

DISPUTE RESOLUTION SERVICE**D00018568****Decision of Independent Expert**

Associated Newspapers Limited

and

Equaliser Internet

1. The Parties:

Complainant: Associated Newspapers Limited
Northcliffe House
2 Derry Street
London
W8 5TT
United Kingdom

Respondent: Equaliser Internet
22a Fishergate
York
YO10 4AB
United Kingdom

2. The Domain Name:

dailymailadvertisers.co.uk (the "Domain Name")

3. Procedural History:

On 20 February 2017, the dispute was received. The complaint was validated on 21 February and notification of the complaint was sent to both parties. On 10 March a response reminder was sent and on 13 March a response was received and notification sent to both parties.

On 16 March a reply reminder was sent and a reply was received the same day and notification sent to both parties. On 29 March Nominet appointed a mediator and mediation started. By 21 April mediation failed and the close of mediation documents were sent to both parties. On 28 April payment for an Expert decision was received and on 05 May the Expert, Tim Brown, was appointed.

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 parties.

4. Factual Background

The Complainant is a limited company located in London that was incorporated in the United Kingdom in April 1905. It publishes a range of newspapers in the UK including the Daily Mail and The Mail on Sunday.

The Daily Mail is the Complainant's flagship publication; it was launched in 1896 and had an average readership of 3.4 million per issue between October 2015 and September 2016. Between 02 and 29 January 2017 the paper's average circulation was approximately 1.5 million per issue.

The Respondent is an entity located in York. The Respondent operates a website through the Domain Name which advocates boycotting the Complainant's advertisers. The website is headed "Daily Mail Advertisers" and notes, *inter alia*, "Is anybody interested in maintaining a list of Daily Mail advertisers which you may choose to boycott?". The site lists several companies that have advertised in the Complainant's paper and it links to various social media accounts operated by the "Stop Funding Hate" campaign which, again, seeks to encourage the public to boycott the Complainant's advertisers.

The Domain Name was registered on 03 April 2013.

5. Parties' Contentions

5.1. Complainant – Rights

The Complainant is the registrant of at least two registered trademarks for the term DAILY MAIL. These include UK trade mark number 1207666 which has a registration date of 22 November 1983 and European Union Trade Mark number 193433 which has a date of entry in the register of 05 November 1999. Extracts of both marks from the related databases have been exhibited.

The Complainant contends that the Domain Name differs from its registered mark only by the addition of the generic word "advertisers" and says that this term fails to dispel the connection between the Domain Name and its trade marks. Furthermore, the Complainant says that the additional term reinforces the link between the Domain Name and the Complainant's mark in that it denotes those who advertise in the Complainant's newspaper.

5.2. Complainant – Abusive Registration

The Complainant avers that the Domain Name is being used for the purpose of unfairly disrupting the business of the Complainant in terms of Policy paragraph 5.1.1.3. The Complainant says that the Domain Name itself strongly implies an official connection with the Complainant in that it will make web users think that it will lead to an online resource for the Complainant's advertisers or a website listing the offerings of those advertisers.

The Complainant further notes that when users arrive at the Respondent's website they find instead an invitation to boycott the Complainant's advertisers. The Complainant contends that this will damage the Complainant financially. The Complainant refers to a page linked from the website which refers to the dispatch of 16,000 tweets to nine of the Complainant's advertisers in a ten-hour period.

In supporting its contentions, the Complainant refers to the appeal decision in Rayden Engineering Limited v. Diane Charlton¹ and says that the current case is materially the same as the Rayden case in that the Domain Name does not remotely signal the purpose of the website associated with the Domain Name and therefore gives rise to "initial interest confusion".

The Complainant further contends that for these same reasons the Respondent has used the Domain Name in a way which is likely to cause confusion in accordance with Policy paragraph 5.1.2.

5.3. Respondent – Rights

The Respondent does not take issue with the Complainant's contentions on Rights and accepts that the Complainant owns a range of registered trade marks for the term DAILY MAIL and that the Complainant has a substantial reputation in the DAILY MAIL name.

5.4. Respondent – Abusive Registration

The Respondent says that the Domain Name is used for an unauthorised criticism site but contends that Domain Name does not in fact unfairly disrupt the Complainant's business. The Respondent instead avers that the website's primary intention is to encourage consumers to boycott Daily Mail advertisers. The Respondent further notes that its secondary intention is to encourage advertisers to put pressure on the Complainant to change the way it reports the news.

As the Complainant has done, the Respondent also refers to the Appeal decision in Rayden but says that the present dispute is different in that the Domain Name is not identical to the mark in question, as was the case in Rayden. Equally, the Respondent says that the Domain Name is not directed to the Complainant's customers but to its advertisers.

The Respondent denies that the Domain Name has caused any confusion and refers to the decision in RTA (Business Consultants) Ltd (trading as RTA) v. DMBCS² which related to a "protest site" related to the domain name rta-complaints.co.uk.

5.5. Complainant's Reply

The Complainant notes that it does not matter whether the Domain Name is targeted at the Complainant's readers or its advertisers as both are the Complainant's customers. Either way, the Complainant says that Respondent set out to damage the Complainant financially by encouraging users to boycott the Complainant's advertisers.

The Complainant says that the Domain Name implies an official connection with the Complainant and notes that the Domain Name is similar to a domain name which the Complainant uses for its own advertiser-facing website, namely mailadvertising.co.uk.

The Complainant contends that the Domain Name gives no hint of its negative purpose and says that the additional word "advertisers" is entirely related to the Complainant's field of activity and is one that denotes that the Domain Name is an official website intended for the Complainant's customers. Equally, the Complainant avers that the Domain Name does not give the slightest suggestion of negativity, criticism or protest and, instead, closely reflects the name of the Complainant's own advertiser-focussed website. The Complainant states that the decision in RTA (Business Consultants) Ltd (trading as RTA) v. DMBCS does not assist the Respondent.

¹ DRS 06284 - rayden-engineering.co.uk

² DRS 08580 - rta-complaints.co.uk

6. Discussions and Findings

This dispute concerns a domain name associated with a website whose contents take issue with the Complainant. It is important to note that, as with all similar disputes relating to "protest sites" under the DRS, my decision has no bearing on the merits, or otherwise, of the protest itself. I have carefully read both parties' submissions and make my decision based on these and exclusively on how they relate to the DRS Policy.

6.1. Rights

The Complainant has exhibited registered trade marks for the term DAILY MAIL which pre-date the registration of the Domain Name. The Domain Name differs from these registered marks by the addition of the word "advertisers". I take the view that the additional word is generic and descriptive and does not detract from the clearly dominant "DAILY MAIL" element of the Domain Name.

I therefore find that the Complainant has Rights in respect of a mark which is similar to the Domain Name.

6.2. Abusive Registration

Disputes relating to so-called "protest sites" are not uncommon under the DRS and paragraph 4.9 of the Expert's Overview³ covers the main issues concerning this category of dispute by asking "*Do tribute and criticism sites necessarily constitute fair use unless proved otherwise?*" It answers with the following commentary which I have edited slightly to remove considerations which are irrelevant to the current matter:

No. Paragraph 4(b) of the Policy provides that "Fair use may include sites operated solely in tribute to or in criticism of a person or business". Note the use of the words "may" and "solely"— it will depend on the facts.

...

Note also that the use of the word "may" means that even if a site is operated solely as a tribute or criticism site it is still open to the Expert to find that it is abusive. In assessing the fairness or otherwise of the use, the Expert needs to have regard to both the nature of the domain name in dispute and its use. Some decisions in the past have concentrated solely upon whether the site fairly pays tribute to or criticises the Complainant (often a very difficult thing for an expert to assess in a proceeding of this kind).

The appeal decision in DRS 06284 (rayden-engineering.co.uk) confirmed the consensus view among experts today that the nature of the domain name is crucial to the exercise. A criticism site linked to a domain name such as <IhateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant. But, again, note the decisions in DRS 08527 (ihateryanair.co.uk) and DRS 11271 (opticalexpressruinedmylife.co.uk) regarding commercial activity on criticism sites. Each case will depend upon its facts.

³ The Expert's Overview is a document which discusses common issues that arise under the DRS. It can be found on Nominet's website.

In DRS 06284 the domain name was identical to the name in which the Complainant had rights. A modified name that made it clear that this was a protest site would presumably have been less successful in drawing the protest to the attention of customers of the Complainant. The Panel concluded there was a balance to be drawn between the right to protest (which could be effected via a modified name) and the Complainant's rights in its own name, and that in this case at least the latter outweighed the former. Note that the Panel did not rule that use of an identical name would always and automatically be unfair, but did conclude that it was only in exceptional circumstances that such use could be fair. The Panel declined to find that such exceptional circumstances existed in the case in question.

The Parties discussed the decisions in Rayden Engineering Limited v. Diane Charlton relating to the domain name rayden-engineering.co.uk and RTA (Business Consultants) Ltd (trading as RTA) v. DMBCS which concerned the domain name rta-complaints.co.uk. The decision in DCM (Optical Holdings) Limited v. Sasha Rodoy,⁴ which involved the domain name opticaexpressruinedmylife.co.uk, also provides some useful discussion.

Paragraph 3.3 of the Overview provides further valuable commentary on what is meant by "confusing use" in the terms of the Policy and discusses the concept of initial interest confusion; both of which have a bearing on my decision.

I note that the Domain Name is not identical to the mark in which the Complainant has Rights as it incorporates the additional word "advertisers". It is common practice for web users to find web sites through search engines or directly type domain names into their browsers. The question is whether a web user, when they see the Domain Name in isolation via a search engine's results or decide to type it into their browser, would expect to find a website operated by the Complainant or an unrelated third party like the Respondent. Does the additional word "advertisers" make it clear to web users that this is a protest site or a site operated by the Complainant or otherwise connected with them at the point they see the Domain Name?

Where no action was taken in the earlier disputes noted above the additional words or phrases in the domain name made clear either the type of material that web users might find on the site (such as "complaints") or that the site was not operated by the Complainant (such as "ruinedmylife"). In these cases, the domain name in and of itself made it obvious what users might expect to find on the associated website.

Turning to the current matter I take the view that the additional word "advertisers" does not make it clear who might operate the site or what its contents might be. While this is a relatively closely balanced point I have taken into account that the Complainant itself operates a web site at a similar domain name (namely, mailadvertising.co.uk). I therefore conclude on the balance of probabilities that web users are more likely than not to think the Domain Name is one that is operated by or associated with the Complainant. Based on the Domain Name alone, it is unlikely that web users would expect to find a protest site such as the Respondent's.

I therefore conclude that the Domain Name is likely to cause confusion in accordance with Policy paragraph 5.1.2 and is therefore Abusive in terms of the Policy.

I have also considered whether the Domain Name is being used for the purpose of unfairly disrupting the business of the Complainant in terms of Policy paragraph 5.1.1.3. On balance, I take the view that a potentially confusing domain name is being used to target the Complainant's customers (as advertising is clearly an important element of the Complainant's business model) and it is inevitable that encouraging the Complainant's advertisers to boycott

⁴ DRS 11271 - opticaexpressruinedmylife.co.uk

the Complainant must unfairly disrupt its business. So, again, I find that that the Domain Name is Abusive in terms of Policy paragraph 5.1.1.3.

Finally, I reiterate that my decision has no bearing on the merits of the Respondent's cause for protest and perhaps had the Domain Name made it clear the kind of site that web users might expect to find then my decision may well have been different.

7. Decision

Having determined that the Complainant has Rights in respect of a mark that is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive registration, I order that the Domain Name be transferred to the Complainant.

Signed

Tim Brown

Dated 11 May 2017