



DISPUTE RESOLUTION SERVICE

D00018337

Decision of Independent Expert

Greenwich Service Solutions Ltd

and

Garth Piesse

1. The Parties

Complainant: Greenwich Service Solutions Ltd
Room 102
Birchmere Business Site
Eastern Way
Thamesmead
London
SE28 8BF
United Kingdom

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

2. The Domain Name

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

3. Procedural History

Nominet checked that the complaint received on 22 December 2016 complied with its Dispute Resolution Service ('DRS') Policy ('the Policy'). On the same day it notified the Respondent and invited him to file a response. That response was received on 17 January 2017. On 24 January, the Complainant replied to the response.

Mediation was attempted but ended unsuccessfully and on 13 February Nominet 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 23 February.

On 23 February I, Mark de Brunner, agreed to serve as an expert under the Policy. I 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, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

I must decide a complaint on the basis of the parties' submissions and the Policy (paragraph 18.1). In addition to the complaint, the response and the reply, there is, from the Respondent, what the Policy refers to as a 'non-standard submission' (paragraph 17.2). The Policy (paragraph 17.1) says

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

So it is for me to decide whether to admit this as evidence.

A non-standard submission needs to contain, as a separate paragraph, a brief explanation of why, exceptionally, it is necessary. Nominet passes this paragraph of explanation to the expert and this is only followed by the full submission 'at his or her sole discretion' (paragraph 17.3).

The explanatory paragraph here is reproduced below.

1. In accordance with paragraph 17.3 of the Policy, the Respondent asserts that there is an exceptional need for its (separately submitted) non-standard submission for the following reasons.

2. First, the Reply includes new evidence, which could and should have been filed with the Complaint and should not be admissible at the Reply stage in accordance with the Policy. The submission explains why.

3. Second, the Reply includes a number of assertions which appear to imply some sort of wrongdoing on the part of the Respondent in connection with:

a. the inclusion of a reference to the Complainant in Google search results and the related filing of an amended Response (from which the Respondent draws a range of unwarranted inferences); and

b. the Paypal notice exhibited to the Response.

These are serious matters which the Respondent could not have foreseen. The submission responds to the Complainant's assertions relating to these two issues.

4. The Respondent has resisted the temptation to make a point-by-point rebuttal of the Reply and addresses only the above matters in its submission.

This boils down to the Respondent's arguing that the reply contains (i) new evidence which I should not consider and (ii) false implications of wrongdoing that need to be scotched. But the Policy is clear (paragraph 24.3) that it is for me to determine the admissibility, relevance, materiality and weight of the evidence and, on this occasion, I do not require assistance with that. I therefore decline to admit the non-standard submission as evidence here.

The reply does contain further detail, and supporting evidence, relating to when the Complainant began trading and the question of unregistered rights in the name 'GSS'. The Policy (paragraphs 9.2 and 9.3) says

Any reply by the Complainant must be restricted solely to matters which are newly raised in the Respondent's response and were not raised in the Complainant's complaint as originally submitted to us.

If an Expert is appointed and the reply extends to other matters, the Expert may declare it inadmissible to the extent that it deals with matters going beyond those newly raised in the Respondent's response.

I have excluded from consideration those 'other matters' to which the reply extends.

There are two other points I should draw out here.

- In the reply, the Complainant claims that there is an adverse conclusion to be drawn from the fact that the Respondent sent a revised response with a slightly different list of examples of 'GSS' in common use, the second one excluding a reference to the Complainant. I decline to draw any such conclusion.
- The Complainant also claims that redactions to a Paypal confirmation notice, provided as evidence of the Respondent's acquisition of the Domain Name, cast doubt on the accuracy of the notice and indeed on its authenticity. The suggestion is not backed up elsewhere and appears to me wholly unwarranted. I dismiss it.

The Complainant wrote to the Respondent on 23 September 2016. When the Respondent did not reply, the Complainant initiated proceedings under the DRS.

4. Factual Background

I have visited the website to which the Domain Name resolves, as well as the Complainant's website at <gssol.co.uk>. From that limited research, the complaint, the response, the reply and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant was incorporated on 22 December 2008. It provides recruitment, facilities management, catering and cleaning services. It has been trading using the name 'GSS' and in 2014 it registered 'GSS' as a trade mark in the UK.

The Respondent is in the business of buying, selling and making money from generic domain names.

The Domain Name was registered on 9 September 2015. The Respondent acquired it from the previous registrant on 20 October 2015. The Domain Name resolves to a web page that says it may be available for purchase and invites the completion of a form 'to get a price quote'.

The name GSS is in common use. Examples, taken from the first two pages of a Google UK search, include:

- Graduate Supervision System (GSS) at Oxford
- Government Statistical Service (GSS)
- GSS Marine Services ("the Multi-Role vessels operated by GSS...")
- GSS Construction UK Ltd
- GSS Global Substation Solutions ("At GSS we believe...")
- GSS at www.gssol.co.uk ("Welcome to GSS, whatever your service needs...")
- GSS Global Scholars Symposium ("The GSS 2016 theme...")
- GSS methodology
- GSS Training
- GSS Architecture

The sixth entry on the list above, for <gssol.co.uk>, refers to the Complainant's domain name for its web site.

5. Parties' Contentions

Complaint

The Complainant says it has rights in the Domain Name because it is the name under which it trades and because it has registered 'GSS' as a trade mark in the UK.

It argues that the Domain Name is an abusive registration for reasons that relate to both the intention behind the registration and the use to which the Domain Name has been or could be put. It says that the Domain Name

- (i) was registered primarily for the purposes of selling, renting or otherwise transferring it to a third party for money.
- (ii) was registered primarily as a blocking registration against the mark in which it has rights. The Complainant argues that, as a legitimate business that trades as 'GSS', it is entitled to the Domain Name.
- (iii) is identical to the name in which it has registered rights and therefore has the potential to confuse people or businesses into believing that the Domain Name is connected with the Complainant.

Response

The Respondent denies that the Complainant has established unregistered rights in the name 'GSS', pointing to the limited amount of sales information contained in the complaint. But the Respondent accepts that the Complainant has rights in 'GSS' by virtue of its registered trade mark and that this trade mark is identical to the Domain Name.

On the character of the registration, the Respondent's case is that

- (i) for the complaint to succeed, the Complainant must establish that the Respondent was aware of the existence of the Complainant when he registered the Domain Name or started using it in a way that caused the complaint. This is a principle that the Respondent says was reflected in the decision of the appeal panel

in verbatim.co.uk (DRS 4331). Here, the Respondent, who resides in New Zealand and is not involved in the Complainant's industry, did not know of the Complainant before its letter of 23 September 2016. In the absence of any evidence of the Complainant's reputation, there is no reason to believe that the Respondent should have known of the Complainant.

- (ii) the Respondent is in the business of buying, selling and monetising generic domain names. Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities (paragraph 8.4 of the Policy)
- (iii) the Respondent had a legitimate reason for choosing the Domain Name. He owns many three letter domain names and acquired this one from the previous registrant, He had in mind ultimately to sell it to someone with an interest in using it (most likely as an acronym), hence the form on the website inviting offers.
- (iv) 'GSS' is in common use.
- (v) the Domain Name has not been used in connection with an offering competing with the Complainant. It has only ever been used to host a page offering the domain for sale.
- (vi) there is nothing objectionable about offering a domain name for sale where, as here, it was not acquired for the purpose of sale to the complainant. All the Respondent has done is offer the Domain Name for sale to the world at large.
- (vii) there is no evidence of actual confusion or that might point to the likelihood of confusion. Even if there were, that would not count against the Respondent because the Domain Name was acquired without knowledge of the Complainant.
- (viii) the Complainant does not have superior rights to the Domain Name just because it trades as 'GSS'.

The Respondent seeks a finding that the Complainant's conduct in bringing the complaint amounts to reverse domain name hijacking, on the basis that

- (ix) the case should never have been brought and the Respondent has been put to unnecessary cost. The situation here is on all fours with that in the dispute over so31.co.uk (DRS 16688), There, the expert found that
- the complainant proceeded on the wrong assumption that it had an entitlement to the domain name because the respondent was a domain name trader
 - if the complainant had read the Policy before filing a case it would have been aware that the complaint would almost inevitably fail.

Reply

Excluding the 'other matters' raised in reply, the Complainant makes the following points. (The numbering in this section reflects the numbering in the Response section above, so gaps in the sequence are intentional.)

- (i) The Policy does not mention the need for a respondent to have been aware of the complainant as a prerequisite for establishing that a domain name is an abusive registration. In any event, here the Respondent did know of the Complainant, as shown by the fact that the list of examples of 'GSS' in common use included the Complainant and was compiled by the Respondent. The fact that the Respondent resides in New Zealand and is not involved in the Complainant's industry is irrelevant.
- (ii) Trading in domain names is of itself a legitimate activity but 'GSS' may not be a generic domain name given that the Complainant holds trade mark rights in it. Also, the Respondent is not making fair use of the Domain Name.
- (iv) The list of examples of 'GSS' in common use includes the Complainant. The other entries are different in kind: some relate to government services with government domains; others relate to one-off historical events; none reflects the use of GSS as a trade mark and company name.

- (vi) The Respondent has already admitted that its primary aim was to sell the Domain Name. The Respondent was probably aware of the Complainant. (The Complainant's implication is that the Respondent registered the Domain Name in order to sell it to the Complainant.)
- (viii) The Complainant is entitled to the Domain Name because 'GSS' is its registered trade mark.
- (ix) The Complainant tried to make contact with the Respondent in good faith to clarify the position of both. But as the Respondent ignored the correspondence the Complainant had no choice but to initiate DRS proceedings.

The case cited in the Response, in which there was a finding of reverse domain name hijacking (so31.co.uk - DRS 16688), is very different to this one. There, the respondent claims that the complainant's assertions about its trademarks are misleading because the complainant has neither a US nor a UK registered trade mark. This is not the case here as the Complainant has a registered trade mark. The respondent there is doing something legitimate (expending resources on building a business directory website), whereas here the Respondent is just out to sell the Domain Name and in the meantime is blocking its registration by the trade mark owner.

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

The status of the Complainant's unregistered rights is disputed, but it clearly has registered rights in the form of a UK trade mark for the letters 'GSS'.

Ignoring the .co.uk suffix as a generic feature of Nominet's register, the Domain Name is also 'GSS'.

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.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is or is not an abusive registration, and the complaint points to a number of these factors: that the Domain Name was registered primarily for the purposes of selling it for a profit to a third party (though the Policy refers to sale to the complainant or to a competitor of the complainant), or as a blocking registration; that the use of the Domain Name has confused or could confuse people or businesses into believing that the Domain Name is connected with the Complainant; and (anticipating a possible defence by the Respondent) that the Domain Name is not generic and the Respondent is not making fair use of it.

The Respondent, drawing on the appeal decision in <verbatim.co.uk> (DRS 04331), says that, for a registration to be abusive, at acquisition or during use, either the registrant needs to have known of the existence of the other party and its rights or it can be shown that the registrant ought to have known. In this

case, the Respondent says, he neither knew nor can be expected to have known of the Complainant or its rights. He is a domain name dealer, he has many three letter domain names, 'GSS' is in common use and so he acquired a domain name made up of these letters.

The *Experts' Overview* (section 2.4) contains a useful gloss on the Verbatim case:

The body of expert decisions under the Policy is developing and certain principles are emerging. The section of the Appeal decision in DRS 04331 (verbatim.co.uk) dealing with 'knowledge' and 'intent' sets out one panel's views on that topic. However, new domainer practices (e.g. automated bulk transfers of domain names) are becoming commonplace and to the extent that the Verbatim decision suggests that for a finding of Abusive Registration, the Respondent must have had knowledge of the Complainant and/or its Rights at the relevant time, it is now thought by some Experts that that might overstate the position.

The approach to be taken is therefore not quite as self-evident as the response suggests. It is not inevitable that the Respondent can escape a finding of abusive registration merely by establishing that he did not (and could not be expected to) know of the Complainant and its rights. It is equally true, though, that the simple registration of a trade mark for 'GSS' does not automatically entitle the Complainant to the Domain Name.

Domain names are allocated first come, first served, subject to the rules about acquisition or use that takes unfair advantage of or is unfairly detrimental to a complainant's rights. There is no short cut to the appropriate conclusion about the character of the registration here. But the analysis seems to me to be straightforward nonetheless.

The Respondent acquired the Domain Name without knowledge of the Complainant and did so as part of his legitimate business of trading in domain names. Evidence of 'GSS' being more obviously distinctive, or of the Complainant's reputation in the name, might have had a bearing on any assessment of the character of the registration. In the absence of such evidence, the acquisition of the Domain Name looks wholly unobjectionable.

Since acquisition, the Domain Name has simply been offered for sale through a straightforward notice on the web page to which it resolves. There is no evidence of an illegitimate intention or of confusing or potentially confusing use. The Complainant's trade mark does not automatically confer a superior right to the Domain Name. Nothing done by the Respondent has, in my judgement, taken unfair advantage of the Complainant's rights.

I can now review the other arguments made by the parties in the complaint, the response and the reply.

Complaint

- (i) The Complainant claims that the Domain Name was registered primarily to sell it 'to a third party'. But that is precisely what domain name dealers do and, as the Policy makes clear, their activities are not of themselves objectionable. The Complainant presumably had in mind the Policy's reference (paragraph 5.1.1) to

Circumstances indicating that the Respondent has...acquired the Domain Name primarily for the purposes of selling..the Domain Name to *the Complainant or to a competitor of the Complainant (my emphasis)*, for valuable consideration.

But there is no evidence of this.

- (ii) The complaint also refers to the Domain Name as a blocking registration but it is long-established in DRS expert decisions that such a characterisation is only appropriate where there is some evidence of an intention to block (as opposed to the mere technical reality of a block, by virtue of the registrant's having registered a domain name). There is no evidence of intention.
- (iii) There is no evidence of confusion and I judge the likelihood of confusion to be low.

Response and Reply

(As I am picking out only the arguments I have not yet dealt with, the gaps in the numbering sequence are again intentional.)

- (i) It is true that the Policy does not explicitly mention awareness or knowledge of the Complainant as a factor to be taken into account in determining the character of a registration. But the lists of factors contained there are non-exhaustive and it is clear from the body of DRS expert decisions that awareness or knowledge may be relevant. In this case, I do not regard the matter of awareness as the sole determinant of the question before me, but it is important.

In the absence of evidence of the Complainant's reputation, the Respondent's location (far from the Complainant) and the business in which he operates (not the same sector as the Complainant) are both relevant. The fact that the Complainant appears in a list compiled by the Respondent for the purposes of responding to the complaint does not strike me as evidence that the Respondent knew or ought to have known of the Complainant.

- (ii) I have seen no evidence that 'GSS' has acquired a distinctiveness that would stop it being generic or that the use to which the Domain Name is being put is unfair.
- (iv) I accept that 'GSS' is in common use.
- (vi) There is simply no evidence that the Respondent acquired the Domain Name in order to sell it to the Complainant specifically, as opposed to offering it for sale to the world at large.
- (ix) As for reverse domain name hijacking, I am unpersuaded by the parallels the Respondent seeks to draw with DRS 16688 (so31.co.uk). I see a slightly ill-tempered dispute and some misunderstandings on both sides. But that does not amount to establishing that the Complainant has acted in bad faith and I decline to make a finding of reverse domain name hijacking.

7. Decision

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name but that the Domain Name, in the hands of the Respondent, is not an abusive registration.

In the light of that, I direct that the Domain Name be left undisturbed.

Mark de Brunner

20 March 2017