

**DISPUTE RESOLUTION SERVICE**

**D00016155**

**Decision of Independent Expert**

Rhondda Cynon Taf County Borough Council

and

Jonathan Rees

**1. The Parties:**

Complainant: Rhondda Cynon Taf County Borough Council  
ICT, Ty Elai  
Dinas Iasf Estate  
Williamstow  
Tonypandy  
Rhondda Cynon Taf  
CF40 1NY  
United Kingdom

Respondent: Mr Jonathan Rees  
79 Northover Road  
Bristol  
Avon  
BS9 3LQ  
United Kingdom

**2. The Domain Name:**

visitrct.co.uk

**3. Procedural History:**

I confirm that 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

which could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

26 June 2015 14:29 Dispute received  
29 June 2015 11:24 Complaint validated  
29 June 2015 11:39 Notification of complaint sent to parties  
16 July 2015 02:30 Response reminder sent  
21 July 2015 08:27 No Response Received  
21 July 2015 08:28 Notification of no response sent to parties  
31 July 2015 02:30 Summary/full fee reminder sent  
10 August 2015 11:39 Expert decision payment received

#### **4. Factual Background**

The Complainant is the County Borough Council for Rhondda Cynon Taf, in South Wales. The Respondent is an individual whose address is in Bristol.

The Domain Name used to be registered to the Complainant, until December 2014, but was then registered by the Respondent.

The Complainant says it used to use the Domain Name as its main domain to promote tourism for the County Borough. The Domain Name now points to a webpage [www.topbusinesses.co.uk](http://www.topbusinesses.co.uk), whose home page (as at 18 August 2015) contains a few customer reviews of what appear to be mainly restaurants in the Bristol area. In the About Us section of the website, it is claimed: "TopBusinesses is the UK's verified business ratings site". There is a search facility for various categories of businesses, which include "Hotels and Tourism", alongside such other categories as "Legal" and "Local Government". In the "Local Government" section the Complainant itself is listed (as one entry out of 331 pages in that section).

The Complainant wrote to the Respondent in January 2015 asking him to discuss a transfer of the Domain Name. It appears there was no reply to that letter.

#### **5. Parties' Contentions**

##### **Complainant**

##### **Rights**

The Complainant says it has the trademark "RCTCBC.GOV.UK". It has also registered multiple domain names for various of its departments using both ".gov.uk" and ".co.uk". It says it uses "the RCT" to promote services and events across the County Borough.

Up until December 2014 it used the Domain Name for a site which is used to promote tourism for the County Borough throughout the country, with similar domain names <visitrct.com> and <visit-rct.co.uk>. It says the Domain Name was

in use since 2006, but it missed the renewal deadline. It was its main domain name for promoting tourism, and is on its literature and marketing materials.

### **Abusive Registration**

The Complainant says the Domain Name has been used to confuse Internet users. It is directed to [topbusinesses.co.uk](http://topbusinesses.co.uk), and is not used to promote visiting RCT or any nearby location. Typing in the website address [www.visitrct.co.uk](http://www.visitrct.co.uk) redirects to [topbusinesses.co.uk](http://topbusinesses.co.uk). Using the search term visitrct provides the visitrct webpage promoting tourism within the County Borough.

The Complainant seeks the transfer of the Domain Name to it.

### **Respondent**

The Respondent has not replied.

## **6. Discussions and Findings**

In order to succeed in its Complaint, in accordance with the Policy, the Complainant needs to establish:

- “i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.”*

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”.*

The definition of Rights under the Policy is 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.”*

### **Rights**

The Complainant does not refer to any registered rights, so presumably relies upon common law rights, protected under English Law by the law of passing-off. It does not specifically identify what name or mark it relies upon as giving it Rights under the Policy.

It says it uses “the RCT” to promote its services and events, but it does not provide any evidence of how it does so, or the extent of the recognition of “RCT” as such.

It also refers to the “trademark” RCTCBC.gov.uk, without saying why what would appear on its face to be an address for its principal Council website (rather than a brand, in the same way as, say, lastminute.com) should have acquired independent recognition as a trade mark.

As regards the Domain Name itself, and similar domain names such as <visitrct.com> and <visit-rct.co.uk>, there is no evidence provided as to the distinctiveness of those domains, either. The Complainant has not provided evidence of the marketing material and literature which it says has the Domain Name on it. It says it used the Domain Name since 2006 until December 2014, but does not provide details of how, other than it being the “main domain for promoting tourism”. It also provides an undated Google search on the term “visitrct” with only two results: one is tourism.rctcbc.gov.uk (in other words, the tourism part of the main Council website); the other is a url metrics result, last updated in January 2015, urlm.co.uk/visitrct.co.uk, showing fewer than 300 visitors per month to the visitrct.co.uk website.

The Complainant therefore faces difficulty in saying that it has Rights in a name or mark which is identical to the Domain Name. That might be the case, if the Complainant were claiming that it had rights in the name or mark VISITRCT. However, it could only do that if it could demonstrate sufficient goodwill in the website address itself (including the .com and hyphenated alternatives), as it does not identify anywhere else where the “brand” VISITRCT appears. The Complainant does not seem to be trying to make out the case that it has Rights in the address of the website itself, but even if it were, it would require significant evidence of recognition of that “brand” and its distinctiveness which has not been provided.

Therefore, in the absence of Rights in VISITRCT as an identical name or mark to the Domain Name, the Complainant has to say that there is sufficient similarity either between the Domain Name and what it describes as its “trade mark” RCTCBC.gov.uk, or between the Domain Name and RCT. The former of those is not tenable, in the Expert’s opinion. The differences are just too great. Ignoring the suffix .gov.uk for current purposes, the comparison would be between RCTCBC and VISITRCT, and it would require too great a stretch to say that the names or marks are similar, even if there had been evidence that RCTCBC is distinctive of the Council (which has not been provided). The latter might just be arguable, if the “visit” part of the Domain Name could be shown to be secondary to the dominant part of the mark “RCT” (although, again, the Complainant has not, in fact, argued that). However, the evidence supporting the prominence of the “RCT” name has not been provided either, and without that, the Expert feels he cannot just disregard the “visit” part of the name.

As a public body, the Council also faces the potential difficulties in establishing certain of the elements required to bring an action based on passing-off under English law which were recently discussed by the expert in DRS 14563 inland-revenue.org.uk. The Council no doubt has a reputation which the law would seek to protect from plagiarism. However, the particular area of the Council’s activities in question here is its promotion of tourism in its area, and it is by no means clear to the Expert why that area of its activity should generate the kind of goodwill which would be required to bring an action for passing-off. Its current website at

www.visitrct.com appears to be maintained by the Council's tourism department (out of central funding) for the purposes of highlighting the attractions and facilities of the local area, and providing links to services provided by others, such as accommodation providers. As such, it appears to be a service on behalf of the tourist industry in the area, and it is not funded by payments made by third parties for referrals, income from whom could be lost to the Council if visitors were to be confused, as the Council suggests.

The threshold for establishing Rights is not a high one, and this case has not been contested by the Respondent. As noted above, the Complainant's status as a public body might lead to technical issues surrounding the establishment of common law rights protectable by the law of passing-off. If that were to be the only hurdle which the Complainant needs to overcome, the Expert would be inclined to find in the Complainant's favour on this point. However, it is not the Complainant's only hurdle: as identified above the Complainant has failed to make out a clear case as to what brand it relies upon, and failed to provide convincing evidence of the extent of recognition of any relevant name. There is no evidence of the distinctiveness of the website addresses incorporating "visitrct", and either of the other potential candidates for relevant names or marks (RCT/RCTCBC.gov.uk) would in any event be noticeably different from the Domain Name. The Expert is therefore not prepared to find in the Complainant's favour on the question of Rights.

### **Abusive Registration**

Although the Complainant fails in its Complaint in any event as it has not made out Rights, the Expert will also set out his views on Abusive Registration, as he would also have found against the Complainant on this ground if it had been necessary to do so.

The Complainant appears to rely upon the Domain Name "being used in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant" as one of the circumstances under paragraph 3.a of the Policy as evidence that the Domain Name is an abusive registration in the hands of the Respondent (Policy 3.a.ii). It refers to the Domain Name being "used to confuse Internet users".

However, its reasoning as to why such confusion would occur is unclear. It accepts that typing visitrct into a browser would bring a visitor to a (short) list containing its own (Council) site. As noted above, the Google search result provided by the Complainant is undated, and only contains two entries, the other being results of metrics for the period when the Council last controlled the Domain Name, showing the site ranked as 2,774,901 in the United Kingdom. The Expert cannot see how this provides evidence of confusion.

On the other hand, the Complainant says that typing [www.visitrct.co.uk](http://www.visitrct.co.uk) into a browser would bring a visitor to the Topbusinesses site. It says that the Domain Name "is on [its] literature and marketing materials" (some 6 months after the missed renewal deadline), so perhaps there might be some confusion from that source. However, that confusion could well be said to be as a result of the use of an

out of date address, rather than something for which the Respondent should be held at fault.

So, what is the Complainant's case against the Respondent as to his motives for acquiring the Domain Name? Although Bristol, where the Respondent lives, is geographically comparatively close to the South Wales area of the Complainant Council, why should there be any reason to believe the Respondent must have had the Complainant in mind when he registered the name? The Complainant does not suggest any. It is possible that the Respondent was aware of "RCT" as an abbreviation for the geographical area involved, but does this mean that he would have had the Complainant in mind when registering the Domain Name? The evidence as to the degree of recognition of the Complainant's brands/names/addresses is, as noted above, very thin. The Complainant does not suggest there was any specific link between it and the Respondent, from which the Respondent must have been aware of its rights. One possible alternative explanation is that the name may have been picked up through automated drop-catching, and the geographical closeness may just have been coincidence. However, the Complainant does not begin to say why it believes the Respondent acquired the Domain Name, and it is not really for the Expert to speculate in the absence of a positive case.

What does the Complainant say is wrong about the subsequent use of the Domain Name to point to the Topbusinesses website? Why is it causing confusion? The only argument the Complainant appears to put forward is that the Domain Name does not point to its own site, and does not promote tourism in Council's area (although, presumably if it had done the latter, as a rival to the Council's site, there might have been better grounds for complaining of confusion). What is its complaint about the Topbusinesses website, which on the face of it appears to be a genuine business search facility, if relatively unsophisticated? Again, the Complainant has not explained its case.

The Respondent has not contested the case, but that does mean that the Complainant wins the case by default. It still needs to put forward a sufficiently compelling case to establish Abusive Registration on the balance of probabilities. Assuming that this may be a case of drop-catching, that per se would not be inherently objectionable (see, for instance, DRS13496, fein.co.uk). Also, "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" (Policy, 4d). Unlike in Fein.co.uk, the Respondent has not explained the nature of his activities, but that does not mean that he loses the case by default.

In short, the Complainant has not put forward a sufficiently compelling case on the question of Abusive Registration for the Expert to be convinced on the balance of probabilities that this is not a case of innocent acquisition of Domain Name. Therefore, the Complaint would also fail on this ground.

## **7. Decision**

The Expert finds that the Complainant has not established that it has Rights in a name or mark which is identical or similar to the Domain Name, or that the

Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complaint therefore fails, and the Expert directs that no action be taken in respect of the Domain Name.

**Signed ..... Bob Elliott**

**Dated 1 September 2015**