

DISPUTE RESOLUTION SERVICE

D00012771

Decision of Independent Expert

St John Ambulance

and

Mr Simeon Hills

1. The Parties:

Lead Complainant: St John Ambulance
27 St John's Lane
London
EC1M 4BU
United Kingdom

Complainant: The Most Venerable Order of St John of Jerusalem (The
Order of St John)
3 Charterhouse Mews
London
EC1M 6BB
United Kingdom

Respondent: Mr Simeon Hills
Federico Garcia Lorca
Bloque 17
Pisa 10A
Algeciras
Cadiz
11270
Spain

2. The Domain Name(s):

stjohnsambulance.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my 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 in to question my independence in the eyes of one or both of the parties.

26 April 2013 18:01 Dispute received
29 April 2013 08:32 Complaint validated
29 April 2013 08:48 Notification of complaint sent to parties
08 May 2013 09:53 Response received
08 May 2013 09:54 Notification of response sent to parties
13 May 2013 02:30 Reply reminder sent
13 May 2013 14:10 Reply received
13 May 2013 14:12 Notification of reply sent to parties
13 May 2013 14:12 Mediator appointed
16 May 2013 13:37 Mediation started
21 June 2013 13:12 Mediation failed
21 June 2013 13:13 Close of mediation documents sent
28 June 2013 09:36 Expert decision payment received

4. Factual Background

The First Complainant is the UK's leading first aid training provider and also one of the largest youth movements having been established by the Second Complainant in 1877.

The Second Complainant is the registered proprietor of a number of trade marks registered in the United Kingdom containing the words ST JOHN AMBULANCE and associated images including UK Registration No. 1523724 ST JOHN AMBULANCE filed at the UK Intellectual Property Office on 9 January 1993.

The Respondent is the owner of a substantial portfolio of domain names and has no connection with the Complainants.

The disputed domain name was registered on 5 January 2004.

5. Parties' Contentions

Complainant's submissions

The Complainants submit that they have for many years owned substantial rights in the abovementioned ST JOHN AMBULANCE mark which are enforceable under English law (under registered trade mark law and the common law of passing off) and in other countries.

The Complainants submit the First Complainant was established by the Second Complainant in 1877 and has since grown to be one of the largest charitable institutions in the United Kingdom with over 41,000 members. It trains

approximately 250,000 people on commercial first aid courses every year and provides training for over 200,000 businesses, with over 17,000 scheduled courses taking place at 230 venues annually. The First Complainant also provides treatment and care to approximately 125,000 patients on an annual basis; it provides over 1,000 ambulances and support vehicles and provides support to the NHS Ambulance Trusts. These vehicles all bear the ST JOHN name and each member wears a uniform with the ST JOHN name.

The First Complainant has also acquired a significant reputation in the ST JOHN AMBULANCE mark by extensive promotion of the mark and brand in general. It has almost 65,000 supporters contributing on a direct debit basis and its advertising campaigns have achieved national and regional media coverage. During a recent 'Life Lost' advertising campaign, the First Complainant received 116,418 requests for first aid guides. In the same year, the website at <www.sja.org.uk> (the "Complainants' Website") received 1,031,177 visits, of which 63% were new visitors. In 2012, the First Complainant launched its 'Helpless' advertising campaign which was screened on national television and viewed by approximately 14.1 million people. It is estimated that the First Complainant reached an audience of 34.2 million people through subsequent national and regional media coverage, which included 141 stories in national print. As a result of this campaign, the First Complainant received 18,571 requests for free guides, 17,521 downloads of the 'St John Ambulance First Aid' application, 2,900 views of the First Complainant's first aid videos and 14,590 new Facebook fans. The First Complainant's direct mail campaigns annually communicate with 150,000 cash donors.

The Complainants submit that the disputed domain name (ignoring the suffix .co.uk, which should be disregarded for the purposes of this comparison) is almost identical to the ST JOHN AMBULANCE mark in which the Complainants have prior rights and in particular said UK Registration No. 1523724 ST JOHN AMBULANCE.

The Complainants submit that the disputed domain name was registered in bad faith without the Complainants' consent in 2004, approximately 11 years after the Second Complainant registered the ST JOHN AMBULANCE mark at the United Kingdom Intellectual Property Office and over 125 years after the First Complainant was first established in the United Kingdom.

The Complainants submit that the Respondent is not connected to the Complainants in any way. The respondent is a non-trading individual who has opted to have their address omitted from the WHOIS service. The Respondent is trading as "Enquiries to mrshills@outlook.com".

At the time of registration, the website to which the disputed domain name resolved at the <www.stjohnsambulance.co.uk> address (the "Respondent's Website") consisted of three separate pages providing limited advice relating to first-aid training and first-aid at work.

The Complainants submit that the Respondent must be / have been aware of its rights in the ST JOHN AMBULANCE mark and brand because:

(a) The Complainant's mark and the ST JOHN AMBULANCE brand in general are very famous and have been for a number of years. As an example, a Google search for "St John Ambulance" carried out on 7 March 2013 returned over 2.3 million results, with the first ten results all referring directly to the First Complainant's ST JOHN AMBULANCE service.

(b) Trade mark searches would have disclosed the Second Complainant's rights in the ST JOHN AMBULANCE mark. Website searches would also have disclosed the Second Complainant's rights in the mark, together with the First Complainant's extensive use and promotion of the mark.

(c) The Respondent has used the disputed domain name to offer information that is identical to the services for which the First Complainant is well-established.

The Complainants submit that the disputed domain name was registered by the Respondent in bad faith and in a manner that took unfair advantage of and/or was unfairly detrimental to the Complainants' rights, including on the basis of the factors outline below.

The Complainants submit that, in the circumstances, the disputed domain name was registered and has since been used by the Respondent abusively in particular, but without limitation, because:

(a) Contrary to Policy paragraph 3.a.i.B, the disputed domain name was registered primarily to block the Complainants' use of the disputed domain name, being a domain name which is almost identical to the Mark over which the Second Complainant has rights, and which has been used and promoted extensively by the First Complainant. In particular, given the reputation and goodwill that has attached to the ST JOHN AMBULANCE mark, the Respondent must have known that his use of the disputed domain name would attract a number of users to the Respondent's website. Regardless of whether users who then access the Respondent's website (having been misled by the disputed domain name) remain confused into thinking that it relates to the Complainants, the Respondent will thereby have deliberately and wrongly attracted users to the Respondent's website by (at least initially) misleading them into thinking that it is connected with the Complainants and the Complainants' Website. This is free-riding off the Complainants' reputation in the ST JOHN AMBULANCE mark.

(b) Contrary to Policy paragraph 3.a.i.C, its purpose was to unfairly disrupt the Complainants' business. Whether or not internet users that had been initially confused through the Respondent's use of the disputed domain name conclude that the Respondent's website is connected with the Complainants, they will have been frustrated in their attempt to access and/or been prevented from accessing the Complainants' Website. This is disruptive of and damaging to the Complainants' business. For so long as the disputed domain name is in the Respondent's hands without the Complainants' consent, the Complainants have no control over its ownership or use and this is likewise inherently detrimental to the Complainants. In the circumstances, the Respondent can have no credible legitimate reason for using the Domain Name.

(c) Contrary to Policy paragraph 3.a.ii, the Respondent is using the disputed domain name in a way which is likely to confuse people into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainants. The disputed domain name is almost identical to the ST JOHN AMBULANCE mark, and the Respondent's website purports to provide a service which is the same as that which is widely known to be provided by the First Complainant (namely, the provision of first aid and associated advice and training). This is extremely confusing for anyone searching for the First Complainant's business and detrimental to the reputation of the ST JOHN AMBULANCE mark, particularly in the light of the advice given about first aid services over which the Complainants have no control.

(d) By using a domain name incorporating a name that is almost identical to the ST JOHN AMBULANCE mark, a household name which denotes the First Complainant and nobody else, the disputed domain name inherently misrepresents that it is registered or otherwise connected with the First Complainant and amounts to an instrument of fraud. This is unlawful under UK law- see the Court of Appeal's judgment in *BT v One in a Million*. There is nothing to suggest that the disputed domain name is not an Abusive Registration.

The Complainants further submit that none of the factors in Policy paragraph 4 apply. In particular:

- (a) The Respondent has at no point been legitimately connected with a mark which is identical or similar to the Domain Name.
- (b) The Domain Name is not generic or descriptive.
- (c) It is not credible that the Respondent was unaware of the Complainants, their rights (including the Mark) and cause for complaint and it is also not credible that the Respondent coincidentally chooses to use a Domain Name that is identical to the Mark.

Respondent's Submissions

The Respondent submits that he recently purchased a large portfolio of more than 15,000 Internet domain names including the domain name in dispute. He was motivated to move quickly to purchase the portfolio which was on offer at an extremely low price because a hundred or so of the domain names in the portfolio such <solarHeating.co.uk>, <bioFuel.co.uk>, <dongle.co.uk>, <giftwrap.co.uk>, <faxes.co.uk>, <registrars.co.uk> were generic and worth many times the asking price for all 15,000+ domains.

He states that prior to purchasing the portfolio he had casually reviewed the enormous list without considering each individual domain name and did not notice the domain name in dispute.

Many domain names were about to expire and were pointed to three different domain parking providers as well as some bespoke websites owned by the former registrant and so it took him several weeks just to begin sorting out and classifying the domain names and moving them over to his own domain name parking solution.

As a qualified barrister (non-practising) the Respondent is fully conversant with intellectual property law and would never knowingly infringe upon the rights of another party. As soon as he was made aware of this Complaint he instructed his domain name registrar to remove the DNS servers from the domain name in order to cease the previous registrant's offending website from being served.

Having reviewed all the domain names in the portfolio he is now aware that well over 99 % of the domains are utterly generic and nobody could ever seriously lay claim to them and less than 1 % might have possible intellectual property issues.

If any IP claims are notified to him about any other domain names he will immediately remove the DNS servers and would only seek to recover from the right holder the direct out of pocket costs that he incurred in acquiring each domain name. He would not seek to gain any profit element from the price asked.

Complainant's Reply

In Reply the Complainants acknowledge that the Respondent has removed the content at the Respondent's Website. Nevertheless, while the Respondent remains the registered proprietor of the domain name, there is a risk that the Respondent will either restore the content of the website and/or transfer the domain to a third party.

The Complainants argue that by using the disputed domain name that incorporates a name that is almost identical to the Mark that is a household name which denotes the First Complainant and nobody else, the disputed domain name inherently misrepresents that it is registered or otherwise connected with the First Complainant and continues to amount to an instrument of fraud.

The Complainants request that the disputed domain name be transferred to the First Named Complainant.

6. Discussions and Findings

Paragraph 2 of the DRS Policy requires the Complainant to prove to the Expert on the balance of probabilities that:

- 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.

Identical or Similar

The disputed domain name stjohsambulance.co.uk is very similar and almost identical to the Second Complainant's UK Trade Mark Registration No. 1523724 ST JOHN AMBULANCE (filed at the UK Intellectual Property Office on 9 January 1993). The additional letter "s" does not distinguish the domain name from the Second Complainant's mark in any significant manner as regards appearance or phonetic sound. The position of the letter "s" implies the genitive case and as a

result the same meaning would be attributed to the disputed domain name and the Second Complainant's trademark.

Abusive Registration

The DRS Policy at paragraph 1 defines "Abusive Registration" as meaning "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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

An initial question is whether the Respondent's lack of knowledge of the content of his portfolio affords him the defence that this is not an Abusive Registration.

The well known decision of the Appeal Panel in *Verbatim Limited v Michael Toth DRS 04331 (verbatim.co.uk)* places a focus on whether the respondent had knowledge of the complainant's mark. In the present case the issue is different. The Complainants are relying on a very famous mark in the United Kingdom and the disputed domain name is almost identical to it

While the Respondent has admitted that he had the opportunity to review the portfolio of domain names that included the disputed domain name before he bought the portfolio, he claims that he made only a casual review of the list of 15,000 domain names because there was some urgency to secure the bargain, and he did not notice the Complainants' mark before he purchased the portfolio.

The Nominet Dispute Resolution Service – Expert's Overview states as follows at paragraph 2.4:

"...The question of whether a Domain Name is an Abusive Registration is a multi-factorial assessment which affords some flexibility to Experts, enabling them to keep pace with the fast-moving world of the Internet. What was once thought to be unfair may in time be regarded as fair and vice versa.

The body of a Expert decisions under the Policy is developing and certain principles are emerging. The section of the appeal decision in DRS 04331 (verbatim.co.uk) dealing with 'knowledge' and 'intent' sets out one panel's views on that topic. However, new domainer practices (e.g. automated bulk transfers of domain names) are becoming commonplace and to the extent that the Verbatim decision suggests that for a finding of Abusive Registration, the Respondent must have had knowledge of the Complainant and/or its Rights at the relevant time, it is now thought by some Experts that that might overstate the position.

A particular area of current debate among the panel of Experts is the extent to which the concept of unfair advantage and unfettered detriment are set out in the definition of Abusive Registration [paragraph 1 of the Policy] embrace a subjective element. The members of the Appeal panel in the Verbatim case took the view that for a registration to be labelled “Abusive” there had to be something morally reprehensible of the Respondent’s behaviour, a view more recently adopted in DRS 07066 (whistleblower.co.uk). Others have expressed the view that what is or is not fair can be judged objectively and that gain or cause damage by way of a trademark infringement is necessarily unfair irrespective of the motives of the Respondent. To date this divergences of the view has emerged primarily in the cases where the Complainant’s trademark rights have post dated registration of the domain name-a very small proportion of the overall body of cases.”

In the present case:

- the trademark relied upon by the Complainants is a famous mark;
- the Complainants’ Rights extend back over a hundred years, and beyond into history;
- the disputed domain name is almost identical to the Complainants’ trade mark;
- there is no question but that the domain name was originally registered to take predatory advantage of the Complainants’ rights;
- the Respondent would have immediately recognised that the disputed domain name was almost identical to the Complainants’ famous trademark if he had taken the time to review the domain names which he was purchasing;
- the Respondent admits that he has now identified that approximately one per cent of the portfolio which he purchased – that is 150 domain names - are potentially infringing third party rights and is not taking any active steps to stop using these domain names unless or until he is challenged by the rights holders in each case.

In the Complaint, the Complainants have alleged that the website to which the disputed domain name resolved at the <www.stjohnsambulance.co.uk> address (the “Respondent’s Website”) “[a]t the time of registration” consisted of three separate pages providing limited advice relating to first-aid training and first-aid at work. The Complainants have not adduced any evidence to support this assertion and it is not clear what is meant by the phrase “[a]t the time of registration”, but a Response was subsequently filed and the Complainants’ allegation was not denied but he admitted that for a period of time up until he became aware of this Complaint, he allowed the previous registrant’s offending website to remain active. By allowing such use of the disputed domain name, the Respondent’s activity or inactivity has clearly taken unfair advantage of and has been unfairly detrimental to the Complainants’ Rights.

In the circumstances, this Panel finds that the disputed domain name in the hands of the Respondent is an Abusive Registration regardless of whether the

Respondent intended or did not intend to trade off the Complainants' marks as he has claimed. In making this finding this Expert is applying the formula of the Appeal Panel in *Playboy racing* (DRS 41439) which was in fact cited by the appeal panel in the *Verbatim* appeal:

“While the Panel is prepared to accept that the Respondent did not intend to trade off the Complainant’s goodwill in any way, his intention is not a determinative issue... Of that test is more objective than that, and can be summarised as follows: in the light of the strength of the Complainant’s Rights and the similarity of the domain name to the name in respect of which those Rights exist, has the registration and/or use of the domain name by the respondent taking unfair advantage of or been unfairly detrimental to those Rights?”

7. Decision

This Panel directs that the disputed domain name be transferred to the First Named Complainant.

**Signed ; James Bridgeman
Expert**

Dated 22 July 2013