

Nominet UK Dispute Resolution Service

DRS 12107

Siren Films Ltd.

and

David Eadington

Decision of Independent Expert

1 Parties

Complainant: Siren Films Limited

Address: 5 Charlotte Square
Newcastle upon Tyne

Postcode: NE1 4XF

Country: United Kingdom

Respondent: David James Eadington

Address: Cove Cottage
Watermillock
Penrith
Cumbria

Postcode: CA11 0LS

Country: United Kingdom

2 Domain Name

<sirenfilms.co.uk>

3 Procedural History

- 3.1 On 2 November 2012 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent on 5 November. The respondent responded on 19 November 2012, and the complainant replied on 26 November. The matter was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 13 December 2012 paid the applicable fee.
- 3.2 I was appointed as expert on 20 December 2012. I have made the necessary declaration of impartiality and independence.

4 Factual background

- 4.1 The complainant was incorporated in 2002. It makes films about the behaviour and learning of young children for universities, colleges and local authorities.
- 4.2 Before 2009 another company called Siren Film and Video Limited (“SFV”) was in existence. Its assets were transferred to the complainant in 2008.
- 4.3 The respondent registered the domain name on 18 December 2000 while working as a member and/or director of SFV. He left in 2005.
- 4.4 In July 2012 the complainant paid the respondent £500 to use the domain name for a year.

5 Parties’ Contentions

Complainant

- 5.1 The complainant argues that it began business in 1985, as SFV, and argues that in effect it is the same operation. It says it has always used the domain name, and traded as “Siren Films”.
- 5.2 Although the corporate entity through which “Siren Films” trades has changed, the complainant argues, the nature of the business remains the same as it was before the respondent left in 2005. The change from SFV to the complainant came about, it says, simply because it was felt advantageous to trade through a company limited by shares, rather than (as SFV was) a company limited by guarantee. Apart from the respondent, the complainant says the people involved have not changed.
- 5.3 The complainant argues that the website connected to the domain name while the respondent was still a director advertised the same kind of child development films as are advertised there now.
- 5.4 The complainant says the domain name was registered by the respondent on behalf of SFV. Between 2000 and 2005, it says, the respondent arranged for

renewal fees in relation to the domain name to be paid on behalf of SFV and the complainant.

- 5.5 The complainant says the respondent was one of its directors before he left. It has produced evidence in the form of a letter dated April 20 2005 that the respondent accepted voluntary redundancy from both SFV and the complainant and relinquished all claims to the property, intellectual or otherwise, of both. It argues that the domain name is an asset of the business, now owned by the complainant.
- 5.6 The complainant says that it or SFV has paid the registration and renewal fees for the domain name each year since then.
- 5.7 The complainant has produced evidence that on 22 June 2012, the respondent wrote to say that if it wished to continue using the domain name, he would require £500 a year; and that if he did not hear from it, it would not be able to use the domain name after 1 July 2012. The complainant says it felt held to ransom, and agreed.
- 5.8 The complainant says it is concerned that the respondent may disrupt its business if further sums are not paid.
- 5.9 In terms of the Policy, the complainant cites paragraph 3(a)(v). It says the domain name was registered as a result of the relationship between it and the respondent; it has been using the domain name exclusively, and has paid for the registration and renewal of the domain name.
- 5.10 It says the respondent is threatening to unfairly disrupt its business, citing paragraph 3(a)(i)(C) of the Policy.
- 5.11 Finally, citing paragraph 3(a)(i)(A) of the Policy, the complainant argues that the respondent is using the domain name for the purpose of renting it to the complainant for valuable consideration in excess of his out of pocket costs directly associated with its use.

Respondent

- 5.12 The respondent says he registered the domain name in 2000 whilst working as a member of SFV, which was a non-profit workers' co-operative. He says he did not register the domain name on behalf of anyone else, and that he paid for the registration.
- 5.13 He says he agreed that SFV could use the name. He says he continued to pay the renewals every two years - not on behalf of anyone else - and that when he left SFV in April 2005 he agreed it, SFV, could continue to use the domain name.
- 5.14 The respondent argues that the domain name never belonged to either SFV or the complainant. He says this was clear to everyone and was not part of any settlement when he left SFV. He says he has not expressly relinquished ownership of it.

- 5.15 The respondent argues that SFV was not the predecessor of the complainant. It was he says a completely different type of company doing a wide variety of work as well as that now done by the complainant.
- 5.16 He says the complainant began using the domain name around 2006 without his knowledge or agreement. In 2008, he says, the members closed down SFV and transferred its assets to the complainant. It then he says began using the domain name without his agreement.
- 5.17 As the domain name was now being used for commercial purposes, the respondent says, he decided he would ask for payment.
- 5.18 In relation to paragraph 3(a)(v) of the Policy, he argues there was no relationship between him and the complainant when he registered the domain name. The complainant was incorporated two years after registration.
- 5.19 In relation to paragraph 3(a)(i)(C) of the Policy, he says he is not threatening to disrupt the complainant's business.

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities 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.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has not produced evidence of any registered trade mark. But it has produced evidence from promotional material of its use of the name "Siren Films", and evidence in the form of press cuttings and copies from other publications that it is recognised by a relevant section of the public under that name. It is not disputed that it has used the domain name for its website for a significant period, and it has produced evidence in the form of a screenshot showing that the website contains a link to information "About Siren Films". In addition it has produced a letter from the respondent dated June 20 2012 in which he refers to it as "Siren Films".
- 6.4 Bearing all that in mind I am satisfied that the complainant has rights in respect of the name "Siren Films".

6.5 At the third level (i.e. disregarding “co.uk”), the domain name is obviously identical to “Siren Films”, or very nearly so.

6.6 In those circumstances I am satisfied that the complainant has rights in respect of a name which is identical or similar to the domain name.

Abusive Registration

6.7 Under paragraph 1 of the Policy, abusive registration means a domain name which either:

- 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
- has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant’s rights.

This definition obviously covers both the time of registration, and later use.

6.8 Paragraph 3(a) of the Policy provides a non-exhaustive list of factors which may be evidence that the domain name is an abusive registration.

6.9 Under paragraph 3(a)(v) of the Policy, there may be evidence of abusive registration if the domain name was registered as a result of a relationship between the complainant and the respondent, the complainant has been using the domain name registration exclusively and that it paid for the registration and/or renewal of the domain name.

6.10 The respondent says he did not register the domain name on behalf of anyone else. But since he admits he registered it at the time he worked for SFV, even if he did not do so for the company he must have done so as a result of his relationship with it. Otherwise, his choice of the domain name makes no sense. I am satisfied that the domain name was registered as a result of the relationship, and if what the respondent says in his response is intended to suggest otherwise, I reject it.

6.11 Of course SFV is not the complainant. But I have no hesitation in accepting the complainant’s argument that it is the legitimate successor of SFV, and that it is in all but technical reality the same “Siren Films” business, in a different corporate form.

6.12 There is no dispute that the complainant has in fact been using the domain name exclusively since at least 2009.

6.13 Each party claims to have met the cost of registration and renewal before 2012. Neither party has produced any evidence to support its claim, and I make no finding on this point. But the respondent appears not to dispute that the complainant paid for the most recent renewal.

6.14 Paragraph 3(a) is not exhaustive, so an abusive registration can be found in circumstances that do not fall within the strict terms of paragraph 3(a)(v).

- 6.15 For example, in DRS 11589 (gulfkeystone.co.uk), at paragraphs 6.9-11, the expert found there was an abusive registration where the domain name was registered as a result of a complex relationship involving the respondent only indirectly; and in DRS 08862 (digitalvideos.co.uk), at paragraph 6, the expert found there was an abusive registration where the domain name was registered as a result of a relationship between the respondent and a predecessor in business of the complainant and where the complainant paid for the most recent renewal.
- 6.16 In this case, the domain name was registered as a result of a relationship between the complainant's predecessor and the respondent, the complainant has been using the domain name registration exclusively, and it paid for the most recent renewal of the domain name. Bearing in mind the non-exhaustive nature of paragraph 3(a), in my view these factors are evidence that the domain name is an abusive registration.
- 6.17 In addition, in my view the respondent in his letter of June 20 2012 threatened to use the domain name in way that was unfairly detrimental to the complainant's rights, and to unfairly disrupt the complainant's business. In that letter he said he "required" £500 a year and that unless he heard from the complainant it would no longer be able to use the domain name. The clear implication was that he would deny it use of the domain name if his demand for £500 was not met. In my view that would have been unfair in the circumstances of this case.
- 6.18 Bearing in mind the non-exhaustive nature of paragraph 3(a) of the Policy and that, as paragraph 1.3 of the Nominet DRS Experts' Overview says, a threatened abusive use can constitute "use" within the definition of abusive registration in paragraph 1 of the Policy, in my view that letter is evidence that the domain name is an abusive registration.
- 6.19 I have taken account of paragraph 4(a)(iii) of the Policy, which provides that, in relation to paragraph 3(a)(v), it may be evidence that the domain name is not an abusive registration if the respondent's holding of it is consistent with an express term of a written agreement entered into by the parties. In my view this does not help the respondent.
- 6.20 First, although paragraph 4(a) of the Policy is non-exhaustive, no evidence has been produced that such a written agreement exists. Nor is it clear on the evidence I have seen that the complainant's payment of the £500 required by the respondent necessarily amounts to or implies any unwritten agreement or acceptance that he should hold the domain name.
- 6.21 In any event, I accept that the complainant felt held to ransom by the respondent's demand. So even if there were such an agreement I would not, in the circumstances, consider it fair, or evidence that the domain name is not an abusive registration.
- 6.22 It is for the complainant to make good its case. However, for the reasons I have given I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

7 Decision

- 7.1 I find that the complainant has rights in a name which is identical or similar to the domain name; and that the domain name, in the hands of the respondent, is an abusive registration.
- 7.2 The complaint is upheld. I direct that the domain name be transferred to the complainant.

Carl Gardner

15 January 2013