

**Nominet UK Dispute Resolution Service**

**DRS 04884**

**Maestro International, Inc v Mark Adams**

**Decision of Appeal Panel**

**Dated:** 13 December, 2007

**1. Parties:**

**Complainant/  
Appellant:**

Maestro International Inc.

Address: 2000, Purchase Street  
Purchase  
New York  
Postcode 10577-2509  
Country USA

**Respondent** Mark Adams

Address: PO Box 7310  
Milton Keynes  
Buckinghamshire  
Postcode: MK8 0ZQ  
Country: UK

In this decision, for simplicity's sake, we propose to maintain the terminology of the Expert's decision and refer to the Complainant/Appellant as "the Complainant" and the Respondent as "the Respondent".

**2. Domain Name in dispute:**

maestro.co.uk

This domain name is referred to below as the "the Domain Name"

**3. Procedural Background:**

12/07/2007 Dispute entered into system  
18/07/2007 Hardcopies received in full  
20/07/2007 Complaint documents generated and sent to Respondent  
14/08/2007 Extension of time for Response requested and granted. New deadline 20/08/2007  
21/08/2007 No Response received  
05/09/2007 Fees for Expert Decision received from Complainant  
12/09/2007 Mr Steven Maier selected as expert  
26/09/2007 Expert Decision sent to Nominet

- 09/10/2007 Notice of intent to appeal received from Respondent together with the appropriate deposit fee
- 30/10/2007 Balance of Appeal payment received
- 30/10/2007 Appeal Notice received and forwarded to Complainant
- 14/11/2007 Appeal Response received and copied to Respondent
- 14/11/2007 Mr Tony Willoughby selected as chair of Panel; Messrs Chris Tulley and Mark de Brunner selected as co-panellists

Each of Messrs. Tony Willoughby, Chris Tulley and Mark de Brunner (the undersigned, "the Panel") have individually confirmed to the Nominet Dispute Resolution Service 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."*

This is an Appeal against a Decision at first instance. The Panel for this Case was appointed to provide a decision on or before 9 January, 2008. This process is governed by the *Procedure for the conduct of proceedings under the Dispute Resolution Service* ("the Procedure") and the Decision is made in accordance with the *Dispute Resolution Service Policy* ("the Policy"). Both of these documents are available for inspection on the Nominet website (<http://www.nominet.org.uk/disputes/drs>).

#### **4. The Nature of This Appeal:**

The Policy §10a provides that: *"the appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters"*.

The Panel concludes that in so far as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits. Accordingly, the Panel does not propose to undertake a detailed analysis of the Expert's decision and will only refer to the Expert's decision where the Panel feels it would be helpful to explain any difference in approach.

#### **5. Formal and Procedural Issues:**

There are no outstanding formal or procedural matters, which need to be addressed by the Panel.

## 6. The Facts:

The Complainant is a subsidiary of Mastercard, which, as a household name in the United Kingdom, needs no introduction. MAESTRO is Mastercard's leading debit-card brand in the United Kingdom.

It is not in dispute that the Complainant has trade mark rights in the mark, MAESTRO (word), for a wide variety of goods and services largely in the financial services field.

The Respondent is engaged in web design and domain name registration services. He trades under the name, 3DWeb Online Services and has his main trading website at [www.3dweb.co.uk](http://www.3dweb.co.uk).

Between May 2004 and May 2005 the Respondent registered a number of domain names comprising and/or including the well-known trade marks of others e.g. <goldenarches.co.uk>, <beverlyhillscop.co.uk>, <bigbrothertv.co.uk>, <popidol4.co.uk>, <forrestgump.co.uk>, <phonenames4u.co.uk> and <netnames4u.co.uk>.

The Respondent registered the Domain Name on 5 April, 2006 and shortly afterwards the Domain Name was connected to the Respondent's above mentioned website.

On 19 July, 2006 someone representing the Complainant emailed the Respondent asking him how much he wanted for the Domain Name. The Respondent replied a few minutes later saying that he was planning to develop the Domain Name "and would only consider selling it for an exceptional offer".

On 24 July, 2006, the Complainant's representative went back, asking the Respondent what figure he had in mind. The Respondent replied the same day saying that he had reserved the Domain Name for his own use and had already invested a significant amount of time and energy in the brand. He invited the Complainant's representative to put in his best offer. The correspondence terminated there.

On 3 April, 2007 the Complainant's solicitors wrote a letter of demand to the Respondent seeking transfer of the Domain Name.

On 10 April, 2007 the Respondent replied disputing the validity of the Complainant's trade mark rights, arguing non-infringement and groundless threats and denying passing off. He states that he proposes to use the Domain Name for music downloads, educational and tuition services.

On 17 April, 2007 the Complainant dismisses the Respondent's arguments and renews the demand for transfer of the Domain Name.

This line of correspondence ends with the Respondent's reply of 24 April, 2007 in which he restates his position. In this letter he states that he registered the Domain Name unaware of the Complainant's brand and with the dictionary meaning of the word in mind. He declines to agree to transfer of the Domain Name.

## 7. **The Parties' Contentions:**

The Panel does not feel it necessary to set out in full here the parties' contentions at first instance. They are set out by the Expert in his decision of 26 September, 2007.

The issues before the Panel are amply set out in the Appeal Notice and Response, which are quoted in full below.

### **The Complainant 's Appeal Notice**

1. The Expert has, notwithstanding his own reservations as to the veracity of the Respondent's assertions (made in correspondence rather than in a formal Response) (Paragraph 7.27 of the decision), given the Respondent the benefit of the doubt. In light of the evidence submitted of registrations by the Respondent of domain names including well known trade marks of third parties, the Expert was wrong to do so and he should have considered the Complaint in the overall context of a Respondent who has a record of registering domain names which include third party trade marks.

#### Respondent's lack of Response and Correspondence

2. Paragraph 4 of the Decision acknowledges that no Response was filed to the Complaint despite an extension of time being granted to the Respondent.
3. All correspondence between the Complainant's representative and the Respondent is attached to the Complaint at Annex F.
4. Section 5(iv) of the Procedure stipulates that any Response to the Complaint must end with the following statement of truth: *"The information contained in this response is to the best of the Respondent's knowledge true and complete and the matters stated in this response comply with the Procedure and applicable law"*.
5. The Expert is right to have regard to all evidence submitted by the Complainant, including all correspondence with the Respondent, but, in the absence of a statement of truth, ought not to have relied on it to such a large extent in his consideration of the overall merits of the case.
6. The Respondent should not be allowed to benefit from submissions that have not been verified by a statement of truth and therefore unfairly profit from his decision not to respond to the Complaint in the manner provided by the Policy and the Procedure.

#### Pattern of Abusive Registrations

7. The expert acknowledges that the Respondent's domain names listed at Annex G to the Complaint *"stretch the boundaries of*

*what can properly be regarded as generic*" and that at least <forrestgump.co.uk> cannot be seen as generic.

8. It is submitted that the Expert was too generous in his assessment of the Respondent's domain names. All of the domain names listed in the Complaint are either identical to or incorporate famous third party trade marks in which the Respondent has no legitimate rights and therefore constitute a pattern of registrations. The Expert clearly had in mind that it was necessary or at least of relevance that there was no evidence of "findings" of Abusive registrations. This is not the correct test to be applied under the Policy, and led to the Expert incorrectly dismissing this ground of complaint. The correct test is whether *"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 trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern."* Had the Expert applied the correct test he would have found that the registration of the Domain Name was Abusive.

#### Evidential Burden

9. Section 2(b) of the Policy states that *"The Complainant is required to prove to the Expert that both elements [of Section 2(a)] are present on the balance of probabilities"*. It is submitted that, and notwithstanding the Expert's assertions to the contrary, this was not the test in fact applied by the Expert who seemingly applied a far higher test.
10. Although MAESTRO has a dictionary definition and has been used as a trade mark by other organisations, the Complainant's substantial use of MAESTRO in the financial services industry has resulted in significant acquired distinctiveness and an overwhelming public awareness of the MAESTRO brand.
11. The Expert acknowledged the following points:
  - (a) *"I accept that the Complainant has gained a degree of distinctiveness [in MAESTRO]"* (PARAGRAPH 7.11);
  - (b) *"I accept that a number of the domain names relied upon by the Complainant stretch the boundaries of what can properly be regarded as generic and in one instance, <forrestgump.co.uk>, the name is clearly not generic"* (Paragraph 7.24);
  - (c) *"I treat with a considerable degree of scepticism the Respondent's assertions (i) that he was unaware of the Complainant's brand at the date he registered the Domain Name and (ii) that he*

*intended to "develop" the Domain Name in the manner described" (Paragraph 7.27)*

12. It is for the Complainant to prove that the registration is Abusive and it is submitted that the Complainant has done so on the balance of probabilities for the following reasons:

- (a) the Complainant has shown that the Respondent has a pattern of registrations corresponding to third party trade marks; and
- (b) the Expert should have attached more weight to his "*scepticism*" that the Respondent was unaware of the Complainant's MAESTRO brand and that he intended to "develop" the Domain Name.

### **The Respondent's Response**

1. The Respondent considers this Appeal to be unmeritorious as it is merely the re-submission of previously unsuccessful allegations without offering anything further. Such a vexatious appeal should not be considered. To the extent it is, the Respondent submits the following in response to the Appeal Notice ("the Notice").

#### Respondent's lack of Response and Correspondence

- 2. The Respondent notes paragraphs 2-4 of the Notice.
- 3. The Respondent accepts paragraph 5 of the Appeal to the extent the Claimant acknowledges the Expert has a right to regard all evidence submitted by the Complainant. The Complainant, in its unsuccessful complaint, both referred to the correspondence sent by the Respondent and attached it to their submissions. The Respondent, therefore, believes it is disingenuous for the Complainant to now complain that the expert "relied on it to such a large extent."
- 4. For the avoidance of doubt, the Respondent confirms the information contained in its response to the original complaint is to the best of the Respondent's knowledge true and accurate.
- 5. In any event, the correspondence was sent in good faith to prevent any vexatious complaint.

6. Furthermore, a formal response to the initial complaint is not mandatory nor, in light of the lack of substance to the complaint, was it considered necessary. The Respondent considers that raising this point as a ground on which to appeal the decision is a further example of the disingenuous and vexatious nature of this Appeal.

#### Pattern of Abusive Registrations

7. The Respondent notes the words of the Expert quoted in paragraph 7 of the Appeal but denies paragraph 8.
8. The Complainant does not provide substantive evidence of abusive behaviours on the balance of probabilities; it merely asserts an appearance of impropriety and imputes guilt. The Panel is not charged with assessing the merits of previous registrations, only the Domain Name in question. In the absence of any previous, nor pending, complaints, no impropriety can reasonably be inferred.
9. The Domain Name is a generic term, not exclusively referable to the Complaint; evidenced by the plethora of other domain names including or incorporating 'maestro'.

#### Evidential Burden

10. The Respondent denies that a far higher test than was appropriate was applied. There is no evidence to suggest the expert applied a test higher than necessary in the circumstances.
11. It is perfectly feasible that someone would register the term 'maestro' without the Complainant in mind as it is a generic term, not exclusively referable to the Complainant. Indeed, in the Notice, the Complainant concedes that "MAESTRO has a dictionary definition and has been used as a trade mark by other organisations."
12. Furthermore, it is perfectly feasible that someone would want to register a domain name with the term 'maestro' and then develop that domain due to its potential. It is a word that finds its true meaning in another language, thereby increasing its potential use and audience, and is used in English parlance with laudatory connotations, thereby benefiting from such corresponding goodwill. Such potential is evidenced by the

sheer number of 'maestro' domain names registered with no other variation beyond the corresponding suffix.

### Conclusion

13. The Complainant has simply not satisfied the evidential burden incumbent on it and there are no grounds for appealing the decision.

14. The Respondent is guilty of nothing more than registering the Domain Name before the Complainant. This is not a ground of appeal.

15. The Domain Name is a generic term with laudatory connotations, the benefit of which is both recognised and enjoyed by many other proprietors of domain names incorporating the term 'maestro' with no other variation other than the suffix.

16. This Appeal should be dismissed.

## **8. Discussion and Findings:**

### **General**

In order for the Complainant to succeed it must (Policy §2) prove to the Panel, on the balance of probabilities, **both**:

*that it has Rights in respect of 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 as defined in Paragraph 1 of the Policy.*

The meaning of 'Rights' is clarified and defined in the Policy in the following terms:

***Rights** includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business;*

If the Complainant satisfies the Panel that the Complainant has relevant rights, the Panel must address itself to whether the registration by the Respondent of the Domain Name is abusive.

An Abusive Registration is defined in the Policy as follows:

***Abusive Registration** means a Domain Name which either:*



*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*

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

### **The Issues before the Panel**

There is no dispute between the parties that the Complainant has rights in respect of a name or mark (i.e. MAESTRO), which is identical or similar to the Domain Name.

Accordingly, the Panel merely has to focus its attention on whether or not the Domain Name is an Abusive Registration in the hands of the Respondent.

As indicated above, a domain name can be an Abusive Registration either because it was registered with abusive intent or because it has been used in an abusive manner.

The issue before the Panel is a relatively straightforward one, for in the particular circumstances of this case, all depends upon whether the Complainant can satisfy the Panel on the balance of probabilities that the Respondent registered the Domain Name and/or has used the Domain Name with the Complainant in mind.

As can be seen from the Complainant's contentions set out in the decision at first instance, the Complainant's contentions as to Abusive Registration take a number of forms, but all stand or fall on this particular issue.

The Complainant prays in aid the following matters, namely:

1. The Respondent's denial of all knowledge of the Complainant's MAESTRO trade mark. The Complainant claims that the fame of the mark is such that this denial should not be believed.
2. The Respondent's statement that he intends to use the Domain Name for musical downloads, education and tuition services.
3. The Respondent has made a habit of registering domain names featuring the well-known trade marks of others and the Domain Name is part of that pattern.

The Complainant contends that these three matters (or one or more of them) should lead the Panel to conclude that the Respondent registered and/or has used the Domain Name with a view to taking unfair advantage of or causing unfair detriment to the Complainant's Rights. The Panel deals with each of these matters in turn:

### Respondent's knowledge of the Complainant's trade mark

The Panel is inclined to agree with the Expert that the Respondent might be expected to have known of the Complainant's MAESTRO trade mark when he registered the Domain Name. Whether he had it in mind when he registered the Domain Name is another matter. It might be said (as the Complainant would undoubtedly say): "Well, of course, he had the Complainant in mind. Why otherwise would he make the implausible claim that he was unaware of the Complainant's brand?". The Panel is not prepared to go so far as to accept that, but even assuming that the Respondent was aware of the trade mark, he would also have been aware of the automobile trade mark of the same name. Why should he be assumed to have had the Complainant's trade mark in mind as opposed to the automobile trade mark?

Additionally, knowledge of the Complainant's trade mark only gets the Complainant part of the way. When the trade mark in question is a dictionary word, there has to be something more than knowledge of the trade mark to justify a finding of Abusive Registration. Were it otherwise, owners of trade marks which are dictionary words would effectively be able to monopolise the use of such words for domain names.

Of course, if the Respondent was lying when he said that he was unaware of the Complainant's trade mark, he might have done so simply because he was aware that there have been several decisions under the DRS Policy stating categorically that knowledge of the Complainant's trade mark at the relevant time is crucial to a successful complaint. It is an easy thing to say and difficult to disprove, unless the trade mark in question is a very well-known mark and while the Complainant's trade mark is well-known in many circles, it is probably not yet in the MASTERCARD class, for example.

Nonetheless, the Panel accepts that there is scope for scepticism and that it is a factor to weigh in the balance.

### Respondent's intentions

When a domain name registrant (and particularly a domain name dealer) is approached by a would-be purchaser of a domain name, it is commonly the case that the registrant will talk up the value of the domain name. One way of talking it up is to represent that a significant investment has been made in it or, if there is no demonstrable business associated with the domain name, in plans that the registrant has for the domain name. If the registrant has reason to fear an attack from a rights owner, whether it be a litigious attack or a complaint under the relevant domain name dispute resolution policy, the registrant will ordinarily seek to justify his choice of name, distancing it from the Complainant's Rights.

In this case, the Respondent has behaved entirely predictably. In his email of 24 July, 2006 he told the Complainant's representative "*I have already put a considerable amount of time and energy into the setup of my business for this brand over the year.*" At that time he did not know that his would-be purchaser was a representative of the Complainant. When he was approached openly by the Complainant's solicitors and threatened with legal proceedings, he responded (his letter of 10 April, 2007) by seeking to justify his choice of name saying that he had "*plans to use it for musical downloads, educational and tuition services*" i.e. services pertinent to the dictionary meaning of 'maestro'.

At no stage has the Respondent produced any evidence of his plans, the product of the "*considerable amount of time and energy*", which he claims to have put into the business. It would have been very easy for him to have produced some supporting material had he wished to do so.

The Panel is prepared to assume that the Respondent has not devoted any significant time and energy in the Domain Name and never had the plans for it, which he claims to have had. His purposes in the above communications were first to talk up the value of the Domain Name and secondly to see off the Complainant.

Again, this is a factor for the Panel to weigh in the balance, but in the particular circumstances of this case (primarily the very nature of the Domain Name), the Panel does not give it much weight.

#### The alleged pattern

The evidence before the Panel is that between May 2004 and May 2005 the Respondent registered 12 domain names featuring the well-known names and trade marks of third parties. The names and trade marks are 7 in number, namely: GOLDEN ARCHES, BIG BROTHER, BEVERLY HILLS COP, FORREST GUMP, NET NAMES, PHONE NAMES and POP IDOL.

The 12 domain names identified certainly represent a pattern; but is the Domain Name part of that pattern?

On the evidence before it, the Panel does not believe that it is.

First, while most of the names in that pattern of names include ordinary dictionary words, they are combinations of words, being combinations, which are either so well-known that their ordinary meaning is overwhelmed by their fame as trade marks ( e.g. BIG BROTHER and POP IDOL) or combinations, which are not common expressions (e.g. NET NAMES and GOLDEN ARCHES). BEVERLY HILLS COP and FORREST GUMP are, of course, in a class of their own as names. MAESTRO on the other hand, unlike any of the others is at least as much known for its ordinary English meaning as for anything else.

Secondly, the Domain Name was registered in a different time period, almost a year after the last of the other domain names. Had the pattern been shown to have extended throughout the interim period, the Panel might have viewed the situation differently.

Finally, the Panel suspects that the domain names identified by the Complainant are only a small proportion of the domain names in the Respondent's portfolio. The Complainant, in its Appeal Notice, carefully states "*All of the domain names **in the Complaint** are either identical to or incorporate famous third party trade marks ....*"

If it were the case that the Respondent's portfolio comprised the Domain Name and the objectionable domain names cited in the Complaint and no others, the Panel might have been inclined to draw the inference contended for by the Complainant, but, as the Respondent is a domain name dealer, manifestly that is not the case and the Panel is not prepared to draw that inference.

### **Conclusion**

Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive, if it is to be held to be an Abusive Registration under the DRS Policy.

In this case the Respondent has not done himself any favours by having in his portfolio some obviously objectionable names and by making what appear, in the absence of any supporting evidence, to be disingenuous, self-serving claims in respect of the Domain Name.

However, it is up to the Complainant to prove, on the balance of probabilities, that the registration is abusive. While the Panel has not found this an easy case, the Panel is not satisfied on the evidence before it that the Domain Name in the hands of the Respondent is an Abusive Registration.

### **9. Decision**

The Panel therefore dismisses the Appeal, reaffirms the Expert's decision and directs that NO ACTION be taken in respect of the Complaint.

Chris Tulley

Tony Willoughby

Mark de Brunner

Dated:13 December, 2007