

DISPUTE RESOLUTION SERVICE

D00021142

Decision of Independent Expert

Siteready Ltd

and

Garth Piesse

1. The Parties:

Lead Complainant: Siteready Ltd
The Porter Building, 1 Brunel Way
Slough, Berkshire SL1 1FQ
United Kingdom

Respondent: Garth Piesse
c/o PO Box 181
Palmerston North
Manawatu 4440
New Zealand

2. The Domain Name:

<siteready.co.uk>

3. Procedural History:

The Complaint was filed with Nominet on 22 February 2019. Nominet validated the Complaint on 25 February 2019 and notified the Respondent of the Complaint by post and by email the same day, stating that the due date for submission of a Response was 18 March 2019. The Response was filed on 12 March 2019 and Nominet notified the Response to the Parties on the same day. Nominet notified the Complainant that a Reply had to be received on or before 15 March 2019. The Respondent's Reply was received on 19 March 2019 and the mediator was appointed on the same day.

The Informal Mediation procedure started on 19 March 2019 and failed to produce an acceptable solution for the Parties and so on the same day Nominet informed the Complainant that it had until 2 April 2019 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). The Complainant did not pay the required fee. On 4 April 2019 the Respondent paid Nominet the required fee.

On 9 April 2019 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he was independent of each of the parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of such a nature as to call in to question his independence in the eyes of one or both of the Parties.

4. Factual Background

The Complainant, Siteready Ltd is a company which was incorporated in the United Kingdom on 12 February 2019. It claims to be a labour-hire business that supplies temporary and contract labour to construction-industry clients in the United Kingdom. The Complainant states that it is the registrant of the domain name <siteready.uk>, registered on 13 February 2019 (although the Expert notes that the website at "www.siteready.uk" consists only of a webhosting landing page).

The Respondent is an individual based in Palmerston North, New Zealand. The Respondent operates a business of buying and selling descriptive domain names. The Respondent registered the Domain Name <siteready.co.uk> on 9 August 2018. The Domain Name resolves to a parking page where the Domain Name is offered for sale and invites Internet users to submit an offer for purchase of the Domain Name.

5. Parties' Contentions

Complaint

The Complainant's Rights

The Complainant asserts that it has rights in respect of its company name, which was incorporated and is operating in the United Kingdom. The Complainant also asserts rights in the domain name <siteready.uk>, of which it is the registrant.

The Complainant states that it is engaged as a labour-hire business, as described in the factual background section above. The Complainant states that its business operates from Slough, and only focuses on construction projects and industry clients based in the United Kingdom.

The Complainant asserts that it has developed a website and social media footprint which it would like to "launch under the more established .co.uk domain

www.siteready.co.uk" as most of the Complainant's "client and customer pipeline operate using .co.uk domains."

The Complainant argues that trading without the ".co.uk" domain name will be significantly detrimental to its success as a business and the development of its brand and trading name in the United Kingdom.

Abusive Registration

The Complainant asserts that the Domain Name is registered with an individual based in Palmerston North, New Zealand. The Complainant states that the Respondent does not appear to be using the Domain Name for trading purposes in the United Kingdom, nor does the Respondent have a live website or email service for the Domain Name.

The Complainant states that it attempted to purchase the domain name via the website "www.undeveloped.com" for GBP 100, finding that the minimum offer needed to be above USD 3,000.

The Complainant argues that the Respondent registered the Domain Name primarily for the purposes of selling the Domain Name for valuable consideration well in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or "normally and reasonably maintaining administration" of the Domain Name.

The Complainant believes that the Respondent is engaged in a pattern of registering ".co.uk" domain names which correspond to well-known names or trademarks in which the Respondent has no apparent rights, including the Domain Name. The Complainant states that the Respondent operates a company called "Domain-For-Sale.co.uk", and that the Respondent has been identified as a "serial domainer".

The Complainant acknowledges that there are other companies incorporated in the United States of America and Australia that operate under the business name "Siteready", with which it has no affiliation.

The Complainant requests transfer of the Domain Name.

Response

The Complainant's Rights

The Respondent argues that a complainant claiming unregistered rights must provide evidence which shows that the complainant has used the name in question for a significant period, to a not insignificant degree, and that the name is recognized by the purchasing public as indicating the goods and services of the complainant.

The Respondent states that the Complainant has provided no such evidence in the present case. In fact, the Respondent highlights that the Complainant was incorporated on 12 February 2019, some two weeks before the Complaint was filed.

The Respondent asserts that the Complainant has not even started trading, and disputes that the Complainant has acquired any rights in the term "siteready".

Abusive Registration

The Respondent makes reference to the DRS appeal DRS 4331 (<verbatim.co.uk>), in which the appeal panel stated that for a complaint to succeed, the complainant must satisfy the panel that the respondent was aware of the existence of the complainant or its brand at the date of registration of the domain name or at commencement of an objectionable use of the domain name.

The Respondent explains that it is in the business of buying and selling generic and descriptive domain names, citing paragraph 8.4 of the Policy, which states that "[t]rading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities."

The Respondent states that it registered the Domain Name in 2018, having seen the Domain Name on a list of soon-to-be expired Domain Names. The Respondent noted that the Domain Name was composed of two generic terms "site" and "ready", likely to be relevant to, *inter alia*, the construction industry. The Respondent states that it owns many other domain names including the term "site".

The Respondent notes that a Google UK search for "siteready" brings up approximately 770,000 results, and that the Complainant does not feature on the first page, which confirms the Complainant's admission that other businesses are using the same name.

The Respondent asserts that it could not have been aware of the Complainant at the time of registering the Domain Name, as the Complainant came into existence around six months later.

While the Respondent had it in mind to sell the Domain Name, for reasons set out above, it could not have acquired the Domain Name for the purposes of selling it to the Complainant. Again, the Respondent cites paragraph 8.4 of the Policy, mentioned above.

The Respondent denies that it is engaged in an abusive pattern of domain name registration. In this regard, the Respondent notes that it has been named as a respondent in 14 cases under the Policy, in all of which the Respondent prevailed. The Respondent further notes that the Domain Name does not correspond to a well-known trade name or trademark.

The Respondent notes that the Complainant has provided no evidence in support of its allegation that the Respondent is a "serial domainer", and also notes that ownership of a high volume of domain names is conduct that is expressly allowed for under the Policy.

The Respondent states that in accordance with paragraph 5.2 of the Policy, the failure on the part of the Respondent to use the Domain Name for email or for a website is not in itself evidence that the Domain Name is an Abusive Registration.

The Respondent requests a finding of Reverse Domain Name Hijacking. The Respondent says that the Complainant knowingly filed a hopeless case as it was unwilling to pay the price for the Domain Name quoted on the Respondent's website, hoping that the case would be "waved through" in the event of there being no Response. The Respondent asserts that the Complainant was aware of the provisions of the Policy, but failed to properly address them, and has sought to misrepresent its case and withhold relevant evidence. The Respondent submits that by failing to disclose the date of its incorporation some six months later than the date of registration of the Domain Name, the Complainant withheld a key piece of evidence which fatally undermined its already weak case.

Reply

In reply to the Response, the Complainant wrote the following:

"We have read the respondent's response and do not wish to address the points in the response at this time as we critically need a website up and running ASAP (using another .co.uk domain name as we can not afford the USD\$3000 requested by the respondent for the domain) and believe that any mediation process or subsequent expert opinion may take too long. Therefore, we respectfully withdraw our complaint."

6. Discussions and Findings

Under paragraph 2.1 of the Policy, for the Expert to order transfer of the Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, that:

- 2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- 2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration."

The burden of proof with regard to the above elements is on the Complainant. The Expert notes that in its Reply, the Complainant requested the withdrawal of its Complaint. However, at that time, the Respondent had already been notified of the Complaint, and had spent the time and money necessary to prepare and file its Response. Noting that the Respondent has vigorously disputed the allegations made against it by the Complainant, and also noting that the Respondent has paid for a full decision (which is a procedure that is expressly provided for in paragraph 13.2 of the Policy), the Expert considers it appropriate to proceed to a decision on the merits.

The Complainant's Rights

The Complainant claims rights in its company name "Siteready Ltd". The question of whether a company name registration *per se* can give rise to a Right as defined in the Policy is considered under the Nominet Experts' Overview, paragraph 1.7:

"The consensus view of recent Experts' meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose. An appeal panel in DRS 16594 (<polo.co.uk>) agreed with that approach."

The Expert sees no reason to depart from the consensus view as outlined above, and finds that the Complainant is unable to establish a "Right" based on its company registration alone.

The question then becomes whether the Complainant can establish unregistered trademark rights in "siteready" for the purposes of the Policy.

As noted in the Nominet Experts' Overview, paragraph 2.2:

"If the right is an unregistered trade mark right, evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (*e.g.* by way of sales figures, company accounts *etc*) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant."

Critically, the Complainant has provided no evidence that could support a finding that the Complainant has rights in the term "siteready" beyond its company name. The Complainant has not provided any evidence of the duration and nature of the use of its name, the amount of sales or services rendered using the name, advertising or evidence of promotional expenditure, or any other evidence of its recognition of the name by the public as denoting the goods and services offered by the Complainant.

Notwithstanding that the name "siteready" is clearly reflected in the Domain Name, the Expert finds that the Complainant has produced insufficient evidence to establish "rights" in the term "siteready" for the purposes of the Policy. Therefore the Complaint fails under this element.

Abusive Registration

Even though the Complainant has not succeeded on the first element, the Expert will also consider whether the Complainant has established whether the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Paragraph 1 of the Policy defines "Abusive Registration" as 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."

Paragraph 5.1 provides a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. The Complainant's arguments under this element are focused on paragraphs 5.1.1.1 and 5.1.3 of the Policy.

Paragraph 5.1.1.1 of the Policy states:

"[the Respondent has registered or otherwise acquired the Domain Name primarily] for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name"

The Respondent's intent plays a central role in the Expert's analysis under this paragraph. As noted in the Response, the Complainant must satisfy the Expert that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name, or at commencement of an objectionable use of the Domain Name (see DRS 04331 <verbatim.co.uk>).

Based on evidence produced by the Respondent, the chronology of events in this case is clear. The Domain Name was registered on 9 August 2018, some six months before the incorporation of the Complainant's company on 12 February 2019. The Complainant has not produced any evidence of its business activities before that date (in fact, the Complainant has not produced any evidence of its business activities whatsoever).

As a matter of logic, the Expert cannot reasonably determine that the Respondent registered the Domain Name for the purposes of selling it to the Complainant, as set out in paragraph 5.1.1.1 of the Policy. Even if the Respondent's intent in registering the Domain Name was to sell it, as noted in paragraph 8.4 of the Policy:

"Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities."

Turning to paragraph 5.1.3 of the Policy, this requires that:

"The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under '.uk' or otherwise) which correspond to well-known names or trademarks in

which the Respondent has no apparent rights, and the Domain Name is part of that pattern."

While this is alleged by the Complainant, the Complainant has failed to provide any evidence in support of this contention. Rather, the Respondent has come forward with a list of "site"-formative Domain Names in support of its assertion that its business model is built on the practice of buying and selling domain names composed of descriptive terms. Included in the Respondent's portfolio are such domain names as <sitenet.com> (registered on 24 October 1995), <sitecontrol.co.uk>, registered on 25 November 2010), <sitereport.co.uk> (registered on 27 August 2016) and <siteprotect.co.uk> (registered on 1 May 2018). Moreover, out of the 14 decisions under the Policy involving the Respondent as the registrant of the concerned domain name, the vast majority involved domain names composed of dictionary terms, or combinations of dictionary terms. What is evident from the above is that the Respondent maintains a comprehensive portfolio of domain names composed of dictionary terms, or combinations of dictionary terms, and yet there is no evidence that the Respondent has engaged in a pattern of domain name registration targeting third-party trademarks. As stated above, maintaining a large portfolio of domain names and trading in domain names for profit is expressly provided for under paragraph 8.4 of the Policy.

Finally, not only is the Complainant's assertion that the Domain Name is not being used in connection with any active website inaccurate (the Domain Name resolves to an active website where the Domain Name is offered for sale) – it is also misguided in the sense that failure to use a domain name for the purposes of email or a website is not in itself evidence that the Domain Name is an Abusive Registration: see paragraph 5.2 of the Policy.

For the above-stated reasons, the Expert finds that the Domain Name in the hands of the Respondent is not an Abusive Registration and that the Complaint also fails under this element of the Policy.

Reverse Domain Name Hijacking

As noted above, the Respondent requests that the Expert enter a finding of Reverse Domain Name Hijacking. Paragraph 1 of the Policy defines Reverse Domain Name Hijacking as "...using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name". In submitting its Complaint, the Complainant warrants that:

"The information contained in this complaint is to the best of the Complainant's knowledge true and complete. This complaint is not being presented in bad faith and the matters stated in this complaint comply with the Policy and applicable law."

While the Panel notes that the Complainant was not represented, Nominet has invested substantial time and efforts in order to make resources available online for parties to assess the strengths and weaknesses of their respective filings. In the interests of fairness, parties should be treated equally, represented or not.

The Complainant was clearly familiar with the terms of the Policy – as noted above, the Complainant's submissions under Abusive Registration clearly reference the wording of paragraph 5 of the Policy, and yet the Complainant considered it appropriate to provide no evidence of its business operations whatsoever. In fact, the only evidence provided by the Complainant was a screen capture of the website at the Domain Name.

A not unreasonable inference that can be drawn from the Complainant's omission of such evidence is that there is none. Rather than to attempt to refute the Respondent's assertions, in its Reply, the Complainant wrote:

"[...] we can not afford the USD\$3000 requested by the respondent for the domain and believe that any mediation process or subsequent expert opinion may take too long. Therefore, we respectfully withdraw our complaint."

The Expert infers from the Complainant's conduct that the Complaint was brought, not on the basis of a legitimate dispute over the rights to the Domain Name, but as an attempt to use the Policy as a means to deprive the Respondent of the Domain Name, rather than to be put to the inconvenience and expense of purchasing the Domain Name from the Respondent. As a result, the Respondent has incurred considerable time and expenses defending its position against a meritless complaint.

For the foregoing reasons, the Expert determines that the Complainant has engaged in Reverse Domain Name Hijacking.

7. Decision

Having determined that the Complainant has not established rights for the purposes of the Policy, nor that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert orders that no action be taken regarding the Domain Name. Furthermore, the Expert finds that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking.

Signed: David Taylor

Dated: 7 May 2019