

DISPUTE RESOLUTION SERVICE

D00019787

Decision of Independent Expert

Walden O'Neill Ltd

and

GOOSEBUMPS

1. The Parties:

Lead Complainant: Walden O'Neill Ltd
Walden O'Neill
Cadbury Way
Bermondsey
London
SE16 3XB
United Kingdom

Complainant: Mrs Katherine Ashmore
Outsmart Out of Home LTD
Clear Channel
33 Golden Square
London
W1F 9JT
United Kingdom

Respondent: GOOSEBUMPS
20A Brownlow Mews
London
WC1N 2LA
United Kingdom

2. The Domain Name(s):

outsmart.org.uk

3. Procedural History:

I can 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

25 January 2018 07:28 Dispute received

25 January 2018 11:00 Complaint validated

25 January 2018 11:03 Notification of complaint sent to parties

13 February 2018 01:30 Response reminder sent

16 February 2018 11:29 No Response Received

16 February 2018 11:30 Notification of no response sent to parties

19 February 2018 13:51 Expert decision payment received

23 February 2018 Keith Gymer appointed as Expert

4. Factual Background

The lead Complainant is identified as Walden O'Neill Limited. No information was provided about this Complainant in the Complaint. From its website at www.waldenoneill.com, it is apparently a website development agency that has worked for the second Complainant.

The second Complainant is identified as Mrs Katherine Ashmore of Outsmart Out of Home LTD. According to Companies House records, Mrs Ashmore is Company Secretary of Outsmart Out of Home LTD, which is evidently a digital advertising agency. It operates a website at www.outsmart.org.uk using the Domain Name, where Mrs Ashmore is also identified as the company's Communications Manager.

According to the Nominet Whois records, the Domain Name was first registered as of 5 May, 2015, in the name of "GOOSEBUMPS".

On enquiry from the Expert, Nominet has advised that, at that time, they were also provided with the Company Registration No. 09456502 - which is for a company actually named "Goosebumps Branding Ltd."

The Companies House records confirm that this company was dissolved as of 23 January, 2018 – before the Complaint was filed. However, Nominet has also advised that, in July 2016, GoDaddy took over as Registrar for the Domain Name and the Company Registration details were then removed from the Whois record for the Domain Name.

The Whois record currently identifies the Registrant type as "Unknown".

5. Parties' Contentions

Complainants

The Complaint briefly presents the following main points in support of the Complainants' case:

"The domain <http://www.outsmart.org.uk/> [sic] used to be managed by Goosebumps but they have since ceased trading and they are marked as 'Dissolved' on 23rd January 2018 on Companies House: <https://beta.companieshouse.gov.uk/company/09456502>

However, when they handed over management of the website they failed to provide either Outsmart or Walden O'Neill the login details for the GoDaddy account they used to register the domain, or initiate a domain transfer process.

All they did was change the IPs the domain was pointing to for us [Walden O'Neill] so the site was running from a new host that we had control over and at the time our assumption was that they would have handed control of the domain over to Katherine and Outsmart. As it turns out this never happened.

By rights 'Outsmart Out of Home LTD' (company ID: 01642847) should be the owners of the domain and not the agency partner and they can further prove that by their ownership of the trademark on the brand (certificates submitted as supporting evidence).

We have tried contacting the old Goosebumps team several times, ... to no avail.

[W]e have had no response from ... anyone at Goosebumps to the various requests we have submitted for help and so we feel we are left with no alternative but to submit this dispute.

We first submitted this Complaint on 21st November 2017 but because of the holiday period we missed the deadline to confirm we did want to proceed with the resolution process and pay the fees so we are re-submitting now."

Why is the domain name an Abusive Registration?

"Without access to the domain control panel Outsmart cannot properly manage their domain or have any confidence in being able to retain it in the future.

It is entirely abusive of the Goosebumps owner ... to withhold access to the domain as he has no right to it since he ceased working with Outsmart. He

registered it on behalf of his client whom he then surrendered and he should have surrendered access to all of his clients digital property at the same time.

By retaining control ... Goosebumps are 100% stopping us using the domain, disrupting Outsmart's business and potentially retaining it with the intention of selling or renting it back to Outsmart or a competitor.

If we don't obtain access through this dispute process our only option will be to wait for the domain to expire in May 2018 and attempt to re-purchase it then. But that is fraught with risk and has no guarantees that we won't end up missing out on the domain and having to start a dispute process anyway."

Respondent

The Respondent provided no response.

Remedy Requested

Transfer

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that

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

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

Under Paragraph 18.1 of the Policy, the Expert is required to decide a complaint on the basis of the Parties' submissions and the Policy.

Complainant's Rights

The Complainants have provided a copy of the Certificate of Registration for EUTM 14286736 dating from 2015, demonstrating rights in the mark OUTSMART, originally registered in the name of Outdoor Media Centre Limited, together with a copy of the official notification reporting the recordal of the change of name of this entity to Outsmart Out of Home Limited (i.e. the second Complainant) in January 2016.

The disputed Domain Name is "outsmart.org.uk".

The domain suffixes ".org.uk" are not relevant to the comparison in this case.

The Expert therefore finds that at least the second Complainant has relevant Rights in a name or mark, which is essentially identical to the Domain Name. The requirement of Paragraph 2.1.1 of the Policy is met.

Abusive Registration

The Complainant also must show that the disputed Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines “Abusive Registration” as a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR
- ii. is being or has been used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 5 of the Policy.

The Complainants have asserted that:

“By retaining control ... Goosebumps are 100% stopping us using the domain, disrupting Outsmart’s business and potentially retaining it with the intention of selling or renting it back to Outsmart or a competitor.”

This is plainly an exaggeration, unsupported by any evidence, and contradicted by the Complainants’ themselves who separately state that “[the Respondent] handed over management of the website” ... “so the site was running from a new host that we had control over”. The Complainants are not being prevented from using the Domain Name for their website at all.

More appropriate is their claim that:

“It is entirely abusive of the Goosebumps owner ... to withhold access to the domain as he has no right to it since he ceased working with Outsmart. He registered it on behalf of his client whom he then surrendered and he should have surrendered access to all of his clients digital property at the same time.”

The following example from Paragraph 5 of the Policy is therefore the one relevant to the present dispute:

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;

This particular example of what may constitute evidence of an “Abusive Registration” for the purposes of the Policy was first introduced in Version 2 of the Policy as of 25 October, 2004. Previously, under the original version of the Policy, it was not universally accepted that the Policy should be applied to disputes which could be characterised principally as contractual in nature, between parties which had an agency or employer/employee relationship, as appears to apply in the present case. This is intended to allow for situations where the Domain Name does not fall under Paragraph 1.i of the definition of an Abusive Registration, but where there has been some breakdown in the original relationship, and the original intent of that relationship has been frustrated with some unfairly detrimental consequence for the Complainant, notwithstanding that it is the Complainant (and not the Respondent) which is actually making “use” (in any ordinary sense of the word) of the Domain Name at issue.

However, this is an exceptional example, and the evidential requirements are clearly specified in the Policy, and explained in the Example Complaint Form provided with other supporting materials for Complainants to consult in the DRS Guidance on Nominet’s website, where it states:

“Describe why the domain name is an Abusive Registration...

“The Domain Name in the hands of the Respondent is abusive because it was:

- g. registered because of the prior relationship between us i.e. web designer/ hosting company/friend... *(detail who and what sort of relationship it was, and provide evidence)*...but I am now using the site and paying the registration/renewal fees *(provide evidence – screenshots of the web site/emails and invoices/ emails from them regarding the domain name)*.

Unfortunately, the Complainants do not appear to have taken the trouble to read the actual provisions of the Policy, nor the DRS Guidance in this respect. Consequently, in the Expert’s view, the Complaint is inadequate for a number of reasons.

The relationship with the Respondent entity is not explained clearly, certainly not sufficiently for Paragraph 5.1.5 of the Policy to be satisfied. The identity of the Respondent “Goosebumps” is not clear – whilst Nominet has indicated that this was originally identified as Goosebumps Branding Limited, which was dissolved on 23 January, 2018, that may possibly have changed when GoDaddy took over as responsible Registrar and deleted that information. Thus, it is conceivable that there may have been an intentional change of the Registrant type at that time – e.g. to a trading style of an individual or other entity. The Complainants have provided no evidence to show that either of them had any contract with any “Goosebumps” entity, and no evidence to confirm that they paid for the Domain Name registration and/or renewals.

As Goosebumps Branding Limited has been dissolved, any property and rights outstanding (including rights under their domain name registration contract with GoDaddy) would now be *bona vacantia* and at the disposal of the Crown (subject to whatever GoDaddy contracts may have to say about what happens if a registrant goes out of business).

Para 10.4 of Nominet's own T&Cs for Domain Name Registration state:

10.4 If you are not an natural person, your domain name will be cancelled if you complete a liquidation or disbandment process or otherwise no longer exist, even if (where possible) you are later restored by an official or court order or decision.

If the registrant were unequivocally accepted as Goosebumps Branding Limited, the Domain Name registration would essentially now be forfeit under those terms.

The Expert understands that Nominet's practice in such situations would be simply to suspend the Domain Name registration and allow it to lapse in due course when the current registration period expires. Where there is evidence that an affected Domain Name remains genuinely in use by a third party (as seems to be the situation here), then Nominet is prepared to consider representations from such third party regarding maintenance or transfer of the Domain Name on conditions, and subject to its discretion. It would therefore appear advisable for the second Complainant to contact Nominet directly if it wishes to pursue a claim in these circumstances.

Otherwise, for this Complaint, in view of the inadequacies noted above, the Expert finds that the Complainants have failed to show that the Domain Name, in the hands of the Respondent, is an Abusive Registration under the terms of the Policy.

7. Decision

Having found that the second Complainant has relevant Rights, but that the Domain Name, in the hands of the Respondent, has not been shown to be an Abusive Registration, the Expert denies the Complaint and orders that no action be taken under the Policy.

Signed
Keith Gymer

Dated 28 February, 2018