

DISPUTE RESOLUTION SERVICE

D00010226

Decision of Independent Expert

IEEP

and

State Factory

1. The Parties:

Lead Complainant: IEEP
15 Queen Anne's Gate
London
SW1H 9BU
United Kingdom

Respondent: State Factory
Glass House
177 Arthur Road
London
SW19 8AE
United Kingdom

2. The Domain Name(s):

ieep.org.uk

3. Procedural History:

24 August 2011 16:46 Dispute received
25 August 2011 08:37 Complaint validated
25 August 2011 08:38 Notification of complaint sent to parties
12 September 2011 08:10 Response received
12 September 2011 08:10 Notification of response sent to parties
15 September 2011 02:30 Reply reminder sent
20 September 2011 09:26 Reply received
20 September 2011 09:26 Notification of reply sent to parties
20 September 2011 09:27 Mediator appointed
23 September 2011 10:21 Mediation started
03 October 2011 15:20 Mediation failed
03 October 2011 15:30 Close of mediation documents sent
13 October 2011 02:30 Complainant full fee reminder sent
17 October 2011 08:20 Expert decision payment received

I was contacted by Nominet and asked to confirm whether I could provide an Expert Decision. I responded to Nominet confirming that I had no conflict preventing me from providing a decision.

The matter was thereafter duly referred to me, Simon Chapman, ("the Expert") for an Expert Decision on 17 October.

4. Factual Background

The Complainant is The Institute for European Environmental Policy, otherwise known as 'IEEP'. The institute was founded in 1976 by the European Cultural Foundation in Bonn, Germany. A London office was opened in 1980 and operates as an environmental research organisation. It operates a number of domain names including <ieeplondon.org.uk>, <ieep.be>, <ieep.pl> and <ieep.eu>. It was the registrant of the Domain Name prior to the Respondent's registration of it.

The Respondent is a specialist search engine optimisation agency providing 'link building services' (see www.statefactory.com). It registered the Domain name in November 2009 and operates it as a non profit information website providing an unofficial history of the Complainant. Text on the Respondent's website identifies that it provides 'unofficial' information and directs visitors to the Complainant's website if it is the Complainant's site that visitors are seeking.

5. Parties' Contentions

Complaint

In support of the Complainant's assertion of 'Rights' it refers to its registration of the domain names identified above, in particular its use of <ieep.org.uk> prior to 2008.

It claims that the content of the Respondent's website looks identical to that of the Complainant's at <ieep.eu> and will give visitors to the former the impression that that they have reached the Complainant's website. Some of the content from the Complainant's website has been copied and pasted by the Respondent. The Complainant has not authorised the Respondent's activities.

Response

The Respondent does not accept that its website will cause confusion, or that IEEP is a trade mark. The site is a not for profit information website that does not affect the Complainant's online presence or business dealings. The use of the Domain Name is legitimate as it is complimentary to the Complainant and is not inflammatory or detrimental.

There are a number of other entities that use the acronym IEEP and the Complainant does not have a monopoly over its use.

The Respondent's website does not look identical to the Complainant's site and there has been no copying from the Complainant.

The site will not confuse people because it is clearly marked as an unofficial history of the Complainant. No evidence of confusion has been adduced by the Complainant despite the operation of the site for over 22 months.

Reply

The use of the Domain Name by the Respondent is intended to associate its website with the Complainant. The Complainant asserts that some of the content on the Respondent's site is not complete and at least one link is a circular link to originating text, which will confuse and irritate people who are in fact looking for the Complainant.

6. Discussions 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).

The Complainant must make out its case to the Expert on the balance of probabilities.

Complainant's Rights

The DRS Policy defines Rights 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."

Whilst it is somewhat difficult to divine from the rather brief Complaint what Rights the Complainant does rely upon, I am mindful that the acronym IEEP has been used by the Complainant for a considerable period of time and in my view such use will have attracted sufficient association with the Complainant that it has gained goodwill in that name which would be adequate for the Complainant to claim 'Rights' pursuant to the DRS Policy. I do not think that the use of the same acronym by other entities in different fields of activity is such to deny the Complainant such Rights.

The Policy requires such Rights to be in a name or mark identical or similar to the Disputed Domain Name. 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 .org.uk suffix. The comparison is therefore between 'IEEP' on the one hand, and 'IEEP' on the other. In my opinion the Complainant has established that it has Rights in a 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:

- (iii) *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*
- (iv) *has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

In most circumstances where a Respondent has registered a domain name that is identical or similar to a name or mark in which the Complainant has rights, the name or mark is known, and the Complainant and its mark were known to the Respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration.

However, those responsible for drafting the Policy foresaw that this was not an absolute proposition, and there might be instances where the domain name would not be an abusive registration. In particular and of relevance to the present dispute, this might be so if the domain name were used for the purpose of tribute or criticism. In that respect Paragraph 4(b) of the Policy says as follows –

“Fair use may include sites operated solely in tribute to or in criticism of a person or business”

In my view the terms “tribute” and “criticism” as used in the Policy are to be construed sufficient widely to encompass the activities of the Complainant herein, which might more accurately be described as the provision of an “information” site.

Similar issues to those under consideration herein arose in *Rayden Engineering Ltd and Diane Charlton* (DRS 06284). That case concerned the registration of the domain names <rayden-engineering.co.uk> and <rayden-engineering.org.uk>. It was established that the Complainant had Rights in the name ‘Rayden Engineering’ and that the domain names were identical to the name or mark in respect of which the Complainant had Rights.

The Respondent asserted that because the use of the domain names was for the purpose of criticism and there was no commercial use or benefit to her, her use was not Abusive and fell within Paragraph 4(b) of the Policy. The Appeal Panel disagreed -

“The essence of an Abusive Registration under the Policy is that the domain name was registered or has been used in a manner that has taken unfair advantage of or has been unfairly detrimental to the complainant's Rights. Here it is clear, first, that the Respondent registered the Domain Names so that Internet users would be attracted to visit the Website because of the Domain Names; with the precise intention that she would thereby increase the number of people that would be confronted with her views on the Complainant and those associated with the Complainant including Richard Hayden. She has used domain names that are no more than the trading names of the Complainant without any indication that they lead to a protest site. In effect the Respondent is posing as the Complainant in order to attract members of the public to the site.”

“...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. “

We note the Respondent’s argument that an Internet user would quickly realise that the website it had reached had no connection with Rayden Engineering. As reflected in the <scoobydoo.co.uk> appeal decision cited above, the majority view amongst Nominet Experts is that where a registrant registers or uses a domain name so as to take advantage of “initial interest confusion”, which causes a user to visit a website expecting it to have some connection with a well-known name comprised in or constituting the domain name, he takes unfair advantage of the Rights in the name. By the time the user reads the disclaimer, or realises from the content of the Website that

it is not what he was looking for, the damage is done and the advantage sought by the Respondent is achieved.

In the present dispute, the Respondent has adopted a domain name which is identical to the acronym by which the Complainant is known (indeed the same domain name that the Complainant was previously the registrant of). I do not accept that it has copied content from the Complainant's site, although its website certainly has some similarities as to the look and feel. In my view it has adopted the Domain Name expressly because members of the public will associate its website with the Complainant. In my view it acknowledges the likelihood that visitors to its site will believe that there is an association with the Complainant by referring to its content as 'unofficial' and including prominent disclaimers. If there was no likelihood of confusion, such measures would be unnecessary. However it is my view that the use of the Domain Name alone will at least create initial interest confusion, which is sufficient for the use of the Domain Name to be Abusive. It is not at all unusual that actual instances of confusion would not have come to the attention of the Complainant, as visitors to the site will be disabused of their initial confusion when on the site itself. Initial interest confusion would not arise if the Respondent had adopted a domain more suitable for a third party information site, such as <infoonieep.org.uk> or the like.

Whilst it has not influenced the conclusion that I reached above, I notice that the Respondent's site contains a 'Links' page. Curiously these links all lead to pages on the Internet Archive. I am mindful that the stated business of the Respondent is as a specialist search engine optimisation agency, and I have some doubts that the true intention behind the operation of the Respondent's website is as a not for profit information site.

7. Decision

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

The disputed Domain Name should be transferred to the Complainant.

Signed Simon Chapman

Dated 08 November 2011