

DISPUTE RESOLUTION SERVICE

D00010135

Decision of Independent Expert

General Optical Council

and

Dr. Sydney Bush

1. The Parties:

Complainant: General Optical Council
41 Harley Street
London
W1G 8DJ
United Kingdom

Respondent: Dr. Sydney Bush
Skidby House
Skidby Windmill
Hull
HU16 5TF
United Kingdom

2. The Domain Name:

generaloptycouncil.co.uk

3. Procedural History:

27 July 2011 09:10 Dispute received
27 July 2011 13:49 Complaint validated
27 July 2011 13:56 Notification of complaint sent to parties
28 July 2011 13:12 Response received
28 July 2011 13:12 Notification of response sent to parties
29 July 2011 14:01 Reply received
29 July 2011 14:08 Notification of reply sent to parties
29 July 2011 14:08 Mediator appointed
04 August 2011 17:36 Mediation started
09 August 2011 12:25 Mediation failed
09 August 2011 12:34 Close of mediation documents sent
19 August 2011 02:30 Complainant full fee reminder sent

19 August 2011 11:50 Expert decision payment received

4. Factual Background

The General Optical Council (the Complainant) was set up in 1958 by the Opticians Act and is the regulator for the optical professions in the UK. The Complainant registers around 24,000 optometrists, dispensing opticians, student opticians and optical businesses. It is one of a number of organisations in the UK known as health and social care regulators whose purpose is to oversee health and social care professions by regulating individual professionals.

The Complainant has four core functions:

- setting standards for optical education and training, performance and conduct
- approving qualifications leading to registration
- maintaining a register of individuals who are qualified and fit to practise, train or carry on business as optometrists and dispensing opticians
- investigating and acting where registrants' fitness to practise, train or carry on business is impaired

The Complainant's statutory function is 'to protect, promote and maintain the health and safety' of members of the public, a function interpreted as assuring the health and protection of those who use the services of optometrists and dispensing opticians.

The Complainant's own website is at www.optical.org, the URL being registered on 12 November 1997.

The Respondent, Dr. Sydney Bush is an Optometrist who has expressed a number of grievances with the Complainant through a website whose URL (ignoring the prefix 'www' and suffix '.co.uk') is identical to the name of the Complainant.

The Respondent registered generalopticouncil.co.uk, the domain name in dispute (the Domain Name), on 16 October 2010.

The Panel, as it is entitled to do, has looked at the website to which the Domain Name resolves, as well as the screenshots of the site provided by the Complainant. It appears the website has recently been updated to refer to these proceedings in addition to the underlying grievances of the Respondent.

5. A preliminary matter - the underlying dispute between Complainant and Respondent

The underlying grievances of the Respondent have manifested themselves in a number of criticisms of the Complainant, such as the suggestion that it is 'unfit for purpose'. The Complainant takes issue with these criticisms, describing some as,

for instance, 'unwarranted and offensive' and 'incorrect'. The Complainant also takes issue with the manner in which some of these criticisms have been expressed.

Disputes under Nominet's Dispute Resolution Policy (DRS or Policy) are decided by reference to the terms of the Policy rather than the merits of an underlying dispute between the parties. In this case however, much of what has been set out in the parties' submissions concern the underlying dispute between the parties. This is perhaps not surprising given that the present DRS proceeding appears to arise out of that underlying dispute, the Respondent saying in an e-mail to Nominet (which the Panel has reviewed in addition to the Response) that 'I registered the URL to put my side of the case....'. Nevertheless, except in a certain limited manner to which the Panel will refer below, the underlying issues between the parties has little determinative relevance to a decision under the Policy. Accordingly, only limited reference will be made to the underlying dispute in this Decision, particularly in the section below dealing with the contentions of the parties which will, accordingly, remain brief.

6. Parties' Contentions

The Complainant

- The Respondent's website at generalopticalcouncil.co.uk has no connection with the Complainant;
- The Complainant is concerned because the public could mistakenly believe there to be a connection between it and the Domain Name;
- The Respondent is using the Domain Name to criticise the Complainant and disseminate incorrect and potentially defamatory comments about the Complainant (and a list of examples is contained within the Complaint with responding comments);
- Much of what the Respondent says on his website is incorrect;
- It is perfectly reasonable for members of the public looking for the 'General Optical Council' online, to use the Complainant's name in full as a search term. Two online searches carried out by the Complainant result in the Domain Name appearing on the first page of search results. This could mislead those expecting to see a site connected with the Complainant.

The Respondent

- The Respondent considers himself to have been 'damaged' by the Complainant and registered the Domain Name to put his side of the dispute to the public;
- The website to which the Domain Name resolves is fulfilling its objective of bringing the facts of the dispute to public attention in a fit and proper manner;

- The 'only place that people would be sure to see General Optical Council is in a URL of that name';
- The website to which the Domain Name resolves makes it immediately and abundantly clear that it is the website of the Respondent and there is no possibility, as soon as one starts reading, as to why it exists. It cannot possibly be confused with or identified as having anything to do with official General Optical Council business;
- There is no commercial value in the website; it is a matter of ethics and propriety;
- So far as the Respondent is aware, there has been no formal lay complaint and the Complainant cannot suffer a financial loss of any kind through his actions;
- The content of the website is legal, decent and honest and the actions of the Complaint is a 'predictable' response to the Respondent's only means of bringing the issues between the parties to public's attention.

7. Discussions and Findings

Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's 'Rights'

The meaning of 'Rights' is defined in the Policy as follows:

'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'.

The Complainant is a statutory body which enjoys long-standing rights in the name, General Optical Council by virtue of its extensive regulatory activities under that name in the UK and/or as a result of its very constitution under statute.

Ignoring the prefix 'www' and suffix '.co.uk', the Complainant's name and the Domain Name are identical. Accordingly, the Expert is satisfied that the Complainant has Rights in a name or mark that is identical to the Domain Name. Accordingly, the Expert must now consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

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

was either *'registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights'* or which *'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights'*.

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 3 of the Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily as a blocking registration against a name or mark in which the Complainant has rights, or for the purpose of unfairly disrupting the business of the Complainant.

Other factors suggesting an Abusive Registration include the Respondent using or threatening to use the domain name in a way which has confused or is likely to confuse people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This includes circumstances indicating that before being aware of the Complainant's cause for complaint, the Respondent has made legitimate non-commercial or fair use of the domain name. Paragraph 4(b) of the Policy makes clear that *'Fair use may include sites operated solely in tribute to or in criticism of a person or business'*.

The Complainant is concerned about various matters, including, importantly for the purposes of this DRS proceeding, that the public could mistakenly believe there to be a connection between it and the Domain Name. The Respondent is frank in his submissions as to choice of Domain Name, stating that the *'only place that people would be sure to see General Optical Council is in a URL of that name'*. What the Respondent appears to be saying is that the best way of drawing his concerns with the Complainant to the public's attention, is to use their (the Complainant's) name. The inevitable consequence of this however is that the public are likely to believe, on seeing the Domain Name, that it is *'..registered to, operated or authorised by, or otherwise connected with the Complainant'*.

The Respondent deals with this by saying that his website makes it immediately and abundantly clear that it is his website, not that of the Complainant and that it is also clear that it has nothing to do with the official business of the Complainant.

Dealing with the Complainant's case first, the Panel is of the view that there is sufficient evidence to support a finding of Abusive Registration, absent any countervailing factors. The Domain Name is identical to the Complainant's name and it seems likely that confusion could easily arise – internet users looking for the Complainant online, who are presented with a list of search results which contain the address of the Respondent's website i.e., the Domain Name, may well believe that they had found the Complainant or at least a website with some authorised association with it. Moreover, some internet users looking for the Complainant's online presence may type the Domain Name in full believing that that would take them directly to the Complainant's website. To this extent, the user has been misled. The fact that the internet user's confusion may well dissipate as soon as

he arrives at the Respondent's website, is unlikely to provide an answer to a Complaint under the Policy. The initial confusion, or 'initial interest confusion' as it has come to be known, can provide a basis for a finding of Abusive Registration.

The recent DRS appeal decision in *Emirates v Michael Toth (DRS 8634)* provides a very useful account of the current position on initial interest confusion. In that decision the Appeal Panel dealt with the issue in this way:

'Initial interest confusion

As the panellist found in the complaint regarding <emirates.eu>, the Respondent's business model depends on attracting Internet users to his website who then generate revenue by click-throughs. Visitors drawn to the site following an Internet search are far more likely to have been looking for the Complainant's website than a general resource on the United Arab Emirates, and are likely to have assumed that the site they were visiting was associated with or authorised by the Complainant. Similarly those accessing the Website directly are very likely to have been users guessing (incorrectly) at the URL of the Complainant's UK website.

As paragraph 3.3 of the Nominet DRS Expert Overview (the "Overview") records, "the overwhelming majority of Experts" view "initial interest confusion" as a possible basis for a finding of Abusive Registration,

"...the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name."

*The Panel also notes that in a recent decision of the English High Court in *Och-Ziff Management Europe Limited v OCH Capital LLP* ([2010] EWHC 2599 (Ch)) Mr Justice Arnold held that "initial interest confusion" was actionable under Article 9 of the Community Trademark Regulation. The concept cannot be said to be well-founded only under US law as suggested by the Respondent in his Second NSS of 21 September.*

Accordingly, the Panel would find that the Domain Name was probably registered and has certainly been used in a manner that takes unfair advantage of the Complainant's Rights in the name EMIRATES.'

Turning to the position of the Respondent, the most obvious countervailing factor would be appear to be that described in paragraph 4(a)iC of the Policy, namely that before being aware of the Complainant's cause for complaint (emphasis added), the Respondent has made legitimate non-commercial or fair use of the Domain Name. However, it would be difficult for the Respondent to maintain that he was not aware of the Complainant's cause for complaint before making use of the Domain Name. Indeed, he describes their Complaint as 'predictable'.

Leaving that particular hurdle to one side however, a respondent must still show legitimate non-commercial or fair use. Of relevance here is that the Policy makes clear that websites operated solely in tribute or criticism may constitute fair use. To this end, the Respondent might say that his website is purely a criticism site. Indeed, he does make clear that it is all a matter of ethics and propriety and that the content of the website is legal, decent and honest. However, it would appear the Respondent would run into difficulties here too. A criticism site does not necessarily constitute fair use, even if it satisfies the requirement that that is its sole purpose.

In the DRS appeal decision in *Rayden Engineering Ltd and Diane Charlton (DRS 06284)*, it was said by the Appeal Panel:

'We accept on the evidence before us that the Respondent genuinely holds the views that are expressed on the site, and that those views arise out of a dispute between the Respondent and the Complainant. Beyond this, the merits of that dispute are not an issue that we can determine. We also accept that the site carries a clear disclaimer that would immediately alert visitors to the site that it was not the web site of Rayden Engineering. There is no evidence of any commercial use associated with the site.....

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 Respondent says that the website is the only means of bringing the issues with the Complainant to public attention. Whether or not he intends to raise a 'right of free speech' argument, it would be helpful to set out what the Appeal Panel in *Rayden Engineering* had to say on the issue:

'The argument has been advanced that any restriction on the Respondent using the Domain Names in this way amounts to curtailing the right of free speech – the right of the Respondent to make her protest. Any assessment of such a freedom involves balancing such rights with the rights of those affected by it – in this case the right of the Complainant to enjoy its rights and property in its trade name. Depriving the Respondent of her use of the Domain Names does not deprive her of her right to free speech.

Here it is open to the Respondent to carry on her campaign using a domain name that does not trespass on the Complainant's rights in its trade name in this way – either by using a different domain name altogether or by using one which includes a modifier such that the domain name is not confusingly similar to the Complainant's trade mark or one that made it quite apparent that the domain name was not associated with the Complainant but was being used for the purposes of a protest site'.

There are clear parallels between the present proceedings and those in *Rayden*

Engineering, and the Panel adopts the approach taken by the Appeal Panel in those earlier proceedings.

The Respondent clearly has strongly held views concerning his differences with the Complainant, but the platform he has chosen for the purposes of expressing those views, i.e. one governed by the terms of the Policy, must be subject to those terms. It matters not in the circumstances of this case how genuine and justified the Respondent's views might be (about which no view need be or is expressed by the Panel).

In all the circumstances, the Expert is satisfied that there is a clear risk that use of the Domain Name by the Respondent could confuse internet users, at least initially, as described earlier. Moreover, the Expert does not accept, on the facts of this dispute, that there can be fair use where the Respondent knew the Complainant was likely to Complain and, in any event, where there is no indication in the confusing Domain Name, (which is identical to the Complainant's name), that the Respondent is using his website to protest against the Complainant.

Accordingly, the Expert is satisfied that, in the hands of the Respondent, the Domain Name is an Abusive Registration.

8. Decision

The Expert finds that the Complainant has rights in a name or mark that is identical to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the domain name, generalopticalcouncil.co.uk be transferred to the Complainant.

Signed Jon Lang

Dated 12 September 2011