

The Procter & Gamble Company

-V-

Michael Toth

Nominet UK Dispute Resolution Service

Dispute ID 03316

Decision of Appeal Panel

Dated 26 June, 2006

1. PARTIES

Complainant: The Procter & Gamble Company

Address: One Procter & Gamble Plaza
Cincinnati
Ohio
Postcode: 45202
Country: US

Respondent: Michael Toth
Address: PO Box 773,
TC-437
Providenciales
TC
Country: TC

2. DOMAIN NAME

'bounce.co.uk' ("the Domain Name")

3. PROCEDURAL BACKGROUND

- 3.1 For reasons that will become apparent later on in this decision it is necessary to describe in greater detail than usual the procedural background to this case.
- 3.2 On 24 January 2006 notice of this dispute was received by Nominet. The Complaint was received in full on 25 January 2006.
- 3.3 As at 25 January 2006 the Nominet database recorded the Respondent's postal address as it is shown above (which according to the Respondent's agents is an address in the Turks and Caicos Islands) and with the email address michael@toth.biz. In addition, the Respondent is shown as the administrative and billing contact at an address in Ilkley, West Yorkshire and with the email address michaelt@gbhampers.freemove.co.uk. The database indicates

that the “record was created by “Michael Toth” <michaelt@cableinet.co.uk>”. An Ilkley fax and telephone number (i.e. 01943 600096) was also recorded in the database in relation to the Yorkshire address.

- 3.4 On 25 January 2006 Nominet wrote to the Respondent at the Turks and Caicos Islands address. That letter informed him of the fact that the Complaint had been filed, and that he had 15 working days (i.e. until 18 February 2006) within which to respond to the Complaint. The letter enclosed a copy of the Complaint (together with annexes)
- 3.5 On the same day Nominet sent the Complaint to the Respondent and two of the email addresses recorded in the Nominet database i.e. michael@toth.biz, michaelt@gbhampers.freeserve.co.uk. A copy was also sent to the email postmaster@bounce.co.uk. Delivery failure reports were received by Nominet in respect of the emails sent to michaelt@gbhampers.freeserve.co.uk and postmaster@bounce.co.uk. No delivery failure report was sent to Nominet in respect of the email sent to michael@toth.biz.
- 3.6 The Respondent did not file a response within the deadline. On 21 February 2006, not having received any response of any kind from the Respondent, Nominet wrote to the Respondent noting the Respondent’s failure to submit a Response within the deadline and indicating that on payment of the appropriate fees by the Complainant the matter would be passed to an independent Expert for a decision. This letter was emailed to the Respondent at the same three email addresses and it was also faxed to him at the Yorkshire telephone number provided.
- 3.7 A delivery failure report was received by Nominet in relation to its email of 21 February 2006 but only in respect of the email addressed to postmaster@bounce.co.uk. No delivery failure reports were received in respect of the email sent to the other email addresses.
- 3.8 On 22 February 2006, the Respondent telephoned Nominet to say that he had only just arrived at his Turks and Caicos Islands address and had not at that stage opened any of his post. He informed Nominet that the only correspondence that he had read relating to the Complaint was the email of 21 February 2006 referred to above. Nominet confirmed that he had now missed the mediation stage and could not submit a response as the deadline had passed. He was informed however (and this is not in dispute) that he could nonetheless submit a non-standard submission under paragraph 13b of the Procedure.
- 3.9 There is a dispute as to whether or not the Respondent requested an extension of time for filing a response when he telephoned Nominet on 22 February 2006, but Nominet has acknowledged to the Respondent that had such a request been made, the request would almost certainly have been turned down.
- 3.10 In the course of the telephone conversation on 22 February 2006 the Respondent asked that the Complaint be re-sent by email. It was sent by email to michael@toth.biz, which the Respondent confirmed was the correct address. The Respondent emailed back using the michael@toth.biz address asking to be sent the annexes. He was told that these were not digital documents and the offer was made to fax the annexes to Mr Toth if he could confirm his fax number. The only fax number Nominet had was the fax number on the Nominet’s database, an English fax number whereas the Respondent had indicated that he was overseas. There is no record that the Respondent provided Nominet with another fax number.

- 3.11 Notwithstanding the fact that Nominet had informed the Respondent that he could put in a non-standard request, he did not do so.
- 3.12 Informal mediation not being possible in these circumstances, and the Complainant having duly paid the appropriate fees, on 1 March 2006 Steve Ormand (“the Expert”) was appointed to provide an expert decision pursuant to paragraph 7 of the Nominet UK Dispute Resolution Policy (“the Policy”). The Expert provided his decision on 21 March 2006. He concluded that the Complainant had rights in respect of a name, which was identical to the Domain Name. He also found, on the balance of probabilities, that the Respondent had registered the Domain Name for purposes which took unfair advantage of, and were unfairly detrimental to, the Complainant’s rights. He further found that the Complainant had established that the Respondent had engaged in a pattern of registration of domain names which corresponded to, or were similar to, well known marks and that the registration of the Domain Name was part of that pattern. Accordingly, the Expert concluded that the registration of the Domain Name was an Abusive Registration within the meaning of the Policy. He directed that the Domain Name be transferred to the Complainant. The full text of the Expert’s decision is available on Nominet’s website.
- 3.13 On 22 March 2006 Nominet emailed the decision to the Respondent at the same three email addresses and received a delivery failure report in respect of postmaster@bounce.co.uk, but no indication of delivery failure in respect of the other two email addresses.
- 3.14 On 30 March 2006 the Respondent emailed Nominet using the michael@toth.biz email address indicating that he wished to appeal the Expert’s decision. The same day Nominet responded both to the Respondent and his agent confirming that the deadline for the notice of appeal was 4 April 2006.
- 3.15 The Respondent gave notice of intention to appeal to Nominet on 4 April 2006 and lodged a written appeal notice on 27 April 2006. On 5 May 2006 the Complainant lodged a written response to the appeal notice.
- 3.16 On 15 May 2006 Nominet appointed Mr. Tony Willoughby, Mr. Antony Gold and Mr. Matthew Harris as an appeal panel (“the Panel”) to determine the appeal. The case file was duly sent to each of them by Nominet following confirmation by each expert to Nominet that they knew of no reason why they could not properly accept the invitation to act in this case, and knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question their independence and/or impartiality.
- 3.17 The deadline for submitting the Panel’s decision was set by Nominet as 26 June 2006.

4. THE NATURE OF THIS APPEAL

- 4.1 This Panel has considered the nature of this appeal process and the manner in which it should be conducted. 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”.
- 4.2 The Panel concludes that in so far as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits. Accordingly, the Panel does not propose to undertake a detailed analysis of the Expert’s decision and will only refer to the Expert’s decision where the Panel feels it would be helpful to explain any difference in approach.

5. FORMAL PROCEDURAL ISSUES

- 5.1 The Respondent makes a number of assertions in his Appeal Notice in relation to procedural issues. In particular he alleges that:
1. Nominet acted in error when it failed to extend the time limit for the Respondent to file a response under paragraph 12 of the Rules following his alleged request to do so by telephone on 22 February 2006.
 2. The Expert erred in finding that there were no exceptional circumstances in this case that prevented the Respondent from filing a response before going on to give his decision.
 3. In the circumstances, the Panel should exercise its discretion under procedure 18(h) to the extent of the evidence set out in the Appeal Notice.
- 5.2 As has already been described earlier in this decision, there is a dispute as to whether the Respondent requested an extension of time for filing a response on 22 February 2006, but Nominet acknowledges that had such a request been made it would almost certainly have been turned down.
- 5.3 The Panel does not accept the Respondent's assertions that Nominet (even if it refused a request for an extension) or the Expert acted improperly in this case.
- 5.4 Essentially, what lies at the heart of the Respondent's complaints is that he claims not to have been aware of the Complaint until receipt of the email from Nominet dated 21 February 2006. However, if the Respondent did not receive the Complaint in this case it would appear to be due to a failure on the part of the Respondent to keep his contact details up to date with Nominet.
- 5.5 Paragraph 4 of Nominet's Terms and Conditions of Domain Name registration (terms that have been clarity approved by the Plain English Campaign) makes it clear that a registrant has a "duty" to give and keep Nominet notified of the registrant's name, postal address and any phone, fax or email information. Paragraph 7.2 of the same terms makes it clear that any identity and contact information sent to Nominet must be correct. In short, the obligation is on a registrant to keep those details up to date. That a registrant complies with that duty is crucial to the efficient operation of the domain name registry and the DRS procedure.
- 5.6 Paragraph 2 of the DRS Procedure provides as follows:
- (a) We [i.e. Nominet] will send a complaint ... to the Respondent by using, in our discretion, any of the following means:
 - (i) sending the Complaint by first class post, fax or e-mail to the Respondent at the contact details shown as the registrant or other contacts in our Domain Name register database entry for the Domain Name in dispute;
 - (ii) sending the complaint in electronic form (including attachments to the extent available in that form) by e-mail to:
 - A. postmaster@<the Domain Name in dispute>; or

B. if the Domain Name resolves to an active web page (other than a generic page which we conclude is maintained by an ISP for parking Domain Names), to any e-mail address shown or e-mail links on that web page so far as this is practicable; or

(iii) sending the Complaint to any addresses provided to us by any Complainant under paragraph 3(b)(iii) so far as this is practicable.

...

(e) Except as otherwise provided in this Procedure or otherwise as directed by us or if appointed, the Expert, all communications provided for under this Procedure shall be deemed to have been received:

(i) if sent by facsimile, on the date transmitted; or

(ii) if sent by first class post, on the second Day after posting; or

(iii) if sent via the Internet, on the date that the communication was transmitted;

(iv) and unless otherwise provided in this Procedure, the time periods provided for under the Policy and this Procedure shall be calculated accordingly.

5.7 In this case, Nominet sent the Complaint (albeit without annexes which were not available in electronic form) to three email addresses provided by the Respondent to Nominet in respect of the Domain Name. It further sent a fourth copy of the Complaint (together with annexes) by post to the address provided by the Respondent.

5.8 It seems improbable that the Respondent did not receive at least one of these communications. Nominet received no delivery failure in relation to the e-mail sent to Michael@toth.biz and it is clear that the Respondent received e-mails subsequently sent to him at that address by Nominet. However, even if he did not receive the initial e-mail, it makes no difference. Provided that Nominet complies with its obligations as to service under paragraph 2 of the DRS Procedure, the communications are “deemed” to have been received by the Respondent for the purposes of the Policy.

5.9 Should Nominet be criticised if it did not grant the Respondent an extension of time for service of a Response when and if approached by the Respondent in the circumstances of this case seven days after the date that a response was due? The Panel thinks not. Under paragraph 12 of the Rules Nominet “may in exceptional cases extend any period of time in proceedings under the Dispute Resolution Service”. Without intending to tie the hands of Nominet in a future case, the Panel is unconvinced that such exceptional circumstances apply here. Indeed, the Panel is of the view that there are good reasons why Nominet should not have granted an extension. As was stated by the Expert in Ebel SA v Sm@rtNet Limited [2002] DRS251:

“In the Expert’s view it is the responsibility of the Respondent (or in this case Respondent’s officers) to ensure that up to date address details are maintained with Nominet. Failure to ensure that this is done should not in the Expert’s view be allowed to impede the progress of a validly raised complaint.”

5.10 Similarly, the Panel is unconvinced by the suggestion that the use by the Respondent of a postal address in a jurisdiction where communications are likely to take more than two

days to arrive by post would justify an extension. There is nothing wrong per se in choosing a non-UK address for .co.uk domain registration purposes, but that choice on the part of a registrant should not be permitted to impede or delay the progress of the DRS procedure.

- 5.11 Further, Nominet informed the Respondent that he could nonetheless submit a non-standard submission under paragraph 13(b) of the Procedure. Nominet also offered to fax to him the annexes to the Complaint if he provided Nominet with a fax number in order to enable them to do so. The Respondent did not provide a fax number nor was any non-standard submission provided.
- 5.12 In this respect the Respondent states that he was “not then legally represented [and] did not understand [the] nature of “[a] non-standard submission”. However, the Panel finds these assertions unpersuasive. Mr Toth is an experienced registrant. He had already previously been involved in one DRS proceedings. The nature of a non-standard submission is explained on the Nominet website. He does not appear to have asked for clarification in this respect from Nominet.
- 5.13 Similarly, the Panel is of the view that no criticism can be levied against the Expert in respect of his finding that there were no exceptional circumstances in this case such as to merit an extension of time to enable the Respondent to submit a response out of time.
- 5.14 This leaves the question whether under paragraph 18 of the Procedure the Panel should admit further evidence in this case. Paragraph 18 (c), (f) and (h) of the Procedure provide as follows:
- (c) An appeal notice should not exceed 1,000 words, should set out detailed grounds and reasons for the appeal, but shall contain no new evidence or annexes.
 - (f) An appeal notice response must not exceed 1,000 words, should set out detailed grounds and reasons why the appeal should be rejected but should contain no new evidence or annexes.
 - (h) The appeal 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.
- 5.15 The Respondent appears to be suggesting that in this case the admission of new evidence would be “in the interests of justice”. He maintains that where no evidence was admitted at the first stage, the fact that he is not allowed to produce new evidence now is “severely prejudicial”. Not being able to submit evidence is claimed to be “a breach of natural justice”. In making these assertions the Respondent relies upon the Appeal Panel Decision in *Bravissimo v Gander* (2004) DRS1295 which is stated to recognise that the principle of reaching a “fair resolution” (which phrase is taken from section 1(a) of the Arbitration Act 1996) applies to the DRS.
- 5.16 The Panel does not accept that discounting any “new evidence” in accordance with paragraph 18(h) of the Procedure would be contrary to the interests of justice, whether natural or otherwise. Many appeal systems restrict the extent to which new evidence can be considered under appeal.
- 5.17 The Panel’s view is that the Respondent had sufficient opportunity to put in evidence in this case. If it was unable to do so prior to 18 February 2006, that inability is due to the

Respondent's own failure to keep its contact details accurate and up to date. Moreover, on 22 February, when the Respondent was informed of the fact that he could submit a non-standard submission, he declined to take up that opportunity.

- 5.18 The Respondent's reliance upon the Appeal Decision in *Bravissimo v Gander* is of little assistance to him. In that case the panel expressly considered the issue whether the principles developed by the judges in a line of legal authority dealing with the criteria to be applied when considering whether or not to admit fresh evidence in a case after there has been a judgment on the merits be applied to complaints under the administrative DRS Policy and Procedure. It concluded that in general terms it should follow those principles. In doing so it stated:

“the purpose behind adopting principles on the admission of further evidence is to protect the integrity of the DRS. They would do this by encouraging parties to use the DRS sensibly and efficiently. If there were no limits, there would be little incentive (apart from moderate costs to complainants/appellants) for parties to get it right first time. It should not be forgotten that if these principles are to apply, they would apply not just to complaints in the context of re-filed complaints; they apply equally to the filing of further evidence prior to an appeal”.

- 5.19 For the Respondent to be permitted to admit further evidence in this case he must show exceptional circumstances. No such exceptional circumstances exist in this case.
- 5.20 Of course, the fact that the Respondent is not entitled to rely upon further evidence does not preclude him from launching an appeal under the Policy and Procedure. He is still quite entitled to argue in any appeal that on the facts before the Expert, the Expert's decision was wrong.

6. FACTUAL BACKGROUND

- 6.1 The Complainant is an internationally known brand owner. One of its brands, well known to housewives in the UK, is ***BOUNCE***, which embraces a range of fabric products.
- 6.2 The Complainant itself and indirectly through its subsidiaries is the proprietor of a large number of trade mark registrations of, or including as a principal element of the mark, the word ***BOUNCE*** in Class 3 for laundry fabric softeners, bleaching preparations and the like.
- 6.3 The Respondent registered the Domain Name on 31 October 2001.
- 6.4 It is common ground that the Respondent is the proprietor of domain name registrations running into the thousands. It is not in dispute that they include the domain names cited in Nominet DRS case No. 1740, such as '*usedcars.co.uk*', '*shades.co.uk*' and '*toprates.co.uk*'. The Respondent has not denied that they also include the domain names set out in the Complaint (see section 7.1 below) such as '*starlightexpress.co.uk*', '*wimpy.co.uk*', '*conservative-party.co.uk*' and '*derbycountyfc.co.uk*'.
- 6.5 On 27 September 2005 the Complainant's agents wrote to the Respondent seeking transfer of the Domain Name. They wrote to him at the Turks and Caicos Islands address set out above. The letter was returned on the basis that the address was unknown.
- 6.6 The Complainant claims to have learnt (it is not known from whom) that the Respondent had an email address michaelt@blueyonder.co.uk. The Complainant re-sent the letter to that email address on 28 October 2005 but received no reply.

- 6.7 The Complainant invoked the Nominet DRS Policy by filing the Complainant in this administrative proceeding on 23 January 2006.
- 6.8 As at the date of the Complaint the Domain Name pointed to a directory site at www.unitedkingdom.co.uk.
- 6.9 On 23 August 2004 the Respondent was on the wrong end of a complaint filed against him under the Nominet DRS in respect of the domain name universityoflondon.co.uk. The expert in that case found that that domain name in the hands of the Respondent was an abusive registration.

7. PARTIES' CONTENTIONS

7.1 The Complainant

The Complainant contends that:

1. The Domain Name is identical to the mark, **BOUNCE** in which the Complainant has Rights (as defined in paragraph 1 of the Policy) because:

The Complainant (whether directly or indirectly through its subsidiaries) is the proprietor of the trade mark **BOUNCE** which is used in the UK and in the USA in respect of a range of fabric care products.

The Complainant registered **BOUNCE** as a trade mark before the UK Trade Marks Registry, the Community Trade Marks Office and other countries around the world, including the USA (evidence is provided of the Complainant's UK and Community Trade Mark registrations, the UK registrations being in the name of the Complainant's UK subsidiary, Procter & Gamble Limited).

The Complainant has built up a very substantial goodwill and reputation in the **BOUNCE** name, as a result of the use it has made of this trade mark in the UK since 1982 (evidence is provided of the **BOUNCE** range of products which are available in the UK and the USA and extensive advertising and media coverage of those products).

BOUNCE represents about 50-60 per cent of the market share of sheet conditioners.

2. The Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy) because:

There is to the Complainant's knowledge no prior relationship between the Respondent and Complainant or its subsidiary, Procter & Gamble Limited.

The Complainant wrote to the Respondent on 27 September 2005 (copy provided) to the address then provided on Nominet's WHOIS database asking for the voluntary transfer of the Domain Name to the Complainant. The letter confirmed that the Complainant would be prepared to compensate the Respondent for registration and maintenance of the Domain Name up to this date. The letter was returned marked "address unknown". The Complainant discovered the Respondent's email address and re-sent this letter by email on 28 October 2005. The Complainant received no response.

The Complainant and its subsidiary Procter & Gamble Limited have established substantial goodwill and reputation by over 20 years use of the **BOUNCE** brand in the UK. The

Complainant has pertinent trade mark registrations and has made substantial sales of **BOUNCE** products in the UK.

Considering the extent of these sales and the considerable expenditure on advertising the **BOUNCE** products, it is believed that the Respondent must have been aware that the name **BOUNCE** denoted the Complainant's products and trade mark. Thus, the Domain Name was registered primarily to stop the Complainant registering the Domain Name to reflect its trade mark rights and legitimate business interests.

The Domain Name presently redirects to the website www.unitedkingdom.co.uk, which is classified as an online shopping web directory. This site gives no reason as to why the name **BOUNCE** should have been chosen as the Domain Name (screen dumps of the website provided).

It is believed that the Respondent has engaged in a pattern of such behaviour, evidenced by the fact that the Respondent presently holds 2793 '.co.uk' domain names, many of which appear to correspond to the trade mark rights of third parties. Examples include 'conservativeparty.co.uk', 'derbycountyfc.co.uk', 'dylanthomas.co.uk', 'backstreetboys.co.uk', 'starlightexpress.co.uk', 'wimpy.co.uk', 'georgebest.co.uk', 'garfield.co.uk', 'astonmartins.co.uk', 'rangerovers.co.uk', 'lotussportscars.co.uk', 'alfaromeos.co.uk', 'lamborghini.co.uk', 'volvos.co.uk', 'vauxhalls.co.uk', 'stanstedairport.co.uk', 'hondas.co.uk' and 'agassi.co.uk' (evidence is provided of these domain names, and others, being registered to the Respondent).

A previous decision was made against the Respondent in 2003 [sic], ordering the transfer of the website universityoflondon.co.uk to the lawful owner of that name (DRS 1740).

The Respondent has established no legitimate interest under the Domain Name and appears to have engaged in passing off by registering domain names that correspond to the trade mark rights of third parties. This evidences Abusive Registration. The Complainant believes that registration of the Domain Name is detrimental to it by preventing it from establishing legitimate websites under the Domain Name reflecting its established business activities in the **BOUNCE** name in the UK.

7.2 The Respondent

The Respondent's appeal has 3 elements

(1) Procedural

As part of his Appeal, the Respondent takes a number of procedural points relating to issues such as the refusal of Nominet to permit him further time to serve his Response and his request that he be permitted to adduce evidence (incorporated within the Appeal Notice) at this stage. These points and the Panel's decision in relation to them are set out in full at section 5 above.

(2) The Complainant's Rights

- (a) The Respondent does not deny the existence of the Complainant's rights to the Community trade mark, but asserts that it is Procter & Gamble (UK) who hold the UK trade marks and the UK goodwill (if any) in the name **BOUNCE**. The Respondent points out that the

product packaging examined by his representative refers only to Procter and Gamble (UK), not to the Complainant. The Respondent therefore contends that the Complainant's rights are limited to its Community trade mark.

- (b) The Respondent asserts that the Expert erred in finding that the Complainant had built up goodwill in the UK in the name **BOUNCE** as the evidence of advertising and sales submitted by the Complainant post-dated the registration of the Domain Name.
- (c) The Respondent denies that the **BOUNCE** trade mark is 'well known'. He points to a range of authorities in support of a proposition that what should be regarded as a "well known" mark should be very narrowly drawn. The Respondent claims that **BOUNCE** does not satisfy these criteria and therefore cannot form part of a pattern of "well known" marks.
- (d) The Respondent also submits that a trade mark does not equate to a monopoly right in a common word/phrases for all uses and says that this principle is supported in the DRS decisions in respect of the domain names, '[cyclone.co.uk](#)', '[lists.co.uk](#)', '[loan.co.uk](#)', '[webservers.co.uk](#)' and '[phone4u.co.uk](#)' [N.B. There has been no DRS decision in relation to the last of these names. The Panel assumes that this is a reference to the Court of Appeal decision reported at [2006] EWCA Civ. 244].
- (e) The Respondent says that the Complainant's trade mark lacks exclusivity. The Respondent points to the use of 'bounce.com' by Tower Records, Japan without complaint by the Complainant, to unsolicited offers to buy the Domain Name from third parties who wanted to use it for purposes unconnected with the Complainant and to widespread legitimate third-party registrations for "bounce" at Companies House, OHIM and the Patent Office.

(3) Abusive Registration

- (a) The Respondent denies that the Domain Name is an Abusive Registration. He claims that the Domain Name was not registered, nor was it used to take unfair advantage of, or be unfairly detrimental to, the Complainant's rights. The Respondent denies that he was aware of the Complainant's product or rights when registering the Domain Name and says that the lack of evidence of his intent is material. He draws attention to the Expert's finding that the Respondent may have registered the Domain Name with a legitimate purpose in mind and contends that the Domain Name was registered due to the generic nature of 'bounce.'
- (b) The Respondent asserts that the Complainant has not been blocked in its use of potential domain names for its brand. For example he says that the Complainant registered '[bouncesheets.com](#)' in 1999, but did not register '[bounce.co.uk](#)' at the same time, despite its availability for registration. The Respondent says that the Complainant has now registered '[bounce.eu](#)'.
- (c) The Respondent submits that there is no confusion/likelihood of confusion between himself and the Complainant, nor has his use of the Domain Name suggested the type of association described in paragraph 3 (a)(ii) of the Policy.
- (d) The Respondent claims that the Expert erred in finding, in respect of paragraph 3(a)(iii) of the Policy, that the Domain Name formed part of a pattern of domains corresponding with 'well-known' trade marks, as the Respondent has numerous generic domains, the Domain Name being one of them. He also comments that there is nothing objectionable per se in

dealing in domains as was shown in the DRS decisions relating to 'gdh.co.uk' [sic] and 'parmaham.co.uk'.

- (e) The Respondent claims that although some of his generic sites have yet to be developed, he is making 'fair use' of them as set out in paragraph 4(a)(ii) of the Policy by pointing them at directory pages. Further or alternatively, the Respondent claims that, in accordance with paragraph 4(a)(i)(A) of the Policy, the Domain Name has been used in connection with a genuine offering of goods and services since 2002. The Respondent therefore contends that he is making 'acceptable use' of a generic domain.
- (f) The Respondent also comments that he has not approached the Complainant nor any of the Complainant's competitors regarding the Domain Name.

7.3 Complainant's Appeal Response

The Complainant responds as follows:

1. The Complainant accepts that in future complaints it would be better to include all relevant Procter & Gamble companies as joint complainants in order to allow the Expert to consider the full extent of rights. However, it contends that it does not matter in this case since Procter & Gamble Limited is a wholly owned subsidiary of the Complainant, and the Expert was correct in his conclusions that any goodwill developed as a result of the use of the trade mark **BOUNCE** will ultimately accrue to the Complainant.
2. Further and in any event the Complainant should nevertheless succeed on the basis of Community Trade Mark No. 200089 (which it is clear from evidence filed with the original Complaint is owned by the Complainant) "and that this trade mark dates from 9 April 1996 and therefore substantially predates the registration of the Domain Name on 31 October 2001".
3. As to the state of the Respondent's knowledge of the Complainant's trade mark at the relevant time, the Complainant repeats its assertions that "**BOUNCE** is a significant product in the UK".
4. On the issue of a pattern of abusive registrations, the Complainant simply asserts that it is significant that the Respondent does not deny that the 2793 '.co.uk' domain names, many of which correspond to famous trade mark rights, are held by the Respondent.

8. DISCUSSION & FINDINGS

8.1 General

- 8.1.1 As indicated above the Panel sees no reason why the Respondent should be precluded from appealing the decision of the Expert. The Respondent has paid the requisite fee in time and has complied with the Procedure in this regard.
- 8.1.2 As also indicated above this Appeal is effectively a full re-hearing of the case on the facts and submissions before the Expert as amplified by the parties' appeal submissions.

- 8.1.3 The Respondent's appeal submissions include factual assertions made on the Respondent's behalf by the Respondent's agent. As indicated and for the reasons given above, the Panel declines to admit this further 'evidence' (such as it is) into the Appeal and, save where indicated, the members of the Panel have done their best to ignore it.
- 8.1.4 To succeed in this Complaint the Complainant had to prove to the Expert (and now has to prove to this Panel) pursuant to paragraph 2 of the DRS 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, second, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of DRS Policy).

8.2 Rights

- 8.2.1 Paragraph 1 of the Policy defines 'Rights' as including, but not being limited to, rights enforceable under English law.
- 8.2.2 The Respondent admits the Complainant's rights to its Community Trade Mark (a mark that dates back to 1996). Accordingly, there is no dispute that the Complainant has Rights in the name or mark, **BOUNCE**, which is identical to the Domain Name, if, as is appropriate for this purpose in this case, one ignores the generic domain suffix. The Panel so finds. This is sufficient to satisfy Paragraph 1 of the Policy.
- 8.2.3 Given this finding it is not necessary under this limb of the DRS Policy for the Panel to address the Respondent's contentions regarding the Complainant's alleged common law rights. Nevertheless, given that the degree of fame in the **BOUNCE** name at the time of registration of the Domain Name is a matter of relevance to the question of abusive registration the Panel will do so.
- 8.2.4 First, the Respondent argues that the UK common law rights in respect of the mark, **BOUNCE**, lie with the Complainant's UK subsidiary, Procter & Gamble Limited, and not with the Complainant. The Panel very much doubts that this is the case. Given the co-existence of the UK trade mark registrations in the name of the subsidiary and the CTM registration in the name of the Complainant, the Panel is of the view that at the very least the UK common law rights will be shared.
- 8.2.5 Even if the Respondent is correct and in law the Complainant has no relevant common law rights in the UK, the definition of "Rights" in paragraph 1 of the DRS Policy expressly includes rights not enforceable in the UK. Accordingly, any common law rights of the Complainant in the US will be relevant.
- 8.2.6 Insofar as 'degree of fame' is concerned (see paragraph 8.2.3 above), these legal technicalities are irrelevant. In Internet terms, fame is capable of being universal. The fact (if it be a fact) that the UK goodwill in **BOUNCE** is owned by the Complainant's UK subsidiary is of no assistance to the Respondent in determining whether or not the brand, a brand launched by the Complainant in the US in 1972, is well-known.
- 8.2.7 Secondly, the Respondent argues that the Complainant's claims to common law rights are based on evidence post-dating registration of the Domain Name.

- 8.2.8 The Complainant has provided details of advertising expenditure in the “financial year 2001/2002” but the dates of the relevant financial year and details of exactly when that expenditure was incurred are not provided. Hard evidence to support the claim to common law rights pre-dating that financial year is also sparse in the extreme. Nevertheless, this administrative proceeding is not a court process; it is intended to be a relatively simple, user-friendly method of adjudicating domain name disputes. The Panel is permitted to use a measure of common sense. In this regard it is to be noted that in the Complaint and its annexes various factual claims are made by the Complainant, none of which are challenged by the Respondent. For example, the brand was launched in the USA in 1972 and in the UK in 1982 and astronomical sums of money have been invested in the brand in the UK from at least 2001 onwards.
- 8.2.9 While it would have been helpful to the Panel for evidence to have been produced particularising the sales and advertising of the product occurring prior to the registration of the Domain Name in late 2001, the Panel is entitled to conclude on the balance of probabilities that even if a large part of the 2001/02 expenditure had not taken place prior to the date that the Domain Name was registered, it nevertheless represented a continuation of investment from previous years.
- 8.2.10 In short, the Panel is prepared to accept that BOUNCE was already a very well known name at least insofar as fabric softeners are concerned as at the date of registration of the Domain Name on 31st October 2001.

8.3 Abusive Registration

- 8.3.1 Abusive registration is defined in paragraph 1 of the DRS Policy as follows:-

“Abusive registration means a domain name which either:

- (i) was registered or otherwise acquired in a manner which, at the time 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.”

- 8.3.2 The Complainant claims that the Respondent registered the Domain Name primarily with a view to preventing the Complainant from registering the Domain Name to reflect its trade mark rights pursuant to paragraph 3 a i B of the DRS Policy. The Complainant claims that this is part of a pattern of behaviour indulged in by the Respondent and points to a number of domain names held by the Respondent which feature the well-known names and trade marks of others.
- 8.3.3 The Respondent does not deny that he holds domain names featuring the well-known trade marks of others. He merely says in an unsigned document filed by his agent that (a) he holds many thousands of domain name registrations many of which are generic and (b) the Domain Name falls into the generic category and he

registered it as a generic word. He goes on to say that when he registered the Domain Name he was unaware of the Complainant's product and rights.

- 8.3.4 The Panel believes it most unlikely that the Respondent's primary purpose in registering the Domain Name was to block the Respondent. If, contrary to the Respondent's denial, the Respondent had the Complainant's trade mark in mind at the time, it would have been much more likely that the primary purpose was to attract visitors to the Respondent's website, the visitors being Internet users looking for the Complainant's product.
- 8.3.5 Is the Panel restricted to the Complainant's head of claim or is it permissible for the Panel to decide that the Domain Name is an Abusive Registration for a reason not advanced by the Complainant? The Panel's task is to assess on the basis of the material before it whether or not the Domain Name is an Abusive Registration within the definition set out in paragraph 1 of the DRS Policy. If the evidence supports a finding of Abusive Registration, the Panel is entitled to make such a finding irrespective of whether or not it is on the basis put forward by the Complainant.
- 8.3.6 For a domain name to constitute an Abusive Registration under sub-paragraph (i) of the definition it will normally be the case that at time of acquisition/registration of the domain name the registrant will have knowledge of the complainant's name and/or rights; similarly, for a domain name to constitute an Abusive Registration under sub-paragraph (ii) of the definition, the registrant will normally be aware of the complainant's name and/or rights when using the domain name in the manner complained of.
- 8.3.7 While there may be rare circumstances where a finding of Abusive Registration is justified even though the registrant is unaware of the complainant's name and/or rights at the relevant time, this is not such a case. For the Complaint to succeed, the available evidence must suggest that at the relevant time the Respondent knew perfectly well that **BOUNCE** was a brand belonging to someone else and that its use in the manner made of it by the Respondent would be likely to attract Internet users to the Respondent's site believing that they were visiting a site associated with the brand owner.
- 8.3.8 This is far from a clear cut case and one with which the Panel has had some difficulty, but on balance the Panel believes that the registration should be treated as abusive. The difficulty stems from the fact that the word 'bounce' is an ordinary dictionary word, a word, which anyone might have registered for a host of different, but justifiable, reasons. The mere fact that a generic word happens also to be a trade mark cannot lead to the trade mark owner monopolising all uses of the word. Certainly for the purposes of complaints under the DRS Policy there has to be something more.
- 8.3.9 In this case what there is in addition is the following:
- (1) the fact that the Respondent has amongst his portfolio of domain names a number of names featuring the well-known trade marks of others – he therefore has a track record of hijacking other people's names.

- (2) for the reasons described earlier in this decision the Panel is satisfied that by the date of the registration of the Domain Name the **BOUNCE** brand was very well-known at least in its niche market
- (3) the Complainant expressly alleges in the Complaint that the degree of fame of the **BOUNCE** brand was such that the Respondent “must have been aware that the name Bounce denoted [the Complainant’s] products and trade marks”. There is no admissible challenge to that allegation.
- (4) no explanation is given by the Respondent as to why he selected the name **BOUNCE** Even where a generic word has been chosen for registration there is usually a reason why that generic name rather than some other generic word has been chosen. If, for example, the Respondent’s evidence had been to the effect that he had registered other similar names such as ‘hop’, ‘skip’ or ‘jump’, the registration of “bounce” would have been more readily understandable. However, no such evidence or explanation is offered in this case.
- (5) the web site to which the Respondent has linked the Domain Name has no connection with the word **BOUNCE**.
- (6) the Respondent selected as a registration address an address consisting of little more than a PO Box number in the Caribbean in circumstances where (for the reasons set out in greater detail in section 5 above) he should have been fully aware of the importance of providing readily accessible addresses for the Whois database and an address, which he acknowledges is likely to be susceptible to extensive postal delays. It is well-known to the members of this Panel that ‘cybersquatters’ commonly adopt remote addresses for the Whois database so that it is difficult for potential complainants to track them down. In this case (and as is described in detail in section 3 of this decision) the data that Nominet had for the Respondent also included an address in Yorkshire. However, this is data that was not available in the publicly accessible Whois database, where the only contact details provided were the Respondent’s Turks and Caicos address. This is perhaps by itself not the most compelling of factors, but absent an explanation from the Respondent as to why such a Turks and Caicos address was chosen, it is a factor that tells in the Complainant’s favour.

In sum, the Panel concludes on the balance of probabilities that when the Respondent registered the Domain Name he knew that it was a brand name and registered it for that very reason.

8.3.10 As a brand name the name **BOUNCE** is desirable from the Respondent’s point of view. It is liable to attract Internet users to his directory website, being Internet users expecting to visit a site concerned with the Complainant’s brand, and thereby resulting in business opportunities of one kind or another for the Respondent. In so using it he causes deception.

8.3.11 The Panel finds on the balance of probabilities that the Domain Name was registered in a manner which, at the time the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant’s rights and that the Domain Name has been used in a manner which has taken unfair advantage of the Complainant’s rights.

8.3.12 This decision has been made by the Panel on the basis that it would be inappropriate for it to have regard to any additional evidence in the Appeal Notice. In practice, however, the Panel has necessarily been aware of the additional material which the Respondent has sought to submit. It consists of the following:

- (1) An assertion in the unsigned Appeal Notice filed under the name of the firm of solicitors appointed by the Respondent that “The Respondent was not aware of the Complainant’s products or rights when registering the name”; and
- (2) An assertion in the same document (without further elaboration) that the Domain Name “was registered due to [its generic nature]”.

8.3.13 Whilst the Panel has not formally had regard to the additional material submitted by the Respondent for the purpose of reaching its decision, it is satisfied that, even if the material had been taken into account, the decision would have been the same. It would be necessary for a respondent in these circumstances to provide compelling evidence on its motive for registration of the domain name in issue, this being of central importance in this case. All that the Respondent has provided is a short, bald and unsupported assertion made by an agent. This would not have been sufficient in this case.

9. DECISION

- 9.1 The Panel dismisses the appeal and directs that the Domain Name, ‘bounce.co.uk’, be transferred to the Complainant.

Matthew Harris

Tony Willoughby

Antony Gold

26 June, 2006