

DISPUTE RESOLUTION SERVICE

D00019619

Decision of Independent Expert

MEDIA SMART UK LIMITED

and

Isabella Francis

1. The Parties:

Complainant: MEDIA SMART UK LIMITED
7th Floor North, Artillery House,
11-19 Artillery Row
London
London
SW1P 1RT
United Kingdom

Respondent: Isabella Francis
West Midlands,
United Kingdom

2. The Domain Name(s):

mediasmart.org.uk

3. Procedural History:

The Expert has confirmed that (1) he is independent of each of the parties; and (2) to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need to be disclosed because they might be of such a nature as to call into question his independence in the eyes of one or both of the parties.

11 December 2017 13:25 Dispute received
12 December 2017 12:49 Complaint validated
12 December 2017 13:12 Notification of complaint sent to parties
02 January 2018 01:30 Response reminder sent
04 January 2018 10:36 Response received
04 January 2018 10:36 Notification of response sent to parties
09 January 2018 01:30 Reply reminder sent
11 January 2018 08:27 Reply received
11 January 2018 08:35 Notification of reply sent to parties
11 January 2018 08:37 Mediator appointed
19 January 2018 11:04 Mediation started
16 February 2018 11:43 Mediation failed
16 February 2018 11:44 Close of mediation documents sent
20 February 2018 16:15 Expert decision payment received

4. Factual Background

The Complainant is a company registered with an address in London.

The Respondent is an individual, with an address in the West Midlands.

The Domain Name was originally registered on 24.02.2002, and from at least 06.12.2014 was registered in the name of the Complainant, until the registration apparently lapsed on 25.07.2016. It was then registered in the name of the Respondent.

At the date of this Decision, the Domain Name resolves to a holding page which says that the “Smartest London PR and Media Advertising Agency in the Country” is working very hard to create the “coolest website for you to enjoy”.

5. Parties’ Contentions

The Complainant Rights

The Complainant asserts the right to continue using the Domain Name, and attaches historical WHOIS Data which shows the position regarding previous registrant details.

In its submissions on Rights, the Complainant says that the material shown on the website accessed through the Domain Name is its material, with its contact details. It provides a link to an Internet Archive page and says that the material, evidenced by an undated screenshot of a contact details page apparently from 2008 (it includes “Media Smart UK 2008” in its lower left corner), has not changed over the years.

Abusive Registration

The Domain Name has been used primarily to confuse internet users and block the registration “against a name the Complainant has Rights (sic)”. As the Domain Name still links to the legacy website of the Complainant, users are “genuinely confused and their enquiries do not reach the legitimate business anymore”.

The Complainant also says that “until last week, the WHOIS data relating to the new registrant was incorrect”.

The Complainant seeks transfer to itself.

The Respondent

The Response has apparently been submitted by Marion Goonetilleke, the Registrar, on behalf of the Respondent.

Rights

The Respondent says nothing about Rights.

Abusive Registration

The Respondent says that the “plan is for the domain to be used for a media website on behalf of one of are (sic) clients”. “It seems the site was kept live as having a site was preferable while the new site was being developed. We have informed the client that he cannot host someone else’s content and we have taken the site down”. The Respondent claims there was no malicious intent to pass off as the Complainant as the contact details were unchanged, with the Complainant’s old phone number and address listed.

The Respondent refuses to transfer the Domain Name, and all content relating to the Complainant has been taken off prior to the new site and content going live.

Reply

In its Reply the Complainant thanks the Respondent for taking down its copyright material, but points out that the Respondent continued to host the material up until it complained, and that the Respondent has failed to demonstrate any preparation to launch a new site that predates the Complaint.

6. Discussions and Findings

In order to succeed in its Complaint, in accordance with the Policy, the Complainant needs to establish:

- “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.”*

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is as follows:

“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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”.

The definition of Rights under the Policy is 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.”

Rights

The Complainant appears to have misunderstood, or not read, the guidance on the Nominet website as to what it needs to do to establish that it has (enforceable) Rights in a name or mark which is identical or similar to the Domain Name. It does not say who it is or what it does. There is no indication of how long it has been trading. Its assertion to have used the Domain Name since 2002 is only partially supported by its evidence of historical WHOIS registrant data (the data only goes back to 2014). However, it does cite two websites in its Complaint upon which it relies to support the dispute. One of those is what appears to be its current website at www.mediasmart.uk.com. The other is the Internet Archive Wayback Machine relating to the Domain Name. It also exhibits the screenshot of the contact details page from 2008.

An Expert should not normally conduct investigations independent of the parties' submissions, unless it is particularly expedient in a given case. The Experts' Overview (2016), para 5.10, cautions that “Parties should not assume that Experts will view any web sites mentioned in the Parties' submissions, but if the content of a web site is important to a Party's case, that Party should exhibit print-outs from that web site”. Clearly, that advice has not been followed here, and the Expert does not know what material in particular the Complainant regards as important to its case. The Complainant does not exhibit copies of material accessed through the Wayback Machine, nor indicate which material the Expert should inspect. However, at the same time, the general thrust of the Complainant's case regarding the historical material is clear – the legacy website material continued to be shown on the website accessed through the Domain Name after the Complainant had ceased to be the registrant. This does not seem to be disputed by the Respondent (indeed it is tacitly acknowledged in the Response, by the Respondent taking down “someone else's content”). The Respondent also does not dispute the Complainant's Rights, and goes at least as far as accepting that the Complainant was the owner of the copyright in the material in question.

A bare assertion that the Complainant has Rights will rarely be sufficient to establish the requirement of an enforceable right on the balance of probabilities (Experts' Overview, para 2.2). In this case, it could be argued that the Complainant has not even got that far, as it appears to have misunderstood what is required.

Nevertheless, the Complainant has relied upon its current (and historical) websites, although unfortunately without exhibiting relevant pages, and the Respondent has not disputed the Complainant's ownership of Rights. In the circumstances, the Expert has decided that it would be expedient to look briefly at both websites to see if they support the general thrust of the Complainant's contentions. The www.mediasmart.uk.com Home page explains that the Complainant is a not-for-profit company creating free educational material for schools and youth organisations to help young people think critically about advertising. The Wayback Machine material (a small sample of which the Expert has viewed) shows that similar material with the Complainant's branding appeared from as far back as 2002 (and continued to be shown for at least 12 months after the Complainant ceased to be the registrant of the Domain Name).

Whilst even the current website seems not to explain the extent of the Complainant's business, it does appear to be the case that it has a history of operating over an extended period which would be likely to be sufficient to give rise to enforceable Rights under the Policy in the name or mark MEDIASMART, which is identical to the Domain Name. Given the absence of challenge from the Respondent on this ground, the Expert therefore finds on the balance of probabilities that the Complainant has Rights within the meaning of the Policy.

Abusive Registration

The Complainant's primary contention is that the users of the website, after its loss of the registration in July 2016, will have been confused, and their enquiries do not reach the legitimate business anymore. The Respondent (or the Registrar on her behalf) says that this was a mistake by its client, without malicious intent, and that there would have been no confusion because the contact details were not changed nor added to. Further, the legacy website material was all taken down prior to the new website and content "going live". It says that there is a plan for the Domain Name to be used for a media website on behalf of this client. As the Complainant points out in its Reply, this fails to demonstrate any preparation to launch a new site that predates the Complaint.

There is much to criticise on both sides here. Why, for instance, did the Complainant lose its registration; why has it apparently done nothing about that until now; does it say there is actual confusion; what is the difference between its current and legacy websites; and why and to what extent does it say that the legacy website material would have confused users? What is the relationship between the Respondent, the "client" (referred to as "he" in the Response), and the Registrar; how far advanced

are the “client’s” plans; and why did it think that leaving the legacy website material available would conceivably have been of benefit to it?

The Expert is left feeling that he has been given the barest of explanations by both sides, which is, to say the least, unsatisfactory. However, it seems to be common ground that the Domain Name has been used by the Respondent, perhaps on behalf of some unidentified client, to continue to host the Complainant’s legacy website material after the Complainant lost the registration, without its consent.

Although the logic behind that behaviour is obscure, the Expert cannot agree with the Respondent’s line of reasoning that, because nothing was changed, there was no detriment to the Complainant. A user hoping to access the website of the Complainant, unaware of the change in ownership of the Domain Name, will have been faced with a website which it would no doubt have thought was the up to date and current version of the Complainant’s website, when it was not (or at least the Expert assumes that there would have been changes over time – unfortunately the Complainant does not detail what changes, if any, were made in the intervening period). In that way, the Complainant lost control over how it represented itself to potential users, and that can only have been unfairly detrimental to the Complainant’s business.

Also, although postal and telephone details may not have changed, the screenshot put in evidence by the Complainant also contains an email address (info@mediasmart.org.uk), which would presumably have ceased to work in providing a means of communicating with the Complainant. The excuse put forward by the Respondent that this was all part of some wider plan is wholly unparticularised (and doubtful in any event, given that the proposed website is still said to be under development). However, even if there were some such plan, it would not justify in any way continuing to use the Complainant’s copyright material without its consent. Nor is it any kind of justifiable excuse that the material was taken down before the any new website became live – that has no bearing on the prejudice caused to the Complainant before the material was taken down. Therefore, although the Complaint is a weak one, the Respondent’s position is untenable. On the balance of probabilities, the Expert therefore finds that the registration by the Respondent is abusive.

The Complainant has also referred to the registration being a blocking registration, and claimed that the previous WHOIS details were incorrect, but without further elaboration on either account. The Expert is not prepared to speculate what the Complainant intended to argue by those submissions, and therefore does not accept them. However, this does not matter in relation to the overall result, given the conclusion which the Expert has already reached, above.

7. Decision

The Expert finds that the Complainant has Rights in the name or mark MEDIASMART, which is identical to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Complainant.

Signed Bob Elliott

Dated 8th March 2018