

DISPUTE RESOLUTION SERVICE

D00018819

Decision of Independent Expert

Mine of Information Ltd

and

LyndonGradyCreative

1. The Parties:

Complainant: Mine of Information Ltd
14 Swangleys Lane
Knebworth
Hertfordshire
SG3 6AA
United Kingdom

Respondent: LyndonGradyCreative
38 Thackeray Road
London
SW8 3TT
United Kingdom

2. The Domain Name:

mineofinformation.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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

27 April 2017	Dispute received
2 May 2017	Complaint validated
2 May 2017	Notification of complaint sent to parties
17 May 2017	Response received
17 May 2017	Notification of response sent to parties
22 May 2017	Reply reminder sent
23 May 2017	Reply received
23 May 2017	Notification of reply sent to parties
31 May 2017	Mediator appointed
31 May 2017	Mediation started
12 June 2017	Mediation failed
12 June 2017	Close of mediation documents sent
15 June 2017	Expert decision payment received

4. Factual Background

The Complainant was incorporated on 17 November 1977. The business name, 'MOI' was registered by the Complainant under the Business Names Act, 1916 on 15 March 1979.

The Complainant is an independent computer consultancy based in the UK (St Albans, then Knebworth). It is said to have clients in the UK, Europe and across the world and that it offers consultancy services, and professional and practical advice and assistance on the use of computers for individuals and businesses. It has a website at www.mineofinformation.com (the Complainant's website).

The Respondent registered the domain name, mineofinformation.co.uk, (the Domain Name) on 4 March 2013. The Domain Name resolves to a website which uses the trading name 'Mine of Information' and abbreviation, 'M.O.I.'. It is the website of Alexandra (Alex) Bourn which it is said is used to advertise her services as a 'Girl Friday', sorting out people's day to day organisational problems. The Respondent is her website designer and was directed by her in relation to the Domain Name and website design. The website to which the Domain Name resolves will hereafter be referred to as the Bourn website.

5. Parties' Contentions

The following is a summary of the parties' contentions.

The Complaint

- The Complainant has prior rights to the business names, Mine of Information and MOI and relies on its company and business name registrations referred to above, as well as passing-off rights.
- The Respondent either did not check or chose to ignore the registration entries for Mine of Information and MOI.
- In November 2017, the Complainant will be celebrating 40 years in the computer business, which may attract attention from local, national and international newspapers and websites such as the British Computer Society, Computing.co.uk, TheBookseller.com, LinkedIn.com and TheRegister.co.uk.
- The Domain Name and the prominent use of both registered business names on the Bourn website, which offers business services, is likely to cause confusion in the minds of previous, current and prospective clients of the Complainant and others, such as journalists and their readers.
- The Managing Director of the Complainant, Richard Ross-Langley approached the Respondent informally on 11 April 2017 by submitting a message form on the Bourn website, referring to the tort of 'passing off' and asking for an amicable settlement. No response was received and so on 19 April 2017, a letter was sent by recorded delivery, again asking if the matter could be settled amicably.
- On 20 April 2017, the Respondent telephoned Richard Ross-Langley and said the letter would be sent on to Alex Bourn. Later on 20 April 2017, an email arrived from Alex Bourn stating '*I have received a copy of your letter today and your email and will respond*'. There were no further communications.

The Response

The Response dated 17 May 2017 attached a letter from Alex Bourn dated 12 May 2017. The letter and Response will be summarised separately.

The Alex Bourn letter dated 12 May 2017

- Alex Bourn says that she came up with the Domain Name in good faith in order to

work as a 'Girl Friday', sorting out people's day to day organisational problems.

- In any event, 'mine of information' is a generic expression in common use and that is the reason it was chosen.
- The Domain Name was available and she was advised by the Respondent that she could buy it.
- There has never been any attempt to pass-off either intentionally or unintentionally. She has never received any emails inquiring about '*consultancy, professional and practical advice on the use of computers for individuals and businesses....including(sic) international mail order selling of computer books, including technical editing services to authors and publishers*' (the description given by the Complainant to its current and former offerings).
- The description of the business of the Complainant on the Companies House website is: '58290 – Other software publishing', '62090 – Other information technology service activities', '95110 – Repair of computers and peripheral equipment'.
- The services that Alex Bourn offers on her website are:
 - '*Property Search, Property management, Sourcing of suppliers & contractors, Collation of mortgage advice, Opening bank accounts, Relocation service, Advice on local schools and shops, Home moves, House sitting, Setting up of new offices, Assistance with IT, Setting up new laptops, Proof reading, Editing of documents, General bookkeeping, Research projects, Political analysis, Office moves, Organising events, Project management, Ad hoc research, Ad hoc administration, Travel research & reservations, Care advice for elderly relatives*'.
- It is accepted that the Complainant has been registered since 1977 but not that there is a danger of its customers being confused by the two websites; vastly different services are offered by Alex Bourn with the only possible area of confusion being '*Assistance with IT*', although it is stated that she may be willing to negotiate regarding that wording.
- Alex Bourn also makes the point that she feels that the Complainant did not allow sufficient time to respond to its concerns and has been very hasty – its original letter was only received on 19th April and the Complaint was lodged 2 weeks later.
- Finally, Alex Bourn states that she has spent a considerable amount of money and time on her website design, buying the Domain Name and on hosting, and would like the matter settled as soon as possible.

The Response dated 17 May 2017

- The Domain Name was purchased on 4th March 2013, for £6.98 on behalf of Alex Bourn who needed a website to advertise her availability for administrative jobs. The site was constructed by the Respondent and a friend.
- The services offered by Alex Bourn are not related to those of the Complainant. Alex Bourn offers support for general administrative tasks, property moving, home care and day to day support aimed at people in the Battersea area of London.
- Mr. Ross-Langley appears to have two companies - Mine of Information Ltd (the Complainant) and Mine of Innovation Ltd which offers computer consultancy. His letter inferred that the Bourn website was 'passing off'. Other web designers who having studied both sites suggest that this isn't the case and that it is possible that Mr. Ross-Langley is more interested in obtaining the domain name for himself. This is unfair - it was bought via GoDaddy and it appears wrong that someone who, by coincidence, has the same name can demand something legitimately bought and sold.
- The Respondent (and it is believed Alex Bourn too) had never heard of Mine of Information Ltd. If the name was something Mr. Ross-Langley wished to have for himself, as a computer consultant, he would have known to have bought all accompanying domains.
- There are many Mineofinformation domains for sale and many other companies using the words Mineofinformation, including TuxfordmineofinformationLtd which rank higher in the google rankings than either the Complainant or mineofinformation.co.uk.
- The Bourn website was not built to have a negative impact on Mr Ross-Langley's business and there is no crossover of business interests.
- Both the Respondent and Alex Bourne feel rather harassed and baffled by the Complaint.

The Reply

- The Complainant says that the Response and Alex Bourn letter dispute only one issue raised in the Complaint, namely that relating to the likelihood of confusion (and accept all the others). As to this point, the Complainant notes that both the Respondent and Alex Bourn deny any possible confusion between the Complainant operating at www.mineofinformation.com and the sole trader business, Mine of Information operating at www.mineofinformation.co.uk. The Complainant goes on

to say that the identical names are the primary source of the confusion and are disallowed at Companies House for that reason.

- The Complainant takes issue with the assertion that *'there are many other companies using the words Mineofinformation including Tuxfordmineofinformationltd'* and states that there is only one other company i.e. Tuxford Mine of Information Ltd, which is in fact an example of a name that is distinctly different, as required by Companies House.
- The successful registration of a domain name is not in itself a defence to the tort of passing off, or an answer to the possibility of confusion.
- The Complainant also takes issue with the assertion that the Respondent's website is *'aimed at people in the nearby Battersea area'*, noting that the Respondent's website states that *'Location is no obstacle'* and that the website testimonials page mentions not only London, Norfolk and West Sussex but also *'35 separate events all in different locations, from San Francisco to Helsinki via Toyko'*. The Complainant states that the international aspect of *'both the business and the company'* makes geographic differentiation more difficult and confusion therefore more likely.
- Yet further, the Complainant takes issue with the claim on the Respondent's website that *'Mine of Information is a London based company'* suggesting that this too adds to confusion and refers to the Companies Act 2006 c46 Part 1 Section 1 Clause 1 (1).
- The description of the services offered by Alex Bourn as described by the Respondent (*'general admin, property moving, home care and day to day support'*) is also disputed as it omits the central *'Business Services'* column on the Bourn website, listed in full by Alex Bourn. Alex Bourn says that only one of those services (*Assistance with IT*) might cause confusion with a computer consultancy. The Complainant disagrees. *'Setting up [of] new laptops'* is clearly a computer task.; *'Office moves'* should take account of broadband issues (e.g. notspots) and *'Political analysis'* should include, for example, privacy issues such as Safe Harbor agreements and future Data Protection Regulations. In an online world, computer consultancy is included in all the services listed under the *'Business Services'* heading on the Bourn website.
- It is claimed by Alex Bourn that *'we offer such vastly different services'*. The Complainant says that this is untrue; for it to be true statistically, any similarity would need to be below 5%. The Complainant states that the services are not *'vastly different'* (putting similarity at 33% based on the *'Business Services'* column being one of three columns on the Bourn website).
- The Complainant notes that Alex Bourn is concerned about losing the *'considerable*

amount of money' spent in setting up the website, but says that the dispute is about the Domain Name which cost less than £7 (per annum). The Complainant goes on to suggest that other suitable domain names, such as '*Battersea Mine of Information*' or "*PA For You*" or "*Girl Friday (London)*" or "*Girl Monday*", would have a similar cost of under £7 per annum.

- The Complainant says that someone on the internet looking for 'Mine of Information' and finding mineofinformation.co.uk with the same business name and using the same abbreviation (MOI), and with similar business services, could be confused, perhaps thinking that the Complainant over time had been extended for tax reasons into other areas and no longer offered chartered computer consultancy. This would detrimentally affect the image and goodwill created by the Complainant over the past 4 decades.
- The Bourn website claims to be a company (which it isn't), advertises the name of the Complainant and the abbreviation registered by it as a business name, and offers business services that are comparable. Whether it was intentional or not, there is a good chance that visitors to the Bourn website would confuse that business with the Complainant and this would be unfairly detrimental to the rights of the Complainant.

6. Discussions and Findings

As a preliminary comment, it should be made clear that disputes under Nominet's Dispute Resolution Service (DRS) are decided by reference to the terms of the DRS Policy (the Policy), not the law. And it has developed its own jurisprudence. While intellectual property law may be of some assistance in relation to the question of enforceable 'Rights' (as to which see below), the fact that a domain name registration, or its use, may constitute an English law tort such as (unregistered) trade mark infringement, does not necessarily lead to a finding of Abusive Registration under the Policy. Whatever analysis might be propounded in terms of intellectual property (or other) law, a Complainant must still satisfy the requirements of the Policy.

Whilst there is no system of binding precedent under the Policy, a measure of consistency is naturally preferable. The DRS Experts' Overview, version 2 (the Overview) is designed to assist participants in disputes under the Policy by describing commonly raised issues and explaining how Nominet Experts have dealt with those issues. Reference will be made to that Overview later in this Decision.

Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, 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 in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's Rights

The meaning of 'rights' is defined in 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'*.

The Complainant has no registered trade mark rights but that matters not as long as it can show rights of some sort which are enforceable. Where, as here, a complainant has no registered trade mark rights to rely on, rights afforded by the law of passing-off are often used to found a complaint.

Passing-off

In any action for passing-off under English law, a claimant must satisfy three elements – the 'classic trinity': goodwill or reputation associated with the name (or get up) of the products or services offered by the claimant; a misrepresentation (rather than confusion *per se*) by the defendant to the public resulting or with the likely result that the public believes that his goods or services are those of the claimant; and damage to the claimant. It is the first element that Nominet Experts are concerned with, namely goodwill and reputation, for if either can be demonstrated, and the other elements of passing-off satisfied, such goodwill or reputation would ordinarily be protectable. In other words, all the Nominet Expert needs to be satisfied of is that there is a basis for an enforceable right. Thus, even if goodwill or reputation are demonstrated, that does not mean that passing-off is also established. There is simply no need for an Expert to go on to consider the other elements of passing-off – misrepresentation and damage, because Experts under the DRS are not deciding whether there has in fact been passing-off, but only that a complainant has standing to bring a complaint i.e. that it has Rights for the purposes of the Policy.

It has been stated in many DRS decisions that the test for demonstrating Rights is at a relatively low threshold. As paragraph 2.3 of the Overview puts it, *'...proving the existence of rights in a relevant name or mark ... is intended to be a relatively low-level test'*. However, as low threshold as the test might be, the Expert still needs to be persuaded that, on the balance of probabilities, relevant rights exist. Thus when dealing with unregistered trade mark (passing-off) rights *'...evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results)'* (paragraph 2.2 of the Overview).

When dealing with rights in descriptive or generic terms (being more difficult to acquire than rights in distinctive terms, given the lower likelihood that any one person could acquire for themselves the necessary goodwill or reputation in them), one has to be even more circumspect. But, as the definition of Rights (in the Policy) makes clear, where the descriptive term in question has acquired a secondary meaning - in other words, it has become, by its use, associated with the complainant's goods or services in the minds of relevant consumers, it is quite possible for a complainant (relying on a descriptive or generic term) to satisfy the Rights requirement under the Policy.

In this case, the Complainant claims rights in the expression, 'Mine of Information', a well-known synonym for someone or something that can provide a lot of information. In the Expert's view, very clear evidence indeed would be needed to prove rights in that commonly used expression and such rights, where demonstrated, would likely be very limited in scope. The Expert however is concerned by the scant evidence of unregistered trade mark rights provided by the Complainant. Bare assertions are insufficient. What is required, as the Overview makes clear, is evidence to show that the Complainant has used the name or mark in question, not just for a significant period but also to a not insignificant degree. The Complainant has attached to its Complaint its Certificate of Incorporation dated 17 November 1977; a VAT Certificate also from 1977; an advert for a book series on microcomputers and a list of customers, both on Mine of Information/MoI notepaper and dated March 1978 and March 1979, respectively; a Certificate of Registration of the business name, MoI dated 15 March 1979; an undated photograph of a business plaque bearing the Complainant's name and abbreviation MoI; a letter from Dunn & Bradstreet dated 27 October 1981 which begins 'As an established concern....' and to which is attached a completed questionnaire providing certain information about the Complainant; and a publication by the Department of Industry being a list of Authorised Consultants, dated December 1982, listing the Complainant along with many others.

Given complete absence of any recent evidence of use (of the name, Mine of Information) and the paucity of evidence generally, the Expert considered it appropriate to visit the Claimant's website (and also the Bourn website), links having been provided in the Alex Bourn letter of 12 May 2017.

The Complainant's website is, by and large, a static page. There is a link to 'Historical Documents' which displays a picture of staff at a Midland Bank computer centre which bears the date, 1970, and a book review from 1979. There is an ability to send an e-mail to the Complainant at 'minfo@pobox.com' and a link to a map showing the location of the Complainant. There is also a link entitled 'Mine of Innovation Ltd (MoI)'. This company is described as an '*IT Support Social Enterprise est 2011 for charities and voluntary groups in Hertfordshire, UK*'. It seems to be the case that Mine of Innovation Ltd uses the abbreviation (MoI) also used by the Complainant. The Mine of Innovation link takes Internet users to a more modern looking website, containing several other links.

Having reviewed the evidence accompanying the Complaint (and Reply) and the Complainant's website, the Expert does not consider that sufficient reputation or goodwill has been demonstrated to give the Complainant standing to bring a Complaint under the Policy based on unregistered trade mark (or passing-off) rights. That view of course is not one that would preclude a court from reviewing the matter afresh, were a passing-off action to be commenced, but on the evidence in this proceeding, the Expert is of the view that no enforceable passing-off right has been demonstrated. That is not to say that that was always the case of course. No finding is made in respect of unregistered trade mark rights that once might have been available to the Complainant because it is simply not necessary; the right needs to be enforceable at the time it is relied on. The Expert mentions the point because of what has become evident by enquiries made of his own volition (as he is entitled to do under paragraph 18.1 of the Policy) which, for the sake of completeness, are described in the paragraph below.

The Expert carried out a Google search of his own. The first result which relates to the Complainant was the eleventh entry appearing at the top of the second page of results. This was a link, not to the Complainant's website but to information held at Companies House. The preceding results all concerned the meaning of the phrase, Mine of Information. The Expert followed the Companies House link (it already having been provided by Alex Bourn in her letter of 12 May 2017). The Filing history tab on the Complainant's page at Companies House showed that '*Accounts for a dormant company*' were filed for year ends 31 December 2014 and 31 December 2015. For year end, 31 December 2016, '*Micro company accounts*' were filed. These last three accounts suggest very little, if any, commercial activity. Earlier accounts suggest more significance activity (as also illustrated by the completed questionnaire attached to the Dun & Bradstreet letter of 27 October 1981, referred to earlier, which suggests a turnover for year end 31 December 1980 of over £70,000). Clearly, the Complainant has at some point been more active than it is today. However, if reputation or goodwill is not maintained, it ebbs away and even if once protectable, after a period of time, it will no longer be protectable. No evidence has been adduced by the Complainant of current reputation or goodwill. The evidence adduced, such as it is, is from the Seventies and Eighties. That is hardly convincing. The impression given is one of a company that has been largely inactive for a number of recent years. In these circumstances, it should be of no surprise that, at least in these DRS proceedings, the Complainant is unable to prevent another from using a domain name that incorporates a very well known phrase that also happens to be its company name, based on unregistered trade mark or passing-rights that depend on reputation or goodwill.

However, it is not just passing-off rights that can provide the basis of a Complaint. Other rights, such as a contractual right (e.g. a licence) to use a particular name may be enough, as long as such rights are enforceable. It cannot however be an unenforceable right.

Other rights

The Complainant relies on its Companies Act and Business Names Act registrations. The

Overview deals with the Companies Act point at paragraph 1.7, and asks, *'Can a company name registration (per se) give rise to a right within the definition of Rights?'* The question is answered as follows, *'There are decisions going both ways, DRS 00228 (activewebsolution.co.uk) and DRS 04001 (generaldynamics.co.uk)). The issue is this: does the mere fact that under the Companies Acts (section 28(2) of the Companies Act 1985 and sections 66 and 67 of the Companies Act 2006) the Secretary of State can direct NewCo to change its name because it is the same as, or 'too like', OldCo's name, mean that OldCo enjoys 'rights enforceable under English law and/or 'Rights' within the full meaning of the Policy?'*

The consensus view of recent Experts' meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose'.

The Expert's view mirrors that of the consensus amongst experts. As said in DRS 00228 (Active Web Solutions Ltd v Shaw), *'the incorporation of a company under a particular name does not of itself give rise to the right to prevent others using that name—the most that can be achieved by that registration alone is that it will block anybody else attempting to register exactly the same name with Companies House'*

There is no evidence to suggest that the Respondent (or Alex Bourn) has attempted to register a company of the same or similar name to that of the Complainant, and therefore the Companies Act would appear to be unavailable as a tool to be used by the Complainant in any event.

The Complainant's registration under the Business Names Act would appear to be completely irrelevant. Regardless of the Act's relevance to a DRS proceeding, the registration is of the business name 'Mol', an abbreviation used by Alex Bourn (M.O.I) on her website, but not in the Domain Name. A Complainant must show that it *'has rights in respect of a name or mark which is identical or similar to the domain name in issue'*. The abbreviation 'Mol' could not be said to be identical or similar to the Domain Name. For the sake of completeness, it should also be said, as noted earlier, that a different company associated with the Complainant, Mine of Innovation Ltd, also appears to have adopted the 'Mol' abbreviation. That could raise other issues, were the point not irrelevant.

Ignoring the suffix, '.co.uk' the Domain Name and name, Mine of Information are of course identical, but for the reasons given above, the Expert is of the view that the Complainant has failed to show Rights (in the name, Mine of Information) for the purposes of the Policy. Given that finding it is, strictly speaking, unnecessary to consider the issue of whether the Domain Name would be an Abusive Registration in the hands of the Respondent. However, the parties may find it helpful if that analysis were undertaken.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either

‘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 which ‘is being or has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant’s Rights;’.

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 5 of the Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily as a blocking registration against a name or mark in which the Complainant has rights, or for the purpose of unfairly disrupting the business of the Complainant.

Other factors suggesting an Abusive Registration include the Respondent 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. If the domain name is an exact match for the name or mark in which the complainant has rights, the complainant’s mark has a reputation and the respondent has no reasonable justification for the registration, that too may evidence an Abusive Registration.

A non-exhaustive list of countervailing factors is set out in paragraph 8 of the Policy i.e. factors which may indicate that the Domain Name is not an Abusive Registration. This includes circumstances suggesting that before being aware of the complainant’s cause for complaint, the respondent has used or made demonstrable preparations to use the domain name in connection with a genuine offering of goods or services. A respondent being commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name, or having made legitimate non-commercial or fair use of the domain name, will also be indicative of a registration that is not abusive. Also, if the Domain Name is generic or descriptive and the Respondent is making fair use of it, that too may indicate that the Domain Name is not an Abusive Registration.

It can be seen that, at the heart of the Policy, is the requirement to prove unfairness: for a registration to be considered ‘abusive’ there should be something unfair in the object or effect of the respondent’s behavior. Thus it is perfectly possible for a respondent to make fair use of a domain name that incorporates a Complainant’s trade mark and which also, for that matter, causes confusion.

When dealing with a generic or descriptive name, a Complainant has an additional challenge. This is best explained by reference to paragraph 4.10 of the Overview which asks, *‘Can use of a purely generic or descriptive term be abusive?’* The answer is *‘Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is*

likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an Abusive Registration.'

Knowledge of a Complainant and/or its rights is a crucial element in most cases, but particularly so where, as in this case, the domain name is a commonly used expression. The importance of knowledge on the part of a respondent is illustrated by the 2007 Appeal Panel decision in the case of Verbatim Limited v Michael Toth (DRS 4331), in which the Appeal Panel said that:

'... the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 [now paragraph 5 of version 4] of the Policy:

(1) First, some knowledge of the Complainant and/or its brand/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) [now paragraph 5.1.4] (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.

(2) Secondly, 'knowledge' and 'intention' are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) [now paragraph 5.1.1] of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.

(3) Thirdly, 'intention' is not a necessary ingredient for a complaint under paragraph 3(a)(ii) [dealing with confusion and now paragraph 5.1.2] of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.

(4) Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv) [now paragraph 5.1.4], knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.

(5) Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.'

In this case, the Respondent has said in his submission that he (and, he believes, Alex Bourn) has never heard of Mine of Information Ltd. Alex Bourn does not say so in terms, but she does say that she came up with the name in *'..complete good faith in order to work as a 'Girl Friday'....'*

This does not appear to the Expert to be a case of Alex Bourn or the Respondent coming up with a name with knowledge of, or with any intention of taking a free ride on the goodwill or

reputation of another. If anything, the registration and use of the Domain Name would seem to fall into at least two of the categories of circumstances described in paragraph 8 of the Policy (which indicate that a domain name is not an Abusive Registration): that before being aware of the complainant's cause for complaint, the respondent has used or made demonstrable preparations to use the domain name or one that is similar in connection with a genuine offering of goods or services; or that the domain name is generic or descriptive and the respondent is making fair use of it. Thus, even if the Complainant were to have demonstrated rights for the purposes of the Policy, and a *prima facie* case of Abusive Registration, the Respondent would have little difficulty in establishing an answer to that case.

The reality is however, that the Complainant has difficulty in showing even a *prima facie* case of Abusive Registration. There was no '*primary intention*' to '*block*' the Complainant from registering the Domain Name, or to disrupt its business. As far as using 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, not only is some knowledge of the Complainant or its name a pre-requisite, no evidence of confusion has been adduced. Complaint was not made until April 2017, but the Domain Name was registered 4 years earlier. If there was any or any significant confusion, one would have expected to have seen some evidence. None has been provided. One can only assume that there is none available. If that is the position after four years, it is hardly sustainable to argue that there is a likelihood of confusion. The Complainant would also have difficulty aligning itself with the other examples indicative of Abusive Registration set out in paragraph 5 of the Policy.

For the reasons given above, the Complaint would have failed on the issue of Abusive Registration even if it had succeeded on the issue of Rights.

7. Decision

The Expert finds that the Complainant has failed to demonstrate Rights in a name or mark that is identical or similar to the Domain Name and that, in any event, the Domain Name in the hands of the Respondent would not be held to be an Abusive Registration. Accordingly, the Expert directs that no action be taken in respect of the Complaint.

Signed Jon Lang

Dated 29 June 2017