

DISPUTE RESOLUTION SERVICE

D00014704

Decision of Independent Expert

Mr Aston Merrygold

and

Mr Martyn O'Brien

1. The Parties:

Lead Complainant: Mr Aston Merrygold
c/o Messrs Lee & Thompson Solicitors
4 Gee's Court
St Christopher's Place
London
W1U 1JD
United Kingdom

Respondent: Mr Martyn O'Brien
16 Jersey House
Clifton Road
Islington
London
N1 2JF
United Kingdom

2. The Domain Name:

astonmerrygold.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the Parties.

The dispute was received by the Dispute Resolution Service (DRS) on August 26, 2014 and the Complaint was validated on the same date. Notification of the Complaint was sent to the

Parties on August 26, 2014. The Response was received on September 17, 2014 and notification of the Response was sent to the Parties on the same date. No Reply to the Response had been received by September 25, 2014.

The Mediator was appointed on September 25, 2014, and mediation started on October 1, 2014. Mediation failed and the Close of Mediation documents were sent on October 7, 2014. Expert decision payment was received on October 8, 2014.

4. Factual Background

Factual information about the Complainant is taken from information provided in the Complaint.

The Complainant, an individual, is a British entertainer, singer, dancer and television personality known by his personal name, Aston Merrygold. He was a member of a band called JLS (Jack the Lad Swing) that was runner-up in the Independent Television (ITV) talent show *The X Factor*, the final of which was shown on December 13, 2008, which had 14 million viewers. The Domain Name was registered the following day. JLS also won awards titled *British Breakthrough* and *British Single* at the 2010 BRIT Awards and *Best Song* and *Best Newcomer* at the 2009 MOBO Awards. The band sold more than 10 million records worldwide.

The Complainant has produced a list of appearances in entertainment under the name Aston Merrygold, which are recorded at the website of the Internet Movie Database (IMDB), and draws attention to the following which are mostly post-2008:

2002, British TV: *Stars in Their Eyes Kids*
2004, *Cookie* in *CITV's Fun Song Factory*
Britannia High (TV Series)
Xposé (TV Series)
The New Paul O'Grady Show (TV Series)
The All Star Impressions Show (TV Movie)
Live from Studio Five (TV Series)
Breakfast (TV Series)
Newsround (TV Series)
Eurovision Song Contest: Your Country Needs Blue (TV Movie documentary)
National Movie Awards (TV Movie)
The Saturdays: What Goes on Tour... (TV Series)
The Jonathan Ross Show (TV Series)
Daybreak (TV Series)
Soccer Aid (TV Mini-Series)
Strictly Come Dancing: It Takes Two (TV Series documentary)
Alan Carr: Chatty Man (TV Series)
This Morning (TV Series)
Never Mind the Buzzcocks (TV Series)

Other achievements of the Complainant include:

Judge, Sky Television *Got to Dance* talent competition
Ambassador for the UK charity *Beat Bullying*
Featuring in BBC's *Children in Need 2010*
Featuring in Coca Cola Company's *Share a Coke* advertising campaign

Information about the Respondent is taken from the Response and the Complaint.

The Respondent is an individual and does not state his business in any material way. He is the registrant of domain names including:

astonmerrygold.co.uk	registered December 14, 2008, the disputed Domain Name
astonmerrygold.com	registered December 14, 2008
oritsewilliams.co.uk	registered December 14, 2008
oritsewilliams.com	registered December 14, 2008
marvinhumes.co.uk	registered December 14, 2008
marvinhumes.com	registered December 14, 2008
stevebarringer.com	registered December 15, 2011
nickperelli.co.uk	registered September 27, 2012
paigethomas.co.uk	registered September 27, 2012

5. Parties' Contentions

A. Complainant

The Complainant says his name is uncommon. According to the Office of National Statistics, only 41 people in the UK had the surname Merrygold in 2002, and Aston was the 259th most popular first name in the UK in 2012.

The Complainant contends that he has rights under the Policy in the name Aston Merrygold, to which the Domain Name is effectively identical since the directory and country codes ".co.uk" are customarily not taken into account. He says that his rights are enforceable because since 2002 he has conducted a trade or business as an entertainer under the name Aston Merrygold. His name comprises a unique and distinctive identifier for a range of commercial services in which he has built up significant goodwill and reputation. The Complainant says that his membership of the band JLS under his name Aston Merrygold has enhanced his fame.

The Complainant contends that his name has acquired the status of an unregistered trade mark to which he holds the rights and which is enforceable under English law relating to passing off.

The Complainant further contends that the Domain Name has constituted an Abusive Registration under the Policy both at the time of registration and by the manner of its use. At the time of registration of the Domain Name the Respondent must have had knowledge of the rights of the Complainant, who had at that time been notorious for some years. The Domain Name was registered shortly after the Complainant had featured in the TV programme *The X Factor* as a member of the band JLS. Furthermore, on the same date, the Respondent also registered the domain names oritsewilliams.co.uk and marvinhumes.co.uk, corresponding to the names of two of the other three members of the band JLS, namely Oritsé Williams and Marvin Humes. Also on the same date the Respondent registered the .com versions of all three names, i.e., astonmerrygold.com, oritsewilliams.com and marvinhumes.com.

The Complainant contends that the Respondent's usage of the domain name astonmerrygold.com is indicative of its commercial use by the Respondent or a related entity, although it is not the disputed Domain Name. No historical record of astonmerrygold.co.uk has been found in archival websites such as archive.org and screenshots.com. Astonmerrygold.com, in 2010, was redirected to geniefashion.co.uk, a website that, at least in 2009, sold T-shirts and apparel. Furthermore, geniefashion.co.uk was registered on September 23, 2007 to Rsite Ltd., a director of which had the same name as the Respondent, according to a document obtained from CompanyCheck produced in evidence, and so the Complainant draws the inference that this person was the Respondent.

The Complainant contends that a file of correspondence with the Respondent, produced in evidence, shows commercial intentions for the Domain Name on the part of the Respondent. The Respondent states no substantive plans for the Domain Name but writes about it not making "commercial sense" to transfer it for registration costs, writes about the generation of "ongoing residual income" from the Domain Name, and offers the Complainant a joint venture that would generate "revenue from sales, membership and advertising".

The Complainant further contends that the Domain Name has been used abusively since registration. The correspondence from the Respondent contains what effectively amounts to a threat to use the Domain Name in a manner likely to confuse people or businesses into believing it to be registered to or endorsed by the Complainant. Given the use the Respondent has made of the domain name *astonmerrygold.com*, the Complainant believes the threat to be real and genuine in respect of *astonmerrygold.co.uk*.

The Complainant contends that, following previous decisions under the Policy, passive holding of the Domain Name, if so found, should not detract from a finding of Abusive Registration.

The Complainant contends that the Respondent has engaged in a pattern of the registration of domain names, whether .uk or otherwise, that correspond to well known names or trade marks in which the Respondent has no apparent rights, and the disputed Domain Name is a part of that pattern.

The Complainant has produced a list of the Respondent's domain names that are inferred to constitute a pattern, with reasons. *Astonmerrygold.co.uk*, *astonmerrygold.com*, *oritsewilliams.co.uk*, *oritsewilliams.com*, *marvinhumes.co.uk* and *marvinhumes.com* were all registered on December 14, 2008, the day after *The X Factor* final appeared on TV, and are the names of people who were all at that time members of the band JLS.

Nickperelli.co.uk and *paigethomas.co.uk* contain the names of *The X Factor USA* finalists, registered shortly after their appearances, the name of Nick Perrelli being misspelt.

Stevebarringer.com was registered on December 15, 2011, the date of Steve Barringer's appearance in the final of *MasterChef*.

The Complainant says all these domain names relate to people who have attained celebrity status, at least in part, through their participation in popular TV programmes. It is submitted that on the balance of probabilities the Respondent selected the names in anticipation that these people would become famous.

The Complainant refers to paragraph 6(a) of the Policy, to the Expert Overview, and to previous decisions, and contends that communications from the Respondent marked "without prejudice", that were not generated in Informal Mediation, should be treated as admissible to this proceeding for the Expert to decide whether to take into account. The Complainant submits that statements of intent should be capable of being relied upon even if marked "without prejudice" as they have nothing to do with settlement concessions and are likely to be a key consideration for the Expert.

The Complainant has cited a number of previous decisions under the Policy that he considers to support his case.

The Complainant requests the transfer to himself of the Domain Name.

B. Respondent

The Respondent denies the Complaint and says the claim of abusive registration is not true in any way.

The Respondent contends that the Complainant had the opportunity to register the Domain Name for many years prior to 2008, when it was freely available, but did not do so. The Respondent says the Complainant could have contacted the Respondent or previous owners of the Domain Name in the past six years.

As to any act of registration that may have taken unfair advantage of or was unfairly detrimental to the Complainant's rights at the time of registration or acquisition of the Domain Name, the Respondent contends this is not the case as the Complainant had not himself registered the Domain Name and only enquired about it in the past few months.

As to any use of the Domain Name in a manner that may have taken unfair advantage of or was unfairly detrimental to the Complainant's rights, the Respondent says he has not used the Domain Name to build a website, therefore it has not been used in any detrimental way.

The Respondent contends that the Complainant has had a very good career without the Domain Name.

The Respondent says he was shocked by the manner of the Complainant's representatives in correspondence. He has tried to work with the Complainant, without success.

6. Discussions and Findings

Paragraph 2(a) of the Policy requires the Complainant to prove, 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.”

Complainant's Rights

The onus is upon the Complainant to prove that he has rights in respect of a name or mark. He makes no claim to rely on a registered trade mark in respect of Aston Merrygold, which happens to comprise his real first and last names and is the name by which clearly he is known.

The Complainant has produced an extensive list of his appearances as an entertainer from 2002 until the present (2014) as listed in a screen shot of the website Internet Movie Database (IMDB) and selectively in section 4 above. Several appearances are marked as available to be viewed on YouTube. The Complainant's appearances have included televised talent shows, several other popular TV shows such as *The Jonathan Ross Show* and *Strictly Come Dancing*, as one of the four members of the band JLS that sold 10 million records, and in advertisements for instance for Coca Cola. He has appeared in other productions and in good-cause campaigns such as *Beat Bullying*.

Rights for the purposes of the Policy are defined in paragraph 1 of the Policy as follows:

“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”.

Many of the Complainant's listed appearances have earned fees or payments that confirm the name Aston Merrygold to have commercial value. Before the registration date of the Domain Name in late 2008 the Complainant's performances had included TV shows in 2002 and 2004, the activities of the JLS band, and five episodes of the popular TV show *The X Factor* including the final. The Complainant had acquired by that time the right to protect his name and reputation from impersonation, dilution or commercial exploitation by others. In the Expert's finding, the Complainant already held rights that satisfied paragraph 2(a)(i) of the Policy at the time of registration of the Domain Name by the Respondent.

The wording of paragraph 2(a)(i) of the Policy, however, is in the present tense and requires that the Complainant “has” the prescribed rights in a name or mark. On the evidence, it is clear that the Complainant's public visibility and rights in his name have increased substantially since the dates of the final of *The X Factor* on December 13, 2008 and the registration of the Domain Name the next day.

Identity or Similarity

The Expert finds the operative part of the Domain Name astonmerrygold.co.uk to be effectively identical to the name Aston Merrygold in which the Complainant has rights.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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.”

Paragraph 3(a) of the Policy sets out a non-exhaustive list of circumstances that may be evidence that the Domain Name is an Abusive Registration, which reads in part as follows:

- “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 or threatening to use the Domain Name in a way which has confused or is likely to confuse 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 of 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”.
- (.....)

It is noted that the Respondent has denied making use of the Domain Name, in the following terms: “With regards to point 2 [relating to paragraph 1(ii) of the Policy], I have not used this domain name to build a website and so it has not been used in a manner which took advantage or was detrimental in anyway”. The Complainant has not offered evidence of the Domain Name having been used for a website. Whilst the Respondent's inaction may be insufficient to avoid a finding that the Domain Name has nevertheless been in use within the meaning of paragraph 1(ii) of the Policy, it is the circumstances surrounding the act of registration or acquisition of the Domain Name under paragraph 1(i) of the Policy that will be the main focus of this discussion.

It is also noted that the Respondent referred enigmatically to “previous owners”, as follows: “They [Complainant] could have registered this domain name prior to 2008 and could have contacted me or previous owners at anytime in the last 6 years”. The Respondent has made no formal denial that he was the initial registrant of the Domain Name, but if he acquired it

later, then such comments below as pertain to the time of registration of the Domain Name shall apply equally to the event of its acquisition by the Respondent.

The Respondent's assertion that the Complainant took no action to register the Domain Name ahead of the Respondent, and did not contact the Respondent until now, is of no consequence. No period of limitation is decreed by the Policy and there is no suspicion that the Complainant delayed making the Complaint deliberately in order to increase the discomfiture of the Respondent.

On the facts found to be proven by the evidence, the Domain Name was first registered on December 14, 2008, being the day after the Complainant appeared on TV in *The X Factor* show as a member of the band JLS, which was the runner-up. The Respondent's name is not Aston Merrygold but Martyn O'Brien, he has not claimed any connection with the Complainant or any similarly named entity, and has not offered any acceptable justification for registering the Complainant's name as the Domain Name.

A common pattern in similar disputes is for an abusive registrant, who has in mind to sell or rent a domain name to the relevant trade mark owner, to try to avoid a clear finding against them under paragraph 3(a)(i)(A) of the Policy by waiting for an approach from the trade mark owner. The Respondent has spent money on buying and maintaining the Domain Name and it may reasonably be concluded that he expects some eventual return. He has indicated such an intention in his emails to the Complainant.

The relevant emails from the Respondent are headed "without prejudice". The Respondent, having been served with and responded to the Complaint, has not contested the Complainant's intention to rely on the Respondent's "without prejudice" communications. The Expert will follow the guidance provided by the Appeal decision in *Hanna-Barbera Productions, Inc v Graeme Hay*, Nominet DRS Case No. 00389, as to why "without prejudice" communications should generally be admissible in the circumstances.

On March 4, 2014, the Respondent wrote that he had turned down substantial offers for the Domain Name in favour of his own plans, showing he placed a substantial value on the Domain Name. He wrote of generating residual income from the Domain Name, and of its possible co-ownership with the Complainant, thereby showing a readiness to sell, or to sell a share of, or to rent access to, the Domain Name.

On March 6, 2014, the Respondent wrote to the Complainant in terms of a joint venture that would generate sales, membership and advertising, and which would therefore be commercial.

In an email to the Complainant dated March 8, 2014, the Respondent used the phraseology "... I have invested in the domain name", which may reasonably be taken to indicate the expectation of a return on the investment.

The Expert finds on the balance of probabilities that the Respondent acquired the Domain Name in order to take unfair advantage of the Complainant's rights and to gain commercially, either from the Complainant or from another, by exploitation of the value accrued (and at the time clearly likely to continue accruing) in the Complainant's name, constituting Abusive Registration within the meaning of paragraphs 1(i) and 3(a)(i)(A) of the Policy. The Expert further finds that the Domain Name presently constitutes a blocking registration and Abusive Registration in the terms of paragraph 3(a)(i)(B) of the Policy.

The Respondent acquired, contemporaneously with the disputed Domain Name, the domain names *oritsewilliams.co.uk*, *marvinhumes.co.uk*, *astonmerrygold.com*, *oritsewilliams.com* and *marvinhumes.com*, containing the names of the Complainant and two fellow JLS band members. The Respondent later acquired the domain names *nickperelli.co.uk* (taken to refer to Nick Perelli), *paigethomas.co.uk* and *stevebarringer.com*, all after the people by those names had appeared on TV. The inescapable conclusion is of a scheme by the Respondent to invest opportunistically in domain names of a similar type or character in that they reflected the names of entertainers who had appeared promisingly on TV and whose fame might

increase. The Expert finds Abusive Registration of the disputed Domain Name additionally under paragraph 3(a)(iii) of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in respect of the name Aston Merrygold; that the disputed Domain Name astonmerrygold.co.uk is identical to the Complainant's name; and that the disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name astonmerrygold.co.uk is ordered to be transferred to the Complainant.

Signed Clive Trotman

Dated October 22, 2014