

Nominet UK Dispute Resolution Service

DRS Numbers 04965

Newsquest Media Group -v- D N Computer Services

Decision of Independent Expert

1. Parties

Complainant Type: Business
Complainant: Newsquest Media Group
Address: 58 Church Street
Weybridge
Surrey
Postcode: KT13 8DP
Country: GB

Respondent: D N Computer Services
Respondent name: David Neath
Address: The Old Forge
25A Banbury Road
Ettington
Warwickshire
Postcode: CV37 7SN
Country: GB

2. Domain Names

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

3. Procedural Background

The complaint was lodged electronically with Nominet on 15 August 2007 and in hard copy on 29 August 2007. The Respondent responded on 11 September 2007. The Complainant did not reply. Mediation documents were generated for the complaint on 9 October 2007.

The fee for an expert decision was received on 22 October 2007. On 25 October 2007 Claire Milne was selected to act as expert in the case, having confirmed that she knew of no reason why she could not properly do so; and that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality. Her date of appointment was 29 October 2007.

4. Outstanding Formal/Procedural Issues (if any)

None

5. The Facts

1. The Complainant publishes the Bicester Advertiser, and registered the domain name bicesteradvertiser.com on 16 March 2001.
2. The Respondent registered the Domain Name, along with onlineadvertisers.co.uk and nine other 'advertiser' domain names including place names in central England, on or around 13 April 2004.

3. The Complainant contacted the Respondent to offer to acquire the Domain Name on 13 March 2007. On 20 March 2007 the Respondent rejected an offer by telephone of £100 for the Domain Name and asked for the offer to be put in writing. The Complainant put the offer in writing on 26 March 2007.
4. The website www.bicesteradvertiser.com currently provides articles and advertisements for areas around Bicester and (through www.thisisoxfordshire.co.uk) links to similar or identical websites for domain names registered by the Complainant, such as www.oxfordmail.net, www.didcotgazette.net and www.bicesteradvertiser.net.
5. The website www.bicesteradvertiser.co.uk currently produces HTTP error 403 ('You are not authorized to view this page').
6. The website www.onlineadvertisers.co.uk currently links to websites for three of the other 'advertiser' domain names registered by the Respondent, which provide advertisements for local traders in their respective areas.

6. The Parties' Contentions

Complainant's Contentions

1. The Complainant has established rights in the name 'Bicester Advertiser'. This is a well regarded regional newspaper title that was established in 1879 and has built up a strong regional identity and valuable goodwill in the community.
2. The Respondent has taken unfair advantage of the Complainant's rights by registering a domain name identical to the name. The registration is a flagrant misuse of the name that amounts to actionable passing off.
3. The registration is blocking the use of the Domain Name as the Complainant's primary website. It is also disrupting the business of the Complainant, who hoped to expand its business online using the Domain Name.
4. Readers of the Bicester Advertiser are likely to believe that the Domain Name is operated by or in some way connected with the Complainant. They would often type in www.bicesteradvertiser.co.uk and expect to see the Complainant's website of the Complainant.
5. The Respondent has shown no evidence of using the Domain Name legitimately.
6. On 13 March 2007, the Complainant offered the Respondent his reasonable costs for the registration of the Domain Name, in line with Nominet's guidelines to provide 'out-of-pocket' expenses. On 20 March 2007, the Respondent rejected the offer by telephone, asked for the offer to be put in writing and stated that he would 'consider a substantial offer'. The Complainant asked about the meaning of 'substantial'. The Respondent did not reply and suggested that the Complainant make an offer. The Complainant offered £100. The Respondent laughed and said 'think again'. The Complainant said that £100 was already above out-of-pocket expenses, and that the attempt to extract more money was evidence that the registration was abusive. The Respondent asked for the offer to be put in writing. On 26 March 2007, the Complainant sent the offer in writing to the Respondent. On 11 April 2007, the Respondent rejected the offer and suggested that the Complainant 'reconsider its position and make a sensible offer'.
7. The Complainant felt strongly that there was a possibility that the Respondent would agree to a sensible compromise, but this did not happen. The Complainant is proceeding with this matter under Nominet's Dispute Resolution Service because it is unjust that 'cybersquatters' and persons who register abusive domain names can profit from registering domain names in which others have legal rights. The Complainant feels that this matter needs to be resolved, if necessary by adjudication or through the courts, under an action of passing off.

Respondent's Contentions

1. The Domain Name was registered with other 'advertiser' domain names and www.onlineadvertisers.co.uk for an ongoing project. The Respondent was unaware of any publication with the name 'Bicester Advertiser' until contacted by the Complainant. When researching domain names at the time of registration of the Domain Name, the Respondent found that where a town had an 'advertiser' publication, the corresponding domain name was usually taken already.
2. Bicester is a town and 'advertiser' is a commonly used word, so arguably the Domain Name is generic.
3. There is an email facility at webmail.bicesteradvertiser.co.uk but the website for the Domain Name has not yet been published.
4. The Domain Name could be used without any implication of passing off as the hard copy advertiser. For example, the Bicester Villages Advertiser is displayed at www.postaladvertisers.co.uk, and 'Bicester Villages' has less prominence on the front cover than 'Advertiser'.
5. The Respondent responded to the initial contact from the Complainant with a polite reply offering the Domain Name. The Complainant contacted the Respondent by telephone threatening action through Nominet or the courts, pointing out that the Respondent might as well part with the name, because the Complainant had never yet lost a complaint, and saying that if the complaint went to Nominet it would cost the Complainant only £170 and the Respondent would get nothing. The Complainant offered £100. The Respondent asked for the offer to be put in writing. The Respondent subsequently asked for future contact to be in writing because the Complainant distorted events and added comments such as 'he laughed and said think again'. The Respondent would be unlikely to say that and then ask for the offer to be put in writing.
6. The Complainant would not move from the original offer of £100 when using mediation through Nominet. He did not wish to negotiate, appeared to have decided without justification that the Respondent was a 'cybersquatter', and had adopted an insulting and threatening attitude throughout.
7. The Respondent has never registered a domain name to profit from its resale.
8. The Respondent is happy to transfer the Domain Name to the Complainant on receiving a payment in compensation, and has made this clear to the Complainant. The parties merely need to negotiate the correct payment.

7. Discussion and Findings

The Nominet Dispute Resolution Service Policy ('the Policy') paragraph 2 requires that for a complaint to succeed the Complainant must demonstrate to the Expert, on the balance of probabilities, that:

- i. the Complainant 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 Respondent, is an Abusive Registration.*

Rights

The Policy paragraph 1 states

Rights include, but are not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term that is wholly descriptive of the Complainant's business.

'Bicester' is the name of a town and 'advertiser' is a common word used in one of its ordinary dictionary senses. The name 'Bicester Advertiser' is therefore descriptive of the Complainant's business. However, the Complainant has provided evidence of having rights in the name: its publication has a regional identity and goodwill under that name.

For the purpose of the Policy, spaces are unimportant and the name 'Bicester Advertiser' is similar to 'bicesteradvertiser'. Indeed, the Complainant already uses the domain names bicesteradvertiser.net and bicesteradvertiser.com.

I therefore find that the Complainant has Rights in a name or mark that is identical with or similar to the Domain Name.

Abusive Registration

The Policy paragraph 1 states that an Abusive Registration is a domain name that:

- 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.*

The first point refers to actions at the time of registration. The Complainant has presented no evidence relating to the time of registration. The Respondent says that he did not then know that the Complainant had those Rights, and has suggested that at the time of registration publishers of 'advertiser' publications had usually registered the domain names in which they were interested. He has presented some evidence that he made preparations to use the Domain Name before being aware of the complaint, in that he registered the Domain Name at the same time as various other 'advertiser' domain names that he now uses to display local advertisements.

The second point refers to actions after the time of registration. The Complainant says that the Respondent has shown no evidence of using the Domain Name legitimately. The Respondent points out that the Domain Name has an email facility even if its website has not been published. In itself, being willing to sell the Domain Name for some sum greater than £100 does not imply that the Respondent is using the Domain Name in a manner taking unfair advantage of or unfairly detrimental to the Rights of the Complainant.

Nominet's Policy provides non-exhaustive lists of factors which may be evidence of a Registration being Abusive or not. I have considered each of these factors. The Complainant has alleged that the Domain Name is a blocking registration, but has provided no evidence to that effect. There is reference to a pattern of registrations, and the Domain Name is indeed in a series of similar domain names that the Respondent registered, but the Respondent has demonstrated that he is using some of those domain names as local advertisement websites.

The Respondent is not willing to sell the Domain Name for £100, which the Complainant regards as being greater than the out-of-pocket expenses. However, this does not imply that the Respondent registered the Domain Name to resell it, or to block its use by the Complainant, or to unfairly disrupt the business of the Complainant.

Overall, the Complaint lacks evidence to support its assertions, while the Respondent has supplied some evidence that the registration was not abusive. On the balance of probabilities, I find that the Domain Name, in the hands of the Respondent, is not an Abusive Registration, either through the original registration or through its subsequent use.

8. Decision

I find that the Complainant has Rights in a name or mark that is identical with or similar to the Domain Name. On the balance of probabilities, I do not find that the Domain Name, in the hands of the Respondent, is an Abusive Registration. No action is required.

Claire Milne
4 November 2007