

DISPUTE RESOLUTION SERVICE

D00016835

Decision of Independent Expert

London Luton Airport Operations Limited

and

London Luton Airport Limited

v.

Websalesandleasing Limited

1. The Parties:

First Complainant:

London Luton Airport Operations Limited

Navigation House
Airport Way
London Luton Airport
Luton
Bedfordshire
LU2 9LY
United Kingdom

Second Complainant:

London Luton Airport Limited
Hart House Business Centre
Kimpton Road
Luton
Bedfordshire
LU2 0LA
United Kingdom

Respondent:

Websalesandleasing Limited

Studio 6, The Kiln
Walker Road
Newcastle Upon Tyne
NE6 2HL
United Kingdom

2. The Domain Name:

<lutonairport.co.uk> (the "Domain Name")

3. Procedural History:

02 December 2015 14:32 Dispute received
03 December 2015 12:05 Complaint validated
03 December 2015 12:51 Notification of complaint sent to parties
24 December 2015 01:30 Response reminder sent
29 December 2015 11:09 Response received
29 December 2015 11:20 Notification of response sent to parties
04 January 2016 01:30 Reply reminder sent
06 January 2016 13:49 Reply received
06 January 2016 13:50 Notification of reply sent to parties
06 January 2016 13:50 Mediator appointed
11 January 2016 09:29 Mediation started
28 January 2016 15:43 Mediation failed
28 January 2016 15:43 Close of mediation documents sent
03 February 2016 14:02 Expert decision payment received
09 February 2016 Tony Willoughby appointed as Expert
12 February 2016 Non Standard Submission received from Respondent

I, Tony Willoughby, the undersigned Expert can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call into question my independence in the eyes of one or both of the parties.

I accepted the Respondent's Non Standard Submission on the basis of the explanation given by the Respondent, namely that the Reply raised new issues and that the Complainant had made misleading use of some of the evidence it had produced.

4. Factual Background

The Complainants own and operate an airport at Luton. It was originally opened in 1938 under the name, "Luton Municipal Aerodrome". From the end of the Second World War until 1998 the airport was owned and operated as a commercial airport by the local council, latterly through the First Complainant, a company set up for the purpose in 1986. Since the latter part of 1998 the airport, while still publicly owned by Luton Borough Council, has been operated by the Second Complainant, a public-private partnership, operating under licence of the First Complainant. The Second Complainant is permitted to hold trade mark registrations relating to the airport.

The Complainants' records covering the naming of the airport are unsatisfactorily sparse, but it appears that having started out as "Luton Municipal Aerodrome" in 1938, it moved on to become "Luton Airport" at some stage prior to 1972 [this date is derived from a Customs Stamp bearing the name – see below]. Then at some stage thereafter (certainly by 1985) it became "Luton International Airport". In 1990 the airport changed its name to "London Luton Airport" to emphasise its proximity to London.

The Second Complainant is the registered proprietor of two UK trade mark registrations covering the name of the airport, namely:

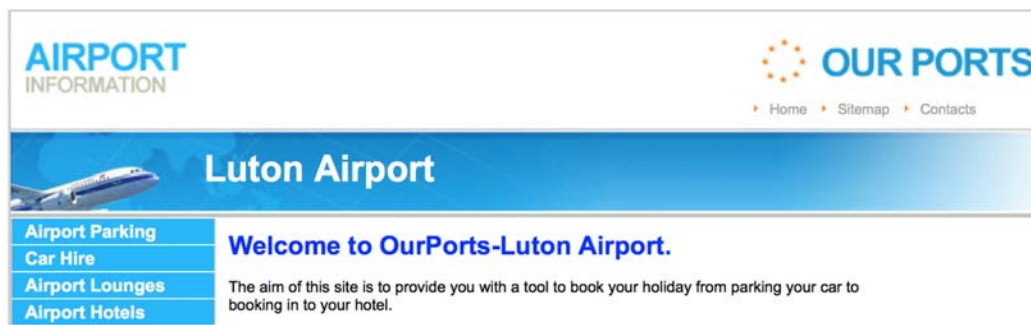
- (a) UK00002573105 filed 23 February, 2011 (registered 29 July, 2011) LONDON LUTON AIRPORT (stylized) for a wide variety of services appropriate to its field of activity in classes 35, 36, 37, 38, 39, 42, 43 and 45. In this stylised mark the words "LONDON LUTON" feature most prominently above the word "AIRPORT" (in smaller font) and below what appears to the Expert to be a stylized arrow.
- (b) UK00002573310 filed 23 February, 2011 (registered 30 September, 2011) LONDON LUTON AIRPORT (words) for similar services in classes 35, 36, 37, 38, 39, 42, 43 and 45.

The Second Complainant had previously in 2000 registered LONDON LUTON AIRPORT (stylised) as a trade mark, but that registration was allowed to lapse in 2010 and adds nothing to this case save to indicate that the Complainants had registered trade mark protection for the name "London Luton Airport" in stylized form for the life of that registration.

The Complainants' main website is connected to their domain name, <london-luton.co.uk>, a domain name which they registered on 31 July 1997.

Until the filing of the paragraph 13b non-standard submission, the case file contained no information on the Respondent apart from its contact details as set out in the pleadings. That submission indicates that the Respondent and/or its associated businesses comprise a corporate hospitality business, a travel related business using the domain name <HolidayExtras.co.uk> and another (or perhaps the same) travel services business using the domain name <OurPorts.com>, the domain name to which the Domain Name is re-directed.

The Domain Name was first registered on 8 July, 1998 (apparently by someone other than the Respondent) and, as indicated, is now connected to a website at <OurPorts.com> which is ostensibly devoted primarily to services related to the Complainants' airport. However, the website is not fully operational. The pages devoted to airport parking, airport lounges and airport hotels preclude any bookings post-2012. The headings of the home page and the airport parking page are as depicted in the following screenshots:



AIRPORT INFORMATION

OUR PORTS
Home • Sitemap • Contacts

Luton Airport

Airport Parking
Car Hire
Airport Lounges
Airport Hotels

Parking at Luton airport

To get the best price for your airport parking at Luton Airport please use the quote engine below.
- We'll guarantee to find you the best price

The website features a disclaimer in small print reading:

"We are not affiliated with any airport but are proud to be associated with all major airports throughout the UK."

5. Parties' Contentions

Complainants' Contentions – Complaint

The Complainants contend that they have unregistered trade mark rights in the names "Luton Airport", "Luton International Airport" and "London Luton Airport" through their use of those names from time to time and, in the case of "Luton Airport", the prior use of that name by their predecessors. They rely also upon their registered rights in respect of "London Luton Airport", details of which are set out at section 4 above.

The Complainants contend that "Luton Airport" is identical to the Domain Name and that "Luton International Airport" and "London Luton Airport" are similar to the Domain Name.

The Complainants suspect that registration of the Domain Name in July 1998 was prompted by the publicity leading up to the formation of the Second Complainant in August 1998.

The Complainants contend that the Domain Name is an Abusive Registration under both limbs of the definition of that term as set out in paragraph 1 of the Policy and primarily on the basis that people are likely to be confused into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with, the Complainants (paragraph 3.a.ii of the Policy).

The Complainants also contend that the Domain Name is an Abusive Registration within the meaning of paragraphs 3.a.i.A, B and C and 3.a.iii of the Policy. In relation to the last of these the Complainants produce evidence to show that the Respondent is the owner of a significant number of domain names featuring the names and/or trade marks of others.

Respondent's Contentions - Response

The Respondent's contentions are that:

- (a) insofar as the Complainants' contentions concern the Respondents' motives at date of registration of the Domain Name (i.e. those covered by paragraphs 3.a.i.A, B and C of the Policy) the Complainants were in possession of no relevant rights (registered or unregistered) in respect of the names "Luton Airport", "Luton International Airport" and "London Luton Airport" at that time.
- (b) "Luton Airport" is a purely descriptive term indicating an airport in the vicinity of Luton and is not susceptible of trade mark protection. The name has never been registered as a trade mark and the Complainants' evidence as to the use of it is sparse in the extreme

- limited to a Custom & Excise stamp, the provenance of which the Respondent challenges, and a temporary airport sign featuring on a Pathé cine film dating back to 1973. Any rights, which might have existed back then, will by now have long been extinguished.
- (c) If, contrary to the Respondent's view of the matter, "Luton Airport" is susceptible of trade mark protection, there are no trade mark registrations in existence and the Complainant has failed to produce evidence sufficient to establish the existence of any unregistered rights.
 - (d) The Complainants' trade mark registrations of LONDON LUTON AIRPORT are not similar to the Domain Name. Their most prominent constituent is the term "London Luton", "London" having been, as the Complainants admit, deliberately incorporated into the trade mark to indicate the airport's proximity to London.
 - (e) As to the name "Luton International Airport", claimed to have been used prior to 1990, it has never been the subject of a trade mark registration, and the evidence as to its use focuses on a logo, which can clearly be distinguished from the descriptive phrase "Luton Airport".
 - (f) In support of its contention that "Luton Airport" is purely a descriptive phrase the Respondent cites the existence of other third party users of that phrase, namely the rail operators using "Luton Airport Express" and "Luton Airport Parkway" and the operator (not the Complainants) of the "Luton Airport Enterprise Zone".
 - (g) As to its use of the Domain Name the Respondent contends that it is merely the legitimate use of a geographical location. Similarly, the Respondent contends that any use that the Complainants may have made of the term "Luton Airport" can be dismissed as use "in a descriptive or colloquial sense to describe place and not as a reference to the Complainants".

The Respondent denies the Complainants' allegation that the Domain Name is an Abusive Registration, claiming that its use of the Domain Name is a legitimate use of a descriptive term, a use which has been running almost continuously for 17 years. The fact that the Complainants have left it this late to take action is indicative that their allegations are misconceived.

The Respondent denies that the Domain Name forms part of a pattern of domain name registrations featuring third party trade marks, but asserts that it is part of a pattern of geographic place names.

The Respondent contends that the delay in taking action should be taken into account in the context of laches and acquiescence and asserts that the Complaint is a claim in contract to which the Limitation Act applies. The Respondent contends that a claim in contract should not be raised more than 6 years after the cause of action arose.

The Complainants' Contentions - Reply

The Reply contains some useful material, which could and should have been included in the Complaint, but I am not prepared to admit that material into this administrative proceeding, pursuant to paragraph 6.b. of the Procedure, which includes the following passage:

"Any reply by the Complainant must be restricted solely to matters which are newly raised in the Respondent's response and were not raised in the Complainant's complaint as originally submitted to us. If an Expert is appointed and the reply extends to other matters, the Expert may declare it inadmissible to the extent that it deals with matters going beyond those newly raised in the Respondent's response."

In the Complaint the Complainants observe that the website to which the Domain Name is connected is in some respects out-of-date and in some respects inoperative. The Respondent fails to deal with that issue and the Complainants elaborate upon their original observations and contend that the website is a sham.

For example, some of the content has not been updated since 2012 and it is not possible to book airport parking through the website. I have taken note of that evidence.

In the Complaint the Complainants state on more than one occasion that it is not possible to know when the Respondent acquired the Domain Name. In the Reply they include further material related to that topic.

Finally, in response to the Respondent's allegations regarding the delay in taking action in relation to the Domain Name, the Complainants state that they only came across the Domain Name in mid 2015. They state that historically they have had little to do with domain name monitoring..

The Respondent's Non-Standard Submission

Much of this submission is taken up with material that could and should have been included in the Response and some of it reiterates what is in the Response. However, the Respondent does in this document provide for the first time a bit of information on the Respondent and its business and indicates that it acquired the Domain Names as part of a portfolio in 2001.

The submission addresses 5 topics, namely "Luton Airport" as a geographic location, the Archive.org webpages produced by the Complainants, the lack of evidence to support the Complainants' claim to unregistered trade mark rights, the lack of any evidence of confusion and "Delay in Claim for Breach of Contract".

I will address all these matters in section 6 below.

6. Discussions and Findings

General

Pursuant to paragraph 2.a.i of the Policy the Complainants to succeed in this Complaint they must prove to the Expert on the balance of probabilities that:

- I. They have 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

"Abusive Registration" is defined in paragraph 1 of the Policy 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.

Rights

There is no dispute between the parties that the Complainants have registered trade mark rights in respect of the name "London Luton Airport" dating back to 2011, the date of their extant trade mark

registrations.

There is, however, a dispute as to whether or not the Complainants have trade mark rights in respect of the names "Luton Airport" and "Luton International Airport" and in respect of "London Luton Airport" pre-dating the current registrations.

Preliminary finding of fact.

The Complainants and/or their predecessors claim to have used 3 names for their airport since the Second World War: first, until the early to mid 1980s, the name "Luton Airport"; secondly, from the early to mid 1980s until 1998, the name "Luton International Airport"; and thirdly, from 1998 until the present day, "London Luton Airport".

There appears to be no serious dispute about the use of the second and third of those names. As to "Luton Airport", however, the Respondent contends that the Complainants have not done enough to demonstrate usage of any significance of "Luton Airport". I agree that the evidence is extraordinarily sparse and none of it is derived from the Complainants' internal records. The Complainants acknowledge the dearth and explain it by saying that "it is thought that the need to archive such material was not perceived to be a priority or a need at the time". While the evidence is sparse, I find it persuasive. It comprises a "Luton Airport" HM Customs and Excise stamp dated 1972:



Customs Stamp
1972

and a clip from a Pathé film (dated 1973 by YouTube) featuring travellers at a departure gate boarding an aircraft and passing a sign outside a marquee reading "Luton Airport – Arrivals – Temporary Holding Area".

The Respondent dismisses that evidence on the basis that the Customs stamp is of doubtful provenance and that the sign in the film clip is self-evidently temporary. I doubt that the stamp is a forgery and would expect the nomenclature on an HM Customs and Excise stamp to be precise. As to the airport sign, while it indicates a temporary structure, that is no reason to assume that the name of the airport appearing on the sign was temporary. Indeed, I find it more likely than not that the airport bore that name as an official non-temporary name at that time.

Accordingly, I find as a fact for the purposes of this decision that the Complainants' airport was named "Luton Airport" for a substantial period prior to the adoption of the "Luton International Airport" name in the early to mid 1980s.

While, the Complainants' claims to rights extend beyond "Luton Airport" to the later names, "Luton International Airport" and "London Luton Airport", I do not need to go beyond "Luton Airport" to decide this case.

The First Element

The Respondent has majored on three matters in relation to the name "Luton Airport", namely

1. The Complainants have produced insufficient evidence to demonstrate any substantial use of that name.
2. In any event the name is merely a place name, a geographical name and place names do not attract trade mark rights.
3. The Complainants have not demonstrated usage sufficient to give rise to unregistered trade mark rights in that name and observe that there are other users of the name.

My preliminary finding disposes of the first of those points. As to the second, is it really the case that geographical names and place names cannot give rise to trade mark rights? The answer is emphatically "No". They can and do give rise to such rights.

In the Respondent's paragraph 13b non-standard submission the Respondent itself cites a UDRP decision in which I was the presiding panellist, *HER MAJESTY THE QUEEN, in right of her Government in New Zealand, as Trustee for the Citizens, Organizations and State of New Zealand, acting by and through the Honourable Jim Sutton, the Associate Minister of Foreign Affairs and Trade v. Virtual Countries, Inc* WIPO Case No. D2002-0754. The three member panel found that the complainant in that case had no unregistered trade mark rights in respect of the geographical name "New Zealand" and the Respondent in this case relies upon that finding.

However, the Respondent appears to have overlooked the following passage in that decision:

"Indications of geographical origin, whether they be the names of towns, cities, regions, countries or indeed continents are certainly capable of being trademarks or service marks, but only when the geographical significance of the name is displaced. This usually only occurs after long and extensive use of the name as a brand by a single trader in such a manner as to distinguish his goods and services from those of his competitors. Thus, in England, for example, to golfers, NEW ZEALAND is well known as being the name of a golf club; to the general public ICELAND is a well known supermarket chain and food brand, MALVERN, the name of a town, is well known as a brand of mineral water and YORK, the name of a city, is a well known brand of vehicular trailer. In all those cases, the names in question are trade/service marks in the narrow areas of activity identified, where the geographical significance of those names has been displaced."

In citing this case the Respondent contends that "New Zealand" (as a geographical term) is equivalent to "Luton Airport". The Respondent underlines the point by citing another UDRP decision *Ipiranga Produtos de Petróleo S.A. v. Domain Admin, Mrs. Jello, LLC* WIPO Case No. D2011-0163 pointing to "*the established principle that a geographical name standing alone is difficult to protect under the UDRP unless there are extraordinary circumstances.*"

In those cases the geographic terms "New Zealand" and "Ipiranga" did indeed stand alone. In this case "Luton", the geographic term, does not stand alone. It is accompanied by the word "Airport", which imports the idea of a business.

The point is made by another UDRP decision cited by the Respondent, *BAA plc, Aberdeen Airport Limited v. Mr.*

H. Hashimi WIPO Case No. D2004-0717 involving the domain name <aberdeenairport.com>. The panelist addressed the evidence in some detail and stated:

“It is true that the expression “Aberdeen Airport” is descriptive in nature, and the Panel accepts that generally in such cases more evidence is necessary than might otherwise be the case, to establish the necessary “secondary meaning” required as a foundation for reputation and consequential business goodwill. However, the Second Complainant’s services in this case substantially consist of the provision of a facility which is apparently unique to the Aberdeen region, which has been operated for some 18 years by a company known as Aberdeen Airport Limited, and which for many years prior to that appears to have been generally known as “Aberdeen Airport”. In some respects, this case is similar to Sydney Opera House Trust v. Trilynx Pty Limited, WIPO Case No. D2000-1224, where the WIPO Panel had no difficulty in finding that the body corporate charged with the management and administration of the famous centre for the performing arts was entitled to use SYDNEY OPERA HOUSE as a common law trademark and to register the mark (which it did). Sydney is a city, just as Aberdeen is, and “Opera House” is as descriptive of the Sydney facility as “Airport” is of the airport.”

The panel in that case went on to hold that *“the Complainants have done enough to show that they have a common law service mark right in ABERDEEN AIRPORT”*.

The Respondent argues that in this case the Complainants have not done enough to show that they have used the name as a brand and the Respondent contends that there is nothing unique or exclusive about the Complainants’ use of the name. The non-standard submission continues:

“Many businesses refer to themselves in this regard [i.e. by reference to the term “Luton Airport”] – in addition to those already indicated in the Response [i.e. “Luton Airport Express”, “Luton Airport Parkway” and “Luton Enterprise Zone”] there are hotels, car hire businesses, car parks etc. that use their brand name and then Luton Airport as a descriptive term to indicate the place of origin of their business and services.

For example, “Premier Inn Luton Airport” shows the term Luton Airport being used descriptively to distinguish that hotel from other Premier Inn hotels; while the trade mark Premier Inn is used to distinguish the hotel services of the Premier Inn chain from other providers of hotel services.

This last point is addressed in yet another UDRP decision cited by the Respondent *BAA plc v. Bob Larkin* WIPO Case No. D2004-0555, a case involving the domain name, <gatwick.com> in which the learned panel of three senior common lawyers found that the complainant had common law rights in respect of the name “Gatwick” in relation to airport services:

“The establishment of Gatwick as a large and successful international airport has meant the flourishing of many businesses incorporating the name “Gatwick”. That fact does not reduce the effect of the common law mark in respect of airport services. However that fact may have considerable bearing on whether the Respondent has a legitimate right to use the name.

Under the “passing-off” test, in a hypothetical situation, if the Respondent were to set up another airport called “Gatwick”, then that conduct would clearly be “passing off” the Complainant’s rights as an airport operator.

The Panel considers that the first limb of the criterion has been made out in respect of the common law mark for the name “Gatwick” in connection with airport services. The fact that an engineering firm has a registered trademark for limited purposes emphasises the boundary of

the Complainant's common law mark. It is restricted to airport services."

In this case there can be no doubt that the Complainants have established that they are running a very successful international airport at Luton. Moreover, there is no suggestion before me that anyone else is operating an airport in the Luton area under and by reference to the name "Luton".

Is it of relevance that since the early to mid 1980s the Complainants have been trading, not as "Luton Airport", but for a few years as "Luton International Airport" and, since 1998, as "London Luton Airport"? In my view "No".

While they ceased to use the name "Luton Airport" in the early to mid 1980s, the evidence produced by the Complainants (particularly Annexes 7, 8 and 9 to the Complaint) demonstrates clearly that the name has stuck and that very substantial numbers of people (identified from social media analysis), travel businesses, broadcasters and film companies to this day refer to the Complainants' airport operation as "Luton Airport". For some years following the Complainants' adoption of their current name, there was also a reality television programme running entitled "Luton Airport" in which members of the airport staff were followed in the course of their working day. The subsequent names have not been so different as to render "Luton Airport" redundant. For many the name still precisely identifies the Complainants' operation and no other.

To adopt the hypothetical test posed by the panel in the *Gatwick* case, if the Respondent were to set up another airport called "Luton Airport", then there would be massive confusion and that conduct would amount to passing off. The Respondent seeks to distinguish between the name as a mere address and the term as the name of a commercial airport operation. In my view, it is not possible to draw that distinction.

I find that the Complainants have common law trade mark rights in respect of the name "Luton Airport".

From that finding it is but a short step to conclude, as I do, that the Complainants' common law trade mark is identical or similar to the Domain Name.

The Complainants' back-up position is that it currently trades as "London Luton Airport", a name in respect of which it has registered trade mark rights and that "London Luton Airport" is similar to the Domain Name. I agree.

The Complainants succeed under the First Element.

As a footnote to this section I should add that in DRS cases I do not normally consider decisions under the UDRP, which is different from the Policy in a number of important respects. However, I agree with the Respondent that in the context of trade mark rights and in the particular circumstances of this case the principles are applicable to both. It should not be forgotten, however, that, unlike the UDRP, the first element of the Policy is not confined to complainants with trade mark rights.

For completeness, I should also add that the Respondent cited two other UDRP cases, in both of which the complainants failed to satisfy the panel that they had unregistered trade mark rights in respect of the names at issue. The cases were *Manchester Airport PLC and Club Club Limited* WIPO Case No. D2000-0638 concerning the domain name, <manchesterairport.com> and *Port of Helsinki v. Paragon International Projects Ltd.* WIPO Case No. D2001-0002 involving the domain name <portofhelsinki.com>. In both those cases the deciding factor was lack of evidence to show that the complainants' use of the names in question had given rise to trade mark rights.

In the former, I was the dissenting presiding panelist and I was satisfied on the evidence that no competitor could set up another airport under the name "Manchester Airport" without finding itself on the wrong end of a passing off action, meaning that I was satisfied that "Manchester Airport" was a common law trade mark in the hands of the Complainant. My co-panelists disagreed with me. I am as mystified

now as I was then. As to the latter case the panel indicated that he was expecting market research or similar evidence to establish the existence of trade mark rights. No such evidence had been filed. Both those decisions were very early decisions in the life of the UDRP and may well not have gone the same way had they been decided today.

Abusive Registration

Paragraph 3 of the Policy features a non-exhaustive list of factors, which may be evidence that a domain name is an Abusive Registration.

Those factors include circumstances indicating that the Respondent registered the domain name with the Complainants in mind and for the purpose of selling it to the Complainants at a profit or blocking the Complainants from registering it or with a view to disrupting the Complainants' business (sub-paragraphs 3.a.i.A, B & C of the Policy). The Complainants contend that all these circumstances, which focus upon the Respondent's motive for registering the Domain Name in issue, are applicable to this case.

The Complainants also rely upon two further factors, namely those covered by sub-paragraphs 3.a.ii and iii of the Policy:

“ii. 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;

iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;”

I will now address each of these factors in turn.

Sub-paragraphs 3.a.i.A, B & C of the Policy

As indicated above, these sub-paragraphs relate to the Respondent's motives at date of registration.

The Domain Name is one of a portfolio of over 250 domain names as listed in Annex 13 to the Complaint, being a selection from what was a portfolio of 1500 names. What were the Respondent's intentions when acquiring them in 2001? Prior to receipt of the Respondent's non-standard submission, I had assumed that with a portfolio of that size, it was for a commercial purpose and that the Respondent's name, Websalesandleasing Limited, provided the answer. In other words they were acquired for sale or leasing.

The non-standard submission states that in 2007 the Domain Name redirected users to the Registrant's OurPorts.com website that provides users with links to travel related services, from which, presumably, the Respondent would derive pay-per-click or advertising revenue.

Generally, registering domain names for monetization (i.e. for sale or leasing or indeed for connecting to pay-per-click parking pages) is an unobjectionable trading activity [see sub-paragraphs 4d. and e. of the Policy] and many of the names in the Respondent's portfolio are dictionary words (such as <addresses.co.uk>, <alcoholics.co.uk>, <perfumeries.co.uk>) or descriptive terms (such as <americanfootball.co.uk>, <bodyfreezing.co.uk>, <armymemorabilia.co.uk>) or geographical names (such as <castleford.co.uk>, <castledonnington.co.uk>, <cheadle.co.uk>). Registering such names (even in large quantities) with that intention (i.e. monetization) is unlikely to fall foul of the Policy

unless the name in question is a name in which a third party owns rights

The Respondent in its non-standard submission labels the portfolio as a portfolio of geographical names, but it is not. As indicated it also incorporates dictionary words and descriptive terms. However, the portfolio is not limited to such names and over 10% comprise names which I recognize as being names in which third parties are likely to have an interest e.g. <newcastleupontyneairport.co.uk>, <teessideairport.co.uk>, <sunderlandafc.co.uk>, <thegunners.co.uk>, <chelseaflowershow.co.uk>, <edinburghfestival.co.uk>, <baftaawards.co.uk>, which, if registered with the permission of the entities indicated, one would have expected to find connected to official websites. I have been unable to find any website connected to these domain names, even though they were all registered in 1998, over 17 years ago and acquired by the Respondent over 14 years ago. Moreover, two of the domain names in the portfolio, which cannot by any stretch of the imagination be described as geographical names are <wwwcoronationstreet.co.uk> and <wwweastenders.co.uk>, which are not names which the owners of rights in respect of “Coronation Street” and “Eastenders” television programmes are likely to have authorized.

Accordingly, I conclude on the balance of probabilities that the domain names in this category, (i.e. those featuring the names or trade marks of others) were likely to have been acquired with knowledge of the third parties’ rights or reckless as to whether those names were the subject of third party rights, but without the permission of those third parties.

In so finding I note that while the Respondent unsurprisingly denies all knowledge of the Complainants’ 2011 trade mark registrations prior to their registration, it makes no attempt to deny knowledge at all material times of “Luton Airport” as the name of the Complainants’ airport.

Sub-paragraph 3.a.ii. of the Policy

Nominet’s online guidance tools for parties to disputes include the Experts’ Overview. Paragraph 3.3 of the Overview, which is directed to the issue of confusing use, contains the following passages:

“What is meant by confusing use?

The ‘confusion’ referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”? “

and

“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant’s web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant,

the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name."

The Respondent contends that if there had been any confusion, it would have come to light before now given that the Domain Name was registered over 17 years ago. The Complainants have produced no evidence of confusion.

While it is true that the Complainants have produced no evidence of confusion, the likelihood of confusion arising from use of a domain name, which can only refer to the Complainants, is in my view self-evident. The fact that there are other operators using the name in relation to other services e.g. "Luton Airport Express", "Luton Airport Parkway" and "Luton Airport Enterprise Zone", is by the by. There is only one Luton Airport and that name on its own identifies the only provider of airport services in Luton, namely the Complainants. As the panel in the *Gatwick* case (*supra*) stated:

"The establishment of Gatwick as a large and successful international airport has meant the flourishing of many businesses incorporating the name "Gatwick". That fact does not reduce the effect of the common law mark in respect of airport services."

The quote continued: "However that fact may have considerable bearing on whether the Respondent has a legitimate right to use the name." and I shall deal with that matter below.

If there is no evidence of confusion, it may be because nobody has bothered to complain or it may be because the Complainants, consistent with the quality of their archive retention have not kept proper records of complaints or it may be because there has never been an active website connected to the Domain Name or it may be a combination of these factors.

The Domain Name was indeed registered over 17 years ago, but the Respondent has provided no details of any use of the Domain Name save for webarchive pages comprising a web broker's website of the year 2000 pre-dating the Respondent's acquisition of the Domain Name and a 2006/7 version of the current website. It failed in its Response to address the Complainants' criticisms of the website. In its non-standard submission it simply dismisses the quality of the website as an irrelevance. The webpages on the current website feature a copyright notice dated 2007 and the years covered by the Airport Parking, Hotels and Lounges booking services are static at 2011 and 2012. The webarchive pages attached to the non-standard submission are static at the years of those pages. For all I know there may never have been an operational website attached to the Domain Name. Had they been active, the Respondent could have produced extraneous documentation to demonstrate that it was conducting a business by reference to the Domain Name. There is no such evidence.

Does the fact (if it be a fact) that there has never been an active, fully operational website attached to the Domain Name affect the issue? After all, the sub-paragraph in question talks of 'use'. In my view it makes no difference. The Respondent has gone to the trouble of defending this case at what is likely to have been a significant cost, which would not have been a worthwhile exercise if the Respondent had not intended to make use of the Domain Name in the future and 'threatened use' is covered by the sub-paragraph. If the website connected to the Domain Name had been active, it would have been providing services competing with those provided by the Complainants (e.g booking of lounges and airport parking). Moreover, the static website connected to the Domain Name might well be thought to be an officially authorised website associated with the Complainants. The Domain Name invites the confusion and there is nothing readily visible on the website to counter any likelihood of confusion. The disclaimer is in small type at the bottom of the page and is in a grey colour, which renders it less readily legible.

Sub-paragraph 3.a.iii. of the Policy

Paragraph 3.4 of the Expert's Overview addresses this topic in the following terms:

“What is meant by “pattern” in paragraph 3(a)(iii) of the Policy? What is meant by “and the domain name is part of that pattern” in the same subparagraph?

The purpose behind this paragraph is to simplify matters for a Complainant, where the only available evidence against the registrant is that he is a habitual registrant of domain names featuring the names or marks of others. However, there is a divergence of view among Experts as to what constitutes a pattern for this purpose.

One view, as expressed by the Appeal Panel in DRS 04884 (maestro.co.uk), is that the mere fact that a registrant has some objectionable domain names in his portfolio cannot of itself be enough to render the domain name in issue an Abusive Registration. To get the benefit of this provision, the Complainant must show that the domain name in issue is part of a conscious policy on the part of the registrant. There must be evidence to justify the linking of the domain name in issue to the other objectionable domain names. The link may be found in the names themselves and/or in the dates of registration, for example.

The contrary view is that the pattern does not need to result from any conscious policy on the part of the Respondent. If the domain name in issue is a well-known name or mark of the Complainant and the Respondent is the proprietor of other domain names featuring the well-known names or marks of others, the pattern is likely to be established, even if there is no obvious link between the names or the manner or their dates of registration.

In practice this difference of view is unlikely to have much of an impact. If the domain name in issue is a well-known trade mark of the Complainant and there is no obvious justification for the Respondent being in possession of the domain name, it is probable that the Complaint will succeed on other grounds.”

The Respondent denies that the Domain Name forms part of a pattern of Abusive Registrations and contends that it forms part of a pattern of geographical place names. While that denial cannot conceivably extend to <wwwcoronationstreet.co.uk> and <wwweastenders.co.uk>, I am prepared to accept that the Domain Name does not extend to the domain names at that extreme end of the portfolio. As to some of the others e.g. <baftaawards.co.uk>, <sunderlandafc.co.uk> and <tetleysbittercupfinal.co.uk>, all of which were acquired at the same time, I can see that the Complainant has an arguable case, but in the absence of evidence that they were registered without the permission of the relevant trade mark owners, I am reluctant to make a finding under this head.

Defences

Paragraph 4 of the Policy sets out a non-exhaustive list of factors, which may be evidence that the Domain Name is not an Abusive Registration. Those potentially applicable here are that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services; that the Domain Name is generic or descriptive and the Respondent is making fair use of it.

However, in light of my doubt that the Respondent has ever made any serious attempt to make any use of the Domain Name in relation to a genuine offering of goods or services and my finding that “Luton Airport” is not generic or descriptive, but a trade mark or service mark of the Complainants, neither of these ‘defences’ is applicable here.

Even if I am wrong on that and it can be said that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services, I do

not believe that any such use can be said to be fair. To my mind the Respondent has shown a reckless disregard for the rights of the Complainants. The Domain Name impersonates the Complainants and is calculated to attract visitors believing the website to be a website of or authorised by the Complainants. The barely legible disclaimer in small print at the bottom of the homepage ("*We are not affiliated with any airport but are proud to be associated with all major airports throughout the UK.*") comes across to me as a recognition on the part of the Respondent that the Domain Name is likely to give rise to confusion. Moreover, it is a seriously defective website and has been so ever since its first iteration was connected to the Domain Name in 2007. As such it can only damage the reputation of the Complainants in the eyes of anyone believing the Complainants to be associated with it.

Above, I quote from the *Gatwick* case a passage in which the panel in that case expressed the view that the respondent in that case might well have a legitimate interest in respect of the <gatwick.com> domain name for a business involved at Gatwick Airport. The panel went on to hold that the respondent did in fact have such an interest and dismissed the complaint. It did so in the following terms:

"The Panel considers that the Respondent has made out a case for operating a legitimate business. He has therefore discharged any burden on him under paragraph 4(c)(i) of the policy.

Given the limitations of the current procedure under the Policy, it is not for the Panel to say whether his claim would be successful in a Court of law in an action for "passing-off". This is a case where the Panel considers that the respective rights of the parties are better dealt with in a Court than through the procedures under the Policy. Accordingly, the Complainant has not proved the second criterion."

In my view this decision was powerfully influenced by the fact that for some years the respondent had been operating a genuine directory service website in relation to the airport under and by reference to the domain name in issue. No panelist likes to interfere with an active operating website where there is an arguable case, which could be better dealt with in a court. Even so, I am by no means sure that I would have followed the same line. Having decided that the name "Gatwick" in relation to airport services effectively meant the complainant's Gatwick Airport operation, confusion resulting from use of the domain name would in my view have been inevitable on the basis of "initial interest confusion". In any event even if the decision on the Gatwick case was correct, the present case can be distinguished on the basis that the Respondent's website does not come anywhere near the operational website of the respondent in the *Gatwick* case.

The matter does not end there. The Respondent contends that as a result of the extensive delay in taking action, the Complainants are barred from invoking the Policy. It asserts 'laches' 'acquiescence' and a contractual limitation period of 6 years under the Limitation Act 1980.

The Respondent refers to the Appeal Decision in *Lucas Film LLC v. Abscissa.com Limited* DRS Case D00015788 in which the Appeal Panel dealt at some length with the issue of delay. I am happy to follow the Panel's reasoning in that case, which in my view disposes of much of the Respondent's arguments.

In particular I find that the Complainants' claim to have been unaware of the Domain Name prior to 2015 is to be believed. I reject the Respondent's assertion that this fact demonstrates the weakness of the Complainants' case. Had the Domain Name been connected to an operational website, the argument might have carried more weight.

I find that the delay is not a delay upon which the Respondent has placed any reliance; nor has it caused any prejudice to the Respondent.

As to the contractual argument I merely observe that by and large the Policy is a discrete alternative dispute resolution system to which the Respondent signed up when acquiring the Domain Name. The Complainants were not a party to that contract. They are not asserting a contractual right. It is not obvious to me that the Limitation Act 1980 has any part to play in this case and I cannot see anything in its wording which would operate so as to provide the Respondent with a basis for defeating the Complaint. Moreover, one of the objects of the Policy is to assist rights owners in restraining confusing use of domain names, which are identical or similar to the rights owners name or mark, and, as I have found, use of the Domain Name in the hands of the Respondent is calculated to cause confusion. As the Appeal Panel in *Lucas Film LLC v. Abcissa.com Limited* DRS Case D00015788 observed:

“The Panel also notes that as a matter of English law delay per se would not prevent an action to restrain ongoing acts of trade mark infringement. Whilst a Complaint under the Policy is not the same as an allegation of trade mark infringement it does seem to the Panel that the same broad approach to delay is desirable. It would be undesirable for the Policy to be applied in such a way as to preclude a complaint purely on the basis of delay, if the effect was to force the Complainant to undertake litigation in relation to the same set of facts, and where the litigation was not barred by delay. The circumstances in which delay and other related considerations may operate as a defence to litigation are considered further below. Overall however the Panel considers that, where the use complained of is ongoing, then delay alone should not automatically preclude a complaint being brought.”

I therefore decline to find that the length of time that the Domain Name has been registered provides the Respondent with a defence to the Complaint.

I find that the Domain Name in the hands of the Respondent is an Abusive Registration.

7. Decision

I direct that the Domain Name be transferred to the Complainants.

Signed Tony Willoughby

Dated 21 February 2016