

DISPUTE RESOLUTION SERVICE

D00019893

Decision of Independent Expert

AA PLC

and

Whois Foundation

1. The Parties

Lead Complainant: AA PLC

Fanum House
Basing View
Basingstoke
Hampshire
RG21 4EA
United Kingdom

Second Complainant: AA Brand Management Limited

Fanum House
Basing View
Basingstoke
Hampshire
RG21 4EA
United Kingdom

Respondent:

Whois Foundation
Ramon Arias Avenue,
Ropardi Building, Office 3-C
PO Box 0823-03015
Panama City
0823
Panama

2. The Domain Names

aainsuranceservices.co.uk
aaroutelanner.co.uk
aaroutemaps.co.uk
theaa-tyres.co.uk
theaaroutfinder.co.uk

(‘the Domain Names’)

3. Procedural History

Nominet checked that the complaint received on 23 February 2018 complied with its UK Dispute Resolution Service (‘DRS’) Policy (‘the Policy’), before notifying the Respondent and inviting a response. That response was received on 9 March. On 13 March, the Complainants replied to the response.

Mediation was attempted but ended unsuccessfully and, on 14 March, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 15 March.

On 26 March I, Mark de Brunner, agreed to serve as an expert under the Policy. 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 that 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.

4. Factual Background

I have visited the web pages to which the Domain Names resolve, as well as the Complainants’ web site at <theaa.com>. From that limited research, the complaint, the response, the reply and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainants are part of a group. The Lead Complainant is a motoring organisation that was established in 1905. It provides car insurance, driving lessons, breakdown cover, loans, motoring advice, road maps and other motoring-related services. It is the main trading entity of the group and is listed on the London Stock Exchange.

The Second Complainant holds the group’s intellectual property. It has an international portfolio of registered rights in the name AA and related brands. Its oldest registration for the mark ‘AA’ dates from July 1914.

The Complainants’ brand has a significant presence on Facebook (33,000 “followers”) and twitter (29,000 followers). Their online route planner receives

over 20 million route requests a month. The group's main website is at <theaa.com>.

The Respondent holds a large portfolio of domain names, including tens of thousands of names within the .uk top level domain. Those domain names include:

bankofscotland.co.uk
cathkindston.co.uk
debehnhams.co.uk
frestylelibre.co.uk
gatwuckairport.co.uk
jet2holdiays.co.uk
karenmilleen.co.uk
laredooute.co.uk
majeticwine.co.uk
nationalexoress.co.uk

The Domain Names at issue here were registered on the following dates:

26 June 2017
23 June 2017
19 May 2017
7 Jun 2017
16 May 2017

They each resolve to a web page with advertising links relating to areas of the Complainants' business and, invariably, to third party web sites including those operated by competitors of the Complainants' group.

5. Parties' Contentions

Complaint

The Complainants say that they have rights in the name 'AA' and that the Domain Names differ from the name in which they have rights only by the addition of words or phrases that relate to their business, or typographical variants of such words and phrases.

They argue that the Domain Names are abusive registrations for the following reasons.

- (i) Their use has confused or is likely to confuse people or businesses into believing that the Domain Names are connected with the Complainants. The Domain Names differ from the Complainants' group's marks only by the addition of words and phrases (or typographical variations of such words and phrases) that are closely associated with the Complainants' group's business. The Domain Names are therefore all inherently confusing. In particular, the

Respondent's use of the Domain Names has or is likely to have created 'initial interest' confusion. On that point, the Complainants refer to paragraph 3.3 of the Experts' Overview, which notes:

"...the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant". This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with... a commercial web site which, may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name."

- (ii) Use of the Domain Names amounts to an unfair disruption of the Complainants' business.
- (iii) As the registrant of some 46,923 .uk domain names, a significant number of which appear to incorporate names reflecting third-party rights which are not associated with it, the Respondent is engaged in a pattern of registrations of domain names which correspond to well-known names or trade marks in which it has no apparent rights, and the Domain Names are part of that pattern.
- (iv) There are no factors that would point to the Domain Names not being abusive registrations.

The Complainants assert that in DRS 19551 the Respondent attempted to transfer the disputed domain names before an expert was appointed, speculating that the reason for that was to avoid a decision against it under the DRS.

Response

The Respondent says it owns a portfolio of generic and descriptive domain names which it acquired lawfully and fairly. It says that, where complainants believe that any of these domain names violates a trademark, it typically agrees to transfer them voluntarily

"irrespective of the legitimacy of the complainant's arguments, in an effort to avoid the needless time and expense associated with litigation and administrative hearings."

It says it was unaware of the Complainants or their marks and that, when learning of this matter, it contacted the Complainant to offer a voluntary transfer of the Domain Names at issue, but that the Complainants refused this

offer.

As things now stand

“without admitting fault or liability and without responding substantively to the allegations raised...[the] Respondent stipulates that it is willing to voluntarily transfer the Domain Name[s] to the Complainant[s].”

But the Respondent

“respectfully requests that the transfer be ordered without findings of fact or conclusions other than [that] the Domain Name[s] be transferred.”

The Respondent refers to ‘numerous prior UDRP decisions’ where:

“panels have consistently ruled that when a complaint has been filed and the respondent consents to the transfer of the domain name, it is inappropriate to issue any decision other than simply ordering the transfer of the domain name. Such panels consistently hold that it would be improper to issue any findings of fact in such cases.

“In The Body Shop International plc v. Agri, Lacus & Caelum LLC, FA 679564 (NAF May 25, 2006), the complaint set forth allegations and requested that the domain name be transferred to complainant. The respondent therein, after the deadline for a response, filed a stipulation agreeing to the transfer of the domain name to the complainant. The panel limited its decision to an order that the domain name be transferred. Regarding the stipulation, the panel stated the following:

‘Consistent with a general legal principle governing arbitrations as well as national court proceedings, this Panel holds that it cannot issue a decision that would be either less than requested, or more than requested by the parties. Because both Complainant and Respondent request the transfer of the disputed domain name to Complainant, the Panel must recognize the common request of the two parties. See: Malev Hungarian Airlines, Ltd. v. Vertical Axis Inc., FA 212653 (Nat. Arb. Forum, Jan. 13, 2004).’

“Other panels have gone further to state that it would be unwise to issue findings of fact or conclusions other than an order transferring the name.”

The Respondent recognises that the Complainants specifically request a decision on the merits of the case. But it argues that for me to make such a decision would be unnecessary as well as unwise:

“Both judicial efficiency and judicial wisdom counsel the Panel to order the transfer without an evaluation of the merits.”

Reply

In reply, the Complainants oppose that request for transfer without findings of fact or conclusions other than that the Domain Names be transferred. They argue that the request is misconceived and appears to be based upon cases decided under the Uniform Domain Name Dispute Resolution Policy (‘UDRP’). They cite the Foreword to Version 3 of the *Experts’ Overview*:

“...it should be stressed for the benefit of those who have had experience of domain name disputes under the...UDRP, that the DRS Policy and the UDRP are different systems. In some places they share very similar wording, but there are significant differences and the citation of UDRP decisions in a dispute under the DRS Policy is rarely likely to be helpful.”

They also draw my attention to section 5.14 of the *Overview*:

“Occasionally, following the filing of the Complaint, but before the case papers have been passed to an Expert for decision, the Respondent informs the Complainant (and/or Nominet) that he is willing to transfer the domain name to the Complainant without charge. If the Complainant agrees to accept the domain name on that basis, there is a procedure whereby Nominet can process the transfer. If, however, the Complainant insists on a decision and pays the prescribed fee, the papers will be sent to an Expert for a decision.”

The Complainants argue that they are entitled to a full decision regardless of the terms of the response, provided that they have paid for this in accordance with section 13 of the Policy.

They say that if the Respondent’s request were allowed, and assuming the Complainants were able to prove the Domain Names were abusive registrations, an expert decision would not fall within the terms of section 5.3 of the Policy, which reverses the burden of proof in certain circumstances. They say that the Respondent has made an identical request in at least three separate live cases under the DRS Policy and conclude that the Respondent may be seeking to avoid section 5.3 being engaged.

Finally, the Complainants note that the Respondent has not attempted any substantive response to the arguments made by the Complainants that the Domain Names are abusive registrations.

6. Discussion and Findings

Scope and nature of the decision

Given that the Complainants are asking for the transfer of the Domain Names and the Respondent is agreeing to such a transfer, I must deal first with the question of whether a decision on the character of the registrations is appropriate here.

The Respondent argues that such a decision is both unnecessary and unwise, and that I should simply order the transfer as an administrative procedure without any finding about (or implication in relation to) the character of the registrations. It says that I have no scope for deciding on more or less than the parties have asked for.

By contrast, the Complainants say that a decision on the nature of the registrations is both necessary and required. They say it is necessary because a finding of abusive registration potentially engages section 5.3 of the Policy:

“There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the two years before the complaint was filed.”

They say such a decision is required, because they are asking for it (and, by implication, because there is no provision to deny them it).

I approach the answer to the question here by reviewing what seem to me to be the terms of the Policy that are most relevant:

- under section 2, a Respondent must submit to proceedings under the DRS if a Complainant asserts to Nominet, according to the Policy, that:
 - the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - the Domain Name, in the hands of the Respondent, is an abusive registration.

The Complainant is required to prove to the expert that both elements are present on the balance of probabilities.

- if the Respondent has submitted a response to a complaint, and mediation has been unsuccessful, Nominet will “notify the Parties that either the Complainant or Respondent can apply for a full decision” (section 13.1).
- within five days of receiving the applicable fee from the Complainant or Respondent, Nominet will appoint an expert from its list (section 14.1).
- the expert will decide a complaint on the basis of the parties' submissions and the Policy (section 18.1).

- unless exceptional circumstances apply, an expert shall forward his or her decision to Nominet within fifteen (15) Days of his or her appointment (section 18.3).
- the decision shall be in writing and provide the reasons on which it is based (section 18.4).
- section 24.3 establishes that it is for the expert to determine the admissibility, relevance, materiality and weight of the evidence.

Here, the Respondent submitted to proceedings under the DRS because the Complainants asserted that they had relevant rights and that the Domain Names were abusive registrations. Mediation was unsuccessful and both parties were notified that either could apply for a full decision. The Complainants applied for a full decision and paid the fee. Under the Policy, the decision they applied for can only be about

- whether they have rights in respect of a name or mark which is identical or similar to the Domain Names; and
- whether the Domain Names, in the hands of the Respondent, are abusive registrations.

Inevitably, therefore, making that decision will involve a judgement about the character of the domain name registrations. That judgement will be reflected in the reasons that are to be provided as part of the decision, in line with my appointment as the expert in this case.

I accept the Complainants' argument that, were a bare transfer order made in these circumstances, respondents could potentially avoid the consequences of the rule reversing the burden of proof where they are found to have made an abusive registration in three or more DRS cases in the two years before a complaint is filed.

The Respondent argues that I cannot issue a decision that would be either less or more than requested by the parties, citing *Malev Hungarian Airlines, Ltd. v. Vertical Axis Inc*, a case decided within the National Arbitration Forum:

“Since the requests of the parties in this case are identical, the Panel has no scope to do anything other than to recognize the common request, and it has no mandate to make findings of fact or of compliance (or not) with the Policy.”

Even if that decision were binding on me, which it is not, the circumstances here are different. The requests in this case are not identical: one party is asking for a reasoned decision, which inevitably reflects a judgement about the character of the registrations; the other is asking for an order to transfer the Domain Names which does not reflect any such judgement.

In the circumstances, I will proceed with a reasoned decision on the character of the registration, as I am required to do under the terms of the Policy.

To succeed in this complaint, the Complainants must prove, on the balance of probabilities, that

- they have rights in respect of a name or mark which is identical or similar to the Domain Names; and that
- the Domain Names, in the hands of the Respondent, are abusive registrations.

Rights

The Complainants have a series of trade mark registrations for the name 'AA'. They evidently have registered rights in the name. Given the length of time since the name AA was first registered by them, the extent of the brand's following on social media and the number of times their online route planner has been used, it is reasonable to infer that they also have unregistered rights in the name.

The Domain Names include the name 'AA' and, ignoring the .co.uk suffix as merely a technical and generic feature of the domain name register, supplement that name with a word or phrase related to the Complainants' business.

I conclude that the Complainants have rights in respect of a name or mark which is identical or similar to the Domain Names.

Registration

As defined by the Policy, an abusive registration is a domain name which:

- 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 has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.

The Policy is clear (section 8.4) that

“trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities.”

But that general point is subject to the over-riding principle that registration or use of a domain name must not take unfair advantage of someone else's rights. On that, it seems to me that the Complainants' arguments are well-founded:

- (i) use of the Domain Names is at the very least likely to confuse people or businesses into believing that the Domain Names are connected with the Complainants. The likelihood of 'initial interest' confusion appears to me to be high.
- (ii) that can only be disruptive of the Complainants' business and such disruption can only be unfair.
- (iii) it seems to me at least capable of being argued that the Respondent is engaged in a pattern of registrations as the registrant of domain names which correspond to well-known names or trade marks in which it has no apparent rights, and that the Domain Names are part of that pattern.
- (iv) I am aware of no factors that would point to the Domain Names not being abusive registrations.

I find it unnecessary to make any finding in relation to the Complainants' assertion that the Respondent has, in another case, attempted to transfer the disputed domain names before an expert was appointed, and their speculation that the reason for that was to avoid a decision against it under the DRS.

The Respondent asserts that it has a portfolio of generic and descriptive domain names which it acquired lawfully and fairly. But mere assertion is not evidence and I think it is for me to judge how far that is an accurate description of the Domain Names at issue here. In my judgement, the Complainants have made out a compelling and, in substance, unanswered case that the registration and use of the Domain Names has taken unfair advantage of their rights.

7. Decision

I find that the Complainants have rights in respect of a name which is identical or similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are abusive registrations.

I therefore direct that the Domain Names be transferred to the Second Complainant.

Mark de Brunner

4 April 2018