

## **DISPUTE RESOLUTION SERVICE**

**D00010732**

### **Decision of Independent Expert (Summary Decision)**

Allie Smith t/a Funnyzulus

and

**BJ COMPUTERS (UK) LIMITED**

#### **1. The Parties:**

Complainant: Allie Smith t/a Funnyzulus  
Flat 20, 279 Seven Sisters Road  
London  
Hackney  
N4 2DE  
United Kingdom

Respondent: BJ COMPUTERS (UK) LIMITED  
259 EVERS Holt STREET  
LONDON  
LONDON  
NW1 1BA  
United Kingdom

#### **2. The Domain Name(s):**

funnyzulus.co.uk

### 3. Notification of Complaint

I hereby certify that I am satisfied that Nominet has sent the complaint to the respondent in accordance with paragraphs 2 and 4 of the Procedure.  Yes  No

### 4. Rights

The complainant has, to my reasonable satisfaction, shown Rights in respect of a name or mark which is identical or similar to the Domain name.

Yes  No

### 5. Abusive Registration

The complainant has, to my reasonable satisfaction, shown that the domain name funnyzulus.co.uk is an Abusive Registration

Yes  No

### 6. Other Factors

I am satisfied that no other factors apply which would make a summary decision unconscionable in all the circumstances

Yes  No

### 7. Comments (optional)

The Complainant must satisfy two basic conditions in the DRS Policy: firstly, that he has "Rights" as defined by the DRS Policy and, secondly, if successful on this first point, that the Respondent has made an "Abusive Registration", again as defined by the DRS Policy. For convenience, "Rights" are defined in the DRS Policy as meaning "Rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

In this case, the Complainant has based his Rights on two matters. The first is a trade mark registration. However, the document on which the Complainant relies is not a trade mark registration but a letter from the Intellectual Property Office dated 21 December 2009 acknowledging receipt of the Complainant's application. It may well be that the Complainant subsequently received a registration of the mark, but this document does nothing to prove it (in paragraph 15 of the draft Particulars of Claim produced by the Complainant, he asserts that he made a successful trade mark application, although it is not clear that this is the same trade mark application: at paragraph 27 of the draft

Particulars of Claim he also refers to an eagle and a cock as further logos which he had designed).

In any case, there is a more fundamental objection to this trade mark as constituting Rights and that is that it is a device mark and does not consist of any words at all. The device is hard to describe but it bears the letters "AS" in a sort of monogram, corresponding to the Complainant's initials. It has nothing whatsoever to do with "funnyzulus" and a third party looking at the device would not reasonably associate it with "funnyzulus". As paragraph 2.a.i of the DRS Policy makes clear, the "Rights" have to be "in respect of a name or mark which is identical or similar to the Domain Name". What this letter discloses has nothing whatsoever to do with the Domain Name. It is true that the Complainant's reference at the top of the letter refers to "www.funnyzulus.com" [sic] and it may well be that the Complainant intended to use the device in connection with the Domain Name, but this is not relevant. The device as disclosed in this letter is not identical with or even remotely similar to the Domain Name.

There is no other evidence of actual use of trade or usage of anything identical with or similar to the Domain Name which might lead to common law rights (for example, the right to bring an action in passing off), such as would constitute "Rights" for the purpose of the DRS Policy. The Complainant has stated that he started to advertise the Domain Name in November 2010 and "gained or drove traffic" to it, but has provided no details of this and it is simply impossible to say whether or not any Rights have arisen, even taking into account the fact that "Rights" is a relatively low threshold to cross.

The second basis on which the Complainant seeks to assert "Rights" is to say that he is entitled as against the Respondent to transfer of the Domain Name as a consequence of a contract (or contracts) he entered into with the Respondent. In a long and somewhat disjointed draft Particulars of Claim, the Complainant has set out a wide variety of claims against the Respondent (and against two other defendants) but the essential claim is that the Complainant believes he is entitled to the Domain Name as a result of "... partly written and partly oral terms of the contracts for the registrations of his domains ..." (paragraph 1). Similar points are made in paragraphs 4, 19, 24, 31 and 62 as well as elsewhere in the draft pleading.

While it is true that contractual entitlements may constitute "Rights", there are some limitations as may be seen from the DRS Policy's Appeal Panel in DRS 04632. The Appeal Panel there envisaged that contractual entitlements could give rise to complex questions of fact and/or law which the DRS Policy is inappropriate to determine.

The problems anticipated by the Appeal Panel in that case are well illustrated here: the Complainant asserts that the contract or contracts in question were partly oral and partly written, but does not provide precise details as to what was agreed orally. Furthermore, many of the documents he relies on as containing the terms of the contract have nothing to do with a contract: of the various documents the Complainant provides as containing the terms of the

alleged contract, none is actually a contract. The closest is an invoice (Exhibit 158) but this is for a “fee for checking the domain and requesting the transfer for DNS ...” [sic]. Note that the services are described as for checking and requesting a transfer, not actually transferring and it is not clear what the proposed object of the transfer is. In other documents, the Respondent seems to be talking about transferring the contents of a website rather than the Domain Name itself and those communications take place after the contract rather than showing what the terms of the contract actually were. The other documents relied on by the Complainant as containing the terms of the contract seem to have nothing to do with containing a contract at all, for example, Exhibit 115, which is a court order and nothing to do with a contract.

In reality, this is a wide-ranging and complex dispute between the Complainant and the Respondent (among others) whose breadth and complexity is amply shown by the Complainant’s draft Particulars of Claim. It is really a matter best left to the courts to resolve this sort of dispute, as only the courts have procedures allowing for cross-examination of witnesses (and disclosure of evidence) which enable the courts (as opposed to an Expert within the DRS Policy) to come to a fair decision on such issues as the existence or the terms of a contract.

I therefore find that the Complainant has not established that he has “Rights as required by the DRS Policy. For that reason, it is not necessary to consider whether the Respondent’s registration is an Abusive Registration.

## 8. Decision

Transfer	<input type="checkbox"/>	No action	<input checked="" type="checkbox"/>
Cancellation	<input type="checkbox"/>	Suspension	<input type="checkbox"/>
Other (please state)	<input type="checkbox"/>		

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Signed: Richard Stephens

Dated: 1 March 2012