

DISPUTE RESOLUTION SERVICE

D00009524

Decision of Independent Expert

Tikit Limited

and

Mr R A Blown

1. The Parties:

Lead Complainant: Tikit Limited
12 Gough Square
London
EC4A 3DW
United Kingdom

Respondent: Mr R A Blown

2. The Domain Name(s):

tikit.co.uk

3. Procedural History:

27 January 2011 17:01 Dispute received
28 January 2011 12:05 Complaint validated
28 January 2011 12:29 Notification of complaint sent to parties
21 February 2011 09:53 Response received
24 February 2011 11:14 Notification of response sent to parties
07 March 2011 14:27 No reply received
07 March 2011 14:27 Mediator appointed
10 March 2011 11:00 Mediation started

23 March 2011 16:58 Mediation failed
23 March 2011 16:58 Close of mediation documents sent
28 March 2011 10:37 Expert decision payment received

Sallie Spilsbury, the undersigned expert (the Expert) has confirmed to Nominet that she knows of no reason why she cannot properly accept the invitation to act as Expert in this dispute and has further confirmed that she knows of no matters which ought to be drawn to the attention of the Parties which might appear to call into question her independence and impartiality.

There are no outstanding procedural issues in this matter.

4. Factual Background

The Complainant

The Complainant provides technology related services to law firms and accountancy practices in the UK, Europe and the US. It was incorporated on 7 January 1994 and its client list currently totals more than 1000 legal and accountancy firms, including more than 90 of the UK's top 100 law firms, 20 of the top 50 US law firms and 18 of the top 50 UK accountancy firms. The services provided by the Complainant are varied and include financial and practice management, content management, document production, customer relationship management and infrastructure services. The Complainant is listed on the London Stock Exchange and has approximately 200 staff working from offices in the UK, Europe and North America. The address of its primary website appears to be www.tikit.com.

In addition to the support services and consultancy provided to clients the Complainant has developed strategic relationships with a number of software vendors and resells third party software applications where it considers them to be appropriate. It has also developed its own software to enhance the functionality of third party software applications. The Complainant owns IP rights in the software that it has developed.

The domain name at issue in this matter, tikit.co.uk (the Domain Name), was registered in the Complainant's name from August 1996- November 2010. Due to an administrative oversight the Complainant did not renew the Domain Name and its registration was cancelled in November 2010 after a period of suspension in accordance with Nominet procedures. The Complainant explains that this oversight was due to a combination of (i) software problems within its domain name agent and (ii) reminders and other warning communications from Nominet being directed to a former employee of the Complainant who did not forward them on to the Complainant.

The Respondent registered the Domain Name on 22 November 2010, at a time when the Complainant's registration had been cancelled.

The Respondent

The WHOIS database lists the Respondent as a non-trading individual. There is no information before the Expert about the Respondent's specific objective in registering the Domain Name. In the Response the Respondent indicates that he has acquired the alphanumeric freephone telephone number 08008 845484 (which spells 08008 TIKIT4). The Respondent says that the acquisition of the number demonstrates that he has what he terms an "intended use" for the word Tikit. No further details are provided.

5. Parties' Contentions

Rights

The Complainant

The Complainant asserts that it has Rights to, and a legitimate interest in, the TIKIT mark and that these predate the Respondent's registration of the Domain Name. In support, it relies on UK Trade Mark registration 2105073 for the word mark TIKIT registered on 10 October 1997 in respect of goods and services in classes 35, 37, 41 and 42 (a copy of the registration certificate is provided at Annex 2 to the Complaint). The goods and services for which the mark is registered reflect the nature of the Complainant's services and include business management and administration, IT services for businesses, training relating to IT and computer programming.

By implication, the Complainant is also asserting unregistered Rights in the goodwill generated by the TIKIT mark arising from its duration of use of the mark and its prominence in the legal and IT sectors.

The Respondent

The Respondent points out that TIKIT is not a mark that is exclusive to the Complainant. He draws the Expert's attention to a product called the Tikit folding bicycle and provides a link to Wikipedia which confirms that the Tikit is indeed a type of folding bicycle. The Respondent also refers the Expert to a website at www.tikit.org which is concerned with old editions of Hodder & Stoughton paperback books. Neither of these sectors have any apparent connection to the Complainant and the Complainant has not filed a Reply disputing the Respondent's submissions.

Abusive Registration

For convenience the Expert has divided the Complainant's submissions into those based on the Respondent's registration of the Domain Name and those based on use. In reality, this divide is not clear from the Parties' submissions and there is

some overlap between them. The Decision also sets out the Parties' submissions on each issue separately.

Acquisition

1. The Complainant asserts that the registration of the Domain Name by the Respondent was abusive because it took advantage of the Complainant's position, in the sense that it took advantage of the fact that the Complainant's registration of the Domain Name had been allowed to lapse. The Complainant points out that the failure to renew the registration was not deliberate on its part (the relevant circumstances are set out above in section 4 of this Decision).

The Respondent submits that he registered the Domain Name in accordance with Nominet procedures and that he had no knowledge of the Complainant's position when he did so. He also points out that under Nominet's terms and conditions a registrant is required to keep Nominet informed of its correct contact details. If the Complainant had done so in this case, the Respondent asserts, the renewal notices and other communications routinely issued by Nominet would not have been sent to the Complainant's former employee and would probably have reached the Complainant.

2. The Complaint asserts that the Domain Name was acquired for the primary purpose of stopping the Complainant from using it. The Complainant states that it received a telephone call from a Rob Blown (the name of the Respondent) on 6 December 2010. Mr Blown did not leave contact details but, according to the Complainant, he said that he was "getting a lot of tikit.com traffic over the last few months since he bought the name from NetNames [a domain name agent]". Mr Blown then requested the Complainant to "re-direct from our website" or to stop using the domain name. Mr Blown allegedly also said that he was building a product using the Tikit name and could not disclose what it was at that time.

The Respondent denies contacting the Complainant with any such request. He points out that no evidence has been produced to support the allegation that the call came from the Respondent, apart from his name which is publicly available information. He points out that he did not purchase the Domain Name from NetNames. The Respondent also states that the request he supposedly made for re-direction of Internet traffic is unclear and makes no sense to him as expressed in the Complaint. Finally, he points out that even if the call has taken place, simply asking the Complainant to stop using a .com name or failing to reveal what use a domain name is to be put to would not in itself constitute an Abusive Registration.

Use

The Complainant submits that the Domain Name is very important to the trade and brand of TIKIT. It relies on the following grounds in support of its case based on abusive use:

- (i) The Respondent has opted out of providing contact details on the WHOIS database and the Complainant cannot contact him;
- (ii) When a web search is conducted for the Domain Name the OpenDNSguide web page reports “Hmm, www.tikit.co.uk isn’t loading right now”. A copy of the website is annexed to the Complaint confirming this position. As the Complainant is a leading supplier of IT services this presents a very poor image to its clients.
- (iii) Any emails sent to the Complaint’s employees with the suffix .co.uk or marketing@tikit.co.uk would be bounced back to the sender. The Complainant asserts that it believes that it has lost between 2 to 4 email enquiries a day due to this confusion and that this presents a very poor image to potential clients, suppliers or investors.

The Respondent states that it had every right to opt out of providing public contact details on the WHOIS database. He also submits that he has demonstrated an intended use of the Domain Name through acquisition of the alphanumeric telephone number referred to above in section 4 of this Decision.

6. Discussions and Findings

Under clause 2 of the Policy a Complainant must establish on the balance of probabilities that:

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

Considering each of these requirements in turn:

Rights

Rights are defined in clause 1 of the Policy as including, but not limited to, “rights enforceable by the Complainant whether under English law or otherwise”. The Complainant has established that it has registered trade mark rights in the UK in the TIKIT mark and that this mark is identical to the Domain Name (it being customary to ignore the “.co.uk” suffix). The Complainant’s trade mark registration therefore provides a bona fide basis for the Complaint.

For completeness, the Expert also finds that on the information before her the Complainant owns unregistered Rights in the goodwill generated by the TIKIT mark in the IT and legal/accountancy sectors. The Complainant has used the TIKIT mark for approximately 15 years and operates a successful international business in a specialist marketplace.

The Complainant has therefore established that it has Rights in a mark that is identical to the Domain Name. The first element of the Policy has accordingly been satisfied.

It should be noted that the Rights that have been established relate to the Complainant's field of activity.

Abusive Registration

Abusive Registration is defined in clause 1 of the Policy as follows:

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 or was unfairly detrimental to the Complainant's Rights.

The Complainant seeks to establish that the Domain Name is an Abusive Registration on both of these grounds.

Clause 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Of relevance to this matter are the following factors:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant;
- ii. Circumstances indicating that the Respondent is 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 by or authorised by, or otherwise connected with the Complainant.

Registration of the Domain Name

In the Appeal decision DRS 04331 (verbatim.co.uk), the appeal panel considered the “knowledge” and “intent” that may be required on the part of a respondent to constitute an Abusive Registration under the Policy. It observed as follows;

“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.”

In this matter there is no evidence before the Expert to suggest that the Respondent was aware of the Complainant’s business when he secured the registration in November 2010 or that he knew that the Complainant’s failure to renew its registration was inadvertent. Nor is there anything to suggest that Nominet’s standard renewal and cancellation procedures were not followed. The Respondent says that he was not aware of the Complainant’s circumstances. Under paragraph 8.13(5) of the Verbatim decision (quoted above) the Expert is required to scrutinise the credibility of this denial to discern whether, on the

balance of probabilities, the relevant degree of knowledge or awareness was present. In the Expert's view the Respondent's denial of knowledge is credible. The Complainant is not a household name. It operates very successfully, but in a specialist field of activity. There is nothing to indicate that the Respondent has a connection with the supply of support/IT services to the legal and accountancy sector such that might make him aware of the Complainant. On this basis, it is likely that the Respondent simply became aware that the Domain Name was available in November 2010 and legitimately secured the registration. This in itself does not amount to taking unfair advantage of the Complainant, nor can it be said to be unfairly detrimental to its Rights.

The Nominet DRS does not serve the function of a safety net, automatically catching every inadvertently cancelled domain name. It only does so where "second hand" domain names have been registered or used abusively. If the Expert were to adopt the Complainant's submissions she would effectively be allowing any and all parties who have inadvertently allowed a registration to lapse to recover that position by indirect means. This would be inconsistent with Nominet registration procedures which clearly state that after a period of suspension an un-renewed domain name will be cancelled and will then be immediately available for re-registration by a third party. It would also be unfair to third parties who have re-registered the cancelled domain name in good faith.

In relation to the submission that the Respondent registered the Domain Name to stop the Complainant using the TIKIT mark, the Expert again finds that the Complainant has failed to make out its case on the balance of probabilities. As stated above, there is no evidence that the Respondent was aware of the Complainant when it secured the registration. In relation to the disputed telephone conversation in December 2010 there is a lack of clarity about the contents of any conversation which the Expert cannot resolve on the basis of the information provided. Even on the Complainant's case, the Respondent is not recorded as having made any threats in relation the Complainant (or its TIKIT mark) or any demands for money. There is nothing to sustain a finding that the registration of the Domain Name constituted an Abusive Registration under the Policy.

Use of the Domain Name

The Respondent has not made active use of the Domain Name to-date. It does not appear to have been directed to a parking page or put to any such similar use. The Complainant refers to email to a .co.uk address bouncing back. There is nothing to indicate that email is actually being received by the Respondent. The Complainant's submission is therefore essentially based on the fact that the Domain Name's *lack of use* is creating a poor impression with parties seeking to communicate with the Complainant. The Expert notes the Complainant's submissions that the TIKIT mark is vital to its business and that it estimates it is losing business enquiries as a result of the Domain Name being inactive. But it must be said that the Complainant's lack of control of the Domain Name is a situation of its own making.

Clause 3(b) of the Policy provides that failure on the Respondent's part to use a domain name is not in itself evidence that the domain name is an Abusive Registration. It follows that in the absence of any indications of bad faith on the part of the Respondent it cannot be said that the lack of use is in itself unfair.

The Respondent states that he intends to use the Domain Name but no details are given about his plans. The question arises whether this amounts to a threat to make use of the Domain Name in a way that could constitute an Abusive Registration. However there is no information about the type of activity that the Respondent might engage in and the Expert is not of the view that *any* use of the Domain Name would inevitably damage the Complainant's Rights. The Rights have been established in relation to the Complainant's business activity. If the Respondent were to engage in an unrelated field of activity one could not predict with any degree of certainty that unfair detriment to the Complainant's mark would occur or that the Respondent would be taking unfair advantage of the Complainant's Rights.

It follows that the Expert finds that the Complainant has not made out its case on abusive use on the balance of probabilities.

For completeness there are three additional matters relevant to this matter:

Firstly, the Expert does not accept the Complainant's suggestion that the Respondent's decision to opt out of providing public contact details for the WHOIS database is reprehensible. The Respondent is entitled to take this position under Nominet procedures.

Secondly, the Expert does not find that the acquisition by the Respondent of an alphanumeric telephone number featuring the word TIKIT in itself demonstrates a genuine intention to use the Domain Name in relation to goods and services. This does not impact on the Expert's decision that the Complainant has not established its case on Abusive Registration.

Thirdly, for the avoidance of doubt, this Decision is made on the basis of the Respondent's use of the Domain Name as it currently stands. It is not an indication that the Respondent will be able to make whatever future use of the Domain Name he chooses without contravening the Policy. If circumstances were to change this decision would not be a block to a new Complaint being filed.

7. Decision

Whilst the Complainant has established Rights in a name that is identical or similar to the Domain Name, it has not proved on the balance of probabilities that the Domain Name in the hands of the Respondent is an Abusive Registration.

Accordingly, the Expert directs that no action be taken in respect of the Complaint.

Signed Sallie Spilsbury

Dated 19 April 2011