

**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.**

These two suggestions will not make a great deal of practical difference to the existing requirements under the first stage of the DRS. Words which have a distinctive character or dictionary words supported by a trade mark or good will are already covered by the existing "rights" requirement. This proposal would clarify the position for web users who are unaware that dictionary words, etc., can and are protected by existing trademark law.

**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**

In the first instance it is unclear why a particular section of the market - that is "domainers" - require specific protection as the rules and policy must apply equally to all. It is also uncertain why these specific activities need to be singled out - they are not mentioned as part of the existing policy as being inherently abusive in any event. Therefore, again, these proposed changes will make little difference to the DRS except to clarify issues that are already adequately covered by the policy.

Furthermore in general terms these proposals place too much specific emphasis on areas of the industry that are particularly popular at the moment, such as pay per click advertising. The DRS policy should be kept widely defined to allow it to adapt accordingly to new developments and new trends.

**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.**

The implementation of this proposal would confuse the DRS procedure and muddle up the two limbs of the policy. For the first test - rights in a name - a complainant either does have rights or they do not. The strength of those rights against the rights of the respondent is currently and properly discussed in the second test - abusive registration. Confusing these two limbs will lead to less clear decisions and will result in less certain outcomes.

In any event, how would the strength of the complainant's rights be judged? Should they be judged subjectively or objectively? How could the strength of rights be measured? By the complainant's advertising spend; the distinctiveness of the mark; would registered rights trump unregistered rights and so on.

Given the problems inherent in judging the strength of rights in a consistent manner this proposal should not be implemented.

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

i) The current outlays for the DRS are minor in comparison to a trade mark dispute or other litigation. It therefore makes little difference how and when an expert decision is charged. A

modest up-front filing fee of, say, £100 would perhaps deter some frivolous claims and would not be objectionable to most complainants.

ii) It would be preferable for the loser to pay the costs of a complainant launching a complaint under the DRS. Such a system would help to deter abusive registrations. However, there are almost insurmountable problems in enforcing a loser-pays policy as discussed below.

**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?**

A system of "loser pays" would be almost unenforceable under the present system. Perhaps the only feasible system would be for the DRS to be updated so that the loser pays in defended cases with undefended cases being awarded to the complainant by default.

**Question 6 - miscellaneous**

**Procedure**

*i) Remove or alter the Reply stage of the DRS*

A respondent should be allowed to reply to the Complainant's response; effectively allowing each side two submissions. However, the time limit for replies should be restricted to avoid lengthening the DRS process.

**Drafting**

**Appeals**

*i) Shorten appeal timelines, so that a Notice of Intention to Appeal gives another two weeks, not another three weeks.*

Appeal timelines are currently satisfactory.

*ii) Allow new evidence to be introduced in Appeals, only if such new evidence is 'necessary' to deal with the case fairly.*

No new evidence should be allowed in appeals unless such facts couldn't have been known at the time of the initial submission. The appeal panel should have the power to accept or reject new submissions as they see fit.

**Expert decisions**

*i) Clarify how experts review evidence, how they weight evidence, and how to deal with issues raised by the experts performing their own research.*

If enforced, this proposal would erode the independence of experts and would draw Nominet into prescribing how decisions are made and decided. It is clear that Nominet should remain independent of the dispute process as far as possible.

*ii) Clarify how decisions can be corrected or amended – for example, to correct typographical errors.*

Nominet should check decisions for typographical errors and for basic formatting. Updates are then sent to the expert for approval before decision is published. After publication further

amendments should be noted on the published decision with the reasoning for such amendments noted.

*iii) Incorporate tests set out in previous decisions that experts routinely rely on or are likely to rely on (because they were in appeal decisions) so the information is in one place.*

Tests and precedents should not be objectively incorporated into the policy, otherwise Nominet will be entering the decision-making process. However, useful tests and precedents could be published on Nominet's site through an extension of Nominet's "typical cases" page to allow complainants and respondents easy access to important cases.

### **Abusive registrations**

*i) Include a likelihood of confusion as evidence of an abusive registration i.e. soften the test at 3(a)(ii) ('has confused').*

The threshold is currently very low in relation to showing evidence of actual confusion among web users, so this may be a useful change for the sake of clarity. Furthermore it is very difficult to show evidence of confusion - especially where that confusion has been wholly successful.

*ii) State that the abusive use does not have to be ongoing for the purposes of Policy 3(a)(iii) – it is enough that abusive use has occurred in the past.*

*iii) Clarify that a long delay in bringing a DRS case, where there is no adequate explanation, is likely to damage a complainant's chance of success.*

This is unnecessary. The Internet is still a relatively new industry and therefore it may have taken some time for an entity to become aware of the importance of the Internet and for them to be aware that their rights are potentially being infringed.

*iv) Clarify when rights have to exist to complain and to prove abuse.*

Further clarification, if there is not already enough clarification on Nominet's web site, of the rights required to bring a successful dispute could be beneficial.

### **Miscellaneous**

*i) Include anti-avoidance provisions for the 'three strikes' rule (Policy 3(c)).*

This is very important, but difficult to implement from a technical point of view. However, Nominet holds information on registrants that is not available to complainants that may show a link between registrants that may not be initially obvious. Such information, if available, should be provided to the expert who may judge if it is relevant to the dispute in hand.

*ii) Change the provisions dealing with communication and service of documents to take into account the new and potential extra online services*

Anyone who is willing to register a domain in the .uk space must make suitable provision to respond to a DRS within the existing time limits. It is not unreasonable for registrants to have a UK address or proxy where papers may be served quickly. This is a requirement in some ccTLDs including Germany where one point of contact must be located in the German jurisdiction.

If this is not enforced the system is open to abuse by registrants who use a foreign address of convenience.

*iii) Clarify the role of representatives.*

It is uncertain why this needs to be clarified. The DRS already allows adequate provision for representatives.

*iv) Add provisions to clarify how a DRS dispute and any processes arising out of the Industry Standards consultation could interact.*

It is uncertain if there are any parts of the Industry Standards consultation which directly relate to the DRS.

*v) Give both parties legal rights against each other if they make untrue statements in submissions.*

This would be a useful provision as it would deter frivolous complaints / defences by both complainants and respondents.

*vi) Whether experts can find a registration abusive for reasons not spelled out in the complaint.*

Experts should be allowed the discretion to find domains abusive for reasons that haven't been presented by the complaint. Similarly they should be allowed to find a domain is not abusive for reasons outwith the response.

*vii) Whether there have been any practical problems with the treatment of 'Without Prejudice' material.*

*viii) Whether experts should be able to represent parties in other disputes, and if not how to keep the quality of experts high.*

*ix) Whether the detail of the DRS can be taken out of the contract and updated more regularly.*

### **Other points arising**

- Domain should be retagged after a successful dispute to a complainant's chosen tag holder. Otherwise a domain can remain pointing to an infringing site for some time after a successful decision. A mechanism could be provided in the online complaint form for the complainant to nominate a tag holder for this purpose.
- Objectively include the issue of initial interest confusion into the DRS policy.

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