

# DISPUTE RESOLUTION SERVICE

DRS 13934

## Decision of Independent Expert

Manchester Digital Laboratory Community Interest Company  
(formerly Manchester Digital Laboratory Limited)

Complainant

and

Tandot Limited

Respondent

### 1 The parties

Complainant:	Manchester Digital Laboratory Community Interest Company (formerly Manchester Digital Laboratory Limited)
Address:	36-40 Edge Street Manchester M4 1HN United Kingdom

Respondent:	Tandot Limited
Address:	132 Two Trees Lane Manchester M34 7GL United Kingdom

### 2 The domain name

*madlab.org.uk* (the "Domain Name").

### 3 Procedural history

I 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.

The procedural chronology of this dispute is as follows (all dates 2014):

3 March	Dispute received;
4 March	Complaint validated;
4 March	Notification of complaint sent to parties;
21 March	Response reminder sent;
25 March	Response received;
25 March	Notification of response sent to parties;
27 March	Reply received;
31 March	Notification of reply sent to parties;
31 March	Mediator appointed;
4 April	Mediation started;
2 May	Mediation failed;
2 May	Close of mediation documents sent;
2 May	Expert decision payment received.

### 4 Factual background

- 4.1 The Domain Name was registered by the Respondent, Tandot Limited, on 13 July 2009.
- 4.2 Tandot was incorporated on 4 September 2008. Its registered office is at what appears to be a residential address at 132 Two Trees Lane, Denton, Manchester.
- 4.3 The Complainant, Manchester Digital Laboratory Community Interest Company, was incorporated on 6 August 2009 as Manchester Digital Laboratory Limited. The change of name took place on 22 November 2013.
- 4.4 The Complainant's field of activity is not entirely clear. It describes itself as "*Hacking, Tinkering and Educating since 2009*". On its website, it says that it provides a space and/or facilities to those interested in "*gardening, crochet, hacking, programming, media arts, filmmaking and animating*": "*we know hackers and crafts people need workspace and may need to get down and dirty – we also know sometimes you need a quiet area to present and show works to your peers. We support both activities.*". The Expert assumes that the Complainant does not carry out, support, or otherwise condone hacking in the sense of obtaining unauthorised access to computers, which is of course a criminal offence.
- 4.5 The Domain Name is currently being used by the Complainant, not least in the URL for its website referred to above.
- 4.6 By letter from its solicitors, Freeth Cartwright, of 23 October 2013 to Mr Mee of the Respondent, the Complainant asked the Respondent to transfer the Domain Name to it. Mr Mee of the Respondent replied on 25 October 2013 declining to do so.
- 4.7 On 31 October 2013, Ms Turner of the Complainant appears to have repeated that request in a letter or email directly to Mr Mee.

## 5 Parties' contentions

### Complaint

- 5.1 The Complainant explains that it is "*a not-for-profit community organisation that upskills and educates the digitally disadvantaged*". It says it has "*an active and regularly maintained*" website at *www.madlab.org.uk*, which promotes the activities of "*over 70 community interest and education groups*", and provides information about workshops and training opportunities to residents of Greater Manchester.
- 5.2 The Complainant asserts that it has rights to the name MadLab which it says it has used exclusively since the Domain Name was registered. It refers to coverage by the BBC, *The Guardian*, *The Times* and in local media. It says that MadLab "*has also worked extensively with Manchester City Council, national arts organisations (such as Arts Catalyst), the Wellcome Trust and various universities*". It describes itself as "*an active and well-publicised organisation with national (and international) name recognition for its pioneering work*".
- 5.3 The Complainant explains that it was established in 2009 by four directors: Rachel Turner, Asa Calow, Hwa Young Jung (who left in mid-2013) and Dave Mee (of the Respondent).
- 5.4 It says that "*in anticipation of the incorporation and the commencement of trading of MadLab, through a company called Tandot Limited (which is owned by Mr Mee as to 50%, of which he is a director and has his home address as its registered office), Mr Mee acquired on MadLab's behalf the domain name madlab.org.uk and opened a Google App for Business account*". The Complainant says that Mr Mee of the Respondent was asked to "*set the registration of the new company up but not via his existing business (which MadLab was not entering into business with)*".
- 5.5 It submits that steps taken by an intended director in anticipation of incorporation are taken on the company's behalf and not on behalf of the intended director personally. This analysis appears to have been lifted from a letter from the Complaint's solicitors, Freeth Cartwright, to Mr Mee of 23 October 2013.
- 5.6 The Complainant asserts that the Domain Name "*belongs to MadLab*" because it was registered just one day after an initial application for funding was made by the founding directors to the Learning Revolution Transformation Fund on 12 July 2009 and because, until it was removed in late 2013, the Complainant's website recorded the fact that its "*design platform and marketing*" were donated by Tandot. Accordingly, the Complainant submits that "*the site...has been gifted to MadLab*".
- 5.7 On 8 October 2013, Mr Mee of the Respondent was removed as a director of the Complainant. The circumstances of his removal are not explained. On the same date, he was asked to hand over to the Complainant the password for the company's Google Apps for Business account and was given two weeks to transfer to the Complainant the Domain Name. Mr Mee refused to transfer the Domain Name to the Complainant. However, he continues to allow the Complainant to use the Domain Name for its website and email addresses.
- 5.8 The Complainant asserts that Mr Mee has never contested MadLab's right to use the Domain Name and accuses him of holding to ransom its "*business activities*". It says that Mr Mee "*continues to assert his link with*" it, and his access to its email system means that "*it is feasible that he could take on work intended for MadLab*".
- 5.9 The Complainant relies on paragraph 3(a)(v) of the DRS Policy (the "Policy") on the basis that the Domain Name was registered as a result of the relationship between the Claimant and the

Respondent. The Complainant says that the fact that a payment may not have been made for the registration does not of itself mean that there can be no Abusive Registration.

- 5.10 The Complainant submits that this is a "*clear-cut*" case of abuse because the Respondent has registered a Domain Name for use by another, where the Domain Name represents the name of that other person, and the registrant has no obvious interest in the Domain Name, but nonetheless refuses to transfer the Domain Name to the person on whose behalf it was registered.
- 5.11 The Complainant asserts that no agreement was reached between the Complainant and either the Respondent or Mr Mee to the effect that the Respondent "*has any title or rights over the domain*". It says that "*no discussion of any shape took place at the time because all parties were going into business together to create MadLab*".
- 5.12 Finally, the Complainant questions whether the Respondent would have any legitimate reason for wanting to keep the Domain Name.

### Response

- 5.13 The Respondent asserts that the Claimant "*is not telling the truth*". The Respondent says that on Mr Mee's removal as a director of the Complainant, he was given not two weeks to transfer the Domain Name, but one. He denies that the Complainant has been caused severe disruption or that its future has been put in jeopardy. He points out that Ms Turner, Mr Calow and Ms Jung of the Complainant jointly accepted an award, together with Mr Mee, given to the Respondent at an event in Manchester called Big Chip (and exhibits a photograph of the said award).
- 5.14 The Respondent accuses Ms Turner of the Complainant of having waged a "*campaign of hostility, slander, fake legal threats, and physical intimidation*" against him and accuses her of having "*forced the door at my home and repeatedly screamed*" at him, causing Mr Mee to have her removed by the police. This account of the incident is denied by the Complainant in its Reply.
- 5.15 He also accuses the Complainant of having "*used deception to create spurious reasons to attempt [to] acquire domain-access passwords from Tandot Limited*".
- 5.16 As to the substance of the Complaint, the Respondent asserts that its registration of the Domain Name is not abusive. It points out that the Complainant is still using the Domain Name to host its website and it is not being used to "*impersonate or attempt to mislead*".
- 5.17 The Respondent characterises this arrangement as "*the agreed licensing of the Domain Name to Manchester Digital Laboratory Limited over the past 5 years*", which he says constitutes legitimate use by the Respondent.
- 5.18 He points out that the Complainant has not paid for the Domain Name, the hosting or any associated services relating to the Domain Name which have been provided by and/or paid for by the Respondent. For this reason, the Respondent says that registration cannot be abusive pursuant to paragraph 3(a)(v) of the Policy.
- 5.19 The Respondent also asserts that the Domain Name has not been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights. It says that "*the licensing of the Domain Name has had no adverse affect on the business or operation of Manchester Digital Laboratory. The website has been constantly available to Manchester Digital Laboratory, who are able to update and use the website (as of 1/11/2013,*

*the Manchester Digital Laboratory no longer uses web server hosting provided by Tandot Limited). Tandot Limited has added email addresses upon request by the Complainant".*

- 5.20 The Respondent says that the Complainant does not have "*formal rights*" to the Mad Lab name and "*cannot claim monopoly rights to the name*". It asserts that the word lab is descriptive (pointing out that Mr Mee's previously company was called Something Labs).
- 5.21 The Respondent complains that it is owed money by the Complainant for hosting the website and renewing the Domain Name beyond an initial six month period. The Respondent also alleges that it is owed payment by the Complainant for (a) £1,000 worth of ADSL payments; (b) training courses; (c) unpaid salary; and (d) three years "*unpaid, full-time labour at Manchester Digital Laboratory (caused by the absence of Ms Turner and Mr Calow after incorporation)*".
- 5.22 The Respondent says that the Complainant's description of its activities does not reflect the position when the Domain Name was registered in 2009, when the Manchester Digital Laboratory Limited "*was formed to provide informal adult learning for digital and technology communities in Manchester*".
- 5.23 The Respondent maintains that during the period 2009 to 2012, Mr Mee and Ms Jung had to carry out most of the work of the Complainant, and in Mr Mee's case he was not paid for it, while Ms Turner of the Complainant was working in Qatar.
- 5.24 The Respondent says that Mr Mee registered the Domain Name not because he was asked to do so, but because he "*volunteered to do so*". He asserts that the Domain Name "*and associated assets*" remain the property of the Respondent which had "*underwritten registration, hosting, design and management of services subsequently. After three years' unpaid work at Manchester Digital Laboratory, I raised the issue of remuneration for these fixed costs, but Ms Turner dismissed this out of hand, declaring 'the role of a director is to subsidise a company'.*".
- 5.25 The Respondent denies that he has withheld from the Complainant the relevant password for the Google Apps for Business account.
- 5.26 He points out that the Respondent's "*ownership*" of the Domain Name has not been contested for over four years and only became an issue following his removal as a director of the Complainant.
- 5.27 The Respondent says that there is no evidence in support of the Complainant's assertion that Mr Mee is misrepresenting himself as still being associated with the Complainant, and describes as "*nonsense*" the suggestion that he could intercept work intended for the Complainant by reason of his access to the email account linked to the Domain Name.
- 5.28 The Respondent denies that it is able to monitor the Complainant's business activities or that it is carrying out work that is similar to that of the Complainant. On the contrary, he says, it is Ms Turner and Mr Callow of the Complainant who are "*impersonating*" Mr Mee, by using his electronic training programme without his permission.
- 5.29 The Respondent says that the reference to the donation by Tandot of "*design platform and marketing*" on the Complainant's website was removed only to make way for a sponsorship message required by Bytemark.
- 5.30 The Respondent rejects the Complainant's version of events when the Domain Name was registered and the Complainant was incorporated. It says that the Complainant "*was*

provided use of the domain by TANDOT. TANDOT suggested that Manchester Digital Laboratory paid for the fixed costs TANDOT had in providing these services, but was rebuffed by Ms Turner". It says that the Domain Name "was clearly owned by TANDOT Ltd. As TANDOT was paying for equipment costs, infrastructure and my time". It maintains that the Complainant only ever had a licence to use the Domain Name.

- 5.31 The Respondent denies that it is holding the Complainant to ransom. It says that the answer is for the Complainant to register a new domain name.
- 5.32 The Respondent says that the question of the fiduciary duties of Mr Mee is irrelevant; he owes duties only to the Respondent.
- 5.33 The Respondent denies that this case falls within paragraph 3(a)(v) of the policy. It asserts that such an argument is "*demonstrably false*".

#### Reply

- 5.34 The Complainant concedes that there was a breakdown in the relationship between its directors in 2013.
- 5.35 The Complainant refers to the demands made in the Response for payment of money and asserts that the clear inference to be drawn is that the Respondent will deny use of the Domain Name to the Complainant if Mr Mee's demands are not met. It asserts that this is very unfair to the Complainant. The Complainant says that the Respondent's demand in its letter to the Complainant's solicitors of 25 October 2013 requiring it to cease using the Respondent's web server by midday on 1 November 2013 was impossible to comply with because the Complainant did not have access to the Domain Name.
- 5.36 The Complainant claims that the Respondent's control of the Domain Name means that it has no control over its email accounts.
- 5.37 Further, it alleges that on 1 December 2013 Mr Mee of the Respondent deleted a number of the Complainant's documents from DropBox, including "*board information and payslips*". The Complainant exhibits a screenshot which appears to evidence the deletion of a number of documents, including payslips of various individuals. The Complainant also exhibits an email from Ms Turner to Mr Mee of 5 December 2013 accusing him of removing approximately 40 files of the Complainant from DropBox.
- 5.38 The Complainant also alleges that on 9 December 2013 and 6 January 2014 Mr Mee and his partner "*accessed MadLab's financial accounts using their MadLab emails*". The Complainant exhibits a screenshot which appears to evidence that Mr Mee accessed the system on 9 December 2013, though it is not clear that Mr Mee accessed the Complainant's financial systems.
- 5.39 The Complainant reiterates that the Respondent has therefore caused disruption to its business, primarily because it retains control of the Domain Name and the associated email accounts.
- 5.40 The Complainant further contends that Mr Mee is still passing himself off as connected with the Complainant. It is not said that this arises out of registration of the Domain Name.
- 5.41 The Complainant asserts that it has unregistered common law rights in the MadLab name and that the Domain Name "*was registered in contemplation of the imminent future incorporation*

of the Complainant". It relies in particular on an email from Mr Mee of 22 July 2009 to his co-directors in the following terms:

*"I will register the domain later today...How do we manage cashflow for donations? I have a bank account I'm not using, but obviously it would be better if we're clean from day one?"*.

- 5.42 The Complainant rejects the Respondent's argument that it had granted a licence to use the Domain Name to the Complainant. This is the first the Complainant has heard of any such licence. It says that Mr Mee *"has not produced evidence of this licence because it does not exist"*. It asserts that Mr Mee of the Respondent understood that the Complainant *"was being set up as four individuals who were not in partnership with any other organisation (i.e. Tandot)"*.
- 5.43 The Complainant reiterates that the Respondent's use of the Domain Name since its registration constitutes abuse under paragraph 3(a)(v) of the Policy and refers in this regard to DRS 2242 (*BAE Systems Plc v Natasha Sime*). In an email to Mr Mee of 7 February 2014, exhibited to the Reply, the Complainant relies also on DRS 3977 (*Amateur Boxing Association of England v Matthew Green*).
- 5.44 The Complainant submits that the use of the Domain Name, pursuant to paragraph 1(ii) of the Policy, is unfair *"because the Domain Name is not actually registered in the Complainant's name, when the original expectation was that it would be so registered"*. The Complainant argues that, since Mr Mee was *"taking steps to become a director of the Complainant at the time he registered the Domain Name and made the arrangements to set up the Complainant's website"*, he was under a duty to act in the interests of the company and not for himself personally, and accordingly that he was using the Domain Name *"on trust for"* the Complainant.
- 5.45 Finally, the Complainant asserts that Mr Mee is now in direct competition with the Complainant and that it is therefore unjustifiable and unfair for the Respondent to *"deny the Complainant control of the Domain Name"*.

## 6 Discussions and findings

### General

- 6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that he has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).

- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

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

### Complainant's rights

- 6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "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*".
- 6.4 The Complainant belatedly identifies, in its Reply, that it relies on common law rights in the MadLab name. However, the evidence of such trading goodwill in the MadLab name is very sparse. No evidence is adduced of the media coverage mentioned in the Complaint, nor of advertising, marketing, usage, or the other usual indicators of the existence of the requisite goodwill.
- 6.5 This is a common failing in DRS proceedings. Complainants would do well to remember that the onus is on them to prove, on the balance of probabilities, that they own Rights (as defined in the Policy) in the name in question. A bare assertion that common law rights have been acquired is unlikely to suffice, where no attempt is made to demonstrate, by reference to relevant evidence, that that is in fact the case.
- 6.6 In this particular case, however, the Expert is prepared to have regard to the fact that no counter-argument is advanced by the Respondent to the effect that goodwill does not attach to the MadLab name. Indeed, the Respondent entirely accepts that contention, its objection being that it says that this was all as a result of the (unpaid) efforts of Mr Mee rather than as a result of any work on the part of Ms Turner.
- 6.7 Secondly, on the basis of fairly cursory searches carried out by the Expert online, it is apparent that the Complainant trades by reference to the MadLab name and appears to have done so for around four years. In those circumstances, it might be thought unconscionable to debar the Complainant on grounds of lack of evidence.
- 6.8 Plainly the MadLab name is identical or similar to the Domain Name for the purposes of paragraph 2(a)(i) of the Policy.
- 6.9 Accordingly, the Complainant just about scrapes home in demonstrating that, pursuant to paragraph 2(a)(i) of the Policy, it has Rights (as defined) in respect of a name or mark that is identical or similar to the Domain Name.

### Abusive registration

- 6.10 The Complainant relies primarily on paragraph 3(a)(v) of the Policy, as well as asserting that, on general principles, the Respondent's use of the Domain Name takes unfair advantage of or is unfairly detrimental to its Rights.
- 6.11 Paragraph 3(a)(v) of the Policy provides that where a domain name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
- (A) has been using the Domain Name registration exclusively; and
- (B) paid for the registration and/or renewal of the Domain Name,
- that may be evidence that the Domain Name is an Abusive Registration.
- 6.12 Even on the Respondent's case, there can be little doubt that this is a case which, potentially at least, falls within paragraph 3(a)(v). It seems to be tolerably clear that the Domain Name was registered by Mr Mee of the Respondent immediately prior to the incorporation of the



Complainant and for the Complainant's use. Whether that was done by Mr Mee acting in his capacity as a director or prospective director of the Complainant, or as a supplier of services to the Complainant, is not hugely material, so far as the Policy is concerned.

- 6.13 Thereafter, evidently there was a breakdown in relations between the directors of the Complainant, primarily in the persons of Ms Turner and Mr Mee, the upshot of which was that Mr Mee was removed as a director of the Complainant.
- 6.14 The fact of the matter, which is not seriously challenged by the Respondent, is that the Domain Name was initially registered for and used exclusively by the Complainant in the course of its not-for-profit business. Accordingly, the Complainant satisfies sub-paragraph (A) of paragraph 3(a)(v).
- 6.15 Since Mr Mee's removal as a director, it may be said that there is a dispute as to whether or not the Complainant still enjoys exclusive use of the Domain Name. The Complainant's position that the Respondent now has effective control of the Domain Name might be said to undermine its own case on paragraph 3(a)(v). However, ironically this is emphatically rejected by the Defendant, whose position appears to be that the Complainant still has exclusive use of the Domain Name. In any event, it probably does not much matter. Sub-paragraph (A) would appear to be satisfied if, when the Domain Name was registered, and presumably for at least some time thereafter, the Complainant has had exclusive use of the Domain Name. This appears to be common ground between the parties.
- 6.16 The Respondent, however, points to the fact that it was the Respondent, and not the Complainant, which paid for registration of the Domain Name and that therefore sub-paragraph (B) is not satisfied. On the face of it, that argument has some force. However, whether it bears closer examination is another matter.
- 6.17 In the first place, the factors set out in section 3 of the Policy are clearly stated to be non-exhaustive. Accordingly, the fact that a case may not sit squarely within one of the sets of circumstances envisaged does not, of itself, preclude a finding of Abusive Registration. That is particularly the case where, as here, the Respondent does not argue that any of the exculpatory factors set out in section 4 of the Policy are available to him.
- 6.18 Secondly, as mentioned by the Expert, Matthew Harris, in DRS 3977 (*Amateur Boxing Association of England v Matthew Green*), it is instructive to consider the history of paragraph 3(a)(v). As Mr Harris helpfully explained in that decision (see paragraphs 7.14 and 7.15) that paragraph was specifically introduced in version 2 of the Policy in October 2004. Before October 2004, there had been a number of cases where a complainant had succeeded against a person who registered a domain name for the complainant but registered it in another name. There were other decisions which went the other way, essentially on the basis that unless there was abusive intent at the time of registration, the Respondent could not be required to transfer the domain name. As Mr Harris puts it: "*The October 2004 amendment made it clear that the former view was the one that should prevail.*".
- 6.19 Mr Harris went on to determine as follows:

*"What these cases and the amendment to the Policy make clear is that the fact that a domain name has been registered for someone else with that person's consent as a result of a commercial relationship between the registrant and that person, this does not preclude a finding that there is an abusive registration. In a case where the complainant has directly paid for the fees associated with registration that clearly indicates that it was the intention of the parties that the domain name would be 'owned' by the paying party. **However, the fact in this case that there was no***

***such payment does not to my mind mean that there is no abusive registration.***"  
(emphasis added).

- 6.20 That view has subsequently been followed in more recent cases (see, for example, DRS 12291 (*Knightsbridge PME Limited v William Franklyn*) and DRS 12194 (*Ufford Parish Council v Ian Glew*) in April 2013 and May 2014 respectively).
- 6.21 This raises the question of whether the position might be different, if there was an agreement between the Complainant and the Respondent that 'ownership' of the Domain Name remained at all times with the Respondent. This is the case which the Respondent appears to be seeking to advance in asserting in the Response that it had granted a licence to the Complainant.
- 6.22 However, no evidence of any such licence is provided. Even if the Respondent were to argue, which it has not, that any such licence were oral or implied, there is no reference in the email correspondence between the parties to any such licence or agreement. Further, the idea that any such licence was ever granted is roundly rejected by the Complainant. Accordingly, it seems more likely that this is an attempt to re-characterise after the event the arrangement which was in fact in place at the time between the Respondent and the Complainant.
- 6.23 Moreover, while the Complainant still appears to have use of the Domain Name, the Respondent does not deny that it, in the person of Mr Mee, has a level of control over its use, not least by controlling access to the associated email accounts. It is not difficult to see how that has at least the potential to cause serious disruption to the Complainant's conduct of its affairs, even without the allegations of unauthorised access to its financial accounts and the deletion of its documents by the Respondent. Taking all those circumstances into account, the Expert is satisfied that such use is unfair within the meaning of paragraph 1(ii) of the Policy.
- 6.24 It is also necessary to bear in mind that the Respondent appears to compete, at least at some level, with the activities of the Complainant, though given that the Complainant does not trade for profit, this carries less weight than it might otherwise do in a normal commercial context.
- 6.25 Accordingly, the Expert is satisfied, on the balance of probabilities, that the Domain Name has been used by the Respondent in a manner which takes unfair advantage of the Complainant's Rights in the Mark and/or was unfairly detrimental to those Rights.

## **7 Decision**

- 7.1 The Expert therefore finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

Signed **David Engel**

Dated 13 June 2014