



DISPUTE RESOLUTION SERVICE

D00022578

Decision of Independent Expert

The Church of Jesus Christ of Latter-day Saints

and

R. Sebald

1. The Parties

First Complainant:

The Church of Jesus Christ of Latter-day Saints
50 East North Temple Street
Salt Lake City
Utah
84150
United States

Second Complainant:

Corporation of the President of The Church of Jesus Christ of Latter-day Saints
50 East North Temple Street
Salt Lake City
Utah
84150
United States

Third Complainant:

Intellectual Reserve, Inc.
50 East North Temple Street
Salt Lake City
Utah
84150
United States

Respondent: R. Sebald
Hamburg
Germany

2. The Domain Name

<churchofjesuschrist.org.uk>

3. Procedural History

20 April 2020 16:56 Dispute received
21 April 2020 09:05 Complaint validated
21 April 2020 09:19 Notification of complaint sent to parties
11 May 2020 02:30 Response reminder sent
13 May 2020 08:51 Response received
13 May 2020 08:51 Notification of response sent to parties
18 May 2020 02:30 Reply reminder sent
20 May 2020 14:02 Reply received
20 May 2020 14:02 Notification of reply sent to parties
20 May 2020 14:03 Mediator appointed
20 May 2020 15:56 Mediation started
10 June 2020 15:10 Mediation failed
10 June 2020 15:11 Close of mediation documents sent
22 June 2020 02:30 Complainant full fee reminder sent
22 June 2020 12:45 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties. 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, that need be disclosed as they might be of a such a nature as to call into question his independence in the eyes of one or both of the parties.

4. Factual Background

The First Complainant is a religious organisation, also known as The Mormon Church. The Second and Third Complainants are not-for-profit organisations operating under the control of the First Complainant. The three Complainants together are referred to as “the Complainant” in the remainder of this Decision.

The Complainant is the owner of various trademark registrations, including European Union Trade Mark number 13365879 for the word mark CHURCH OF JESUS CHRIST

OF LATTER-DAY SAINTS, registered on 18 May 2015 in Classes 9, 16, 41, 42, 43, 44 and 45.

The Domain Name was registered on 9 October 2018.

The Domain Name has been used to resolve to a website at “www.mormonenaustritt.de”. According to a screenshot dated 24 March 2020, the website was headed “Mormon Exit” and “Leave the Mormon church with GDPR” and provided information about leaving the Mormon Church.

5. Parties’ Contentions

The Complaint

The Complainant states that it was founded in 1830 and has over 16 million members worldwide, with 67,000 missionaries operating where permitted throughout the world. It states that it has had an active presence in the UK since 1837 and had an estimated 187,415 church members in the UK as of March 2020.

The Complainant submits that, in addition to operating as a Christian church, it provides charitable and eleemosynary activities for the benefit of families and individuals throughout the UK. It states that all such activities are provided under its CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS trademark.

The Complainant submits that it is regularly referred to, particularly by its members, by the shortened name CHURCH OF JESUS CHRIST. It states that, as of December 2019, it was the registrant of 85 domain names which included this phrase and that it has used the domain name <churchofjesuschrist.org> since January 2019.

The Complainant submits that it relies on both registered and unregistered trademark rights accordingly.

The Complainant contends that the Respondent registered the Domain Name primarily for the purpose of disrupting its business. It also contends that the Domain Name is being used in such a way as to confuse people or businesses into believing that it is operated or authorised by, or otherwise connected with, the Complainant. It contends that the Domain Name is identical to other domain names used by the Complainant and that Internet users will assume that the Domain Name belongs to the Complainant.

The Complainant submits that the website to which the Domain Name relates is a German-language website and that the Respondent registered the Domain Name specifically for the purpose of driving UK traffic to that website.

The Complainant states that the purpose of the website in question is to encourage or facilitate people to leave the Mormon Church and/or to have their information

removed from the Complainant's records. It states that this is clearly contrary to the aims, purpose and very existence of the Complainant's organisation.

The Complainant alleges that the Respondent registered the Domain Name deliberately to impersonate the Complainant. The Complainant submits that the Domain Name is inherently confusing and will inevitably mislead Internet users who are looking for the Complainant's website. The Complainant submits that the registration of a domain name that amounts to impersonation cannot be legitimate in any circumstances (*Clydesdale Conservatories Limited v. Lawton* [2006] DRS 03161).

The Complainant submits that, in the case of criticism websites, the nature of the domain name is crucial (*Rayden Engineering Limited v. Charlton* [2009] DRS 06284). It distinguishes domain names such as "<ihatecomplainant.co.uk>", which make clear the purpose of the website, from one which uses a domain name identical to the Complainant's trademark with the intention of misleading Internet users. The Complainant submits that the Respondent has clearly chosen a domain name which impersonates the Complainant in order more effectively to attract traffic to its website.

The Complainant requests the transfer of the Domain Name.

The Response

The Respondent strongly disputes the Complainant's claim. In particular, he argues that while the Complainant may have trademark rights in the name CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS, it does not have any enforceable rights in the name CHURCH OF JESUS CHRIST. He contends that the latter term is entirely generic and descriptive, describes the whole of Christianity and must therefore be deemed to be in the public domain.

The Respondent relies on *Loans.co.uk Ltd v. Abbeyway Contracts Ltd & Anor* [2004] DRS 01399 (domain name <loans.co.uk>) for the proposition that a complainant cannot rely on a name that is wholly descriptive of its business.

The Respondent submits that the Complainant has falsely sought to suggest that it has longstanding rights in the shortened name, CHURCH OF JESUS CHRIST. He states that the distinctive element of the Complainant's trademark is LATTER-DAY SAINTS, as evidenced by the fact that it is widely known as "the LDS Church". The Respondent contends in particular that the Complainant used the term LDS for the purposes of its primary websites, social media accounts and communication to the public until 2019.

The Respondent refers to the Wikipedia entry for CHURCH OF JESUS CHRIST which states that the term: "... may refer to: the body of all persons that share faith based in Christianity..." He points out that Wikipedia also cites four other churches, not connected with the Complainant, that use the term CHURCH OF JESUS CHRIST as

part of their name. He also refers to the use by the Catholic Church of the term CHURCH OF CHRIST.

The Respondent contends that it was only in January 2019 that the Complainant replaced its primary domain name <lds.org> with <churchofjesuschrist.org>, having acquired that domain name from a third party in October 2018. He says that there is another, unconnected, church that has registered <thechurchofjesuschrist.net>, <thechurchofjesuschrist.com> and <thechurchofjesuschrist.org>, all of which differ from the Complainant's domain only by the use of the word "the", which demonstrates that the term is in common use.

The Respondent states that the Complainant's own guidance states that the full name, "the Church of Jesus Christ of Latter-day Saints" is preferred and that the use of "the Church of Jesus Christ" is encouraged only where a second, shortened, reference is need. The Respondent (who volunteers that he is a former Mormon missionary) says that there are specific reasons why the LATTER-DAY SAINTS element is important to the Complainant and refers to the Complainant's teachings and scriptures in this regard.

The Respondent states that, in a US Supreme Court hearing in 2019, the Complainant filed a statement to the effect that religious trademarks are often comprised of terms such as "church", "God" and "Jesus Christ" and that it is particular combinations of these terms that makes them distinctive. He states that it is also in line with UK and other trademark laws not to dissect a trademark, but to consider the overall impression which it makes.

The Respondent submits that the Complainant has failed to establish that the term CHURCH OF JESUS CHRIST has acquired any secondary meaning for trademark purposes that makes it distinctive of the Complainant. He reiterates that its distinguishing names are "the LDS Church" or "the Mormon Church" and states that the Complainant has invested considerable sums in promoting the distinctive name "Mormon" in particular. He contends that the Complainant cannot establish a secondary meaning in the name CHURCH OF JESUS CHRIST simply by registering a large number of domain names and investing in search engine optimisation.

The Respondent submits that the Complainant is defined by most Christian churches as a non-Christian cult, that it has been established for only 200 years and that its membership is insignificant in terms of worldwide Christian faith. He says that, if the Complainant were permitted to enforce rights in the name CHURCH OF JESUS CHRIST, then an organisation which represents only 0.69% of the worldwide Christian population would have gained exclusive control of this term.

The Respondent also denies that the Domain Name represents an abusive registration.

The Respondent states that he registered the Domain Name on 9 October 2018, whereas the Complainant did not acquire the domain <churchofjesuschrist.org> until

15 October 2018, having bought it from another church. The Complainant did not then use that name until January 2019.

The Respondent denies that he is disrupting the business of the Complainant, since the Complainant is not a business but a church. He submits that the Complainant is a tax-exempt, non-profit organization which does not make any commercial use of any trademark or domain name rights.

The Respondent states that he is not in any event disrupting the Complainant's activities, as the website to which the Domain Name directs is expressly directed to people who have already decided to leave the Complainant's church. He submits that the website also contains information for people who have already left the organisation as to how to have their data deleted on the basis of the GDPR and that it cannot be unfair to inform people of their statutory rights in that way. The Respondent contends that the website fairly criticises the Complainant's practice of violating GDPR rights by failing to delete data and that he is making legitimate non-commercial or fair use of the Domain Name accordingly.

The Respondent further submits that the website in question does not interfere with the Complainant's mission, which is: "... to help us meet the challenges of this life and to help us follow Jesus Christ, so that we will be worthy of the temporal and spiritual blessings God wants for us."

The Respondent further submits that it is clear from the content of the website that it is not operated or authorised by the Complainant. The Respondent says that he has added a trademark attribution notice to it as a sign of goodwill. He specifically denies that the website impersonates the Complainant.

The Respondent asserts that under the Copyright, Designs and Patents Act 1988, a party is permitted to make fair use of a trademark for the purposes of criticism or review.

The Respondent states that he has further plans for the Domain Name, which will include providing fair information about diverse churches in comparison to the biblical church of Jesus Christ.

The Reply

The Complainant takes issue with the Respondent's claim that it has not used the shortened name CHURCH OF JESUS CHRIST in a manner that gives rise to any rights. The Complainant says that it has long used and encouraged the use of this shortened name and that it stated in its 2012 style guide: "When a shortened reference is needed, the terms 'the Church' or 'the Church of Jesus Christ' are encouraged."

The Complainant states that its claim against the Respondent amounts to passing off, which does not require a monopoly right. It submits that the relevant test is whether it had acquired goodwill in the name in question at the date the Domain

Name was registered. The Complainant accepts that it is referred to by a number of different names, but submits that this does not mean that it is not known by any of those names.

The Complainant submits that the Respondent has not disputed that the “Mormon Exit” website refers to the Complainant and it is obvious that he intended that the Domain Name should be seen as referring to the Complainant. The Complainant states that the website can be seen by anyone who accesses it, regardless of whether they have already decided to leave the Mormon Church. The Complainant adds that the website in question had been operating before the registration of the Domain Name and the Respondent clearly registered the Domain Name in order to drive additional traffic to that site.

The Complainant submits that the Respondent registered the Domain Name in October 2018, in direct response to an announcement by the Complainant on 16 August 2018 concerning revisions to its style guide, referring to the use of the shortened name CHURCH OF JESUS CHRIST and to its websites.

The Complainant contends that it is irrelevant that it is not operating a commercial business. It states that it provides religious and charitable services and that the protection of its goodwill is of great importance to it.

The Complainant submits that the Copyright, Design and Patents Act is of no relevance to this matter as this is not a copyright infringement claim.

6. Discussions and Findings

This Complaint falls to be considered under the terms of the Nominet UK DRS Policy (“the Policy”).

Under paragraph 2 of the Policy:

- “2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:
- 2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - 2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration
- 2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”

Paragraph 5 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has established that it is the owner of a trademark registration for the word mark CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS. On the basis of the Complainant's evidence, which the Respondent does not dispute, the Panel finds that this trademark is widely recognised throughout the world as referring to the Complainant and its organisation.

The Domain Name is <churchofjesuschrist.org.uk>. While the Domain Name is identical to the first part of the Complainant's trademark, the Respondent argues that the term CHURCH OF JESUS CHRIST is an insignificant part of that trademark and is wholly descriptive of the Complainant's activities in any event. The Respondent contends that the distinctive element of the Complainant's trademark is LATTER-DAY SAINTS and that it has no exclusive or enforceable rights in the term CHURCH OF JESUS CHRIST, which is descriptive of the whole of Christianity.

It should be noted at this point that the Complainant is not required by the Policy to prove that it has enforceable Rights in the shortened term CHURCH OF JESUS CHRIST. Having established that it has Rights in the trademark CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS, its obligation under the Policy is to show that that trademark is identical or similar to the Domain Name.

The Expert also observes that, as stated in paragraph 2.3 of the DRS Experts' Overview:

“... the first hurdle (i.e. proving the existence of rights in a relevant name or mark) is intended to be a relatively low-level test... The objective behind the

first hurdle is simply to demonstrate a bona fide basis for making the complaint.”

The term CHURCH OF JESUS CHRIST comprises the first part of the Complainant’s trademark CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS. In the view of the Expert, it is also a material part of that trademark, in the sense that a significant number of members of the public are likely to believe that the Domain Name represents a shortened version or abbreviation of that trademark.

The Expert finds in the circumstances that that the Complainant has Rights in a trademark that is similar to the Domain Name.

Abusive Registration

In the view of the Expert, there can be no serious doubt that the Respondent registered the Domain Name with the Complainant’s name and trademark in mind. While the Respondent contends that the Domain Name comprises a form of words that is descriptive of Christianity generally, he does not dispute that the Domain Name resolves to a website at “www.mormonenaustritt.de” which is headed “Mormon Exit”, refers to the Complainant and is intended for the consumption of past and present members of the Complainant’s church.

While the Respondent denies that the Domain Name impersonates the Complainant, the Expert finds that the Domain Name is inherently confusing since, as observed above, a significant number of members of the public are likely to believe that the Domain Name <churchofjesuschrist.org.uk> represents a shortened version of the Complainant’s trademark CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS.

The Expert expresses no view on the merits of the content of the website to which the Domain Name resolves. However, in accordance with generally accepted principles of freedom of expression, a party is entitled to criticise another party, including via the medium of a website, providing it does so lawfully. The Policy specifically provides for this contingency by way of paragraph 8.1.1.3, which recognises that a respondent may be able to establish that a registration is not abusive where it is has made “legitimate non-commercial or fair use” of the relevant domain name.

What a respondent may not do, however, is to impersonate a trademark owner for the purpose of misleadingly diverting Internet traffic to a website which attacks that trademark owner. In this regard, the Complainant rightly makes a distinction between domain names such as “<ihatecomplainant.co.uk>”, from which the purpose of any connected website is inherently clear, and one utilises a complainant’s trademark with the intention of misleading Internet users. Previous decisions under the DRS have clearly upheld this principle, e.g. *GuideStar UK v. Wilmington Business Information Limited* [2005] DRS 02193 in which the Appeal Panel observed:

“Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned... Ordinarily, it would be tantamount to impersonating the person whose name it is. Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy.”

In *Rayden Engineering Limited v. Diane Charlton* (cited above) the Appeal Panel considered a case in which the respondent had used a domain name identical to the complainant’s trademark to redirect to a site which contained criticisms of the complainant. The Appeal Panel stated:

“The Respondent has deliberately used the Complainant's trade mark as a designation for her protest site without adding any additional component that would identify it as such. She is thereby creating a likelihood of confusion with the Complainant and attracting Internet users who would not knowingly follow a “...sucks” link. The Respondent does not argue, and there is no scope for maintaining, that the Domain Names are intended to refer to anything or anyone but the Complainant.”

The Expert considers the present case to fall squarely within the approach taken by these earlier cases and others. While in this case the Domain Name is not identical to the Complainant’s trademark, the Expert finds it to be similar to a misleading extent and infers in all the circumstances of the case that it was chosen deliberately to attract Internet users expecting to find a website operated or authorised by the Complainant.

The Respondent makes the point that it would be obvious to anyone visiting the Respondent’s website that it was not owned or operated by the Complainant. While that may be the case, that does not sufficiently address the mischief caused by a domain name that is inherently misleading in nature, namely the concept of “initial interest confusion”. Having attracted an Internet user to its website by virtue of the inherently misleading Domain Name, the Respondent has already gained an unfair advantage by securing that user’s attention to the website before the visitor realises it is not the Complainant’s. As observed in *Rayden Engineering*, the position might have been different if the Respondent had added a component to the Domain Name which fairly indicated the true purpose of the name.

Nor is the Expert persuaded by the Respondent’s arguments that the website is aimed only at those who have already decided to leave the Complainant’s church, or who want to obtain information about the deletion of their data under GDPR. The Expert accepts the Complainant’s submissions that the content of the website is intended to disrupt the Complainant’s activities, and regardless of whether such disruption is considered to be legitimate or not, the Respondent is not entitled to impersonate the Complainant for that purpose.

As to the Respondent's objection that the Complainant does not operate a "business", the Panel is of the view that this term must be sufficiently widely construed to include the Complainant's religious and charitable activities: the Policy is not intended to protect only commercial interests.

In the circumstances, the Expert finds on the evidence that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 5.1.1.3 of the Policy). The Expert further finds that the Respondent is 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 (paragraph 5.1.2 of the Policy).

In consequence of both such findings, the Expert concludes that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The Expert considers it important to address the Respondent's assertion that a finding in favour of the Complainant would in some manner invest the Complainant with exclusive rights in the term CHURCH OF JESUS CHRIST. That assertion is incorrect for the reasons set out above. In accordance with the requirements of the Policy, the Complainant has established that it has Rights in the trademark CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS, that the Domain Name is similar to that trademark, and that the Respondent registered and has used the Domain Name in a manner that took unfair advantage of, or was unfairly detrimental to, the Complainant's Rights.

7. Decision

The Complainant has established that it has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complaint therefore succeeds and the Expert directs that the Domain Name be transferred to the Complainant.

Steven A. Maier
Independent Expert

8 July 2020