

DISPUTE RESOLUTION SERVICE

D00018089

Decision of Independent Expert

Russam GMS Limited

and

Identity Protect Limited

1. The Parties:

Lead Complainant: Russam GMS Limited
19, Eleanor's Cross
Dunstable
Bedfordshire
LU6 1SU
United Kingdom

Additional Complainant: Trustees Unlimited LLP
10 Queen Street Place,
London,
EC4R 1BE

Respondent: Identity Protect Limited
PO Box 795
Godalming
Surrey
GU7 9GA
United Kingdom

2. The Domain Name:

<steponboard.co.uk>

3. Procedural History:

3.1 The initial procedural history of this matter is as follows:

31 October 2016 13:36 Dispute received
01 November 2016 14:14 Complaint validated
01 November 2016 14:18 Notification of complaint sent to parties
18 November 2016 01:30 Response reminder sent
22 November 2016 15:57 Response received
22 November 2016 15:57 Notification of response sent to parties
24 November 2016 12:23 Reply received
24 November 2016 12:24 Notification of reply sent to parties
24 November 2016 12:24 Mediator appointed
29 November 2016 11:07 Mediation started
12 January 2017 17:02 Mediation failed
12 January 2017 17:30 Close of mediation documents sent
24 January 2017 01:30 Complainant full fee reminder sent
26 January 2017 10:27 Expert decision payment received

3.2 I have confirmed to Nominet that I am independent of each of the parties. I have also confirmed 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.

3.3 On 14 February 2017 I issued a procedural communication to the Lead Complainant and the Respondent. It invited the Complainant to file a further submission in these proceedings addressing the questions of whether it had rights for the purposes of the Policy and/or if it wished some other entity to be joined as a complainant in these proceedings. It also allowed the Respondent to file further submissions in response.

3.4 On 21 February 2017 the Lead Complainant sent an email to Nominet asking that Trustees Unlimited LLP (“TULLP”) be joined as a Complainant in these proceedings and filing a copy of a letter from TULLP dated 16 February 2016 in which that entity consented to be so joined.

3.5 The Respondent did not file any additional submission in response.

4. Factual Background

4.1 The Lead Complainant is a company that along with a number of other entities is involved in a programme that operates under the “Step On Board” name. “Step On Board” is a programme that works with commercial organisations to encourage their employees to act as trustees of charities. The programme is run by TULLP in conjunction with the National Council for Voluntary Organisations (“NCVO”), which is a charitable company limited by guarantee.

- 4.2 There is a “protocol” in place between TULLP and NCVO in relation to that programme, which describes “Step on Board” as a “Joint Arrangement Non Entity” or “JANE”.
- 4.3 TULLP and NCVO have together also been granted a licence by Bates Wells & Braithwaite London LLP to use UK registered trade mark no 2315274 as part of the term “Step On Board”. The registered trade mark was filed on 8 November 2002 in classes 41 and 42 in respect of the word “OnBoard”.
- 4.4 The Lead Complainant provides marketing and IT systems services to TULLP. These include the build, hosting and maintenance of websites for TULLP.
- 4.5 The formal Respondent in these proceedings is the company through which 123-reg Limited, the registrar for the Domain Name, provides “privacy services” to its customers. However, it is undisputed that the person who in reality controls the Domain Name is an individual named Thomas Bridge.
- 4.6 Thomas Bridge was an employee of the Lead Complainant from 1 December 2014 to 8 April 2016. As an employee of the Lead Complainant, he was involved in the Lead Complainant’s activities for TULLP including the “Step On Board” programme.
- 4.7 On 30 April 2016, the Domain Name was registered by Mr Bridge. Since registration a 123 Reg parking page that displays various sponsored listings, mostly with a nautical or boating theme, has been displayed from the Domain Name

5. Parties’ Contentions

The Complainants’ contentions

- 5.1 The Complaint and Reply filed by the Lead Complainant set out, with various supporting documents, the facts which have already been set out in section 4 of this decision. The Lead Complainant further contends that whilst Mr Bridge was an employee of the Lead Complainant he was “tasked with reserving” the Domain Name.
- 5.2 The Lead Complainant asserts that the Domain Name is an abusive registration because it took unfair advantage of and was unfairly detrimental to “the rights of Step on Board” at the time of registration, and that it was registered with “the primary purpose of stopping Step On Board and the partner firms from using it, to disrupt their business and/or to confuse internet users”.
- 5.3 The Lead Complainant also contends that on 15 July 2016, Mr Bridge told its solicitors that “the website is worth £10k to Russam and I can just keep it if I want.”

The Respondent's contentions

- 5.4 The formal Respondent (i.e. Identity Protect Limited) has taken no part in these proceedings. However, Mr Bridge did file a Response with Nominet in the form of an email.
- 5.5 In that email Mr Bridge denies that he was asked to purchase the Domain Name on behalf of the Lead Complainant. Instead he claims that he told the Lead Complainant that it should "put a backorder" on the Domain Name and that because he was "not given money or a company account" he used his personal account. According to Mr Bridge, that backorder was completed after he had left the Lead Complainant's employment and when a previous owner of the Domain Name allowed it to lapse. He claims that he offered to transfer the Domain Name to the Lead Complainant for free provided he was reimbursed the registration fees, that initially the Lead Complainant agreed to do this, but rather than this he received a letter from the Lead Complainant's lawyers.
- 5.6 Mr Bridge also claims that "at the same time" he was approached by a "modern dance / ballet company" asking if it could use the domain for their new website. He asserts that he agreed to this and that construction of the new website was due to commence in January 2017. He also stated that "now that a better organisation wants the domain, I would rather use it for them". However, the dance company is not identified and no supporting evidence is provided in respect of these claims. Further, no new website has prior to this decision appeared at the domain name.

6. Discussions and Findings

General

- 6.1 To succeed under the Policy, a complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the domain name the subject of the proceedings (paragraph 2.1.1 of the Policy) and second, that the domain name is an Abusive Registration in the hands of the respondent (paragraph 2.1.2 of the Policy). A complainant must prove to the expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"Abusive Registration means 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) *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

6.3 I will address the issues of rights and abusive registration in turn in this decision, but before I do so it is necessary to address the question of the addition of TULLP as a complainant in these proceedings.

Addition of TULLP as a Complainant

6.4 As I have already described in the Procedural History section of this decision, after being appointed I issued a communication to the parties which invited the Lead Complainant to file a further submission addressing the question of the rights it relied upon in these proceedings and/or seeking to join another complainant to these proceedings.

6.5 I issued that communication because it appeared to me that it was questionable whether the Lead Complainant had any relevant Rights. It provided services to TULLP in relation to the "Step On Board" programme but it was not clear on what basis that would grant it any rights. The fact that it was a member of TULLP did not of itself grant it any rights in any term used by that entity. Further, TULLP and NCVO, rather than the Lead Complainant, appeared to be the beneficiaries of a licence in respect of the registered trade mark relied upon.

6.6 One option to an expert in such circumstances would have been to dismiss the Complaint, leaving it to an entity that more clearly had relevant rights to file a fresh complaint. For an example of a case where an expert had done this where the complaint was brought in relation to some domain names by the wrong company in a group of companies, see DRS15947 (*British Telecommunications Plc v Sapphire Brands*).

6.7 Nevertheless, this appeared to me to be unduly harsh. The reasons for this were as follows:

- (i) It seemed possible by reason of its activities in relation to the Step On Board programme that the Lead Complainant did have some form of licence in that term that might grant it such rights; and
- (ii) The circumstances of the case were unusual in that the Lead Complainant had previously been Mr Bridge's employer and Mr Bridge's actions when he was an employee in placing a "back order" for the Domain Name appear to have directly led to the present registration. That in turn also raised the possibility that the Lead Complainant might seek to argue that it had some form of contractual or similar right in the Domain Name that would have been adequate for the purposes of the Policy. In this respect see my discussion in DRS 15217 (*Cardiff Bay Leisure Limited v Hopkins*).

- 6.8 The Lead Complainant in filing an additional submission did not seek to clarify or explain further why it might have any relevant rights. Instead, it sought to add TULLP as a party to these proceedings.
- 6.9 That the Lead Complainant did this is perhaps unsurprising given that (although without prejudice to what position I might take on any issue in my decision) I had identified this in my communication to the parties as a possible option. However, there is no express provision in the Policy that permits this. Nor does the Policy expressly grant a general power and discretion as to procedural matters that might arguably permit this, of the sort granted by paragraph 10 (a) of the Rules for Uniform Domain Name Dispute Resolution Policy that apply in UDRP proceedings.
- 6.10 Nevertheless, I believe that an expert does have a similar discretion under the Policy in respect of such procedural matters, provided that he or she does not exercise that discretion in a manner that is contrary to the Policy. The Policy, although different from the UDRP in a number of important respects, is fundamentally of the same character as the UDRP and heavily drew upon it when the Policy was initially set up. Both are relatively informal administrative proceedings of a sort that if they are to operate efficiently require the expert / panelist to have at least some degree of discretion in the operation of the proceedings. Both are also intended to provide a result that is broadly fair and does justice to the parties. Indeed, in the case of the Policy there are express references to the “interests of justice” (albeit in the context of certain specific questions). The ability of an expert to exercise some discretion in procedural matters, provided that this is done in a manner that no party is unfairly disadvantaged, helps further that aim.
- 6.11 Further and significantly, in this particular case although the Respondent was provided with an opportunity to respond to the Lead Complainant’s request to add TULLP as a party to these proceedings and raise reasoned objections in this respect, it did not do so.
- 6.12 In the circumstances, I have allowed TULLP to be added as a Complainant to these proceedings.

Complainants’ Rights

- 6.13 With the addition of TULLP as a Complainant, the issue of rights becomes relatively straight forward. First, TULLP is a licensee of a registered trade mark that comprises the word mark “OnBoard” and a licence is generally considered to have rights in a mark for the purposes of the Policy (see paragraph 1.1 of the Experts’ Overview v 2). Second, even absent the licence, TULLP appears to be the owner of rights under the law of passing off in the term “Step On Board” (whether or not these rights are shared with NVCO) by reason of its use of this as the name of the programme that it operates.
- 6.14 Further, the Domain Name can only be sensibly understood as the term “Step On Board” in conjunction with the “.co.uk” suffix. Accordingly, I have little

difficulty in concluding that both by reason of the licence in the “OnBoard” registered trade mark and rights under the law of passing off in the name “Step On Board”, TULLP has rights in a name or mark that is similar to the Domain Name. It has thereby satisfied the requirements of paragraph 2.1.1 of the Policy.

Abusive Registration

- 6.15 The issue of abusive registration is also relatively straight forward. The Domain Name was registered not only because Mr Bridge was aware of the use of the term “Step On Board” by TULLP as a name for its programme. Instead, it was registered directly as a consequence of acts he took as an employee of an entity that was undertaking work for TULLP at that time.
- 6.16 There are perhaps analogies here with the paragraph 5.1.5 of the Policy, which gives as one of the non-exhaustive list of examples of factors which may evidence abusive registration a situation where broadly a domain name is registered for the use of another and that other person has paid for the registration and/or renewal but the registrant refuses to transfer the domain name to that person. Given this, if Mr Bridge (as he claims) did initially offer to transfer the Domain Name to one of the Complainants in return simply for payment of the registration fee and the Lead Complainant refused to reimburse Mr Bridge the modest sum involved, then that decision on the part of the Lead Complainant was frankly ill advised.
- 6.17 However, even if Mr Bridge’s claims are true, matters clearly moved on thereafter. Mr Bridge has now threatened to enter into some commercial arrangement with some unidentified third party whereby the Domain Name would either be transferred to, or used by that third party. He has also not denied that he has made statements to the Lead Complainant’s lawyers as to the value of the Domain Name to the Lead Complainant, which are way in excess of any registration expenses.
- 6.18 Given this I conclude that it is more likely than not that the Domain Name is now primarily retained by Mr Bridge because of its association with the activities of TULLP and with the purpose of sale to either the Lead Complainant or TULLP for a sum in excess of his out of pocket costs. This is sufficient to justify a finding of abusive use of the Domain Name.
- 6.19 Finally, there is the fact that the Domain Name has been registered not in Mr Bridge’s name, but in the name of Identity Protect Limited. The use of such proxy privacy services has now become relatively common in the case of domain names to which the UDRP applies. Although their use remains a matter of controversy, there now appears to be consensus as to the significance of the use of such a service to UDRP proceedings. In short, although the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith, the use of such a service does not in and of itself demonstrate bad faith (see paragraph 3.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition).

- 6.20 However, this is an area where the position under the Policy can and should differ from the UDRP. Unlike domain names to which the UDRP applies, there are already specific procedures in place so far as .uk domain names are concerned that should be sufficient to protect any legitimate expectation of privacy or misuse of personal information on the part of any registrant. Non-trading individuals can opt out from providing certain information. There has also recently been introduced a specific Nominet WhoIs privacy service framework, which permits privacy services that have been validated by Nominet to comply with certain requirements and safeguards. If a privacy service is validated under that framework, the privacy service is not the formal registrant of the domain name and the safeguards mean, for example, that Nominet can where appropriate disclose the details of the underlying registrant to third parties.
- 6.21 As at the date of this decision Identity Protect Limited is not a privacy service that is validated under that framework. That is why it remains the formal Respondent in these proceedings. I therefore accept that the use of such an unvalidated service by Mr Bridge is at least a further factor that indicates abusive registration or use. By using such a service Mr Bridge has sought to disguise his identity in a manner and to a degree than goes further than is necessary to address any genuine privacy concerns.

7. Decision

- 7.1 I find that the Additional Complainant TULLP has Rights in a name, which is similar to the Domain Name, and that the Complainants have shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to TULLP.

Signed

Dated 7 March 2017