

**DISPUTE RESOLUTION SERVICE**

**D00012438**

**Decision of Independent Expert**

Blake Laphorn

and

Ittou Services Ltd

**1. The Parties**

Complainant: Blake Laphorn  
New Kings Court  
Tollgate  
Chandler's Ford  
Eastleigh  
Hampshire  
SO53 3LG  
United Kingdom

Respondent: Ittou Services Limited  
5 Dundas Avenue  
Torrance  
Glasgow  
East Dunbartonshire  
G64 4BD  
United Kingdom

**2. The Domain Name**

blaw.co.uk

**3. Procedural History**

- 3.1 On 6 February 2013 the complaint was received. On 7 February 2013 the complaint was validated and notice of it sent to the Respondent. On 8 February 2013 the response was received and notified to the Complainant. On 8 February 2013 the reply was received and on 11 February 2013 it was notified to the Respondent. On 11 February 2013 the mediator was appointed, on 14 February 2013 the mediation started and on 12 March 2013 the mediation failed. On 18 March 2013 the expert decision payment was received.
- 3.2 On 3 April 2013 Patricia Jones ("the Expert") confirmed to Nominet that she knew no reason why she could not properly accept the invitation to act as expert in DRS 12438 and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might call into question her independence and/or impartiality.

**4. Factual Background**

- 4.1 The Complainant is a full service UK law firm with offices in London and the South East. Its roots date back to 1733. The Complainant has gone through a number of name changes over the years: in 1869 it became 'Blake'; in 1883 'Blake Reed & Laphorn'; in 1922 'Blake Laphorn & Roberts'; in 1930 'Blake Laphorn Roberts & Rea'; in 1962 'Blake Laphorn Rea &

Williams'; in 1983 'Blake Laphorn'; in 2003 'Blake Laphorn Linnell'; in 2006 'Blake Laphorn Tarlo Lyons'; and finally in 2008 'Blake Laphorn'.

- 4.2 The Complainant's turnover over recent years is as follows: in 2008 £50.7 million, ranked 57<sup>th</sup> in the Lawyer UK 200 list of largest UK law firms by revenue; in 2009 £47.9m, ranked 60<sup>th</sup>; in 2010 £45m, ranked 60<sup>th</sup>; in 2011 £44.3m, ranked 61<sup>st</sup>; and in 2012 £45.7m, ranked 60<sup>th</sup>.
- 4.3 The Complainant owns the following UK registered trade marks:
- (a) No 2541914 for BLAKE LAPHORN registered on 23 July 2010 in classes 9, 16, 35, 36, 41 and 45;
  - (b) No 2541925 for the figurative mark BLAKE LAPHORN registered on 23 July 2010 in classes 9, 16, 35, 36, 41 and 45;
  - (c) No 2458987 for BL FOCUS registered on 30 November 2007 in class 45; and
  - (d) No 2541918 for BLLAW registered on 23 July 2010 in classes 9, 16, 35, 36, 41 and 45.
- 4.4 The Complainant uses the domain names bllaw.co.uk and blclaims.co.uk which were registered (respectively) on 12 March 2003 and on 27 October 2010. The number of visits to and page views of the Complainant's site at bllaw.co.uk are as follows: in 2010 255,333 visits and 1,174,634 page views; in 2011 353,093 visits and 1,236,450 page views; and in 2012 333,596 visits and 986,706 page views. The current average number of monthly visits is around 35,000.
- 4.5 The Respondent is a computer consultancy company specialising in project management within the UK financial services industry. On 6 March 2011 the Respondent registered the Domain Name. At the same time the Respondent registered a number of other 4 letter domain names including: awns.co.uk; awee.co.uk; bosk.co.uk; ajee.co.uk; awny.co.uk; agly.co.uk; hant.co.uk; hies.co.uk; geed.co.uk; gaud.co.uk; gowk.co.uk; gapy.co.uk; gyri.co.uk; gaun.co.uk; herl.co.uk; gies.co.uk; fyke.co.uk; goas.co.uk; caph.co.uk; coky.co.uk; foin.co.uk; fohn.co.uk; fyce.co.uk; fummy.co.uk; cepe.co.uk; coly.co.uk; and fley.co.uk<sup>1</sup>.
- 4.6 The Respondent has received e-mails dated 21 May 2012, 22 June 2012, 4 July 2012, 19 July 2012, 24 October 2012 and 30 January 2013 which were intended for the Complainant. These e-mails were sent to info@blaw.co.uk. The Complainant has an e-mail address info@bllaw.co.uk.
- 4.7 On 30 January 2013 Mr McNeill, a director of the Respondent, e-mailed the Complainant's IT Director, Vivien Eaden, in the following terms:
- "My name is Malcolm McNeill an IT consultant from Glasgow.*
- One of my subsidiary businesses is the acquisition of domain names, some which are developed and others an investment.*
- I have owned [the Domain Name] for the past 2 years and during this time, it has been established to offer basic click –thru legal services.*
- Over the past 2 years I have received several e-mails from clients mistaking my site for yours, the latest one only today, which I immediately forwarded to your info@bllaw.co.uk address.*
- With this in mind would your organisation be interested in acquiring [the Domain Name] to ensure further errors could be avoided.*

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<sup>1</sup> The Expert's own enquiries indicate that hies.co.uk and herl.co.uk were registered on 7 March 2011 but nothing turns on this and they can be considered as being registered at the same time as the Domain Name.

*If so, please let me know and I will arrange to pass you to the domain auction site commissioned to deal with this matter.”*

- 4.8 On registration the Domain Name was parked on Sedo and used to advertise links to various legal websites. Subsequently the Respondent built a website at the Domain Name. On 8 May 2012 the website was headed ‘b-LAW’ with the strapline “*If it’s legal you need then let it b-LAW*”. There were three columns on the site. The first headed “*Speak to a lawyer ONLINE NOW! For immediate access to a reputable lawyer use the box below to ask the question and get an immediate response*”. The box referred to was headed “*Ask a Lawyer Online A lawyer will answer you ASAP-24/7*”. It featured a space to type the legal question and submit it. The second column was headed “*Download legal documentation*” with a click through to buy the legal documents of Netlawman. The third column was headed “*Create a Will*” with a click through to wills.org.uk which allows users to write a will online without using third parties such as a solicitor. The Respondent’s name was in a copyright notice on the bottom of the site.
- 4.9 The Respondent currently has 444 domain names listed for auction on Sedo including the Domain Name at a list price of £750.

## **5. Parties’ Contentions**

- 5.1 I set out below a summary of what I regard to be the main contentions of the parties.

### **The Complainant’s complaint**

- 5.2 The Complainant submits it has rights in respect of a name or mark which is identical or similar to the Domain Name:
- (a) The Complainant says it has built up considerable goodwill in the name ‘Blake Laphorn’ which is often shortened by the Complainant and its clients to ‘BL’. The Complainant asserts the goodwill enjoyed by it in the name ‘Blake Laphorn’ affords it protection over the shortened version ‘BL’ and as a result of the services provided by the Complainant over the marks ‘BLLAW’ and/or ‘BLAW’.
  - (b) The Complainant relies on its UK registered trade marks.
  - (c) The Complainant contends that the mark ‘BLLAW’ is visually, aurally and conceptually highly similar to ‘BLAW’.
- 5.3 The Complainant asserts that the Respondent registered the Domain Name for the purpose of selling it to the Complainant at a price greater than its cost:
- (a) The Complainant relies on the content of the Respondent’s e-mail dated 30 January 2013 (see paragraph 4.7) and also says this is indicative of the Respondent’s intention at the time of registration to sell the Domain Name to the Complainant at an inflated price.
  - (b) The Complainant submits the £750 price on Sedo for the Domain Name is an opening bid, that the final purchase price is likely be significantly in excess of this and that this price is greater than the costs of the Domain Name (likely to be £10-15).
- 5.4 The Complainant submits that given its reputation and goodwill in the marks ‘BLLAW’ and ‘Blake Laphorn’, shortened to ‘BL’ and/or ‘BLLAW’, the Respondent’s registration and use of the Domain Name was intended to take unfair advantage of the Complainant’s reputation and/or to unfairly disrupt the Complainant’s business. The Complainant says the Respondent knew or should have known of the Complainant’s reputation when the Domain Name was registered. The Complainant says that until mid 2012 the Respondent used the Domain Name to advertise links to various websites and thereafter hosted a website at the Domain Name which offers competing legal services. Accordingly, the Complainant submits

that the Respondent would have become aware of the Complainant and its rights from the Respondent's due diligence prior to registering the Domain Name. The Complainant contends the Respondent deliberately chose a similar domain name to the Complainant's to take unfair advantage of the same by offering identical services to those of the Complainant.

- 5.5 The Complainant submits the Respondent has no rights or legitimate interests in the names 'BLAW' or 'BLLAW'. The Complainant says the Respondent has no association with the Complainant, nor has the Complainant licensed or otherwise permitted the Respondent to use its mark or to apply for any domain names incorporating its mark or a similar mark. The Complainant also says the Respondent is not known under the names 'BLLAW' or 'BLAW'.
- 5.6 The Complainant contends the Domain Name is being used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's rights. The Complainant relies on the instances of confusion among its clients/potential clients referred to in the e-mail of 30 January 2013. The Complainant says that communications sent to it are highly confidential and it is concerned that they have, as result of confusion, been sent to the Respondent in error. The Complainant asserts the Respondent's use of the Domain Name in purporting to provide legal services has confused Internet users into mistakenly believing that the Domain Name, and the site at the Domain Name, is registered to, operated or authorised by or connected with the Complainant. The Complainant says that by using the Domain Name, the Respondent is trying to direct Internet users who misspell 'BLLAW' to the Respondent's website which also offers legal services and the e-mail of 30 January 2013 demonstrates that this has happened. The Complainant submits the Domain Name is an Abusive Registration because the Respondent has registered the Domain Name for the purpose of unfairly disrupting the Complainant's business. The Complainant says the website at the Domain Name is basic and causes detriment to the Complainant's goodwill by diluting the Complainant's brand.

#### **The Respondent's response**

- 5.7 The Respondent says the Domain Name was registered on 6th March 2011 as part of a range of 4 letter domain names purchased at this time as a domain investment portfolio. The Respondent states it accessed [scrabble.org.au/words/fours.htm](http://scrabble.org.au/words/fours.htm) and registered whatever names had not previously been registered.
- 5.8 The Respondent says the word 'blaw' has some potential domain value, as it is a Scots slang word for 'blow'. The Respondent says it checked the potential traffic for the Domain Name on [estibot.com](http://estibot.com), which suggested average monthly searches of 10,125 (current), and then parked the Domain Name, along with the other domain names, on [sedo.com](http://sedo.com). The Respondent says the £750 value for the Domain Name was based upon the Estibot estimate of \$750.
- 5.9 The Respondent states the Domain Name earned only 0.29 Euros when parked which made the Respondent think about creating a mini-site which it did last year. The Respondent says the site is one page containing affiliate adverts with a legal slant; that it looks nothing like the Complainant's sleek, professional site; that it does not purport to be the Complainant's site; and it is clearly stated that the site belongs to the Respondent.
- 5.10 The Respondent states that according to the AdSense report for the Domain Name it has received 81 page views; 2 clicks; CPC of £0.53; and earnings of £1.06. The Respondent says that in the past month the 'click-thru' adverts for [wills.org.uk](http://wills.org.uk) and [NetLawman](http://NetLawman) received 5 clicks and 6 clicks respectively generating no revenue. The Respondent states that, according to Google Analytics, between 1 May 2012 and 7 February 2013 the website at the Domain Name received 96 visitors (predominantly from the UK) with 121 page views.

- 5.11 The Respondent states it is a part time 'domainer' with around 500 domain names in its portfolio, including two domain names which it has developed. The Respondent says it purchased the Domain Name with no knowledge of the Complainant's brand and it was unaware of the Complainant until receipt of the e-mails intended for the Complainant. The Respondent contends that the Complainant is unknown in Scotland. The Respondent states the Domain Name was purchased without malicious intention; it has no cyber squatting intentions; and it has been co-operative by forwarding important documentation in a pleasant and business-like manner. The Respondent says it may have been naive in approaching the Complainant to buy the Domain Name to protect future correspondence going astray and this was not a malicious act.
- 5.12 The Respondent denies that Internet users will be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant as the site at the Domain Name states that it is owned by the Respondent.
- 5.13 The Respondent argues that the Complainant's site at bllaw.co.uk could be gaining mistyped traffic from Bloomberg Law's site at blaw.com. The Respondent says the Complainant purchased bl-law.co.uk in the past and queries why the Domain Name was not secured at that time. The Respondent says other domain names for 'bllaw' are currently available.

#### **The Complainant's Reply**

- 5.14 The Complainant submits that the Respondent was, at the time of registration, well aware of the Complainant and its rights and registered the Domain Name to take advantage of the Complainant's rights.
- (a) The Complainant relies on the goodwill enjoyed by it as set out in the complaint.
- (b) The Complainant says the Respondent would have identified the Complainant's website and rights from the Respondent's due diligence when determining the domain names to purchase. The Claimant says the Respondent would have carried out internet searches to identify any potential conflicts which would have included searching for potential typographical errors.
- (c) The Complainant doubts the Respondent's explanation for registering the Domain Name based on the use of an Australian Scrabble word generating website. The Complainant notes that the site features 5,526 words; the Respondent claims to have registered "*whatever names had not previously been registered*"; and argues that it is highly unlikely only 28 of those words were, at that time, unregistered. The Complainant asserts the Respondent carried out further research when choosing the domain names to be registered in order to identify the value of such domain names.
- (d) The Complainant says the Respondent has not explained why 'blaw' being Scottish slang for 'blow' would lead it to register the Domain Name.
- 5.15 The Complainant says the purchase of the Domain Name as part of a domain name investment portfolio demonstrates that the Respondent registered the Domain Name for the purpose of selling, renting or otherwise transferring the Domain Name to the Complainant (or a competitor) at a price in excess of its costs.
- 5.16 The Complainant contests the Respondent's claim that it checked the potential traffic on estibot.com in March 2011 which gave average monthly searches of 10,125. The Complainant says it obtained this figure from the Estibot site on 8 February 2013, the date of the reply. The Complainant also says the Respondent has provided no evidence that the starting auction price for the Domain Name came from an estimate provided by Estibot or in relation to the monies earned from the site at the Domain Name.

- 5.17 The Complainant disputes that the site at the Domain Name "*contains affiliate adverts with a legal slant*" and says the site offers legal services. The Complainant asserts that if the Respondent was not aware of the Complainant at the time of registration of the Domain Name then the Respondent became aware of the Complainant having registered the Domain Name and, having achieved little success in monetising the Domain Name as a parking site, proceeded to create a website that would take advantage of the Complainant's Rights.
- 5.18 The Complainant contends that consumers would likely disregard or not read the footer on the site which states the site belongs to the Respondent. The Complainant further contends that if consumers read the footer then they would assume it is a reference to the Complainant's web developer. The Complainant argues it is an industry standard for web developers to include their names on the footer and that the Respondent has a name that consumers would identify with a web developer.
- 5.19 The Complainant alleges that by reason of the similarity between the Domain Name and the Complainant's domain name, Internet users have been confused into contacting the Respondent by e-mail instead of the Complainant. The Complainant is concerned there are more instances of confusion than the e-mails which the Respondent has provided and is concerned that the Respondent has received highly confidential information. The Complainant argues this makes the Respondent's actions in registering the Domain Name, with the intention of causing such confusion and either benefitting directly through increased use of its site/services or indirectly through forcing the Complainant into paying an inflated value for the Domain Name, all the more serious.
- 5.20 The Complainant says it is in the business of providing legal advice and not in building up a portfolio of domain names. The Complainant states it registers those domain names of most importance to it and does not register every single possible misspelling of its trade marks, dealing with cyber-squatting when it occurs.

## **6. Discussions and Findings**

- 6.1 Paragraph 2 of the Nominet Dispute Resolution Service Policy ("the Policy") sets out that for a Complainant's complaint to succeed it must prove to the Expert that:
- i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 6.2 The Complainant is required to prove to the Expert that both the above elements are present on the balance of probabilities.

### **The Complainant's Rights**

- 6.3 Under Paragraph 1 of the Policy, Rights is defined as "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*". It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.
- 6.4 In this case the Complainant has a UK trade mark registration for BLLAW in relation to its products and services, including legal services. I am therefore satisfied that the Complainant owns Rights in the BLLAW mark.
- 6.5 I consider that the BLLAW mark is identical or similar to the Domain Name (disregarding the .co.uk suffix). Although there are some differences between the pronunciation of BLLAW and blaw, overall the marks are very similar differing only by the extra 'L'. This conclusion is

supported by the fact that there is evidence in this case of actual confusion between the marks.

- 6.6 I therefore find that the Complainant has Rights in a name or mark, BLLAW, which is identical or similar to the Domain Name.

**Abusive Registration**

- 6.7 It now has to be considered whether the Domain Name, in the hands of the Respondent, is an Abusive Registration. Paragraph 1 of the Policy defines Abusive Registration as a domain name which either:

- i. 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
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

- 6.8 It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.

- 6.9 Paragraph 3(a)(i) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under Paragraph 1(i) of the Policy as follows:

Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

- A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
- B. as a blocking registration against a name or mark in which the Complainant has Rights; or
- C. for the purpose of unfairly disrupting the business of the Complainant.

- 6.10 The Complainant relies on Paragraphs 3(a)(i)A and 3(a)(i)C of the Policy in its complaint. However, it must be borne in mind that Paragraph 3(a)(i) of the Policy relates to the Respondent's motives at the time of registration of the Domain Name. Paragraph 4(d) of the Policy makes it clear that trading in domain names for profit and holding a large portfolio of domain names are, of themselves, lawful activities and that the Expert will review each case on its merits.

- 6.11 Accordingly, what must be considered was the Respondent's intent at the time of registration of the Domain Name. Did the Respondent register the Domain Name with the intent of selling it to the Complainant for a profit or for the purposes of unfairly disrupting the business of the Complainant? The Respondent admits to having a domain name portfolio for investment purposes, many of its domain names are for sale, including the Domain Name and on 30 January 2013 the Respondent approached the Complainant about buying the Domain Name. However these facts, in themselves, do not mean that there was an Abusive Registration under paragraph 1(i) of the Policy. It must be established that the Respondent had knowledge of the Complainant and/or its Rights at the time of registration of the Domain Name.

- 6.12 The Respondent denies being aware of the Complainant and/or its Rights at the time of registration of the Domain Name and has given an explanation for registering the Domain

Name which I have to take into account. In this case, the Respondent registered a number of other four letter words as domain names at the same time as the Domain Name. The Complainant does not suggest, nor does it appear, that these other domain names relate to names or marks in which third parties have rights. I consider that the registration of these other domain names is consistent with the Respondent's explanation that the Domain Name was registered as part of a range of four letter words generated using a Scrabble website. I also accept the Respondent's submission that the Domain Name has some meaning, being a Scots word for 'blow'<sup>2</sup>, which may explain why it was selected for registration from the four letter words generated from the Scrabble website.

- 6.13 Further, although the Complainant is a prominent law firm with significant turnover, it is based in London and the South East and has no offices in Scotland. It is therefore credible the Respondent was unaware of the Complainant and/or its Rights at the time of registration of the Domain Name.
- 6.14 The Complainant submits that as part of the Respondent's due diligence in determining the domain names to purchase the Respondent would have carried out internet searches to identify any potential conflicts which would include searching for potential typographical errors of the domain names. The Complainant says the Respondent would have identified the Complainant's website and Rights from such searches. In this case the Respondent registered 28 four letter domain names, including the Domain Name, each of which has a large number of potential mistypes. I do not consider it can be expected that the Respondent would have carried out searches on every typographical variation of what, on their face, appear to be obscure four letter words.
- 6.15 I therefore do not find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(i) of the Policy.

**Abusive Registration under Paragraph 1(ii) of the Policy**

- 6.16 As set out above I have found that the Respondent was unaware of the Complainant when it registered the Domain Name and began using the Domain Name on Sedo to advertise links to various legal websites. It therefore has to be considered whether the Respondent has done something to take advantage of or to exploit its position once it became aware of the Complainant's Rights. This necessitates a consideration of whether the Respondent made the change to the use of the Domain Name to a site offering legal services after it became aware of the Complainant's Rights.
- 6.17 The Complainant's evidence is that the site at the Domain Name offering competing legal services was set up in mid 2012. The Respondent says it set up this site "last year" because of the minimal earnings from the Domain Name being parked on the Sedo site. I am skeptical of the Respondent's explanation for setting up the site. The Respondent is a dealer in domain names, the majority of which are offered for sale on Sedo and only a limited number of which it develops. Indeed the Respondent says it has developed only two other domain names (bestcarhire.com and fabbydoo.com). It is clear that the Respondent is careful about which of its domain names it develops.
- 6.18 I do not regard minimal earnings from the Domain Name being parked on the Sedo site to be a sufficient explanation of why the Respondent developed the site at the Domain Name. It would be expected that the other domain names registered at the same time as the Domain Name, also parked on Sedo, would have had minimal earnings yet none of these have been developed. This is suggestive that the Respondent developed the site at the Domain Name because it had become aware of the Complainant and/or its Rights.

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<sup>2</sup> The Expert, being Scottish, is aware of this.



- 6.19 However I have to take into account that the Respondent has denied being aware of the Complainant until receipt of the misdirected e-mails. The Respondent says the misdirected e-mails adduced in evidence were received after the site was established. This is consistent with the Complainant's evidence which shows the site at the Domain Name was in existence on 8 May 2012, whereas the first misdirected e-mail adduced in evidence is dated 21 May 2012. The Complainant has not adduced any evidence as to how the Respondent would have become aware of the Complainant whilst the Domain Name was parked on Sedo. Whilst the Complainant says the Domain Name was used on Sedo to advertise links to various legal websites, the Complainant has not adduced any evidence on the nature of those links and whether they related to the Complainant. There is also no evidential basis to doubt that the e-mail of 21 May 2012 was the first misdirected e-mail received by the Respondent.
- 6.20 Further, given that 'law' is incorporated into 'blaw', it is feasible that the Respondent set up a legal website at the Domain Name without knowledge of the Complainant and/or its Rights. Indeed, the site on 8 May 2012 uses the heading "b-LAW" and the strapline "*If it's legal you need then let it b-LAW*". This demonstrates that 'blaw' has an implicit meaning in relation to legal services. The Respondent could, therefore, have set up the site at the Domain Name to provide legal services to take advantage of this implicit meaning, without knowledge of the Complainant and/or its Rights. Indeed, in my view the Domain Name stands out from the other domain names which the Respondent registered at the same time as it incorporates an element, 'law', which has some meaning. This is consistent with the Respondent selecting the Domain Name from the others in its portfolio for a site providing legal services.
- 6.21 Accordingly, whilst I am unconvinced by the Respondent's explanation that it set up the site at the Domain Name due to low earnings from Sedo, after weighing the evidence, I do not consider the Complainant has established, on the balance of probabilities, that the Respondent knew of the Complainant and/or its Rights when it set up the website offering legal services at the Domain Name.
- 6.22 Paragraph 4(a)(i)A of the Policy sets out a factor which may be evidence that the Domain Name is not an Abusive Registration namely that before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services. In this case, given my finding that the Respondent was not aware of the Complainant and/or its Rights when it set up the site at the Domain Name, this factor indicates that the Respondent's use of the Domain Name for a site providing legal services is not an Abusive use of the Domain Name.
- 6.23 It must therefore be considered whether the Respondent has done something else to take advantage of or to exploit its position once it became aware of the Complainant's Rights, after receipt of the misdirected e-mail on 21 May 2012.
- 6.24 Paragraph 3(a)(ii) of the Policy sets out a factor which may be evidence that the Domain Name is an Abusive Registration under Paragraph 1(ii) of the Policy, namely circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant. Section 3.3 of the Dispute Resolution Service – Experts Overview, which provides assistance to participants to a dispute under the Policy by explaining how experts have dealt with commonly raised issues, sets out the following:

*“Another potential for confusion (frequently overlooked) is the use of a domain name for the purposes of email. There are many examples of registrants of domain names receiving email traffic intended for the Complainant. See for example Global Projects Management Ltd v Citigroup Inc. (citigroup.co.uk) [2005] EWHC 2663 Ch., and DRS 0114 (penquin.co.uk). Whether evidence of this occurring will lead to a finding of Abusive Registration will, of course, depend to a large extent on the nature of the domain name and the circumstances of its use. If, at the third level, it is a name which is lawfully in use by a number of people (e.g. a surname), the resultant confusion may just be a hazard which the Complainant will have to accept”.*

6.25 In this case ‘blaw’ is not a name which is lawfully in use by a number of people. The Respondent has argued that the Complainant’s site at bllaw.co.uk could be gaining mistyped traffic from Bloomberg Law’s site at blaw.com. However, this is a site relating to legal and business intelligence for legal professionals and is of a different nature to the Complainant’s site.

6.26 The Respondent has adduced in evidence e-mails dated 21 May 2012, 22 June 2012, 4 July 2012, 19 July 2012, 24 October 2012 and 30 January 2013 which the Respondent received and which were intended for the Complainant.

6.27 The e-mail of 21 May 2012 related to a new query for the Complainant but which followed on from work that had previously been carried out by the Portsmouth office. The Respondent replied to the misdirected e-mail in the following terms:

*“I am the chief executive of www.Blaw.co.uk.*

*With regards to your enquiry below, I'm afraid that I personally would not be able to help you as our site does not specifically provide legal information but points you to someone who could assist. For example the "ask a lawyer online now" facility will instantly allow you to chat with a UK lawyer. There is a fee for this, but can I say I have used the facility myself and can recommend it for providing an answer almost immediately.*

*I also notice that the website www.Bllaw.co.uk (2 L's) has an office in Portsmouth and maybe who you are looking for.*

*I wish you all the best with your enquiry.”*

6.28 In the case of the e-mails of 22 June 2012, 4 July 2012 and 19 July 2012 the Respondent notified the senders of these e-mails that they had been received in error and gave either the Complainant’s website or e-mail address. The Complainant was copied into the Respondent’s responses to the e-mails of 24 October 2012 and 30 January 2013. The e-mail of 19 July 2012 contained a confidentiality notice in the footer that the e-mail and attachments are confidential (except where the e-mail states it can be disclosed), may also be privileged and that if received in error the contents should not be disclosed, the sender should be notified and the e-mail and any attachments deleted. The e-mail of 30 January 2013 also contained two confidentiality notices in the footer which in summary state that if received in error the e-mail should not be used, copied or delivered to anyone else, should be deleted and the sender notified.

6.29 In my view the Respondent would have become aware from reading the content of the e-mails and from the nature of the Complainant’s business that they contained confidential information. There are difficult issues in relation to the law of confidence concerning e-mails which are received in error. However, what I must focus on is whether there is an Abusive Registration under paragraph 1(ii) of the Policy which involves a consideration of whether the Respondent has done something to take advantage of or to exploit its position in relation to the misdirected e-mails.

- 6.30 Arguably, the Respondent took advantage of or exploited its position in respect of the e-mail of 21 May 2012. When responding to this misdirected e-mail the Respondent gave details of its site as a potential way of answering the query and thereby sought to divert an enquiry intended for the Complainant in order to try to generate revenue. However, at the same time, the Respondent let the sender know that the e-mail had been received in error and gave details of the Complainant.
- 6.31 Further, the Respondent has let the senders of the other misdirected e-mails know of their error and has not expressly tried to divert them to its site. On the other hand these misdirected e-mails relate to ongoing matters with the Complainant. The Respondent may not have given details of its site in the responses because it realised that this would be unlikely to generate revenue. In contrast, the e-mail of 21 May 2012 related to a new enquiry (albeit a follow up to work previously carried out by the Complainant) which the Respondent may have thought could be diverted by giving details of its site in the response.
- 6.32 What I must consider is whether the Respondent has used the misdirected e-mails in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. In determining this it is appropriate to keep in mind the comments of the Appeal Panel in DRS 05856 (Deutsche Telekom AG v Lammtara Multiserve Limited) that *"Abusive Registration connotes culpable behaviour akin to knowing wrongdoing"*.
- 6.33 In this case I consider that whilst the Respondent sought to take some advantage of the confusion in relation to the misdirected e-mail of 21 May 2012, this was to a limited extent. In this respect the Respondent also notified the sender of the error and gave details of the Complainant. Since then the Respondent has continued to notify the senders of the misdirected e-mails of the error and about the Complainant and has also not sought to take advantage of the confusion. Accordingly, after weighing the evidence, I do not consider that the Respondent has committed culpable behaviour akin to knowing wrongdoing in respect of the misdirected e-mails.
- 6.34 It must also be considered that the Respondent has offered to sell the Domain Name to the Complainant. In DRS 0114 (penquin.co.uk) the respondent received many e-mails which were meant for the complainant, informed the complainant of this and sought a high price for the domain name (the final offer price was £50,000). The decision has similar facts to this case: the respondent was a domain name dealer who registered and sold domain names; the domain names in its portfolio did not appear to correspond to well-known names and trade marks; and the domain name in dispute was not originally registered by the respondent for the purposes of selling it to the complainant. The expert considered that in attempting to use the confusion to gain a higher price for the domain name, the domain name had been used by the respondent in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights. The expert found that there was a threat by the respondent that the detrimental confusion would continue through the large number of hits on the respondent's website and misdirected e-mails if the complainant did not buy the domain name. The expert cited the Court of Appeal decision in Marks & Spencer & Ors v One in A Million & Ors, 23rd July, 1998 where *"[t]he value of the name[] lay in the threat that [it] would be used in a fraudulent way."* The expert considered that once the respondent was aware of the confusion caused between the complainant's trade mark and the domain name, it sought to leverage that difficulty into demanding an exorbitant sum, much more than the domain name would otherwise be worth.
- 6.35 In this case the Respondent approached the Complainant regarding the potential purchase of the Domain Name in the e-mail of 30 January 2013 in the following terms:

*“Over the past 2 years I have received several e-mails from clients mistaking my site for yours, the latest one only today, which I immediately forwarded to your info@bllaw.co.uk address.*

*With this in mind would your organisation be interested in acquiring [the Domain Name] to ensure further errors could be avoided.*

*If so, please let me know and I will arrange to pass you to the domain auction site commissioned to deal with this matter.”*

- 6.36 The Respondent is clearly approaching the Complainant regarding the potential purchase of the Domain Name in the context of the past and potential future receipt of misdirected e-mails. In my view the Respondent would be aware when making this approach that the Complainant as a law firm would be concerned about the receipt by the Respondent of e-mails containing confidential information. The issue is whether against the background of the misdirected e-mails the Respondent, in a similar way to the penguin case, has sought to leverage that difficulty into demanding a sum much more than the Domain Name would otherwise be worth.
- 6.37 In this respect the comments of the Appeal Panels in relation to the sale of domain names must be borne in mind. In DRS 05856 (Deutsche Telekom AG v Lammtara Multiserve Limited) the Appeal Panel stated *“dealing in domain names is a perfectly legitimate activity (per se) and commonly the price that a vendor will put upon the name is either the minimum that the vendor is prepared to accept for it or...the vendor’s estimate of the value of the name to the purchaser.”* Further the Appeal Panel stated in DRS 00389 (Hanna-Barbera Productions Inc -v- Graeme Hay): *“The fact that a demand for money may be in excess of the out of pocket expenses of the registrant cannot of itself constitute abusive use of the Domain Name. ...Ordinarily, the price put upon a domain name by a registrant is simply evidence of what the registrant regards as being its market value”.*
- 6.38 In this case the Respondent did not offer to sell the Domain Name at a particular price in the e-mail of 30 January 2013 to the Complainant. Instead the Respondent enquired whether the Complainant would be interested in acquiring the Domain Name and referred to the domain auction site commissioned to deal with the matter. However, given that the Domain Name is offered for sale on the Sedo site I consider that the Respondent was in effect making an offer to the Complainant to sell the Domain Name at a price to be reached using the Sedo domain name auction site.
- 6.39 The list price for the Domain Name on Sedo is £750. The Respondent says the £750 value for the Domain Name was obtained from the Estibot site, although it is unclear what this value is based on and from the evidence there is some uncertainty over when the Estibot figure for the average monthly searches was obtained. However, the Complainant’s evidence of extracts from the Sedo site shows that the list price for the Domain Name is in line with and is not excessively higher than the list prices of other domain names in the Respondent’s portfolio. It is also not the highest list price (which from the Complainant’s evidence appears to be 2500 USD for linking.mobi).
- 6.40 I consider that by not giving a price for the Domain Name in the e-mail of 30 January 2013 the Respondent intended to try to seek a higher price than the list price for the Domain Name through the Sedo domain name auction site. However, arguably the Respondent was merely using the auction site to try to achieve the market value for the Domain Name. The issue to be considered is whether, as was said at paragraph 6.34, *“[t]he value of the name[] lay in the threat that [it] would be used in a fraudulent way.”*
- 6.41 In this respect, I consider that this case can be distinguished from the DRS decision in penguin. In that case the respondent sought to leverage the difficulty caused by the

confusion between the complainant's trade mark and the domain name by demanding an exorbitant sum, £50,000, much more than the domain name would otherwise be worth. Further in that case there was an initial offer price for the domain name in the region of £500,000. In this case the starting list price of £750 for the Domain Name cannot be considered on its face to be an exorbitant sum. The fact that this list price is in line with and is not excessively higher than the list prices of other domain names in the Respondent's portfolio also suggests that the Respondent is not seeking to take advantage of the confusion by seeking an exorbitant sum for the Domain Name.

- 6.42 Further I do not consider the fact that the misdirected e-mails are likely to continue if the Complainant does not purchase the Domain Name is a factor to take into account in considering whether the Respondent has sought to leverage its position when selling the Domain Name. In this respect, the Respondent cannot influence whether it receives misdirected e-mails because senders type in the wrong e-mail address. I consider the Respondent's behaviour in respect of the misdirected e-mails is relevant to whether the Respondent has sought to leverage its position when selling the Domain Name. However, as I have found above, I do not consider that the Respondent's overall behaviour in respect of the misdirected e-mails has been improper and there is no evidence that the Respondent has threatened to carry out any wrong doing in relation to the misdirected e-mails to seek an enhanced value for the Domain Name from the Complainant. In the circumstances I do not consider that the Respondent's offer to sell the Domain Name to the Complainant is an Abusive use of the Domain Name.
- 6.43 As a general comment I would state that many of the issues I have had to decide upon have been finely balanced. However, after weighing the evidence and taking into account that the Complainant is required to prove the requirements of paragraph 2 of the Policy on the balance of probabilities (see paragraph 6.1 above), for the reasons set out above, I do not consider that the Domain Name has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. I therefore do not find that there is an Abusive Registration of the Domain Name under paragraph 1(ii) of the Policy.

## **7 Decision**

- 7.1 I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.
- 7.2 For the reasons set out above I do not find that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.3 I direct that NO ACTION be taken in relation to the Domain Name.

**Patricia Jones**

**22 April 2013**