

DISPUTE RESOLUTION SERVICE

D00019014

Decision of Independent Expert

TabletLawyer Limited

and

AIZIO Associates LTD

1. The Parties

Complainant: TabletLawyer Limited
c/o ONE Legal Services Ltd
12 Eaton Avenue
Euxton
Buckshaw Village
Lancashire
PR7 7NA
United Kingdom

Respondent: AIZIO Associates LTD
1st Floor, 2 Woodberry Grove
Finchley
London
N12 0DR
United Kingdom

2. The Domain Names

<tabletlawyer.co.uk>
<tabletlawyer.uk>
<thetabletlawyer.co.uk>
<thetabletlawyer.uk>

("the Disputed Domain Names")

3. Procedural History

The Complaint was filed with Nominet on 13 June 2017. Nominet validated the Complaint on the same day and notified the Respondent by post and by email, stating that the Response had to be received on or before 5 July 2017. The Response was filed on 19 June 2017. On the same day Nominet notified the Complainant that a Reply had

to be received on or before 26 June 2017. A Reply was received on 21 June 2017 and the mediator was appointed on 27 June 2017.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 21 August 2017 Nominet informed the Complainant that it had until 5 September 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 23 August 2017 the Complainant paid Nominet the required fee.

On 24 August 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, which 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 UK limited company incorporated on 16 September 2015 (company number 0978070). It is currently dormant. It owns the UK trade mark THE TABLET LAWYER, registered on 7 November 2014.

The Respondent appears to offer a variety of services under various different brands, in particular IT services. Its website is currently available at <https://aizio-associates.eu/>.

The Disputed Domain Names were registered on the following dates:

<tabletlawyer.co.uk>: 28 August 2014
<tabletlawyer.uk>: 28 August 2014
<thetabletlawyer.co.uk>: 19 December 2014
<thetabletlawyer.uk>: 19 December 2014

At the time that the Complaint was filed, the Disputed Domain Names were pointing to a detailed website offering information about a software application called TabletLawyer, aimed at assisting lawyers to work on mobile devices and available for a monthly fee.

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant asserts that the Disputed Domain Names were registered on its behalf as part of a project to develop an application and accompanying services. To demonstrate this it attaches some correspondence from 2015 between one of its directors and an employee of one of the Respondent's associated companies concerning the registrations.

The Complainant states that the project included the development of a website and attaches a screenshot from the Internet Archive dated 23 May 2016 showing in the footer that this website is the copyright of the Complainant.

The Complainant attaches evidence that it applied for the trade mark THE TABLET LAWYER on 31 July 2014, prior to the registration of the Disputed Domain Names. This

trade mark was registered on 7 November 2014. The Complainant argues that the Disputed Domain Names are identical or sufficiently similar to this trade mark and thus the Respondent has no legitimate rights to claim ownership of them.

Abusive Registration

The Complainant states that it believes that the evidence submitted (the trade mark registration, usage and acknowledgement of ownership) demonstrates that the Complainant is the rightful owner of the Disputed Domain Names and that the Respondent's actions represent abusive registration.

The Complainant contends that the Respondent is using the Disputed Domain Names to direct visitors to a website offering the application/service that is the intellectual property of the Complainant. In the Complainant's opinion, although this aspect is outside of the scope of the Complaint, the redirection itself is causing confusion with regard to the legitimate owner of the Disputed Domain Names.

The Complainant argues that the Respondent has no legitimate rights to claim ownership of the Disputed Domain Names, and states that the Respondent is withholding access to their management and misleading others. The Complainant adds that the Respondent has failed to permit access to correct DNS records and as a result internet services for the Complainant have been severely affected.

The Complainant states that it believes that the Respondent has also acknowledged in previous communications that the Complainant is the rightful owner of the Disputed Domain Names.

On the basis of the evidence presented, the Complainant requests that the Disputed Domain Names be returned to the control of the Complainant with immediate effect.

Response

The Respondent states that one of its associated companies entered into a joint development agreement and partnership on 7 July 2014 with one of the Complainant's associated companies. This agreement dealt with software development and associated services for the TabletLawyer products. The terms of the agreement covered liability, ownership, termination and payment. In the Respondent's opinion, the agreement was clear and detailed and included provisions relating to dispute resolution.

The Respondent contends that the Complaint is misleading and highly inaccurate, and states that the agreement indicates that the software developer (its associated company) retained all right of ownership of all products and associated intellectual property until such time as payment was received in full, and the Disputed Domain Names form part of the retained intellectual property.

The Respondent underlines that the Complainant indicates that there is no pending legal action, but asserts that the Complainant has been served notice of termination for breach of contract and advised that the developer reserves the right under statute to recover sums due as per the agreement.

The Respondent states that the Complainant:

- ignored all attempts to settle under the agreed alternative dispute resolution process and timeframe by the developer;
- failed to make payments as per the agreement, and therefore intellectual property, including the Disputed Domain Names, was not transferred; and
- attempted to circumvent payment by registering a number of alternative domain names whilst also attempting to transfer items covered within and beyond the agreement.

The Respondent states that the agreement and other services were terminated due to the Complainant's contractual breach in August 2016. The Respondent's associated company attempted to pursue settlement and transfer of intellectual property under the agreed alternative dispute resolution process until October 2016, although the Complainant failed to acknowledge or respond to any communication. In November 2016, the Complainant's associated company agreed in the absence of payment to allow the developer to retain all intellectual property including the Disputed Domain Names.

The Respondent argues that:

- the Complainant has a track record of not paying for services or work completed, and other services remain suspended due to lack of payment and are subject to on-going recovery action;
- the Disputed Domain Names are owned by the Respondent and its associated company, as well as all content and associated services;
- the Disputed Domain Names form an integral and important part of the Respondent's systems, software and marketing efforts for its on-going business, and any attempt to transfer them will be vigorously defended;
- the Complainant had ample opportunity to respond to the agreed alternative dispute resolution process yet chose to ignore this, and thus any claim to intellectual property rights has already expired; and
- any trade mark disputes the Complainant could raise including the scope will be successfully defended.

In summary, the Respondent contends:

- the Complainant operates a dormant company using another domain name registered in October 2016, <tabletlawyer.net>, which still displays nothing more than a registrar holding page;
- <tabletlawyer.net> has no published DNS records or MX capabilities;
- the Disputed Domain Names were registered by the Respondent in August 2014, over one year before the incorporation of the Complainant;
- the on-going associated costs of the Disputed Domain Names to date, including renewals, have been met by the Respondent, who remains the rightful established owner, both current and historic, with full rights to operate them within the needs of its business, including all associated intellectual property, without interference;
- the Respondent has invested significant time, money and effort in its TabletLawyer brand, including the function, design, marketing and technical framework; and
- as the established operator, owner and developer of the TabletLawyer brand and services, the Respondent considers the registration of <tabletlawyer.net> to be misleading and will explore further options to pursue ownership.

The Respondent refutes all of the Complainant's claims and reiterates its opinion that it is the legitimate owner and operator of the Disputed Domain Names. It asserts that the Complainant has not operated them in any way, and nor does the Complainant have any entitlement to use them. In the Respondent's opinion the Complaint has no merit.

The Respondent argues that, in view of the above, the Nominet Dispute Resolution Service ("DRS") is not the right platform for the dispute, which falls outside the scope of the Policy. The Respondent stresses that its products and services depend heavily on the Disputed Domain Names.

Finally, the Respondent adds that, in the event of transfer, it would seek resolution via the agreed alternative dispute resolution service or the courts, given the complex nature of the issues, including the potential for significant loss and disruption to its business.

Reply

The Complainant asserts the following:

- no form of partnership or joint development agreement was either created with or entered into by the Complainant and the Respondent;
- any and all agreements referred to by the Respondent were with the Respondent's associated company alone, and at no time was any form of partnership or joint development agreement either created with or entered into with such associated company;
- any relationship between the Respondent and the Respondent's associated company is not the concern of the Complainant;
- the agreement referred to by the Respondent is clear that the ownership of the intellectual property shall and shall remain the property of the Complainant (no terms in that agreement appear to suggest otherwise, however the Complainant states that it is happy for the relevant portions of that agreement to be considered with the information previously submitted);
- THE TABLET LAWYER is a trade mark of the Complainant (it was transferred to the Complainant shortly after its formation);
- the status of the Complainant is not relevant to this dispute - it remains operational and therefore retains the trade mark;
- on 3 October 2016, the Complainant received a statement of services provided by the Respondent's associated company from one of its representatives, and in that email the Respondent voluntarily identified that two of the Disputed Domain Names belonged to the Complainant (and the Complainant states that it would be happy for that email to be considered with the information previously submitted); and
- all other aspects noted by the Respondent in its response are outside the scope of this dispute, and the Complainant states that it will only address matters solely related to the Disputed Domain Names.

6. Discussion and Findings

General

Under paragraph 2.1 of the Policy, for the Expert to order a transfer of a 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*".

The Expert is satisfied, based on the evidence presented, that the Complainant has the necessary Rights in the mark THE TABLET LAWYER, notably as a result of the UK trade mark referred to in the Complainant's submission and attached as evidence (Number: UK00003066574).

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights must be identical or similar to the Disputed Domain Names. It is accepted practice under the Policy that the ".co.uk" and ".uk" suffixes may be discounted, and the Complainant's trade mark and two of the Disputed Domain Names are thus identical to one another (<thetabletlawyer.co.uk> and <thetabletlawyer.uk>). As for the additional two domain names (<tabletlawyer.co.uk> and <tabletlawyer.uk>), the Expert finds that the omission of the word "the" is not significant enough to dispel any similarity between the Complainant's trade mark and the Disputed Domain Names.

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 or similar to the Disputed Domain Names.

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."*

The Expert has considered the parties' submissions in detail and understands that the Respondent registered the Disputed Domain Names as a result of a contractual relationship with the Complainant (it seems that the contracting parties were likely to have been their associated companies, but this is irrelevant for the purposes of the Policy). Relations have now clearly broken down and the Complainant would like to obtain the Disputed Domain Names. Whether or not it is entitled to do so most likely depends on the terms of the contract covering the services provided by the Respondent. In this regard the Complainant asserts that such contract provides that it owns the Disputed Domain Names, whilst the Respondent asserts the opposite, namely that it is entitled to retain them due to the Complainant's breach.

Neither party has provided the Expert with a copy of such contract, but this is not an issue as it is not the Expert's role to decide complex contractual disputes, see for example *Learning South West v. Conscribe Limited*, Nominet DRS 01560. In that case the Expert commented as follows:

"The Nominet DRS procedure is not designed to resolve contractual disputes between parties; that is the province of the Courts. This is not just because many of the Nominet Experts have no formal legal training. Where there is no dispute as to the key contractual terms governing the registration of the Domain Name, an Expert may feel able to decide whether or not there has been a breach of contract as part of his or her broader analysis of whether there has been an Abusive Registration; but where the parties are in serious dispute over such fundamental matters as the intended registrant or the availability of a contractual lien, it is inappropriate for an Expert to attempt to resolve such disputes on the basis of brief written submissions. Moreover, in such circumstances it is difficult to see how the Respondent's registration or use of a domain name could be characterised as 'unfair' or 'abusive' with any degree of confidence when there exists a realistic prospect that the Respondent has in fact done nothing more than perform the agreement in accordance with the parties' intentions."

The Expert wholly agrees with this statement. It is impossible to decide, based on the evidence presented, whether the Disputed Domain Names were abusively registered under limb (i) in the name of the Respondent, without seeing the signed contract covering the services concerned, or without further detailed examinations of the parties' contentions. Similarly, whether the Respondent's subsequent use under limb (ii) is abusive or not also depends on what was contractually agreed between the parties, although this is additionally complicated by the existence of the Complainant's registered trade mark.

Even if the Expert had been supplied with a copy of the signed contract, detailed consideration of this would be outside of the scope of Nominet's DRS Service, which is predominantly intended to combat straightforward cases of cybersquatting and only provides for consideration of brief written submissions. In addition, whilst cybersquatting and trade mark infringement generally coincide, it is simply the Expert's job to decide whether abuse is made out under the terms of the Policy, not to consider complex trade mark infringement issues or contractual disputes. This is not the purpose of the Nominet forum, but instead a question for a court of competent jurisdiction.

Having said this, an Expert may feel able to decide on abuse, even when the dispute touches on wider issues such as contract law or trade mark infringement, if such abuse is found to exist on the balance of probabilities. However the Expert feels that this is not the case here based on the evidence presented. It is of note that the parties' submissions are completely contradictory. The Expert notes that the Complainant's initial submission did not mention the contractual dispute, and, although the Complainant asserted in both the Complaint and the Reply that the Respondent had acknowledged the Complainant's ownership of certain of the Disputed Domain Names, no evidence of this was provided. In addition, the Respondent asserted that it had always paid for the registrations and renewals of the Disputed Domain Names and the Complainant did not dispute this.

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 Names are 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 Names, but is not satisfied that the Disputed Domain Names, in the hands of the Respondent, are an Abusive Registration. No action should therefore be taken in relation to the Disputed Domain Names.

Jane Seager
19 September 2017