

**DISPUTE RESOLUTION SERVICE**

**D00012265**

**Decision of Appeal Panel**

Dated: 18 March 2013

Norton Peskett LLP

and

Mr Tom Hampson

**1. The Parties:**

Complainant: Norton Peskett LLP  
141 King Street  
Great Yarmouth  
Norfolk  
NR30 2PQ  
United Kingdom

Respondent: Mr Tom Hampson  
14870 Granada Ave  
Apple Valley  
Minnesota  
55124  
United States

## 2. The Domain Name:

<nortonpesket.co.uk> (“the Domain Name”)

## 3. Procedural History

The main steps in the procedure to date in this case have been as follows:

07 December 2012	Complaint received
11 December 2012	Complaint validated
11 December 2012	Notification of Complaint sent to parties
02 January 2013	Response reminder sent
07 January 2013	No Response Received
07 January 2013	Notification of no response sent to parties
09 January 2013	Summary decision payment received
10 January 2013	Expert summary decision
28 January 2013	Appeal Intent notification
05 February 2013	Appeal Notice
19 February 2013	Appeal Response
25 February 2013	Appeal Panel appointment

Tony Willoughby, Philip Roberts and Anna Carboni (together, “the Panel”) have each made a statement to the Nominet Dispute Resolution Service in the following terms:

*“I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.”*

This is an appeal against the summary decision issued on 10 January 2013 in favour of the Complainant.

## 4. The Nature of This Appeal

Paragraph 10(a) of the Policy provides that: *“the appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters”*. The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits. In any event, the decision under appeal was a

summary decision given without reasons, so the Panel is in any event effectively starting with a clean sheet.

In addition to the decision under appeal, the Panel has read the Complaint dated 7 December, 2012 (with annexes), the Appeal Notice filed on 5 February, 2013, the Appeal Response filed on 19 February, 2013 and sundry correspondence between the parties and Nominet.

## 5. Formal and Procedural Issues

From correspondence passing between the Respondent and Nominet it appears that the Respondent believes that, notwithstanding his failure to respond to the Complaint, the Expert's summary decision should be set aside and that he should be permitted to respond to the Complaint, effectively re-running the case at first instance. In being compelled to utilize the Appeal process instead, he complains that he has been required to pay the Appeal fee and he has been limited by the word count provision.

While it appears to be the case that the Respondent may have had an understandable reason for not having responded to the Complaint in timely fashion, it was through no fault of the Complainant or Nominet. The simple, straightforward operation of the Policy would be undermined if decisions duly arrived at in accordance with the terms of the Policy and the Procedure could routinely be set aside due to the individual personal circumstances of a respondent.

In this case, the Respondent has not been disadvantaged (save arguably as to cost) in that he has been able to put before the Panel the 'pleadings' in two previous cases, one under the UDRP and one under the Policy, both of which involved similar facts, thereby ensuring that the detail of his side of the dispute is before the Panel despite the limited word count for the Appeal Notice itself.

The only procedural issue before the Panel is as to whether or not the Panel should admit the content of the Respondent's Appeal Notice to the extent that it constitutes new evidence, paragraph 18.h. of the Procedure providing that:

*"The Panel should not normally take into consideration any new evidence presented in an appeal notice or appeal notice response, unless they believe that it is in the interests of justice to do so."*

While the Respondent's explanation for his failure to respond to the Complaint is not entirely clear, it appears that the Respondent may have had an understandable reason and the Panel believes it to be in the interests of

justice that the content of the Appeal Notice is admitted in full.

## **6. The Facts**

If a respondent fails to respond to a complaint under the DRS, it is open to the complainant to seek a summary decision rather than a full decision. The only difference between a summary decision and a full decision is that the former is cheaper, occasioned by the fact that the Expert is not required to go to the time and trouble of putting his/her reasons in writing.

In this case the Respondent failed to respond to the Complaint, the Complainant sought a summary decision and the Expert issued his decision on 10 January, 2013 holding that there was no reason why it would be unconscionable for him to deal with this case by way of a summary decision and holding that the Complainant 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. He directed that the Domain Name be transferred to the Complainant.

The essential facts are not in dispute. The Complainant is a firm of solicitors, which for several decades carried on practice under the name Norton Peskett & Forward until 1996 when it dropped “& Forward” from the name. Recently, it adopted a different trading style, Quality Solicitors Norton Peskett, but continues to use its old name in various ways, including for email addresses.

The Complainant is the registrant of the domain name, <nortonpeskett.co.uk>, which it registered on 5 November 1997. The website attached to this domain name is connected to an active website of the Complainant.

The Respondent is a former client of the Complainant who became seriously dissatisfied with the quality of service provided to him and to his late father by the Complainant.

The Respondent has leveled very serious allegations against the Complainant and some of its partners and former partners, and the Complainant has reciprocated with allegations of impropriety and illegality against the Respondent. It should be made clear that the Panel is not in a position to determine the truth or falsity of these allegations, nor would it be appropriate for it to attempt to do so. The DRS is not the correct forum for the resolution of such matters.

The Respondent registered the domain name, <nortonpeskett.com>, on 9 April, 2009 and connected it to a website publishing his allegations.

On 3 June 2009 the Complainant launched a complaint with the World Intellectual Property Association (“WIPO”) under the Uniform Domain Name

Dispute Resolution Policy (“UDRP”) in respect of the <nortonpeskett.com> domain name and seeking transfer of that domain name to the Complainant. The WIPO panelist issued his decision on 21 July 2009 (WIPO Case No. D2009-0724). The complaint failed because the WIPO panelist concluded, “*although not without some difficulty*”, that the Respondent had demonstrated a legitimate interest in respect of that domain name.

The Respondent registered the Domain Name on 3 July 2009 and connected it to a website publishing his allegations.

In 2010 the Respondent registered/acquired 8 domain names, each of which comprised the Complainant’s name, Norton Peskett, a description of a legal service area, such as “criminallaw” and “residentialconveyancing” and the ‘.co.uk’ domain suffix. This provoked an earlier complaint under the Policy, which was resolved and/or withdrawn following the mediation stage.

On 7 December 2010 the Complainant filed a UK application for registration of the trade mark, NORTON PESKETT, in class 45 for legal services. Registration was granted on 4 March 2011.

The Complainant launched this Complaint under the Policy on 7 December 2012.

## **7. The Parties’ Contentions**

### **The Complainant**

The Complainant contends that it has common law rights in respect of its Norton Peskett name and that the Domain Name, absent the domain suffix, is substantially identical to the Complainant’s name, merely omitting the final ‘t’.

The Complainant contends that, in registering the Domain Name and using it as he is, the Respondent is publishing seriously defamatory matter and setting out to cause the Complainant maximum commercial damage. The Complainant contends that, in using a domain name so closely resembling the Complainant’s name and domain name (<nortonpeskett.co.uk>), the Respondent is setting out to catch unwary Internet users seeking the Complainant’s website.

The Complainant contends that in the course of this activity the Respondent has received emails intended for the Complainant, but incorrectly addressed, and has used documents thus received to publish confidential material of the Complainant and its clients. The Complainant contends that certain of those documents name children concerned in care proceedings (thus breaching provisions of the Children Act).

The Complainant further contends that the Respondent has infringed various third party copyrights by copying material off the Complainant's website and has used the Complainant's name and logo in breach of the Complainant's trade mark rights.

The Complainant asserts that it has not given the Respondent permission to use its name and trade mark and that none of the provisions of paragraph 4 of the Policy is applicable.

The Complainant contends that the Domain Name, in the hands of the Respondent is an Abusive Registration as defined in paragraph 1 of the Policy.

### **The Respondent**

The Respondent refutes the Complainant's contentions.

The Respondent refers to the Complainant's recent change of name and contends that the Complainant has abandoned any rights it may have had in respect of the name, Norton Peskett.

The Respondent contends that this Complaint is an abuse of the process in that it is substantially identical to the earlier complaint filed by the Complainant with WIPO under the UDRP (see above), a case in which the panel found that the Respondent had a legitimate interest in the domain name, <nortonpeskett.com>, which he was using in substantially the same manner as he is using the Domain Name. The Respondent asserts that this Complaint "*forms part of a pattern of abusive complaints [see below] and is brought in bad faith*".

The Respondent contends that in filing this Complaint the Complainant had no *bona fide* belief in the merits of the Complaint. The Respondent refers to the previous DRS complaint filed by the Complainant in 2010 (see paragraph 6 above), which the Respondent alleges was withdrawn following the mediation stage, when the Complainant was required to pay a fee to pursue the complaint further.

The Respondent contends that this is in effect an abusive attempt to re-try the case and that in so doing the Complainant is harassing him and compelling him to pay a £3000 Nominet fee which is to be contrasted with the £200 fee that was required of the Complainant for the summary decision.

The Respondent contends that the Domain Name is not an Abusive Registration. The Respondent contends that he has been making "*legitimate non-commercial or fair use of the Domain Name*" within the meaning of paragraph 4.a.i.C of the Policy. He asserts that "*DRS policy 4.b. also clearly states that criticism websites constitute fair use*". He points out that the Domain Name resolves to the same website as <nortonpeskett.com> which the WIPO panel in WIPO Case No. D2009-0724 has found to be a legitimate non-commercial fair use of the Domain Name.

The Respondent contends that he *“uses the domain <nortonpesket.co.uk> solely for the purpose of publishing a criticism website to warn future potential victims of the dangers posed by the Complainant's predatory behavior. It is a useful and important public service.”*

The Respondent contends that he *“has no other motive than to protect the public from the predatory practices of the Complainant. There is no advertising on this site, no offer to sell the domain to the Complainant or its competitors. No ulterior motive of any kind.”*

The Respondent recognises that there is nothing in the DRS Policy requiring a Nominet Expert or Appeal Panel to follow a precedent set by a WIPO panel, but *“respectfully suggests that it is in the best interests of all Internet users worldwide for all Domain Name registration authorities to follow the same policies. Divergent policies across multiple jurisdictions leads to confusion, and undermines attempts to unify Internet regulation worldwide”.*

The Respondent accepts that he is causing disruption to the Complainant's business, but that it is fair disruption. He contends that paragraph 3.a.i.C of the Policy *“does not prohibit the disruption of the Complainant's business, it only prohibits unfair disruption of the Complainant's business. Thus if the disruption is fair, then it is permitted. The Respondent's use of the disputed domain name does not disrupt the Complainant's business to any greater extent than the Complainant's use of its similar domain name disrupts the business of the Respondent. Equality equals fairness. The disruption of dangerous predators stalking their prey is fair. Protecting vulnerable sick and elderly victims from the Complainant is fair. Indeed, it is an important public service.”*

The Respondent refers to the Complainant's allegations in relation to offences under the Children Act, wrongful publication of confidential information, mis-use of misdirected emails and police investigations and denies them. He asserts that the Complainant has falsified documents to discredit the Respondent.

The Respondent denies that anything he has published about the Complainant is defamatory. He claims that it is all true.

As to the Complainant's contentions in relation to copyright infringement, the Respondent asserts that the Policy *“does not cover copyright issues relating to website content, only copyright issues relating to the domain names themselves. In any event the Complainant's font, photos, etc. are not used in the website to which the disputed domain name resolves.”*

The Respondent seeks dismissal of the Complaint and a finding of Reverse Domain Name Hijacking.

## **8. Discussion and Findings**

### **General**

To succeed in this Complaint the Complainant has to satisfy the Appeal Panel pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has “Rights” (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an “Abusive Registration” (as defined in paragraph 1 of the Policy).

### **Reverse Domain Name Hijacking**

Paragraph 16.d. of the Procedure provides *inter alia* that “*If, after considering the submissions, the Expert finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking, the Expert shall state this finding in the Decision.*” By virtue of paragraph 18.i. of the Procedure this provision also applies to appeal decisions.

Reverse Domain Name Hijacking is defined in paragraph 1 of the Procedure as “*using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name*”.

### **Identity/Similarity**

The Domain Name (absent the domain suffix, which the Expert may ignore for the purposes of assessing identity and similarity under this element of the Policy) comprises the Complainant’s NORTON PESKETT trade mark, but omitting the final ‘T’. No one is contending that the missing ‘t’ renders the Domain Name dissimilar to the Complainant’s mark.

The Panel rejects the Respondent’s contention that the Complainant in recently having changed its trading style to “Quality Solicitors” has abandoned any rights it may have had in the Norton Peskett name. The Complainant has satisfied the Panel that it continues to use the name in various forms in the course of its business (including for email addresses) and in any event there will be a residual goodwill.

The Panel finds that the Complainant has Rights in respect of a name or mark, which is similar to the Domain Name.

### **Abusive Registration**



This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines “*Abusive Registration*” as:-

“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.”

Paragraph 3 of the Policy contains a non-exhaustive list of what may constitute an Abusive Registration for these purposes. Paragraph 4 of the Policy contains a non-exhaustive list of what a Respondent may show to demonstrate rights or legitimate interests in respect of the Domain Name.

The Respondent claims that he registered the Domain Name and is using the Domain Name fairly to warn clients and potential clients of the Complainant (i.e. the very people whom the Complainant aims to reach with its website connected to its domain name, <nortonpeskett.co.uk>) “of the dangers posed by the Complainant’s predatory behavior” and that, in so doing, he is performing “a useful and important public service.” He observes that his website is a non-commercial website; that it contains no advertising and no offer to sell the Domain Name. He claims to have “no ulterior motive of any kind”.

The Respondent prays in aid the WIPO decision in his favour in relation to the domain name, <nortonpeskett.com>, which, as he correctly observes, involved substantially identical facts. He also relies on paragraph 4.b. of the Policy.

The Panel will approach this case on the basis (accepted by the Respondent as being the case) that the Respondent’s website is causing disruption to the Complainant’s business. As noted above the Panel cannot and will not attempt to decide whether the Respondent’s complaints about the Complainant are well-founded. The Panel cannot conclude that the Respondent’s allegations are true, nor can it conclude that they are untrue. Accordingly for the purposes of this decision the Panel will approach the assessment under the Policy upon the assumption that these are serious and substantial allegations which are sincerely held but at least some of which are currently unproven.

The Respondent places significant emphasis on the fact that in WIPO Case No. D2009-0724 the panel found in his favour on very similar facts in relation to the domain name, <norton-peskett.com>. That panel found that in using the domain name for a non-commercial criticism site the Respondent had a legitimate interest in respect of that domain name.

As a preliminary observation it should be noted that, as acknowledged by the panel in that decision, the WIPO decision relied upon by the Respondent was a close call, which could easily have gone against him.

This Panel is aware that there is a divergence of view amongst WIPO panelists as to the correct approach to such cases. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview”) deals with the issue in paragraph 2.4 (“*Can a criticism site generate rights and legitimate interests?*”):

*“This section only concerns sites that practise genuine, noncommercial criticism. There are many UDRP decisions where the respondent argues that the domain name is being used for a free speech purpose but the panel finds that it is primarily a pretext for commercial advantage.*

*In the event that a domain name identical or confusingly similar to a trademark is being used for a genuine noncommercial free speech website, there are two main views. In cases involving only US parties or the selection of a US mutual jurisdiction, panelists tend to adopt the reasoning in View 2 (though not universally).*

*View 1: The right to criticize does not necessarily extend to registering and using a domain name that is identical or confusingly similar to the complainant's trademark. That is especially the case if the respondent is using the trademark alone as the domain name (i.e., <trademark.tld>) as that may be understood by Internet users as impersonating the trademark owner. Where the domain name comprises the protected trademark plus an additional, typically derogatory term (e.g., <trademarksucks.tld>), some panels have applied View 2 below.*

*View 2: Irrespective of whether the domain name as such connotes criticism, the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is fair and noncommercial.*

*Additional considerations: Some panels have opted to assess questions of whether a respondent may have a legitimate interest in using a trademark as part of the domain name of a criticism site by reference to additional considerations, including whether: (i) the domain name has been registered and is used genuinely for the purpose of criticizing the mark owner; (ii) the registrant believes the criticism to be well-founded and lacks intent for*

*commercial gain; (iii) it is immediately apparent to Internet users visiting the website at the domain name that it is not operated by the owner of the mark; (iv) the respondent has refrained from registering all or most of the obvious domain names reasonably suitable for the owner of the mark; (v) where appropriate, a prominent and appropriate link is provided to the relevant trademark owner's website; and (vi) where there is a likelihood that email intended for the complainant will use the domain name in issue, senders are alerted in an appropriate way that their emails have been misaddressed.”*

The panel in the case cited by the Respondent subscribed to View 2. Many other panelists, subscribing to ‘View 1’, would have reached a different conclusion.

However, in the view of the Panel this is somewhat beside the point. As has been pointed out in numerous DRS Decisions, the UDRP and the Policy are not the same. In particular, while the Policy requires a complainant to prove that it has relevant Rights (as discussed above) and that the Domain Name is an Abusive Registration, the UDRP has a three-step test under which a complainant must prove that: (i) the domain name is identical or confusingly similar to a mark in which the complainant has rights; and (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith [paragraph 4.a. of the UDRP].

Thus, whilst similar fact cases may lead to the same outcome under both the UDRP and the Policy, that will not always be the case; and it cannot be assumed from the result of a case under the UDRP that there will be the same outcome under the Policy (or *vice versa*).

For Experts and Appeal Panels deciding cases under the Policy, the ultimate issue is as to whether the domain name in issue was registered or has been used *“in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”* [Paragraph 1 of the Policy]. This wording does not appear in the UDRP and, as can be seen from the extract quoted below from the DRS Experts’ Overview, there is a consensus view among Experts, which more closely approximates to the ‘View 1’ of WIPO panelists.

In these circumstances the previous WIPO decision does not bear the weight which the Respondent would seek to place upon it.

The Respondent *“respectfully suggests that it is in the best interests of all Internet users worldwide for all Domain Name registration authorities to follow the same policies.”* Laudable as this sentiment may be, it is of no assistance in the resolution of this Appeal. The Nominet DRS is governed as a matter of contract solely by the terms of the Policy and Procedure and it is not open to the Panel to apply the divergent test under the UDRP. This Appeal will be decided according

to the provisions of the Policy.

In stating, as he does, that paragraph 4.b. of the Policy “clearly states that criticism websites constitute fair use”, the Respondent is misquoting the Policy. Paragraph 4.b. of the Policy provides that “Fair use **may** include sites operated solely in tribute to or criticism of a person or business.” [Emphasis added]. This is dealt with further in paragraph 4.8 of the DRS Experts’ Overview, which is one of the many resources available on the Nominet website, “Do tribute and criticism sites necessarily constitute fair use unless proved otherwise?”:

*“No. Paragraph 4(b) of the Policy provides that “Fair use may include sites operated solely in tribute to or in criticism of a person or business”. Note the use of the words “may” and “solely”— it will depend on the facts. If, for example, commercial activity beyond that normally associated with a bona fide fan site takes place, the registration may be abusive. See the Appeal decision in DRS 00389 (scoobydoo.co.uk). Note also that the use of the word “may” means that even if a site is operated solely as a tribute or criticism site it is still open to the Expert to find that it is abusive.*

*In assessing the fairness or otherwise of the use, the Expert needs to have regard to both the nature of the domain name in dispute and its use. Some decisions in the past have concentrated solely upon whether the site fairly pays tribute to or criticises the Complainant (often a very difficult thing for an expert to assess in a proceeding of this kind).*

*The appeal decision in DRS 06284 (<rayden-engineering.co.uk>) confirmed the consensus view among experts today that the nature of the domain name is crucial to the exercise. A criticism site linked to a domain name such as <lhateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant.*

*In DRS 06284 the domain name was identical to the name in which the Complainant had rights. A modified name that made it clear that this was a protest site would presumably have been less successful in drawing the protest to the attention of customers of the Complainant. The Panel concluded there was a balance to be drawn between the right to protest (which could be effected via a modified name) and the Complainant’s rights in its own name, and that in this case at least the latter outweighed the former. Note that the Panel did not rule that use of an identical*

*name would always and automatically be unfair, but did conclude that it was only in exceptional circumstances that such use could be fair. The Panel declined to find that such exceptional circumstances existed in the case in question.”*

While the Domain Name is a modified version of the Complainant’s name, it is not a significant modification, but a ‘typo’, which might well not be noticed by many, and the Domain Name is intended to be recognised as the name of the Complainant.

Moreover, while the Respondent asserts that his purpose is solely to provide a public service alerting Internet users to the dangers of dealing with the Complainant, the tone and content of the allegations are such that the Panel has had difficulty accepting that there is no ulterior motive. It is difficult to resist the impression that the Respondent has a serious axe to grind, and quite probably a desire for revenge.

Adopting the approach taken by the Appeal Panel in DRS 06284 (<rayden-engineering.co.uk>), discussed in the quotation above, the Panel finds that the Respondent’s choice of Domain Name and the use to which it has been put falls on the wrong side of the line. It does not constitute legitimate fair use.

The Panel finds that the Domain Name, in the hands of the Respondent is an Abusive Registration as defined in paragraph 1 of the Policy.

No doubt, notwithstanding this decision, the Respondent will seek to continue his publicity campaign against the Complainant using a website accessible via another domain name. The effect of the ruling of this Panel is merely that he will be unable to do so using the Domain Name <nortonpesket.co.uk>.

## **9. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Panel affirms the decision of the Expert, dismisses the Appeal, rejects the allegation of Reverse Domain Name Hijacking and directs that the Domain Name, <nortonpesket.co.uk>, be transferred to the Complainant.

**Dated: 18 March 2013**

**Philip Roberts**

**Tony Willoughby**

**Anna Carboni**