

**DISPUTE RESOLUTION SERVICE**

**DRS 06832**

**Decision of Independent Expert**

Paulson Ambookan

and

Elife Limited

**1. The Parties:**

Complainant: Paulson Ambookan  
Address: PO Box 7738  
Hicksville  
Postcode: 11802  
Country: United States

Respondent: Elife Limited, c/o Mohammad Zaffer  
Address: 383 Pinner Road  
North Harrow  
Middlesex  
Postcode: HA1 4HN  
Country: United Kingdom

**2. The Domain Name(s):**

Computeruser.co.uk

### **3. Procedural History:**

The Complaint was lodged with Nominet on February 6, 2009. Nominet validated the Complaint and notified the Respondent of the Complaint on February 9, 2009 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent submitted a Response on February 27, 2009. On April 22, 2009 the Respondent paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

Dawn Osborne, the undersigned, (“the Expert”) confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in this case and further confirmed 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.

### **4. Factual Background**

The Complainant is the owner of two websites, namely, computeruser.com and computerusers.com.

### **5. Parties’ Contentions**

The substance of the Complaint is as follows:

1. The domain is similar to the Complainant’s domain in the United States.
2. The Complainant contends that name is an UPTO (sic) trademark.
3. Complainant receives many visitors from the United Kingdom and companies who use the publications to generate business.
4. If the site is set up it will be misleading
5. Currently the site is being used to take away the Complainant’s readers to a domain collection page.
6. The site is used for domain crawling purposes only and without any business reference. ComputerUser Magazine has been in business for over 30 years and is consistent in providing technology news to businesses. They have over 300 companies providing content every day to help businesses grow.

The substance of the Respondent is as follows:

1. The Respondent strongly disputes that the Complainant has acquired any rights in the term “computer user”.

2. The Complainant refers to a “UPTO trademark” but does not identify it, let alone supply proof. The Complainant then goes on to say “I would both trademarks” which does not make sense.
3. The term “computer user” is a common generic and descriptive name. It describes a person who uses a computer. This statement hardly requires supporting evidence.
4. The Complainant itself uses the term “computer user” in a generic/descriptive manner. On its own website at computeruser.com, the Complainant states: In this new internet everybody is a computer user.
5. The public has no reason to associate the generic/descriptive term “computer user” with the Complainant. For example, the decision in DRS 00752 (datingagency.co.uk) at para 8.5:

*“Notwithstanding the fact that the Complainant has clearly expended considerable time and effort in creating a successful business by use of the Mark, I find it impossible to say that the words “dating agency” are not a name or term which is wholly descriptive of the Complainant’s business and I am not assisted by the development of the Mark into its various forms by the addition of e-commerce suffixes. I consider the words “dating agency” to be both generic and descriptive and notwithstanding the success and development of the Complainant’s business I am not persuaded that the Complainant has acquired a secondary distinctive meaning through the use the Complainant has made of them adequate to give the Complainant sufficient protection as would enable it to have an unfair monopoly of those words”.*

6. The Respondent refers also the well known statement of the House of Lords that traders run the risk of confusion (denied in this case) if they adopt words in common use for their trade names: “But that risk must be run unless the first user is allowed unfairly to monopolise the words.” (*Office Cleaning Services v Office Cleaning Association (1946) 63 RRP at 43*)
7. The Respondent acknowledges that under the Policy “Rights” includes rights in descriptive terms which have acquired a secondary meaning. Here, it must be the case that the widely used generic and wholly descriptive term “computer user” is incapable of generating secondary rights.
8. Even if the term was capable of generating rights, the Complainant would have a hugely difficult task in demonstrating a secondary meaning. It has not even attempted this task.
9. The Complainant simply makes the bald assertion that it is “a leading online magazine for business users” but provides no meaningful detail, let alone supporting evidence, in relation to its claims.

10. The Complainant has failed to establish rights.
11. The Complainant should not be allowed to correct the fundamental flaws in its complaint by providing new information or evidence in a reply. Paragraph 6b of the DRS Procedure states: “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.” The Complainant did raise the issue of rights in the complaint (as it has to do) but addressed it in a way which was wholly inadequate.

*Applicable principles*

12. The DRS appeal panel in *verbatim.co.uk* (DRS 4331) analysed previous DRS appeals and concluded at paragraphs 8.13-14 that: “...for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name.” Similar principles were applied by Appeal Panels in *mercero.co.uk* (DRS 3733) at 8.14-15, and *bounce.co.uk* (DRS 3316) at 8.3.6-7.

*Acquisition and use of the domain name*

13. The Respondent is in the business of buying, selling and monetising generic domain names. (Paragraph 4d of the Policy observes that “[T]rading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities.”) 2.3 The Respondent registered the disputed domain name on 10 December 2005 . The Respondent thought it a potentially attractive domain name to have because it reflected a common generic term used in relation to the computer / IT industry. The Respondent owns many similar generic computer / IT-related domain names including *computerexpert.co.uk* and *computerguru.co.uk*. The domain name was registered in that context.
14. The Respondent had in mind to profit from advertising links and ultimately to sell the domain name at some point to anyone with an interest in it.
15. The Respondent did indeed connect the domain name to a parking page provided by a third party provider. This consists entirely of insurance-related links. The Respondent makes no apologies for use of a parking page, which is of itself entirely legitimate (contrary to the insinuation of the Complainant) – see further below.

*Lack of knowledge of the Complainant*

16. The Respondent was not aware of the Complainant’s “online magazine” on registration of the domain name nor was there any reason why the Respondent should have heard of it. Indeed the Complainant has not suggested any reason.
17. The Complainant has produced no evidence of significant reputation at all, let alone in the UK. Insofar as the Complainant does have a reputation, it is clear that this is in the US. The Complainant refers to its “domain in the United States” and indeed the logo on the Complainant’s site includes the US and Indian flags. As to the UK, the Complainant simply makes the vague and unsupported assertion that it has “a lot of visitors from the UK”.

18. Accordingly, in accordance with *verbatim.co.uk*, the Complainant has failed to get to first base as it has not demonstrated that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the domain name or at any material time thereafter.
19. Even if the Respondent had become aware of the Complainant's "online magazine" (which it had not), it would not have occurred to the Respondent that it was debarred from registering / using the domain name because a business happened to use the same generic term. See, eg, the appeal decision in *maestro.co.uk*, (DRS 4884):
 

*"... knowledge of the Complainant's trade mark only gets the Complainant part of the way. When the trade mark in question is a dictionary word, there has to be something more than knowledge of the trade mark to justify a finding of Abusive Registration. Were it otherwise, owners of trade marks which are dictionary words would effectively be able to monopolise the use of such words for domain names."*
20. Indeed, the appeal panel also stated in *maestro.co.uk*, *supra*:
 

*"Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive, if it is to be held to be an Abusive Registration under the DRS Policy."*
21. In this case, the domain name consists of two single ordinary English words which are commonly used in conjunction with each other, their meaning has not been displaced by an overwhelming secondary meaning and there is no evidence at all - let alone any persuasive evidence - of abuse.
22. The complaint must therefore fail but for completeness the Respondent nonetheless addresses the Complainant's (unclear) assertion that "[T]here will be a misleading site if the site is up. Currently the site is used to take away my readers to a domain collection page and I am looking customers [sic]".

#### *Confusion*

23. Paragraph 4e of the Policy makes clear that sale of traffic (ie connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable. The Expert is to take into account, inter alia, use of the domain name and the nature of the advertising links.
24. In *wiseinsurance.co.uk* (4889), the appeal panel stated:
 

*"...the limitations of the goodwill associated with the Complainant's use of its name, makes the likelihood of such confusion very low indeed, and given that the Complainant has adopted a descriptive name for its business it cannot, without more extensive rights, complain about the use of the same descriptive name by a third party."*
25. Here, for reasons stated above, there is no goodwill at all associated with the Complainant's use of the disputed domain name and it cannot complain about the use of similar descriptive / generic terms by third parties.
26. In any case, the Complainant fails to explain why anyone would associate with the Complainant a site consisting purely of a directory of search category links,

which in fact are completely unconnected with the Complainant's business. Internet users are well used to this kind of directory / search engine site which is a world away from the Complainant's own website.

### *Conclusion*

27. For the above reasons, the Respondent denies that computeruser.co.uk is an abusive registration.

### *Reverse domain name hijacking*

28. The Complainant has made no attempt to address the Policy or provide any evidence in support of its very general assertions. The Complainant cannot seriously have contemplated that it could win this case and the Respondent has been put to unnecessary expense in having to defend it. The Respondent asserts that this complaint is therefore an abuse of process and requests a finding of domain name hijacking.

## **6. Discussions and Findings**

### **General**

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

### **Complainant's Rights**

The Complainant must prove it has enforceable legal rights in a name or mark which is identical or similar to the Domain Name. The definition of "Rights" in the Policy is not confined to intellectual property rights and could conceivably extend to other enforceable legal rights. It may include rights in descriptive terms that have acquired a secondary meaning.

The Complainant appears to be saying that he has a US registered trade mark, but does not give any details or provide any copy of the registered trade mark. It is possible that the Complainant has built up some goodwill in the Computer User name for its services, but with such a descriptive term there would need to be evidence of significant use in order to show secondary meaning. All the Complainant has sent is one screen shot of the home page of a web site at [www.computeruser.com](http://www.computeruser.com). Accordingly sufficient evidence has not been provided to allow the panellist to reach a conclusion. It is certainly possible that "computeruser" is purely descriptive in the context of the Complainant's services. It is unsatisfactory that the Panel is left to guess at the position and it has not been adequately addressed in the Complaint.

In such cases panellists can call for further information from the Complainant. However, in view of my further conclusions set out below I find that this will not be necessary.

### **Abusive Registration**

Under the second limb the questions is whether the Domain Name, in the hands of the Respondent 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. has been used in a manner, which took unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.”

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. There being no suggestion by the Complainant that the Respondent has any relationship with the Complainant or that the Respondent has given to Nominet false contact details, the only potentially relevant ‘factors’ in paragraph 3 are to be found in subparagraph i, ii and iii which read as follows:

- i “Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - A. 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;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C. primarily for the purpose of unfairly disrupting the business of the Complainant;”
- ii “Circumstances indicating that the Respondent is using 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.
- iii “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 trade marks in which the Respondent has no apparent rights and the Domain Name is part of that pattern”

There is no evidence that the Complainant has been specifically targeted by the Respondent. The Domain Name is being used to point to links that are not connected with the Complainant in any way even by industry. The Complainant has not shown that the Respondent was or ought to have been aware of his online magazine which is based in the US. The Respondent specifically states that it was not aware of the Complainant. On the other hand the Respondent has provided a list of over seventy generic domain names which it owns relating to the subject of computer services and eighteen of these begin with the wordstring “computer” but are followed by other wordstrings which do not contain the “user” such as “computerexpert.co.uk”. The Domain Name could be used in a purely descriptive way. The

Respondent admits that it registers generic domain names for sale. It is not abusive in principle to register and sell generic domain names. I am supported in my decision by the appeal decision in *Maestro International Inc v Mark Adams* which the Respondent quotes correctly. The Domain Name consists of two ordinary dictionary words in a commonly seen conjunction. In my view there is not sufficient evidence in this case to persuade me that the Domain Name is an Abusive Registration within the meaning of the Policy.

Accordingly, the Expert is unable to determine that the registration is an Abusive Registration within the definition of that term in paragraph 1 of the Policy.

However, there is nothing to suggest that the Respondent did not genuinely believe it was entitled to lodge a Complaint about the Domain Name or does not genuinely have a computer on line magazine using the domain name computeruser.com, albeit that almost no evidence has been submitted to support his claims. Since there is no evidence that the Complaint was lodged in bad faith the panellist declines to make a finding of reverse domain name hijacking as requested by the Respondent.

## **7. Decision**

***In light of the foregoing findings, namely that it has not been proven that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name remain in the hands of the Respondent. However, the Expert declines to make a finding of reverse domain name hijacking against the Complainant.***

*Dawn Osborne*

*Date 12 May 2009*