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Benefiting from a user-friendly system

The United Kingdom is one of the most cost-effective jurisdictions in which to deal with domain name abuses

The '.uk' country-code top-level domain (ccTLD) has been extremely popular with businesses and individuals in the United Kingdom. Nominet, the registry for all '.uk' domain names, reported in March 2012 that there are now more than 10 million '.uk' domain names registered. '.uk' is therefore the world's second most popular ccTLD, after the Chinese ccTLD, '.cn'.

As with generic top-level domains (gTLDs) such as '.com', and many of the other ccTLDs, legitimate businesses suffer at the hands of the unscrupulous and the naïve from cybersquatting, typosquatting and similar abuses of the '.uk' domain name system. However, the United Kingdom is one of the most straightforward and cost-effective jurisdictions in which to deal with domain name abuses.

Background

The '.uk' domain name system is administered by Nominet, the registry for all '.uk' domain names. The '.uk' domain name is a fully open system: anyone can register a '.uk' domain name if the name is not already registered to another party.

As with other domain name systems, the '.uk' ccTLD suffers from abuses from unscrupulous individuals and businesses that seek to take advantage of names associated with other businesses. In addition, naïve and unsophisticated users of the domain name system can register a domain name without understanding fully the consequences of including a third party's name within the domain name.

The Uniform Domain Name Dispute Resolution Policy (UDRP) applies to existing gTLDs and certain ccTLDs. For the '.uk' ccTLD, Nominet operates its own Dispute Resolution Service (DRS) that many consider to be superior to the UDRP.

WHOIS records for '.uk' domain names

The first step in any domain name dispute is to identify the holder of the domain name.

In the case of gTLDs this can often be problematic - in particular, where more experienced cybersquatters use privacy protection services or blatantly false contact details.

As a general rule, the WHOIS records maintained by Nominet are accurate. Nominet permits registrants who are not using the domain name for commercial purposes to withhold their address details from the WHOIS record. This 'opt-out' is often abused by cybersquatters. However, if Nominet is notified (a short email is usually sufficient) that the WHOIS opt-out is being abused and the domain name is being used for commercial purposes, Nominet will, once it has offered the registrant a short period of time to respond to the allegation of abuse, publish the address details in the WHOIS record.

Where the registrant uses a false address (either the address of another person or an address that does not exist), Nominet will, once it is notified of this fact and has given the registrant an opportunity to correct the address details, suspend or cancel the domain name.

While these processes can seem a little slow (in both cases it can take four weeks or more for Nominet to update the WHOIS or cancel the domain name), the process is still quicker and far more cost effective than that for gTLDs, where a false WHOIS record can usually be dealt with only by filing a complaint under the UDRP.

Cease and desist letters

The effectiveness of Nominet's DRS policy means that cybersquatters, whether deliberate or unaware, can generally be persuaded to cease using the domain name

or transfer it without the need for the legitimate owner of the domain name to file a complaint under Nominet's DRS policy.

In most cases a well-worded cease and desist letter with a minimal amount of follow-up with the registrant is sufficient to recover the domain name. It is thought that in excess of 80% of disputes relating to '.uk' domain names can be resolved in this manner.

A number of brand owners have a policy of not making any payments to those who register abusive domain names, fearing that this will encourage others to register similar names. However, where the registrant has been naïve rather than deliberately targeting the brand owner, offering a small payment to cover the registrant's out-of-pocket expenses in acquiring the domain name can often persuade the registrant to transfer the domain name quickly.

Nominet's Dispute Resolution Service

On the rare occasions where the domain name cannot be recovered by means of negotiation, Nominet's DRS offers a quick, effective and cost-efficient system for recovering or cancelling domain names that prejudice the rights of a brand owner or third party which has rights in a name.

DRS policy

A complainant under Nominet's DRS can have a domain name transferred or cancelled if the complainant can establish that the domain name is an abusive registration.

An abusive registration is a similar concept to that of a bad-faith registration under the UDRP. However, one of the significant failings of the UDRP is that the complainant must show that the domain name has been registered and used in bad faith. Under Nominet's DRS, the complainant must show that the domain name:

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

While many UDRP panellists take a reasonably relaxed view of the requirement that the domain name have been registered and used in bad faith, the Nominet procedure is clearly advantageous for the many cases where, for example, the domain name has not been used at all, or the domain name was first registered or acquired for legitimate purposes, but then used at a later date by the registrant for illegitimate purposes.

The rights that the complainant must demonstrate in the name are any rights enforceable by the complainant anywhere in the world. Obviously, the '.uk' domain name is aimed at customers in the United Kingdom, but Nominet's DRS does not limit itself to complainants which have rights applicable in the United Kingdom.

DRS procedure

The DRS procedure itself is straightforward. The complainant files the complaint with Nominet. No fee is payable to Nominet at the time the complaint is filed. This gives the DRS procedure a significant advantage over the UDRP, where the fee is payable at the time of filing.

Nominet provides the complaint to the registrant within three business days and the registrant is given a further 15 business days in which to respond. Within the UDRP system, this would conclude the written submissions by the parties. However, Nominet permits the complainant an additional five business days to file a written reply to the registrant's response.

Nominet mediation

A further positive feature of the DRS system that is not available under the UDRP is that Nominet operates a free mediation service. Nominet has trained mediators who speak to the parties in turn to see whether the dispute can be resolved. Nominet's mediation service is very effective and most domain name disputes that reach the mediation stage are resolved without the need for the DRS complaint to be determined by a Nominet expert.

DRS decisions and summary determination

If the mediation is not successful, the



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complainant has the opportunity to pay a fee (£750 plus value added tax (VAT)) to have the matter determined by a Nominet expert. If the complainant declines to pay the fee, the registrant has an opportunity to pay the fee to have the matter determined.

Another useful feature of the DRS for cases where the registrant does not respond to the complaint is that the complainant can pay £200 plus VAT to have the Nominet expert give a summary determination of the dispute. Again, given the large number of cases in which registrants do not respond to correspondence or to the UDRP/DRS complaints, the inexpensive summary determination under Nominet's DRS offers a significant advantage over the UDRP.

Appeal

Once the expert has given his or her decision, the unsuccessful party has an opportunity to appeal the decision, although the fee is far higher (£3,000 plus VAT).

There remains some uncertainty as to whether the unsuccessful party can seek the court's involvement in overturning a decision under Nominet's DRS. The recent High Court decision in *Michael Toth v*

Emirates [2012] EWHC 517 (Ch) suggests that the court cannot intervene and that a decision of Nominet's appeal panel is therefore final.

Advantages

Nominet's DRS is the gold standard of domain name dispute resolution procedures. It offers advantages over the UDRP - in particular, the fees are not payable until a final decision is needed, Nominet's experienced mediators can often resolve a dispute early without the complainant needing to pay any fees to Nominet, and the level of expertise of Nominet's appointed experts is high. Therefore, decisions are mostly consistent and the system is predictable for both complainants and registrants.

Litigation

The effectiveness of Nominet's DRS in terms of speed and cost means that court litigation regarding domain names is rare.

As in other countries, in the early days of the domain name system, the English courts struggled to apply traditional trademark law successfully to disputes relating to domain names. In particular, where a domain name had been registered but had not been linked to a website, the courts concluded that the trademark incorporated in the domain name was not being "used in the course of trade", a fundamental element for infringement. The English Court of Appeal acknowledged that this was an unsatisfactory result and developed with the High Court the concept of a domain name as an 'instrument of fraud': a domain name that incorporates a third party's trademark was, in the courts' view, an instrument of fraud and therefore unlawful (*British Telecommunications Plc v One in a Million Limited* [1998] EWCA Civ 1272).

Conclusion

Nominet is a sophisticated, user-friendly registry that offers significant advantages to users of the '.uk' ccTLD over many other ccTLD and gTLDs. In particular, Nominet's DRS offers brand owners and others an effective mechanism to deal with disputes regarding '.uk' domain names. [WTR](#)