

DISPUTE RESOLUTION SERVICE

D00018361

Decision of Independent Expert

Activ Technology Ltd

and

Mr Alan Jones

1. The Parties

Complainant: Activ Technology Ltd
Hadrian House, Balliol Business Park, Longbenton
Newcastle
Tyne and Wear
NE12 8EW
United Kingdom

Respondent: Mr Alan Jones
Unit 4, Millstone Yard
Main Street
Shipton by Beningbrough
York
North Yorkshire
YO30 1AA
United Kingdom

2. The Domain Names

<activtechnology.co.uk> ("the Disputed Domain Name")

3. Procedural History

The Complaint was filed with Nominet on 5 January 2017. Nominet validated the Complaint on 9 January 2017 and notified the Respondent by post and by email, stating that the Response had to be received on or before 30 January 2017. The Response was filed on 18 January 2017. On the same day Nominet notified the Complainant that a Reply had to be received on or before 25 January 2017. A Reply was received on 20 January 2017 and the mediator was appointed on 26 January 2017.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 8 February 2017 Nominet informed the Complainant that it had until 22 February

2017 to pay the fee for the decision of an Expert pursuant to paragraph 13 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 13 February 2017 the Complainant paid Nominet the required fee.

On 15 February 2017 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she was independent of each of the parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of such a nature as to call in to question her independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant is a limited company incorporated on 29 April 2006. It is based in Newcastle and is an independent provider of mobile, communications and IT services to small and medium businesses in Northern England and Scotland. Its main website is currently available at www.helloactiv.co.uk.

The Respondent is an individual. He previously operated a limited company incorporated on 10 May 2011 called Activ Technology Services Ltd. However this company was dissolved on 3 September 2013 and the Respondent now operates as a sole trader. The Respondent is based in York and provides IT services. His website is currently available at www.activ.co.uk.

The Disputed Domain Name was registered on 7 June 2011. At the time that the Complaint was filed it was not pointing to an active website.

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant states that it is an active, registered trading company and has been registered with Companies House since 29 April 2006 under number 05801496. Given this and the fact that it currently trades using the name Activ Technology Ltd, the Complainant argues that it would make the most commercial and logical sense for it to host its website using the Disputed Domain Name.

The Complainant states that it is recognised by its customers and prospective customers by the name Activ Technology and attaches one of its customer invoices to illustrate this. The Complainant also adds that it provides products and services to its customers under the name Activ Technology, and uses this name across all of its marketing and branding materials. The Complainant points out that when searching for Activ Technology on Google and Bing, it appears as the first hit, and attaches screen captures demonstrating this.

The Complainant states that its current website is at www.helloactiv.co.uk. However, it underlines that as its registered company name is Activ Technology Ltd, it would be in a better branding position if it was known as Activ Technology across all media and platforms. In the Complainant's opinion, such coordinated branding would enable it to increase conversions from its website and promote positive trust through its company name.

The Complainant points out that it is in the process of releasing a radio advertisement on a local radio station in Newcastle in which it will be referred to as Activ Technology. The call to action at the end of the clip will be for prospective customers to search online for "Activ Technology" and, as noted above, this search will bring the Complainant's website up as the first hit on browser search engines. However, the Complainant asserts that if it owned the Disputed Domain Name this would create a much more unified branding approach.

Abusive Registration

The Complainant asserts that the Disputed Domain Name is abusive in the hands of the Respondent because the Respondent's company, Activ Technology Services Ltd, was dissolved on 3 September 2013 (company registration number 07629309 with registered address at Tower Court, Oakdale Road, Clifton Moor, York, YO30 4XL). In the Complainant's opinion, the Disputed Domain Name is therefore no longer of use to the Respondent as his company is inactive and no longer trading.

The Complainant indicates that the Disputed Domain Name is currently not hosting a live website, and instead it is pointing to a forbidden 404 page. If the Disputed Domain Name was transferred to the Complainant, the Complainant states that it would use it to host a live website to promote its active and trading company.

The Complainant argues that, in the hands of the Respondent, the Disputed Domain Name could create confusion for the Complainant's prospective or existing customers typing it directly into a browser. In the Complainant's opinion, they would get the impression that the Complainant did not have a live website, nor a positive online presence. Both would be incorrect assumptions as the Complainant is active and trading and certainly has a strong online presence, and this would be strengthened by owning the Disputed Domain Name which reflects its registered company name.

The Complainant points out that the Respondent instead appears to be using the domain name <activ.co.uk> to point to its website. However, only one page (the home page) seems to be live.

In the Complainant's opinion, as the Respondent's company is now dissolved, it no longer requires the use of the Disputed Domain Name. Given that the Complainant is an active registered company whose name matches the Disputed Domain Name, it argues that it would benefit from being the registered owner.

The Complainant mentions that it has sent two separate letters to the Respondent in order to try and resolve the issue, but unfortunately, it has never received any reply. The Complainant apparently indicated in its second letter that a lack of response would result in the submission of a complaint under Nominet's Dispute Resolution Service (DRS). Finally, the Complainant underlines that no contact from the Respondent has been received at any point and requests that the Disputed Domain Name be transferred to it.

Response

The Respondent states that he registered the Disputed Domain Name on 7 June 2011 in anticipation of changing his trading status from a limited company to a sole trader or LLP in the foreseeable future. The limited company was dissolved in September 2013 and he

continued trading from that date as Activ Technology (the Respondent adds that sales invoices in that name could be provided as reference material if required).

The Respondent wonders why, if the Complainant has an issue with the Respondent's registration of the Disputed Domain Name, it has taken it over five years to raise this. The Respondent argues that it operates in a different commercial sphere to the Complainant (although some slight overlaps are inevitable) and it is geographically separated by 100 miles. The Respondent contends that it operates and trades within a 50 mile radius of York and therefore poses no commercial threat to the Complainant.

Reply

The Complainant states that it understands that the Respondent's company was dissolved in September 2013, but that he has since continued trading without the limited status. However the Complainant argues that the dispute is linked to ownership and use of the Disputed Domain Name, which is currently inactive. Given that the Disputed Domain Name is currently not in use, the Complainant wonders what reason there could be for the Respondent to wish to keep it?

The Complainant states that it has recently started the process of going through a re-branding exercise. Up until recently its logo contained the words "Activ Hello Technology", but it has now updated its logo to simply say "Activ Technology", dropping the "Hello". Its logo now matches its registered limited company name. The Complainant underlines that this explains why it hasn't raised the dispute until now, as its current website was previously fit for purpose.

The Complainant states that when it researched the availability of the Disputed Domain Name and discovered that it was not linked to an active website, it went through Nominet's DRS because it felt that it would be able to make much more use of the Disputed Domain Name. It decided to do this after attempting to contact the Respondent directly twice, but received no reply to its two mailed letters.

The Complainant adds that the domain name that it uses to point towards its current website contains the word "hello": www.helloactiv.co.uk. It is therefore looking to acquire the Disputed Domain Name as part of its re-branding exercise so that everything is positively linked with the same name.

The Complainant argues that, regardless of where the Respondent operates, access to the website is not restricted by location and when a search is carried out on Google for the term "Activ Technology", the first hit returned is the Complainant's website (currently www.helloactiv.co.uk).

The Complainant contends that its credibility as a business would be increased if its limited company name was mirrored in the domain name used for its website. Furthermore, although the Complainant primarily operates in North East England, the Complainant asserts that this does reach down to the York area and points out that it has customers and prospective customers in this area.

Finally the Complainant states that the Respondent is using the website www.activ.co.uk and as such appears to have no need for the Disputed Domain Name, especially given that it is not linked to a live website.

6. Discussion and Findings

General

Under paragraph 2.1 of the Policy, for the Expert to order a transfer of the Disputed Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"2.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

2.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration."*

Complainant's Rights

The Policy defines Rights 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*".

By far the easiest way to demonstrate Rights under the Policy is usually the provision of a registered trade mark. However the Complainant has supplied no evidence that it owns any registered trade marks.

The Complainant is an incorporated company called Activ Technology Ltd. Section 1.7 of the Nominet Experts' Overview deals with the question of whether a company name registration can give rise to a Right under the Policy in and of itself, and provides as follows:

"There are decisions going both ways, DRS 00228 (activwebsolution.co.uk) and DRS 04001 (generaldynamics.co.uk). The issue is this: does the mere fact that under the Companies Acts (section 28(2) of the Companies Act 1985 and sections 66 and 67 of the Companies Act 2006) the Secretary of State can direct NewCo to change its name because it is the same as, or 'too like', OldCo's name, mean that OldCo enjoys 'rights enforceable under English law and/or 'Rights' within the full meaning of the Policy?"

The consensus view of recent Experts' meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose".

Having considered the relevant previous cases, the Expert considers that there is no justification in this case to depart from the consensus view. It is advisable for complainants, respondents and their advisors to have certainty in relation to the Policy and predictability when it comes to decisions, and so, in line with the vast majority of cases, the Expert finds that the Complainant's registered company name is not enough to provide it with Rights under the Policy.

The question then arises as to whether the Complainant has any other Rights in the term ACTIV TECHNOLOGY. Given that the Complainant has not supplied evidence of any registered trade marks, the issue is whether the Complainant has established that it has any unregistered rights in the term, by virtue of having used it in the course of trade, which would amount to Rights for the purposes of the Policy. In this regard it should be noted that Section 2.3 of the Experts' Overview provides that the first hurdle is intended to be a relatively low-level test, and that the objective for a complainant is simply to demonstrate

a *bona fide* basis for making a complaint. It is also generally established that a complainant only needs to prove Rights at the time a complaint is filed, and not that such Rights pre-date the registration of the domain name in question.

Thus in view of the fact that the first hurdle is intended to be a relatively low-level test, the Expert is satisfied that the Complainant has Rights in the term ACTIV TECHNOLOGY, given the evidence shown on the Complainant's website as to the Complainant's use of this term as a trading name and the Complainant's provision of a customer invoice also making reference to this term.

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights (ACTIV TECHNOLOGY) must be identical or similar to the Disputed Domain Name (<activtechnology.co.uk>). It is accepted practice under the Policy to discount the ".co.uk" suffix, and so the Complainant's trade mark and the Disputed Domain Name are thus identical to one another.

Therefore the Expert finds that paragraph 2.2.1 of the Policy is satisfied and that the Complainant has Rights in respect of a name which is identical to the Disputed Domain Name.

Abusive Registration

"Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

- "(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."*

On the basis of the evidence presented, the Expert is not persuaded that the Respondent incorporated a limited company called Activ Technology Services Ltd in 2011 and then proceeded to register the Disputed Domain Name shortly afterwards with the aim of taking unfair advantage of the goodwill and reputation of the Complainant (trading since 2006 using a very similar company name, Activ Technology Ltd). Given that the parties are, relatively speaking, geographically not that far apart, and both are operating broadly in the same field (IT services), this could potentially have been the case, especially as the term ACTIV is not a dictionary term and is quite distinctive.

However, at no point does the Complainant suggest any wrongdoing on the part of the Respondent, and an examination of the website of each party would lead the Expert to believe that the Complainant and the Respondent are very different, both in terms of size and types of activities, and the Respondent does not appear to be operating a confusing website with a similar "look and feel" to that of the Complainant (for example by using similar colours, logos or fonts). It therefore seems more likely than not, without any further evidence, that the Respondent's choice of a similar name was a mere coincidence.

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Disputed Domain Name is an Abusive Registration, as follows:

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 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;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.4 It is independently verified that the Respondent has given false contact details to us;

5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively; and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name".

The Expert has examined each of these in turn and finds that none of them can be said to apply in this case. The Complainant appears to be suggesting that paragraph 5.1.2 is of relevance in that the Respondent's non-use of the Disputed Domain Name is likely to confuse people and make them think that the Complainant has no online presence. However if, as the Expert concludes above, the fact that the parties have chosen to trade using very similar terms is the result of a mere coincidence, then any resulting confusion cannot be abusive. In this regard the Expert finds the reasoning of the Appeal Panel in *Verbatim Ltd v Michael Toth*, DRS 04331, to be very useful. The Appeal Panel states (referring to the paragraph numbering in the previous version of the Policy):

"factor 3(a)(ii) (use that causes confusion with the Complainant) will generally be insufficient where there is nothing else in the evidence to indicate abuse: other questions must be asked, such as how well-known the Complainant's relevant Rights are, whether the Respondent was aware of them, and whether the Respondent intended confusion to

arise. The Expert's role is then to consider the materiality and weight of all the evidence in determining whether it is sufficient to establish that the Domain Name is an Abusive Registration."

In other words, for the use of the Disputed Domain Name to qualify as abusive, there has to be an element of abusive behaviour on the part of the Respondent, not just confusion in itself. As discussed above, the Complainant does not argue that the Respondent registered the Disputed Domain Name in order to take unfair advantage of the Complainant's reputation and goodwill, and nothing in the evidence would suggest this. In this regard it is also worth underlining that paragraph 5.2 of the Policy states:

"Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration".

The list at paragraph 5.1 is only meant to give illustrative examples of abusive behaviour, and so the Expert has considered whether there are any other arguments which could suggest that the Respondent's registration or use of the Disputed Domain Name is abusive. The main thrust of the Complainant's argument appears to be that it would simply be more appropriate for it to own the Disputed Domain Name as it would make more use of it than the Respondent, and that this would make sense given its rebranding exercise. It is worth underlining at this point that Nominet's DRS is intended to be used to combat domain name abuse, such as cybersquatting. It is for an Expert to decide when there has been abuse and thus when it is appropriate to forcibly remove a domain name from a registrant's ownership, not to judge whether a domain name would be more appropriate in the hands of one party or another and which party would be most suitable to own it. Domain name registrations generally take place on a "first come, first served" basis, and usually a Nominet Expert will only see fit to overturn this on evidence of some form of wrongdoing by a registrant. In the Expert's opinion nothing in evidence in this case would suggest that the Respondent has done anything untoward.

For the sake of completeness, it should be noted that paragraph 8.1 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Disputed Domain Name is not an Abusive Registration, and in this case paragraph 8.1.1.2 would appear to be of assistance to the Respondent:

"8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has: [.....]

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name".

The Complainant argues that the dissolution of the Respondent's company in 2013 should weigh in its favour. However, the fact that the Respondent incorporated a company called Activ Technology Services Ltd in May 2011 and registered the Disputed Domain Name less than a month later only reinforces the Expert's view that the Respondent had a legitimate reason for registering the Disputed Domain Name and this was not done abusively.

In its Reply, the Complainant wonders what reason there could be for the Respondent to wish to keep the Disputed Domain Name, given its non-use at the time of the filing of the Complaint, and to that the Expert would simply underline that domain names are assets, sometimes valuable ones, and that in itself is as good a reason as any to wish to retain

one. It is not for the Expert to subjectively decide who would be most suitable to own a particular domain name and who would make the best use of it, but to decide whether or not there has been abuse in accordance with the provisions of the Policy.

In conclusion, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is not satisfied that the Complainant has succeeded in proving, on the balance of probabilities, that the Disputed Domain Name is an Abusive Registration in accordance with paragraph 2.1.2 of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in a name which is identical to the Disputed Domain Name, but is not satisfied that the Disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. No action should therefore be taken in relation to the Disputed Domain Name.

Jane Seager
10 March 2017