

**DISPUTE RESOLUTION SERVICE**

**D00016050**

**Decision of Independent Expert**

Mascot International A/S

and

Stenning Limited

**1. The Parties:**

Complainant: Mascot International A/S  
Julstøvej 100  
Silkeborg  
Jylland  
8600  
Denmark

Respondent: Stenning Limited  
Bramblewood  
18 Birchen Lane  
Haywards Heath  
West Sussex  
RH16 1SA  
United Kingdom

**2. The Domain Name:**

<mascot.co.uk>

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

I, the undersigned "Expert", 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 such a nature as to call into question my independence in the eyes of one or both of the parties.

The Complaint was received by Nominet on 9 June, 2015 and was withdrawn on 7 July, 2015 following receipt of the Response, which was filed on 1 July, 2015. The case was re-opened at the instance of the Respondent on 14 July, 2015 and a mediator was appointed on the same day. The mediation commenced on 17 July, 2015, but terminated on 3 August 2015, having failed to achieve a settlement. The Respondent paid the fee for a decision and the Expert was appointed on 11 September, 2015 having provided to Nominet a Declaration of Independence (as above).

An unusual aspect of this case is that it is the Respondent, not the Complainant, who has paid the fee for this decision. Following receipt of the Response, the Complainant elected not to proceed with the Complaint. The Respondent, as was its right pursuant to paragraph 8(b) of the Procedure, elected to have the case re-opened in order for the case to proceed to a decision.

### **4. Factual Background**

The Complainant is a Danish company engaged in the manufacture and supply of work wear and safety footwear under the MASCOT brand.

The Complaint invites the Expert to visit the Complainant's website connected to its domain name, <mascot.dk>, for further information on the company. It appears that the company was founded in 1982, has over 2000 employees and trades internationally with Western Europe (including the UK) being its main market.

The Complainant is the registered proprietor of trade mark registrations covering its MASCOT brand including:

UK Trade Mark No. 2,132,394 MASCOT (word) dated 9 May, 1997 (registered 12 June, 1998) in class 25 for various types clothing and footwear.

The Complainant is also the proprietor of *inter alia* the following domain names, namely <mascot.dk (1998)>, <mascot.be> (2001) and <mascot.nl> (2001).

The Domain Name was registered on 2 August, 2011 and has been connected (as it still is) to the webpage depicted below:

**mascot.co.uk is a premium domain name that could be your key to internet success!**

Premium domain names are rare, highly sought after and could be the measure of your success on the web.

**mascot.co.uk may be for sale!**

We are open to serious offers for this valuable and prized domain name. Monthly rental options for the domain may also be considered.

Please get in touch direct with us using the e-mail address below.

**contact@stanning.net**

Alternatively, complete our [contact form](#).

We are happy to complete the sale using [Escrow.com](#), ensuring a completely safe, private and reliable transaction for all parties.

© mascot.co.uk

## 5. Parties' Contentions

### The Complainant

Prior to withdrawing its Complaint on 7 July, 2015 the Complainant contended that its MASCOT registered trade mark was identical to the Domain Name. It further contended that the Domain Name was an Abusive Registration within the meaning of that term as defined in paragraph 1 of the Policy on the basis that the Respondent registered the Domain Name having no right or legitimate interest in respect of it, there being no active website attached to it, and simply with a view to selling it “to the Complainant, a competitor or third parties” at a profit (paragraph 3.a.i.A. of the Policy).

### The Respondent

For reasons which will become apparent, it is unnecessary for the Expert to go into any great detail here about the terms of the Response. Suffice it to say that the Respondent admits the Complainant’s trade mark rights, but denies that it had any knowledge of the Complainant and its MASCOT brand prior to receipt of the Complaint, so could not have had the abusive intent attributed to it by the Complainant when registering the Domain Name in 2011.

The Respondent seeks a finding of Reverse Domain Name Hijacking.

## **6. Discussions and Findings**

### General

Pursuant to paragraph 2.a.i of the Policy for a complainant to succeed in a complaint under the Policy it must prove 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

“Abusive Registration” is defined in paragraph 1 of the Policy 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Before moving onto the merits of the case it is necessary to refer to a further provision, namely:

Paragraph 1 of the Policy. “Reverse Domain Name Hijacking means using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name.”

### The Merits of the Complaint

There is no dispute that the Complainant's MASCOT trade mark is identical to the Domain Name at the third level.

As to the allegation that the Domain Name is an Abusive Registration, the Complainant claims that its trade mark is well-known “especially among businesses and consumers, who purchase work wear and safety footwear.” The Complainant points to the fact that it has not granted the Respondent any permission to use its trade mark and contends that there is no obvious reason why the Respondent could be said to have any rights or legitimate interests in respect of the Domain Name. The Complainant also points to the use made of the Domain Name, namely to post it for sale or rent. The Complainant concludes that the Respondent registered the Domain Name for no *bona fide* purpose, but simply with a view to exploiting it for money or money's worth by selling it “to the Complainant, a competitor or third parties” at a profit. In putting it in this way, the Complainant accepts

that the Respondent's purpose may have been to sell the Domain Name to someone having no connection with either the Complainant or a competitor of the Complainant. Crucially, the Complaint contains no allegation that the Respondent was aware of the Complainant when registering the Domain Name.

The Respondent, represented as it is by a very experienced practitioner in the field of domain name disputes, satisfactorily answers the Complainant's case in a well-argued Response.

The Respondent registered the Domain Name, an ordinary and widely-used dictionary word, without any knowledge of the Complainant or its trade mark and with a view to monetizing it by way of sale or rent. As the Respondent observes, dealing in Domain Names is, of itself, a perfectly legitimate activity sanctioned by the Policy (paragraph 4.d.).

To succeed on the ground advanced by the Complainant the Complainant had to establish that the Respondent in registering the Domain Name was targeting the Complainant and/or its trade mark. The Respondent denies knowledge of the Complainant or its trade mark at the relevant time and produces a wealth of arguments to demonstrate why it had no reason to be aware of the Complainant or its trade mark at that time. Significantly, as indicated above, the Complaint contains no allegation that the Respondent was aware of the Complainant or its trade mark when registering the Domain Name. Without the relevant knowledge, there cannot have been the necessary intent. The Complaint had to fail.

Predictably, on reading the Response, the Complainant wrote to Nominet on 7 July 2015 withdrawing the Complaint. While it is just possible that the Complaint might have been withdrawn for some other reason, the Expert concludes on the evidence before him that the reason for the withdrawal was that the Complainant accepted that the Complaint was misconceived and would fail.

At the Respondent's request (see section 3 above) the case was re-opened and the case has proceeded to a decision on the Respondent paying the requisite fee.

While, theoretically, this opens up the whole case for review, the Expert is satisfied that there is no merit in the Complaint primarily for the reason that there is no evidence in the case file to counter the Respondent's denial of any knowledge of the Complainant or its trade mark at time of registration of the Domain Name. The Expert directs that the Domain Name should remain with the Respondent, which was the result reached on 7 July, 2015 when the Complainant withdrew the Complaint.

The sole remaining issue is the Respondent's contention that the Complainant has been guilty of Reverse Domain Name Hijacking ("using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name.").

The section of the Response dealing with Reverse Domain Name Hijacking reads as follows:

"Reverse Domain Name Hijacking

31. The DRS is clearly a two stage process. Owning a trade mark merely satisfies the first leg of the process. It is clearly not sufficient to succeed with a complaint.

32. There must also be evidence to support a claim of Abusive Registration. The DRS Policy and other materials published by Nominet set out the basis under which such a claim might succeed.

33. The Complaint in this case is clearly and completely defective in respect to the claim of Abusive Registration. The Complainant is a commercial enterprise that has retained one of Denmark's leading law firms (Bech-Bruun) to represent and advise it.

34. It is inconceivable that the specialist trade mark lawyer who advised the Complainant and drafted the Complaint could have been unaware of the deficiencies in the Complaint.

35. The Registrant has been put to considerable effort and has had to engage legal counsel to prepare this Response. That is

a needless exercise, caused by the attempted bad faith use of the DRS Policy by a sophisticated and legally advised Complainant.

36. The Panel is urged not only to dismiss the Complaint; but also to find that the Complaint is an attempt at Reverse Domain Name Hijacking.”

The Respondent is arguing that the Complainant’s representative, an experienced trade mark lawyer, drafted the Complaint knowing of its deficiencies and with a view to wrongfully depriving the Respondent of its legitimately registered and used Domain Name.

One of the difficulties when launching a complaint under the Policy is that one frequently has very little information on the registrant of the domain name in dispute. Even now the Expert has next to no information on the Respondent save that it is an English company and presumably one engaged in the registration and exploitation of domain names for profit.

If the Complainant and/or its representative (both Danish), had undertaken any background searches generally into the use of the word “mascot” in the UK, the Complainant would have learnt very quickly that “mascot” is a commonly used dictionary word in the English language and is also used as a trade mark by other companies, not merely the Complainant. That might well not have deterred the filing of the Complaint. The Complainant expresses a commonly held view among trade mark owners that registering domain names featuring their trade marks for no reason other than to exploit them for profit cannot give rise to a right or legitimate interest in respect of those names. However, on that view (not a view to which the Expert subscribes), the Complainant was faced with the Respondent, a registrant without any right or legitimate interest in respect of the Domain Name, a name identical to the Complainant’s trade mark, openly offering the Domain Name for sale or rent. On that view, while the Respondent might have had an answer, the Complaint had a realistic chance of success, sufficient to require the Respondent to provide the answer.

The Expert believes it likely that until the Complainant saw the



Response it was unaware of the full extent of the deficiencies in its case and, in particular, the powerful case advanced by the Respondent to demonstrate why it could very reasonably have been wholly unaware of the Complainant and its trade mark when it registered the Domain Name. Faced with the Response the Complainant responsibly withdrew the Complaint.

The Complainant could perhaps have flushed out the essence of the Response in advance by writing to the Respondent prior to filing the Complaint, but the failure to do so cannot reasonably give rise to an inference that the Complainant was actuated by bad faith in launching the Complaint. The Expert believes that the Complainant is much more likely to have launched the Complaint, concerned for the safety and integrity of its trade mark and genuinely believing that it had a legitimate case under the Policy.

## **7. Decision**

The Expert directs that no action be taken on the Complaint and declines to make a finding of Reverse Domain Name Hijacking.

**Signed** Tony Willoughby

**Dated** 12 September, 2015