

## **DISPUTE RESOLUTION SERVICE**

**D00020650**

### **Decision of Independent Expert**

Mr Max Fox

and

Dudley Leisure Ltd

#### **1. The Parties**

Lead Complainant: Max Fox  
Blackpool  
United Kingdom

Second Complainant: Dominic Creighton  
Blackpool  
United Kingdom

Respondent: Dudley Leisure Ltd  
3 Church Street  
Blackpool  
Lancashire  
FY1 1HJ  
United Kingdom

#### **2. The Domain Name**

thejerseys.co.uk (“the Domain Name”)



### 3. Procedural History

Nominet checked that the Complaint received on 2 October 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 25 October. On 2 November, the Complainants replied to the Response.

Mediation was attempted but ended unsuccessfully and, on 21 January 2019, 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 1 February.

On 2 February 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.

I need to deal with two points at the outset – one relating to the prospect of legal action that might affect the continuance of proceedings under the DRS at all; and the other to do with the evidence to be taken into account under any such proceedings.

#### *Prospect of legal action*

The Respondent says that the proceedings under the DRS should not continue while there is court action pending. The Complainants say that, whilst court proceedings are under consideration, they have not been initiated and in any event do not relate to the Domain Name (but rather to a wider question about the format and branding of a show in which all parties have been involved).

The Policy says that the operation of the DRS will not prevent either the Complainant or the Respondent from submitting the dispute to a court of competent jurisdiction (20.13). But

“the complaint shall tell [Nominet] whether any legal proceedings have been commenced or terminated in connection with the Domain Name” (4.3.8) and

“a Party must promptly notify [Nominet] if it initiates legal proceedings in a court of competent jurisdiction relating to the Domain Name during the course of proceedings under the DRS” (25.2).

The Policy provides:

“if it is brought to [Nominet’s] attention that legal proceedings relating to the Domain Name are issued in a court of competent jurisdiction, and have been served, [Nominet] will suspend the DRS dispute pending the outcome of those legal proceedings” (25.1).

As far as I can tell from the evidence before me, proceedings relating to the Domain Name have not been issued in a court of any kind and on that basis there is no need for this DRS dispute to be suspended.

*Evidence to be taken into account*

The Complainants have taken the opportunity to reply to the Respondent's Response. The Policy is very clear about the limits to what such a reply should cover:

“Any reply by the Complainant must be restricted solely to matters which are newly raised in the Respondent's response and were not raised in the Complainant's complaint as originally submitted to us” (9.2).

“If an Expert is appointed and the reply extends to other matters, the Expert may declare it inadmissible to the extent that it deals with matters going beyond those newly raised in the Respondent's response. To the extent that the Expert intends to take note of any new material, the Expert should invite the Respondent to file a further submission in response to that material . . .” (9.3).

The Policy is also clear that it is for the expert to determine “the admissibility, relevance, materiality and weight of the evidence” (24.3).

Here, the Reply contains further evidence relating to the Complainants' unregistered rights. That further evidence is not directly relevant to matters newly raised in the Respondent's response. I therefore have two options: to ignore part of the Reply, or to admit it all and invite a further submission from the Respondent. My decision is to ignore that part of the Complainants' Reply that goes beyond matters newly raised in the Response.

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

I have visited the web page to which the Domain Name resolves. 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 musical performers. Their act is a tribute to the songs and music of Frankie Valli and “The Four Seasons”, and similar American bands. The line-up consists of the Complainants plus two others. They originally performed under the name “The Mode” but in their second year switched to calling themselves “The Jerseys”. The Complainants hold a trade mark, filed on 17 December 2016, for the name “The Jerseys”.

In exchanges between the parties in June 2016, the Respondent refers to some confirmed dates for a production under the title “Oh What a Nite”, involving:

“Jerseys & Dancers”

and

“Jerseys, Leye and Dancers”.

In March 2018 the Complainants wrote to the Respondent to end their commercial relationship. In the email, the Second Complainant signs himself as “Managing Director, The Jerseys” and refers to having been in the group “for 5 years”.

The Respondent is a producer and promoter of entertainment shows.

The Domain Name was registered on 6 December 2016.

On 9 December 2016 there is an exchange between the Respondent and the Second Complainant that confirms the registration of the Domain Name:

Respondent to Second Complainant:

“Did Max tell you I've bought [www.thejerseys.co.uk](http://www.thejerseys.co.uk) as well? “

Second Complainant to Respondent:

“Yeh he mentioned it yesterday what's the plans with it?”

The Domain Name redirects to a website at <[jerseybeats.co.uk](http://jerseybeats.co.uk)>, the main wording on the landing page for which is:

THE JERSEY BEATS  
Oh What a Nite!

THE JERSEY BEATS  
THE ULTIMATE TRIBUTE TO  
FRANKIE VALLI AND THE FOUR SEASONS

The “Jersey Beats” are another tribute band – effectively the Respondent’s replacement for the Complainants as part of the “Oh What a Nite!” show

The incorrect use of the name “The Jerseys” in the Respondent’s rival show, to refer to another band, has caused confusion on at least one occasion.

## **5. Parties’ Contentions**

### *Complaint*

The Complainants base their complaint on registered rights in the name “The Jerseys”. They argue that the Domain Name is an abusive registration because it is being used to direct traffic to the website for a rival act.

Attached to the Complaint is a letter to the Respondent from the Complainants’ legal representatives. Its primary focus is making the case that the Complainants devised and own the intellectual property rights to a tribute show under the branding “Oh What a Nite!”. As part of that, the letter refers to the Complainants’ choosing the name “The Jerseys” and using it for their band “upon its name change for The Mode”.

### *Response*

The Respondent says this is not an abusive registration because:

- (i) The Domain Name was registered before the Complainants registered “The Jerseys” as a trade mark. It argues that this fact alone is conclusive of the present dispute.
- (ii) The Domain Name was registered with the Complainants’ knowledge.
- (iii) The Respondent and the Complainants are still in correspondence over “the band”.

### *Reply*

In reply to points newly raised in the Response, the Complainants say:

- (i) and (ii) The Respondent took no action to oppose the Complainants’ application to register “The Jerseys” as a trade mark.
- (iii) No legal proceedings are underway or have been issued in relation to “The Jerseys”.

(The Complainants then attempt to adduce evidence of their use of the name “The Jerseys”, and generally of their unregistered rights in that name, but I have ignored this as inadmissible for the reasons given in section 3 above.)

## **6. Discussion and Findings**

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 Name; and that
- the Domain Name, in the hands of the Respondent, is an abusive 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.

### *Rights*

The Complainants have registered rights in the name "The Jerseys". Ignoring the .co.uk suffix, this is identical to the Domain Name. So the Complainants have rights in respect of a name which is identical or similar to the Domain Name.

### *Registration*

The Complainants have evidently got over the low threshold of rights for the purpose of establishing a complaint under the DRS. But in terms of understanding whether unfair advantage has been taken of their rights, the position is less clear-cut.

There is significant evidence, in the Reply, of the Complainants' unregistered rights in the name "The Jersey". But I have ruled that inadmissible. So what evidence is there, from the Complaint, of the Complainants' rights, for the purpose of understanding whether unfair advantage has been taken of them?

The Domain Name was registered by the Respondent on 6 December 2016. The Complainants' application to register their rights in "The Jerseys" was made eleven days later, on 17 December.

A flyer from April 2018, produced by the Respondent and referring to "The Jerseys", appears as part of the Complainants' broad evidence that the Respondent is taking advantage of various of their rights: the point being made in correspondence here is that the band being promoted in fact is not the Complainants' band but I take that also as some evidence that the Complainant had rights in the "The Jerseys" by then.

There is little direct evidence of the date from which the Complainants had unregistered rights but I accept that they started using the name "The Jerseys" when they switched to it from "The Mode" in their second year. It is hard to pinpoint that precisely but I note that the email of March 2018 from the Second Complainant to the Respondent refers to "The Jerseys" as having been together for five years. Taking

that together with all the other admissible evidence in the round, I think it is reasonable to infer that the rights in “The Jerseys” reflected in the trade mark application in December 2016 were complemented by unregistered rights that had already built up by then.

But even taking the extreme view that there were no such unregistered rights, and therefore no enforceable rights until the trade mark registration:

- although the registration of the Domain Name could not, on that extreme view of the circumstances, take advantage of the Complainants’ rights (because on that view they did not have any until several days later)
- the use to which the Domain Name was put, redirecting traffic to a web site promoting a rival act, did take advantage of the rights established by the Complainants shortly after the Domain Name was registered. The advantage taken can, in my judgement, only have been unfair.

In summary, in my judgement the Complainants had both registered and unregistered rights in “The Jerseys” when the Respondent registered the Domain Name. That registration, and the redirection of web traffic to a web page for a rival act for which the Respondent was promoter, took unfair advantage of the Complainants’ rights.

I can now review the remaining arguments here – two advanced by the Respondent and one by the Complainants.

The Respondent says the fact that the Domain Name was registered before the Complainants registered “The Jerseys” is conclusive of the present dispute. I do not agree, for two reasons. First, it discounts entirely the possibility that the Complainants may have had unregistered rights before that formal recognition of rights. For the reasons set out above, I do not find that credible.

Second, it ignores the fact that the definition of an “abusive registration” has two limbs and that, while one of those relates to the circumstances at the time of the registration itself, the other limb is concerned with the use to which the domain name has been put – a consideration that can only relate to the period since registration.

The Respondent says that the Domain Name was registered with the Complainants’ knowledge. Perhaps it was. From the evidence, the Respondent had certainly mentioned making various arrangements for an online presence. But it is equally clear that the Complainants were not sure exactly what was being proposed or of the use to which the Domain Name was to be put. It also seems undeniable that they could well have thought that any arrangements were being made by the Respondent as their agent on their behalf. I see no evidence that the Complainants knowingly accepted the registration of the Domain Name as confirmation that the Respondent



had rights in “The Jerseys” on its own account, distinct from the Complainants’ rights.

The Complainants say that the Respondent took no action to oppose their application to register “The Jerseys” as a trade mark. That does seem to me to be significant, and tends to confirm the view that even the Respondent recognises that the Complainants had rights in the name at the point of their application.

## **7. Decision**

I find that the Complainants have rights in respect of 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.

I therefore direct that the Domain Name be transferred to the Lead Complainant.

**Mark de Brunner**

**19 February 2019**