

Using the Dispute Resolution Service for .uk domain names online survey

Submit date : **Feb 15, 2007**

Question 1: Please give us feedback on our proposals that the DRS should include:

- (a) protection for words which have a distinctive character as a result of the use made of them.
- (b) dictionary words which are protected by registered trade marks or good will.

Such words are already covered by the DRS. The DRS covers names or marks in which the Complainant has rights. Words, which have acquired distinctiveness through use, are known as unregistered trade marks in respect of which, under English law, their proprietors have what are known as common law rights in passing off. Dictionary words are similarly protectable as trade marks whether by registration or through use. Examples include BRITISH GAS, FORD, PENGUIN, ELAN, FIESTA, VANISH, EGG, BLACKBERRY, etc, etc. Accordingly, to the extent that this is said to be a proposal, it is not a proposal for change, but a proposal for clarification. I support any attempt to clarify the DRS.

Question 2: Please give us your feedback on our proposal that the DRS should include the following as examples of things that are not necessarily evidence of abuse:

- a general offer to resell a domain name
- sale of traffic (i.e. visitors to the domain name)
- registering many domains

Again, this is simply a proposal for clarification. Even now, none of these situations is of itself a basis for a finding of abusive registration under the DRS Policy. There is nothing inherently objectionable in trading in domain names for profit, in linking domain names to parking pages with a view to deriving pay per click revenue or in holding large portfolios of domain names. All depends upon the motives of the registrant at the time of registration and/or at time of use.

Question 3: Please give us feedback on our proposal that the DRS should include a statement that, where the evidence is finely balanced, the weaker the rights that the complainant has, the less likely it is that abusive registration or use will be inferred.

This question elides two distinct issues:- (i) the weaker the complainant's rights the more difficult it will be for the complainant to establish abuse. This is common sense and reflects the law; (ii) the evidence is finely balanced. If the evidence is so finely balanced that the expert is uncertain which way to go, this ought ordinarily to result in the complaint failing for the burden of proof is on the complainant.

Question 4: Please tell us which payment option you would prefer and why: no change; a small upfront fee; or loser pays?

If proposal 2 can be introduced in a way which does not result in small time complainants being deterred from using the process, I support it, simply to encourage complainants to give greater attention to their complaints than is currently the case. Otherwise, I favour 'no change'.

Question 5: How would you enforce any system of refund (outlined in option 3)? Which section of the community would you imagine would most benefit from a refund system?

I am against option 3 simply because I cannot see how such a system could sensibly be enforced.

Question 6: Do you have any comments about the proposals to change aspects of the procedure, payment, drafting, appeals, expert decisions, abusive registrations or miscellaneous issues?

Remove or alter the reply stage of the DRS

Whatever is adopted, it is crucial that in coming to their decisions Experts do not rely on any fact or matter raised by one party and adverse to the other party, to which that other party has not had an opportunity of responding. Accordingly, Experts must still have the discretion to seek further submissions.
Drafting

To my mind 'abusive registration' is preferable to 'unfair registration'. The term 'abusive registration' accurately indicates that for a complaint to succeed under the DRS, the complainant has to show, on the balance of probabilities, an element of abusive behaviour on the part of the respondent.

Appeals

I am against the introduction of new evidence for an appeal unless it falls within the 'second bite of the cherry' provisions in relation to re-filed disputes. Nothing should encourage a party to adopt a laissez-faire approach to the initial round of submissions.

Expert decisions Reasoning.

We are conscious that the service is not perfect and are in the process of reviewing how decisions are expressed. Some are better than others, an inevitable result of having a cadre of Experts from a variety of different backgrounds and disciplines. Contrary to public perception, a significant minority of the Experts have no background in trade mark law, for example. We have set up a review group, which is currently going through a large number of the decisions with a view to coming up with recommendations for the Experts. This is in addition to the regular meetings of Experts at which controversial issues are discussed. The aim is to improve consistency and, above all, to ensure that the decisions are clearly reasoned. Incidentally, from some remarks made at the recent Nominet consultation meeting in Great Queen Street, it appears that some people only read the "Discussion and Findings" section of a decision. To make sense of a decision, the "Facts" section ought to be crucial.

Expert investigations.

Experts will normally look at the website to which the domain name is connected. Indeed, more often than not the Complainant will invite the Expert to do so and will exhibit print-ups. Only very rarely will it be appropriate for an Expert to do more than that. Where an Expert does do more than that and proposes to rely upon the information obtained, it is very important that the Expert gives the parties an opportunity to make submissions on that information. The same applies where, as sometimes happens, the Expert has personal knowledge in respect of some fact or matter raised in the case.

General.

I would be in favour of Nominet producing an equivalent to the WIPO Overview (to be found at the WIPO website) setting out some of the more common issues to arise in disputes and the consensus view of Experts in relation to those issues. Abusive Registrations Likelihood of confusion (para 3(a)(ii) of the Policy). Many of the Experts already adopt this approach. In my view it would be absurd to

of the Experts already adopt this approach. In my view it would be absurd to compel a complainant to wait for the near inevitable to happen and come to his attention in satisfactory evidential form before allowing a complaint to succeed. This reflects the judicial approach. See the comments of Lord Justice Jacob in the phoe4u.co.uk appeal. I am in favour of a change to the wording of the paragraph to make this clear. As to para 3(a)(iii) I agree that a past abusive use MAY be sufficient to warrant a finding of Abusive Registration. However, the word 'may' is important because I can envisage circumstances where such a use might have been overtaken by subsequent events e.g. an agreement with the complainant.

The effects of delay.

Again, while I agree that delay in enforcing rights is a dangerous option for a rights owner, I should prefer the use of the word 'may' rather than 'is likely to'. So much depends upon the circumstances. I query, for example, how a flagrantly abusive registration, flagrantly abusive at the outset, could become non-abusive simply as a result of delay on the part of the complainant in taking action.

The timing of rights.

This could usefully be clarified. It's amazing to me how many people do not seem to appreciate that an abusive use can occur in relation to an originally legitimate registration and in circumstances where the complainant's rights post date the registration of the domain name.

Question 7: Do you have any other changes you would like to see within the DRS, or topics within the DRS that you wish to comment on? In particular, if you have any views about any of the following topics which have been the subject of discussion, please let us know:

- Length of submissions and word limits.
- The impact of Internationalised Domain Names, if introduced.
- Whether experts can find a registration abusive for reasons not spelled out in the complaint.
- Whether there have been any practical problems with the treatment of 'Without Prejudice' material.
- Whether experts should be able to represent parties in other disputes, and if not how to keep the quality of experts high.
- Whether the detail of the DRS can be taken out of the contract and updated more regularly.

Whether experts can find a registration abusive for reasons not spelled out in the complaint. The task of the Expert is to assess whether or not the registration is an abusive registration within the meaning of the Policy and relying upon the facts and matters set out in the parties' submissions. Abusive Registration is defined by reference to the taking of unfair advantage and/or the causing of unfair detriment.

If the facts and matters set out in the submissions persuade me that the domain name is an Abusive Registration within that definition, I will find in favour of the complainant whether or not the complainant and I agree as to the precise basis for that finding. Put another way, if the Complainant bases his complaint solely upon paragraph 3(a)(i), but I take the view that paragraph 3(a)(ii) is a better basis for the

finding, I will make the finding notwithstanding that the complainant has not mentioned that sub-paragraph in the complaint. Necessarily, however, if the Respondent is participating in the process I would give the respondent an opportunity to deal with the issue if I felt that he had not had a proper opportunity of addressing the point. In my view, it would be absurd to permit an Abusive Registration to remain in the hands of the respondent simply because the complainant has chosen the wrong peg on which to hang the complaint PROVIDED of course that the facts and matters set out in the submissions support such a finding.

- Whether there have been any practical problems with the treatment of 'Without Prejudice' material. I am not aware of any problem having arisen. For the reasons set out in the <scoobydoo.co.uk> appeal decision, I believe it would be a mistake to seek to introduce the rule to the DRS.

- Whether experts should be able to represent parties in other disputes, and if not how to keep the quality of experts high. This is an issue worthy of debate. The fear is that in some way we (I fall into the category of practitioner/Expert) will somehow bring pressure to bear or will be thought to bring pressure to bear on our fellow Experts when acting for a party and, when acting as Experts, will favour our colleagues representing parties to disputes. In other words whether or not we in fact behave improperly, justice will not be seen to be done.

Those of us who are UK litigators are used to these situations. Judges are promoted from the ranks of barristers and often find themselves being addressed by friends from their old chambers. In the case of deputy judges, they are practising barristers and may be faced by advocates from their own chambers. They may be hearing cases involving similar issues to cases in which they are involved on behalf of clients.

While there is a theoretical risk, in 40 years in the profession I have never come across a case of bias of the kind feared. The truth of the matter is that we are all independent professional people. None of us wants a decision to go out under our name which calls into question our integrity. Risking our professional integrity in this way would spell professional ruin and would make no sense. The conflict rules are strictly applied. If the lawyers practising in the field were excluded from the DRS panel of experts, Nominet would have a very difficult task in maintaining, let alone improving upon consistency.

Please give us your contact details

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