

**Nominet UK Dispute Resolution Service**

DRS 03844

**Stoneygate 48 Limited and Wayne Mark Rooney**

–v–

**Mr. Huw Marshall**

Decision of the Independent Expert

**1. Parties:**

Complainants: (1) Stoneygate 48 Limited and (2) Wayne Mark Rooney

Address: c/o Grant Thornton  
Heron House  
Albert Square  
Manchester

Postcode: M60 8QT

Country: GB

Respondent: Mr. Huw Marshall

Address: 17 Kings Oak Court  
Wrexham

Postcode: LL13 8QH

Country: GB

**2. Domain Name:** waynerooney.co.uk (“the Domain Name”).

**3. Procedural Background:**

The Complaint was lodged with Nominet on 21 July 2006. Nominet validated the Complaint and attempted to notify the Respondent of the Complaint on the same date. All communications from Nominet met with delivery failure, until on 11 August 2006 a representative of Trowers & Hamlin, Solicitors informed Nominet that they were acting on behalf of the Respondent and that the Respondent had updated contact details from those currently held by Nominet. They further informed Nominet that their client had not received the Complaint. In light of this information Nominet agreed to re-issue the Complaint on 11 August 2006 with a new response deadline on 25 August 2006. The Respondent entered a Response, which was received by Nominet on 24 August 2006. The Complainants were advised by Nominet of this Response on the same date and on 1 September 2006 a Reply was received from the Complainants.

Nominet initiated its mediation procedure on 1 September 2006. The mediation procedure proved unsuccessful and on 14 September 2006 Nominet wrote to the Complainants informing them that the matter could be referred to an Independent Expert for decision. On 20 September 2006 the Complainants paid Nominet the required fees for a decision of an Expert in accord with Paragraph 7 of the Nominet (UK) Dispute Resolution Service Policy (“the Policy”). On the same date Nominet contacted myself (Andrew Murray) to inquire whether I might provide an independent decision in this dispute. I formally confirmed to Nominet that I knew of no reason why I could not properly accept the invitation to act as an Expert in this case and further confirmed that I knew of no matters which ought to be drawn to the attention of the parties or which might appear to call into question my independence and/or impartiality. On 27 September 2006 I was appointed as Independent Expert for this dispute.

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

Due to incorrect contact details being held on file the original attempt to communicate the Complaint to the Respondent met with delivery failure. It is not the role of the Expert to determine who was at fault in this, although I note that Para.4.1 of the Nominet Terms and Conditions of Domain Name Registration require that registrants “give and keep us notified of your correct name, postal address and any phone, fax or e-mail information and those of your contacts”.

In this case, the initial failure of communication between Nominet and the Respondent was rectified due to a fortuitous independent communication with the Respondent. I am content that following re-issue the Complaint on 11 August 2006 and the extended deadline for response of 25 August 2006 a fair and equitable position for both Complainants and Respondent was realised. Having reviewed the full set of documents from both parties I am content to proceed to decision on this Complaint.

#### **5. The Facts**

- 5.1 The Lead Complainant, Stoneygate 48 Limited (hereafter “Stoneygate”), is a company registered under the laws of England and Wales (no.04380068). Stoneygate was incorporated on 22 February 2002 and was formed to exploit the “Wayne Rooney” name and image rights.
- 5.2 On 16 January 2003 the “Wayne Rooney” name and image rights were assigned to Stoneygate. Second Complainant Wayne Mark Rooney is one of three Directors of Stoneygate and is the sole shareholder of the company.
- 5.3 Stoneygate owns Community Trade Mark registration no.002989051 in the mark “Wayne Rooney”. The registration was filed on 23 December 2002 and was published on 25 June 2004.

- 5.4 Second Complainant Wayne Mark Rooney (hereafter “Rooney”) was born in Liverpool on 24 October 1985 and is currently a high profile footballer, with a worldwide reputation.
- 5.5 Rooney made his first appearance for the Everton FC Youth Football team on 26 August 2000. He enjoyed considerable success as part of the youth team, including reaching the FA Youth Cup final during the 2001/2002 season. It appears he was already regarded in 2000 as a rising star in the football profession.
- 5.6 Rooney has also represented England at a number of the different youth age groups, including: England Under 15 (2000/2001); England Under 17 (2000/2001); England Under 19 (2002/2003). Rooney made his debut for the full England team on 12 February 2003, aged 17 years and 111 days.
- 5.7 Rooney made his debut for the senior Everton team in August 2002 and on 19 October 2002 become the youngest goalscorer in the English Premiership. Rooney signed his first professional contract when he signed for Everton Football Club on 17 January 2003.
- 5.8 Rooney joined Manchester United Football Club in a deal worth £30 million on 31 August 2004 and has made over 80 appearances to date.
- 5.9 Once Rooney obtained a professional footballing contract he began to earn income through contracts for endorsement and advertising of products. Since then Rooney’s reputation and popularity has grown considerably and he is now one of the most famous footballers in the world and is the focus of massive media interest. Over the course of his professional career the goodwill attached to the “Wayne Rooney” name has increased as his status as a footballer has grown.
- 5.10 Rooney, through Stoneygate, currently has sponsorship from some of world’s most influential corporations and brands. The main commercial partners are the sportswear manufacturer Nike, the drinks manufacturer Coca Cola, the software company EA Sports, and the football club Manchester United. A further partnership exists with the publisher Harper Sport .
- 5.11 The Domain Name was registered on 16 April 2002 by the Respondent. The Domain Name is not currently in use.

## **6. The Parties’ Contentions**

### **Complainants:**

The Complainants contend that:

The Complainants have rights in the Domain Name because:

- 6.1 The Complainants, and particularly Wayne Rooney himself, have goodwill attached to the “Wayne Rooney” name which is protected in England and Wales

- under the common law of passing off. This goodwill has existed since Wayne Rooney's emergence as a rising talent in youth international and club football in 2000 and has grown into the strong right that it is today.
- 6.2 Stoneygate owns Community Trade Mark registration no. 002989051 of the mark "Wayne Rooney". The registration dates from 23 December 2002.
  - 6.3 Rooney was born in Liverpool on 24 October 1985 and has always usually been known by the name "Wayne Rooney". A copy of his passport confirms his personal name which he has used since birth.
  - 6.4 The Domain Name is identical to a name and mark in which the Complainants have rights.
  - 6.5 The Complainants have rights by registration and at common law in the name and trade mark "Wayne Rooney" in the United Kingdom (and equivalent rights elsewhere including in the rest of the EU), and as such have a legitimate basis to wish to register the disputed domain name.
  - 6.6 The Respondent is not related or connected to Rooney, nor to Stoneygate, and does not have the permission of the Complainants to use "Wayne Rooney" or variations thereof. As the Respondent is not related or connected to the Complainants there is no apparent reason or justification for his adoption of a domain name including as its distinctive element "Wayne Rooney".
  - 6.7 The Domain Name connects to a directory of "sponsored links" concerning a range of activities, including flights, royalty free photographs, ticket sales, music downloads, finance, soccer posters and online dating, thereby indicating that the Respondent is making financial gain from use of the Domain Name. The statement that these internet links are sponsored provides the false indication that there is authorisation or endorsement by the Complainants, and falsely associates the Complainants with activities such as finance and ticket sales.
  - 6.8 The use of the Domain Name by the Respondent shows that it is an Abusive Registration as:
    - (i) the Domain Name is a blocking registration; and/or
    - (ii) the Domain Name has intentionally been used by the Respondent in an attempt to attract for financial gain, internet users to the registrant's website or other online location, by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product or service on the Respondent's website.
  - 6.9 The registration of the Domain Name in April 2002 was at a time when Rooney's football career was taking off and he was the subject of considerable press coverage for his club and international youth football achievements. The

registration was a cynical attempt to block future registration of a promising young footballer's name. The registration has:

(i) stopped the Complainant from registering the domain name consisting of his given name, and has

(ii) stopped the Complainants from being able to exploit the "Wayne Rooney" name through use of such a domain name registration.

6.10 The Domain Name is a natural guess for a UK or other internet user looking for the authorised website of the Second Complainant. The absence of any relationship between the Respondent and the Complainants illustrates that there can be no legitimate or fair use of the Domain Name by the Respondent. The confusion and misleading of consumers is likely to be amplified by the Respondent's use of statements falsely implying an endorsement, affiliation or association with the Complainants, having potential to damage the goodwill and reputation in the "Wayne Rooney" name of the Complainants.

6.11 The Domain Name in the hands of the Respondent are abusive as: on the basis of ownership by the Complainants of trade mark rights by registration and at common-law to "Wayne Rooney", and in light of the foregoing reasons, the Domain Name is an Abusive Registration in that:

(i) it was registered in a manner which, at the time when the registration took place, took unfair advantage of and was unfairly detrimental to the rights of the Complainants, and/or

(ii) use of the Domain Name has taken, or will take, unfair advantage of, and be unfairly detrimental to, the rights and commercial interests of the Complainants.

**Respondent:**

The Respondent contends that:

6.12 The registration is not contrary to the Policy because:

(i) at the time of registration neither Complainant had any rights in the name – the rights simply did not exist. The Policy makes clear that rights must (1) be subsisting at the time of the Registration of the Domain Name and (2) belong to the Complainant.

(ii) even if the Complainants had rights dating back to the time of the registration, my registration did not take unfair advantage of nor was detrimental to those rights. The Domain Name was intended to be used for a "fan site", a legitimate, non-commercial, fair use.

6.13 Further the registration is not contrary to the Policy because:

(i) I have not subsequently used the Domain Name and Paragraph 3(b) of the Policy makes it clear that my non-use of the Domain Name does not constitute an Abusive Registration.

(ii) in any event the material is not abusive.

6.14 I first saw Rooney play for Everton in early 2002 in the Youth Team. I thought he was a striking new talent and kind of player who represented the future of Everton. I had the idea of setting up a non-commercial fan site which would relate both to Rooney and Everton. I registered the Domain Name on 16 April 2002.

6.15 I never got round to setting up the site. I never got to grips with the technology of setting up a website, and I found myself unable to devote the necessary time to the site.

6.16 Subsequently Rooney left Everton for Manchester United. As a result I lost interest in the idea of a fan site because it would no longer be possible to relate it to Everton.

6.17 I agree that the first Complainant owns Community Trade Mark registration no. 002989051 but the application was not made until 23 December 2002. The Rights of a CTM only date from the date of publication of the application which was on 25 June 2004.

6.18 I accept that **now** the Complainants have passing off rights in the name and accept for present purposes they own such rights.

6.19 As at April 2002 there were no unregistered rights because:

(i) Rooney's reputation was not sufficiently extensive at the time. A subsequently acquired reputation cannot support an action based on unregistered rights. See *Cadbury-Schweppes Pty. Ltd. v Pub Squash Co Pty. Ltd.* [1981] 1 WLR 193.

(ii) Rooney was not a trader as at that date, only an employee. As is clear from *Erven Warnink v Townend*, the fourth characteristic of passing off is that there must be a damage to the business or goodwill of the Claimant **as a trader**.

6.20 Notwithstanding Rooney's rightly recognised and admired talent, his rise to national and subsequently international stardom was neither a foregone conclusion nor such as to give Rooney unregistered rights as at 16 April 2002.

6.21 As regards the Complainants' claim that my registration is a 'blocking registration'. Obviously my registration of the Domain Name prevents the use of an identical domain name, but my purpose in registering the Domain Name was not to block the Complainants but to have a suitable name for my fan site. My registration does not prevent the Complainants from having a dominating presence

on the internet in relation to the name as they are free to use metatags to bring their website(s) to prominence in internet searches. Further there are plenty of other domain names available to the Complainants. Some of those names have since been registered, however the fact that cybersquatters (apparently) have taken those other names does not render my registration abusive, and the Complainants are free to get those names back.

- 6.22 I was not responsible for the content complained of on the site and I derived no financial or other benefit from it. I have been told by the registrar that this is its material and that it routinely places links to content of this nature on “blank” websites.
- 6.23 This content has now been removed. In any event even if I am held to be responsible for the content, I believe it is very clear from the content that it was not a site endorsed or approved by the Complainants.
- 6.24 I did not register the Domain Name for the purpose of selling, renting or transferring it to a competitor of the Complainants, nor to disrupt their business.
- 6.25 It is perfectly fair to set up a “fan website” devoted to a particular football player or club, and the natural and obvious name to use is a name which consists of, or includes the, name of the player or club. Two examples of such websites are: [www.waynerooneyonline.com](http://www.waynerooneyonline.com) and [www.david-beckham.ws](http://www.david-beckham.ws)

**Reply:**

In Reply the Complainants contend that:

- 6.26 The Respondent has made clear that he was aware of Complainant Rooney at the time of registering the Domain Name, and indeed registered the Domain Name **after** having watched Rooney play football for the Everton youth team in early 2002.
- 6.27 The Respondent also registered the domain name “waynerooney.com” at the same time as the Domain Name. If the respondent wished to register a legitimate fan site there is no real reason to register two domain names when one would suffice.
- 6.28 If the Respondent was unable or uninterested in setting up a legitimate fan website then there was no reason for the Respondent to renew his registration and pay renewal fees.
- 6.29 The Court of Appeal has held that placing a third-party owned distinctive name on an internet register amounted to passing off (*BT v One in a Million* [1999] FSR 1) as a misrepresentation of a connection or association with the owner of the goodwill in the name, and use of a domain name comprising of a third party’s distinctive name would amount to passing off.

- 6.30 The Respondent has alleged that the Complainants' had no unregistered rights at the time of registration of the Domain Name. There are a number of cases where individuals have established passing off rights in their personal name, e.g. *Irvine v Talksport* [2003] EWCA Civ 423. At the time of the registration of the Domain Name, the Second Complainant was a rising star within football circles and had played for the Everton and England youth teams. This, coupled with media exposure gave the Second Complainant goodwill in his name at the date of Registration.
- 6.31 The Respondent claims that the Domain Name is registered for use as a fan website. However the absence of any such use by the Respondent does not support this assertion. No further corroboration is provided by the Respondent.
- 6.32 The Respondent claims that he does not block the Complainants from having an internet presence as they could use other domain names or metatags to bring their website to prominence during internet searches. However the Respondent ignores the fact that the Domain Name is the natural choice for the Second Complainant given his personal name. It is also natural for users seeking the Second Complainant. It is absurd to suggest the Complainants use another domain name, particularly when the Respondent has no right, legitimate interest or connection to the name "Wayne Rooney".
- 6.33 Paragraph 4 of the DRS Policy provides details of how the Respondent may demonstrate that the Domain Name is not an Abusive Registration. The Respondent has not established any of these factors are applicable in this case and the unsubstantiated allegation that he wished to set up a fan site some four years ago is insufficient. The Respondent has made clear that he was unable to set up a fan website, and indeed lost interest in doing so two years ago. He has however maintained ownership of the Domain Name and waynerooney.com.

## **7. Discussion and Findings**

### **7.1 General**

According to Paragraph 2 of the Policy, in order to succeed in this Complaint, the Complainant has to prove to the Expert that, on the balance of probabilities:

- 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.

### **7.2 Complainant's Rights**

Rights are defined in the Policy as including, but not limited to, rights enforceable under English law.

The issue of whether or not the Second Complainant, Wayne Mark Rooney, had rights in the name at the date of registration of the Domain Name has been challenged by the Respondent. The Respondent, in particular claims that:

As at April 2002 there were no unregistered rights because:

(i) Rooney's reputation was not sufficiently extensive at the time. A subsequently acquired reputation cannot support an action based on unregistered rights. See *Cadbury-Schweppes Pty. Ltd. v Pub Squash Co Pty. Ltd.* [1981] 1 WLR 193.

(ii) Rooney was not a trader as at that date, only an employee. As is clear from *Erven Warnink v Townend*, the fourth characteristic of passing off is that there must be a damage to the business or goodwill of the Claimant **as a trader**.

(iii) The Policy makes clear that rights must be subsisting at the time of the Registration of the Domain Name. At the time, Rooney had no such rights. Even if he did, the Policy does not permit the Complainant to rely on these rights, because at the time they were not the Complainants' rights.

Further he claims that the Community Trade Mark owned by the Lead Complainant must be ruled out as:

The application was not made until 23 December 2002. The Rights of a CTM only date from the date of publication of the application which was on 25 June 2004.

In reply the Complainant states that:

The Respondent has alleged that the Complainants had no unregistered rights at the time of registration of the Domain Name. There are a number of cases where individuals have established passing off rights in their personal name, e.g. *Irvine v Talksport* [2003] EWCA Civ 423. At the time of the registration of the Domain Name, Complainant Rooney was a rising star within football circles and had played for the Everton and England youth teams. This, coupled with media exposure gave Complainant Rooney goodwill in his name at the date of Registration.

The Court of Appeal has held that placing a third-party owned distinctive name on an internet register amounted to passing off (*BT v One in a Million* [1999] FSR 1) as a misrepresentation of a connection or association with the owner of the goodwill in the name, and use of a domain name comprising of a third party's distinctive name would amount to passing off.

I rather think that both parties have gone somewhat off point in contesting this issue in this manner. Although the question of whether the Second Respondent had sufficient goodwill

in his name as at 16 April 2002 to sustain a claim in passing off may be an issue for the courts in a claim such as this, and although it is arguable that as an employee he was not in a position to develop this goodwill at this time; it is clear from Paragraph 1 of the Policy that the DRS takes a less restrictive view of “rights”:

“Rights includes, but is not limited to, rights enforceable under English law”.

As was noted by the Expert in *J F Home Improvements Ltd. v Mr. David Giddy* (DRS 03051) the words “includes, but is not limited to” mean that the Policy contemplates rights in a name that are not enforceable under English law.

With this established, and taking direction from the comment of the Appeal Panel in *Seiko UK Limited v. Designer Time/Wanderweb* (DRS 00248) that: “the requirement to demonstrate ‘rights’ is not a particularly high threshold test” and with reference to Nominet UK’s *Dispute Resolution Service Complaint Form Help Page* which at the paragraph entitled “Rights in a name or mark” gives the following advice to the Complainant:

*(Demonstrating) Rights in a name or mark:*

- (1) A description of the Rights you are asserting, this could be that:*
- a) The Domain Name is identical or similar to your company name.*
  - b) The Domain Name is identical or similar to your trade mark.*
  - c) The Domain Name is identical or similar to your trading name.*
  - d) The Domain name is identical or similar to your personal name.*

I find that the Second Complainant, Wayne Mark Rooney, had rights in the term “Wayne Rooney” enforceable under Paragraph 2(i)(a) of the Policy on 16 April 2002 as this was his personal name, and was the name by which he had been known since birth on 24 October 1985. Further by assignment dated 16 January 2003, the Second Complainant passed to the Lead Complainant an interest in the rights he held in the name or mark “Wayne Rooney” at that time. Thus I find that both Complainants have rights in the name “Wayne Rooney”, and that such rights were in place on 16 April 2002.

### **7.3 Abusive Registration**

To be an Abusive Registration the Domain Name must be one which either:

“...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 of the Policy)

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 primarily;
  - A. 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. 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. The Complainant can demonstrate that the Respondent is engaged in a pattern registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;
- iv. It is independently verified that the Respondent has given false contact details to us; or
- v. The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
  - A. Has been using the Domain Name registration exclusively, and
  - B. Paid for the registration and/or renewal of the Domain Name Registration.

In their complaint, the Complainants rely primarily upon Paragraph 3(a)(i)(B).

### **7.3.1. Blocking Registration**

This claim is therefore central to this dispute. The Respondent has made no use, or preparation to use, the Domain Name which means that the Complainants are unlikely to succeed in a claim with regard to the Domain Name names under the other heads of claim found in Paragraph 3 of the Policy.

The Complainants are required to establish that the Respondent has “registered or otherwise acquired the Domain Name; *primarily* as a blocking registration against a name or mark in which the Complainants have Rights.”

The burden of proof thus rests initially with the Complainants and this burden requires them to discharge not simply that the Domain Name may act as a blocking registration, but that this was the primary intent of the Respondent at the time the registration was made.

This issue was discussed in the Appeal decision *Viking Office Products Inc. v Wenda Sparey* (DRS 02201), where the majority panelists noted that “It is for the Complainant to prove on the balance of probabilities that the Domain Name, in the hands of the Respondent, is an Abusive Registration, that is that the Respondent is taking unfair advantage of, or is unfairly detrimental to the Complainant’s rights”. In that decision, the majority panelists noted that such decisions were often difficult to reach because of a lack of available evidence presented by the Complainant. This case is one such case where the Expert finds that he is being called upon to weigh two quite different explanations of events from the two parties.

### **7.3.1.1 Paragraph 3(a)(i)(B)**

Firstly do the Complainants discharge their burden of proof?

The Complainants note that the Domain Name forms part of a wider pattern of registrations by the Respondent which also includes the domain name waynerooney.com, registered on the same date. In addition, the Complainants note that:

“the registration of the Domain Name in April 2002 was at a time when Rooney’s football career was taking off and he was the subject of considerable press coverage for his club and international youth football achievements” and that “the Domain Name is a natural guess for a UK or other internet user looking for the authorised website of the Complainant, Rooney.”.

Later in their reply the Complainants note that:

“The Respondent has made clear that he was aware of Complainant Rooney at the time of registering the Domain Name, and indeed registered the Domain Name after having watched Rooney play football for the Everton youth team in early 2002.” Further the Complainants reject claims made by the Respondent that he was planning to make legitimate use of the Domain Name, noting: “if the Respondent was unable or uninterested in setting up a

legitimate fan website then there was no reason for the Respondent to renew his registration and pay renewal fees in 2004” and “The Respondent claims that the Domain Name is registered for use as a fan website. However the absence of any such use by the Respondent does not support this assertion. No further corroboration is provided by the Respondent.”

Finally the Complainants suggest that the Domain Name is of particular value to the Complainants and that the Respondent’s registration of it affects their ability to be found on the internet:

“the Respondent claims that he does not block the Complainants from having an internet presence as they could use other domain names or metatags to bring their website to prominence during internet searches. However the Respondent ignores the fact that the Domain Name is the natural choice for the Second Complainant given his personal name. It is also natural for users seeking the Second Complainant. It is absurd to suggest the Complainants use another domain name, particularly when the Respondent has no right, legitimate interest or connection to the name “Wayne Rooney””.

There are two compelling pieces of evidence among these claims. The first is the admission of the Respondent that he registered the Domain Name after watching Wayne Rooney play for the Everton youth team. This is compelling not only of the fact that he had the Second Complainant specifically in mind when he registered the Domain Name, but also speaks to Mr. Rooney’s particular right and interest in the name “Wayne Rooney” in April 2002. The second is the failure by the Respondent to take any steps to develop the fan site he suggests he had in mind between April 2002 and August 2004, and further his decision to retain the registration when he had already decided to abandon the project in August 2004 when Rooney left Everton for Manchester United. I believe these two factors are sufficient to create a *prima facie* case that this is a blocking registration.

### **7.3.1.2 Paragraphs 4(a)(i)(C) and 4(b)**

Under Paragraph 4(a)(i) of the Policy a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is provided. These are:

- i. Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has:
  - A. used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;
  - B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

- C. made legitimate non-commercial or fair use of the Domain Name

Further, under Paragraph 4(b), the Policy states that: “Fair use may include sites operated solely in tribute to or in criticism of a person or business.”

In response, the Respondent claims that the Domain Name was intended to be used for a “fan site”, a legitimate, non-commercial, fair use. This appears to be a claim under Paragraphs 4(a)(i)(C) and 4(b). Crucially, though, the Respondent provides no evidence in support of this assertion.

As was noted by the majority panelists in *Viking Office Products, Inc. v Wenda Sparey* (DRS 02201), “where a domain name is used as the URL for a website pertaining to a fictitious or non-genuine business this would be a factor which would very much lead to negation of the test in Paragraph 4(a)(i)(A) of the Policy.” I believe the same principles would, and should, extend to Paragraph 4(a)(i)(C): that is where a domain name is registered for use as the URL for a website pertaining to a fictitious or non-genuine non-commercial site this would be a factor which would very much lead to negation of the test in Paragraph 4(a)(i)(C) of the Policy.

The Respondent’s failure to develop the fan site he suggests he had in mind also undermines his defence under Paragraph 4(b). Paragraph 4(b) clearly envisages a situation where the Domain Name is being actively used: “Fair use may include sites **operated** solely in tribute to or in criticism of a person or business.” There is currently, nor has there ever been on the Respondent’s own admission, any site operated at the Domain Name. Therefore the defence available under Paragraph 4(b) is not made out.

On the basis of the foregoing analysis it is my opinion that with the evidence available to me the Respondent has failed to discharge the burden of proof that arose once the Complainants made their *prima facie* case that, on the balance of probabilities, the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Having examined all the materials available to me I find that the Complainants have rights in terms of Paragraph 1 of the Policy and Procedure and that on the balance of probabilities I find that the Complainants have proven their claim under Paragraph 3(a)(i)(B) of the Policy. Further I find that the Respondent has failed to satisfactorily rebut the claim that the registration in the hands of the Respondent is an Abusive Registration.

#### **7.4 Finding**

Accordingly, the Expert finds that the Domain Name is an Abusive Registration as defined by Paragraph 1 of the Policy on the basis that it is being used as a blocking registration in contravention of Paragraph 3(a)(i)(B) of the Policy and is therefore being used in a manner which takes unfair advantage of the Complainants’ rights.

## **8. Decision:**

In light of the foregoing findings, namely that the Complainants have rights in respect of name which are 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, waynerooney.co.uk, be transferred to the Lead Complainant.

Andrew Murray

Date: 5 October 2006