

## **DISPUTE RESOLUTION SERVICE**

**D00019672**

### **Decision of Independent Expert**

**Metacompliance Ltd**

and

**Mr Tom Fuller**

#### **1. The Parties:**

Complainant: Metacompliance Ltd  
Third Floor,  
The City Factory,  
100 Patrick Street  
Derry  
BT48 7EL  
United Kingdom

Respondent: Mr Tom Fuller  
15 Spinners Close  
Coppull  
Chorey  
Lancashire  
PR7 5FQ  
United Kingdom

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

my-compliance.co.uk (“the Domain Name”).

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

The Complaint was submitted to Nominet on 13 December 2017 and was validated and notified to the Respondent by Nominet on the same date. The Respondent was informed in the notification that it had 15 working days, that is until 5 January 2018 to file a

response to the Complaint. On 4 January 2018, the Respondent's representative emailed Nominet to confirm that it had been appointed to represent the Respondent, attaching the Response and Exhibits thereto in view of the tight timescale. On 8 January 2018, Nominet informed the Respondent's representative that it would create an online account for the Respondent whereby its Response could be uploaded.

On 16 January 2018, the Response was inserted into the online account. On 19 January 2018, the Complainant filed a Reply to the Response and the case proceeded to the mediation stage on 24 January 2018. On 6 June 2018, Nominet notified the Parties that mediation had been unsuccessful and, pursuant to paragraph 10.5 of Nominet's Dispute Resolution Service Policy Version 4 ("the Policy"), invited the Complainant to pay the fee for referral of the matter for an expert decision. On 20 July 2018, the Complainant paid the fee for an expert decision. On 25 July 2018, Andrew D S Lothian, the undersigned ("the Expert"), confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 26 July 2018.

The Expert observes that Nominet appears to have allowed the Response to be received initially in email form on 4 January 2018 rather than by use of the online electronic forms on its website. Although it is not clear from the case file, Nominet presumably considered that exceptional circumstances applied (see section 7.3 of the Policy) due to the preceding holiday period and the shortness of time available to the Respondent before the Response deadline expired on 5 January 2018. Formal notification of the Response does not appear to have been made to the Complainant until after this had been inserted in the online account on 16 January 2018, following which the Complainant proceeded to file its Reply on 19 January 2018. These slight modifications to the usual timescales do not appear to have prejudiced either of the Parties and accordingly the Expert is content to proceed to a Decision.

#### **4. Factual Background**

The Complainant is a company registered in Northern Ireland. The Complainant notes that it has been developing software and content for the Cyber Security and Compliance market since 2005. The Complainant offers what it describes as "a one-stop-shop solution" that resides within an online platform named "MyCompliance Cloud". The Complainant adds that its "MetaCompliance" software suite comprises a range of products including "MyCompliance". According to a press release dated 29 March 2012 issued by the Complainant, to which the Complainant provided a hyperlink in the Complaint, the Complainant reported that it intended to launch the "MyCompliance" solution at an Exhibition named InfoSec 2012 which was to take place from 24 to 26 April 2012.

The Complainant is the owner of European Union registered trade mark no. 9240664 filed on 12 July 2010 and registered on 30 November 2010 in Nice classes 9 and 16 in respect of a figurative mark featuring a circular logo in white on a blue background and outlined in black, together with the neologism or portmanteau word MyCompliance.

The Respondent is the director of a company registered in England named The Virtual Coach Limited. For practical purposes, the Respondent and his limited company appear to be synonymous and the Expert has treated them as such for the purposes of this Decision. The Respondent registered the Domain Name on 26 January 2015. The Respondent launched the Domain Name in February 2015 to provide a modular online

compliance website under the MY COMPLIANCE brand. According to a screen print provided by the Respondent, the service offered by its website features, for example, legal registers, incident and accident reporting, risk assessment management, contractor compliance and environmental management.

Following the registration of the Domain Name, the Respondent registered other domain names featuring what it says is its MY formative brand, namely:-

<mysalestracker.co.uk> - registered 27 August 2015;  
<my-legalregister.co.uk> - registered 26 January 2016;  
<my-incidents.co.uk> - registered 26 April 2016; and  
<my-rdc.co.uk> - registered 24 May 2016.

These domain names are held either in the name of the Respondent personally or in the name of the Respondent's limited company.

## **5. Parties' Contentions**

### **Complainant**

The Complainant contends that the Domain Name is identical or similar to a trade mark in which it has rights and that in the hands of the Respondent the Domain Name is an Abusive Registration.

The Complainant submits that its software continues to be the first choice for customers in the UK and Ireland. The Complainant states that it has been using the mark MyCompliance in Ireland and the UK for many years before the registration of the Domain Name. The Complainant asserts that it has acquired a very substantial reputation in its MyCompliance trade mark "through extensive sales, advertising and marketing".

The Complainant provides evidence of use of its trade mark by way of three web links without providing further description of these. The first link appears to relate to a posting on the UK Government's Digital Marketplace website relating to the Complainant's MyCompliance Advantage product, describing its features and benefits. The second link reaches the home page of Infosecurity Europe, a security industry conference organiser. From the link structure, this appears to have related to the Complainant as an exhibitor in a previous conference although the page concerned has been taken down. The third link points to a press release on the PRWeb NewsCenter, the author of which bears to be a member of the Complainant's staff. This release is dated 29 March 2012 and indicates that, at InfoSec 2012, the Complainant "will be launching MyCompliance®, their new cloud based risk, user awareness and policy management software solution".

The Complainant states that its trade mark predates the Respondent's registration of the Domain Name by four and a half years, adding that the Complainant enjoys substantial recognition in its field under such mark. The Complainant asserts that the Domain Name has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

The Complainant submits that the use of the Domain Name is a misrepresentation that any goods or services for which it is used emanate from or are associated with the

Complainant, citing *British Telecommunications Plc v. One in a Million Ltd* (1999) FSR 1. The Complainant adds that this case has been followed by *Global Projects Management Limited and another v. City Group Inc. and others* (Decision of Park J, Chancery Division, October, 2005). The Complainant submits that these cases are authority for the proposition that mere registration and holding of a domain name that leads people to believe that the holder of the domain name is linked with the person is enough to make the domain name a potential “instrument of fraud” and amounts to passing-off.

The Complainant submits that the use of the Domain Name is causing damage to the goodwill and reputation of its trade mark and asserts that the Domain Name was primarily registered for the purpose of unfairly disrupting the business of the Complainant. The Complainant adds that the Respondent lacks legitimate interests or rights in the Domain Name because the Respondent is not associated with the Complainant and has never sought or received authorisation or licence to use the Complainant’s trade marks in any way or manner.

### **Respondent**

The Respondent contends that the Complaint is without merit and should be rejected in its entirety.

The Respondent states that at the time the Domain Name was registered it was unaware of the rights which the Complainant claims. The Respondent explains that it carried out basic searches on the Google search engine and on the Companies House database for the term MY COMPLIANCE prior to registering the Domain Name, adding that a current Google search (the first page of which is produced) dating from 2 January 2018 does not list any results referring to any rights in the Complainant’s name.

The Respondent points to evidence which it has provided of the history of its service, namely the initial configuration of its email address at the Domain Name on 17 February 2015, an email to a prospective customer dated 20 March 2015 and a receipted invoice to a customer dated 1 April 2015 in respect of a “Monthly Credit Card Subscription to MY Compliance”.

The Respondent asserts that it adopted the name MY COMPLIANCE because this is a simple and straightforward reference to the nature and characteristics of the goods and services being provided, adding that the term is descriptive in relation to the compliance services offered. The Respondent provides a print from its website to give further detail of the services concerned.

The Respondent submits that it first became aware of the Complainant and its rights when it received a letter from the Complainant’s solicitors dated 1 December 2015 which referred to the Complainant’s trade mark. With reference to the links listed by the Complainant, the Respondent notes that prints have not been produced by the Complainant and produces its own prints. It explains that the InfoSec Europe link directs to the applicable home page and that the Respondent has obtained information relative to the Complainant by searching under the exhibitors link, which has produced evidence relating to the Complainant’s participation in a 2018 exhibition.

The Respondent submits that it has reviewed the Complainant’s website at <[www.metacompliance.com](http://www.metacompliance.com)> and that it could not immediately locate any use of the term MY COMPLIANCE on such website. The Respondent asserts that there are numerous descriptive uses of the term COMPLIANCE throughout the said site.

The Respondent acknowledges that the Complainant's trade mark is similar to the Domain Name because the former contains the words MYCOMPLIANCE conjoined although the Respondent asserts that such mark also contains a device which it says is highly distinctive. The Respondent contends that the inclusion of such device provides the trade mark with the required level of distinctiveness to secure registration and that without this such mark would be deemed descriptive of compliance related goods.

The Respondent submits that although the Complainant has claimed very substantial reputation, extensive sales, advertising and marketing for its trade mark, together with use in the UK and Ireland for many years, the Complainant has not provided any evidence which could be deemed sufficient to support such claims. The Respondent also asserts that no evidence has been provided that the Domain Name has been used in a manner which takes unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

The Respondent states that the Complainant has referred to a single incident of a customer mistakenly using the Respondent's website but notes that no evidence of the same has been produced. The Complainant adds that the One in a Million case cited by the Complainant cannot apply in the present case as the Complainant's trade mark is not well-known and the Respondent is currently and was at the time of filing of the Complaint using the Domain Name in connection with an active website in connection with the provision of goods and services.

The Respondent addresses the terms of section 5 of the Policy, submitting that there is no evidence that the Domain Name was primarily registered to sell it to the Complainant, to block the Complainant or to unfairly disrupt the Complainant's business, adding that at the time of registration the Respondent was unaware of the Complainant or any rights claimed by the Complainant in the term MY COMPLIANCE.

The Respondent submits that there is no evidence of threatened or likely confusion arising from the use of the Domain Name because the Respondent uses this in a purely descriptive manner to identify compliance goods and services. The Respondent asserts that it is not engaged in a pattern of domain name registrations corresponding to well-known names or marks, nor has it given false contact details to Nominet. The Respondent notes that the Domain Name has not been registered as a result of a relationship between the Parties. The Respondent reiterates with regard to section 5.1.6 of the Policy that the Complainant's mark includes a distinctive device and that the words MY COMPLIANCE are descriptive.

With regard to section 8 of the Policy, the Respondent states that before being aware of the Complainant's cause for complaint it has used the Domain Name in connection with a genuine offering of goods or services, having launched its website in February 2015 and offered continuing services thereby since that date and has made legitimate and fair use of the MY COMPLIANCE term to refer descriptively to its goods and services in the compliance sector. The Respondent specifically asserts for the purposes of section 8.1.2 of the Policy that the term MY COMPLIANCE is descriptive. The Respondent notes that it is not trading in domain names for profit nor selling traffic.

### **Complainant's Reply**

The Complainant contends that the date of registration of the Domain Name is not relevant and that a lack of knowledge of the Complainant's prior trade mark is not a defence. The Complainant submits that it is unbelievable that if the Respondent carried

out searches on Google and Companies House it did not also conduct a trade mark search before registering the Domain Name.

The Complainant asserts that the name of its website is not relevant, adding that it has goodwill and reputation in its MyCompliance mark and that the fact that the registration includes a graphic element does not lessen the likelihood of confusion given that domain names cannot contain graphic representations. The Complainant reiterates that the Domain Name is a misrepresentation that the goods or services upon which it is used emanate from or are associated with the Complainant and that the Domain Name is identical or at least confusingly similar to its trade mark, depending upon whether the country code top level domain is or is not included in the comparison.

The Complainant reiterates that the Domain Name in the hands of the Respondent is abusive and a blocking registration as it prevents the owner of the trade mark from reflecting same in a corresponding domain name. The Complainant states that its claims of unfair advantage or unfair detriment are based on fact and notes that the Respondent's website came to the Complainant's attention via a customer who thought it was the Complainant's website and tried to log in. In support of this contention, the Complainant produces an email between a member of its staff and the Complainant's solicitor which repeats this contention.

The Complainant concludes that it has been well proven that the Respondent registered and used the Domain Name in bad faith and that the Domain Name ought to be transferred to the Complainant.

## **6. Discussions and Findings**

### **General**

In terms of paragraph 2.2 of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraphs 2.1.1 and 2.1.2 of the Policy, namely that the Complainant 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.

### **Complainant's Rights**

Paragraph 1 of the Policy provides that Rights means "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

On this topic, the Complainant relies upon its registered trade mark as described in the factual background section above. This trade mark constitutes a right enforceable by the Complainant under English law. However, there are two particular issues that need further consideration. The first of these is the fact that the Complainant's mark is a figurative or device mark. The second is the Respondent's challenge to that mark which might be summarised as an assertion that the words in the device mark are wholly

descriptive and that evidence has not been provided of the acquisition of a secondary meaning.

Dealing with these in turn, the aspect of a figurative mark which is protected is the image or graphical depiction itself (which, as here, may also include words as part of such image or graphic). The protection extends to the overall impression of the image including any words as they appear in the figure. Unlike a word mark, however, words appearing within the graphic do not have protection as words themselves outside of their graphical representation. This is quite a fine distinction but it is important for the purposes of a domain name dispute because of the fact that domain names can only consist of alphanumeric elements and hyphens. There are no graphical elements to consider in a domain name.

The Experts' Overview version 3 notes at section 1.4 "rights in a logo or device mark may not equate to trade mark rights in respect of any words featured in the logo/device; much will depend upon the nature of the words in question and their prominence". In *Record Power Limited v. J&B Electric Power Tool Co Limited*, DRS No. 04849, the expert considered that a figurative mark featuring the words "Record" and "Power" at the top and bottom of a circular logo respectively could not be said to be identical to the domain name <record-power.co.uk>. However the expert had no difficulty in concluding that such mark was similar to the domain name concerned due to the prominence of the words in the mark. Applying the same approach, the Expert notes that the words "MyCompliance" in the Complainant's mark are prominent, given that they take up the bulk of the graphic, appearing side-by-side with the circular element and at almost the same height. They can be distinguished easily from the circular element of the device.

Notwithstanding their prominence, however, the words "MyCompliance" in the Complainant's mark do appear to the Expert to have a descriptive quality to them which may have an effect on the extent of the Complainant's Rights in the mark. The descriptiveness of marks and consequent effect on complainant's rights has been considered in a number of past cases under the Policy. For example, the expert in the case of *Tiles Porcelain Ltd v. Tile HQ*, DRS No. 9177 was faced with a similar figurative mark featuring a variety of words, most prominently BUY TILES. The expert noted that this was not wholly descriptive of a business selling tiles but was what the complainant in that case would like people who come to its website to do. If one were to apply the same logic in the present case, the words "MyCompliance" do not wholly describe a business offering compliance services. However, it is "my compliance" (seen through the eyes of each customer) which the Complainant wants its customers to undertake using the Complainant's online platform. On the other hand, the expert in the summary but fully reasoned decision in *SpareKeys.com Limited v. Mr Mark Buchanan*, DRS No. 11631, found that a domain name featuring a similar possessive form <mysparekeys.co.uk> was "very descriptive" of a business which operated as a key holder for third parties while the expert in *RWA Compliance Services Limited v. Mr Mark Wilson*, DRS No. 18426 found that a figurative mark containing a similar possessive term MY DEVELOPMENT ZONE was only "somewhat descriptive" of an online e-learning compliance training business.

The experts in both *Tiles Porcelain* and *RWA Compliance Services Limited* determined that the partial level of descriptiveness which they had identified was not an impediment to the complainant claiming Rights in the mark concerned. However, that determination was made principally because in each case the complainant had also provided sufficient evidence relating to how the mark was used, such as by reference to media publicity, advertising spend and similar. Likewise, in *Record Power Limited*, the expert had the benefit of evidence of the complainant's trading activity which allowed for a finding that the complainant had goodwill in the name "Record Power", this being

found to be protectable on independent grounds according to the common law of passing off.

In the present case, the Expert is presented with slightly greater difficulty than the experts in these various cases, largely because while the Complainant makes assertions as to the extent of its trading activity most of these are not backed up by any form of supporting evidence. For example, the Complainant submits that it has acquired a substantial reputation “through extensive sales, advertising and marketing” but does not further describe or evidence this. The three web links provided by the Complainant do no more than demonstrate that it announced that it was launching a product named “MyCompliance” at the InfoSec exhibition in 2012 and that it currently offers relative services on the UK Government’s Digital Marketplace. This does not evidence a substantial reputation or extensive sales, advertising or marketing. However, in the Expert’s view, it does at least demonstrate a degree of trading activity on the balance of probabilities, namely that the Complainant has offered products or services under a “MyCompliance” banner for six years (on the reasonable assumption that the 2012 launch proceeded) and is still offering those services currently to the public sector in the UK. These matters should therefore be taken into account in assessing the extent of the Complainant’s Rights.

Considering the prominence of the words in the Complainant’s figurative mark together with the probable length of use of the MyCompliance name in its product since 2012, the Expert is prepared to find that the Complainant has Rights in this name or mark within the framework of the Policy. Nevertheless, in much the same way as was observed by the expert in *Tiles Porcelain*, the Expert does so while remaining conscious of the traditionally low threshold test of the first element which the Complainant must prove under the Policy and, furthermore, notes that such conclusion has been reached very much on the balance of probabilities. The Complainant’s lack of evidence regarding its claims of a substantial reputation in the mark remain of importance to the merits of the Complaint as a whole and the Expert will revisit this when considering the topic of Abusive Registration.

On a simple comparison between the MyCompliance mark and the Domain Name, it will be noted that domain names are not case sensitive and thus that the only other difference (disregarding the top level “.uk” and second level “.co” of the Domain Name as is customary in the comparison process under the Policy) is the addition of a hyphen in the Domain Name. This is of no particular distinguishing significance and the Expert therefore finds that the Complainant has proved on the balance of probabilities that it has Rights in the mark MyCompliance within the meaning of the Policy and that such mark is similar to the Domain Name.

### **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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

This general definition is supplemented by paragraph 5.1 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an



Abusive Registration. Paragraph 8.1 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The Complainant makes a variety of contentions on this topic surrounding the Respondent's registration and use of the Domain Name. These are all predicated on the assertion that the Complainant has acquired a very substantial reputation in its MyCompliance trade mark through extensive sales, advertising and marketing, the underlying implication being that the Respondent is unfairly targeting such mark through the Domain Name, whether by registration, use or both.

Turning to the analysis regarding the point of registration, the Complainant's case is that the Respondent registered the Domain Name primarily to block the Complainant or alternatively primarily for the purpose of unfairly disrupting the Complainant's business. The Respondent's case outlines a straightforward riposte to these assertions. The Respondent emphasises that it selected and has used the Domain Name independently of the Complainant's mark and with no knowledge of this. It offers evidence that it has registered other my- formative domain names, albeit at various dates after the registration date of the Domain Name. It says that it registered the Domain Name to provide a genuine offering of goods and services in connection with its own online compliance platform, asserting that the words MY COMPLIANCE are descriptive of such a service. It casts doubt on the strength of the Complainant's mark, noting that this is figurative only and pointing out the lack of evidence for the Complainant's claims regarding substantial reputation. It adds that it found no sign of the Complainant's use of the term in a basic Google or Companies House search at the point of registration and provides evidence that the first page of a similar Google search today for the words "my compliance" (as independent words and not as a phrase) does not return any mention of the Complainant or its product. In fact, such search shows the Respondent's business using the Domain Name as the top result.

The Appeal Panel in the conjoined cases of *Bayerische Motoren Werke Aktiengesellschaft v. Toby Russel*, DRS16525 and *Bayerische Motoren Werke Aktiengesellschaft v. E DRIVE Ltd*, DRS 16526 noted that a disavowal of any knowledge of a complainant's registered trade mark rights when the domain name at issue was registered, if credible and believable, is likely to be an important factor for an expert or appeal panel to take into account. The Appeal Panel in *Wise Insurance Services Limited v Tagnames Limited*, DRS 4889, which related to a domain name of a similarly descriptive nature, <wiseinsurance.co.uk>, stated that a disavowal of knowledge can be regarded as reasonable if the evidence which the complainant provides as to its goodwill is of limited extent. As noted earlier, that is the case here.

All that the Expert knows regarding the Complainant's use of its mark, based on the evidence, is that the Complainant probably launched its product at an exhibition in 2012, offers it to the public sector via a UK Government portal and is taking part in an exhibition in 2018. The remainder of the Complainant's evidence relates to the features of the MyCompliance service itself. Most importantly, no evidence has been adduced to support the Complainant's key claim of extensive sales, advertising and marketing under the mark. There are likewise no details available of the volumes of customers using the Complainant's portal. Those materials which have been produced by the Complainant, in the form of web links, do not take the Complainant very far since they are not directly supportive of the Complainant's key claim and, in any event, are materials which were generated by the Complainant itself. They do not benefit from the objective independence of, for example, mainstream or trade media recognition of the Complainant's activities under its mark.

In *Wise Insurance Services Limited*, when considering the topic of Abusive Registration at the point of registration, the Appeal Panel particularly focused upon the complainant's failure to make any reference to the respondent's assertion that it was unaware of the existence of the complainant, noting that the respondent had provided a perfectly reasonable explanation in the face of the limited extent of the complainant's goodwill. In the present case, the Expert makes a similar observation. The Complainant has chosen not to address itself to this principal contention, despite having an opportunity to do so by way of the Reply, other than largely to reiterate its case as set out in the Complaint and to assert that lack of knowledge is not a defence. It is of particular significance to the Expert on this topic that when the Respondent pointed out the weakness in the Complainant's case regarding the absence of evidence of the claimed substantial reputation, the Complainant did not seek to respond to this in its Reply. The Complainant thus in fact had two opportunities to provide the necessary evidence - both by way of the Complaint and in the Reply. In consequence of the Complainant's silence on that important issue, it is reasonable for the Expert to infer that the Complainant is not in fact in a position to substantiate such claim.

A remaining aspect of the state of the Respondent's knowledge at the point of registration is the Complainant's assertion that the Respondent should have not only conducted a Google search and Companies House search but also a trade mark search. The Complainant's case is that the fact that the Respondent claims not to have conducted a trade mark search is not credible in the face of its other admitted searches and that had it conducted such search it would have had knowledge of the Complainant's mark. There is however no general duty on the part of any prospective domain name registrant to conduct any form of pre-registration search and particularly no requirement to undertake a trade mark search. In any event, the Respondent's case contains a reasonable explanation as to why it conducted the searches it did (and by implication those it did not). The Respondent asserts that the term MY COMPLIANCE is descriptive. In these circumstances, it would not reasonably have expected to find the term in a registered trade mark for services relating to compliance. It seems reasonable to the Expert that the Respondent might however have wished to assess the extent to which the term was already in use, albeit descriptively, by other parties and that it could achieve this by way of the Internet searches which it undertook. Indeed, it does appear from the Respondent's current Google search that other parties are using the term descriptively for compliance services (for example "MyComplianceOffice" and "My Compliance Home") thus adding some further support to the Respondent's case that the term is descriptive and that accordingly it had come upon the phrase independently of the Complainant and its mark.

In all of the above circumstances, the Expert does not find that the Domain Name was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Turning to the use of the Domain Name, it appears that the Respondent has developed its own compliance platform. As far as the Expert can discern, the forms of compliance which the Respondent supports are slightly different from those of the Complainant, whose platform appears to focus on IT Governance. While that might serve to minimise potential confusion, the Complainant asserts that the Respondent's use of the Domain Name has caused actual confusion on the basis of one example of a customer who allegedly attempted to log in to the Respondent's portal rather than that of the Complainant. The Respondent's case is that this is only a single instance of confusion and that in any event no evidence has been produced of the same. Despite this one example having been firmly placed in issue by the Respondent, the Complainant has not taken the opportunity to provide suitable direct evidence. Instead, the Complainant has

produced a copy of an email to its solicitor wherein it reports that the instance of confusion has occurred.

While it would have been preferable to receive direct evidence of the alleged confusion, the Expert does however have no particular reason to disbelieve the Complainant that an instance has occurred as described. That said, it remains very difficult for the Expert to place this into context or to determine its materiality when the Expert does not know who was confused, by what, when, and the precise circumstances in which this confusion is said to have occurred. Furthermore, the Expert accepts the Respondent's contention that given the descriptive quality of the MY COMPLIANCE name where used in the manner of both the Complainant's service and the Domain Name, any resulting confusion is likely to arise from the Parties' independent selection of the same descriptive term rather than from the Respondent unfairly targeting the Complainant's Rights. On the basis of that analysis, the use of the Domain Name is neither unfairly detrimental to nor taking unfair advantage of the Complainant's Rights.

The Expert is fortified in this opinion when considering the terms of section 4.7 of the Experts' Overview which asks whether it is possible for a respondent to make fair use of a domain name where that name is also the Complainant's trade mark and the Respondent's use is causing confusion. The section notes that where a complainant's mark is a combination of dictionary words and not well-known and the respondent reasonably registered and has been using the domain name in ignorance of the complainant's rights, such use may not be regarded as unfair within the terms of the DRS Policy. These are the circumstances on the evidence in the present case and the Expert has reached the same conclusion.

The section of the Overview goes on to note that a minority of the expert panel hold a view that a confusing use which is likely to constitute trade mark infringement cannot be anything other than unfair. It is not for the Expert in the present matter to opine as to whether the Respondent's use of the Domain Name constitutes trade mark infringement. However, the Expert has already indicated that there may be doubts regarding the extent and reach of such mark given that it is figurative in nature and has a descriptive quality when used in the manner outlined above. In any event, the Expert considers that the majority view is appropriate in this particular case and in all of these circumstances, the Expert finds that the use of the Domain Name does not constitute an Abusive Registration.

The Complainant has indicated that the case of *British Telecommunications Plc v. One in a Million Ltd* (1999) FSR 1 is relevant to the issues in dispute. With regard to this case, the Experts' Overview notes that the English Courts have held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name, adding that the prevailing approach under the DRS is consistent with this. Importantly, however, the Experts' Overview goes on to note that the *One in a Million* case was concerned solely with well-known trade marks. On the evidence before the Expert, that is not the situation here.

The *One in a Million* case was commented upon by the Appeal Panel in *DIGNITY FUNERALS LIMITED v. Steve Dale*, DRS 18931. Their reasoning indicates that the generic nature of a domain name (in that case, <dignity.co.uk>) may provide a clear point of distinction between the facts of a case and the facts before the Court in *One in a Million*. In the Expert's view, that point of distinction may equally apply to domain names featuring descriptive wording where there is no evidence of a secondary meaning having been established in the corresponding term. In both *DIGNITY FUNERALS* and the

present case, the domain name at issue could sensibly refer to many other entities. As noted above, if one were in any doubt about the descriptive nature of the term “my compliance”, one need look no further than the Respondent’s Google search which demonstrates the independent use of the term by other entities besides the Parties to describe their respective online compliance services.

In conclusion, the Expert is not satisfied that the Domain Name in the hands of the Respondent is an Abusive Registration either according to the manner in which the Domain Name has been registered or its manner of use. In these circumstances, the Complaint fails.

## **7. Decision**

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is similar to the Domain Name but has failed to prove that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that no action be taken with regard to the Domain Name.

**Signed** .....

**Andrew D S Lothian**

**Dated** 13 August, 2018 .....