

DISPUTE RESOLUTION SERVICE

D00017552

Decision of Appeal Panel

Oralect Licensing, Ltd.

and

Tracey Bell Clinic

1. The Parties:

Complainant

Oralect Licensing, Ltd.
2711 N. Haskell Avenue, Suite 650
Dallas, TX 75204
United States of America

Respondent:

Tracey Bell Clinic
Dorothy Pantin House
Kensington Road
Douglas
Isle of Man
IM1 3PE
United Kingdom

For convenience the Parties will continue to be referred to as the “Complainant” and “Respondent” in this Appeal Decision.

2. The Domain Names

The domain name in issue is fastbracesisleofman.co.uk

It is referred to in this decision as the “Domain Name”.

3. Procedural History

This is an appeal against the decision of Steve Ormand (the “Expert”) issued on 8 December 2016 in favour of the Respondent. It falls to be determined under the Nominet Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) and terms used in this decision have the meaning set out in those documents unless the context or use indicates otherwise. The Complainant filed an Appeal Notice on 23 December 2016. The Respondent filed an Appeal Response on 12n January 2017. The procedural history of this dispute prior to this Appeal is set out in the Expert’s decision and does not need to be repeated here.

Nick Gardner, Ian Lowe and Claire Milne (the “Appeal Panel”) have each made a statement in the following terms:

“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 such a nature as to call in to question my independence in the eyes of one or both of the parties”.

4. The Nature of This Appeal

Paragraph 10a of the Policy provides that *“The Panel will consider appeals on the basis of a full review of the matter and may review procedural matters”*. The Appeal Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a redetermination on the merits. It is not therefore necessary to analyse the first instance decision in any detail.

At this point, the Appeal Panel simply records that the Expert concluded that the Complainant had Rights in the name FASTBRACES which was similar to the Domain Name but had failed to show that Respondent's registration and use of the Domain Name had taken unfair advantage of or had been unfairly detrimental to the Complainant's Rights, and, therefore, it was not an Abusive Registration.

5. Admissible material on Appeal

Nominet’s DRS system is intended to be a relatively informal, quick and economic means of resolving disputes about domain names, where the dispute falls within the ambit of the Policy. It is not essential for parties to be represented, whether by solicitors or others. The system does however have rules which do need to be followed and parties need to prepare their case in accordance with those rules. This is essential if a fair, consistent and predictable system is to be available to determine these disputes. As well as the rules there are also guidelines promulgated by Nominet which are available to assist parties in preparing their case thoroughly. All of this is clearly explained on Nominet’s website.

In the present case the Complainant seems to have paid little attention to the rules or the guidelines. The Complaint was extremely short and it is appropriate to set it out verbatim, in its entirety. It reads as follows:

“What rights are you asserting?”

The Complainant is the owner of the following trademark registrations:

- US Reg. No. 2,130,607 for the FASTBRACES® mark for orthodontic services (Annex 02);*
- US Reg. No. 3,044,111 for the FASTBRACES® mark for orthodontic appliances (Annex 03);*
- Canada Reg. No. 660,816 for the FASTBRACES® mark for orthodontic services (Annex 04);*
- European Community Trademark Reg. No. 1,270,214 for the FASTBRACES® mark for orthodontic and dental services; information, advisory and consultancy services in relation to all of the aforementioned services (Annex 05); and*
- European Community Trademark Reg. No. 8,204,737 for the FASTBRACES® mark for dental apparatus and instruments; orthodontic appliances and brackets; parts and fittings for all of the aforesaid goods (Annex 06).*

The Complainant would submit that the domain FASTBRACESISLEOFMAN.COM [sic] is confusingly similar to the above-referenced trademark registrations. The only difference being a geographical reference to "Isle of Man". Moreover, the domain is being used to promote the Respondent's orthodontic practice and fraudulently implying to be an affiliate of the Complainant in offering licensed and certified Fastbraces® orthodontic brackets and services. (See Annex 07)

Why is the domain name an Abusive Registration?

The Respondent has no rights or legitimate interests in respect of the domain name FASTBRACESISLEOFMAN.CO.UK. The Respondent has used the domain to promote the Respondent's orthodontic practice despite numerous notifications from the Complainant to cease doing so. The Respondent has also used the domain to fraudulently imply that Respondent is an affiliate of the Complainant, licensed to offer Complainant's certified Fastbraces® orthodontic brackets and services.

How would you like this complaint to be resolved?

Transfer

Additional Complainants:

[no additional complainants]

As far as you are aware have any legal proceedings been issued or terminated in connection with the domain name?

[answered no]

Are there any web pages that support this dispute?

- www.fastbracesisleofman.co.uk

[end of submission]”

The Annexes to the Complaint simply comprised copies of the trademark certificates relied upon, and a print out of part of the Respondent’s website.

A complaint is filed with Nominet by using its online system. In circumstances where that system detects that a complaint is very short or is unaccompanied by evidence, the system will, before accepting a complaint, generate a warning and invite a prospective complainant to reconsider whether it has properly explained its case, and allow the draft complaint to be amended. That warning is in the form of a notice from the Chair of Nominet’s Appeal Panel of Experts (who is also the chair of this Appeal Panel). It is referred to in this decision as a “Chair’s Warning”. It states as follows:

“Warning from Nick Gardner, the Chairman of our Independent Experts, in relation to short or unsupported complaints

You are receiving this warning as the complaint that you are submitting contains less than 500 words and/or has no evidence attached to it.

One of the challenges that the Independent Experts face is deciding cases where they have been provided very little information to go on and/or no evidence to back up what is being alleged. Surprisingly many cases fall into this category.

It does not mean that your complaint will fail, it simply means that it is less likely to contain the detail or evidence required to enable the Independent Expert to give full weight to the case you are seeking to make.

Remember that in the DRS we do not check your complaint or decide how to deal with it. The way that this system works is that it is your duty (as the Complainant) to prove your case on the “balance of probabilities”. This means that, if your case does come before one of the Experts, you have to prove to them that it is more likely than not that:

you have rights in respect of a name or mark which is identical or similar to the Domain Name; and

the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The meaning of “Rights” and “Abusive Registration” is given in the DRS Policy.

The Expert will only see your written submissions and supporting evidence. You do not have the chance to talk to the Expert, and they are not required to research the case. Anything you want the Expert to consider should be provided in the Complaint and its supporting evidence.

We would encourage you to look at your complaint to see if it sets out the required information and is adequately supported by documentary evidence.”

The Complainant proceeded to file the Complaint in the form set out above after receiving this warning.

As appears below the Respondent filed a Response making a large number of points. The Complainant did not then file a Reply although it could have done if it wished.

The Complainant now by its Appeal Notice seeks to introduce a wide range of what are clearly new allegations, including for example as to its contractual relationship with the Respondent. It also refers to additional material, such as earlier correspondence being “available upon request”. The general rule under the Procedure is very clear: **no new evidence on appeal**. Paragraph 18c of the Procedure states “An appeal notice should not exceed 1000 words, should set out detailed grounds and reasons for the appeal, but shall contain no new evidence or annexes” and paragraph 18f states “An appeal notice response must not exceed 1000 words, should set out detailed grounds and reasons why the appeal should be rejected but should contain no new evidence or annexes”. This is the general rule, subject to the limited exception set out in paragraph 18h of the Procedure: “The Panel should not normally take into consideration any new evidence presented in an appeal notice or appeal notice response, unless they believe that it is in the interests of justice to do so.”

The Complaint has not made any formal application for permission to introduce any new material or to justify to the Appeal Panel why it would be in the interests of justice to consider such new material. The Respondent has objected to the introduction of this material. All of the material appears to the Appeal Panel to be material which would have been available to the Complainant at the time it filed the original Complaint and at the time when it could have filed a Reply. In circumstances where the material was all readily available to the Complainant, and the Complainant has ignored a Chair’s Warning, and then chosen not to file a Reply, and has not sought leave from the Appeal Panel to introduce new material, the Appeal Panel has no hesitation in declining to admit any new material. Accordingly, this Appeal will proceed on the basis of the material that was before the Expert. If the Complainant is aggrieved at this ruling it should consider its own responsibilities in this matter. In view of this ruling the Appeal Panel does not propose to set out in this decision the new material contained in the Appeal Notice. In any case, because of the absence of supporting evidence, the Panel has not been in a position to assess the implications (if any) of the new material.

6. The Facts

The Appeal Panel knows very little about the facts behind this dispute. This is a direct consequence of the brevity of the Complaint and the lack of information it contains, and the rather confusing nature of the Response (see below). In these circumstances the Appeal Panel does not propose to try and set out the factual background but instead will set out below what can be discerned from the Complaint and the Response.

7. The Complaint

The Complaint itself is set out above. All that is apparent from the Complaint when it is reviewed carefully is as follows:

1. The Complainant is a US company apparently based in Texas.
2. It owns the identified trademarks, all for the term “fastbraces”, and registered in relation to orthodontic appliances and services.
3. Its name suggests it may be involved in licensing, but no details of any such activity are provided, or whether any such licensing is of technology, or of trademarks, or both, or of something else.
4. The trademarks suggest its business is related to orthodontic appliances and/or services, but no further details are provided.
5. The Complaint says the Domain Name is confusingly similar to its trademark as it only involves the addition of a geographical term. It mistakenly refers at one point to fastbracesisleofman.com rather than fastbracesisleofman.co.uk.
6. The Complainant also says the Respondent has used the Domain Name to promote the Respondent's orthodontic practice despite numerous notifications from the Complainant to cease doing so. No further details of these notifications are provided.
7. The Complainant goes on to say the Respondent has used the Domain Name to “*fraudulently imply that Respondent is an affiliate of the Complainant, licensed to offer Complainant's certified Fastbraces® orthodontic brackets and services*”. Other than providing a reference to the Respondent's website, and a printout of part of that website (cut off in the middle of a picture), this allegation is not explained further. This allegation does by implication provide the further information that the Complaint's business involves orthodontic brackets and services which use the Fastbraces trade mark. These are apparently “certified” in some way though no details as to what this means are given. It also suggests the Complainant carries on business by licensing “affiliates” but the Appeal Panel does not know what this involves.

Strikingly no information is given about the size or scale of the Complainant's business, or whether it is a manufacturer and/or supplier of orthodontic braces, or a licensor of relevant technology or trademarks (or both) or as to how any relevant affiliate program operates. All the Complaint states in substance is that the Complainant has some trademarks and that it is in some way involved in the orthodontics business. The only website the Complainant relies upon is the Respondent's so no further information about the Complainant or its business is available to the Appeal Panel, save to the extent anything can be divined from the Respondent's website.

The Respondent's website contains descriptions and photographs of various types of dental brace (see further below). One entry reads as follows:

“Fast Braces@TraceyBell

Technology that creates beautiful smiles in a Fast and Safe manner

Fastbraces @ Tracey bell are designed to straighten teeth in a short time period of 3 months to about a year! The teeth are moved differently and safely, creating a beautiful smile that you have always dreamed of!

What are the advantages of Fastbraces®?

*Fast! Treatment times range from 3 months to about a year
Fastbraces Technology typically works with just one orthodontic wire from start to finish, whereas old braces usually require a series of wires and tightening procedures. Fastbraces® Technology uses a special square super-elastic nickel-titanium wire which is activated by the special design of the braces. This dynamic wire helps upright the whole tooth using the natural temperature of the mouth in just one stage. Now treatment time can be measured in months instead of years!”*

The Complainant has not attempted to explain whether it says this passage relates to whatever its business is and, assuming it does, why it is said to be objectionable. The Appeal Panel infers that it is likely to be the relevant passage as none of the other braces described on the Respondent’s website are referred to as “Fastbraces”. The Appeal Panel does not know whether the Complainant is complaining because it says the Respondent is offering a service it cannot provide, or is offering products or services that are not genuine; or is representing inaccurately that it is an authorised dealer (or “affiliate”) in whatever products or services the Complainant provides, or whether some other cause for complaint is alleged.

8. The Response

It would appear from the website www.traceybell.co.uk which is relied upon in the Response that the Respondent operates a dental practice with a number of locations on the Isle of Man and in Liverpool. These practices were founded by an individual named Tracey Bell. It is not clear to the Appeal Panel whether the Respondent is that individual or some sort of corporate vehicle associated with her, but nothing turns on this. For convenience, this decision refers to the “Respondent” and assumes it is a corporate entity.

The Response is somewhat longer than the Complaint but it does not provide much more by way of background information that would assist the Appeal Panel to understand this dispute more fully. Instead it makes a large number of points apparently assuming that the Appeal Panel is familiar with whatever is the relevant background. This has resulted in a document that is somewhat confusing. The main points the Respondent makes are as follows.

1. It purchased the Domain Name in order to use it for a website based and operated in the UK, designed to educate patients in the various options available to those looking for fast (acting) dental braces and which were available from its practices based in the United Kingdom and Isle of Man.

2. It identifies a number of specific types of such braces including ones it described as ‘Quick Straight Teeth’, ‘CFAST’, ‘Invisalign’ and ‘Damon Braces’.
3. It says the Domain Name “was not purchased to **solely** advertise or profit from the Complainant’s trademark FastBraces product, but to educationally inform in regards any fast (acting) dental products” [emphasis added].
4. It says the Complainant made clear it felt it had absolute right to the Domain Name and demanded its transfer. It says the Complainant indicated it intended to ‘rent’ - or license - the domain back for a substantial monthly fee.
5. It says that following discussions the Respondent offered the Complainant the option to purchase the Domain Name. It does not say whether a specific figure was proposed but does say it wanted to recoup its registration and hosting costs and a large figure was not assigned to the sale. It says it was not attempting to make vast sums of money on this sale by “holding it hostage”.
6. The Respondent then says the Complainant “refused to entertain any discussion on this and followed on to remove our provision of the FastBraces product they supply to us.” It says this left its clinics with a loss of monies “in relation to the cost in education (including courses) and purchasing of their brackets”.
7. It says the Complainant knowingly made charges against a staff credit card for licensing of the Domain Name over a substantial period of time. This card was provided purely for the payment of supplies and licenses in relation equipment and services, not domains. These were illegal unauthorized charges for which it says it had to pursue (and obtained) full refunds.
8. The Respondent says its website never carried any commercial revenue-generating adverts nor sold any products, nor did it ever feature any sponsored links. The Respondent says it was a purely educational website.
9. The Respondent says it was requested by the Complainant to remove trademark logos and references to their products and links to their webpages, from its website, which it did.
10. It also says that following “further harassment” it was requested by the Complainant to remove any combination of the words Fast and Braces when sequential but not linked - i.e. ‘Fast braces’ rather than ‘fastbraces’. The Respondent says this was “perhaps over-reaching in regards the trademark rights they hold on the term ‘FastBraces’”. The Response does not say what the Respondent did in this regard though it appears from its website (see extract quoted above) it did not fully accede to this request.
11. The Respondent says the Complainant’s trademarks do not permit it sole and exclusive ownership of the adjective ‘fast’ and noun ‘braces’ when used as sequential words in a sentence such as: “There are a number of products

available from various suppliers that act as fast braces, giving you the result you desire as quickly as possible....”.

12. The Respondent denies that the Domain Name is either identical or confusingly similar to the Complainant’s trademark. It says that anyone searching for 'FastBraces' or FastBraces IsleofMan' on Google is not going to find the website at the Domain Name which does not appear on Google (certainly not within the first 10-12 pages of results it searched).
13. It says the Complainant wishes to profit from the value the Respondent has added to the Domain Name over the period it has owned it, and to then lease the Domain Name back to the Respondent (or other parties as the Complainant now has additional suppliers of their product on the Isle of Man).
14. The Respondent says the Domain Name was not purchased to trade on or make profit from the purchase by selling it to the trademark owner, nor has it ever been its intent to use it to damage the trademark owner, or to confuse visitors to the web site at the Domain Name that it is in some way the Complainant or associated directly with the Complainant.
15. The Respondent says the Domain Name is not a top level country domain featuring only the Complainants’ trademark and points out that fastbraces.co.uk is also not owned by the Complainant, nor by the Respondent.
16. The Respondent refers to a third party source which records that “Courts have consistently protected the public’s right to use the trademarks of others in order to engage in criticism, commentary, news reporting, and other forms of non-commercial expression.” By implication it suggests it is entitled to benefit from this approach.

9. The Parties’ Contentions on Appeal

Complainant’s Contentions

The Complainant says that the Expert was incorrect to conclude in favour of the Respondent on the basis that the Complainant failed to "present any evidence that the name FASTBRACES has acquired a secondary meaning”. The Complainant says that it does not need to do this given the trademark registrations it relied upon.

The remainder of the Complainant’s contentions on appeal amount to material which either repeats what was said in the Complaint, or which this Panel considers inadmissible, for reasons explained above. The Appeal Notice includes three references to further evidence which would be “available on request”.

Respondent's Contentions

The bulk of the Respondent's submissions on appeal are directed at objecting to the contents of the Appeal Notice as amounting to new material. The Panel has accepted that argument (see above) and does not need to set out the detail of what the Respondent has said in this regard. The Respondent also repeats that its website is educational and says that *"we challenge the comment that "Fast braces" is an attempt to use the Complainant's trademark. It is descriptive and must be accepted as so as all the products listed are examples of fast (acting) braces."*

10. Discussion and Findings

General

Pursuant to paragraph 2 of the Policy, the Complainant must prove in relation to the Domain Name, 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.

Rights

"Rights" are 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 has established that it is the owner of a number of registered trade marks for the term "fastbraces".

The Domain Name is in the opinion of the Appeal Panel similar to these trademarks. It in substance combines the trademark with a geographic non-distinctive term. The suffix ".co.uk" may be ignored for the purposes of this assessment. It does not matter, as the Respondent appears to suggest, that the website at the Domain Name is not found when a particular Google search is carried out.

Accordingly, the Appeal Panel is satisfied that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

"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”.

The inchoate nature of the material that is before the Appeal Panel means assessment of this issue is not straightforward. The Complainant has simply not explained its case properly. From what has been said in the Complaint and the Response the Appeal Panel can tentatively ascertain the following potentially relevant background:

- (i) The Respondent is promoting (amongst other products) a dental braces product which its own website describes as “fastbraces ®”. It seems likely this product may be something to do with the Complainant, but the Complainant has not explained to the Appeal Panel what the relevant facts are and why it says this is objectionable.
- (ii) The Respondent’s website also describes other types of dental braces, which seem likely to be unconnected to the Complainant, but again this has not been properly explained.
- (iii) There has been some sort of relationship between the Complainant and the Respondent – but the nature of this relationship is unexplained.
- (iv) There has been correspondence between the Complainant and Respondent about the Domain Name, but the Appeal Panel does not know what this said.
- (v) The Respondent has apparently made some changes to its website at the Complainant’s request.

The Appeal Panel does not accept the Respondent’s claim that its website is simply educational and non-commercial. It may well be providing information about different types of dental braces but it is at the same time quite clearly promoting the Respondent’s business and seeking to attract customers looking for dental braces. The fact that it does so by providing information about the advantages and disadvantages of different types of dental brace does not alter this analysis.

The Appeal Panel also regards with scepticism the Respondent’s arguments that the words “fast” and “braces” are generic or descriptive if not conjoined. Even without the benefit of explanation from either Party the Appeal Panel can appreciate that the time for which dental braces need to be used may be an important factor to patients, but that alone does not seem sufficient to enable the Appeal Panel to conclude, without further evidence, that “fast braces” is an entirely generic term, signifying “fast acting braces”.

The Appeal Panel notes that the Respondent’s own website at the Domain Name contains an ® designation after the term “fastbraces” when it is used in that conjoined form. That would seem to be an acknowledgment that the conjoined form is a registered trademark and, at least implicitly, an acceptance of the distinctiveness of that conjoined term. It does not seem to the Appeal Panel easy then to say that the separated form is nevertheless non-distinctive. The Appeal Panel also notes that the Respondent’s usage of the words in separated form is odd, sometimes capitalising the

first letter of the word “fast” as in for example (at www.traceybell.co.uk/) “At Tracey Bell we provide a number of Fast braces options that are suitable for patients of all ages and with different presenting dental problems”. This usage is rather clumsy and seems somewhat at odds with the argument that the words are entirely generic. It may as matter of English usage make sense to refer to a “fast car” but referring to “fast braces” in the dental context does not seem to the Appeal Panel to be a natural use of language – a fact implicitly acknowledged by the Respondent in that it sometimes appears to find it difficult to use the words in a descriptive sense without also adding the word “acting” between “fast” and “braces” (as for example in its Appeal Response – see above) in order for the descriptive usage to read correctly.

The Appeal Panel is however reluctant to reach a conclusion contrary to the case that the Respondent has advanced, given that the Respondent has very clearly raised this argument and the Complainant, for whatever reason, has not put in any Reply at all and accordingly has chosen not to rebut the Respondent’s allegations.

The Appeal Panel is also troubled by the allegation from the Respondent that the Complainant wishes to obtain the Domain Name so that it can then lease or licence its use back to the Respondent. The Appeal Panel does not know if this allegation is correct but again the Complaint has not sought to rebut it. If it is correct the Appeal Panel would wish to understand much more clearly than is presently possible why it is the Complainant says the registration is Abusive.

If matters rested upon the issues identified above the Appeal Panel would regard the case as finely balanced. Ultimately however there is a further reason which leads the Appeal Panel to conclude this Appeal should be rejected. That arises out of the way that the Complainant has presented its case - on the basis that the Respondent is acting “fraudulently”. This is a direct allegation of dishonesty made against an apparently bona fide dental practice. The Appeal Panel is not prepared to make a finding that would in substance be accepting such an allegation of dishonesty unless, at a minimum, a convincing case has been advanced which was properly supported by a clear explanation and cogent evidence. That has not occurred.

Accordingly, the Appeal Panel rejects the Appeal. It may well be that if the Complainant had more fully explained its case, it could have prevailed. It is important to note that the DRS is a procedure which will result, if a complaint is successful, in a respondent being dispossessed, without compensation, of an asset that it obtained and paid for and (in most cases including this one) has used. It is incumbent upon a complainant to make out its case properly and with a clear explanation as to the nature of the case, and with appropriate supporting evidence. A complainant that fails to do so should not be surprised if its complaint fails. All of this is clearly explained on Nominet’s website. In the present case the Complainant has apparently paid no attention to this guidance, despite receiving a Chair’s Warning whilst filing its Complaint. The Appeal Panel in this case concludes that the Complainant has simply not explained its case clearly enough to establish, on a balance of probabilities, that there is an Abusive Registration. It is not for an expert or the Appeal Panel to infer or guess what case a complainant may have been able to make had it explained matters more clearly, nor is it for an expert or the Appeal Panel to carry out further research to make good any deficiencies in a complaint.

11. Decision

The Appeal is dismissed. No action is necessary to implement this decision.

Dated

Signed Nick Gardner

Signed Ian Lowe

Signed Claire Milne