

DISPUTE RESOLUTION SERVICE

D00008521

Decision of Independent Expert

Kirwans Solicitors

and

Dr Neil Cooke

1. The Parties

Complainant: Kirwans Solicitors

6th Floor, Martins Building

Water Street

Liverpool

Merseyside

L2 3SX

United Kingdom

Respondent: Dr Neil Cooke

c/o 336a Old Chester Road

Rock Ferry

Birkenhead

Wirral

CH42 3XE

United Kingdom

2. The Domain Name

<kirwans.co.uk> ("the Domain Name")

3. Procedural History

- 3.1 The Complaint in this case was received by Nominet on 16 April 2010 and validated and sent to the Respondent on 20 April 2010. A Response was filed on 12 May 2010 and a Reply on 19 May 2010. Mediation not being

successful, the Complainant paid the fee for a Full Expert Decision on 23 June 2010 and the matter was referred to me on 25 June 2010. I confirmed that I was independent of the parties and that I was not aware of any matters that could call my independence into question.

- 3.2 In view of one factual submission contained in the Response that I regarded as novel, I decided to invite the Respondent to respond to that specific allegation under paragraph 13(a) of the Nominet Dispute Resolution Service Procedure ("the Procedure"). That further response ("the Paragraph 13(a) Response") was received on 26 July 2010.

4. Factual Background

- 4.1 The Complainant is a firm of Solicitors with offices in Liverpool and on the Wirral.
- 4.2 The Respondent registered the Domain Name on 4 October 1999.

5. Parties' Contentions

The Complaint

- 5.1 The principal submissions contained in the Complaint may be summarised as follows:
- 5.1.1 The Complainant is a law firm with offices in Liverpool and on the Wirral. It has been in business for over 60 years and has traded under the name "Kirwans" throughout that period. It is the registrant of the domain name <kirwanssolicitors.co.uk>.
- 5.1.2 The Respondent is a former client of the Complainant. He has registered the Domain Name as an act of mischief and is using it to connect to a website named "Clone Zone" which offers products and services of an obscene nature (the Complainant exhibits print-outs from the website which include gay sex toys and related merchandise). This has caused, and continues to cause, embarrassment and damage to the reputation of the firm.
- 5.1.3 The Complainant wrote to the Respondent on 19 March 2010 seeking a transfer of the Domain Name but no reply was received from him.

5.1.4 The Complainant seeks a transfer of the Domain Name.

The Response

5.2 The principal submissions made in the Response may be summarised as follows:

5.2.1 The Respondent is the legitimate owner of the Domain Name, having registered it in 1999 and having used it for the past 11 years (the Respondent does give further details).

5.2.2 The Complainant has only recently rebranded from "Kirwans Solicitors" to "Kirwans" and has previously traded under the former name.

5.2.3 The Complainant owns no rights or trade marks in the name "Kirwans" There are numerous business that use the name including funeral directors, bakers, plastic surgeons, musicians and the actress Dervla Kirwan. There are also 1,921 individuals named Kirwan in the UK.

5.2.4 Nor is the Complainant the only solicitors' firm named Kirwans in the UK. There is another such firm in Enfield, Middlesex, which registered the domain name <kirwanssolicitors.org.uk>.

5.2.5 The Complainant has maintained incorrect contact details for its own registration of <kirwanssolicitors.co.uk>, its address being shown as 363 Whitchurch Road instead of 363 Woodchurch Road.

5.2.6 It was improper and a breach of its professional code for the Complainant to have disclosed that the Respondent was a former client of the firm.

5.2.7 The website at "Clone Zone" is not "obscene" as the Complainant alleges. It has been voted "Best Gay Shop 2010" in "The Pink Paper" and offers only products that could be bought in a High Street store such as Ann Summers. The site contains no graphically explicit images and the Complainant's objection to the site is homophobic in the extreme.

- 5.2.8 The Complainant's internal emails as annexed to the Complaint show that it wished to obtain the Domain Name before it became aware of the link to "Clone Zone".
- 5.2.9 In view of the very different nature of the products and services being offered at www.kirwans.co.uk and www.kirwanssolicitors.co.uk it is unlikely that anyone would be confused between the two. Accordingly there is no basis for the Complainant to claim that it has been distressed or harmed.
- 5.2.10 The Complainant could have registered the Domain Name before the Respondent did so in 1999.
- 5.2.11 Furthermore, the Respondent offered the Domain Name to the Complainant for a nominal sum (possibly £100 to include transfer fees) several years ago, on the basis that he had been receiving emails that he believed were intended for the Complainant. However, the Complainant replied that it used <kirwanssolicitors.co.uk> and that the Domain Name was of no interest to it.
- 5.2.12 The Complainant is attempting to reverse hijack the Domain Name.

The Reply

- 5.3 The Complainant's Reply makes the following principal submissions:
- 5.3.1 While it is correct that the firm has recently made a routine change to its branding, the firm has always been named "Kirwans" and has always been a firm of solicitors. The term "solicitors" is merely descriptive and is used by many firms of solicitors.
- 5.3.2 The Complainant has rights in the name "Kirwans" in relation to the provision of legal services within the locality. The name has considerable reputation although the Complainant has no registered trade mark.
- 5.3.3 The mistake in the Complainant's address for its registration of <kirwanssolicitors.co.uk> was merely a typographical error.
- 5.3.4 The Complainant has taken care to ensure that no confidential information concerning the Respondent has been disclosed. A

billing guide including the Respondent's address was exhibited to demonstrate that the Respondent was in fact a former client of the firm.

- 5.3.5 The material displayed on the "Clone Zone" site comprises adult content and continues to cause embarrassment and distress to the Complainant and its staff. Older members of staff and clients in particular would find the images to be inappropriate.
- 5.3.6 The Complainant has also established from representatives of "Clone Zone" that the Respondent has no connection with that company. They were surprised that the Respondent had chosen to link the Domain Name to their website.
- 5.3.7 It is correct that, in about 2006, the Complainant declined the Respondent's offer to sell it the Domain Name. The Complainant considered that it was entitled to the Domain Name and did not believe that it should be asked to pay for it.
- 5.3.8 The Complainant notes that the Respondent admits having received emails intended for the Complainant. This constitutes disruption to the Complainant's business additional to that caused by the link to "Clone Zone".
- 5.3.9 The Respondent is acting in bad faith. He has no legitimate interest in the Domain Name, provides no goods or services under the Domain Name and has sought to sell the Domain Name to the Complainant for financial gain.

The Paragraph 13(a) Response

5.4 In view of the submission referred to in paragraph 5.3.6 above, which was an allegation that did not appear in the Complaint, I invited the Respondent to make a further response to that specific allegation. The Respondent's further response may be summarised as follows:

- 5.4.1 The link to the "Clone Zone" website has been in place for many years.
- 5.4.2 The business of "Clone Zone" has undergone several changes of ownership over the years, but the individuals to whom the

Complainant spoke were not directors of any relevant company. The Respondent has known the two correct individuals for many years.

- 5.4.3 The Respondent has used the name "Kirwans" for many years as a "mask" to supply goods to the lesbian, gay, bisexual and transsexual ("LGBT") community. Many members of this community have not "come out" and do not want the names of companies such as "Clone Zone" to appear on bank statements and credit card receipts. The name "Kirwans" is used for that purpose and is well known on LGBT forums. The link also allows internet users to view the "Clone Zone" site without the name of that site appearing in their browser history.
- 5.4.6 The Respondent chose the name "Kirwans" as it had a strong connection to his partner's name (the Respondent does not give further details).
- 5.4.7 The Respondent offered to put a "gateway" on the site informing internet users that they were about to enter an adult site but the Complainant refused this offer.

6. Discussions and Findings

6.1 This dispute falls to be determined under the Nominet Dispute Resolution Service Policy ("the Policy") and the Procedure. Under paragraph 2 of the Policy:

- (a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, 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.*
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."*

6.2 Under paragraph 1 of the Policy the term "Rights":

"includes, but is not limited to, rights enforceable under English law..."

6.3 Also under paragraph 1 of the Policy, the term "Abusive Registration" means 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 was unfairly detrimental to the Complainant's Rights."

6.4 Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 sets out a non-exhaustive list of factors that may be evidence that it is not. However, all these factors are merely indicative of, and subject to, the overriding test of an Abusive Registration as set out above.

Rights

6.5 The Complainant has established that it is a firm of solicitors that has operated in Liverpool and on the Wirral for many years. It has also established that it has traded during this time as either "Kirwans Solicitors" or "Kirwans". While the Complainant has provided little information concerning the extent of its business activities, I find on the balance of probabilities that the Complainant has rights in the name "Kirwans" in association with legal services in the Liverpool and Wirral region. These are in the nature of unregistered trade mark rights and are sufficient to amount to Rights for the purposes of the Policy.

6.6 It makes no material difference to the Complainant's Rights in the name "Kirwans" that it may have traded until recently as "Kirwans Solicitors". The term "Solicitors" is merely descriptive of the services in respect of which the Complainant has Rights in the operative part of the mark.

- 6.7 While the Respondent is correct in stating that the Complainant does not have exclusivity in the name "Kirwans", and that many other businesses and individuals may legitimately use the same name, that does not prevent the Complainant from itself having Rights in the name (although such Rights may not be particularly strong) and to object to an Abusive Registration by another party.
- 6.8 In the circumstances, I find for the purposes of the Policy that the Complainant has Rights in a name or mark, namely "Kirwans", that (but for the formal suffix .co.uk) is identical to the Domain Name.

Abusive Registration

- 6.9 The Complainant has established that the Respondent is a former client of its firm, that the Respondent offered to sell it the Domain Name (which offer the Complainant declined), and that the Respondent has linked the Domain Name to a website offering sex toys and related products that many people would find offensive.
- 6.10 In my view, the above circumstances give rise to a *prima facie* case of Abusive Registration, namely that the Respondent has used the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 3(A)(i)(c) of the Policy). A *prima facie* case having been established, it is nevertheless open to the Respondent to show that the Domain Name in his hands is not an Abusive Registration.
- 6.11 Dealing first with the submissions in the original Response, I am unimpressed by the Respondent's assertion that no-one who actually visited the website at www.kirwans.co.uk would believe that it was operated by the Complainant. The issue is that a number of internet users are liable to type in the URL www.kirwans.co.uk in the expectation of finding the Complainant's site, only to be confronted instead with images of a sexual nature. Plainly this is disruptive to the business of the Complainant.
- 6.12 There is also no significance in the fact that the Complainant could have registered the Domain Name before the Respondent did so, or of the fact that it declined to purchase the Domain Name from the Respondent. Neither of these matters entitles the Respondent itself to register or use the Domain Name in an abusive fashion.

- 6.13 Nor is it relevant that the Complainant may have developed an interest in obtaining a transfer of the name before it became aware of the "Clone Zone" link. The relevant issue for determining Abusive Registration is the conduct of the Respondent, not the Complainant's state of knowledge at any particular time.
- 6.14 Significantly, nowhere in his original Response does the Respondent offer any explanation for having registered a domain name incorporating the name "Kirwans" or provide details of any legitimate connection with that name. Nor does he attempt to explain the linking of the Domain Name to the "Clone Zone" website. While he does deal with these issues in the Paragraph 13(a) Response (which he could not have known he would be invited to submit) it is extraordinary that these matters were not addressed in the Response itself.
- 6.15 I now turn to the contents of the Paragraph 13(a) Response. In this document, the Respondent submits that he has a connection with the "Clone Zone" website and knows the directors of that company, although it is not clear whether he is actually claiming to be the owner or operator of that specific site. In any event, he says that he has used the name "Kirwans" for many years as a "mask" for supplying the LGBT community and that he chose the name "Kirwans" because it had a strong connection to his partner's name.
- 6.16 I do not accept the Respondent's submissions about these matters. There are two principal reasons for my view, the first is that none of these potentially crucial submissions was contained in the Respondent's original Response, which was the proper and obvious place for them to be advanced. Instead, the Respondent chose in the Response to make a number of largely peripheral points while ignoring these potentially key issues. Secondly, when the Respondent did eventually make the submissions in question, in the Paragraph 13(a) Response, he did so without any level of detail or supporting evidence sufficient to establish the veracity of what was being stated.
- 6.17 So far as the "Clone Zone" website is concerned, the Respondent states that he has known the correct directors of the "Clone Zone" business for many years. He also states that he has used the name "Kirwans" for many years as a "mask" to supply the LGBT community and as the name that appears

on bank statements and credit card receipts. What he fails to make clear, however, is whether he is contending that he is himself the owner or operator of the "Clone Zone" site, whether he is simply making the Domain Name available to the owners of that site, or whether some other scenario exists. Further, he provides no documentary evidence of any commercial connection between himself and the "Clone Zone" business, or of the alleged use of the "Kirwans" name for financial transactions.

6.18 So far as the choice of the Domain Name is concerned, the Respondent makes a bare assertion that the name "Kirwans" has a "strong connection to [his] partner's name", but he does not state what his partner's name is, nor does he provide any further explanation or evidence in support. The lack of any such detail (both here and above) is particularly surprising since, most unusually, the Respondent has been given a "second bite of the cherry" in this case. However, he has failed even at the second attempt to put forward a persuasive explanation for his registration and use of the Domain Name.

6.19 In the circumstances, I do not accept the Respondent's submissions contained in the Paragraph 13(a) Response and I conclude on the balance of probabilities that the Domain Name has been used by the Respondent in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights. It is therefore an Abusive Registration.

7. Decision

7.1 The Complainant has established for the purposes of the Policy that it has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complaint therefore succeeds and I direct that the Domain Name be transferred to the Complainant.

STEVEN A. MAIER

2 August 2010