

DISPUTE RESOLUTION SERVICE

D00010339

Decision of Independent Expert

9 LTD

and

XYZ Invest LLC

1. The Parties:

Lead Complainant: 9 LTD
Address: Cliveden Chambers
Cliveden Place
Longton
Stoke on Trent
ST3 4JB
Country: United Kingdom

Respondent: XYZ Invest LLC
Address: 318 N Carson Street 208
Carson City
Nevada
89701
Country: United States

2. The Domain Name:

9.co.uk (“Domain Name”)

3. Procedural History:

29 September 2011	Dispute received
30 September 2011	Complaint validated and notification sent to the parties
21 October 2011	Response received
24 October 2011	Notification of response sent to the parties

26 October 2011	Reply received and notification sent to the parties
26 October 2011	Mediator appointed
1 November 2011	Mediation started
8 November 2011	Mediation failed
16 November 2011	Steve Ormand appointed as Expert

Nominet's standard procedure when it receives short complaints or complaints which do not have supporting evidence is to invite the complainant to review its case. Nominet did so in this Complaint by email dated 30 September 2011. The Complainant responded to Nominet by email dated 30 September 2011 declining Nominet's invitation and requesting Nominet to forward the Complaint to the Respondent.

The Respondent refers in its Response to correspondence that it alleges took place between Nominet and the Complainant prior to, during and after the auction of short domain names and that such correspondence concerns the Complainant's trade mark in the mark "9". The Respondent requests that, for the purposes of neutrality of the DRS, Nominet should disclose this correspondence to the Expert. This is contrary to the Procedure; it is the responsibility of the parties to make out their respective cases and to provide supporting evidence.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the "Policy") and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the "Procedure") unless the context or use indicates otherwise.

4. Factual Background

The Complainant is a company incorporated under the laws of England and registered on 19 August 2010. It is listed at Companies House as "Non Trading". The Complainant's business is not stated in the Complaint save that a quoted webpage indicates involvement in the insurance industry and provides a link to insurance services provided by what appears to be another organisation.

The Complainant has a registered UK trade mark dating from January 2011 in respect of the name '9'.

The Respondent acquired the Domain Name, by way of a bidding agent, in the recent Nominet auction of short domain names. The Domain Name was registered on 29 September 2011. The Respondent does not state anything about its business.

5. Parties' Contentions

The Complaint

The Complainant contends that it has Rights in the name '9' because:

1. It is the owner of a UK trade mark registration no. 2556343 for '9' (registered 19 August 2010).
2. The company, 9 Ltd, has been registered in the United Kingdom with company number 05208323 since 17 August 2004.
3. It has used the trade mark '9' with the domain name www.9.ltd.uk since late 2010.

The Complainant contends that the Respondent's registration and/or use of the Domain Name is an Abusive Registration because:

1. The Complainant attempted to purchase the Domain Name in the auction operated by NFPA and its bid was the highest on 12 separate occasions but it was outbid by a domain speculator who has now sold/transferred the Domain Name to a foreign domain investment company who has no legitimate rights to the Domain Name.
2. The Domain Name was acquired by Domain-for-sale.co.nz and transferred within a few hours which is sufficient evidence of abuse.
3. The Respondent also owns 1.co.uk, 5.co.uk, 7.co.uk, I.co.uk, s.co.uk, t.co.uk which is further evidence of bad faith.

The Response

The Respondent contends that its registration and use of the Domain Names is not an Abusive Registration because:

1. This is a transparent scheme of gamesmanship by which the Complainant's sole aim is to acquire the Domain Name, and other domain names, following the recent release by Nominet of single-letter and short domain names by auction.
2. The 'bad faith' allegation is that the Respondent prevailed in an auction conducted under Nominet's policies. The Complainant admits to participating in the auction was thus bound by the terms of participation.
3. As shown in DRS 10367 brought by the Complainant in relation to single numerical digit .co.uk domain names for 1, 5 and 7 there is no particular 'bad faith' attributable to the respondent whose actions and identity are interchangeable with any party who would and did prevail in the Nominet auction of these single digit domain names and of course for which domain names their acquisition, followed immediately by the proceeding, had precluded development. The Complainant does not allege how the registration of these domain names constitutes a violation of the Complainant's claimed trade mark rights.
4. The Complainant is a domain name speculator and something of a trademark registration speculator.
5. In the lead up to the release of single digit domain names, the Complainant was disqualified from the Nominet 'sunrise' policy concerning such domain names.
6. The Complainant's point is that it alone is entitled to a monopoly in the numeral '9' regardless of any other considerations.
7. The Complainant's trade mark 2556343 is registered in connection with, amongst other things, "financial services, insurance services, monetary affairs ...". The Complainant provides no information concerning these activities or how the mark is used. There is no suggestion in the Complaint that there is any actual underlying goodwill among any customers and no evidence that the mark has been used for any purpose.
8. The Complainant is the registered owner of the following UK trade mark registrations for the same class of services in each case:
 - a. 2556343 "9" (filed 19/8/10, registered 19/11/10)
 - b. 2560534 "8" (filed 5/10/10, registered 7/1/11)
 - c. 2560535 "7" (filed 5/10/10, registered 18/2/11)
 - d. 2560537 "6" (filed 5/10/10, registered 7/1/11)
 - e. 2560538 "5" (filed 5/10/10, registered 7/1/11)
 - f. 2560539 "4" (filed 5/10/10, registered 7/1/11)
 - g. 2560540 "2" (filed 5/10/10, registered 28/1/11)

- h. 2560541 "1" (filed 5/10/10, registered 28/1/11)
 - i. 2560542 "0" (filed 5/10/10, registered 21/1/11)
 - j. 2560543 "O" (filed 5/10/10, registered 7/1/11)
9. It is remarkable that the Complainant claims an exclusive right in each and all of the single digits (save "3") in the Arabic numeral system. The Complainant's motives can be surmised from several other UK trade mark registrations owned by the Complainant, each registered in connection with "Provision of advice and assistance in respect of domain name dispute resolution":
 - a. 2569249 "AB" (filed 17/1/11, registered 22/4/11)
 - b. 2569250 "JB" (filed 17/1/11, registered 22/4/11)
 - c. 2569251 "SB" (filed 17/1/11, registered 22/4/11)
 10. It is thus apparent that the Claim is not based on any underlying bona fide trade or service mark but is merely part of a scheme to collect single digit .co.uk domain names.
 11. The Complainant filed its application to register "9" with the Intellectual Property Office in August 2010, shortly after the close on 8 June 2010 of Nominet's consultation on the release of short domain names. Nominet published the "Release of reserved short domain names update" on 13 September 2011.
 12. The Complainant filed applications to register the above single digit trade marks on 5 October 2010 shortly after publication of the rules under which short domain names were to be released. The trade marks were registered in January 2011. The applications to register the two letter combinations followed.
 13. It is clear that the single digit trade marks are inventions for the purpose of bringing this dispute and parallel disputes. The timing of the trade mark applications suggests motivation by the Nominet short domain name release consultation rather than a desire to protect actual commerce in connection with these claims.
 14. The Complainant registered a batch of domain names in October 2010, such as 1from9.co.uk, 5from9.co.uk, 7from9.co.uk consisting of copies of the Complainant's site of 9.ltd.uk. None of these sites involves the sale of insurance or anything other than biographical information about the Complainant's principal and his wife. A link entitled "Get A Quote" merely forwards visitors from each of them to another site britishinsuance.com which is a "lead generation" site for collecting information about persons desiring to purchase insurance. All of these sites were apparently constructed to provide a token use of the single digits which the Complainant claims as his exclusive property.
 15. The Complainant's principal is a cybersquatter having registered, for example, gamesdisney.net among others.
 16. The transparency of the Complainant's scheme is revealed in correspondence to the Respondent's agent dated 1 October 2011 in which the Complainant's principal states "I would be prepared to transfer my Trade Marks for 0, 0, 1, 2, 4, 5, 6, 7 and 9 in exchange for 9.co.uk" and suggests these could be used to go after those other domain names. This suggests the Complainant's interest is something other than the protection of goodwill in any actual business conducted under such marks or consumer recognition.
 17. The Complainant has stated that it intends to bring an identical dispute against the registrant of several of the other single digit .co.uk domain names after appraising the outcome of this Compliant and the proceedings relating to 1.co.uk, 5.co.uk and 7.co.uk.
 18. The Respondent, using a bidding agent, acquired the Domain Name in accordance with Nominet's rules. The fact that the Respondent outbid the Complainant is not abusive activity in relation to the Complainant's limited right in the numeral "9" in connection with the alleged services stated in the trade mark registration.

19. The Respondent has not proceeded with development of the Domain Name as acquisition was immediately followed by threats from the Complainant and the proposal to exchange its other trade marks for the Domain Name. The Respondent does not wish to disclose its development plans for the Domain Name and sees no need to do so since the Complaint does not set out how the Respondent's registration of the Domain Name is abusive.
20. The Respondent has no plan to use the Domain Name in connection with services recited in the Complainant's trade mark registration.
21. The issue of whether a bare registration alone constitutes evidence of goodwill among customers sufficient to allege actual or potential confusion was addressed in DRS 9674 where it was decided that mere registration of a domain name corresponding to a trade mark was insufficient to show consumer diversion amounting to bad faith registration or use.
22. A single digit cannot be considered solely exclusively or distinctive of the Complainant to the extent that mere registration of the Domain Name suggests intent motivated by the Complainant's claimed rights. This is illustrated by the profusion of other UK trade mark registrations incorporating a representation of the numeral "9". The Complainant advances no theory by which the Complainant is not interchangeable with these other trade mark owners in respect of abusive registration. Further, the Respondent is interchangeable with any other party who would have prevailed in the auction.
23. The Complainant advances no theory of how the Respondent's registration is motivated by bad faith and has not alleged any abusive activity in relation to its trade mark.
24. A single digit domain name has a wide variety of uses and a high inherent value. That is why Nominet auctioned these names and laid down sunrise rules, for which the Complainant did not qualify.
25. For the reasons set out above the Respondent submits that the Complainant has not met its threshold burden on any head of the Policy.

The Reply

The Complainant replied to the Response as follows:

1. 9 Ltd is a wholly owned subsidiary company of British Money Limited, formerly the British Life Office, a life insurance company registered in Scotland in 1896. 9 Ltd was acquired by British Money on 19/8/10 with the sole intention to provide Nine low cost, essential insurance policies to pregnant women. On the exact date of 9 Ltd's acquisition, an application for a Trade Mark for '9' was made for this purpose.
2. The Complainant cannot consider launching this new venture without the Domain Name. The Complainant currently uses the domain 9.ltd.uk but believes that this is not fit for purpose as it does not convey the gravitas and professionalism that would be required to ensure this venture is a success. The Complainant has set 9.ltd.uk to lapse at renewal and will wind up 9 Ltd if it is unsuccessful in this dispute. In the interim, 9.ltd.uk has a link to British Insurance, a former company of the Complainant's proprietor, with whom 9 Ltd has an agency to sell insurance. It has been stated that Britishinsurance.com is a lead generation site but this is incorrect, it is fully transactional and sells vast quantities of redundancy insurance to UK consumers.
3. To date this is the only numeral Trade Mark for '9' in the UK and Europe, the small number of others being logos and devices containing the mark text '9'.

4. Furthermore, to obtain the maximum possible protection for this venture, it was decided by the directors of 9 Ltd to obtain Trade Marks for each of the individual products. For example, '1' being for life insurance, '2' for health insurance etc.
5. It has been stated that the Complainant's proprietor is a "a domain speculator," "trade mark registration speculator" and a "cybersquatter". This is completely untrue. The domain name: www.gamedisney.net may have been registered by a person called Simon Burgess but this is not the Complainant's proprietor who is completely unaware of this or any other cybersquatting activity. The Complainant's proprietor is a widely recognised consumer champion with awards for Business Ethics and Excellence, as well as being a pre-eminent business leader who is allowed by the Secretary of State for Business to use the word 'British' as a company and trading name, who only registers trade marks and domain names in good faith for the legitimate use of his business activities.
6. It has been alleged that the Complainant's proprietor has been engaged in "mere gamesmanship". This is not true. In order to achieve a speedy resolution, he was and is prepared in the spirit of openness to transfer the less important trade marks to obtain 9.co.uk. What he has not been prepared to do is to swap 9.co.uk for other domains in his portfolio as suggested by the Respondent's representative in order to fulfil its avaricious desire to collect a full alphabet of single letter domains with "high inherent value".
7. The following web pages support the Complainant's assertions:
 - a. www.britishmoney.com/simon-and-sara-ann-burgess
 - b. www.britishmoney.com/awards

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test 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.*

Complainant's Rights

Rights is defined in §1 of the Policy 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.

The wholly generic suffix ".co.uk" is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant presents no evidence to support its claim to registered rights in the mark "9" and makes no claim to any unregistered rights and/or goodwill arising from its use of

the mark. The Respondent has, however, submitted evidence in the Response of the Complainant's registered rights in the mark.

I find it impossible to judge from the papers before me, and from the websites quoted in the Complaint and Reply, whether the mark "9" is descriptive of the Complainant's business but on the basis of those papers and websites I am satisfied that it has not acquired a secondary meaning that is distinctive of the Complainant's products or services.

Nevertheless, it is well established that the first limb of the test pursuant to §2 of the Policy is a low threshold to overcome and I am satisfied that the Complainant has sufficient Rights in the mark "9" to found a complaint on the basis of its registered trade mark. Accordingly, I find that the Complainant has Rights in a mark which is identical to the Domain Name, save for the addition of the generic suffix, and which predate the Respondent's registration of the Domain Name.

Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

1. *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*
2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3 of the Policy.

The Complaint is extremely short and presents nothing more than stating the name and registration date of the company 9 Ltd, brief details of the trade mark "9" and a bare assertion of Abusive Registration. Despite Nominet's suggestion, the Complainant declined the opportunity to provide additional information and evidence to support its Complaint.

The Complainant's allegation of Abusive Registration is based on:

1. the Respondent's acquisition via a bidding agent of the Domain Name from the operation of Nominet's auction in the recent short domain name release process; and
2. the Respondent owning other single digit domain names.

The Complainant has not put forward any satisfactory explanation, provided sufficient details of, nor offered any evidence to support its allegation. There is nothing in the papers before me to show that the Respondent's acquisition of the Domain Name took unfair advantage of or was unfairly detrimental to the Complainant's Rights or that the Respondent knew of the Complainant's Rights at that time. Nor is there anything to show that the Respondent's ownership of other single digit domain names indicates a pattern of abusive registrations.

It is a well established principle that in the case of a purely generic or descriptive term, or a dictionary word, it requires a much higher level of evidence to establish that the use of

such a term or word in a domain name is abusive. In DRS 04884 (maestro.co.uk) the Appeal Panel observed “Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning the evidence of abuse will have to be very persuasive, if it is to be held an Abusive Registration under the DRS Policy.” Furthermore, it is possible to make fair use of a domain name where that name is also the complainant’s trade mark. For example, where the complainant’s name or mark is a dictionary word and not well known and the respondent reasonably registered and has been using the domain name in ignorance of the complainant’s rights.

These principles in relation to generic, descriptive and dictionary words must hold true in respect of the single digit and short domain names released by Nominet. The Complainant has not presented any evidence to overcome the hurdles presented by such principles.

The Respondent, for its part, has submitted a rather lengthy Response in which it does not present any evidence to explain its reasons for the registration or acquisition of the Domain Name and states that it sees no need to, and in any case does not wish to, divulge its plans for the Domain Name save to say that its plans do not involve the business services in which the mark is registered. The Respondent states that it has not yet commenced development of the Domain Name. It is not necessary for me to deal with the Response any further.

The Complainant’s Reply does not present anything to support its allegations of Abusive Registration.

For the reasons set out above, and the lack of any evidence in support of the Complainant’s assertion, I find that the Complainant has failed to make out its case of Abusive Registration in the Complaint and has failed to satisfy the second limb of the test required by §2 of the Policy.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical to the Domain Name, but has failed to show that the Domain Names, in the hands of the Respondent, is an Abusive Registration, I direct that no action is taken in relation to the Domain Name.

Signed

Steve Ormand

Dated: 5th December 2011