

Nominet Dispute Resolution Service

DRS 6044

Racing UK Limited

v

TagNames Limited

Decision of Independent Expert

1 PARTIES

Complainant: Racing UK Limited

Address: 38-44 Gillingham Street
London
Postcode: SW1V 1HU
Country: UK

Respondent: TagNames Limited

Address: 7 The Willows
Great Chesterford
Essex
Postcode: CB10 1QL
Country: UK

Represented by: Adlex Solicitors
76A Belsize Lane
London NW3 5BJ

2 DOMAIN NAME

2.1 www.racinguk.co.uk ("the Domain Name")

3 PROCEDURAL BACKGROUND

3.1 On 31 July 2008 Nominet entered on its system the complaint and on 1 August 2008 the complaint was validated. On 27 August 2008 Nominet received the response and on 28 August 2008 Nominet received the reply. After a period during which the parties unsuccessfully mediated this matter, on 21 October 2008, Nominet received the complaint fees from the Respondent rather than from the Complainant.

3.2 On 30 October 2008 Patricia Jones ("the Expert") confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might call into question her independence and/or impartiality.

3.3 The Expert was appointed on 30 October 2008.

- 3.4 On 4 November 2008, the Expert exercised her discretion to refuse to accept non-standard submissions from both the Complainant and the Respondent which had been submitted under paragraph 13 of the Nominet Dispute Resolution Service Procedure (“the Procedure”).

4 THE FACTS

- 4.1 The Complainant operates a horse racing channel on satellite TV and also operates a web-site at racinguk.tv.
- 4.2 The Respondent registered the Domain Name on 26 March 2004. The Respondent registered the domain names racing-uk.co.uk, uk-racing.co.uk and racinghorses.co.uk at the same time.
- 4.3 On 29 May 2004, the Complainant launched its TV channel under the brand name Racing UK.
- 4.4 The Domain Name currently resolves to a blank page.

5 THE PARTIES’ CONTENTIONS

The Complainant

- 5.1 The Complainant’s Complaint is so short that it can be repeated verbatim:
- (a) “Racing UK Limited is a leading horse racing TV Channel. The company is owned by 30 of the countries leading race courses. We have a TV Channel broadcasting on the Sky platform called Racing UK and we also offer other services on-line. Considerable advertising and marketing is spent on the Racing UK brand and identity. The company commenced broadcasting on TV on 29 May 2004.
 - (b) The domain was registered (sic) by the respondent for to stop Racing UK registering (sic) its own domain name. It is one of a series of registrations that the Respondent has made and in the past the respondent has lost at least one DRS case.”
- 5.2 The Complainant has provided as evidence in support examples of its advertisements.

The Respondent

- 5.3 The Respondent disputes that the Complainant has acquired any rights in Racing UK on the basis that:
- (a) It is a common generic and descriptive term denoting racing with reference to the UK. Indeed, the Complainant’s website says “Racing UK is a dedicated horseracing channel showing quality racing from all the top UK courses featuring the cream of British Racing.”
 - (b) The public has no more reason to associate “Racing UK” with the Complainant than with any of the numerous other websites or businesses in the UK connected with racing.

- (c) The Respondent acknowledges that Rights under the Policy includes rights in descriptive terms which have acquired a secondary meaning. The Complainant would have a hugely difficult task in demonstrating a secondary meaning and has barely attempted this. The Complainant has not provided any evidence of trading by reference to its name and has made a vague and unsupported assertion of “considerable advertising and marketing”.

5.4 The Respondent denies that the Domain Name is an Abusive Registration:

- (a) Shortly before registering the Domain Name the Respondent became aware that it was about to “drop” and assumed the previous owner no longer wanted it. The Respondent thought it a potentially attractive domain name to have because single word generic domain names such as “racing” are long gone and adding “UK” is the next logical step and good for search engine optimisation.
- (b) The Respondent owns many domain names which consist of a generic term followed by “UK”.
- (c) The Respondent owns approximately 100 generic racing-related domain names, the first having been registered in July 2003.
- (d) The Respondent did not register the Domain Name to stop the Complainant from registering it. The Respondent was not aware of the Complainant’s name when it registered the Domain Name nor could it have been as the Complainant had not by then started using the name “Racing UK”.
- (e) The Respondent has lost one DRS case (wiseinsurance.co.uk) but the decision was reversed by the DRS appeal panel.

5.5 The core assertion by the Complainant is that the Respondent registered the Domain Name to stop the Complainant registering its “own” domain name. The Complainant must have known that this assertion could not be correct as it must have been aware that the Domain Name was registered before it adopted “Racing UK”. The Respondent asserts that the complaint is an abuse of process and that the Complainant is domain name hijacking.

The Reply

5.6 The Reply is so brief it can be repeated verbatim:

“The Respondent was using the domain to route to a Horse Racing related website (since the dispute was raised he has ceased doing this and now routes it to a blank page). The Respondent was using racinguk.co.uk to profit from the brand and reputation of Racing UK so any argument about generic term are nonsense (sic) as the domain was being used specifically for the Respondent to profit from Racing UK’s work. Racing UK is part of the Setanat (sic) pack and is in over 3 million homes as a branded TV Channel owned by 30 Racecourses. It is a specific brand name and as such highly associated with horse racing and in particular broadcasting.”

6 DISCUSSION AND FINDINGS

6.1 Paragraph 2 of the Nominet Dispute Resolution Policy (“the Policy”) sets out that for the Complainant’s complaint to succeed 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.

6.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities. The Complainant says that the Respondent has lost at least one DRS case (without citing the decision(s)), which the Respondent denies. Under paragraph 3 (b) of the Policy there shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the two years before the complaint was filed. The Complainant has not proved this and the Respondent does not appear on Nominet’s published list of 3 cases respondents. I will therefore decide this matter on the basis that the Complainant is required to prove the requirements of the Policy on the balance of probabilities.

6.3 I will also consider this matter on the basis of the complaint, response and reply documents. I have exercised my discretion not to accept non-standard submissions from both the Complainant and the Respondent because, on the basis of their explanations, I did not consider that there was an exceptional need for these submissions.

Complainant’s Rights

6.4 Paragraph 1 of the Policy states 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.”

6.5 The Complainant commenced trading on 29 May 2004 under the brand name “Racing UK”. The Respondent says that this is a generic and descriptive term and that the Complainant has not established any secondary meaning in “Racing UK”.

6.6 I am required to consider whether the Complainant has sufficient Rights to found a complaint. Under the previous version of the Nominet Policy it was fairly consistently considered that the threshold for establishing Rights for the purposes of bringing a complaint was a low one. Although the definition of Rights has been amended in the current version of the Policy, I consider that this is still the right approach to take.

6.7 I consider that “Racing UK” has descriptive connotations when used in connection with the Complainant’s business of a horse-racing TV channel. However, I do not consider that “Racing UK” is wholly descriptive of the Complainant’s activities, as it does not specifically refer to horse-racing.

6.8 Racing UK is currently in 3 million homes and is owned by 30 racecourses, who undoubtedly have an interest in promoting it. Although the Complainant has not provided details of the extent of its marketing and advertising, it has provided examples of its creative materials featuring “Racing UK” in connection with well known races and well

known characters from the racing world. In all the circumstances, I am satisfied that the Complainant has built up goodwill in Racing UK as a horse racing TV channel, sufficient to establish enforceable rights in passing off under English law.

6.9 I therefore consider the Complainant has Rights in a name or mark which is identical to the Domain Name.

Abusive Registration

6.10 I have to consider whether the Domain Name, in the hands of the Respondent, is an 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. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

6.11 Knowledge of the Complainant and/or its rights at the time when the Domain Name was registered or at the commencement of the objectionable use of the Domain Name is a crucial element of an Abusive Registration.

6.12 In this case the Respondent denies being aware of "Racing UK" at the time the Domain Name was registered. The Respondent has presented evidence that the brand name "Racing UK" was launched on 29 May 2004, two months after registration of the Domain Name, and that before then the TV channel was known as the Horse Racing Channel. The Respondent has also shown that it registered some other racing related domain names (racing-uk.co.uk, uk-racing.co.uk and racinghorses.co.uk) at the same time as the Domain Name which suggests that the Respondent was interested in registering domain names with a descriptive connotation in relation to racing.

6.13 In contrast, the Complainant has presented no evidence whatsoever as to how the Respondent could have known about Racing UK at the time the Domain Name was registered in March 2004, prior to the public launch of the Racing UK brand.

6.14 I therefore do not consider that the Complainant has established on the balance of probabilities that the Respondent knew of the Complainant or its brand when the Domain Name was registered. I find that the Domain Name is not an Abusive Registration under paragraph 1(i) of the Policy.

6.15 In its reply, the Complainant appears to allege the Domain Name is an Abusive Registration under paragraph 1(ii) of the Policy, as the Respondent has used the Domain Name in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights, in relation to its routing through to a horse racing related website. However, the Complainant has presented no evidence on this, for example when such use took place or copies of the web pages nor do I consider the provision of a horse racing related website in itself as likely to be an unfair use of the Complainant's Rights.

6.16 Currently, the Domain Name resolves to a blank page. Paragraph 3b of the Policy sets out that the failure on the Respondent's part to use the Domain Name for the purposes of

email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

- 6.17 In the circumstances, based on the evidence submitted by the Complainant, I do not consider that the Complainant has established on the balance of probabilities that the Domain Name is an Abusive Registration under paragraph 1(ii) of the Policy.
- 6.18 The Respondent alleges that the Complainant is Reverse Domain Name Hijacking, using the DRS in bad faith in an attempt to deprive the Respondent of the Domain Name. I do not consider this to be the case on the evidence. I have found that the Complainant has Rights in Racing UK which entitled it to bring the complaint and there is no bad faith use of the DRS just because that complaint has been unsuccessful.

7 DECISION

- 7.1 I find that the Complainant has Rights in a name or mark which is identical to the Domain Name.
- 7.2 I do not find that the Domain Name in the hands of the Respondent is an Abusive Registration.
- 7.3 I direct that NO ACTION be taken in relation to the Domain Name.

Dr Patricia Jones

19 November 2008