



NOMINET

Dispute Resolution Service

DRS 17376

Mathan Coomaraswamy

and

Stuart Moss

Decision of Independent Expert

1 Parties

Complainant: Mathan Coomaraswamy

Address: Jetview Properties Ltd., Argyle House,
3rd Floor Northside, Joel Street,
Northwood Hills, Middlesex

Postcode: HA6 1NW

Country: United Kingdom

Respondent: Stuart Moss

Address: Jetview Properties Ltd., Argyle House,
Joel Street, Northwood

Postcode: HA6 1NW

Country: United Kingdom

2 Domain name

<undergroundliving.co.uk>

3 Procedural History

- 3.1 On 22 April 2016 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent on the 25 April 2016. No response was received. The complainant requested referral of the matter for expert decision under the Procedure, and on 1 June 2016 paid the applicable fee.
- 3.2 I was appointed as expert on 6 June 2016. I have made the necessary declaration of impartiality and independence, confirming that I am independent of each of the parties and that 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

4 Factual background

- 4.1 The domain name was registered by the respondent in 2009. It appears from the evidence that the contact name in relation to that registration was changed in April 2015 (making the complainant the contact) and changed back in April 2016 (making the respondent the contact again). But the registration itself has never been transferred.

5 Parties’ Contentions

Complainant

- 5.1 The complainant says an agreement was signed in March 2015 between himself and the respondent to transfer all rights to the website <undergroundliving.co.uk> from the respondent to him.
- 5.2 He says he then registered a web hosting account in his own name, and registered the domain name with a new registrar. Since April 2015, he says, he has been managing the domain name, including commissioning a new website design.
- 5.3 The complainant says in April 2016 he received an email from Nominet informing him that the respondent had removed him as the contact for the domain name, That indicated to the complainant that the domain name had not been transferred.
- 5.4 The complainant says he contacted the respondent asking him to finalise the transfer. He says the respondent replied that he would not carry out his agreement to transfer the domain, for reasons the complainant describes as “frivolous”.

Respondent

5.5 There is no response.

6 Discussion and Findings

General

6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities that:

- it has rights in respect of a name or mark which is identical or similar to the domain name, and that
- the domain name, in the hands of the respondent, is an abusive registration.

Rights

6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise. They may include rights in descriptive terms which have acquired a secondary meaning.

6.3 At the third level (i.e. disregarding “.co.uk”) the domain name can be read, and in my view is most naturally read, as consisting of a two-word phrase, “underground living”.

6.4 The complainant asserts no registered trade mark similar to the domain name. Nor does he argue that the term “underground living” has acquired a secondary meaning denoting him or his products or services.

6.5 The rights asserted by the complainant arise in connection with a contract. He says there was an agreement to transfer it, and implies that he assumed he owned the domain name before being contacted by Nominet in April 2016.

6.6 The evidence produced by the complainant (including one page from a written contract showing the terms of an “addendum agreement”) supports his claim that the respondent agreed to transfer to him all rights to the website <undergroundliving.co.uk>, apparently in return for his professional services. Emails he has produced (dated 29 April and 15 November 2015) suggest he was given access enabling him to transfer the hosting of the website connected to the domain name. Other emails he has produced (dated 14 and 19 April 2016) tend to support his contention that the respondent has refused to transfer registration of the domain name.

6.7 The definition of rights in the Policy does not exclude contractual rights to the domain name itself. However where the right is disputed or the surrounding circumstances are complex (as they appear to be here), the complaint may be

rejected as not being appropriate for adjudication under the Policy.

- 6.8 In my view the complexities here are as follows. First, I'm not sure it's absolutely beyond dispute that the wording of the "addendum agreement" produced by the complainant, which provides that his fees will be

off-set against the transfer of all rights to the website "UndergroundLiving.co.uk" belonging to Mr Stuart Moss and Mr Stuart Moss will have no involvement or rights to the website or associated name

was in fact an agreement to transfer the registration of the domain name. I say this partly because the complainant has produced emails from himself (dated 25 March 2015) and from the respondent (apparently dated 26 March 2015) which taken together seem ambiguous on the point; and another email from the respondent (dated 14 April 2016) which can be read as suggesting the respondent thought the domain name itself was to remain his property.

- 6.9 Second, on the limited evidence before me I cannot make a finding that the complainant performed his own obligations under the agreement (something the evidence shows the respondent disputed) or that the circumstances were such as to make the respondent's actions a breach of contract, or unjustified and abusive in terms of the Policy.
- 6.10 I note that the complainant does not say the registration is abusive for any reason other than the alleged breach of contract. Both aspects of this dispute—the question of rights and the question of abuse—turn entirely on contractual issues.
- 6.11 As the appeal panel said in *David Munro v Celtic.com Inc* (DRS 04632 <*ireland.co.uk*>), as a general proposition contractual disputes are best left to the courts to resolve. The appeal panel went on to say that pure contractual disputes of this kind are outwith the scope of the Policy. It is clear from the appeal panel's reasoning that it was concerned that DRS experts could not resolve such issues fairly. The appeal panel's decision in the *Ireland* case is not binding on me, but does have persuasive force.
- 6.12 This contractual dispute is in my view best left to a court. I do not think a DRS expert can fairly determine these parties' contractual rights and obligations for DRS purposes.
- 6.13 I am therefore, as the *Ireland* appeal panel put it, unable to satisfy myself on the balance of probabilities that the complainant has rights in the domain name.
- 6.14 It might be argued in support of the complainant's assertion of rights that this case raises issues analogous to those mentioned in paragraph 3(a)(v) of the Policy.
- 6.15 Paragraph 3(a)(v) of the Policy provides that it may be evidence of abusive registration where the domain name was registered as a result of a relationship between the complainant and the respondent, and the complainant has been using the domain name registration exclusively and paid for its registration and/or

renewal.

- 6.16 It might also be argued that the underlying assumption of paragraph 3(a)(v) is that such circumstances, reflecting a contractual or similar relationship between the parties, may have given rise to rights in respect of the domain name.
- 6.17 Here, however there is no evidence that the domain name was registered as a result of a relationship between the complainant and the respondent.
- 6.18 In addition in my view, paragraph 3(a)(v) of the Policy deals only with possible evidence of abusive registration. The two requirements to prove rights and abusive registration are distinct under the Policy. It follows that rights must be independently demonstrated before paragraph 3(a)(v) of the Policy can be relied on. Paragraph 3(a)(v) does not create a special exemption from the requirement to prove the existence of rights, and cannot be used on its own as the basis of a finding that the complainant has rights in respect of the domain name.
- 6.19 In those circumstances, I am not satisfied that the complainant has rights in respect of a name or mark identical or similar to the domain name.

7 Decision

- 7.1 I do not find that the complainant has rights in a name or mark which is identical or similar to the domain name.
- 7.2 The complaint must therefore fail. It is not necessary to consider whether the domain name, in the hands of the respondent, is an abusive registration. As I mentioned above at paragraph 6.10 the question of abuse, like the question rights, would turn entirely on contractual issues.
- 7.3 I direct that no action be taken.

Carl Gardner

8 July 2016