interval, which might affect either party, and cause a balance of justice or injustice in taking the one course or the other, so far as relates to the remedy.”***

*... As in the case of laches, mere delay in exercising a right is not enough to establish a defence of acquiescence; an extra element is required. Essentially, **acquiescence on the part of a claimant seeking to exercise a legal right will not deprive them of the right unless it is of such a nature and in such circumstances that it would be unconscionable of the claimant to rely on it.***

*It can be seen that a court’s assessment of arguments based on laches and acquiescence in cases of delay brings into play the same kind of factors as were taken into account in *Emirates v Toth*, which have already been discussed above in relation to this case. **While the length of the delay plays a part, so do the activities and behaviour of each party, as well as the impact on both parties of the relief that is being sought.***

On the facts of that case, the Appeal Panel concluded that ten years of inactivity of the complainant did not deprive it of a remedy under the DRS. The same result was reached in the Toth case (quoted within the quote above), where the delay was of similar length and the respondent claimed that he had suffered prejudice as a result of the delay (through wasted expenditure on web development and his purchase of another domain name in reliance on the inaction of the complainant). In fact the Panel has been unable to find a DRS decision where delay or acquiescence alone prevented a finding of Abusive Registration.

Applying these considerations to the present case, the Panel is satisfied that the delay between registration and complaint, considerable though it was, will not of itself weigh heavily in the scales on the issue of Abusive Registration. The website has been in continuous use and it has not been suggested that the delay has hampered the Appellant's ability to advance its case or has prejudiced a proper consideration of the issues.

The real question is whether the balance is tipped in the Appellant's favour by the Hollingshead and/or Wain correspondence. It makes little difference whether the issue is formally labelled as implied consent, acquiescence or estoppel. The substantive question to which the Panel has given careful consideration is whether

the Jockey Club's representations gave rise to a reasonable expectation on the part of the Appellant that the Jockey Club did not object to the registration and use of the Domain Name, and if so whether the Appellant relied on that representation to its detriment.

The Hollingshead approach in February 2011 is an inauspicious basis for this allegation. First, this approach was plainly not made on behalf of the Jockey Club. Mr Hollingshead was employed by a third party marketing company and he contacted the Appellant because "I can see you rank number 2 in Google for the Cheltenham festival" and because "I know your (sic) already an affiliate of ours". Second, all he says is that he was "keen to speak to someone there regarding the selling of tickets for the upcoming festival", which offer was never taken up.

The Michaela Wain communications are more promising in the sense that she does appear to have been an employee of the Jockey Club. These exchanges represented an opportunity for the Jockey Club to impress upon the Appellant its objection to the registration and use of the Domain Name. That opportunity was missed, and as a result the Appellant may indeed have formed the (relatively short-lived) impression that the Jockey Club in fact had no objection. However on examination of the exchanges passing between Ms Wain and the Appellant in August 2014, the Panel is unable to conclude that it was reasonable for the Appellant to assume, on the strength of these exchanges, that the Jockey Club had no such objection. In this case the absence of a negative representation does not equate to a positive representation. Moreover even if the Appellant was somehow lulled by Ms Wain into a false sense of security, that false sense of security would only have persisted for fifteen months (from August 2014 to November 2015) and does not appear to have resulted in any detrimental reliance on the part of the Appellant.

In the circumstances the Panel concludes that the Appellant was never given an explicit assurance that the Jockey Club did not or would not object to the registration and use of the Domain Name, and the Panel is satisfied that the communications from Mr Hollingshead and Ms Wain do not amount to an implicit representation to this effect on which it would have been reasonable for the Appellant to rely (and were in any event relatively recent).

The Panel's conclusion is that the Appellant registered the Domain Name with the Jockey Club's famous Cheltenham Festival in mind, and has since used that Domain Name in a way which unfairly oversteps the line between the use of 'Cheltenham Festival' as an *indication* and the use of 'Cheltenham Festival' as *impersonation*. The Panel is satisfied that the Appellant will have attracted a considerable volume of traffic to its site and will have earned a considerable sum in affiliate revenue. In the circumstances of this case, these activities constitute both unfair advantage and unfair detriment.

For these reasons the Panel concludes that the Domain Name was registered and has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Jockey Club's Rights.

9. Decision

The Appeal is dismissed. The Panel finds that the Jockey Club 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 Appellant, is an Abusive Registration. Accordingly, the Panel affirms the Expert's direction that the Domain Name be transferred to the Jockey Club or its nominee.

Signed: Philip Roberts Claire Milne David King

Dated: 7 December 2016