

NOMINET DISPUTE RESOLUTION SERVICE

DRS 07066

Decision of Independent Expert

**Whistle Blowers Press Agency Limited and Commercial and Legal
Services (UK) Ltd**

and

Ketts News Service Limited

1. Parties:

Complainant: Whistle Blowers Press Agency Limited
(lead complainant)

Address: 6 Wivenhoe Business Centre
Brook Street
Colchester
Essex

Postcode: CO1 9EU

Country: UK

Complainants: Commercial and Legal Services (UK) Ltd

Address: Commerce House, 9 Temple Court
Colchester
Essex

Postcode: CO4 0PR

Country: UK

Respondent: Ketts News Service Limited

Address: 1st Floor Grosvenor House
Prince of Wales Road
Norwich

Postcode: NR1 1NS

Country: UK

2. Domain Name:

www.whistleblower.co.uk

3. Procedural Background:

The Complaint was entered into the Nominet system on 30 March 2009 and thereafter validated. On 6 April 2009 Nominet wrote to the Respondent advising it that the Complainant had invoked Nominet's Dispute Resolution Service to complain about its registration of www.whistleblower.co.uk and that it had until 29 April 2009 to respond. The Respondent served a Response on 29 April 2009 and the Complainants served a Reply dated 7 May 2009. The case was not resolved at the mediation stage and the fee to obtain an independent Expert's decision under Nominet's Dispute Resolution Service Policy (the 'Policy') was paid to Nominet on 18 June 2009. Jon Lang was appointed as

the independent Expert on 30 June 2009. The Expert confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances that might call into question his independence in the eyes of the parties.

The Complainants' representative has requested that Whistle Blowers Press Agency Limited be the 'lead complainant' to whom the disputed domain name (hereafter www.whistleblower.co.uk or the Domain Name) should be transferred in the event that an order for transfer is made. The Whistle Blowers Press Agency Limited will be referred to hereafter as the Complainant, Commercial and Legal Services (UK) Ltd as CLS and together as the Complainants.

4. Outstanding Formal/Procedural Issues

There are no outstanding formal or procedural issues other than one small matter in relation to the Complaint. On 12 May 2009, Nominet received notification from the Complainant that there was a mistake in their Complaint, namely "...that at paragraph 4 of our statement of grounds it is stated that the domain name www.whistleblowers.co.uk was acquired by 'CLS on 19th February 2008'. This should read '19th February 2009'. Please inform the respondent accordingly and amend the complaint at paragraph 4."

The Complaint has not been amended but the Expert has noted the correct date.

5. The Facts

The Complainant is a UK based company (incorporated on 27 February 1997) providing news and media services. It has provided such services to the public 'since at least as early as 13 March 2007'. Its www.whistleblowers.uk.com website was first made accessible to the general public on 13 March 2007 (the date on which the domain name www.whistleblowers.uk.com was registered to it) via a "site under construction" web page containing contact details for the Complainant.

The Complainant is the proprietor of UK trade mark No. 2127339 for WHISTLE BLOWER in Classes 35 and 42 (filed on 21 March 1997 and granted registration on 31 October 1997) and trade mark No. 2497247 for WHISTLE BLOWER in Class 41 (filed on 10 September 2008 and granted registration on 9 January 2009).

It is also the proprietor of www.whistleblowers.uk.com registered on 13 March 2007.

CLS is a UK Company providing investigative media research and journalism services and has been trading since as early as 1989. CLS has been granted a licence to use the trade mark WHISTLE BLOWER which it has done in connection with the above services since at least as early as 2005.

CLS is the proprietor of www.whistleblowers.co.uk having been acquired by it on 19th February 2009.

The Respondent's business was founded in 1993 as an independent press agency. The business was incorporated in September 2003. In February 2004 it set up a website called 'cash4yourstory' which enabled members of the public to supply their true stories to the media. The Respondent subsequently came up with the idea of further expanding its web presence and established the website at www.whistleblower.co.uk which it acquired from a company called Ctrl-Alt-Del IT Ltd on 20 January 2008.

6. The Parties' Contentions

Many issues have been aired in the Complaint, Response and Reply (and annexures). Some of these issues are less significant than others. For instance, the Expert does not think the issue of whether the Respondent should or should not register with the Information Commissioner particularly relevant in proceedings under the Policy. Accordingly, only the more significant issues are dealt with below.

The Complainants

- The website at www.whistleblower.co.uk includes a copyright notice dated 2008 and accordingly it is contended that the first use of the term WHISTLE BLOWER or whistleblower.co.uk by the Respondent was made at the earliest in January 2008. In any event the Complainant is unaware of any evidence of use by the Respondent pre-dating the Complainant's trade mark (which it has used in connection with its business prior to the 13 March 2007, the date the Complainant's own domain name, whistleblowers.uk.com was registered to it).
- The Complainant's position is that it is the proprietor of rights enforceable under English Law in the term WHISTLE BLOWER and/or WHISTLE BLOWERS from a date prior to the registration of the Domain Name, and from at least as early as 1997 when the Complainant was incorporated and the trade mark granted.
- The Trade Mark WHISTLE BLOWER, the Company Name Whistle Blowers Press Agency Limited and the Domain Name (whistleblowers.uk.com) are at least similar if not identical to the Domain Name. The Complainant therefore contends that the Domain Name is an abusive registration from and including the date of its registration in that the Domain Name takes unfair advantage of and is detrimental to its rights.
- The Complainants have attached to their Complaint, amongst other documents, a copy of Section 10 of the UK Trade Marks Act 1994, and the Complaint sets out the effect of that provision. It is contended, inter alia, that the services provided by the Respondent are identical to the services provided by and protected by the Complainant's trade mark, and trade mark infringement is alleged.
- The Complainants also attach printouts from Chapter 15 of Kerly's Law of Trade Marks and Trade Names 14th Edition, which summarises the common law action of 'passing off'. The Complainants allege that the requirements of a passing off action have been satisfied and refer to a witness statement of a Mr Bryan McFarlane (a contributor to the website of the Complainant) and who passed on details of the Complainant's website and services to his colleagues. Some of his colleagues subsequently accessed the Respondent's website in error and the Complainant contends that that was as a direct consequence of the confusion caused by the similarity of the Complainant's and Respondent's domain names.
- The Complainants also contend that the registration of the Domain Name is actively blocking and disrupting its business interests, future operation and the provision of services by it.
- The Complainant contends that it has taken prompt action to address the abusive registration and use, in that on 23 January 2009 a cease and desist letter was sent to the Respondent which it is said produced an unsatisfactory response, (hence these proceedings).

- In view of the Complainant's company name, domain name, trade mark and common law rights in the mark WHISTLE BLOWER, it contends that it is highly unlikely that the Respondent, contrary to what it has said, had no knowledge of the business activities of the Complainant and of its use of the term WHISTLE BLOWER.
- The Complainant contends (in answer to a point raised by the Respondent) that the fact that Companies House records it as "dormant" is an absolute irrelevance. The Complainant is not dormant and it states that a company can submit accounts to Companies House up to 28 months after commencement of trading.
- The Complainant refers to its licence to CLS and contends that 'Whistle Blowers' has been a trading name of CLS (who have been supplying the media with stories since 1991, two years before the Respondent was incorporated).
- The Complainants say that the Respondent's investigations fall below the standard reasonably required to clear a mark for use as a 'badge of origin' for the supply of goods or the provision of services. A check of the UK Trade Marks Register for the term WHISTLE BLOWER should have been made; that the use by the Respondent on its website of WHISTLE BLOWER is trade mark use and that WHISTLE BLOWER is not a generic term in respect of the services being provided.

In summary, the Complainants contend that the Domain Name should be transferred.

The Respondent

- The first knowledge the Respondent had of the Complainant was on receipt of its solicitors' letter of 23rd January 2009, to which it replied and heard nothing further until being advised, by Nominet, of the Complaint.
- The Respondent acquired the Domain Name for the purposes of setting up a website called whistleblower.co.uk. The idea for the website was conceived after several whistleblowers (members of the public wishing to expose wrong doing) began contacting the Respondent's cash4yourstory.co.uk website. The plan was to target whistleblowers via a generically named website. The whistleblower.co.uk website as it exists now went live on 8 February 2008.
- The Respondent has no wish to sell or rent the Domain Name; it is for its own use. In setting up its website, it was obvious to the Respondent that it should incorporate the name whistleblower, since 'whistleblowers' was the group of people it was targeted at. It investigated whether there was such a website operating in a similar way but found no evidence that there was. The Respondent carried out various search engine checks on the terms 'whistleblower', whistleblower', 'whistleblowers', 'whistle-blowers', 'whistleblowing', 'whistle-blowing', 'whistleblow' and 'whistle-blow', 'blowthewhistle', 'blow-the-whistle' among others. At no point did www.whistleblowers.uk.com appear on any of these search term results. The Respondent was unaware of anyone else having a similar idea. It had no prior knowledge of the Complainant's plans.
- The whistleblower.co.uk website went live on 8th February 2008, thus the Domain Name was being used for nearly a year to make a genuine offer of goods and services before the Respondent became aware of any complaint.
- The Complainant is listed as a 'dormant' or 'non-trading company' by Companies House, and has had no income since its inception.

- Around the same time as setting up the website, the Respondent was contacted by a journalist working for The Guardian newspaper, Ms Liz Hollis, who was compiling a feature article about whistleblowers. Ms Hollis has produced a statement (annexed to the Response) in which she states that during her research for the article she found no mention of a press agency called Whistle Blowers Press Agency Ltd. She states that she would have contacted them for an interview had she come across them. She also states she was told that the Respondent was considering setting up a website to cater for whistleblowers.
- The word or phrase 'whistleblower' is generic and descriptive and the Respondent is making fair use of it in the course of its business.
- The Respondent takes issue with the conclusions drawn from the statement from Mr Brian MacFarlane concerning confusion and notes that a google search of the term 'whistle blower' throws up 322,000 results.
- The Respondent refers to the statement of Joseph Toomey which is in fact produced by the Complainant. Mr Toomey states that he created a temporary single web page with words to the effect of 'Site under construction for Whistle Blowers Press Agency Ltd.' at or around the time of registration of www.whistleblowers.uk.com (on 13 March 2007). Mr Toomey states that his meetings concerning the design of a website for the Complainant continued well into 2008, yet the Respondent's web site at whistleblower.co.uk went live in its full form on 8 February 2008. The Respondent also states that the Complainant's site was not detected by Google until late February 2009, suggesting the website was not in full operation until December 2008, at the earliest.
- In the context of knowledge (of the existence of the Complainant), the Respondent refers to the home page of the Complainant's website, which contains the following paragraph:

'Since 1997 "Whistle Blowers" has broken countless national and international news stories; all without acknowledgement of the Agency's existence. We may have been the original source of the material but we have remained invisible – and we like it that way. Anonymity is the cornerstone of our success. It is also the reason not one of our many "sources" have ever been identified'.
- The Respondent says that the services it provides are different to the services provided by the Complainant.
- CLS are registered with the Office of Fair Trading as a debt collection agency.

Reverse Domain Name Hijacking

The Respondent maintains that there are grounds for a claim of 'reverse domain name hijacking' and contends as follows:

- The Complainant is using the Policy in bad faith due to its use of the whistleblowers.co.uk domain name which recently began to be advertised on google sponsored links alongside the Domain Name. The Respondent relies on other matters including the following:

- The domain name www.whistleblowers.co.uk was not acquired until 11 days after the website www.whistleblower.co.uk had gone live. [in fact it was one year and 11 days given the mistake in dates referred to earlier].
- The Complainant was aware of www.whistleblower.co.uk before registering www.whistleblowers.co.uk.
- The domain name www.whistleblowers.co.uk is nearly identical to www.whistleblower.co.uk and therefore is likely to cause confusion in the eye of the public.
- The Complainant now uses the domain name www.whistleblowers.co.uk to forward traffic to its hosting website www.whistleblowers.uk.com which appears to be a deliberate attempt to hijack traffic intended for www.whistleblower.co.uk

In answer to the Respondent's claim of reverse domain name hijacking the Complainants contend:

- The Complainants are entitled to use the website www.whistleblowers.co.uk. It relates in part to the name of the Complainant (Whistle Blowers Press Agency Limited) and is used in accordance with its registered trade mark (and CLS's licence to use that trade mark).
- The rights claimed by the Respondent do not exist because of the presence of the trade mark owned by the Complainant.

7. Discussion and Findings

A large part of the Complaint is taken up with discussion of trade mark infringement and passing off. The approach of the Complainants to the Respondent's domain name registration can perhaps best be illustrated by paragraphs 12 to 14 of their Complaint. Paragraph 12 refers to the Complainant's trade mark registration of March 1997, (WHISTLE BLOWER). Paragraph 13 refers to the identity or similarity of that trade mark, the Complainant's own domain name (whistleblowers.uk.com) and of the company name, Whistle Blowers Press Agency Limited, to the Domain Name. Paragraph 14 then begins '*Whistle Blowers Press Agency therefore contends that the Domain Name whistleblower.co.uk is an abusive registration*'. But a finding of abusive registration does not automatically flow from what is said in the preceding paragraphs.

The fact that a domain name incorporates a trade mark, even if that means that the two are identical, does not automatically mean that there has been an abusive registration. There are several examples of trade mark owners failing to secure transfers of domain names incorporating their marks. Indeed, the Policy (as well as the rules of other similar organisations) would be written in a very different fashion if a trade mark owner had an exclusive right to any domain name into which its trade mark was incorporated.

The Complainant alleges trade mark infringement and passing off, but those are not matters for this Complaint. Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an abusive registration. Both elements are required.

Complainant's rights

'Rights' is a defined term and the definition includes a proviso that '*a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business*'. There may be an argument, as the Respondent appears to suggest, that despite the Complainant's trade mark registration, the mark is wholly descriptive for the purposes of the Policy. However the Expert accepts that, for the purpose of this proceeding, the Complainant has rights in a mark which, if not identical, is certainly very similar to the Domain Name. The Expert has ignored the prefix 'www' and suffix '.co.uk' and if one also ignores the gap between the two component words of the trade mark ('whistle' and 'blower'), it can be said that the mark and Domain Name are identical. However, the Complainant still needs to prove an abusive registration.

Abusive Registration

Paragraph 1 of the Policy defines abusive registration as a domain name which was either '*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 which has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights;*'.

A non-exhaustive list of factors which may indicate that a domain name is an abusive registration is set out in paragraph 3 of the Policy.

Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily as a blocking registration against a name or mark in which the Complainant has rights, or for the purpose of unfairly disrupting the business of the Complainant.

Other factors suggesting an abusive registration include the Respondent using or threatening to use the domain name in a way which has confused or is likely to confuse people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This includes circumstances indicating that before being aware of the Complainant's cause for complaint, the Respondent has:

- a) used or made demonstrable preparations to use the domain name or one that is similar in connection with a genuine offering of goods or services;
- b) been commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name;
- c) made legitimate non-commercial or fair use of the domain name.

Other countervailing factors include circumstances where the domain name is generic or descriptive and the Respondent is making fair use of it.

The Complainant argues that it is highly unlikely, contrary to what has been said, that the Respondent had no knowledge of the business activities of the Complainant and of its use of the mark WHISTLE BLOWER. However, there seems to be little evidence upon which such allegation is founded. On the contrary, there is considerable material, including that advanced by the Complainant itself, to support the Respondent's position that it had no knowledge of the Complainant at the time it (the Respondent) set up its website. For instance, it would appear that it was not until sometime in 2008 that the Complainant had any significant web presence (a mere holding page having been constructed in 2007), and the Complainant's prior internet searches and the statement of the journalist Liz

Hollis appear to support this. It is also worth mentioning that the Complainant's website does seem to suggest that it intentionally keeps a low profile.

The Complainant says that it has taken 'prompt action' to address the abusive registration and refers to the 'cease and desist' letter of 23 January 2009. The inference is that as soon as it became aware of the Respondent's website, it took action. This is more or less supported by the witness statement of Mr McFarlane on whom the Complainant relies, who says that when he spoke to Mr Scott of the Complainant in November 2008, 'I learned he had just realised another company was trading on the internet, using the name, 'Whistle Blower'''. However, the Respondent's website went live on 8 February 2008, so it seems that the Complainant was unaware of the Respondent's site for some considerable time. If that is the case, why should the Respondent be disbelieved when it says that it was similarly unaware of the Complainant at the relevant time? This Expert finds no reason to disbelieve the Respondent when it says it had no prior knowledge of the Complainant's mark.

It is clear that knowledge of a Complainant and/or its rights is a crucial element in most cases under the Policy. This was made clear in the Appeal Panel decision in the case of *Verbatim Limited v Michael Toth* (DRS 4331):

'In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

(1) First, some knowledge of the Complainant and/or its brand/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.

(2) Secondly, 'knowledge' and 'intention' are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.

(3) Thirdly, 'intention' is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.

(4) Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.

(5) Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.'

The Expert accepts the evidence of the Respondent on knowledge which, on the basis of the Appeal Panel decision in *Verbatim*, will preclude a finding that the Respondent 'has registered or otherwise acquired the domain name primarily as a blocking registration against a name or mark in which the Complainant has rights, or for the purpose of unfairly disrupting the business of the Complainant.' It should be said however, for the sake of completeness, that whilst it is alleged that the Domain Name is an abusive registration

because ‘..it is a blocking registration and unfairly disrupts the business of the Complainant’s’, the Complainant doesn’t expressly allege that the Respondent’s primary purpose was to ‘block’ or ‘disrupt’.

The Complainant also alleges confusion. It is not entirely clear whether the Complainant seeks to make out a case under paragraph 3.a.ii of the Policy (as opposed to a case of passing off or trade mark infringement), but it will be assumed it does. Here too however, some knowledge of the Complainant is required. The Respondent did become aware of the Complainant in January 2009 but it had clearly been using the Domain Name for almost a year beforehand. Such prior use, if for a genuine offering of goods or services, as the Expert accepts it was, is one of the factors listed in paragraph 4 of the Policy as demonstrating a non-abusive registration.

The Expert appreciates that it is inconvenient for the Complainants that the Respondent is using the Domain Name and even that it may be disadvantageous to them that it does so. The Expert also accepts confusion may arise (as it often does when using the internet). But that is not enough. To constitute an abusive registration under the Policy the use must take unfair advantage or be unfairly detrimental to the Complainant’s Rights. On the evidence before the Expert there is nothing unfair about the Respondent’s use.

Reverse Domain Name Hijacking

Reverse Domain Name Hijacking is defined in Nominet’s Dispute Resolution Service Procedure as using the Policy in bad faith in an attempt to deprive a registered domain-name holder of a domain name. In the Panel decision of *Speciality Welds Ltd v Hydroweld* DRS02676, the Expert said

‘In any event, in the view of this Expert, reverse domain name hijacking is a term which should be restricted to abusive use of the Policy to deprive a registrant of a domain name in circumstances where the Complainant knows that the Complaint has no merit within the terms of the Policy. Here, the Respondent’s case is that the Complainant expected the Complaint to succeed.’

In the Expert’s view, the Complainant similarly believed that its Complaint had merit, despite it failing and accordingly dismisses the allegation of reverse domain name hijacking.

8. Conclusion

The Expert finds that the Complainants have Rights in a name or mark that is identical or similar to the Domain Name but that the Domain Name in the hands of the Respondent is not an abusive registration. Accordingly, the Expert directs that no action be taken in respect of the Complaint.

Signed: Jon Lang

Dated: 20 July 2009