

Nominet UK Dispute Resolution Service

DRS Complaint No 05311

Decision of Independent Expert

1. Parties

Complainant: Joelson Wilson & Co
Address: 30 Portland Place
London

Postcode: W1B 1LZ
Country: GB

Respondent: Digital Assets Inc
Address: Unit 2982C
34 Eglinton Avenue West
Toronto
Ontario

Postcode: M4R 2H6
Country: CA

2. Domain Name

joelsonwilson.co.uk

3. Procedural Background

The Complaint was validated by Nominet on 12 December 2007 and sent to the Respondent on that date by post, fax and email to the respective contact details held by Nominet. Nominet informed the Respondent that it had 15 working days, i.e. until 8 January 2007, to respond to the Complaint. All of the above communications failed insofar as the fax transmission was not completed and the email and posted letter were returned.

By 9 January 2007, no formal Response having been received from the Respondent, Nominet wrote to the Complainant's representative confirming that no Response had been filed and invited the Complainant to request an Expert Decision.

The Complainant paid the fee within the relevant time limit and thereafter I was contacted by Nominet and asked to confirm that I was able to provide an Expert Decision. I responded to Nominet confirming that I was able to provide a decision.

On 25 January 2007, the matter was duly referred to me, Simon Chapman, ("the Expert") for an Expert Decision.

4. Outstanding Formal/Procedural Issues (if any)

The Respondent has not submitted a formal response to the Complaint, which is unsurprising given that the Complainant appears not to have been successfully delivered to the Respondent. From the papers that have been submitted to me by Nominet, it is apparent that they have sent the Complaint to the Respondent using the contact details held on Nominet's Register.

When registering a .uk domain name applicants agree to be bound by Nominet's Terms and Conditions. Clause 4.1 of those terms and conditions states that the registrant of the domain name shall:-

*"4.1 give and keep us **notified of your correct** name, postal address and any phone, fax or e-mail information and those of your contacts (if you appoint any, see condition 5.2). This duty includes responding quickly and correctly to any request from us to confirm or correct the information on the **register**"*

In addition paragraph 2(e) of the Dispute Resolution Service Procedure (the "Procedure") states that:-

"e. Except as otherwise provided in this Procedure or as otherwise decided by us or if appointed, the Expert, all communications provided for under this Procedure shall be deemed to have been received:

- i. if sent by facsimile, on the date transmitted; or*
- ii. if sent by first class post, on the second Day after posting; or*
- iii. if sent via the Internet, on the date that the communication was transmitted;*
- iv. and, unless otherwise provided in this Procedure, the time periods provided for under the Policy and this Procedure shall be calculated accordingly."*

In light of the above it is my view that Nominet has done everything that it is obliged to do to bring the Complaint to the attention of the Respondent.

I now move on to consider the consequences of the Respondent not submitting a response. The Procedure envisages just such a situation and provides in Paragraph 15 that:-

"c. If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate."

I am not aware of any exceptional circumstances to explain why the Respondent should not have responded to the Complaint, and as such believe it appropriate to proceed to a Decision.

I will draw such inferences from the Respondent's failure to respond as I think appropriate, but must keep in mind that there may be a number of reasons why a respondent might fail to serve a response, for example that they have nothing useful to say.

5. The Facts

The Complainant is a London based UK law firm specialising in business law, which has traded under the name "Joelson Wilson & Co" since 1957 and more recently as "Joelson Wilson". It has had an internet presence since 2002, when it commenced use of the domain name <joelsonwilson.com> to direct interested parties to its website. It is acknowledged as having expertise in its field by the well known publication 'Chambers & Partners Guide to the Legal Profession'. In September 2007, the Complainant instructed a Canadian Law firm who in turn instructed a process server to serve a letter of complaint on the Respondent. The process server was unable to locate the Respondent at the address recorded on Nominet's records, and the process server confirmed that the address was in fact false. Evidence of the

process server's efforts is given by way of attendance notes of conversations with the process server. An extract from one of the notes is as follows –

"... I was sent out to deliver the letter from Joelson Wilson to Digital Assets. Well, my suspicions were correct. 34 Eglinton Avenue West is, in fact, a Mailbox etc. The problem is that when I attended, they actually don't have a listing for Digital Assets Inc. – Unit 2982C, which I thought would be a box number, doesn't exist here."

The Domain Name was registered on 30 March 2007 and at the time of the Complaint was directed to a website that provided links to third party websites. Many of the links on the website are of a legal nature, for example 'Legal Advice', 'Legal Contract' and 'Criminal Law'.

The website came to the attention of the Complainant when one of its former employees notified it that he had attempted to locate the Complainant's website via a search engine and came across the Respondent's site, which he assumed was associated with the Complainant.

The Parties' Contentions

Complainant

The Complainant asserts that it has Rights in respect of a name and mark which is similar to the Domain Name and the Domain Name in the hands of the Respondent is an "Abusive Registration" as defined in the Dispute Resolution Service Policy (the "Policy").

In support of the claim to Rights, the Complainant says that it has traded under the name 'Joelson Wilson' for many years and has developed a goodwill and reputation under that name over a period of 50 years.

In support of the claim that the Domain Names are Abusive Registrations the Complainant says that -

- i) the Domain Name was primarily registered to unfairly disrupt the Complainant's business;
- ii) the Respondent's use of the Domain Name has confused people into thinking that it is controlled by the Complainant; and
- iii) the address details of the Respondent are incorrect.

Respondent

As indicated above, the Respondent has not filed a Response.

6. Discussion and Findings:

General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Disputed Domain Name; and
- (ii) the Disputed Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

Despite the absence of a response from the Respondent, the Complainant must make out its case to the Expert on the balance of probabilities. It is still incumbent on the Expert to assess the admissibility, relevance, materiality and weight of the evidence as presented in the Complaint (see Paragraph 12b of the Procedure).

Complainant's Rights

The DRS Policy defines Rights as follows –

“Rights includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business”

The Complainant has clearly made extensive use of the name ‘Joelson Wilson’, and has used that name such that it is likely to have created extensive goodwill therein. It is clear that the Complainant therefore qualifies as having the necessary Rights in that name/mark.

The Policy requires such Rights to be in a name or mark identical or similar to the disputed Domain Name. The Domain Name is <joelsonwilson.co.uk> For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one must ignore the .co.uk suffix. The two are identical and I therefore determine that the Complainant has established that it has Rights in a name or mark identical to the disputed Domain Name.

Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above.

The Policy defines an Abusive Registration as –

“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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights”

The third ground of complaint relied upon by the Complainant seems to marry up with the ground identified in the Policy at Paragraph 3(a)(iv) namely –

“It is independently verified that the Respondent has given false contact details to [Nominet]”.

In light of the evidence submitted by the Complainant in respect of the attempts by a Canadian process server to serve a letter of complaint on the Respondent and his confirmation that the Respondent's address was false, I am satisfied that the ground set out in the Policy has been met, and therefore conclude that the registration of the Domain Name is Abusive. It is therefore unnecessary for me to set out my detailed opinion on the other grounds relied upon by the Complainant, save to say that I am of the opinion that the registration is Abusive under those grounds also.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name or mark which is similar to the Domain Name <joelsonwilson.co.uk>, and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds.

The disputed Domain Name <joelsonwilson.co.uk> should be transferred to the Complainant.

Simon Chapman

7 February 2008