



opticaexpressruinedmylife.co.uk: not an abusive domain name registration

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*DCM (Optical Holdings) Ltd v Sasha Rodoy*¹

Nominet has refused to order the transfer of the domain name opticaexpressruinedmylife.co.uk to the owners of Optical Express, DCM (Optical Holdings) Limited (DCM), finding that the domain name is not an abusive registration as its purpose is the genuine criticism of Optical Express. This decision is interesting as it differs from an earlier Nominet decision, in respect of a Ryanair criticism website located at ihateryanair.co.uk, as to the degree to which a registrant's commercial gain can taint an otherwise good faith registration.

Background

Nominet is the organisation that manages the .uk top level domain. As part of this function it offers a dispute resolution service for .uk domain names. If mediation of the dispute fails, then it is referred to an independent expert for determination.

Facts

Sasha Rodoy is a private individual. She suffered problems following laser eye surgery performed by Optimax, a competitor of DCM, and pursued legal action against them. Consequently she registered the domain name optimaxruinedmylife.co.uk

and set up a website inviting other Optimax patients that had suffered post-surgery problems to contact her.

Mrs Rodoy also received complaints from patients of DCM following surgery at Optical Express clinics and was urged to set up a companion site under the domain name opticaexpressruinedmylife.co.uk (the Domain) and which she duly registered on 19 April 2012.

Consequently, DCM filed a complaint with Nominet alleging that the Domain was an abusive registration for the following reasons:

- the Domain implied that DCM's services were not of appropriate standards;
- the purpose of the Domain was to damage and disrupt DCM's business;
- Mrs Rodoy was seeking to leverage benefits from DCM;
- Mrs Rodoy was taking unfair advantage of the Optical Express name and registered trade mark;
- non-English speaking users would be unable to differentiate between the Domain and the Optical Express domain registered and operated by DCM;

Any comments or queries

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- at the time of filing the complaint the Domain resolved to a holding page giving the impression that the Domain was for sale; and
- the Domain breached DCM's intellectual property rights and Nominet's terms of registration.

Decision

Pursuant to the Nominet dispute resolution service policy (the Policy), a domain name will be considered an abusive registration if it takes unfair advantage or is unfairly detrimental to a complainant's rights or is used in a manner which takes unfair advantage or is unfairly detrimental to a complainant's rights. A non-exhaustive list of factors which may be relevant in assessing whether a domain name is an abusive registration are also set out in the Policy.

One such factor is the degree to which the commercial motives of a registrant can undermine the purported purpose of the domain name and website, such as a criticism website. For example, the expert in Nominet decision DRS 08527 *ihateryanair.co.uk* (the Ryanair decision) said that "*criticism websites are essential in a democratic society, but if they draw in users using a domain name containing a company's brand then they must be wholly devoted to honest criticism and open discussion and not potentially tainted by commercial concerns*". In that decision, it was determined that the £322 of advertising revenue generated through *ihateryanair.co.uk* was sufficient to taint the registration and for it to be considered an abusive registration.

The expert in this decision (concerning DCM) took a different view, deciding that where the commercial concerns in respect of the use of a domain name are de-minimis and clearly incidental it is not necessarily always unfair for a critic to obtain some income (eg general advertising or donations) to maintain its website.

Having considered the relevant factors, the expert determined that the Domain name was not an abusive registration. He found that the expression "X is unfair" is likely to be perceived by any ordinary reader as an expression of personal opinion/emotional hyperbole and people are entitled to differences of opinion and so the Domain name is not intrinsically unfair. Further, no organisation, however high its standards, can avoid adversely affecting someone and Mrs Rodoy has legitimate reasons to be championing the cause of patients adversely affected by laser eye surgery performed by DCM. As to the allegations that Mrs Rodoy had commercial motives, the expert found there was no evidence to support this. Indeed, the evidence showed that the only benefits Mrs Rodoy sought to exploit from DCM (and had success in obtaining) were for adversely affected patients, and the expert decided that the use of criticism to achieve such benefits would hardly qualify as unfair.

Comment

This decision is a useful discussion of the factors that Nominet will consider when assessing abusive registrations for criticism websites incorporating a complainant's trade mark in the domain name. As the expert summarised, a registration will not be abusive if "*...the Domain Name itself makes it abundantly clear that there is no connection between the Domain Name and the trade mark holder and leaves internet users in no doubt as to what type of content to expect when accessing the corresponding website... [and where] the Domain Name does not exactly match the Complainant's trade mark and neither is it likely to cause any confusion in the minds of internet users*". However, in light of this expert's approach conflicting with the expert in the Ryanair decision, there is some uncertainty going forward as to whether de-minimis commercial interests will be viewed by Nominet as tainting otherwise bona fide registrations or not.