

DISPUTE RESOLUTION SERVICE

DRS 6516

Decision of Independent Expert

British Tourist Authority

and

Toby Lingstadt

1. The Parties:

Complainant: British Tourist Authority
Address: Thames Tower
Blacks Road
London
Postcode: W6 9EL
Country: United Kingdom

Respondent: Toby Lingstadt
Address: Scorrybrae
Goslawdales
Selkirk
Postcode: TD7 4EP
Country: United Kingdom

2. The Domain Name(s):

visit-england.co.uk

3. Procedural History:

The Complaint was filed on 12 November 2008 and subsequently sent to the Respondent who filed a Response on 9 December 2008. That in turn was sent to the Complainant which then filed a Reply on 18 December 2008. The Reply was then sent to the Respondent. Mediation was unsuccessful and on 27 January 2009 the Complainant paid the fee to refer the matter to an expert for a decision to be made. I was subsequently appointed, having confirmed my independence.

There is one outstanding procedural issue to deal with first. Having received a copy of the Complainant's Reply, the Respondent asked to make a further non-standard submission under paragraph 13 of the DRS Procedure, the relevant part of which states as follows:

13 b. Any communication with us intended to be passed to the Expert which is not part of the standard process (e.g. other than a complaint, response, reply, submissions requested by the Expert, appeal notice or appeal notice response) is a 'non-standard submission'. Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission. We will pass this explanation to the Expert, and the remainder will only be passed to the Expert at his or her sole discretion. If there is no explanation, we may not pass on the document or information.

13 c. On receipt of a non-standard submission we shall copy to the other Party the explanatory first paragraph, but we will only send the remainder to the other Party if and when the Expert requests sight of the remainder.

I have received the Respondent's explanatory paragraph in which he says that he wants to comment on what he believes are the significant changes as between the Complaint and the Reply in the dates that the Complainant relies on as to its ownership of similar domain names. However, I do not believe anything turns on the changes of dates because the revised dates still pre-date the Respondent's acquisition of the Domain Name and I cannot see that there is any exceptional need for the Respondent to comment on them. I therefore do not require sight of the non-standard submission.

4. Factual Background

The Complainant is a UK statutory body set up in 1969 with powers to promote tourism to and within Great Britain. As from April 2003 it has operated under the name of "Visit**Britain**". Since then, it has also used "Visit**England**", "visit**England**" and "enjoy**England**". Each of these is in a slightly stylised form, usually with the "visit" and "enjoy" elements in lower case and the "England" element with a capital "E" and in bold and with no gap between the words. They are often used in association with a Tudor rose logo.

Since 2003 the Complainant has used "visit**England**" principally when advertising abroad via brochures and guides and the like, whereas "enjoy**England**" is aimed principally at English residents. However, the Complainant's use of visit**England** appears to have increased since 2008 when it began to be used on one form of its headed notepaper and became the name of the English Marketing Advisory Board which itself had previously been known as the English Tourist Board.

However, the Complainant's main website is at www.enjoyengland.com, which heralds itself as "*the official website for tourism in England*"; "*the official website for English tourism*" and "*the official website for breaks and days out in England*". The Complainant controls the domain names visitengland.co.uk and visitengland.com, both of which resolve directly to the Complainant's website at www.enjoyengland.com.

The Complainant also has websites at www.visitengland.fr, www.visitengland.de and www.visitengland.nl in French, German and Dutch respectively. However, the front page of each one is headed, not with the **visitEngland** name, but with the **enjoyEngland** name alongside its Tudor rose logo and heralds itself as "*the official website of English tourism*" in each local language.

The Domain Name was first registered on 12 June 1999 and was subsequently transferred to the Respondent on 26 May 2006. It currently resolves to a parking page that contains links to a variety of other websites, including sites relating to accommodation, travel and hotels etc. The Respondent has a portfolio of .co.uk domain names comprising the word "visit" followed by the name of a country or city, some with a hyphen in between and others without. The Domain Name is part of this portfolio. The Respondent's practice has been to resolve each domain name to a parking page website containing automated links to third party websites. He then monitors traffic levels before deciding which of his portfolio of domain names to develop further and in what order.

5. Parties' Contentions

There have been extensive submissions and supporting documentation filed by the parties.

Complainant:

The Complainant says that:

1. *The Complainant has rights in the Domain Name because:*
 - a. *On 25th July 1969 it was incorporated under the Development of Tourism Act 1969 as both the "British Tourist Authority" and the "English Tourist Board" with statutory powers to promote tourism to and within Great Britain;*
 - b. *By order of the Secretary of State for the Department of Culture, Media and Sport, the Government of the United Kingdom authorized the new trading names of "VisitBritain" and "VisitEngland" to be effective from April 2003;*
 - c. *It trades under the name "VisitEngland" and has done so since April 2003: It exhibits examples of the use made in the form of*
 - *marketing (Tabs 3-9 of the bundle),*
 - *advertising materials (Tabs 3-9 of the bundle), and*
 - *letterheads (Tab 9 of the bundle);*

d. It has advertised using the name "VisitEngland" since April 2003. It spent £4,046,375.00 in the financial year 2003-2004 on such advertisements;

e. It provides services under the name "VisitEngland" as evidenced by the brochures, map and guides exhibited;

f. It is the registrant for the domain name *visitengland.co.uk*, which was registered by the Complainant on 14th October 1998. It is the registrant for the domain name *visitengland.com*, which was registered by the Complainant on 17th October 1998.

g. It is the owner of all the share capital in the shell company *VisitEngland Limited*. This company registration number: 06322637 is registered at Companies House Cardiff. It was incorporated on 24th July 2007. The company search is at Tab 10.

h. It is the owner of the following eleven (11) UK registered trade marks:

- 2422132 Enjoy England + Tudor Rose
- 2422133 Enjoy England + Tudor Rose
- 2422134 Enjoy England + Tudor Rose
- 2422135 Enjoy England + Tudor Rose
- 2234227 England + new rose emblem
- 2234231 England + stylized flag
- 2205579 English Tourism Council device
- 2217222 English Tourism Council
- 2281421 England Net
- 2312676 England Net Online Tourism Network
- 2214032 Tudor Rose emblem

2. The Complainant emphasizes:

- The Complainant is a statutory corporation set up by the Development of Tourism Act 1969 (Tab 1) in 1969 and funded by grant-in-aid by the UK Government.

- The Complainant exists to promote tourism to and within Great Britain.

- In April 2003 there was a re-structure and re-branding within the Complainant. The 1969 Act set up both the British Tourist Authority and the English Tourist Board as separate statutory corporations. The activities of the English Tourist Board were merged with those of the British Tourist Authority in April 2003. "VisitBritain" was adopted as the overall business name.

- The Complainant also adopted at this time the names "VisitEngland" and "EnjoyEngland" as two new business names and trademarks for its domestic tourism activities. Presently "VisitEngland" is used by the Complainant principally to attract foreign visitors to come and visit England. "Enjoy England" is used by the Complainant principally to market England as a tourist destination in its own right to people who already live in England. These two brands are however interlinked and form part of the Complainant's overall business strategy. The overview of this strategy is in the document: "Introducing Visit England: Growing England's visitor economy" at Tab 7 of the bundle.

- *In 2008 the Complainant has made a further internal restructuring within its business. "Visit England" remains as the business name of the body corporate incorporated under the Development of Tourism Act 1969 (Tab 1) as the "English Tourist Board". "Visit England" is also now used as the name of the marketing division within "Visit Britain" (the business name of the entity incorporated under the Development of Tourism Act 1969 as the "British Tourist Authority"). This recent restructure does not alter the fact that "Visit England" has been used by the Complainant as a domain name since October 1998 and as a principal business name since April 2003.*
- *The Secretary of State for Culture Media & Sport approved the new business name.*
- *The Complainant registered VisitEngland.co.uk on 14th October 1998.*
- *The Complainant registered VisitEngland.com on 17th October 1998.*
- *The Complainant's Board Minutes show that the Complainant spent over £4 Million on promoting its new brand identity in the Financial Year 2003-4.*
- *At Tabs 3-8 are samples of the Complainant's brochures produced between 2004-2008 all clearly stating its business name "VisitEngland" and referring to its website address of www.VisitEngland.com.*
- *At Tab 9 is a sample of the Complainant's business stationary first used in April 2008. Also at Tab 9 is a PDF of colour artwork used to produce a promotional mug by the Complainant in April 2004. This clearly states "VisitEngland.com" as the Complainant's website address.*
- *At Tabs 3-5 are versions of the Complainant's brochures clearly bearing the name "VisitEngland" with the Tudor Rose Registered Trademark (Tab 2). These brochures have been translated into French, German and Dutch/Flemish to attract visitors to England from France, Germany and the Netherlands respectively.*
- *The Complainant has micro-sites for these territories whose website addresses are www.visitengland.fr , www.visitengland.de and www.visitengland.nl respectively. The home page screen dumps for these micro sites along with that for www.enjoyengland.com are at Tab 11 of the bundle. These micro site domain names were registered on 31st March 2005, 18th November 2005 and 17th December 2004 respectively. The web address www.visitengland.com typed into a web browser defaults automatically to the portal www.enjoyengland.com .*
- *The Respondent registered Visit-England.co.uk on 15th March 2004. This was 1 year after the Complainant adopted its new business name and trademark. It was also 6 years after the Complainant secured its initial registrations for its business for the domain names visitengland.com and visitengland.co.uk .*
- *The Complainant has eleven (11) Registered Trademark applications for its various "England" brand names – see Tab 2. This includes an existing Registered Trademark dated 10th November 1999 in the Tudor Rose emblem*

(Number: 2214032) used as part of its post-April 2003 brand identity – see Tab 2.

- There has been extensive promotion of VisitEngland by the Complainant. This started with the new brand's launch at Shakespeare's Globe on St George's Day (23rd April) 2003.

- The Respondent did not think up the VisitEngland name!

- At Tab 12 is the initial "Cease & Desist" letter dated 5th May 2008 attempting to obtain a voluntary transfer of the Domain Name, the Respondent's email dated 25th June 2008 disputing the Complainant's entitlement to invoke Nominet's abusive registration process and the Complainant's rebuttal letter dated 27th June 2008. These requests for voluntary transfer remain unheeded at the date of filing this Complaint.

3. The Domain Name in the hands of the Respondent is abusive because it was:

a. primarily registered for the purposes of selling, renting or otherwise transferring it to [the Complainant] or [its] competitor for at a price greater than his costs in that he has no bona fide intention of offering a "VisitEngland" portal. The Respondent is not and never has been "Visit England". The Respondent is called "Toby Lingstadt". The name of the Respondent's business is "UK Website Marketing". The Respondent has no rights in the name "Visit England".

b. primarily registered to stop [the Complainant] registering it despite [its] rights in the name because the visit-england.co.uk name was only registered by the Respondent on 15th March 2004 which was one year after the Complainant adopted its new brand identity. The domain name visit-england.co.uk was registered by the Respondent 5 years and 3 months after the Complainant started using the visitengland.com and visitengland.co.uk names.

c. primarily registered to unfairly disrupt [the Complainant's] business because the hyphen in the domain name used by the Respondent has the great potential to cause confusion and its use by the Respondent is not innocuous. The Complainant sends out regular newsletters to its contact database from the newsletter@enjoyengland.com email address and surveys from the info@enjoyengland.com email address. If the Respondent was to send out emails from either the newsletter@visit-england.co.uk or info@visit-england.co.uk addresses, the Complainant's customers, suppliers, contacts, prospects and business users would be misled and deceived into believing that those emails were officially endorsed by the Complainant and/or the UK Government's Department for Culture Media and Sport.

d. used by the Respondent in a way which already has confused people into thinking that it was controlled by the Complainant, specifically running a tourism portal which purports to be the official UK Government back tourism website and confused members of the public and those in the tourism industry in the process.

e. could be used by the Respondent (if it has not been so used already) for phishing and cloning scams whereby the Complainant's identity was impersonated and members of the public were duped into believing they were

dealing with a UK Government Non Ministerial Public Body rather the Respondent who seeks to trade off the Complainant's goodwill.

f. registered with incorrect name and address details, because the Respondent acted in bad faith and the initial registration he had with Nominet UK was that for a private individual and his address details were hidden from the "Whois" database. It is clear that the Respondent is running a business called "UK Website Marketing" (www.ukwebsitemarketing.co.uk) and has done so since 2003. This is a search engine optimization company.

g. On the home page for www.visit-england.co.uk which the Respondent has produced in the top right hand corner is a link saying: "Enquire about this domain". This link takes you to www.namehire.com where an on-line form can be completed to contact the owner to enquire about the purchase of this domain name. It is clear from this that the name was registered by the Respondent just for re-sale at a profit. These screen dumps are at Tab 12 of the bundle.

4. Cases resolved by Nominet Experts in favour of the legitimate rights holder involving hyphens in co.uk names:

- *Enjoy-England.co.uk* *DRS04250/04251*
- *Fruit-of-the-loom.co.uk* *DRS02257*
- *Alliance-Leceister.co.uk* *DRS03453*
- *Various Alliance & Leicester* *DRS02532*
- *The-Salvation-Army.co.uk* *DRS01341*
- *Club-18-30.co.uk* *DRS00655*

DOCUMENTATION IN SUPPORT OF COMPLAINT

- 1 Extract of Development of Tourism Act 1969 25th July 1969
- 2 Trademark Certificates for the following marques at the UK Intellectual Property Office:
 - (i) 2422132 EnjoyEngland® + Tudor Rose 18th May 2006
 - (ii) 2422133 EnjoyEngland® + Tudor Rose 18th May 2006
 - (iii) 2422134 EnjoyEngland® + Tudor Rose 18th May 2006
 - (iv) 2422135 EnjoyEngland® + Tudor Rose 18th May 2006
 - (v) 2234227 England® + new Rose 27th May 2000
 - (vi) 2234231 England® + stylised flag 27th May 2000
 - (vii) 2205579 English Tourism Council® device 11th August 1999
 - (viii) 2217222 English Tourism Council® 15th Dec1999
 - (ix) 2281421 EnglandNet® 25th Sept 2001
 - (x) 2312676 EnglandNet Online Tourism Network® 9th Oct 2002
 - (xi) 2214032 Tudor Rose emblem 10th Nov 1999
- 3 Discover England brochure – French version February 2008
- 4 Discover England brochure – German version February 2008
- 5 Discover England brochure – Dutch version February 2008
- 6 England Rocks – Dutch version April 2008

- 7 Introducing VisitEngland – Growing England’s visitor economy – Corporate Brochure June 2008
- 8 EnjoyEngland ideasbooks (x2) – Outside Front covers September 2004
- 9 VisitBritain stationary samples for England marketing
 - (i) A4 letter headed, April 2003
 - (ii) A4 letter headed, September 2007
 - (iii) PDF of artwork used to produce promotional mugs 30th April 2004
- 10 Company search on VisitEngland Limited (Company Registration Number: 0632263), 24th July 2007
- 11 Front page screen dumps for the following portals:
 - (i) www.visitengland.fr,
 - (ii) www.visitengland.de,
 - (iii) www.visitengland.nl, and
 - (iv) www.enjoyengland.com.
- 12 Cease and desist correspondence:
 - (i) Screen dumps for www.visit-england.co.uk and www.namedrive.com , 8th Sept 2008
 - (ii) Initial letter to Toby Lingstadt sent recorded delivery, 5th May 2008
 - (iii) Email from Toby Lingstadt to D Bowden Consulting 25th June 2008
 - (iv) Our further letter 27th June 2008

The Respondent:

In his Response, the Respondent says:

- *This is the first time I have been involved in a DRS case.*
- *I do not believe that the Complainant has Rights to a mark/name that is identical or similar to visit-england.co.uk. And definitely not Rights that prevent anyone else owning and using a domain name involving the generic words “VISIT” and “ENGLAND”.*
- *I also state that my ownership of the domain visit-england.co.uk is NOT an abusive registration.*

IN RESPONSE TO THE COMPLAINANT’S POINTS

1a and 1b:

I do not disagree with these.

1c:

I do not believe the evidence provided shows that the term “VisitEngland” is actively used today to promote the England Tourist Authority in the UK.

Tab 3 shows “visitEngland” is used in France via visitEngland.fr in 2008.

Tab 4 shows "visitEngland" is used in Germany for visitEngland.de in 2008.

Tab 5 and 6 show "visitEngland" is used in Holland for visitEngland.nl in 2008.

Tab 7 shows that "visitEngland" is used as part of the visitBritain.com/corporate website in 2008.

Tab 8 and 9 are the only places where "visitEngland" appears in a domain name, namely visitengland.com is mentioned in the three photos featuring writing. However, all three of these are from the year 2004. Are there no more recent examples from 2005-2008?

Unless the Complainant has any more recent examples where they use visitengland.com, this appears to suggest a move away from "visitEngland" to "enjoyEngland" as the main site for advertising the services of the English Tourist Authority in the last few years. This is supported by the fact that the URL visitengland.com is not in use as a website per se, but instead forwards users directly to the EnjoyEngland.com website. VisitEngland.co.uk also forwards the user directly to the same EnjoyEngland.com website.

The 3 photos from 2004 (in Tab 8 and 9) that do mention the visitengland.com website appear to have a TM trademark next to them. Can the Complainant please clarify if the domain name visitengland.com is trademarked or not? If not, was this a mistake on the photos? If it is trademarked, what is the trademark date? There is no mention of such a Trademark Certificate in Tab 2 that covers the Complainant's trademarks (mostly involving "EnjoyEngland" + Tudor Rose).

It appears that there is no trademark for "VisitEngland" on its own (without a Tudor Rose), nor for visitengland.com, nor for "Visit England", nor for "Visit-England" nor for the domain visitengland.com, nor for the domain visitengland.co.uk, nor for my domain visit-england.co.uk.

1d:

A proper breakdown is required to see how much was spent on material that used the visitengland.com or visitengland.co.uk domains. The next question is why has the Complainant not provided a more recent figure, such as for the financial year 2007-2008? I believe this is because "VisitEngland" is not being used to promote the British Tourist Authority in the UK. Maybe "VisitEngland" is just too generic for advertising and trademark purposes in English-speaking countries?

1e:

Some of this has already been addressed in more detail in section 1c. above. "VisitEngland" services are used in brochures in France, Germany and Holland. The only mention of any service provided under the name "VisitEngland" is Tab 7, a booklet entitled "Introducing VisitEngland" that claims "VisitEngland is the new stakeholder Board for the development and marketing of England's visitor economy". Emphasis should be placed on the words "Introducing" and "new" here. This booklet is from June 2008, several years after I became the owner of the domain visit-england.co.uk. Creating a new organisation or company AFTER my domain registration date would invalidate this new organisation or company from being able to claim Rights to my domain name. It also suggests why there is perhaps this sudden interest in my domain name, despite the fact that it has never been owned by

"VisitEngland" or the British/English Tourist Authority in the past. It also suggests that this may be an attempt at Reverse Domain Name Hijacking by the Complainant.

It is also interesting to note that "VisitEngland" uses visitbritain.com/corporate as the only URL in this booklet, rather than any URL involving the words "Visit" and "England" (such as visitengland.co.uk, which as mentioned, forwards to EnjoyEngland.com).

1f:

I do not disagree with this.

1g:

This new company VisitEngland Limited was only formed in 2007. visit-england.co.uk was registered many years beforehand – in 1999, on 6/12/1999 in fact (see APPENDIX B. More on this matter later). This looks like an attempt at Reverse Domain Name Hijacking!

1h:

None of the 11 trademarks mentioned by the Complainant involve "VisitEngland" or "Visit England" or "Visit-England". My domain visit-england.co.uk does not infringe on any of the trademarks mentioned by the Complainant - such as "EnjoyEngland", the Tudor Rose or the English Tourism Council. Non of these appear on visit-england.co.uk.

I believe the two words "VISIT" and "ENGLAND" are too generic to trademark on their own - hence there is no trademark for "VisitEngland" (which differs from my domain anyway, as my domain has a hyphen, which is important, and ends in .co.uk, also important).

2.

Bullet points 1, 2 and 3:

I do not disagree with these points.

Bullet point 4:

This bullet point has been split up and issues raised are addressed one at a time.

COMPLAINANT states: "The Complainant also adopted at this time the names "VisitEngland" and "EnjoyEngland" as two new business names and trademarks for its domestic tourism activities".

Without spelling it out clearly (for obvious reasons), the Complainant appears to make a case that one name ("VisitEngland") is similar to the disputed domain visit-england.co.uk, and that they have Trademark Rights in a second name ("EnjoyEngland"). This crossover invalidates their case if the Complainant has to assert that the domain name in dispute is similar/identical to a name AND they have Rights to that SAME name.

COMPLAINANT states: "Presently "VisitEngland" is used by the Complainant principally to attract foreign visitors to come and visit England".

My domain at www.visit-england.co.uk is aimed at people from the UK, hence the co.uk ending. Therefore there is NO overlap in our target audiences.

The Complainant is not using visitengland.co.uk, it forwards to enjoyengland.com. For a UK audience the Complainant uses "EnjoyEngland" and the domain EnjoyEngland.com. EnjoyEngland.co.uk re-directs to EnjoyEngland.com. These are very different from visit-england.co.uk, so there is no overlap or possible confusion for visitors.

It should be noted that visitengland.com does NOT seem to be aimed at attracting foreign tourists to the UK. It forwards to enjoyengland.com, which is aimed at UK visitors. It appears visitengland.com is not aimed at anyone really. It is not used for foreigners and for UK people they are re-directed to enjoyengland.com.

COMPLAINANT states: "Enjoy England" is used by the Complainant principally to market England as a tourist destination in its own right to people who already live in England.

"Enjoy England" is very different from my domain name visit-england.co.uk, so there is therefore no chance that the UK public will get our domains confused.

The Complainant is not advertising visitengland.com, visit-england.com (they don't own this domain anyway) or visitengland.co.uk, so why would visitors looking for the EnjoyEngland Tourist Authority website therefore try to access it via visit-england.co.uk?

COMPLAINANT states: These two brands are however interlinked and form part of the Complainant's overall business strategy. The overview of this strategy is in the document: "Introducing Visit England: Growing England's visitor economy" at Tab 7 of the bundle.

A new business strategy developed in 2007/2008 apparently, several years after visit-england.co.uk was registered. This DRS case is starting to evermore look like an attempt at Reverse Domain Name Hijacking.

Bullet point 5

First of all, why has "VisitEngland" become "Visit England"? Where did this new space come from between the two words? Is this a mistake by the author? Or is this a new name? Is it trademarked? The same applies to "Visit Britain". There is no space in the marketing material provided. This is misleading. However, I will this assume this is carelessness by the Complainant's representative, rather than trying to be deliberately misleading in creating a name more similar to my domain name.

Secondly, registering the visitengland.com and visitengland.co.uk domains in 1998 does not give the Complainant automatic rights to similar names. Apparently "VisitEngland" is a principal business name as of 2003. If it is a principal business name now, why do visitengland.com and visitengland.co.uk forward to EnjoyEngland.com? It does not appear to be a principal business name in terms of being used for UK website purposes.

Even if it has been a principal business name since April 2003, visit-england.co.uk was registered before that date. On 12/6/1999 (more on this later. Also see APPENDIX B). Creating a marketing division in 2008 with the name "Visit England" –

or should that be "VisitEngland" - and then trying to claim domain names that contain the generic words VISIT and ENGLAND, like mine, that were registered several years earlier – is certainly a creative way at trying to obtain a domain name. The Complainant's marketing department may even get some publicity from this DRS case.

Bullet points 6, 7, 8:

I do not disagree with any of these points.

Bullet point 9:

Is this for VisitBritain.com? Which brand?

The Complainant's point seems irrelevant. They would have known that visit-england.co.uk was already registered in 2003 by someone else had they checked. Again, the fact that these are financial figures from over 4 years ago also seems strange. How much did the Complainant spend on "VisitEngland" and related domain name advertising in 2007-8 in the UK? And how much did the Complainant spend on "EnjoyEngland" and related domain name advertising in 2007-8 in the UK? As visitengland.com and visitengland.co.uk simply forward to enjoyengland.com, and no evidence has been provided of "VisitEngland" advertising, I believe "EnjoyEngland" is the name that receives any significant UK funding, rather than "VisitEngland".

Bullet point 10:

A misleading sentence. Tabs 3, 4, 5, 6, 7 and 8 do NOT all refer to the website address of visitEngland.com. The ONLY one that does so is Tab 8, and this is photo material from 4 years ago in 2004. No evidence has been provided from the last 3 years that includes the website address visitEngland.com (or visitEngland.co.uk, for that matter). Tabs 3-7 promote other website addresses.

Bullet point 11

The stationary uses the domain visitbritain.com/visitengland. This is very different from my visit-england.co.uk domain.

However, the phrase "...first used in April 2008" is important. Perhaps this explains the Complainant's sudden interest in my visit-england.co.uk domain, which started in June 2008. Nine years after this domain was first registered and several years after I became the owner!

With regards to the mug artwork from 2004, no Trademark Certificate evidence has been supplied to show that a TM trademark symbol can be legitimately be placed next to the visitengland.com website address here.

Bullet point 12

Please see [APPENDIX C]. It is interesting to note that visitEngland.fr, visitEngland.de and visitEngland.nl are active websites. They do NOT forward to EnjoyEngland.fr, EnjoyEngland.de and EnjoyEngland.fr, for example. Yet, visitEngland.co.uk is not an active website, it forwards to EnjoyEngland.com.

Now the Complainant wants my visit-england.co.uk domain, despite not even using visitengland.co.uk. And yet

visit-england.fr points to a holding page (no mention of VisitEngland)

*visit-england.nl points to a holding page (no mention of VisitEngland)
and*

visit-england.de forwards to Grossbritannien.de (owned by someone else, unrelated to VisitEngland).

This suggests that "VisitEngland" do not believe that hyphenated versions of their domain names are important for them to use, nor that visitors will be confused and type in a hyphenated version of a "VisitEngland" domain name.

The same applies to visit-england.co.uk., except even more so, as VisitEngland do not even use visitEngland.co.uk in any UK marketing material. EnjoyEngland.com is the official website for English tourism. People will NOT type in visit-england.co.uk looking for "EnjoyEngland" or "VisitEngland" websites.

It is also worth noting that VisitEngland do not own the domains visit-england.com, visit-england.net or visit-england.org.

Bullet point 13

Why does visitengland.com default automatically to enjoyengland.com?

Why does visitengland.co.uk default automatically to enjoyengland.com?

This suggests visitengland.com and visitengland.co.uk are not being advertised and promoted in the UK. EnjoyEngland.com is.

Bullet point 14

Possibly an interesting point by the Complainant IF it was correct. However, it is incorrect. The WHOIS data does not give the original date of registration, which occurred 9 years ago now, on 6/12/1999! This was confirmed by Nominet after a number of emails to them (see APPENDIX B).

1999 is quite a while before 2003 and any date when VisitEngland could perhaps claim to have any rights on a hyphenated version of their name ending in co.uk.

I believe this registration date invalidates any further argument that can be made by the Complainant that they have Rights to the visit-england.co.uk domain name, as it was registered BEFORE VisitEngland was used for a business and any possible trademark they may - or probably do not - have regarding the name. And visit-england.co.uk was registered LONG BEFORE they created VISITENGLAND LIMITED in July 2007 (Complainant's Tab 10).

It does not matter that visitengland.com and visitengland.co.uk were registered in 1998. They are generic names and at the time were not trademarked. As far as I know, they are still not trademarked. Generic domain names (especially when not trademarked, and by their nature they are hard/impossible to trademark) are available to be registered by other people/companies/organisations. This is what happened with visit-england.co.uk.

Bullet point 15

None of these trademarks seem to involve the words "VisitEngland" "Visit England" or most importantly "Visit-England", with a hyphen. My domain name is visit-

england.co.uk. None of the trademarks that the Complainant seems to have - such as "EnjoyEngland" - are similar to my domain name.

Bullet point 16

There is no evidence that VisitEngland is/has actively been promoted in the UK in the last 3 years at least. VisitEngland.com and VisitEngland.co.uk both even default to a different website address – EnjoyEngland.com! There is no mention of "VisitEngland" on the EnjoyEngland.com website.

One area where money has been used for with regards to VisitEngland is to register a new company VISITENGLAND LIMITED with Companies House (see the Complainant's Tab 10). The Date of Incorporation is 24/7/2007! Several years after I became the owner of visit-england.co.uk. So the Complainant registered a limited company in 2007 and then in 2008 they try and get a domain name that was registered several years earlier. This seems quite ridiculous and I suggest this is either a very poorly thought out DRS case, or a deliberate attempt at Reverse Domain Name Hijacking by the Complainant and their representative.

Bullet point 17

What can you say to that? I am not sure what point is being made here by the Complainant and elegantly put by their representative David Bowden from LobbyandLaw.com, for I am not a trained lawyer as he is. It seems like a waste of an exclamation mark certainly, and two possible answers are:

- a) I am not claiming to have thought up the "VisitEngland name", nor am I using the "VisitEngland" name. Visit-England.co.uk differs in that it has a hyphen in between the two words and ends in a .co.uk suffix. There is no mention of "VisitEngland" on my website.*
- b) The Complainant did not think up the Visit-England.co.uk domain name.*

Bullet point 18

First of all, the initial "Cease & Desist" letter is NOT dated 5th May 2008. The letter was sent five weeks later and is dated 12th June 2008 (see the Complainant's TAB 12). Another example of carelessness and lack of attention to detail by the Complainant and their representative, D. Bowden.

Secondly, I should point out that the Complainant's rebuttal letter dated the 27th June 2008 did not address any of the 32 points raised in my first reply (see the Complainant's TAB 12).

Also, further correspondence between the Complainant and myself took place between 1st, 8th and 23rd July. I am not sure why this was not mentioned by the Complainant. I have added these emails in [APPENDIX D]. It was clear that the Complainant was going to initiate a DRS case, though I am not sure why it took them a further 4 months to do so.

3.

3a:

Why would I think that the English Tourist Authority, that advertises under EnjoyEngland and does not use any hyphenated visit-england names, nor owns visit-

england.com, nor even uses visitengland.com or visitengland.co.uk (apart from forwarding purposes) would want to buy visit-england.co.uk?

I have not offered to rent or sell this domain to anyone since I became its owner. I even stated visit-england.co.uk was not for sale in my first correspondence with the Complainant. Perhaps that is why the Complainant has resorted to using a DRS case in order to try to obtain my domain name.

The Complainant appears not to have done any proper background research, apart from a quick Google search on my own name to find an unrelated website. Had the Complainant considered that I might own other similar domain names, they would have discovered that I own many domains in the form visitX.co.uk, where X is country or city. I bought them to develop – not for re-sale. Without giving you an exact figure, it is safe to say that I own over 100 such domains, and have done so since 2000, when my first ones were purchased. Since then I have bought further similar names that were unregistered, as well as buying them from other owners who wanted to sell theirs to me.

In cases where the visitX.co.uk name was no longer available, I obtained a suitable alternative domain. This would allow me to build travel portals over time for all the main countries and overseas cities that are likely to be of interest to travellers from the UK. Each travel site would have a unique destination-specific domain name. This is what happened in 2006 with visit-england.co.uk. It was transferred to me by the original owner who registered it in 1999. It was purchased by myself in good faith in May 2006 along with 7 other visitX.co.uk domains. Nominet Transfer forms regarding this mass transfer are included in [APPENDIX E].

Over time, the domains I own have slowly been developed into travel portals, featuring travel guides, hotels, flights, sights and other useful travel information and web links. I do not work on this fulltime, and progress depends on various matters. This is an ongoing project.

*Some examples of both developed and parked sites are:
visitmadrid.co.uk – DEVELOPED - (registered 23 April 2000 by myself)
visitberlin.co.uk – DEVELOPED - (registered 21 April 2000 by myself)
visitmorocco – DEVELOPED - (registered 28 July 2000 by myself)
visitchina.co.uk – PARKING - (registered 3 Feb 2000 by myself)
visitmuscat.co.uk – DEVELOPED (registered 2 May 2005 by myself)
visitvietnam.org.uk - DEVELOPED (registered 18 June 2005 by myself)*

The following names were all registered in 1999 by the same person who registered visit-england.co.uk in 1999. They were sold on to me in 2005 and 2006. Nominet have the relevant transfer forms.

*visitaustralia.co.uk - DEVELOPED
visitgreece.co.uk - DEVELOPED
visititaly.co.uk – DEVELOPED
visitindia.co.uk - PARKING
visit-ibiza.co.uk – PARKING
visitthailand.co.uk - DEVELOPED*

A further example of my interest in purchasing visitX.co.uk domains over time can be found in [APPENDIX F], regarding a Nominet mass transfer of such domains in 2005.

I own over 100 such domains. Some of these have been developed for several years, some for several months. See [APPENDIX G] for some examples of developed sites.

Others are being parked – including visit-england.co.uk. Similar parked pages include visit-india.co.uk and visit-ibiza.co.uk (See APPENDIX H). Content for parked domains is in different stages of development.

I should point out that while I prefer visitX.co.uk names, for certain destinations the domain was bought by someone else before I could get my hands on it, and they have either developed it or do not want to sell to me at a price I am happy to pay. In such cases, I have purchased similar alternative names involving the word VISIT and the CITY/COUNTRY, plus either a hyphen or a non-co.uk suffix, normally .org.uk, .org. or .net.

visitengland.co.uk was already taken, hence the reason for obtaining an alternative name. That explains why I obtained the domain visit-england.co.uk in the first place. It was not to resell or rent out but to use myself. In fact, rather than selling this or similar names, I am still buying such names on the rare occasions such quality names become available. As visitengland.co.uk is clearly not being used, I would certainly be interested in purchasing it if the Complainant decided to sell that name to cover some of their EnjoyEngland running costs, such as for their lawyer fees for example.

It is clear therefore that I have a legitimate reason for owning the domain visit-england.co.uk. Once developed, it will not be a “VisitEngland” portal however, but Visit-England.co.uk. There is a difference. The hyphen and co.uk suffix.

In case the Complainant is wondering why I have not already chosen to develop visit-england.co.uk, they will now appreciate that I own many domain names and these are being developed in a certain order. Parking the names with namedrive.com (who provide the content on the current page) provides me with statistical information. Using these statistics determines the order in which I develop domain names. Providing free statistical information in an easy-to-access way, plus a simple content page and contact form is why visit-england.co.uk and other domains are parked with NameDrive.com.

3b:

Visit-england.co.uk was registered on 6/12/1999. [See APPENDIX B again].

It was already owned by somebody else in 2003 when the Complainant apparently adopted their new brand identities.

3c:

If the hyphen can cause confusion, why don't VisitEngland make use of visit-england.fr and visit-england.nl? And what about visit-england.com and visit-england.de, which they don't even own? The hypothetical email scenario presented by the Complainant applies to these domains as well.

3d:

The domain is and has quite clearly been forwarding to a parking page with general travel links on it. It has never suggested that it was part of a UK Government backed

tourism website. All content links are provided by the parking company namedrive.com. The Complainant has provided a screenshot (TAB 12). There is no evidence to what D Bowden and the Complainant are stating here – and it seems to be a blatant and deliberate lie.

3e:

Any website could theoretically be used for phishing, cloning scams or illegal purposes. Mine is not. The suggestion that this might have occurred seems to be verging on slander, though I am no legal expert of course.

3f:

My name and address were and are correct in the WHOIS data. I did not act in bad faith. I prefer not to get spam mail. UKWebsiteMarketing.co.uk is a separate website, unrelated to my travel websites, but also owned by me. I am a self-employed individual.

3g:

The content at visit-england.co.uk is provided by a company called NameDrive.com, who provide parking pages for domain names in development (whatever stage that may be). It is possible to choose what sort of links and background you want. I have used a travel theme and travel links, as that is what the name will be eventually be used for. Other similar parked domains of mine include visit-india.co.uk, visit-ibiza.co.uk and many others (see APPENDIX H).

If someone wants to ask a question regarding the domain, they can use the ENQUIRE link. ENQUIRE does NOT have the same meaning as FOR SALE. If it did, a word in the English language would be redundant. The ENQUIRE link will take the user to page saying: "Contact the owner of visit-england.co.uk

If you are interested in a possible purchase of this domain or would like to contact the owner, please fill in the following information and submit your message:"

Sentence structure and syntax may not be the Complainant's strong point, but the OR is important in the above sentence. The visitor has two options. He can check if the domain is for sale, in which case I would say "No". OR he can ask a question. For example "Is this the official website of the England Tourist Authority?". Again, I would answer "No".

I also want to point out that the Complainant suggests that the ENQUIRE link takes you to www.namehire.com. The company is www.namedrive.com. Using an incorrect address namehire.com here by the Complainant is again either another piece of carelessness on their part or a deliberate attempt to mislead into thinking this domain is advertised for hire by myself. It is not.

4.

To counter the DRS examples provided by the Complainant (all of which are trademarked), here are some co.uk cases involving hyphens where no action was taken and the domain stayed with the original registrant.

DRS 00069 tel-box.co.uk

DRS 00192 apc-overnight.co.uk

DRS 00753 datingagency.co.uk and dating-agency.co.uk

DRS 06222 my-life.co.uk

The fact that the Complainant is focusing on cases involving hyphens suggests that he thinks all hyphenated names should belong to the owners of the non-hyphenated version.

For clarification, which of the following would the Complainant be happy for somebody else to own and use without initiating a DRS case?

*visit2england.co.uk
england-visit.co.uk
englandvisit.co.uk
visitenglandnow.co.uk*

RESPONDENT'S SUMMARY

The Complainant has NOT proven that they have Rights to generic domain names that contain the words VISIT and ENGLAND. They do not use visitengland.com or visitengland.co.uk, which simply re-direct to the actual website for English Tourism - EnjoyEngland.com. They do not own visit-england.com. They have no Rights to my visit-england.co.uk domain name. They set up VISITENGLAND LIMITED in July 2007. My domain was registered in December 1999. I have not infringed upon any trademarks. Visit-england.co.uk is generic and I have a legitimate reason for owning it.

This was NOT an abusive registration. It was obtained in order to develop in a similar fashion to other visitX.co.uk domain names that I have bought and developed on a continual basis since 2000. I have not offered to sell or rent this name to the Complainant or anyone else.

Due to the lack of evidence provided by the Complainant and the fact that the Complainant's representative is a trained lawyer and has written related papers such as "Tourism Domain Names – Protecting Your Investment" (David Bowden, Feb 2008), I believe this DRS case has been made in bad faith and that it is an attempt to obtain my domain via means of Reverse Domain Name Hijacking. On reading this case, some people might even think that the Complainant's representative has either not researched this case properly, hopes there will be no response or is simply wanting to charge his client for his "consultancy" time for as long as possible.

Web pages that support this dispute.

- <http://www.enjoyengland.com>
- <http://www.enjoyengland.co.uk>
- <http://www.visitengland.com>
- <http://www.visitengland.co.uk>
- <http://www.visit-england.co.uk>
- <http://www.visit-england.com>
- <http://www.visit-england.net>
- <http://www.visit-england.org>
- <http://www.visit-england.fr>
- <http://www.visit-england.nl>
- <http://www.visit-england.de>
- <http://www.visitmadrid.co.uk>
- <http://www.visitberlin.co.uk>
- <http://www.visitmorocco.co.uk>

- <http://www.visitchina.co.uk>
- <http://www.visitmuscat.co.uk>
- <http://www.visitvietnam.org.uk>
- <http://www.visitaustralia.co.uk>
- <http://www.visitgreece.co.uk>
- <http://www.visititaly.co.uk>
- <http://www.visit-india.co.uk>
- <http://www.visit-ibiza.co.uk>
- <http://www.visitthailand.co.uk>
- <http://www.lobbyandlaw.com/documents/DomainNamesWebFeb2008ART.pdf>

Complainant's Reply

The Complainant identified 16 substantive points in the Response. Its Reply set out each of these points and then went on to explain why it considered that this does not provide the Respondent a defence to the Complainant's claim, as follows:

1. *VisitEngland is not used to promote English Tourist Authority (sic) (1(c) & 2 bullet 7,8,16)*

Not true. Although www.visitengland.com was registered by another IPR infringer in October 1998, Complainant secured it in April 2003. It has used this site to promote its business now for over 5½ years.

www.visitengland.co.uk was registered by another IPR infringer (VisitMap Digital Limited) in October 1998. By 24th May 2005 Complainant had secured this name too. Complainant wants to ensure the record is accurate. Dates in this Reply are to prevail over those in Complaint in the event of any conflict. VisitEngland is used as a brand by Complainant to promote England as a holiday destination for overseas visitors. EnjoyEngland is used to promote England to those people who already live there. "VisitEngland" is now also the business name of the legal entity the English Tourist Board which was incorporated under the Development of Tourism Act 1969.

Respondent accepts that visitengland.com and visitengland.co.uk were registered in October 1998. In the light of this admission, quite why Respondent continues to resist Complainant's claim to visit-england.co.uk is beyond its comprehension.

Brand/Domain name appears prominently on Complainant's brochures (Bundle Tab 8) and promotional mugs. Presently Complainant's website addresses resolves to www.enjoyengland.com. See 4 below.

2. *VisitEngland not a trademark (1(c)(h))*

"VisitEngland" is Complainant's unregistered trademark. It is not a registered trademark with the UK Intellectual Property Office because, without evidence of distinctiveness or a secondary meaning, it would not satisfy the requirements of section 3 (1) (c) of Trade Marks Act 1994. Complainant can enjoin those who like Mr Lingstadt seek to pass themselves off as Complainant by free-riding on the back of Complainant's unregistered trademark. "VisitEngland" is also used in conjunction with Complainant's registered trademarks especially the Tudor Rose device (registered: November 1999) (see: Bundle Tab 2). Unregistered trademarks are "Rights" under 2(a)(i) of Nominet policy.

3. Brand Advertising (1(d) 2 bullet 9)

Figure of over £4 million for advertising the brand by Complainant in the year 2003-4 is correct. From further information supplied, corresponding figure for joint brand advertising of VisitEngland and EnjoyEngland in 2007-8 is also £4 million domestically within UK and further £1.986 million promoting solely VisitEngland internationally.

4. VisitEngland dates from June 2008 (1(e) (g)/2 bullets 4, 12, 13, 15 & 16)

Complainant reiterates points made in Complaint.

In April 2003 there was a re-structure/re-branding within Complainant. The 1969 Act set up both British Tourist Authority and English Tourist Board as separate statutory corporations. Activities of English Tourist Board were merged with those of British Tourist Authority in April 2003. "VisitBritain" was adopted as overall trading name. English Tourist Board ceased to trade and changed its remit to that of an advisory body called English Marketing Advisory Board.

Complainant also adopted at this time the names "VisitEngland" and "EnjoyEngland" as two new business names/trademarks for its domestic tourism activities. Presently "VisitEngland" is used by Complainant principally to attract foreign visitors to come and visit England. "Enjoy England" is used by Complainant principally to market England as a tourist destination in its own right to people who already live in UK. These two brands are however interlinked and form part of Complainant's overall business strategy. (See: Overview Bundle: Tab 7).

In 2008, English Marketing Advisory Board changed its name to VisitEngland. "Visit England" also remains the name of the England marketing division within "Visit Britain" "Visit England" has since April 2003 been used by Complainant as both a domain name and business name for England marketing activities.

Respondent has no rights in either name nor does any other free-rider in Respondent's position.

5. Relevant registration date? (2 bullet 14)

Earliest record Complainant can find for www.visit-england.co.uk on internet archive wayback machine <http://web.archive.org/web/20000407090810/http://www.visit-england.co.uk> is 7th April 2000. Name was initially registered by Firevision Limited.

Respondent has produced papers showing transfer of disputed domain name with others to him. Transfer is dated 28th May 2006. Respondent accepts he bought this domain name. Respondent has not stated how much he paid for it when he bought it from Graham Briggs.

Complainant refers Expert to the unanimous 3-person WIPO Panel decision in *bme.com* (Case No. D2008-0882 21st August 2008). Complainant invites Expert to reach same conclusion under Nominet policy as the WIPO panel reached under UDRP. WIPO panel held: "The ordinary rule on registration is that transfer to a new registrant constitutes "registration" for purposes of paragraph 4(a)(iii)'s determination of bad faith. Indeed it is a Consensus View that "While the transfer of a domain name to a third party does amount to a new registration, a mere renewal of a domain name does not amount to registration for the purposes of determining bad faith."

The date Expert has to use therefore in assessing Respondent's bad faith under 3(a)(i) of the Nominet Policy is 28th May 2006 and not any earlier date. In May 2006, Complainant had been the registered owner of visitengland.com for 3 years and of visitengland.co.uk for 1 year. As the National Tourist Board for England it was well-known as VisitEngland.

At time of May 2006 transfer, it is inconceivable that Respondent did not know of Complainant's existence and prior use over the preceding 3 years of www.visitengland.com. Respondent is a classic free-rider. Complainant refers Expert to unanimous 3-person Nominet panel decision in www.verbatim.co.uk (DRS 04331 31st July 2007) – especially paragraph 8.13 on issue of knowledge/intent under paragraph 3 of Policy.

6. Reverse Domain Name Hijacking (1(e)(g) 2 bullet 4,16 and Respondent's Summary)

This is nonsense. Complainant has legitimate claim to the disputed domain name. Respondent has no legitimate claim to it. Respondent's business name is "UK Website Marketing" – not VisitEngland.

7. Visit England Limited (1(g) 2 bullet 14)

This company was incorporated on 24th July 2007 as a protective measure by Complainant to protect its IPR in VisitEngland brand. VisitEngland is a business name of English Tourist Board – a body corporate incorporated under the Development of Tourism Act 1969 (see 4 above).

8. Hyphen: Sufficient differentiator

Other's domain names in other territories (1(h) 2 bullet 4, 12)

Complainant has rights in VisitEngland name. Complainant is entitled to variants of domain names with a hyphen. A hyphen is not a sufficient differentiator. This has been the subject of repeated rulings in the DRS – see Expert's decision in www.enjoy-england.co.uk (DRS 4250/4251, 29th March 2007).

Respondent states that visit-england.fr, visit-england.nl and visit-england.de are registered by others. This is irrelevant. Complainant has zero-tolerance policy of IPR infringement. To protect confidentiality of other matters, Complainant is unable to comment of progress of other actions against other IPR infringers.

9. No overlap in Parties' activities (2 bullet 4)

This is irrelevant. Under Nominet Policy Complainant has to prove it has rights in the name, that Respondent does not and that the use is abusive.

10. Prior domain name registrations confer no benefits (2 bullet 14)

Respondent claims Complainant's prior registrations of visitengland.com and visitengland.co.uk do not confer any rights to similar domain names. This is not true. Only those who have legitimate rights in a name can register and use the corresponding domain name. Respondent in his own right and/or as UK Website Marketing has no such rights.

11. Respondent's Credibility (Respondent's Bundle – pages 23-31)

Respondent annexes correspondence. Respondent's letter dated 28th May 2006 to Nominet states: "I am a private individual, and the new registrant details in my name for the 8 domain names above are...". Respondent has signed this letter. This declaration is false. Expert is referred also to 3(f) of Complaint. Respondent has since 2003 run a business called "UK Website Marketing" (www.ukwebsitemarketing.co.uk). Annexed to this Reply at Tab 13 its website pages from 27th July 2003. When Respondent signed letter in May 2006, he had been in business for at least 3 years and was no longer a UK private individual.

12. Cease and Desist correspondence (2 bullet 18)

Complainant accepts the letters and emails referred to by Respondent were sent or received. No voluntary transfer was forthcoming. Complainant declines to enter into unproductive correspondence with IPR infringers.

13. Respondent not offering to sell Domain name (3(a))

This is not true. Respondent bought the domain name in May 2006 but he has not said for how much. The domain name is still clearly for sale now. Printouts to this effect are at Bundle Tab 12. This activity falls all four square within the "selling" part of the abusive section (3a i A) of Nominet's policy. Complainant accepts the click through link is to www.namedrive.com (not namehire.com).

Whether Respondent has legitimate rights to other domain names remains unclear. It provides no defence to this claim.

14. Respondent's admission: Prior knowledge of Complainant's existence (Response: 3(a))

Respondent states: "visitengland.co.uk was already taken, hence the reason for obtaining an alternative name." Respondent therefore accepts/admits he was aware of Complainant's existence and prior superior rights at the time he bought the domain name in May 2006 – but went ahead regardless. This is fatal to Respondent's defence. See also 5.

15. Respondents' offering is genuine (Response: 3(a) (d) (g))

Respondent's website appears to consist of nothing more than a home page with click-through advertising.

Although website is www.visit-england.co.uk – it presently features prominently on the home page adverts for holidays to Egypt!

Home page appears to offer search facility. For "Alton Towers", responses included links to hotels in Aberystwyth and an accident claims-line. Similar search for "Windsor Castle" brings up adverts for office refurbishment company, Slough locksmiths and undertakers! Link bars on Respondents' website are equally poor. "Cumbria Cottage" bar brings up adverts for cottages in Devon & Dorset and Complainant's main EnjoyEngland portal! Respondent's website consists of nothing more than links to other sites or pay-per-click advertisements. It has no original content.

Electronic Commerce (EC Directive) Regulations 2002 (2002 SI/2013) have been entirely ignored by Respondent. Regulation 6 has not been complied with.

Respondent's website does not contain his name(s), geographic address or email address.

In short, neither now nor at any time in the past has there been any genuine offering by Respondent.

16. Hyphen cases (Response: 4)

*See also 5 & 8 above. Respondent's 4 cited cases are all decisions of single expert. Complainant refers Expert to decision of 3-person WIPO panel in www.discover-tasmania.com.au (DAU2003-0001, 16th April 2003) (referred to by Expert in *EnjoyEngland* (DRS 4250/4251)). A 3-person Panel decision is more persuasive than any others that registering a version of a domain name incorporating another's brand name but with the sole addition of a hyphen constitutes abusive domain name registration.*

tel-box.co.uk can be distinguished as it involved dispute between 2 people who used to work together who subsequently fell out. apc-overnight.co.uk was made because insufficient evidence of prior rights was submitted. datingagency.co.uk has to be distinguished as decision on its own unusual facts. my-life.co.uk refers to Verbatim (see 5 above).

*Complainant refers Expert to DRS05890 (waltdisney.co.uk). Expert (page 3 final paragraph) says: "The expert in the *HQUK Ltd v. Headquarters* DRS Number 01405 determined that the addition of any punctuation marks to a domain name is not sufficient in itself to render the domain name distinctive."*

*Finally Complainant refers Expert to DRS6184 (takeoverpanel.org.uk). Expert (page 6, 2nd paragraph) says: "There is no obvious justification for the Respondent's registration of the Domain Name and the Respondent has failed to come forward with an explanation for having selected the Domain Names. Under such circumstances, as the Complainant points out, it will ordinarily be reasonable for an expert to infer that a respondent registered a domain name for a purpose that was abusive, see *Chaivas Brothers Limited v. David William Plenderleith* (DRS292). Based on the record before it the Expert so finds.*

6. Discussions and Findings

It can be seen that both parties have gone about their task with an abundance of enthusiasm. Unfortunately many of the points argued between the parties have strayed into the area of irrelevance. The Respondent sought to introduce further non-standard submissions in reply to the Complainant's Reply. I decided that I did not require sight of those non-standard submissions. The last thing this case needs is another round of submissions by the parties.

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, i.e. that:

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

These terms are defined in the Nominet UK DRS 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;
- **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.

It is worth emphasising that the two issues of whether or not the Complainant has Rights, and whether or not the Domain Name is abusive are separate matters. The parties have, on occasions, tended to mix the two issues in their exchange of arguments on the points and the evidence relied upon.

Before I turn to the question of Rights, I will address a couple of points of principle that have engaged the parties in their submissions.

The first is the relevance of the initial date of registration of the Domain Name and the date it was purchased by the Respondent. The question is whether the Domain Name is, in the hands of this particular Respondent, an Abusive Registration. Therefore, the date of initial registration by a third party is not relevant. It is the date of its subsequent acquisition by this Respondent and what this Respondent has subsequently done with it that must be taken into account. It follows that the reference to "*registered or otherwise acquired*" in the first limb of the definition of Abusive Registration is a reference to the initial registration by the Respondent if originally registered by him or, if not, its subsequent acquisition by transfer to the Respondent. I should add that renewals of an existing domain name registration are not to be treated as a new and separate registration or acquisition of the domain name.

The second issue is whether or not having a hyphen between "visit" and "england" in the Domain Name makes any, or any material difference. My view is that it does not, and it should be treated in all respects as being identical to each of "Visit England", "VisitEngland", "visit England" and "visitEngland". The same applies to the addition of the .co.uk suffix which should also be ignored when considering whether or not the Domain Name is identical or similar to a name or mark in which the Complainant has Rights.

Therefore, in my view, the Domain Name visit-england.co.uk is identical (and in any event clearly similar) to any of "VisitEngland", "Visit England", "visit England" or "visitEngland". But first, the Complainant must prove that it has Rights in that term as a name or mark.

Complainant's Rights

The Complainant has put forward in evidence a list of its registered trade marks but none of them have any relevance to this matter as none of them include the words "Visit England" in any form.

However, "Rights" for the purpose of the Nominet DRS can include unregistered rights in a name or mark. That is what the Complainant must rely on if it is to pass the first hurdle of proving, on the balance of probabilities, that it has Rights enforceable by the Complainant, whether under English law or otherwise, in respect of a name or mark which is identical or similar to the Domain Name.

Proving the existence of such Rights for the purposes of the Nominet DRS is generally considered to be a fairly low threshold, but in this case the Complainant has an obvious problem to overcome. The words "visit England" start out life as being completely descriptive of a business or agency involved in promoting or providing services relating to tourism in England. However, that is not the end of the case for the Complainant as it is made clear by the definition of "Rights", that a complainant is able to rely on rights in descriptive terms which have acquired a secondary meaning.

Therefore, the first issue to consider is whether or not the Complainant has proved, on the balance of probabilities, that the words "visit England" have, as a result of its use of that term, acquired a secondary meaning so that it is no longer a generically descriptive term but has now become distinctive as a brand name of the Complainant. As a general rule, the more descriptive and widely used the term to start with, the harder it is for any one entity to show that it has become distinctive of them. In my view, in relation to use of the words "visit England", the Complainant starts out with a very stiff challenge to overcome.

It is worth noting here that one of the several previous DRS decisions relied on by the Complainant was its own complaint in relation to the domain names "enjoy-england.co.uk" and "enjoy-england.org.uk". In that joint case in March 2007 (DRS 04250 and 04251) the Expert found in favour of the Complainant and ordered that the domain names be transferred to the Complainant.

It can be seen from the published decision that the points put forward by the Complainant in its complaint in that case bear a striking similarity to the points put forward in this case.

The Expert in the previous case had to decide, on the evidence before him, whether or not "Enjoy England" is "*wholly descriptive of the Complainant's business*"? The Expert said in his decision:

"The Expert has mulled over this question at considerable length. The Expert has been minded at stages to go one way, then the other. It is an issue over which reasonable people can be expected to disagree.

.....

It appears to the Expert that the words "enjoy England" encapsulate the objectives of the Complainant, very pithily. No doubt that is why they were adopted by the Complainant in the first place, but doubtless also in inadvertent ignorance of the potential difficulty it might pose for deciding on application of the Nominet DRS.

This is a case where the decision on the applicability of the claimed rights has been finely balanced throughout the Expert's deliberations.

However, ultimately, the Expert has come to the view that, whilst they may be an apt encapsulation of the desired end result for the Complainant - that visitors and holidaymakers should "enjoy England", the words are nonetheless just far enough away from being "wholly descriptive of the Complainant's business" that the proviso in the definition of "Rights" under the Policy, being an exclusion of Rights, which should be interpreted narrowly, is not applicable in this case."

When the previous "enjoy England" complaint was made, the Expert was dealing with an earlier form of the DRS policy and procedure which had a slightly different definition of "Rights" i.e.

"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".

The previous definition expressly excluded reliance on names or terms that were "wholly descriptive" whereas the current definition is phrased in an inclusive manner, so that a complainant may rely on rights in descriptive terms if they have acquired a secondary meaning.

I think the change of definition has, if anything, raised the hurdle for a complainant a little higher. Under the old definition, if a complainant could prove that a term, whilst being descriptive to some extent, was not "wholly" descriptive, the proviso fell away and he could rely on his enforceable rights in such a descriptive term. However, under the current definition, a complainant must go on to prove that such a descriptive term has actually acquired a secondary meaning.

Even so, the Expert in the previous enjoy-england case also commented, with some foresight, as follows:

"According to Section 2(1) of the Development of Tourism Act 1969 (as cited by the Complainant), under which the British Tourist Authority was established:

- "2.-(1) It shall be the function of the British Tourist Authority –*
- (a) to encourage people to visit Great Britain and people living in Great Britain to take their holidays there; and*
 - (b) to encourage the provision and improvement of tourist amenities and facilities in Great Britain;*
- and the English Tourist Board, the Scottish Tourist Board and the Wales Tourist Board shall have like functions as respects England, Scotland and Wales respectively."*

*By these very words, it would seem clear that, for example, the name "VisitBritain" could reasonably be considered "wholly descriptive of the Complainant's business", and were this dispute to be over visit-britain.co.uk (which is evidently not presently owned or operated by the Complainant, but who does own and use visitbritain.co.uk), then the proviso in the definition of "Rights" under the Policy might indeed be applicable. **The same might also be the case for (say) "Visit England" or "Tour England" or "Holiday in England"***

(emphasis added).

The evidence put forward by the Complainant to show that the term "visit England" has acquired a secondary meaning distinctive of the Complainant comprises the following:

"It has traded and provided services under the name "VisitEngland" since April 2003: It exhibits examples of the use made in the form of

- **marketing and advertising materials (Tabs 3-8 of the bundle); and**
- **letterheads (Tab 9 of the bundle)."**

Tabs 3,4 and 5 are copies of its French, German and Dutch language versions of its brochure. The bottom right corner of both the front and back pages carry the "visit**England**" name alongside the Complainant's Tudor rose logo which has the "TM" claim next to it. The front and back pages also carry "visitEngland.fr", "visitEngland.de" or "visitEngland.nl" respectively. The same domain names are displayed at the bottom of most of the internal pages of the brochure.

Tab 6 is a smaller Dutch brochure called "England Rocks!" which carries the Tudor rose logo with "visit**England**.nl" underneath, which is followed by the "TM" sign.

Tab 7 is an English language booklet used since 2008 entitled "*Introducing VisitEngland / Growing England's visitor economy*". The front and back pages carry the "Visit**England**" name next to the Tudor rose logo, the logo being followed by "TM". Both front and back pages also carry "visit**Britain**" followed by the TM sign and a reference to "visitbritain.com/corporate". The booklet's contents start by saying "Welcome to **VisitEngland**" and the "VisitEngland" name is used several other times. However, the booklet also refers to "VisitBritain", "Partners for England", "visitbritain.com/visitengland", "Enjoy England", "England Rocks!", "tasteEngland", "CityCulture", "Outdoor England", "enjoyengland.com", "English Tourism", "meet**England**.com"; "enjoy**England**", "PartnersFor**England**" alongside the Tudor rose logo, and "partnersforengland.com".

Tab 8 is the artwork for covers of two "ideasbooks". I am told that they were both produced in September 2004. Both have "visitengland.com" in the bottom right hand corner followed by a very small and very faint "TM". In much larger font on each front cover is "enjoy**England**" and "ideas**book**" each followed by a reasonably prominent "TM" claim.

Tab 9 is the artwork for a promotional mug produced in April 2004. It carries "visitengland.com" followed by "TM" at one end and "enjoy**England**" followed by "TM" at the other end.

Tab 9 also has samples of two letterheads that have been used since April 2008. One uses, in the top right hand corner, a prominent Tudor rose logo with "VisitEngland" followed by "TM" underneath the rose logo. The footer consists of the following:

"visitbritain.com/visitengland

VisitEngland - Incorporated under the Development of Tourism Act 1969 as English Tourist Board"

The other letterhead has a heading of "visit**Britain**" followed by "TM", the words being wrapped around a smaller version of the Tudor rose logo. The footer for this notepaper states:

However, I have not been told how many of each of the brochures, booklets, "ideasbooks", promotional mugs or letterheads were published and distributed so it is not easy to attach any particular weight to their existence when deciding whether the Complainant has proved that it has rights in "visit England" that are extensive enough to have acquired a secondary meaning. The existence of these items might be sufficient to give the Complainant some limited passing off rights in its particular style of use of the words "visit England", possibly even without the addition of the Tudor rose logo. However, when attempting to establish that a descriptive term has acquired a secondary meaning through use, establishing the extent and period of use, and its reputation amongst users and potential users, is of fundamental importance.

In relation to the extent of use the Complainant says that:

"It has advertised using the name "VisitEngland" since April 2003. It spent £4,046,375.00 in the financial year 2003-2004 on such advertisements"

The Respondent challenged this figure in his Response saying:

"A proper breakdown is required to see how much was spent on material that used the visitengland.com or visitengland.co.uk domains. The next question is why has the Complainant not provided a more recent figure..."

In the Complainant's Reply, in response to this challenge, it states:

"Figure of over £4 million for advertising the brand by Complainant in the year 2003-4 is correct"

However, the Complainant in its Reply also stated:

"From further information supplied, corresponding figure for joint brand advertising of VisitEngland and EnjoyEngland in 2007-8 is also £4 million domestically within UK and further £1.986 million promoting solely VisitEngland internationally."

The figures put forward by the Complainant are reasonably significant sums and would go some way to establishing a reasonably significant extent of use. However, in the previous DRS case involving the domain names "enjoy-england.co.uk" and "enjoy-england.org.uk" in March 2007 (DRS 04250 and 04251) I note from the published decision that in that case the Complainant contended that:

"It has advertised using the name "EnjoyEngland" since April 2003. It spent £4,046,375.00 in the financial year 2003-2004 on such advertisements"

This is word for word and to the penny identical to the claim now made for the figure spent promoting "VisitEngland". It seems the Complainant is indulging in an exercise of double counting its expenditure.

I have not been provided with a detailed and proper breakdown of what the money claimed by the Complainant was actually spent on, and, in the circumstances, I treat the figures put forward by the Complainant with a reasonable degree of caution.

"It is the registrant for the domain name www.visitengland.co.uk which was acquired by the Complainant on 24th May 2005. It is also the registrant for the domain name www.visitengland.com which it acquired in April 2003 and it has used this site to promote its business now for over 5½ years."

However, these two domain names, visitengland.com and visitengland.co.uk, are not actually used for separate websites. They both automatically redirect to the Complainant's website at www.enjoyengland.com where the visitor is met on the front page with the name "enjoy**England**" followed by the Tudor rose logo and the strap line "the official website for breaks and days out in England". I cannot see any use at all of "Visit England" in any shape or form on the front page of the website.

I therefore do not attach much weight to the fact that these domain names are held by the Complainant.

It is the owner of all the share capital in the shell company VisitEngland Limited. This company registration number: 06322637 is registered at Companies House Cardiff. It was incorporated on 24th July 2007.

The fact that there is a company with the VisitEngland name does not assist the Complainant to prove an acquired secondary meaning if the company is merely a "shell company".

The Complainant has micro-sites for these territories whose website addresses are www.visitengland.fr, www.visitengland.de and www.visitengland.nl respectively. The home page screen dumps for these micro sites along with that for www.enjoyengland.com are at Tab 11 of the bundle. These micro site domain names were registered on 31st March 2005, 18th November 2005 and 17th December 2004 respectively. The web address www.visitengland.com typed into a web browser defaults automatically to the portal www.enjoyengland.com.

The Respondent in his submissions has questioned the relevance where the use relied on by the Complainant is not use within the UK. However, for the purposes of Nominet's DRS, Rights in a name or mark acquired through use outside the UK still count just as much as use within the UK. So the existence of these websites does give the Complainant something.

However, I note from the Complainant's exhibit of screen shots of these websites at Tab 11 that the websites all bear, rather than the name "visit England", the name "enjoy**England**" alongside the Tudor rose logo followed by the "TM" sign and the strap line "Welcome to the official website of English tourism" in each local language. In addition, I have not been given information about the extent of visitor traffic to or promotion of these websites which makes it difficult to attach much weight to them when assessing whether or not the descriptive term "visit England" has acquired a secondary meaning distinctive of the Complainant.

In summary, I believe that, having chosen to adopt as one of its trading names what starts out life as the entirely descriptive and very commonly used term "visit England", the Complainant has given itself a very difficult task to establish sufficient

Rights to complain successfully about similar domain names under the Nominet DRS.

The use it has made of the descriptive term "Visit England" as a name or mark since 2003, and in particular since 2008, might be sufficient to give some limited passing off rights in the particular font and style of use to enable it to complain of any third party use in the same font and style. However, in order to rely on such rights in a descriptive term under the DRS, the Complainant must go much further and prove that the term has actually acquired a secondary meaning distinctive of the Complainant so that effectively it is in a position to complain about third party use in any form or style. When the term in question begins life as being completely descriptive, that is a very difficult hurdle to overcome.

I do not think the Complainant is assisted in that task when the use it has made of "Visit England" as a name or mark is often used alongside a plethora of other names such as "Visit Britain" "Enjoy England", "Meet England", and "Partners For England".

In addition, I note the Respondent's references to other "visit England" domain names, namely visit-england.fr, visit-england.nl and visit-england.de, each held by third parties and at least one of which is being used to resolve to an active tourism related website that has nothing to do with the Complainant.

In the circumstances, I do not believe that the evidence of use relied on by the Complainant even comes close to establishing a secondary meaning in the descriptive term "visit England".

One of the points made by the Complainant in its Reply is a very telling one in this respect. In reply to the Respondent's point that "Visit England" was not a registered trade mark the Complainant said:

"It is not a registered trademark with the UK Intellectual Property Office because, without evidence of distinctiveness or a secondary meaning, it would not satisfy the requirements of section 3 (1) (c) of Trade Marks Act 1994."

Whilst the Complainant claimed it as its unregistered trade mark with rights to take action against those guilty of passing off, this seems to be tantamount to an acceptance by the Complainant that any such rights that it may have are not sufficient for the term to have acquired a secondary meaning distinctive of the Complainant.

In the circumstances, I find that the Complainant has failed to prove, on the balance of probabilities, that it has Rights in the descriptive term "Visit England" sufficient for the term to have acquired a secondary meaning.

Having found that the Complainant effectively fails at the first hurdle, it is unnecessary for me to go on to consider whether the Domain Name was acquired by the Respondent in a manner which, at the time when his acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights or that it has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Having said that, if I had found that the Complainant had proved it had Rights for the purposes of the DRS, I would still not have found in its favour. I will briefly explain why, with reference to the points relied on by the Complainant in its Complaint in

support of its claim that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Those points were as follows:

a. "it was primarily registered for the purposes of selling, renting or otherwise transferring it to [the Complainant] or [its] competitor for a price greater than his costs. On the home page for www.visit-england.co.uk which the Respondent has produced in the top right hand corner is a link saying: "Enquire about this domain". This link takes you to www.namehire.com where an on-line form can be completed to contact the owner to enquire about the purchase of this domain name. It is clear from this that the name was registered by the Respondent just for re-sale at a profit."

This relies on paragraph 3 a i A of the DRS Policy, being one of the non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration.

The Respondent has countered this by explaining that he acquired the Domain Name in 2006 as part of a bundle of similar domain names to become part of his portfolio of domain names comprising the word "visit" followed by a country or place name. He explained that he parks these domain names to then monitor traffic and then decides which of them merit further development and in what order. On its face, that is a perfectly plausible and acceptable explanation.

The Respondent also points out that he has never offered the Domain Name for sale to anyone. He says that the "Enquiry" function on the third party parking page is stated to be for the dual purpose of either enquiring about a possible purchase or simply to contact the owner, and that he informed the Complainant that it was not for sale in their pre-DRS complaint exchange of correspondence.

On the evidence before me, the Complainant has failed to prove, on the balance of probabilities that the Domain Name was primarily acquired by the Respondent for the purposes of selling, renting or otherwise transferring it to the Complainant or its competitor for a price greater than his documented out-of-pocket costs directly associated with acquiring or using the Domain Name.

b. "it was primarily registered to stop [the Complainant] registering it despite [its] rights in the name"

This allegation relies on paragraph 3 a i B of the DRS Policy. However, the allegation relating to the purpose of the initial registration of the Domain Name does not get off the ground as the Respondent has demonstrated that, in fact, it was initially registered in 1999, long before the Complainant starting using the "visit England" term as a name or mark.

In addition, the Complainant has failed to prove, on the balance of probabilities that the Respondent's subsequent acquisition of the Domain Name in 2006 was primarily for this purpose in the face of the Respondent's very plausible explanation of why he did acquire it and the circumstances of its acquisition.

c. "it was primarily registered to unfairly disrupt [the Complainant's] business because the hyphen in the domain name used by the Respondent has the great potential to cause confusion and its use by the Respondent is not innocuous."

This allegation relies on paragraph 3 a ii of the DRS Policy. There appears to be no support whatsoever in the evidence for this allegation, and certainly no evidence to prove it on the balance of probabilities.

e. "it could be used by the Respondent (if it has not been so used already) for phishing and cloning scams whereby the Complainant's identity was impersonated and members of the public were duped into believing they were dealing with a UK Government Non Ministerial Public Body rather the Respondent who seeks to trade off the Complainant's goodwill."

This is simply a wild allegation unsupported by any evidence whatsoever.

f. "it was registered with incorrect name and address details, because the Respondent acted in bad faith and the initial registration he had with Nominet UK was that for a private individual and his address details were hidden from the "Whois" database. It is clear that the Respondent is running a business called "UK Website Marketing" (www.ukwebsitemarketing.co.uk) and has done so since 2003. This is a search engine optimization company."

This allegation relies on paragraph 3 a iv of the DRS Policy i.e. *"It is independently verified that the Respondent has given false contact details to [Nominet]"*. However, the Complainant's allegation seems to be, not that the Respondent gave a false name or a false address/contact details but that he claimed to be a private individual. The Respondent, has countered by saying that whilst he may run a website marketing business, his holding of a portfolio of "visit+name" domain names is in his capacity as a self-employed individual. This seems to be something of an irrelevant sideshow skirmish between the parties as in any event it does not appear that the actual contact details the Respondent gave to Nominet were incorrect because there is nothing to indicate that Nominet had any problem in contacting the Respondent using those contact details.

7. Decision

For the reasons outlined above I find that the Complainant has not proved, on the balance of probabilities, that it has Rights in respect of the name "visit England", being 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 not an Abusive Registration.

In the circumstances I order that no action be taken in respect of the Domain Name.

Signed

Chris Tulley ✓

Dated 26 February 2009