

The

DISPUTE RESOLUTION SERVICE

D00011507

Decision of Independent Expert

Mines Rescue Service Limited

and

Garth Piesse

1. The Parties:

Lead Complainant: Mines Rescue Service Limited
The Mansfield Mines Rescue Station
Leeming Lane South
Mansfield Woodhouse
Mansfield
Nottinghamshire
NG19 9AQ
United Kingdom

Respondent: Garth Piesse
PO Box 181
Palmerston North
Manawatu
4440
New Zealand

2. The Domain Name(s):

minerescue.co.uk

3. Procedural History:

21 June 2012 13:08 Dispute received
26 June 2012 09:26 Complaint validated
26 June 2012 09:28 Notification of complaint sent to parties
12 July 2012 13:21 Response received
12 July 2012 13:21 Notification of response sent to parties
17 July 2012 02:30 Reply reminder sent
20 July 2012 09:14 No reply received
20 July 2012 09:14 Mediator appointed
25 July 2012 09:26 Mediation started
26 July 2012 11:47 Dispute resolved during mediation
31 July 2012 14:22 Dispute opened
31 July 2012 14:23 Mediation failed
03 August 2012 09:34 Close of mediation documents sent
15 August 2012 09:40 No expert decision payment received
24 August 2012 12:27 Expert decision payment received

The Complaint in this matter is presented very briefly. On 21 June 2012, Nominet sent an email to the Complainant drawing the Complainant's attention to Nominet guidance about bringing a complaint and inviting the Complainant to review the way in which it had presented its case. The Complainant did not amend its Complaint.

4. Factual Background

The Complainant held the registration of the Domain Name until the first part of 2012 when, due to an apparent administrative oversight, its registration was not renewed and was subsequently cancelled.

The Respondent is in the business of buying, selling and what it terms, "monetising" domain names. It owns many domain names. On 21 June 2012, following cancellation of the Complainant's registration, it registered the Domain Name. The Complainant disputes the validity of this registration.

5. Parties' Contentions

The Complainant

The Complainant asserts Rights in the Domain Name by virtue of the following:

- (a) the Complainant owned the Domain Name registration until it was cancelled, and
- (b) the Complainant is the owner of the domain name www.minesrescue.com.

The Complainant submits that the Respondent's registration of the Domain Name is abusive for the following reasons:

- (a) The Respondent operates a domain selling business which is not based in the UK and which has no connection to the Domain Name
- (b) The failure to renew the registration of the Domain Name was an error. The Complainant's system inaccurately listed the renewal date as being two months later than the correct date and the Complainant received no warning that the Domain Name was due to expire.

The Respondent

The Respondent asserts that the Complaint has not established that it has Rights in a name which is identical or similar to the Domain Name. In support of this submission it relies on the following:

- (a) The term "mines rescue" is a generic and descriptive term denoting mine rescue activities. The public has no reason to associate the term with the Complainant. There are a proliferation of businesses and organisations using the terms "mines rescue" and "mine rescue" in the UK and internationally. The Respondent attaches snapshots of websites for some of these organisations as Exhibits to the Response. The Exhibits include webpages at *minerescue.co.uk* which forwards to the website of a UK business branded "Mines and Industrial Emergency Centre/Rescue Centre" and *minerescue.net*, which forwards to a business offering rescue related technology.
- (b) Under the Nominet Dispute Resolution Policy (the Policy) "Rights" are defined to include rights in descriptive terms which have acquired a secondary meaning. However, the term "minerescue" is so generic and descriptive that it is incapable of generating secondary rights or, alternatively, the Complainant has not demonstrated that a secondary meaning has emerged.

The Respondent disputes that the Complainant has established that the registration of the Domain Name is an Abusive Registration. In support of this submission it relies on the following:

1. The Complainant's only argument on abusive registration is that the Respondent is a non-UK "domain selling company" which has "no tie to the domain name at all". This is a misunderstanding of how the domain name system works. There is no requirement that the registrant of a .co.uk domain name must be based in the UK or that a registrant must have any "tie" to the domain name. Indeed paragraph 4d of the Policy observes that "trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities."
2. The Respondent registered the domain name on becoming aware that the domain name was on a list of domains which were about to "drop". It assumed that the previous owner no longer wanted it. The Respondent thought it a potentially attractive generic domain name

to have. The Respondent already owns a large number of similar generic training / rescue-related domain names as well as mining-related domain names including miningconsultants.co.uk, undergroundtraining.co.uk, projectrescue.co.uk and safetymatters.co.uk

3. The Respondent had in mind to profit from advertising links aimed at people interested in mine rescue issues and ultimately to sell the domain name at some point to someone with an interest in that area. Accordingly, the Respondent set up a standard parking page with a “for sale” notice.
4. The Respondent was not aware of the Complainant when it registered the Domain Name on 21 June 2012. The Complainant only came to the Respondent’s attention when it made the Complaint. The DRS appeal panel in verbatim.co.uk (DRS 4331) analysed previous DRS appeals and concluded at paragraphs 8.13-14 that: “...for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name.” In accordance with verbatim.co.uk the Complainant has failed to get to first base as it has not even suggested, let alone demonstrated, that the Respondent was aware of the existence of the Complainant on registration of the domain name.
5. Even if the Respondent had become aware of the Complainant’s activity on registration that would still not have sufficed to give rise to an Abusive Registration. See, the Appeal Panel decision in oasis.co.uk (DRS 6365), where the panel said at paragraph 8.10:

“...absent any evidence that the Respondent was purchasing the Domain Name as part of some sort of deliberate scheme to take advantage of the Complainant's established name and business even had the Respondent known of the Complainant's business that does not itself make the purchase of a Domain Name, which comprises an ordinary English word, objectionable. This is not a case where the word is a made up word which, if contained within a domain name, inevitably raises at least an inference that it will be associated with the party most commonly associated with the word. In such cases an Expert can infer that the purpose of the purchase was to take advantage of that connection. It would for example be relatively easy to infer (at least absent any credible explanation) that a third party purchasing, say, kodak.co.uk intended to take advantage of the name and reputation enjoyed by the well known Kodak company. The same is not true where the name comprises a common English word where any number of uses may be perfectly

unobjectionable – particularly where, as here, the evidence shows a large number of trade marks for that word co-exist.”

In this case, the Domain Name is an obvious descriptive term in common use by other businesses and there is no evidence of abuse.

6. Discussions and Findings

Under Paragraph 2 of the Policy in order for the Complainant to succeed, it must establish on the balance of probabilities, both:

that it has Rights in respect of a name or mark which is identical or similar to the Domain Name, and

that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Rights are defined in Paragraph 1 of the Policy as follows;

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

If the Complainant satisfies the Expert on the balance of probabilities that it has relevant rights, the Expert must consider whether the registration and/or use of the Domain Name by the Respondent are abusive.

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

“Abusive Registration means 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”.

The basis on which the Expert will proceed

Clause 2 b. of the Policy provides that the Complainant is required to prove to the Expert that both elements are present (Rights and Abusive Registration) on the balance of probabilities. This is made clear to potential complainants in guidance issued by Nominet, for example in the DRS Experts Overview of the Policy which can be found on the Nominet website. It was drawn to the Complainant's attention by the email sent by Nominet dated 21 June 2012 which advised the Complainant to review its case in the light of the brevity of the Complaint. The Expert finds that the Complainant has been given every opportunity to develop its

Complaint. It is not part of the Expert's role to carry out independent research to support submissions or to make good the case that a party to a dispute has presented. The Expert will accordingly proceed solely on the basis of the Parties' submissions and the evidence provided to her.

Rights

The Complainant bases its submission that it owns Rights in a mark which is identical or similar to the Domain Name on its former ownership of the Domain Name (prior to cancellation of the registration) and its current minesrescue.com registration. This is not a valid supposition. In and of itself a domain name registration will not constitute Rights in the underlying mark or brand that make up the domain name (the MINESRESCUE mark in this case). The registration of domain names on the .co.uk and .com registers does not require a registrant to demonstrate a link to a particular domain name as a condition of registration. This means that in itself a registration does not confirm ownership of the underlying mark or brand. A domain name registration alone will not ordinarily afford the proprietor a right to prevent others from using a mark or brand that makes up a domain name. This is important because Rights are defined by the Policy as meaning *enforceable* rights in a mark which is identical or similar to a domain name (see the definition section of the Policy set out above). By basing its case purely on past and current domain name registrations the Complainant has failed to demonstrate that it has enforceable rights that are recognised under the Policy.

The Complainant has not provided any information about trade mark registrations covering the MINESRESCUE mark. There is also no information about the Complainant's business. The Respondent is correct when it asserts that on its face the MINESRESCUE mark is descriptive of a type of business. Clear evidence of use of the mark would be required before a finding could be made that the mark had come to be associated with the Complainant (the so-called "secondary meaning" referred to in the definition of Rights in the Policy). But the Expert has not been made aware how long the Complainant has been trading, how it markets itself or how successful its business is. There is nothing to indicate that the Complainant has built up goodwill or a trading reputation that would rise to unregistered rights enforceable through an action in passing off.

The Expert therefore concludes that the Complainant has not demonstrated on the balance of probabilities that it has Rights in a mark which is identical or similar to the Domain Name. The first requirement of the policy has not been met.

Abusive Registration

The concept of Abusive Registration under the Policy is linked to damage to the Complainant's Rights. Given that the Complainant has not established that it has any Rights, it is inevitable that its case on Abusive Registration must also fail. For completeness, the Expert makes the following observations on the Parties' submissions:

The Complainant bases its case on (i) the nature of the Respondent's business as a trader in domain name registrations and its lack of connection to the Domain Name and (ii) the circumstances surrounding the expiry of its own registration of

the Domain Name. The focus of the complaint is on the registration of the Domain Name. There are no submissions about the way that the Respondent has used the Domain Name and the Expert will not consider this matter further in this Decision.

In relation to the first of the Complainant's submissions, the Respondent is correct in its assertion that it is not a condition of domain name registration that it shows a prior link to the Domain Name or that it is based in the UK. The fact that the Respondent is not in the mine rescue business or UK based is, absent any features which indicate abusive intent on its part, irrelevant to the validity of the registration. Nor is the Respondent's business as a trader in domain names in itself an indication of abuse. The Policy makes this clear at clause 4d which provides that; *"Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits."*

There is no evidence to show an improper motivation on the part of the Respondent in securing the registration of the Domain Name. A strong line of authority in decisions of the Appeal Panel make it clear that the Complainant must demonstrate that the Respondent was aware of the existence of the Complainant or its brand at the time of registration of the disputed domain name or at the start of abusive use (see for example verbatim.co.uk DRS 4331). The Respondent has stated that it was unaware of the Complainant when it registered the Domain Name. This has not been disputed by the Complainant and the Expert has no reason to doubt the Respondent's submission.

In relation to the Complainant's second submission, whilst it is unfortunate that it accidentally allowed its registration of the Domain Name to lapse, the Policy does not recognise such an administrative oversight as a ground for defeating the Respondent's prompt registration of the name when it became available.

7. Decision

The Complaint accordingly fails. The Complaint has failed to demonstrate that it has Rights in the Domain Name or that the registration of the Domain Name by the Respondent was an Abusive Registration.

No action to be taken.

Signed Sallie Spilsbury

Dated 19 September 2012