

DISPUTE RESOLUTION SERVICE

DRS 8428

Decision of Independent Expert

The Society of Operations Engineers (UK Registered Charity)

and

Aztec Media Services Limited (UK Limited Company)

1. The Parties:

Complainant: The Society of Operations Engineers (UK Registered Charity)

Address: 22 Greencoat Place
London
SW1P 1PR

Country: United Kingdom

Respondent: Aztec Media Services Limited (UK Limited Company)

Address: 1 Bankside
Churt Road
Hindhead
Surrey
GU26 6NR

Country: United Kingdom

2. The Domain Name:

transportengineer.co.uk

3. Procedural History:

- 3.1 The complaint was received by Nominet, on 19 March 2010 (the 'Complaint'). On 22 March 2010, Nominet validated the Complaint and took appropriate steps to notify the Respondent of the Complaint.
- 3.2 A response from the Respondent (the 'Response') was received on 14 April 2010, and the Complainant's reply (the 'Reply') to the Response was received on 21 April 2010. A mediator was appointed on 21 April 2010.
- 3.3 On 21 April 2010, mediation was closed and the status of the dispute changed from mediation to a request under Nominet's dispute resolution service ('DRS') procedure (the 'Procedure').
- 3.4 On 30 April 2010, Dr Russell Richardson was appointed as the expert (the 'Expert') who confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as the Expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual Background:

- 4.1 The Complainant is a professional membership organisation for engineers, being a registered charity (Charity Number 1081753). The Respondent is a UK limited company (Company Number 04629636).¹
- 4.2 The Institute of Road Transport Engineers ('IRTE') started publishing the *Transport Engineer* magazine (the 'Magazine') for its members in July 1970.
- 4.3 The Complainant was formed in 2000 following the merger of two professional bodies, the aforementioned IRTE and the Institution of Plant Engineers ('IPlantE').
- 4.4 The Complainant refers to its members as being members of the IRTE Professional Sector of the Complainant.
- 4.5 The Complainant outsourced the production of the Magazine to contract publishers; from 1994² to 2009, it was outsourced to the Respondent. When that contract lapsed, it was outsourced to Findlay Media Ltd.
- 4.6 The Domain Name was registered by the Respondent on 14 May 2004.³

¹ Based on search at Companies House, 23 May 2010.

² Noting that the Complainant stated in its Complaint that the start date was 1995 – but in its response stated that the Respondent published the Magazine from 1994 to 2009.

³ Based on a search by the Expert of the Nominet's WHOIS database.

5. Parties' Contentions:

The Complaint:

5.1 In summary, the Complainant argues that the Domain Name should be transferred to it because:

- it has Rights in the Domain Name. When the IRTE merged with the IPlantE to become in effect the Complainant organisation, all assets of the IRTE, including the Magazine, were transferred to the Complainant.

The name of the Magazine, *Transport Engineer*, has been synonymous with the IRTE, and latterly the Complainant, from 1970, and its publication has been independently audited by the Audit Bureau of Circulation ('ABC') since then.⁴

The IRTE was established in 1944 and today the IRTE Professional Sector of the Complainant has approximately 11,000 members worldwide. Its members receive post-nominal letters (MIRTE, FIRTE) and continuing professional development advice and assistance. They also receive the Magazine each month.

The Magazine's primary readership is individual and company members of the IRTE Professional Sector of the Complainant. The Magazine also has separate subscribers, who subscribe directly with the Complainant, which makes up around 2% of the total readership.

Advertising space is sold in every edition of the Magazine. All news and features published in the Magazine (from 2005 - present) are added to the Complainant's website (www.soe.org.uk).

The IRTE and latterly the Complainant has solely paid for the design, production of editorial, print and distribution of the Magazine. The Complainant is listed as the publisher of the Magazine, and therefore is the owner of the title/Magazine.⁵

The Complainant owns the domain name www.transportengineer.org.uk, which is now used as a supporting website for the Magazine.

The Domain Name was registered by the Respondent as a result of the publishing contract signed between the Complainant and the Respondent in 1995, for the Respondent to produce the Magazine on its behalf. This contract expired on 31 December 2009.

From when the Domain Name was registered in 2004, up until the contract expired in December 2009, the Domain Name was used solely for the support and promotion of the Magazine.⁶

The Respondent's continued use and control of the Domain Name after 31 December 2009 constitutes an Abusive Registration.

⁴ <http://www.abc.org.uk/Data/ProductPage.aspx?tid=2848>

⁵ A print-out of the Magazine cover as of October 2009 and March 2010 provided in support.

⁶ Screen shots of the magazine from November 2009 provided in support.

This is because, as of 1st January 2010, the contract to produce the Magazine was awarded to another contract publisher. Therefore, the relationship between the Respondent and the Complainant no longer exists.

Following the contract expiry, the Respondent established a rival publishing venture, and is currently using the Domain Name to support this new venture.⁷

The Respondent's continued operation of the Domain Name is potentially confusing to members, advertisers and customers, who may visit the website to find out information about the IRTE's official magazine.

This confusion is potentially very damaging for the Complainant, its members and its charitable aims. It is an attempt by the Respondent to promote their new venture and to gain commercial advantage, using the long-established and respected name of *Transport Engineer*.

It is a deliberate attempt by the Respondent to confuse the market place and generate income from potential advertisers/customers who may be duped into thinking that the Respondent's new venture is a replacement for the Magazine.

The Response:

5.2 In summary, the Respondent argues that the Complaint should not succeed because:

- the Respondent has a long and distinguished track record in producing various high-quality publications, both printed and published online, read by transport engineers.

It produced such publications: before entering into a contract with the Complainant; during its contractual relationship with the Complainant; and now, following the end of the latest contract (at the end of November 2009, not December as the Complainant wrongly asserts). These publications have been referenced using the Domain Name.

The Respondent considers that the term '*Transport Engineer*' describes a person who works in or is interested in the engineering aspects of transport (in all its forms). It is descriptive of such persons and activities. It is so descriptive that it is doubted whether such a term could acquire a 'secondary meaning'. To suggest anything else would be to give the Complainant 'exclusive rights' in the words *Transport Engineer* and preclude any legitimate transport engineer from the right to describe themselves this way.

In support of this, there are hundreds of thousands of transport engineers in the United Kingdom alone, including those in membership of such professional bodies as: *The Institute of Transportation Engineers* (around 17,000 members);⁸ *The Institution of Mechanical Engineers* (around

⁷ Screen shot of Domain Name website as at March 2010 provided in support.

⁸ www.ite.org

80,000 members);⁹ and, *The Society of Automotive Engineers* (around 90,000 members).^{10 11}

The Complainant has existed only since 2000, any direct connection between the Complainant and the term *Transport Engineer* cannot go back any more than ten years.

The Respondent was responsible for the content of the Magazine from 1994 to 2009, retaining full editorial control and ownership of all copyright in the contents throughout that time. Its rights under the Copyright, Designs and Patents Act 1988 have been asserted on the contents page of every issue of the Magazine it produced.¹²

Contrary to the claim made by the Complainant, the Domain Name was not registered: "as a result of a contract awarded by the [Complainant]". None of the contracts the Respondent has had with the Complainant (and previously, the IRTE) contains any reference to any Domain Names.¹³

The Domain Name was acquired and registered by the Respondent because it recognised and responded to the growing use of the Internet by the transport engineers for whom it produced various publications.

It made sense for it to register a descriptive term to link to a website dealing with transport engineering matters in general and publicising in particular the Respondent's activities in the field of transport engineering. This decision was taken without any reference to the Complainant.

The Domain Name has pointed to the Respondent's website from 2004, with the full knowledge of the Complainant (and therefore with its implied consent, though this was never needed).¹⁴ As a result of such use of the Domain Name, the Respondent has developed valuable goodwill in the Domain Name.

Further, the use made of the website associated with the Domain Name since it was registered six years ago has been decided entirely and exclusively by the Respondent. The Complainant has never had anything to do with the Domain Name.

Additionally, all costs related to the registration and maintenance of the Domain Name and associated websites have been borne by the Respondent. The Complainant has never had any control over or involvement of any kind in the Domain Name's registration, the costs associated with it or the content of any website to which it has pointed.

⁹ www.imeche.org

¹⁰ www.sae-uk.org

¹¹ Other Professional Bodies referred to by the Respondent include – *The Institute of the Motor Industry* ('IMI') (around 25 000 members); and, *The Institution of Engineering and Technology* ('IET') (around 150 000 members).

¹² Insert page from the September 2009 edition of the Magazine and letters from journalists who provided content to the Magazine, provided in support.

¹³ The Respondent provided a draft of and the copy of the contract between the Complainant and the Respondent, signed 14 December 2006.

¹⁴ Screen prints from websites dated 21 July 2004, 5 February 2005, and 3 August 2006 provided in support.

The Respondent did use the Domain Name to promote the Magazine while it was responsible for the content of that magazine, but any such use and any such goodwill benefits the Respondent and not the Complainant.

The Complainant has set up another website, at www.transportengineer.org.uk, apparently aimed at a wider audience of transport engineers, the domain name for which being registered in February 2009. The website to which this domain name now points has become active only in the past few months.

The Complainant recognises that when the Respondent was responsible for the content of the Magazine, it was: "renowned for its independent viewpoint and for its authoritative reporting, news analysis and comment." This reputation is based almost entirely on the efforts of the Respondent and the people working for it while it edited and produced the magazine

If the term *Transport Engineer* has acquired any secondary meaning related to the publication of that name (which it strongly disputes), then any goodwill attached to that secondary meaning must at the very least be shared with the contract publisher responsible for the Magazine's contents and publication.

As to any confusion, the Complainant's assertion that its continued ownership of the Domain Name is: "potentially confusing to members, advertisers and customers...." is misplaced, as is its claim that the generic or descriptive term *Transport Engineer* is "synonymous with the IRTE professional sector of [the Complainant]."

The Domain Name now points to its online magazine *Commercial Vehicle Engineer*. This is aimed primarily at transport engineers and fleet managers so it is perfectly legitimate and sensible to have the Domain Name pointing at it.

The Respondent in this way does not consider that a user of its current the website could confuse *Commercial Vehicle Engineer* with any of the Complainant's publications, including *Transport Engineer*, and that nobody is in any danger of being "duped" or "confused" by its continuing ownership and control of the Domain Name.

The Respondent has no reason to wish to be associated with the Complainant, by mistake or otherwise. It is in its interest to ensure that all visitors to its websites are made aware that it is an independent, trusted publishers of high-quality information for transport engineers, no longer having any connection with the Complainant.

The Complaint is an attempt by the Complainant at: "reverse domain name hijacking".¹⁵

Reply:

5.3 The Complainant replied as follows, in summary:

¹⁵ This assertion is explained and considered at paragraph 7.50 et seq below.

- from the Domain Name's registration in 2004, up until the end of the contract between the Respondent and the Complainant (in early December 2009), the website hosted at the Domain Name has been used to raise awareness of and promote the Magazine.¹⁶ The Complainant's members and the general public would have only associated the Domain Name with the Magazine.

Any goodwill built up in the Domain Name was as a result of the link between the website and the Magazine. The Magazine has been the official publication of the IRTE Professional Sector of the Complainant since 1970.

No goodwill in the Domain Name would have been possible had the Respondent not been contracted by the Complainant to produce the Magazine, on its behalf from 1994 to 2009.

Similarly, the Domain Name was chosen and registered by the Respondent as *Transport Engineer* because this is and has been the title of the Magazine since 1970.

The Complainant and Respondent provided other exhibits than the ones referred to above, and links to websites. The Expert has seen all exhibits and also accessed the websites linked to the web-addresses provided.

6. Outstanding formal/procedural issues

6.1 The Respondent in its Reply refers to a previous complaint raised by the Complainant (DRS 7881). As this complaint did not proceed to the Expert decision stage, the Expert does not consider this relevant to his findings in this matter.

7. Discussions and Findings

General

7.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the DRS policy (the 'Policy'), on the balance of probabilities (that the Complainant's case is more likely than not to be the true version¹⁷), that:

(i) it has Rights in respect of a name or mark identical or similar to the Domain Name (paragraph 1 of the Policy); and,

(ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration (paragraph 1 of the Policy).

7.2 Addressing each of these limbs in turn:

i) Complainant's Rights

¹⁶ Screenshots of the website attached to the Domain Name taken from 2nd November 2009, and archived from 2004, 2005, 2006 and 2009 in support.

¹⁷ <http://www.nominet.org.uk/disputes/drs/legalissues/>.

7.3 Paragraph 1 of the Policy defines 'Rights' as:

“[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;”

Also, the Complainant must have the Rights at the time of the complaint.¹⁸

7.4 The Expert notes that the Complainant has not obtained registered trademark protection for the name in consideration, *Transport Engineer* (or the 'Name'); a registered trademark being an enforceable right as understood by the above definition.

7.5 As the above definition does embrace other enforceable rights other than registered trade (or service) marks, the Expert has considered whether such a non-registered enforceable right arises in the Name (the Name being identical to the Domain Name, not counting the generic *.co.uk* suffix). The Expert considers that relevant to this consideration is whether:

(a) the Complainant has used the name in question for a not insignificant period and to a not insignificant degree; and,

(b) the name in question is distinctive by the purchasing public (including trade purchasers) as indicating the goods or services of the Complainant.

Addressing each of these considerations in turn:

7.6 In relation to consideration (a), the Expert notes that the Magazine has been published in one way or another since 1970, albeit the Complainant has only been associated with the Magazine since 2000 through the merger of the two professional bodies IRTE and IPlantE. Therefore, the Complainant in this way has used the Name, as being the title of its Magazine, for a 'not insignificant' period.

7.7 However, the Expert does not consider that the use of the Name by the Complainant has been to 'a not insignificant degree'. To explain, the Expert has only limited evidence before him of the extent of the use of the Name as attached to the Magazine and considers such use as being limited only to a closed and limited group; namely the approx 11 000 members of the IRTE Professional Sector of the Complainant who receive the Magazine as part of their subscription. This is further explained below at paragraphs 7.15 *et seq.* For these reasons, the Expert does not consider that the Name has been used by the Complainant to 'a not insignificant period'.

7.8 In relation to consideration (b), in any event, the Expert does not consider that the Name is distinctive by the purchasing public as indicating the goods or services of the Complainant.

7.9 First, the Expert does not consider that the Name is of itself distinctive, in that it is a descriptive term of a profession. Relevant to this finding, the Expert notes the Respondent's references at paragraph 5.2 above to the fact that the term *Transport Engineer* describes a person who works in or is interested in

¹⁸ See for example, Nominet Appeal decision, *ghd*, DRS No. 03078, at page 9, para 9.2.2.

the engineering aspects of transport (in all of its forms) and that there are many other Transport Engineering related trade bodies and members of those trade bodies (which run into the hundreds of thousands).

- 7.10 In addition, based on the evidence before him, the Expert does not consider that such a descriptive term has acquired a 'secondary meaning' as referred to in the above definition of 'Rights', such as to make the Name distinctive to the purchasing public (including in this case those in the transport engineering trade and the average consumer of transport engineering related goods and services) as indicating the goods or services of the Complainant.
- 7.11 In so deciding, the Expert has considered whether the Complainant has generated goodwill in the Name, similar to an action in passing off ('Goodwill'). The Expert considers that such a test is relevant, noting that whether a trademark is distinctive is a "higher standard" than whether a person in a passing off action has established Goodwill in the name relied upon.¹⁹ If the Complainant could show it has Goodwill in the Name, this would be sufficient evidence that it has Rights in the Name. As such, the Expert has considered in this context whether Goodwill has been generated by the Complainant in the descriptive term *Transport Engineer*.
- 7.12 Goodwill has been defined as: "the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom."²⁰ Where a person is seeking to establish Goodwill in a name, in this case *Transport Engineer*, they must show that the name is distinctive of its business or goods in the eyes of the purchasing public such that it is exclusively associated with his business or goods.²¹ A descriptive name does not in this way usually indicate the source of the goods or business but merely the nature of the goods or business.²² Indeed, "where a trader has used a highly descriptive name he will find it virtually impossible to obtain protection at all by means of passing off proceedings."²³
- 7.13 Therefore, the Expert has to consider whether the descriptive name *Transport Engineer* is distinctive of the Complainant's Magazine in the eyes of the purchasing public. The Expert notes that there is evidence before him that the Magazine has been published since 1970, published exclusively via the website attached to the Domain Name since 2004, and that the Magazine has a readership of (approx) 11 000, being the members of the IRTE Professional Sector of the Complainant. This is evidence brought forward by the

¹⁹ See discussion in *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at paragraphs 25 – 26, 32.

²⁰ *Inland Revenue Commissioners v Muller & Co Margarine Ltd* [1901] A.C. 217 at 223,224.

²¹ *Inter Lotto (UK) Ltd v Camelot Group plc* [2003] 3 ALL E.R. 191; [2004] R.P.C. 171; upheld [2004] 1 W.L.R. 995; [2004] R.P.C. 186, CA. As stated by Lord Oliver in the House of Lords case, *Reckitt & Colman v Borden* [1990] 1 WLR 491, (the *Jif Lemon* case), at p 499D – H: "[There are three elements to establish a successful action of passing off]. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services."

²² *McCain International Ltd v County Fair Foods* [1981] R.P.C. 69 ("Oven Chips"); *My Kinda Town Ltd v Soll* [1983] R.P.C. 407 ("Chicago Pizza").

²³ Laddie J, *Antec International Ltd v South Western Chicks (Warren) Ltd* [1997] F.S.R. 278, at 285.

Complainant that the descriptive term *Transport Engineer* is somehow distinctive of the Complainant.

- 7.14 However, the Expert does not consider this evidence sufficient. He considers that the (approx) 11 000 members of the IRTE Professional Sector of the Complainant, as being the readers of the Magazine (and purchasers one would assume through their membership fees), is too closed and limited subset of the relevant purchasing public for there to be the necessary distinctiveness. The Expert notes in this regard the evidence before him that while the Magazine has subscribers who are not members of the professional body, these make-up only around 2% of the total readership (about 220).
- 7.15 Further, as set out at paragraph 5.2 and discussed at paragraph 7.9, both above, there are many other professional bodies 'related to' *Transport Engineering* who have larger memberships. Also, there is no relevant evidence before the Expert that, at the time of the Complaint: there was a public advertising campaign surrounding the Magazine; advertisers accessing the website did so on the basis that it was exclusive to the Complainant; the Complainant publicised the Magazine in any way; or that anyone other than its members subscribed to the magazine or visited the website attached to the Domain Name to look at the Magazine.²⁴
- 7.16 It is worth noting here that even if such a subset were to make-up the relevant 'purchasing public', there are references in the Magazine to suggest that the purchasing public would likely consider that the Respondent also had Rights in the Name as well as the Complainant, and therefore the Complainant does not have exclusive rights sufficient to generate Goodwill in the Name.
- 7.17 Relevant to this consideration is the fact that the:
- Respondent has been associated with the Magazine since 1994 (six years before the Complainant);
 - Respondent's details were set out in the Magazine information column on the info page as being the Editor and also controlling the Magazine's advertising (in conjunction with the Complainant);²⁵ and,
 - Respondent's name was set out in bold at the top right of the homepage of the website linked to the Domain Name.²⁶
- 7.18 Also relevant is that, in the letters section of the November 2009 edition of the Magazine, it was stated that: "The views expressed by the Magazine are the responsibility of the Editor and do not necessarily reflect the views of [the Complainant]." The Expert considers that this would suggest to the members that the Respondent, as Editor of the Magazine, had a degree of Rights in the Magazine (and hence, following such logic, in the Name).
- 7.19 In addition, there was a letter from the Chief Executive of the Complainant in the November 2009 edition of the Magazine discussing the expiry of the

²⁴ Noting that the requirement to demonstrate "Rights" is not a particularly high threshold - see for example, Nominet appeal decision, *seiko-shop*, DRS No. 00248, at page 17.

²⁵ E.g. print-outs provided of the Magazine from January 1995 and October 2009.

²⁶ E.g. screen printouts for July 2004, August 2004, February 2005, August 2006, May 2008, and November 2009.

contract between it and the Respondent, and the change in the editing of the Magazine, explaining to the members that: “[to back up the new editorial services] and to satisfy the need for electronic communications, a new content-rich *Transport Engineer* website will be launched [...]”.

- 7.20 The Expert considers that this would be understood by the members as the Complainant intending to launch a new website (not linked to the Domain Name) from which to publish the Magazine (whether on its website at www.soe.org.uk or on a website attached to the domain name it registered at www.transportengineer.org.uk).
- 7.21 As such, the Expert does not consider that the Name is distinctive of the Complainant in the minds of the purchasing public.
- 7.22 Given the reasoning at paragraphs 7.3 *et seq.* above, either when considered singularly or together, the Expert does not consider that the Complainant has Rights in respect of the Name and therefore the Complainant fails in its Complaint on this limb.
- 7.23 Finally, as a matter of law, the Expert does not accept as stated by the Complainant in paragraph 5.1 above, that merely because the Complainant is listed as publisher of the Magazine, it is the owner of the title in the Domain Name (or even the owner of the Magazine). First, a publisher of a magazine could be publishing that magazine on someone else’s behalf. Secondly, a distinction can be drawn between having Rights in a name and owning a magazine; in that, for example, a person who publishes a magazine could licence branding from another person who owns intellectual property rights in the various elements of that branding. Therefore, the Expert does not consider this relevant to his consideration of the Complaint.

ii) Abusive Registration

- 7.24 In any event, and for completeness, even were the Expert to be wrong and the Complainant has Rights in the Name, the Expert has considered whether the Respondent’s use of the Domain Name is an Abusive Registration as understood by Paragraph 2 a. ii. of the Policy.

- 7.25 Paragraph 1 of the Policy defines “Abusive Registration” as a domain name which either:

“i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or

ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights;”

- 7.26 *In relation to (i) above* – the Complainant has not alleged that there was an Abusive Registration at the time of registration, 14 May 2006. As such, the Expert does not consider this limb relevant to the Complaint and, consequently, his Decision.

- 7.27 *In relation to (ii) above* – the Complainant alleges that the Respondent’s continued use and control of the Domain Name after the end of the

contractual relationship between the Complainant and the Respondent (31 December 2009) constitutes an Abusive Registration.

7.28 Paragraph 3 of the Policy sets out a *non-exhaustive* list of factors which may be evidence that the Domain Name is an Abusive Registration.

7.29 In this case, the Complainant refers in substance to the factor set out at Paragraph 3 (a) (ii) of the Policy, which states that:

“[there may be evidence of an Abusive Registration if there are] Circumstances indicating that the Respondent is using [...] 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.”

7.30 The Complainant makes three points in this respect:

- following the expiry of the contract between the Complainant and the Respondent at the end of 2009, the Respondent established a rival publishing venture, and is currently using the Domain Name to support this new venture.
- The Respondent's continued operation of the Domain Name is potentially confusing to members, advertisers and customers, who may visit the website to find out information about the IRTE's official magazine.
- This is potentially very damaging for the Complainant, its members and its charitable aims; and is a deliberate attempt by the Respondent to confuse the market place and generate income from potential advertisers/customers who may be duped into thinking that the Respondent's new venture is a replacement for the Magazine, thus gaining commercial advantage over the Complainant.

Thus, such actions took unfair advantage of or were unfairly detrimental to the Complainant's Rights.

7.31 The Expert has also considered whether any other factors support the Complainant's case, in particular whether Paragraph 3 a. v. of the Policy is relevant on these facts, which states that:

“[there may be evidence of an Abusive Registration if t]he Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant: A. has been using the Domain Name registration exclusively; and B. paid for the registration and/or renewal of the Domain Name registration.”

7.32 In relation to the first factor, the Expert does not consider that, on the balance of probabilities, the Respondent's use of the Domain Name after the expiry of the contractual relationship between the Parties 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.

- 7.33 Relevant to this is: the website heading after the expiry of the contractual relationship between the Parties, namely *Commercial Vehicle Engineer*;²⁷ the different 'get-up' of the websites (the current website is in green whereas the website previously was in blue); and, the limited and closed readership of the Magazine as discussed previously.²⁸ The Expert considers it is likely that, after the contract expired, the members (or advertisers, as suggested by the Complainant) would not access the website attached to the Domain Name expecting it to be that of the Complainant. Indeed, as discussed at paragraphs 7.16 *et seq* above, if Rights can be attached to the Name, the Expert considers that through the close contractual relationship with the Respondent as represented both in the Magazine and on the website, the Respondent would also have Rights.
- 7.34 In addition to the reasoning set out above, this finding is in part based on the November 2009 letter from the Chief Executive of the Complainant explaining the expiry of the contract with the Respondent and the 'new direction' the Complainant was taking, with the launch of "a new content-rich *Transport Engineer* website."²⁹ It is also based on the words used in the same letter responding to members' concerns that the quality of the magazine would not suffer as a consequence of the 'new direction'. This made it very clear to the members that the Parties' contractual relationship had expired.
- 7.35 Thus, given the limited and closed nature of the readership of the Magazine (i.e. the members), the Expert considers that the purchasing public (being the members and advertisers) looking to access the Complainant's website would likely have been aware of the change in approach towards the Domain Name, and as a consequence there would be no 'initial confusion' or otherwise of those seeking to access the site.
- 7.36 Additionally, the Expert does not consider that the factor at Paragraph 3 a. v. of the Policy is relevant. In coming to this view, the Expert considers it relevant to consider such factors in light of the fifteen year contractual relationship between the Respondent and the Complainant (and previously, the IRTE). Noting in this regard, that there is a lack of evidence on the papers before the Expert as to who owns the Domain Name under contract (either verbal or written) between the Parties.
- 7.37 In this regard, the Expert was referred by the Respondent to the contract between the Parties, dated 14 December 2006, which regulated their contractual relationship between 1 January 2007 up until the publication of the December 2009 issue. Indeed, this contract was intended to define the arrangements in place in October 2006 for the benefit of the Parties. Also, the contract was entered into by the Parties after the Respondent had registered the Domain Name so it was an opportunity to clarify the contractual ownership of the Domain Name.
- 7.38 However, contrary to the expectations of the Expert, this contract did not: define what Intellectual Property Rights each party was 'bringing to the table'; or, set out ownership of either the Domain Name or any wider intellectual property rights. (While the contract does set out that part of the Respondent's responsibilities is to up-date the SOE website with employment vacancies

²⁷ Based on print-out of the website, dated March 2010.

²⁸ As discussed in paragraph 7.13 – 7.14 above.

²⁹ See paragraph 7.19 above.

advertised in the Magazine, the Expert takes this to refer to the Complainant's www.soe.org.uk website and not the website attached to the Domain Name.)

7.39 To put this in to context, the Respondent had in effect been contracted by the Complainant (since 2000) and previously the IRTE (since 1994) to provide a full editorial and production service for the Magazine, including the supply of all editorial content.³⁰ The Respondent, separate from its contractual obligations, decided to register the Domain Name in 2004 (it argues, choosing a descriptive term *Transport Engineer*), and then used that Domain Name to make the Magazine available electronically. It was only after the expiry of the contractual relationship between the Complainant and the Respondent that the ownership of the Domain Name was questioned.

7.40 The Expert also notes that the Complainant registered the www.transportengineer.org.uk website on 25 February 2009,³¹ nearly ten months before the expiry of the contractual arrangement between the Complainant and the Respondent. The Expert considers that this action suggests that it was at least in the mind of the Complainant that ownership of the Domain Name was unclear and, as such, it acted to cover itself in such circumstances.

7.41 Finally, and based on the submissions before the Expert, he considers that, on the balance of probabilities:

- the Domain Name was registered by the Respondent separately from any contractual relationship with the Complainant (as said, the 2007 contract between the parties which was provided to the Expert made no reference to the ownership of any Intellectual Property rights);
- the use made of the website associated with the Domain Name has been decided entirely and exclusively by the Respondent;
- the registration, the renewal and up-keep of the Domain Name was paid for by the Respondent separate from its contract with the Complainant; and,
- the Respondent decided to use the website attached to the Domain Name as another way of publishing the Magazine (separate from the contract between the Parties).

The benefits were mutual, in that the Domain Name could be used as another way to publish the Magazine, and the members of the Complainant would access the website attached to the Domain Name to access the Magazine and generate greater click-throughs for advertising purposes.

7.42 As such, while the Domain Name was used prior to the expiry of the contract to relate exclusively to the Magazine, for the reasons set out below, the Expert does not consider that the Domain Name's registration or renewal was paid for by the Complainant. Thus, this factor falls as the Complainant did not pay for the registration or renewal of the Domain Name.

7.43 Neither does the Expert consider that any of the other factors listed in Paragraph 3 of the Policy help the Complainant on the evidence before him.

³⁰ Based on clause 2.3 of the 1 January 2007 contract.

³¹ Based on a search by the Expert of the Registrar's WHOIS database.

- 7.44 In any event, the Expert considers that there is evidence/arguments before him which are relevant to his consideration whether the Domain Name is *not* an Abusive Registration. (In relation to this, the Expert notes the *non-exhaustive* list of factors set out at paragraph 4 of the Policy.)
- 7.45 The Respondent in effect argues that, in reference to:
- “[Paragraph 4 a. i. of the Policy, b]efore being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has: A. used or made demonstrable preparations to use the Domain Name [...] 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;”*
- 7.46 Relevant to this factor is that, as described in paragraph 5,2 above, the Respondent has before the breakdown in its contractual relationship with the Complainant:
- made legitimate use of the Domain Name by using it to publish the Magazine online (the Respondent being responsible for full editorial and production service of the Magazine, including the supply of all editorial content and material);³² and/or,
 - been connected with the Name through its close involvement in the production of the Magazine as discussed above (see for example paragraphs 7.16 *et seq.*).
- 7.47 Also relevant to this consideration is the factor listed at Paragraph 4 a. ii of the Policy, that the: “Domain Name is generic or descriptive and the Respondent is making fair use of it.”
- 7.48 For the reasons set out at paragraphs 7.9 *et seq* above, the Expert considers that the Domain Name is descriptive and the Respondent is making fair use of it by using it to run a website entitled *Commercial Vehicle Engineer* which those with an interest in the Magazine i.e. in practice the members or advertisers, would not consider as being “registered to, operated or authorized by, or otherwise connected with the Complainant”.
- 7.49 As such, the Expert considers that, notwithstanding the arguments put forward by the Complainant as summarised in paragraphs 5.1 and 5.3 above, the Domain Name has not been *used* in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights (on the alternative basis that the Complainant has Rights in the Name).
- 7.50 Finally, the Respondent argues that the Complaint is an attempt by the Complainant at “reverse domain name hijacking”.
- 7.51 Paragraph 1 of the ‘Procedure, defines this as meaning: “using the Dispute Resolution Service in bad faith in an attempt to deprive a Respondent of a Domain Name.” Paragraph 16 d. of the Procedure states that if the Expert

³² Based on the contract between Complainant and Respondent, dated 14 December 2006.

finds a complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking, the Expert shall state this finding in the Decision.

- 7.52 Apart from a bald statement from the Respondent claiming such an intent, there is no evidence to support a claim of bad faith against the Complainant. Therefore, the Expert does not consider it appropriate to make such a statement in his decision.

8. Decision

- 8.1 The Expert finds, on the balance of probabilities, that the Complainant has not provided that it has Rights in a name which is identical to the Domain Name and that, in any event, the Domain Name in the hands of the Respondent is not an Abusive Registration. Therefore, the Expert directs that no action be taken with regard to the Domain Name.

Signed Dr Russell Richardson

Dated 4 June 2010