

# **DISPUTE RESOLUTION SERVICE**

**D00019096**

**Decision of Independent Expert**

The Boots Company PLC

and

John Temperley, Paul Williams

## **1. The Parties:**

Complainant: The Boots Company PLC  
The Boots Company PLC  
Nottingham  
Nottinghamshire  
NG2 3AA  
United Kingdom

Respondents: John Temperley, Paul Williams  
27 Knights Templar Way  
High Wycombe  
Buckinghamshire  
HP11 1PX  
United Kingdom

## **2. The Domain Name(s):**

no7.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.

03 July 2017 17:47 Dispute received  
04 July 2017 10:14 Complaint validated  
05 July 2017 11:09 Notification of complaint sent to parties  
24 July 2017 02:30 Response reminder sent  
26 July 2017 08:29 Response received  
26 July 2017 08:29 Notification of response sent to parties  
31 July 2017 02:30 Reply reminder sent  
03 August 2017 08:57 Reply received  
03 August 2017 12:22 Notification of reply sent to parties  
03 August 2017 12:22 Mediator appointed  
08 August 2017 17:20 Mediation started  
26 September 2017 15:11 Mediation failed  
26 September 2017 15:11 Close of mediation documents sent  
06 October 2017 02:30 Complainant full fee reminder sent  
10 October 2017 16:10 Expert decision payment received

### **4. Factual Background**

Based on the parties' respective submissions and evidence presented I find the following facts as underlying the current dispute:

- i. The Complainant is a well known high street retailer active in particular in the pharmaceutical area but also active across a wide range of other activities.
- ii. The Complainant has since 1935 marketed a range of cosmetic products under the brand "NO 7" and is the owner of a number of trade marks as well as having acquired by significant usage unregistered rights in that brand.
- iii. The brand is of significant value and has become well recognised, not only in the UK but in other parts of the world.
- iv. The Respondents registered the Domain Name in or around 1995.
- v. They had been running a guesthouse aimed at gay/lesbian customers since 1991, which business continued until 2001, when it closed.
- vi. The Respondents considered reopening their business and so kept the Domain Name which resolved to a website to support the guesthouse business, but around February/March 2003 decided against doing so.

- vii. Since 2008, the Domain Name has resolved to a parking page: in the period between 2003 and 2008, there is a dispute in the evidence between the parties concerning usage of the Domain Name, which I discuss below.
- viii. Around 2003, the Respondents approached the Complainant with a view to selling their registration of no7.com and possibly also the Domain Name.
- ix. The Domain Name is currently for sale with an internet agency, Sedo, for the sum of £50,000, providing for a minimum offer of £10,000.
- x. In early 2017, the Complainant through a third party agency made an offer of £2,000 for the Domain Name, which the Respondents refused.

## 5. Parties' Contentions

The Complainant made the following submissions and asserted the following facts:

- i. It is a leading retailer in the pharmaceuticals sector with more than 2,500 UK stores.
- ii. It launched the No7 brand in 1935, which has been re-launched in 1991, 1995 and 2012.
- iii. It has more than 50 registered trade marks, of which 13 are UK trade marks and 5 are EU trade marks.
- iv. It has sold many products under the No7 brand and in the 80s and 90s was the leading brand in the cosmetics market.
- v. There has been significant marketing of products under the No7 brand, and the Complainant has expended significant sums on such marketing: between £2m and 7m pa between 2007 and 2013.
- vi. No7 as a brand also has an international reputation.
- vii. In May 2007, one product marketed under the No7 brand became the fastest selling product for the Complainant.
- viii. The Domain Name is identical with the Complainant's No7 brand.
- ix. The Complainant has never consented to the Respondents' use of the Domain Name.
- x. It appears that the Respondents have used the Domain Name and no7.com for the same purposes, but evidence is not available before 1999.
- xi. There have been phases of abuse for no7.com:
  - a. 25/01/1999 – 02/03/2003: homepage for a guesthouse for gay/lesbian clientele;
  - b. 27/03/2003 – 01/05/2003 – frame for wellbeing.com (registered to the Complainant);
  - c. 15/12/2004 – 13/01/2007 – displaying a page headed "Best Value for Quality Home Shopping" and getting click-through revenue; and
  - d. 17/05/2008 – 04/10/2016 parking page
- xii. Paragraphs (xi)(b) to (d) are cybersquatting and (b) and (c) are flagrant abuse.
- xiii. The Domain Name was used for the same purposes as no7.com:
  - a. The phases of use are the same;
  - b. As at 27 March 2003, the Domain Name redirected to no7.com (which framed wellbeing.com) and as at 2 February 2005 it re-directed to ace-internet.co.uk (an error); and

- c. Between 24 October 2005 and 10 March 2006, there was a 404 page linking to no7.com, but it was displaying the same content as no7.com
- xiv. Given that the Domain Name and the Complainant's Rights are identical, people and businesses will be confused, visiting the Domain Name in the hope and expectation that they are visiting a site operated or authorised by the Complainant.
  - xv. The Respondents are British and reside in the UK and are aware of the likelihood of confusion.
  - xvi. During the second phase, the Domain Name framed wellbeing.com and would have been identical to the Complainant's site, displaying the Complainant's trading name and device trade mark with the same colour scheme and get-up.
  - xvii. The framed webpage allowed visitors to click through to some of the Complainant's other webpages, including a "About Us" page showing that it was operated by the Complainant: this was incorrect when applied to the framed webpage.
  - xviii. Such framing was abusive by showing that the Domain Name was connected with the Complainant's Rights or authorised by it.
  - xix. In the third phase, the Domain Name simply redirected to no7.com, which used "Boots", "no7" and No7" as metatags, showing the Respondents' knowledge of the Complainant's Rights.
  - xx. In the third phase, there was a "Health & Beauty" link in the top banner linking to tracker.tradedoubler.com, thereby generating pay per click revenue; the link was probably to the Complainant's website. It also had other pay per click links to electrical and travel links, copying other areas of the Complainant's business.
  - xxi. The passage of time does not prevent abuse and the Respondents can revert to abusive use: delay is not a ground on which to refuse relief.
  - xxii. Such is the similarity of the Domain Name and the Complainant's Rights that the Respondents cannot have an innocent explanation and use of the Domain Name has been and is abusive.
  - xxiii. The Respondents have listed the Domain Name for sale at £50,000, minimum of £10,000: far in excess of any out-of-pocket expenses or value to the Respondents and much more than other similar domain names.
  - xxiv. The same price is asked for no7.com.
  - xxv. The Respondents have refused the Complainant's offer of £4,000.
  - xxvi. The Complainant does not know the initial purpose of the Domain Name's registration, but later use can still constitute an Abusive Registration.

The Respondents made the following submissions and asserted the following facts:

- i. They accept that the Complainant has Rights identical to the Domain Name.
- ii. From 1999 to 2001 the Respondents operated a guesthouse for gay and lesbian clientele known as "Number Seven" or "No 7" as it was located at 7 Josephine Avenue in Brixton.
- iii. The Respondents do not recall the date of registration: it was probably on or around 21 December 1995.

- iv. The Complainant is wrong when it says there is no evidence of use before 1999.
- v. Use for the guesthouse was legitimate as a site and for email.
- vi. The Domain Name when registered was not an Abusive Registration.
- vii. The Respondents were not aware of the Complainant's Rights when registering the Domain Name: there was little internet usage of the Complainant's Rights at the time.
- viii. The Complainant has produced no evidence to show illegitimate use of the Domain Name: in fact, there was no illegitimate usage of the Domain Name.
- ix. The guesthouse closed in 2001, therefore the Respondents left the website in place; when they decided not to reopen, they removed the website from the Domain Name in February 2003 and Ace Internet (the Respondents' website host) put a redirect to its own homepage.
- x. The Complainant has not produced evidence to show anything other than the Ace Internet redirects as set out above.
- xi. To the best of the Respondents' recollection, the Domain Name never redirected to no7.com when the latter framed wellbeing.com.
- xii. The Complainant has drawn the incorrect conclusions from the 404 error messages in its evidence: it has not shown that the Domain Name resolved in any way that was illegitimate.
- xiii. Until February/March 2003, the Respondents used the Domain Name and no7.com in connection with the guesthouse; the Domain Name would attract UK custom and no7.com would attract international custom.
- xiv. Since mid-2008, the Domain Name and no7.com have resolved to a holding page: the Respondents have used them for private purposes on various occasions.
- xv. In the second and third phases as described by the Complainant, the Domain Name redirected to the home page of the Respondents' webhost, except for the 404 error pages.
- xvi. There were various people potentially interested in use of no7.com, and the Respondents simply redirected to the Complainant's webpage as part of a scheme to sell the domain to the Complainant: this took place over one month out of twenty years.
- xvii. The Respondents sought to earn income from the Domain Name and no7.com, and in so doing entered into transactions with TradeDoubler, which necessitated certain steps regarding site content: this was not unique to the Complainant's business, but included metatags from a wide variety of retailers and the Complainant likely approved no7.com.
- xviii. Still, there is no actual evidence of specific targeting of the Complainant's business, but rather reference to a wide variety of retailers, which would have confused no-one.
- xix. There is no evidence of confusion and use of a website to generate income is not of itself objectionable.
- xx. The Respondents registered the Domain Name in good faith and have done nothing actively since then to abuse or exploit that position.
- xxi. Forming an intention subsequent to registration of selling the Domain Name at a profit to the Complainant or anyone else is unlikely to be abusive; the

- Respondents have not sought to sell the Domain Name to any competitor of the Complainant and have made no type of threat to the Complainant.
- xxii. The same principles as apply to selling a domain name to a third party after it has become famous should apply to the situation here, where the Respondents registered the Domain Name in ignorance of the Complainant's Rights.
  - xxiii. The attempted sale of the Domain Name is due to its inherent desirability as being brief and of potential interest to a number of businesses.
  - xxiv. The Complainant's delay has unfairly prejudiced the Respondents.
  - xxv. The Complainant has not produced evidence to support its case.
  - xxvi. This is Reverse Domain Name Hijacking.

The Complainant replied making the following submissions and relying on the following facts:

- i. The evidence as a whole points to the Domain Name as being used to frame no7.com as at 10 March 2006, as is also shown by the evidence for 23 February 2006.
- ii. The 404 errors mean that the webpage was temporarily down.
- iii. The Respondents have accepted that no7.com displayed TradeDoubler links between 2005 and 2007.
- iv. Wayback's results have varied and there are various reasons for this.
- v. The Respondents have mischaracterised the Ace redirects: Wayback has substituted one result for 18 redirects without explanation; throughout the second and third phases, the use was abusive.
- vi. Regardless of whether the Respondents were aware of the Complainant's Rights at the time of registration, their subsequent use has been abusive.
- vii. The Respondents' explanation of the framing is implausible.
- viii. Visitors seeing the framed website would have been confused and profit is not relevant.
- ix. Usage of "No7" was inherently confusing for anyone visiting the page during the third phase.
- x. The evidence shows that advertisements were included for both the Complainant and its competitors.
- xi. The Respondents have not shown that the Complainant ever consented to the Respondents' use of their website.
- xii. Earning click-per-view can be abusive if it takes unfair advantage of the Complainant's Rights: in fact, the Respondents used advertisements which competed with the No 7 brand and with the Complainant.
- xiii. There is no case of Reverse Domain Name Hijacking.

As the Complainant has included new evidence with its Reply, I gave the Respondents the opportunity to make a further submission in relation to it. The Respondents submitted as follows:

- i. There have been various times during the last twenty years when the Domain Name has redirected to no7.com, but the Respondents cannot be precise about this.
- ii. The Complainant has relied on confusing, technical and unreliable evidence.
- iii. The evidence shows that the Wayback Machine is unreliable.
- iv. The Complainant's HTML evidence is unclear and the Complainant's conclusion drawn from it are pure speculation.
- v. There is nothing to connect the Wayback Machine screenshots with the Domain Name rather than with no7.com.
- vi. There was no abusive intent with regard to framing wellbeing.com and it was allied to the Respondents' attempt to sell the Domain Name to the Complainant.
- vii. There was no abusive intent with regard to TradeDoubler; in any case, the site used many general retailers and had no specific reference to the cosmetics branded under the No 7 trade mark.
- viii. The Respondents have faced evidential difficulties as a result of the Complainant's excessive delay: this has led to some important evidence being unavailable

## **6. Discussions and Findings**

### **Rights**

The Respondents have conceded that the Complainant has Rights identical with the Domain Name. This also appears from the evidence led by the Complainant which has produced some evidence of marketing. It would have been more useful to see an actual copy registration certificate rather than a list of registered trade marks, but I accept, as do the Respondents, that the Complainant has, as required by the DRS Policy, Rights identical with the Domain Name.

### **Abusive Registration**

The definition of Abusive Registration in the DRS Policy is as follows:

*“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;”*

It will be seen that the term 'Abusive Registration' is defined in the DRS Policy in two complementary ways: the first limb focusing on the time of acquisition or registration of a domain name, and the second limb focusing on what is done with the domain name subsequent to acquisition or registration.

I will take each of these limbs in order in this Decision, as the considerations are somewhat different.

### ***Initial registration***

Paragraph 5 of the DRS Policy contains a non-exhaustive list of factors which may point to an Abusive Registration. Paragraph 5.1.1 is relevant to the present dispute and it provides that the evidence could include:

*“5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*5.1.1.1 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;*

*5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or*

*5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;”*

I am satisfied, after reviewing the evidence presented by the Respondents, that they registered the Domain Name for the primary purpose of hosting a website for supporting their business of running a guesthouse aimed a gay/lesbian clientele. I accept that they chose the Domain Name as that was a useful abbreviation of the address of the guesthouse (7, Josephine Avenue in Brixton, London). They state in their Response that they had no knowledge of the Complainant's Rights and I accept that that is an honest recollection. There is no particular reason why two men at that time should have knowledge of the Complainant's range of cosmetics aimed no doubt at a largely female audience. The Complainant has not produced extensive evidence showing anything like the ubiquity of its marketing message, such that someone in the Respondents' position would inevitably associate “No 7” with the Complainant's product range in particular. Indeed, as the Respondents observe in their Response, “No 7” is used by Jack Daniels as well; they say that the term is used by other businesses, and Exhibit 12 to their Response shows use by a guesthouse in Whitby, a restaurant, a hair salon and a pub.

I further accept, based on the evidence they have produced, the Respondents' assertions that they used the Domain Name as an address for hosting a website for their guesthouse business until it closed in 2001 and kept the website alive until around February/March 2003 against the possibility of their reopening the business. I also accept that they used the Domain Name for the purposes of email: this makes perfect sense given the nature of the Domain Name being used to promote a specific business.



It is worth recording that I find that the Respondents also used no7.com over the same period with the same intention of providing a website to support their guesthouse business. I accept their explanation that they conceived that the .com registration would be most suitable to an international audience whereas the Domain Name would be most suitable for a UK one.

In these circumstances, there is nothing illegitimate about the Respondents' registration of the Domain Name, and there is no evidence that their subsequent usage of the Domain Name until February/March 2003 in support of that business (even after it shut in 2001) amounted to an Abusive Registration as illustrated by paragraph 5.1.1 of the DRS Policy.

Domain names in general are available on a first come first served basis and, where there are several potentially interested parties (such as the Complainant, the Respondents, Jack Daniels and the other businesses listed in Exhibit 12 to the Response), it comes down to who is first in the queue. No-one out of the Complainant, the Respondents or Jack Daniels has a unique right to the Domain Name as such: the DRS Policy is only engaged if there is some form of subsequent use which falls into the second limb of Abusive Registration (dealt with below).

The Complainant would have to show circumstances indicating that the Respondents registered the Domain Name "*primarily*" for the purposes listed in paragraphs 5.1.1.1 to 5.1.1.3: in my view, they are a long way from being able to demonstrate any such purposes given the Respondents' legitimate use of the Domain Name over the course of several years.

Paragraph 5.1.6 of the DRS Policy is also engaged, which provides that an Abusive Registration can exist where:

*"The Domain Name is an exact match (within the limitations of the character set permissible in domain names) 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 having registered the Domain Name."*

It is certainly correct that the Complainant's Rights are absolutely identical with the Domain Name, but the Respondents have satisfied me that they had a reasonable justification for registering the Domain Name in the first place i.e. it was used in support of their business in operating a guesthouse.

### ***Subsequent usage after 2003***

#### *Preliminary comments*

There is no limitation period included in the DRS Policy, and there is no doctrine of laches (or delay). Each case comes down to an investigation of the facts and evidence presented by the parties and then applying the DRS Policy. The

Respondents point out that one possible consideration in cases of delay is the prejudice to the Respondent, and I shall consider that below.

In all the voluminous evidence and in the submissions presented by the Complainant, there is no mention of why it has delayed so long in bringing this complaint. It has described various phases of alleged abusive use of the Domain Name which is a useful classification which I gratefully adopt, but this dates back over ten years and there is no explanation of why it has waited so long to bring a complaint. I observe that the Complainant has also not explained why it (apparently) took no action with regard to no7.com and why such illegitimate use of which it now complains did not (apparently) result in an application to the appropriate body.

It is not for me to speculate on whether the Complainant knew of the alleged illegitimate activities of the Respondents all along but decided to do nothing for years on end, or whether it simply was unaware of the Respondents' ownership of the Domain Name until very recently. What it describes as flagrant abuse in the third phase ended by its own admission in 2007 – ten years ago. Since 17 May 2008, there has been a parking page.

The parties have helpfully referred to some previous Decisions under the DRS Policy, but neither referred to the more recent Decision of the Appeal Panel in DRS17490 cheltenham-festival.co.uk (“Cheltenham Festival”), which itself took into account and discussed various Decisions looking at the question of delay. There is not, of course, a strict system of precedent under the DRS Policy, but it is wise to have regard to how other Experts, and especially an Appeal Panel, have approached the same or similar issues in the past.

In Cheltenham Festival, the Complainant (the Jockey Club) showed usage going back some 200 years or more in the Cheltenham Festival as being a horseracing meeting of high quality as well as having registered relevant trade marks in “THE CHELTENHAM FESTIVAL” and “CHELTENHAM FESTIVAL”. The respondent registered the domain name in that case in 2004 and used it for the purposes of a webpage providing news, comparing odds, giving statistics and analysis as well as tips for the betting public. The usage was consistent between the time of first registration until the complainant's application in May 2016 – an interval of some twelve years. There were various issues in the appeal in Cheltenham Festival, but the Appeal Panel also reviewed the question of delay in bringing a complaint under the DRS Policy.

From the Appeal Panel's conclusions in Cheltenham Festival, and also based on the other Decisions that it considered in the course of its Decision, I draw the following conclusions in my approach to this case when it comes to considering delay:

- i. This is not a “legalistic” exercise in the sense of having regard to and being constrained by general legal principles, such as the equitable doctrine of laches: the question in every case is to go back to the wording of the DRS Policy and apply that in the light of how other Experts and especially the Appeal Panel have approached the issue.

- ii. Delay, even egregious delay, is consequently not as such an absolute bar to bringing a successful complaint under the DRS Policy: there has to be something else, some other factor which makes delay a relevant ground for denying the complainant a remedy under the DRS Policy.
- iii. Delay, however, could be relevant when considering the complaint in the round, taking account of all relevant factors, such as whether there was some sort of acquiescence (or even approval) by the complainant of the respondent's activities.
- iv. By and large, delay in bringing a complaint under the DRS Policy should not be seen as a serious factor and the focus should be on applying the wording of paragraphs 5 and 8 of the DRS Policy to the facts as found by the Expert in the particular case.
- v. The focus is, therefore, on the "here and now", whether any of the grounds for finding Abusive Registration exist in the present, at the time when the complaint is brought.

It will immediately be seen that one striking similarity between Cheltenham Festival and the present dispute is that the name in which Rights are maintained is absolutely identical with the domain name without any adornment or distinction. The Appeal Panel in Cheltenham Festival concluded that "*it is highly likely that an Internet user seeing the Domain Name is likely to believe that it is registered to, operated or authorised by, or otherwise connected with the [complaint]*". The Appeal Panel also considered the use that had been made of the domain name in that case, dismissing the respondent/appellant's submissions that it had made use of suitable disclaimers and the fact that it offered rather different services (betting as opposed to organising horseracing).

I think those comments also highlight some vital distinctions between Cheltenham Festival and the present case. In my view, they are as follows:

- i. The respondent in Cheltenham Festival registered the domain name in that case with the intention of providing complementary services to the horseracing organised by the complainant – it was providing betting-related services so as to enhance the betting public's enjoyment of the complainant's horseracing business, the two services going hand in hand so to speak. The situation in this case is entirely different: the Respondents, as I have found, registered the Domain Name without any regard to the Complainant's Rights and without advertng to the Complainant's cosmetics business at all. The identity of the Rights with the Domain Name is entirely coincidental.
- ii. For many years, the Respondents operated a legitimate business using the Domain Name. If the Complainant had brought its present complaint at any time before 2003, it would, in my view, have faced major difficulties in getting a transfer of the Domain Name to it based on the evidence I have seen.
- iii. In Cheltenham Festival, the usage of which complaint was made was consistent over the entire period since registration until the Appeal Panel's

decision to order transfer of the domain name. In this case, initial usage was legitimate, followed by two relatively short phases of differing usage (which I shall consider below) and finally by a lengthy phase of no usage at all (other than for private purpose – again, I shall consider this below).

These differences also apply when considering this case against other cases where delay has been a factor e.g.:

- i. DRS08634 emirates.co.uk: in that case, the respondent, owner of a significant portfolio of domain names, had registered the domain name, but had not made any serious business or other use of it, with the website considered in that case simply providing disparate bits of information for travellers interested in going to the UAE. As the Appeal Panel stated, “[t]he Respondent’s use of the Domain Name for the website at [www.emirates.co.uk](http://www.emirates.co.uk) has significantly influenced the Panel’s view of this case. ... [the website] has little value as a source of current, accurate information about the area in question. ... Rather, its use comes across as a vehicle for click-through traffic and a place holder for a valuable domain name.”
- ii. DRS15788 concerned a number of domain names around various spellings of star wars which redirected to a webpage at [www.starwars.co.uk](http://www.starwars.co.uk). These domain names had been registered by a business specialising in all sorts of fancy dress. The websites to be found at the domain names in this case advertised costumes from the Star Wars franchise of films, and clicking on one of them would take the viewer to the respondent’s main business website where they could hire the particular costume in question.

The point is that, in those cases, the domain names in question had apparently been registered with the intention that some sort of business should be conducted, whether generating pay-per-click revenue or selling costumes, and such businesses had been conducted over a consistent period of time before the complaint under the DRS Policy. Since 2008 in this case, on the Complainant’s evidence, there has been no such business and all that exists is a parking page.

#### *The second and third phases*

There has been a vast amount of evidence presented in this case, especially relating to the second and third phases. The Complainant tried to make good some of the deficiencies in its evidence attached to its Complaint by producing further material in its Reply. The Respondents objected, but I accepted the evidence as I wished to see as much evidence as possible for what it was. The consequence of this course of action was for me to permit the Respondents to have a further right to reply, which was only fair in the circumstances. The Complainant sought permission to reply in turn, which I refused, as each party had now had two opportunities to produce evidence and make submissions and it was necessary to bring matters to a conclusion.

Much has been submitted on the question of framing and redirects in this case. The Complainant has presented much evidence relating to no7.com. There is a sense in which what the Respondents did with no7.com has a bearing on the Domain Name: if what they did with no7.com was a flagrant abuse of the Complainant's Rights, then that is some, albeit only some, evidence that they were perhaps more likely to use the Domain Name in an illegitimate manner. However, it comes down to the evidence in the case and I cannot make assumptions without some evidence to support those assumptions. The DRS Policy most certainly does not have a rule to the effect that misuse of one domain name inevitably infects others with the same element in their URL, as if a single act of misuse of one domain name brought all the others down like a house of cards. It comes down to the evidence. I do accept that, if the Domain Name simply redirected to no7.com, and no7.com was being used illegitimately, then that would be as good as showing that the Domain Name was an Abusive Registration – the usage being made of no7.com would be imputed to the Domain Name in that case.

The Complainant has produced no contemporaneous evidence for the Domain Name, but instead uses the Wayback Machine to show that no7.com was used to frame wellbeing.com (registered to the Complainant) for some five weeks between 27 March 2003 and 1 May 2003.

I pause to observe that this is a very short period of time indeed. If the Respondents' intention was to derive illegitimate income from no7.com or indeed from the Domain Name while trading on the Complainant's reputation, this was not a long-term plan or, if it was, it was quickly abandoned.

The Complainant's evidence for no7.com in its third phase relates to the period from 15 December 2004 until 13 January 2007, a period of just over two years.

It should be recalled that the Domain Name was registered in or about 1995: it is not even possible to state with precision when the Domain Name was registered but let me assume that 1995 is the correct date of registration as the parties seem agreed on that. The Respondents have asserted, and I accept from their evidence, that they were running a guesthouse business between 1991 and 2001. I have found that the Domain Name was used to resolve to a website and email service in support of that business. The Complainant is asking me to accept that allegedly illegitimate usage over a period of about 2 years, the last of which ended some nine years ago, out of a total period of registration of some twenty-two years shows current or threatened abuse such that the Domain Name should be transferred. I just do not accept that that can be so.

When one looks at paragraph 5 of the DRS Policy, the grounds in effect being relied on by the Complainant relate to current or future usage: paragraph 5.1.2 of the DRS Policy requires the Complainant to show "*circumstances that the Respondent is using or threatening to use the Domain Name which has confused or is likely to confuse ...*" [emphasis added]. The issue here is that there is no current use other than a parking page (which I consider below) and there is no evidence of any actual threat by the

Respondents to use the Domain Name in such a way as to confuse anybody. The only such evidence would be the evidence of the second and third phases, where the Complainant is in effect asking me to accept this behaviour as indicative of the Respondents' typical behaviour such that the Respondents are capable of doing exactly the same again. The point is that there is no evidence that the Respondents repeated the behaviour over the course of nearly ten years. If the evidence over the last nine years showed intermittent attempts to generate pay-per-click revenue illegitimately e.g. by advertisements to the Complainant's competitors' products, then I would be more inclined to find that paragraph 5.1.2 was engaged. But that is not the evidence in this case.

A similar point could be made about the definition of Abusive Registration, where it provides that it is a Domain Name which "... *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;*" [emphasis added]. The point is that the usage in the second and third phases is not current ("*is being*") and the use of the perfect tense ("*has been used*") rather suggests something in the recent past, or something with effects carrying on to the present.

Of course, it is wrong to subject these words to stringent analysis: the DRS Policy at paragraph 5 gives a "*non-exhaustive list of factors which may be evidence*" of Abusive Registration and does not suggest that the wording should be read like some sort of statute. However, the general sense I get from the DRS Policy is that there has to be some sort of connection between the acts complained of and present or likely confusion – I will not say "nexus" as that imports all sorts of connotations of finding some sort of cause and effect. In my view, it is not possible to say after the cessation of activities some nine years ago that anyone now either is confused or is likely to be confused. In fact, there is no evidence of current confusion by anyone.

When it comes to the evidence presented by the Complainant to support its contentions as to the second and third phases, I have to confess to considerable reservations about it. The Complainant relies on what it calls in its Complaint the "Wayback Machine", but I find it hard to put much reliance on its results. Let me give some examples.

- At paragraph 13.2 of the Complaint, the Complainant states that "*at the time of submission of this complaint, it redirects to www.ace-internet.co.uk as at 2 February 2005 (post-dating the crawl date by two years and therefore clearly an error)*"
- At paragraph 25 of the Complaint, the Complainant refers to "*the limited information available from the Wayback Machine*"
- At paragraph 11.1 of its Response, the Complainant seeks to deal with another anomaly in the Wayback Machine's result, concluding with an inquiry to a director of the Wayback Machine to which he responded to the effect that "*there could be any one of a number of Wayback Machine internal reasons*"

- At paragraph 11.2 of its Response, the Complainant concedes that Mr Nichols, its then solicitor, “*was conducting an initial review of the Domain. ... Mr Nichols has a very clear recollection of the redirection precisely because it was difficult to document using static screenshots; ... With hindsight, video would have assisted ...*”
- At paragraph 11.4 of its Response, it states that “*the Complainant’s solicitors did not take a full record of screenshots from Wayback in April 2017*”
- At paragraph 11.5 of its Response, the Complainant deals with another issue and states that “*this does not show that all 18 originally went to this page, but that Wayback has substituted one result for 18; it does not explain why*”

This point is also made by the Respondents at paragraph 2.8 of their Response, where they state, “*Strikingly, the Complaint focusses [sic] almost exclusively on use of the .com on the apparent pretext that the Wayback results returns [sic] “fewer errors” than the Domain Name (Complaint, 26).*”

Having spent a good deal of time going through the vast amount of evidence presented by the parties and by the Complainant in particular, some of it highly technical, I have serious reservations about the reliability of the evidence of the Wayback Machine presented by the Complainant in this case. To the extent that I can make anything out of it all, I find the Respondents’ explanation given in paragraphs 2.16 to 2.30 of their Response to be the more convincing on the balance of probabilities.

As the Respondents have observed, the results from the Wayback Machine relied on by the Complainant seem to relate by and large to no7.com, not the Domain Name. I cannot assume that the Respondents used the Domain Name in exactly the same way and I would need reliable evidence showing a redirect in force from the Domain Name to no7.com throughout the period of the second and third phases. The Complaint talks a good deal about what the Respondents did with no7.com, but falls short in proving on the balance of probabilities that the Respondents had such a redirect in force or producing evidence to show that the Respondents did exactly the same with the Domain Name as they did with no7.com. I could see that the Respondents would be incentivised to do so – that, having done it for one domain, they would do the same for the other. However, I need evidence in which I can place confidence proving such a proposition on the balance of probabilities. The Complainant has not produced that reliable evidence.

There are further difficulties with the evidence. The Respondents in their Response to the Complainant’s Response also make a point about the unreliability of evidence and the prejudice that they suffer in consequence of seeking to defend allegations about activities taking place some ten years ago. They refer at paragraph 14 of that document to two now missing emails that might have existed: the Respondents’ email to the Complainant in 2003 and the Complainant’s approval of no7.com for inclusion of advertisements via TradeDoubler. I could add to the evidential problems the Complainant’s apparent confusion of its offer for the Domain Name this year not in the sum of £4,000 but of £2,000.

Even after reading the evidence in this case in great detail, I feel that the delay in bringing this Complaint for alleged activities that took place some ten years ago and which have not been repeated, is a cause of actual prejudice to the Respondents.

I note that the second phase is of extremely short duration. If the Domain Name was being used in the manner alleged by the Complainant (redirecting to no7.com which was framing wellbeing.com) this actually tallies with the Respondents' description of what they were seeking to do with no7.com: they were trying to sell the domain to the Complainant and used framing to illustrate the value to the Complainant of the domain. As I have said, the Respondents are disadvantaged in not being able to produce email evidence to support this given the age of the matter, but the brevity of the second phase makes this actually a likely explanation. Even if true, it might still be an Abusive Registration were it continuing today, but the point is that the activities complained of have long since been discontinued, if they ever happened with the Domain Name at all (as opposed to no7.com).

The real problem for the Complainant is illustrated by paragraph 26 of the Complaint, where it states:

*“The passage of time does not excuse such abusive use, and as the expert said in D00012280 (wherelondon.co.uk), “It is irrelevant that the Domain Name is not currently active.” See also (D00009819 (vikingdepot.co.uk) and D00018226 (bookingyeah.co.uk). While they retain ownership, there is nothing to stop the Respondents from reverting to such abusive use (see, for example, DRS02223 (itunes.co.uk)). See also D00008634 (emirates.co.uk), where the Appeal Panel held that “The generally held view amongst Nominet experts (and UDRP panellists) is that delay alone is not a ground on which a Complaint may be denied”, and D00013281 (dailies.co.uk).” [emphasis added]*

The real point is that this case is very unlike those cases where the respondent has been using a domain name illegitimately and in contravention of the DRS Policy for a lengthy period but where the complainant for some reason has simply failed to bring any complaint for a number of years. In this case, uniquely as far as I can tell from previous Decisions under the DRS Policy, the Complainant is asking me to accept that the Respondents' activities of some ten years ago, and not repeated since, is a guide to their current and possible future intentions and to the likelihood of current internet users being confused. I do not accept that. On the contrary, each passing year demonstrates to my mind that the Respondents attempted to earn money from no7.com (and possibly from the Domain Name – but not proved to my satisfaction) but the elapse of such a long period since the end of the third phase, since when the Domain Name has just directed to a parking page, leads me to assume that the Respondents have no current intention of engaging in any abusive activities and would be happy to sell it for a good price to any interested buyer and forget about it.



### *Usage since 2008 – the fourth phase*

I dealt with the first phase above. The Complainant in its description of the last three phases asserts in its Complaint that they are all “*classic examples of cybersquatting*”, with the middle two “*absolutely flagrant abuse*”. Having dealt with the second and third phases, I shall now look at the last (fourth) phase. It is important to note that this is crucial according to my understanding of the DRS Policy: having found that the second and third phases have no continuing effect such that the DRS Policy is engaged, everything depends on the current activities undertaken by the Respondents with regard to the Domain Name. It is perfectly possible for their activities since 2008 to constitute an Abusive Registration notwithstanding that their earlier activities no longer do.

### *Parking page*

The Complainant asserts that the Domain Name has resolved to a parking page since 17 May 2008 until now. The Respondents have explained that they have used the Domain Name and the page to which it resolves for purely private purposes on the odd occasion that they needed it – for photographs, invitations to parties and such like.

I would disagree with the Complainant’s contention that simply having a parking page to which the Domain Name resolves is, of itself and without more, cybersquatting and that it therefore constitutes an Abusive Registration. The reality is that the Respondents have done nothing actively with the Domain Name for nearly ten years other than occasional private usage. They are not obliged to use a Domain Name and paragraph 5.2 of the DRS Policy in fact provides that a failure to use the Domain Name for the purposes of email or a website is not in itself evidence that the Domain Name is an Abusive Registration.

When looking at the webpage to which the Domain Name resolves as included in the evidence, the parking page has no advertisements, and consists of a black screen with text towards the top of the page saying in purple letters, “number seven LONDON”. No-one arriving at this webpage would be confused into thinking that this had anything to do with the Complainant, principally for the following reasons:

- i. It has nothing whatsoever to do with cosmetics, and there is no mention of any sort of products at all.
- ii. There are no links to anything else, such as links to the Complainant or any of its competitors.
- iii. The Complainant has submitted that it trades in a wide variety of goods, not just cosmetics, but there is nothing to suggest any sort of connection with any products at all of any type.
- iv. It has no sort of advertising or association with the Complainant, its competitors or anyone else.
- v. The style and get-up has nothing to do with the examples of how the Complainant’s “NO 7” cosmetics products are branded and marketed as

disclosed in its evidence; the “get-up” of the Complainant’s products is completely different.

- vi. The fact that it specifies “number seven LONDON” with the geographical designation of “London” limits the application of the wording and its relevance: no-one interested in the Complainant’s global cosmetics brand would think for one minute that they had landed on a website in any way connected to, authorised by or operated by the Complainant, let alone run by it.

I should add for completeness that, for these reasons, I do not see paragraph 8.5 of the DRS Policy as engaged either.

### *Sale of the Domain Name*

A related matter to having the parking page is the willingness of the Respondents to sell the Domain Name. The Complainant evidences a listing of the Domain Name on Sedo, looking for a sale in the sum of £50,000 with £10,000 as a minimum. The Complainant gives comparisons with the prices being asked for other domain names comprising the formula “no[number]”.com or .co.uk, and demonstrates that the prices asked are substantially lower. I accept that evidence.

The Complainant also asserts that it made an offer of £4,000 in February 2017: the Respondents dispute this and say that the offer was only of £2,000. The Complainant in its Reply says that its agent was instructed to offer £4,000. It has not been able to produce relevant records to show that.

The selling of domain names for an inflated price is relevant to paragraph 5.1.1 of the DRS Policy which provides, in so far as is relevant, that evidence of an Abusive Registration can be found where there are

*“circumstances indicating that the Respondent has registered ... the Domain Name primarily ... 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”*. [emphasis added]

As I found above, the Respondents had perfectly legitimate reasons for registering the Domain Name and had no intention at that time of seeking to demand money from the Complainant far in excess of their costs. The paragraph is only engaged where the original registration of the Domain Name had that primary purpose. That is not the case here.

It is perfectly legitimate to find oneself with a domain name which has value to a number of potential purchasers. The Respondents have referred to both the Complainant and Jack Daniels as well as other businesses who might be potentially interested in the Domain Name because they share the same branding. There is no reason why the Respondents should not in effect auction the Domain Name now

that it has outlived its original usefulness to them provided they do not engage in abusive activities under the DRS Policy in doing so. The Complainant refers to various decision of Experts in other cases (e.g. DRS02223 itunes.co.uk) to support its case that simply offering to sell a domain name to a complainant or one of its competitors is of itself an Abusive Registration; however, there is no evidence that the Respondents are threatening to sell the Domain Name to a competitor of the Complainant and the only evidence is that they are demanding a price beyond what the Complainant is willing to pay.

The Complainant at paragraph 30 of its Complaint states that the “*highly inflated sums [the Respondents] are looking for demonstrate that the party they are intending to sell it to is the Complainant or one of its competitors*”. I would disagree: Jack Daniels, for example is not a competitor of the Complainant, nor is any of the other businesses in Exhibit 12 to the Response, and the Complainant has not produced any other evidence to show which of its competitors might be interested in acquiring the Domain Name. The Domain Name might have inherent value because there are various interested parties which potentially wish to acquire it, something that is not necessarily true of e.g. “no17.co.uk” which corresponds (as far as I know) to nobody’s brand. Furthermore, there is no evidence that the Respondents have made any sort of threats to the Complainant to sell the Domain Name to one of its competitors unless an exorbitant sum is paid for it.

To put it bluntly, I cannot see any particular reason why I should direct transfer of the Domain Name to the Complainant as opposed to the owner of the Jack Daniels brand. Depending on the individual tastes and viewpoint of an internet user, he or she could see “No 7” on its own and think straightaway of either the Complainant’s cosmetics or of a brand of whisky. In that respect, this case is unlike Cheltenham Festival, where the Appeal Panel found that there was really only one association that the average internet user would make when seeing “Cheltenham Festival”. There were other festivals claiming to be held at Cheltenham, but absolutely nothing with anything like the name or reputation of the complainant’s activities in that case.

I therefore find that the Respondents’ usage since 2008 does not amount to an Abusive Registration.

I also considered more generally whether there were other grounds for finding Abusive Registration which are not mentioned in paragraph 5 but concluded that there are not. For the reasons given above, I have concluded that the Domain Name is not an Abusive Registration.

## **7. Decision**

I order that there should be no transfer.

**Signed Richard Stephens**

**Dated 27 November 2017**