

Nominet UK Dispute Resolution Service

DRS 00669

Guinness United Distillers & Vintners BV -v- John F Walker

Decision of Independent Expert

Parties:

1. Parties:

Complainant: Guinness United Distillers & Vintners BV

Address: Molenwerf 10-12
1014 BG Amsterdam

Country: The Netherlands

Respondent: Mr. John Francis Walker

Address: 38 Canterbury Place
Norwich

Postcode: NR2 4QJ

Country: GB

2. Domain Name:

johnniewalker.me.uk ("the Domain Name").

3. Procedural Background:

The Complaint was lodged with Nominet on 22 October 2002. Nominet validated and notified the Respondent of the Complaint on the same date. The Respondent was informed that he had 15 working days within which to lodge a response. The Respondent duly lodged a response on 11 November 2002, which was forwarded to the Complainant on 13 November 2002; at which point Nominet advised the Complainant they had 7 working days within which to lodge a reply. The Complainant lodged a reply on 22 November 2002. On the same day Nominet advised the parties that the dispute would be sent to the Informal Mediation stage of the Dispute Resolution Service. A settlement could not be reached at the Informal Mediation stage, held between 26 November and 4 December 2002, and on 9 December 2002 the Complainant paid the necessary fee to obtain an Expert Decision pursuant to Paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

Andrew Murray, the undersigned, ("the Expert") has confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality. On 10 December 2002, Nominet invited the undersigned, the Expert, to provide a decision on this case.

4. Outstanding Formal/Procedural Issues (if any):

There are no outstanding issues in this case.

5. The Facts

The Complainant is named as Guinness United Distillers & Vintners BV. The Complainant company is a wholly owned subsidiary of Diageo plc. Diageo plc is the world's leading premium alcoholic beverage supplier, trading in over 180 markets worldwide and listed on both the London and New York Stock Exchanges. The Complainant holds trade marks in several well known premium drinks brands, including Smirnoff Vodka, J&B Whisky, Baileys Original Irish Cream, Tanqueray Gin and most pertinently for the instant case Johnnie Walker Whisky. Johnnie Walker is one of the Complainant's "global priority brands". In the year June 2001 – June 2002 the Complainant spent £138 million advertising the brand worldwide, an investment which resulted in the sale of 79 million bottles of Johnnie Walker Red Label and 37 million bottles of Johnnie Walker Black Label worldwide.

The Domain Name was registered on 9 September 2002 on behalf of the Respondent. The address www.johnniewalker.me.uk currently resolves to a website offering web development tutorials. This site offers tutorials on developing content, web marketing and search engine submission. It appears this site is a mirror site for another site www.321WebLiftOff.net which was first registered by the Respondent on 8 August 2000. The Complainant though offers contemporarily gathered evidence that the current incarnation of the website is quite different from that encountered on 17 September 2002. At that date the website contained several references to alcoholism, alcoholics anonymous and contained a representation of an apparently intoxicated man walking across the screen. The website seems to have undergone several incarnations before the current version.

6. The Parties' Contentions

Complainant:

The Complainant contends that:

1. Whilst the Complainant accepts that the Respondent's name appears to be John F Walker, the Complainant is doubtful that prior to the Respondent's registration of the Domain Name he was commonly known as Johnnie, spelled Johnnie as opposed to John or the common spelling Johnny, Walker. In support, the Complainant relies on the following evidence:
 - Mr Walker's e-mail address is jfwalker@ureach.com and the auto reply from that e-mail address is signed John Walker
 - The City of Norwich Business Directory lists the Respondent's business as Norvic Software and Director as "Mr JF Walker"
 - A Juniper search suggests that Norvic Software is not a limited company but a proprietorship and the proprietor is understood to be John F Walker
2. [T]he use by the Respondent of "Johnnie Walker", "Keep Walking", "Red", "Black", "Blue" and "Gold" and "Label" in close proximity in the metatags points clearly to the fact that the Respondent is familiar with the Johnnie Walker portfolio and had it in mind when registering the Domain Name and creating the website.
3. On 11 September 2002 the Respondent sent an e-mail to domain.registrar@diageo.com and media@diageo.com advising that he owned the "johnniewalker.me.uk" domain name and that the website was available for "advertising". It is clear from the nature of the website, the choice of the metatags and the immediate contact made to Diageo, the Complainant's parent

company, not only was the Respondent well aware of the Complainant's mark but also must have been aware of the deception and confusion that would inevitably follow if he used the Domain Name.

4. The Complainant has not licensed or otherwise permitted the Respondent to use any of its trade marks or to apply for or use any domain name incorporating any of its marks.
5. The Respondent does not own a UK trade mark, or any other registered mark, in any of the international classes of goods and services in respect of the Complainant's mark. Insofar as the Domain Name is allegedly the Respondent's own name, save in respect of correspondence with the Complainant and use in registering the Domain Name, the Complainant has found no use of the name "Johnnie Walker" by the Respondent.
6. [T]he Respondent registered the Domain Name primarily for the purpose of selling, renting or otherwise transferring the Domain Name to the Complainant for valuable consideration in excess of the Respondent's out of pocket costs and/or for the purpose of unfairly disrupting the business of the Complainant contrary to Paragraphs 3(a)(i)(A) and/or 3(a)(i)(C) of Nominet's Dispute Resolution Service Policy. The Complainant submits that there can be no other explanation as to why the Respondent obtained the Domain Name and created the website incorporating the Complainant's trade marks and words associated with the Complainant's business and then contacted the Complainant's parent company two days after he had registered the Domain Name to advise that he owned it and that it was available for advertising. The Complainant submits that the Respondent did this to induce the Complainant to buy the Domain Name to safeguard its rights in the mark. Further the use of the Domain Name and the original contents of the website are such that visitors attracted to the website by the Domain Name or metatags could be confused or offended by the content leading to unfair disruption of the Complainant's business which, as noted above, promotes responsible drinking.
7. [T]he circumstances indicate that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant contrary to Paragraph 3(a)(ii).
8. The overall effect of the Respondent's activities brings the Respondent's use of the Complainant's mark clearly within the definition of Abusive Registration both at the time of registration and in terms of the use that has been made of the Complainant's mark after registration. The circumstances in which the Respondent is using the Complainant's mark combined with use of the Complainant's other registered trade marks, renders the Domain Name in the hands of the Respondent an Abusive Registration.
9. Whether or not the Respondent is known as Johnnie Walker, the Complainant submits that by virtue of his actions the Domain Name in his hands is an Abusive Registration and the Respondent has no rights in the name.

Respondent:

The Respondent contends that:

1. [T]he .me.uk domain name is intended for use by natural persons with a UK connection, not by corporations based in the Netherlands. (Rule 7 of the rules for the .me.uk Second Level Domain)

2. The Respondent is a natural person born in the UK, who has lived in the UK all his life. The name on his birth certificate is John Francis Walker and as such he is entitled to use the name "Johnnie Walker", a nickname by which he has been known since a child.
3. The Respondent denies the Complainant's allegations. He denies he is trying to pass himself off as anything or anyone other than who he is and the webpage at the domain in issue is a Web development tutorial site and does not infringe the complainant's trademarks.
4. The Respondent submits that GuinnessUDV, as a corporation based in the Netherlands, is not entitled to possess a *.me.uk* domain name.

Complainant's Reply:

The Complainant in replying to the Respondent's response contends that:

1. While Rule 3 of the *.me.uk* Rules states that the *.me.uk* SLD is intended to provide a personal namespace within the *.uk* TLD and it is anticipated that registrants will be natural persons who have an association with the UK, Rule 4 states that any entity may register in the *.me.uk* SLD provided that the registration complies with the Nominet UK Terms and Conditions, the Rules and the Rules for the *.me.uk* SLD.
2. Accordingly, if the Complainant wished to register the Domain Name, then subject to the agreement of a specific natural person whose name is a reasonably faithful representation of that person's legal name, the Complainant would be entitled to the Domain Name. The Complainant does not make any allegation under Paragraph 3(a)(i)(B) of the Policy that the Respondent has registered the name as a blocking registration.
3. Under Paragraph 4(a)(i)(B) of the Policy, it is indicative of non-Abusive Registration if the Respondent has been known by the name identical or similar to the Domain Name. With regard to the Respondent's "nickname" defence, while the Respondent may have a nickname, the Complainant specifically put the name by which the Respondent was known in issue. Save for the use by the Respondent of the name "Johnnie Walker" in the Domain Name itself and only the initial approach to Diageo, the Respondent appears to be known as and uses John, JW or JF Walker. No weight can be given to the bare assertion that "I am entitled to use the name "Johnnie Walker", a nickname by which I have been known since I was a child" in the absence of any documentary evidence in support of the Respondent's use of this name and use of this name spelled Johnnie.
4. The website has been subject to frequent changes. The Complainant submits that the Respondent changed his website as he served his Response to give the impression that the Domain Name in his hands is not an Abusive Registration.
5. The Respondent has not addressed any of the submissions or evidence served by the Complainant. While the Respondent may be called John Walker, his approach to the Complainant two days after registration of the Domain Name, the nature of the original website and the use of the Complainant's trade mark "Johnnie Walker" together with the Complainant's other trade marks in the website's metatags show clearly that the Domain Name in the hands of the Respondent is an Abusive Registration.

7. Discussion and Findings

Special consideration of the .me.uk SLD rules:

This is only the second action under the Nominet DRS Policy dealing with a *.me.uk* Domain Name. As has been recognised by both parties this brings with it a special set of circumstances and at this juncture it is useful to deal with these before moving on to analyse whether or not the Domain Name in the hands of the Respondent is an Abusive Registration.

The *.me.uk* SLD was introduced by Nominet on 14 January 2002. It is designed to offer natural persons a specific SLD which they may exploit to develop a web presence. As such the *.me.uk* SLD is quite different from the more familiar *.co.uk* and *.org.uk* SLDs and it is governed by a special set of rules which may be read at <http://www.nominet.net/meuk/rules.html>. In the event the *.me.uk* SLD rules conflict with the rules for the *.uk* TLD the *.me.uk* SLD rules shall have precedence (Rule 2 of the *.me.uk* SLD rules).

The rules for the *.me.uk* SLD have, to date, been analysed in a single Nominet UK DRS decision, that of *Nokia Corporation v Saeed Mahmood, Naqi Jawad & Taqi Jawad (DRS 00292)*. In the opinion of the Expert in that case, Mr. Philip Roberts, "on first reading one could be forgiven for believing that *.me.uk* domain name registrations are only available to natural persons (as opposed to legal persons such as corporations)...on closer inspection of the Rules as currently drafted, it is apparent that Rule 3 is little more than a 'mission statement': Rule 4 provides that any entity may register a *.me.uk* domain name; Rules 1 and 6 provide that the specific *.me.uk* Rules apply in addition to - rather than in substitution for - Nominet's terms and conditions, the Rules for the *.uk* TLD and Nominet UK's Dispute Resolution Policy and Procedure."

The Expert in the current case concurs with this finding. Rule 3 of the rules for the *.me.uk* SLD merely *anticipates* that registrants will be natural persons who have an association with the UK. Rule 4 clearly *expresses* that "any entity may register in the *.me.uk* SLD provided the registration complies with the Nominet UK terms and conditions, the rules for the *.uk* domain and the rules for the *.me.uk* SLD." Therefore although the Expert agrees with the Respondent's assertion that "[T]he *.me.uk* domain name is *intended* for use by natural persons with a UK connection, not by corporations based in the Netherlands." this intention is in no way conclusive and is no bar to a Netherlands based corporation taking a registration in the *.me.uk* SLD.

More persuasive is the Respondent's reference to Rule 7 of the rules for the *.me.uk* SLD. This states that:

"There shall, without exclusion, be a sufficient demonstration of an abusive registration if the registrant is not a natural person and cannot demonstrate that they registered the domain name with the agreement at the time of a specific natural person, and that the domain name was a reasonably faithful representation of that person's legal name."

Thus Rule 7 gives pre-eminence to natural persons in the *.me.uk* SLD space. In event of a conflict between a corporate registrant and a natural complainant the burden of proof is switched to the registrant who is required to establish a natural interest in the *.me.uk* domain name in question. Although this is evidence within the rules of the intent that the *.me.uk* SLD should become the space within the *.uk* TLD for natural persons to establish themselves it does not provide any assistance in the instant case.

As explained by the Expert in the *Nokia Corporation* decision (DRS 00292), Rule 7 contains a set of cumulative requirements:

- (1) the registrant is not a natural person
- (2) the registrant cannot demonstrate that they registered the domain name with the agreement at the time of a specific natural person; and
- (3) the registrant cannot demonstrate that that the domain name was a reasonably faithful representation of that person's legal name.

“Where the three cumulative requirements of Rule 7 are present, the Registration is conclusively deemed to be Abusive, regardless of the factors set out at Paragraphs 3 and 4 of the Policy; but where one or more of the three requirements of Rule 7 are absent, abusiveness must be judged under the usual provisions of the Policy.”

In the instant case the registrant is a natural person, Rule 7 therefore falls at the first hurdle and I derive no assistance from the rules for the *me.uk* SLD in determining whether or not the Domain Name is an Abusive Registration.

General Considerations under the Nominet UK Dispute Resolution Policy and Procedure

The Complainant has to establish under Paragraph 2 of the Policy 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 that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy. Rights, as defined, "include but are not limited to rights enforceable under English Law." However they cannot be merely "rights in a name or term which is wholly descriptive of the Complainant's business". The Complainant has the burden to prove on the balance of probabilities both that it has the rights and also that the Domain Name, in the hands of the Respondent, is an abusive registration.

Does the Complainant generally have a right in this name?

The first (.uk) and second (.me) levels of the Domain Name should be discounted for the purposes of comparison as being of a generic nature (*APC Overnight v M+J Couriers (DRS 00192)*). Thus the name in issue is Johnnie Walker. The Complainant has provided evidence that they currently hold four registered UK trade marks in the term "Johnnie Walker" (with one further application pending) as well as five additional UK registered trade marks incorporating the term "Johnnie Walker" in conjunction with a further term or device. The oldest of these trade marks (in Class 33) dates from 30 November 1908 and thus clearly pre-dates the Respondent's date of registration. I am amply satisfied on the evidence before me that the Complainant has rights in the designation Johnnie Walker. I am further satisfied that this name is identical to the Domain Name in issue.

Abusive Registration

To be an Abusive Registration the Domain Name must be one which "...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 has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights" (Paragraph 1, Nominet UK Dispute Resolution Service Procedure "the Procedure".)

Paragraph 3(a) of the Policy contains a *non-exhaustive* list of factors which may be evidence that the Domain Name is an Abusive Registration. These are as follows:

"Evidence of Abusive Registration

- i. *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name;*
 - A. *primarily 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 people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;*
 - iii. *In combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations; or*
 - iv. *It is independently verified that the Respondent has given false contact details to us."*

In their complaint, the Complainant relies upon Paragraphs 3(a)(i)(A) and 3(a)(i)(C) and 3(a)(ii).

Paragraph 3(a)(i)(A)

The Complainant bases their claim under this sub-paragraph on the basis of an e-mail sent from the Respondent on 11 September 2002 to the Complainant's parent company Diageo plc offering them the opportunity to advertise on his site. In the opinion of this Expert this is insufficient to raise a claim under this Paragraph 3(a)(i)(A). Advertising is commonplace on the Internet and the policy requires that the Respondent has "registered or otherwise acquired the Domain Name; primarily for the purposes of **selling, renting or otherwise transferring the Domain Name.**" It is quite clear that this is not the case here. The Respondent did not on the evidence before me offer to transfer the Domain Name in any fashion, he merely offered advertising space on a webpage he would develop at this address Therefore the claim under Paragraph 3(a)(i)(A) fails.

Paragraph 3(a)(i)(C)

The Complainant presents a broad-based claim under this heading. The Complainant submits that there can be no explanation (other than to unfairly disrupt the business of the Complainant in terms of this sub-paragraph) as to why the Respondent obtained the Domain Name and created the website incorporating the Complainant's trade marks and words associated with the Complainant's business and then contacted the Complainant's parent company two days after he had registered the Domain Name to advise that he owned it and that it was available for advertising. The evidence supplied by the Complainant under this head is extremely compelling. Although the Respondent now hosts a web tutorial site at the Domain Name it is clear from evidence presented by the Complainant that the Respondent originally registered the Domain Name with a view to disrupting the business of the Complainant. This he did through meta tagging various trade marks and allied descriptions of the Complainant's product and through prominent placement on the webpage of the statement "Johnnie Walker supports Alcoholics Anonymous, Sobriety and Temperance" and of a stylised intoxicated man walking across the screen which clearly was designed to put the viewer in mind of the Complainant's "striding man" trade mark. In the Expert's opinion the Complainant has satisfactorily made out a claim under this heading.

Paragraph 3ii

The Complainant further asserts that the circumstances indicate that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant contrary to Paragraph 3(a)(ii). The Complainant bases this assertion upon the original design of the website (discussed above) and the prominent meta tagging of terms such as “Scotland”, “alcohol”, “scotch”, “whisky”, “blend”, “malt”, “liquor”, “drink”, “spirits” and “brewers”. The Complainant relies upon the decision of Pumfrey J. in *Reed Executive plc and another v Reed Business Information Ltd and others* [2002] All ER (D) 300 which held that use of another’s registered trade marks as key words in metatags falls within Section 10 of the Trade Marks Act 1994 “because ultimately its purpose is to use the sign to suggest a connection which does not exist...”. The Expert finds the reasoning of Mr Justice Pumfrey to be quite correct in this regard. There is no doubt the Respondent tagged his site in this manner to create “false positive” results when particular search terms are entered into a search engine. These false positives would create within the mind of the user a confusion, leading them to assume the Respondent’s site is connected to the Complainant. Although the Respondent has since removed these tags it would take but a matter of minutes for them to be restored and therefore the Expert finds that the Complainant is right to be “concerned that the Respondent may continue to post further material on the site which causes members of the public to believe that the Respondent is associated with the Complainant when this is not the case.” The expert therefore finds that the Complainant has further made a satisfactory claim under this heading.

Paragraph 4(a)(i)(B)

The Respondent defends himself against these claims by reference to Paragraph 4(a)(i)(B), that he has “been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name”. It is his contention that although his name is John Francis Walker, he has been commonly known by the nickname “Johnnie”, a nickname he has had since childhood. To this expert’s knowledge this is the first case where a defence of this nature has been made under the Nominet DRS Policy. It is important that individuals are allowed to use their natural name when establishing a web presence and this is one of the prime concerns addressed by Paragraph 4(a)(i)(B). This concern is magnified somewhat by the lens of the use of the *.me.uk* SLD in this case. The key question is, is there evidence that the Respondent has been commonly known by the name “Johnnie Walker” as opposed to “John Walker” or “Johnny Walker”? The Respondent presents no evidence of this apart from his bare assertion in his Response to the Complaint. There is though some evidence presented by the Complainer which suggests he is known by the name “John Walker”, that being the name he uses in e-mail replies for instance. Also, although the Respondent registered the Domain Name in the name “Johnnie Walker”, when registering his previous domain name of 321WebLiftOff.net he did so in the name “John Walker”. The Respondent has not, in the Expert’s opinion, demonstrated that he is commonly known by the name, or nickname, “Johnnie” and as such this defence is not satisfactorily established.

8. Remedy

The Complainant asks that the Domain Name be transferred to it or in the alternative suspended. As this is only the second case involving the *.me.uk* SLD it is worth considering these alternatives. Although the Policy allows Experts to “cancel, transfer, suspend or otherwise amend” a Domain Name registration (Paragraph 10(a)) special consideration must be taken of the rules for the *.me.uk* SLD. In particular Rule 7, as discussed previously gives pre-eminence to natural persons within the *.me.uk* SLD. It states that:

"There shall, without exclusion, be a sufficient demonstration of an abusive registration if the registrant is not a natural person and cannot demonstrate that they registered the domain name with the agreement at the time of a specific natural person, and that the domain name was a reasonably faithful representation of that person's legal name."

This Rule seems quite clear. If a corporation such as the Complainant takes registration of a Domain Name within the *.me.uk* SLD without the specific agreement of a natural person who shares this (or a suitably similar) name the corporation will be deemed to hold an abusive registration. In the instant case, were the Expert to transfer the Domain Name, as requested by the Complainant, without the agreement of a natural person known as John or Johnnie Walker it would therefore create an abusive registration within the terms of Rule 7 of the rules for the *.me.uk* SLD. It is clearly stated by Rule 2 of the rules for the *.me.uk* SLD that "where a conflict exists between the Rules and the rules for the *.me.uk* SLD, the rules for the *.me.uk* SLD shall have precedence." It is the belief of this Expert that the powers awarded to the Expert under the DNS Policy and Procedure are therefore constrained by the terms of the rules for the *.me.uk* SLD and that to transfer the Domain Name to the Complainant would be *Ultra Vires*. The Expert therefore is compelled to find in favour of the Complainant's alternative remedy, that of suspension of the Domain Name.

9. Decision

In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, johnniewalker.me.uk be suspended.

Andrew D. Murray

19 December 2002