

DISPUTE RESOLUTION SERVICE

D00010067

Decision of Independent Expert

Philip Barton on behalf of “The Savoy Singers”

and

Richard Stockton

1. The Parties:

Complainant:

Mr Philip Barton
Sandhurst
Berkshire
United Kingdom

Respondent:

Mr Richard Stockton
Camberley
Surrey
United Kingdom

2. The Domain Name:

<savoysingers.org.uk>

3. Procedural History:

3.1 The procedural timeline in this case is as follows:

11 July 2011 22:44 Dispute received

13 July 2011 09:48 Complaint validated
13 July 2011 09:53 Notification of complaint sent to parties
01 August 2011 02:30 Response reminder sent
03 August 2011 08:32 Response received
03 August 2011 08:32 Notification of response sent to parties
05 August 2011 12:07 Reply received
11 August 2011 08:21 Notification of reply sent to parties
11 August 2011 08:21 Mediator appointed
23 August 2011 11:07 Mediation started
09 September 2011 14:29 Mediation failed
12 September 2011 12:29 Close of mediation documents sent
22 September 2011 02:30 Complainant full fee reminder sent
23 September 2011 13:10 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is the treasurer and one of the registered trustees of “The Savoy Singers”. The Savoy Singers are an amateur operatic company based in Camberley Surrey, and are a UK registered Charity (registered charity 273603). The legal nature of the charity is not explained in the Complaint, but the Complainant states that the Complaint is being brought on behalf of the “Committee” of The Savoy Singers which is also referred to as the “Society”. It, therefore, seems likely that The Savoy Singers is an unincorporated association and the Complainant has brought these proceedings as a representative of the members of that association.
- 4.2 Accounts filed with the Charity Commission show that the charity has over the past five years had income and expenditure in the region of £30K per annum.
- 4.3 The Domain Name was initially registered in February 2002. The Domain Name is currently registered in the name of one Richard Stockton. It would appear that until recently the Respondent was the Musical Director of The Savoy Singers.
- 4.4 As at the date of the Complaint the Domain Name was being used for a website promoting the activities of The Savoy Singers. It features what look like photographs from productions and with what look like buttons with text “Book Tickets”, “Contact Us”, “Auditions“ and “Members”. There is the statement on the home page of that website: “No Future Events to advertise”. This website continues to operate as at the date of this decision.

5. Parties’ Contentions

- 5.1 In the Complaint the Complainant contends that the website operating from the Domain Name was designed and maintained by the Respondent

for the Society. He claims that The Savoy Singers have “now realised” that the Domain Name was not registered in the name of the charity. The Complainant also claims that the Society has been reimbursing the Respondent’s third party hosting fees.

- 5.2 The Complainant also refers to emails in 2011 to the Respondent in which he called for an invoice in relation to the hosting of the website and for the transfer of the Domain Name to the Society.
- 5.3 The Complainant further contends that earlier this year, the Respondent “ceased to be involved with the Society and is no longer maintaining the web site”. It would appear here that the complaint is not that the website no longer operates, but that the Respondent has removed material from the website and added the words “No Future events to advertise!”, which is said to be untrue. According to one of the documents annexed to the Complaint, the Society will be performing “[a]n original review” of Rodgers and Hammerstein works at the Camberley Theatre between 7 and 9 October 2011.
- 5.4 In his Reply the Respondent makes no reference to any past association with the Complainant. It is convenient to reproduce the Respondent’s substantive contentions in full. They are as follows:

“I see no reason why I should relinquish my private web domain name that I have used for 10 years.

It has been used by me to communicate details of my rehearsals and my personal photographs of shows that my wife has performed in.

I attach current payment details which have been in place for some years showing th[at] it is my wife who pays for this domain and has done so for the last ten years since we set it up.

I am in the process of re-developing the site for a different purpose to investigate the history and biographies of singers in the original Savoy Operas. This has been an interest of mine for a long time and I am considered something of an expert in this field.

You can easily google this subject by typing in “Savoy Operas” and you will see that this is a subject of some interest. I can supply references showing that I am considered an expert in this field.”

- 5.5 The attached “payment details” appears to be a printout setting out the credit card payment details retained by the Respondent’s internet service provider Claranet in relation to the item “Claranet UK Soho: savoyingers.org.uk + savoyingers.org.uk”
- 5.6 In his Response the Complainant refers to the Respondent’s previous position as Musical Director of the Society. He then proceeds to comment on a line by line basis in relation to the points made in the Reply. In that

line by line rebuttal, the Complainant denies that the Domain Name has ever been used as the Respondent's "personal domain". In this respect, he refers to the Internet archive which is said to hold snapshots of the Complainant's website back to 2002 (although copies of these snapshots are not provided).

6. Discussions and Findings

General

- 6.1 To succeed under the Policy, the Complainant must prove first, that he has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"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."

Complainants' Rights

- 6.3 As I have already stated, it seems likely that the "Savoy Singers" are an unincorporated association and that the Complainant has brought these proceedings on behalf of that association (and given the reference to the Society's committee, with the Society's authorisation). It is possible for a member of an unincorporated association to bring legal proceedings in the English courts by means of an authorised representative (see *Artistic Upholstry Ltd v Art Forma (Furniture) Ltd*, [1999] 4 All E.R. 277; [2000] F.S.R. 311 and Rule 19.6 of the Civil Procedure Rules). I see no reason why this should not also be possible in the case of proceedings under the Policy.
- 6.4 Therefore, in assessing whether the Complainant has relevant rights for the purposes of the Policy, it is legitimate to consider the position of the association as a whole rather than the Complainant's personal position.

- 6.5 The difficulty in this case is that no rights as such whether belonging to the Complainant or the “Savoy Singers” are expressly claimed or referred to in the Complaint. However, ultimately (and albeit with some hesitation) I have concluded that the Complainant has and can rely upon sufficient rights for it to satisfy this requirement of the Policy.
- 6.6 In this respect, it has long been clear as a matter of law that an unincorporated association is capable of possessing through its members goodwill that may to found a claim under the law of passing off (see for example, paragraph 36 of the *Artistic Upholstry Ltd* decision). Also it is clear that a charity engaged in trading activity and most likely a charity that does not trade but is engaged in fund raising activity can also bring a claim in passing off (see para 3-051 Wadlow on Passing Off 4th Edition).
- 6.7 The evidence filed with the Complaint shows that The Savoy Singers have for at least five years been engaged in not insubstantial trading and/or fund raising activities under “The Savoy Singers” name. I, therefore, conclude that by reason of these activities it has sufficient goodwill and rights in that name to found a claim in passing off. These sorts of rights (often referred to as “unregistered trade mark rights”) have long been recognised as rights in a name for the purposes of the Policy. In this particular case these are rights in a name (i.e. “The Savoy Singers”) that save for the removal of the definite article, and the addition of the “org.uk” suffix, is identical to the Domain Name. There is a clear similarity between the relevant name and the Domain Name and the Complainant has therefore made out the requirements of paragraph 2(a)(i) of the Policy.

Abusive Registration

- 6.8 Insofar as there is any substantive difference between the parties as to the facts, I prefer the Complainant’s contentions to that of the Respondent. By far the most compelling evidence in this case is that of the manner in which the Domain Name was being used at the date of the Complaint. There appears to be no real dispute that this was being used for a website to publicise the activities of The Savoy Singers.
- 6.9 It is a fact that is hard to reconcile the Respondent’s claim that the Domain Name “is his own private web domain name that [he has] used for 10 years”. Insofar as the Respondent is claiming that the Domain Name is being used for some personal non- Savoy Singers related purpose, I reject that submission. .
- 6.10 The Complainant goes further and contends that the Domain Name has always been used for that purpose. This is not just mere assertion but is said to be supported by snap shots in the Internet Archive. The Complainant has not provided copies of these snap shots but he does provide a link to the relevant webpage.
- 6.11 The guidance on the Nominet website suggests that a Complaint can refer to urls (see <http://www.nominet.org.uk/disputes/drs/complainant/>). The

implication seems to be that this can be relied upon so far as evidence is concerned. If so, I would respectfully suggest that this is unhelpful and perhaps consideration should be given to changing the words used. Material on active websites can change and if a party wishes to rely on online material it should be encouraged to exhibit a copy of that material rather than to refer to a url.

- 6.12 A fuller explanation of the position so far as online evidence is concerned is to be found in section 5.10 of paragraph of the Dispute Resolution Service – Experts’ Overview, also published on the Nominet website. This states as follows:

“The basic rule is that Experts should not make any investigations of their own. They should make their decisions “on the basis of the parties’ submissions, the Policy and the Procedure”. The second sentence of paragraph 16(a) [of the Dispute Resolution Service Procedure] enables Experts to view web sites mentioned in the parties’ submissions, but no party should assume that the Expert will necessarily do so. If the content of a web site is important to a Party’s case, the safest course is to exhibit print-outs from the web site.

No party should assume that the Expert will make any investigations to support a bare assertion made in a party’s submission. However, there may be occasions where an Expert will find it expedient to conduct a simple online enquiry of a publicly available database, where, for example, an exhibit purporting to support a party’s contention does not do so and it appears that the ‘error’ is a simple oversight and not one of any major significance. In such circumstances, a simple enquiry of that kind may be a proportionate alternative to either ignoring a point made in the submission in question or initiating a further round of submissions by way of requests for further information. See DRS 00658 (chivasbrothers.co.uk). “

- 6.13 In light of that guidance (and out of fairness to the Complainant given the content of the Nominet Complaint guidance identified above) I have decided to review the Internet Archive material available in relation to the Domain Name. This does indeed show that as early as 8 August 2002 a website was operating from the Domain Name promoting the activities of The Savoy Singers.
- 6.14 Given these facts I find that the continued holding of the Domain Name and the refusal to transfer the Domain Name to the Complainant is an abusive registration. The Respondent relies upon the fact that he (or to be more accurate his wife) has paid for the Domain Name, but this does not matter, if (as the Complainant contends, has provided some evidence of, and does not seem to be disputed) that there was an arrangement in place whereby the Respondent was reimbursed for these costs. Indeed this seems to be a case which falls within the scope of paragraph of paragraph

3(a)(v) of the Policy. This states that a factor which may constitute evidence of an abusive registration is that the:

“The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

A. has been using the Domain Name registration exclusively; and

B. paid for the registration and/or renewal of the Domain Name registration.”

- 6.15 The Respondent’s counter argument that he intends to use the Domain Name for a website “to investigate the history and biographies of singers in the original Savoy Operas” is both legally and factually unconvincing.
- 6.16 Factually it sounds highly contrived. Why use this particular Domain Name (whose second level “org” suffix is ordinarily associated with organisations)? In the absence of evidence beyond mere assertion, I am not prepared to give this claim any weight.
- 6.17 Further, even if this is the Respondent’s true intention, I do not think it matters. Had the Respondent registered the Domain Name without reference to the Savoy Singers and with the intention of using the Domain Name for the claimed purpose, there may well have been no abusive registration. However, the situation is very different here. There is a pre-existing relationship and in such a case a registrant cannot save himself from a finding of abusive registration by simply pointing to a possible or intended non-abusive future use.
- 6.18 In the circumstances, the Claimant has made out the requirements of paragraph 2(a)(ii) of the Policy.

Remedies

- 6.19 The Complainant has sought the transfer of the Domain Name to “The “Savoy Singers”. Although, as I have already explained, I see no reason why the Complainant cannot bring this action in a representative capacity, I agree this it is preferable that the Domain Name be transferred into the name of the Society rather than its representative.
- 6.20 The Nominet systems permit registration in the name of a registered charity (under the RCHAR code) regardless of the exact legal form that charity takes. In the circumstances, it seems appropriate to order the transfer the Domain Name into the charity’s name.

7. Decision

- 7.1 I find that the Complainant (acting as a representative of The Savoy Singers) has Rights in a trade 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.

- 7.2 I, therefore, determine that the Domain Name, <savoysingers.org.uk> should be transferred to The Savoy Singers, UK Registered Charity No. 273603.

Signed Matthew Harris

Dated 27 September 2011