

DISPUTE RESOLUTION SERVICE

D00020494

Decision of Independent Expert

The Brighton & Hove Albion Football Club

and

Mr Dave Bantock

1. The Parties:

Complainant: The Brighton & Hove Albion Football Club
Brighton
United Kingdom

Respondent: Mr Dave Bantock
Brighton
United Kingdom

2. The Domain Name(s):

brightonseagulls.co.uk
brightonseagulls.uk

3. Procedural History:

The Expert has confirmed (1) he is independent of each of the parties; and (2) to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need to be disclosed because they might be of such a nature as to call into question his independence in the eyes of one or both of the parties.

07 August 2018 13:43 Dispute received
09 August 2018 12:18 Complaint validated

10 August 2018 11:05 Notification of complaint sent to parties
14 August 2018 16:20 Response received
14 August 2018 16:23 Notification of response sent to parties
17 August 2018 02:30 Reply reminder sent
20 August 2018 17:28 Reply received
20 August 2018 17:28 Notification of reply sent to parties
20 August 2018 17:29 Mediator appointed
23 August 2018 10:17 Mediation started
02 October 2018 14:45 Mediation failed
02 October 2018 14:46 Close of mediation documents sent
08 October 2018 11:41 Expert decision payment received

4. Factual Background

The Complainant is an English football club that runs a team currently playing in the Premier League. The Respondent is an individual in the Brighton area who registered the Domain Names in April 2017.

In August 2018 the Respondent advertised the brightonseagulls.co.uk Domain Name, together with brightonseagulls.com as “website for sale” in the rear window of a car (part copied below), giving a mobile telephone number as a means of contact (telephone number omitted from full view of advertisement on data protection grounds).



This advertisement led to contact from representatives of the Complainant by telephone on 3 August 2018, asking for voluntary transfer of the Domain Names to the Complainant, which the Respondent declined to do.

The Domain Name brightonseagulls.co.uk has also been offered for sale on a website www.picclick.co.uk for £3000, and on another website www.friday-ad.co.uk it has been offered for sale with brightonseagulls.com for £500.

5. Parties' Contentions

Complainant Rights

The Complainant claims registered and unregistered rights in trademarks for the words "BRIGHTON AND HOVE ALBION", and "SEAGULLS" and for the club crest incorporating a seagull and the words Brighton and Hove Albion (below). All three marks are registered for a variety of goods and services in the United Kingdom.



The Complainant was founded as a club in 1901, and the company was incorporated in 1904. It is nicknamed and widely known as the "Seagulls", and as a Premier League club enjoys extensive national and international media coverage. Inter alia, it has its own TV Channel, "Seagulls TV". Among its websites are the club's official site at www.brightonandhovealbion.com and www.seagulls.co.uk (which redirects to the official site). It owns the domain names for those sites, among others.

The Complainant says that the combination of "Brighton" and "Seagulls" in the Domain Names will therefore be understood to refer to the Complainant as a combination of its club name and nickname. A Google search for "brighton seagulls" and "seagulls" returns the Complainant's website/business as the top result.

Abusive Registration

The Complainant says that when it became aware of the advertisement in a rear car window in August 2018 offering to sell the Domain Name brightonseagulls.co.uk and the domain name brightonseagulls.com it made further enquiries, which revealed that the Respondent was also the registrant of the Domain Name, brightonseagulls.uk. In a telephone call to the Respondent on 3 August 2018, he was asked to transfer the Domain Names voluntarily to the Complainant, but declined to do so, asking for a "reasonable fee", but otherwise inviting the Complainant to take legal action. Further internet research by the Complainant using the mobile number given in the car advertisement revealed additional offers for sale on www.picclick.co.uk and www.friday-ad.co.uk. The former offered to sell the Domain Name brightonseagulls.co.uk for £3000, the latter that Domain Name and

brightonseagulls.com for £500. Both used the Complainant's trademarks without its consent.

The Respondent is not known to and has no connection with the Complainant.

The Complainant relies upon several of the non-exhaustive list of factors which might indicate that a domain name registration is abusive in paragraph 5.1 of the DRS Policy.

(a) Primarily registered for purposes of selling/renting/transferring the Domain Names (paragraph 5.1.1.1 DRS Policy)

The Complainant relies upon the advertisements referred to above, and says that the Respondent's intention was to sell the Domain Names to it or to a competitor for valuable consideration in excess of the Respondent's out-of-pocket costs directly associated with acquiring or using the Domain Names.

(b) Primarily registered to unfairly disrupt the Complainant's business (paragraph 5.1.1.3 DRS Policy) and as a blocking registration (paragraph 5.1.1.2 DRS Policy)

Having refused to transfer the Domain Names voluntarily, the Respondent continues to offer the Domain Names for sale in the vicinity of the Complainant's business, causing unfair disruption to the Complainant's business, and blocking it from registering the Domain Names itself.

(c) Likely to confuse internet users (paragraph 5.1.2 DRS Policy) and match to a mark in which the Complainant has rights (paragraph 5.1.6 DRS Policy)

The use of the terms "brighton" and "seagulls" together creates an immediate connection to the Complainant's business, which use is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant has a substantial reputation in a mark which matches the Domain Names, and the Respondent does not use that name, does not have an active website operating at the Domain Names, and has otherwise made no bona fide or legitimate use of the Domain Names.

(d) Respondent has engaged in pattern of conduct (paragraph 5.1.3 DRS Policy)

The Respondent uses the online alias "mr-jamesbond", and in that guise offers for sale a number of domain names which include other well-known names or trade marks, including mrjamesbond.co.uk, primeministerborisjohnson.co.uk, chelsea-fc.com, jay-z.club, fatboy-slim.com and formula1cars.com, among a total of at least 94 similar registrations. The Complainant says that the Respondent does not have any apparent rights to those names, the Respondent is therefore engaged in a pattern of such registrations, of which the Domain Names are part of the pattern.

The Complainant seeks transfer of the Domain Names to itself.

Respondent Rights

The Respondent does not appear to contest the Complainant's Rights relevant to the Domain Names.

Abusive Registration

The Respondent claims that he is only custodian of the Domain Names (and others) for his son, who is 15, and who owns the domain names. His son is autistic/ADHD, and has been unable to attend school for 2 years due to his disability. This has left him at home, and looking for a focus and something to do. This coupled with his son's addictive personality meant that many domain names were purchased, some of which were "maybe a little 'borderline' in respect of being close to an existing company name but certainly not out of a deliberate nature".

The Respondent says that the advertisement in the car window was "maybe being a bit creative with the sign", but that it was taken down after the phone call from the Complainant in August 2018. The Complainant (whose representative did not identify himself in the phone call) demanded that the Domain Names should be handed over, and never discussed the purpose of the sign, or whether an agreement could be reached to pay compensation for the costs to effect a transfer.

The Domain Names were purchased in order to start a fan-based website, and then advertised for sale in order to attract a like-minded person to "maybe invest in the the website and retain/teach my son how to get it started". The Respondent denies that a "dodgy sign" in the back of an old car is evidence of a professional domain name pirate seeking to extort vast sums, and says he has never approached the club seeking to sell the Domain Names in order to extract large sums of money.

The Domain Names were freely available, and had not been acquired by the Complainant. By bringing this complaint, the Complainant therefore "appears to be a chancer out to blag a couple of free domains which have no more value than an overpriced seagull sandwich".

Reply

The Complainant notes that the Respondent is the registrant for these and other domain names. He uses his own mobile phone number as the contact, and is the Respondent to ongoing parallel proceedings under the UDRP in respect of the brightonseagulls.com domain name.

The Complainant gives a different version of the conversation on 3 August 2018 to that provided by the Respondent. It says the Respondent said that they get contacted all the time in respect of their domain name registrations, and they would only agree to transfer the Domain Names in exchange for payment. He said that

their experience with other domains meant that they were aware that reclaiming the Domain Names would involve a long legal process.

The online advertisements do not show any sign of the Respondent wanting to set up a fan-based website or to attract investment. The wording of the advertisements includes the following (from www.friday-ad.co.uk): "Great businesses start with a great name and will be remembered or hold for resale/investment. Apply to a website / rent them out / attach to your existing business to get instant recognition / build a trade page for other traders to advertise or store them for future use. BRIGHTONSEAGULLS.COM / BRIGHTONSEAGULLS.CO.UK / BRIGHTONSEAGULLS.CLUB / BRIGHTONSEAGULLS.NET / BRIGHTONSEAGULLS.INFO / BRIGHTONSEAGULLS.UK. Available individually or to buy as one lot to protect the brand".

The sums being sought are far in excess of any domain acquisition costs.

The delay in taking action is explained by the Complainant having only recently become aware of the Respondent's registration and offer for sale of the Domain Names as a result of the car window advertisement.

Respondent's further submission

The Respondent has subsequently sought to introduce further material by way of a non-standard submission. However, the Expert declined to consider it as the explanatory paragraph did not demonstrate any exceptional need for its admission outside the procedure set out in the DRS Policy.

6. Discussions and Findings

In order to succeed in its Complaint, in accordance with the Policy, the Complainant needs to establish:

- "i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration."*

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is as follows:

"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".*

The definition of Rights under the Policy is 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.”

Rights

The Respondent does not contest the Complainant’s assertion that it has relevant Rights. Nevertheless, the Complainant must show that it does so, on the balance of probabilities.

The Complainant does not specifically claim to have established Rights in the mark “BRIGHTONSEAGULLS”, which would be identical to the Domain Names. Instead, its contention is that its established rights in the names “BRIGHTON & HOVE ALBION” and “SEAGULLS” mean that the combined name “Brighton Seagulls” would be understood to refer to the Complainant. It also points to a Google search for “brighton seagulls” returning the Complainant’s website as the top result. However, this falls short of an assertion that those attributes would give the Complainant enforceable rights in the name or mark BRIGHTONSEAGULLS itself within the meaning of the DRS Policy.

This leaves the Expert uncertain as to how the Complainant puts its case, in terms of the wording of the DRS Policy. However, it needs to be borne in mind that the hurdle of establishing Rights is intended to be a relatively low level one which establishes a party’s bona fides for bringing a complaint. Without further evidence, the Expert does not feel able to find that the Complainant has established Rights in the identical mark “BRIGHTONSEAGULLS”. However, the words “and Hove Albion”, whilst formally part of the Complainant’s identity, are often lost in an abbreviation of the club’s name to “Brighton”, and are of secondary significance (while no doubt important to the residents of Hove). The Complainant has established rights in both the longer club name and “SEAGULLS”. It seems to the Expert that the combination of the shortened club name (Brighton) and Seagulls in the Domain Names is sufficiently similar to the Complainant’s marks that the Complainant succeeds in establishing Rights on the balance of probabilities.

Abusive Registration

The Complainant relies upon various of the factors set out in paragraph 5 of the DRS Policy which provides, in relation to Abusive Registration:

“A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:.....”.

Before going on to consider the merits of the Complainant’s contentions, the Expert would note that paragraph 8.4 of the DRS Policy provides: *“Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.”*

Looking at the merits, in this case, the Complainant has relied upon 6 different subparagraphs within paragraph 5 of the DRS Policy as evidence of abusive registration. However, there is little detail in the argument presented in respect of each – more often that not the submission is effectively a repeat of the wording of the DRS Policy, with an assertion that this applies in this case. Taking two examples, the Complainant relies upon paragraphs 5.1.1.3 and 5.1.1.2 together, which deal with unfair disruption to its business and blocking registration. However, the complaint in relation to unfair disruption relies upon the car window advertisement appearing near the club’s ground. It is not explained what business of the Complainant this is disrupting, and how. The complaint about blocking registration is unparticularised – why would the Complainant want to register the Domain Names, and why would the Respondent want to stop it doing so? The Complainant also relies upon paragraph 5.1.6, which would require it to establish that it has a substantial reputation in a mark which matches the Domain Names (ie in BRIGHTON SEAGULLS), but it does not at any stage say that it uses that mark or has established goodwill in such a mark, only that the use of those terms together creates an immediate connection to the Complainant.

However, the Respondent has admitted that some of his registrations are “borderline” and that the car window advertisement was “maybe being a bit creative”. He advances an explanation which seeks to put at least some of the blame for the registrations on his unnamed son, but without any supporting evidence. His only attempt to justify the purpose behind the registrations of the Domain Names is that they were purchased in order to start a fan-based website, and advertised in order to seek investment in such a website, or help for his son. Again, this is totally unsupported by evidence, and appears to be contradicted by the wording of the advertisements, which just offer the Domain Names for sale, or as a useful point to start a business from/addition to an existing business. There is no suggestion at all in the advertisements that the website is a fan-based one, or that he is seeking investment in his own or his son’s venture. In short, he is trading in domain names, which he thinks might be attractive to potential purchasers for some reason, and seeking substantial payments for those domain names. This, as noted above, is not of itself unlawful.

It seems to the Expert that the real issue here is whether he has overstepped the mark in his choice of attractive domain names, by choosing domain names which are “close to an existing company name”, as the Respondent himself puts it. In this case, there can be no doubt that the Respondent was aware of the Complainant and its trade marks when he registered the names, and intended the Domain Names to be seen as referencing the Complainant and its business in some way. The advertisement in the car window itself demonstrates this very clearly, by not only advertising the Domain Names, but also using the club crest (another registered trade mark) alongside the advertisement to do so. Even the suggestion in the Response that the accompanying website was supposed to be fan-based acknowledges the likely link between the Domain Names and the Complainant. The Respondent has also not explained the other registrations in his name highlighted by the Complainant, which appear to incorporate well-known names or trade marks in

which he has no apparent legitimate interest (such as James Bond, Fatboy Slim and Chelsea F.C, which are all registered marks). He is using those names or trade marks because he believes that this will increase the attraction of the domain names to potential purchasers, and in doing so is taking unfair advantage of them.

The Expert therefore considers that the Respondent has overstepped the mark, and that the registrations of the Domain Names fall squarely within the definition of Abusive Registration in the DRS Policy, as *“a Domain Name which... 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”*. It may well be, as the Complainant contends, that this is part of a pattern of such registrations, which would bring it within paragraph 5.1.6 of the DRS Policy. Although the Domain Names are currently parked, and are not identical to the Complainant's marks, any use of the Domain Names for a website could also lead to at least initial interest confusion on the part of a visitor to the site. Other contentions put forward by the Complainant are less persuasive (at least in their current form). However, the Expert agrees with the Complainant that, overall, the registration of the Domain Names took unfair advantage of its Rights, and was therefore abusive.

7. Decision

The Expert finds that the Complainant has Rights in the names or marks BRIGHTON AND HOVE ALBION and SEAGULLS, which in combination are similar to the Domain Names, and that the Domain Names in the hands of the Respondent are Abusive Registrations. The Expert therefore directs that the Domain Names be transferred to the Complainant.

Signed Bob Elliott

Dated 21 October 2018