



(Hong Kong Office)

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK 1600869
<b>Complainant:</b>	Consilium Law Corporation
<b>Respondent:</b>	William Timmons
<b>Disputed Domain Name:</b>	<consiliumlawsingaporescam.com>

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**1. The Parties and Contested Domain Name**

The Complainant is Consilium Law Corporation, of Singapore.

The Respondent is William Timmons, of Singapore.

The domain name at issue is <consiliumlawsingaporescam.com> (“the Domain Name”), registered by the Respondent with Enom, Inc., of Kirkland, Washington, United States of America.

**2. Procedural History**

The Complaint, naming as respondent a person other than the Respondent, was received by the ADNDRC electronically on May 13, 2016, followed shortly thereafter by the case filing fee. On May 17, 2016, by e-mail to the ADNDRC, the Registrar confirmed that the Domain Name is registered with the Registrar and named the Respondent as the current registrant of the Domain Name. The Registrar verified that the Respondent is bound by the Registrar’s (English language) registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy” or the “UDRP”).

On May 27, 2016 the ADNDRC notified the Complainant of the deficiency in the Complaint and on May 30, 2016 the Complainant filed an amended Complaint naming the Respondent as respondent.

On May 31, 2016, the ADNDRC served via e-mail to the Respondent and to postmaster@consiliumlawsingaporescam.com, a Written Notice of the Complaint, together with the Amended Complaint and all Annexes, setting a deadline of June 20, 2016 by which the Respondent could file a Response to the Complaint.

The Respondent submitted an email to the ADNDRC on May 31, 2016 but did not submit any formal Response. On June 21, 2016 the ADNDRC notified the parties of the

Respondent's default and, pursuant to the Complainant's request to have the dispute decided by a single-member Panel, appointed Alan L. Limbury as Panelist.

### **3. Factual background**

The Complainant is a law firm based in Singapore, which acted in relation to the Respondent's divorce from his wife, which was granted by the Court in Singapore on 15 October 2012.

The Domain Name was registered on July 17, 2013. It resolves to a website containing an account by which the Respondent's former wife expressed her own and the Respondent's criticisms of the way in which the Complainant handled and charged for that divorce matter.

### **4. Parties' Contentions**

#### **A. Complainant**

The Complainant has unregistered trade mark rights in CONSILIUM LAW, used in connection with the provision of corporate commercial law and family law services since the Complainant's incorporation in Singapore in 2010. Given that "Singapore" refers to a geographical location and the defamatory word "scam" refers to the purported activity or description of "Consilium Law", the Domain Name is more of a phrase than a name. The name "Consilium Law" within this phrase, is identical, or else at least confusingly similar to the Complainant's trade mark.

A person who knows of the firm, upon reading or hearing the Domain Name, would reasonably come to the conclusion that the Domain Name is making a reference to the firm. On an objective test, an ordinary and sensible reader would have thought that the defamatory Domain Name refers to the Complainant's name, because there is no other law firm in Singapore that has a name similar to "Consilium Law". If there is any remaining doubt as to the link between the Domain Name and the Complainant's trade mark, the Domain Name should be construed in the context of the website's contents, which show clearly, even on a subjective test, that the Domain Name is meant to refer to the Complainant's name and trade mark. Hence, the Domain Name is identical or at least confusingly similar to the Complainant's trade mark.

The Respondent has no rights or legitimate interests in the Domain Name, which is not being used for the purpose of the Respondent's business nor for any constructive purpose. The Respondent's use of the Domain Name is a clearly deliberate reference to the Complainant's name and trade mark. Simply by construing the Domain Name on its face, it is clear that the Domain Name is not meant to promote the Respondent's business interest, but to carry a message to viewers and internet users regarding the Complainant.

If there is any remaining doubt as to whether the Respondent has any rights or legitimate interests in respect of the Domain Name, the Domain Name should be construed in the context of the contents of the website, which makes reference to the Complainant's personnel and identifies the authors as ex-clients of the firm. It is clear that the Respondent is using the Domain Name in reference to the Complainant's name and trade mark.

Therefore, the Respondent has no rights or legitimate interests in respect of the Domain Name, and is not claiming any rights or legitimate interests in respect of the Domain Name.

The Domain Name was registered and is being used in bad faith to defame the Complainant. Before the registration of the Domain Name, the Respondent clearly had knowledge of the Complainant's trade mark and its value. That was the reason why the Respondent used it in the Domain Name. The use of the word "scam" in the Domain Name was intended to describe the Complainant as dishonest and deceitful, or else, in the very least, that the Complainant is guilty of professional misconduct and lacks professionalism. If there is any remaining doubt as to whether the Domain Name is being used in bad faith, the Domain Name should be construed in the context of the website, which contains a number of statements that are clearly defamatory as it lowers the Complainant in the estimation of right-thinking members of society generally. The fact that the defamatory Domain Name affects the Complainant's professional standing in the eye of the Singapore public shows the severity of this complaint. This shows that the Domain Name is being used in bad faith

Paragraph 4(b) of the Policy lists, without limitation, certain circumstances which will constitute evidence of the registration and use of a domain name in bad faith, including (iii): "[the Respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor". The Respondent intended to use the Domain Name to defame the Complainant and thereby disrupt the Complainant's business. Although the Complainant is not a competitor of the Respondent, this should not prevent the Complaint from satisfying the element of bad faith on the part of the Respondent. The registration of the Domain Name does not serve the commercial purpose of the Respondent, but serves the tortious intention of the Respondent. This must be prohibited by the spirit of the Policy. In any event, bad faith, which is a general term, would certainly include the circumstances of this Complaint.

(i) The Complainant seeks cancellation of the Domain Name.

B. Respondent

As mentioned, there was no formal Response. However, by email to the ADNDRC on May 31, 2016, the Respondent offered to take down the website if the Complainant undertook not to sue the Respondent.

## **5. Findings**

In accordance with paragraph 4(a) of the Policy, to obtain cancellation of the Domain Name the Complainant must prove the following three elements: (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in the Domain Name; and (iii) the Respondent has registered the Domain Name and is using it in bad faith.

Under paragraph 15(a) of the UDRP Rules, "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, asserted facts may be taken as true and reasonable inferences may be drawn from the

information provided by the complainant. See *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. D2000-0441.

### **A) Identical / Confusingly Similar**

The Panel accepts that, through use, the Complainant has established common law trademark rights in the name CONSILIUM LAW.

The Domain Name is not identical to the Complainant's mark since it comprises that mark and the geographic identifier "Singapore", the word "scam" and the inconsequential gTLD ".com", which may be disregarded: *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525.

In determining confusing similarity, evidence of actual confusion is not required. The test is an objective one, confined to a comparison of the Domain Name and the trademark alone, independent of the products or services for which the Domain Name may be used, or other marketing and use factors usually considered in trademark infringement cases (see *Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic*, WIPO Case No. D2000-1698; *AT&T Corp. v. Amjad Kausar*, WIPO Case No. D2003-0327).

Generally, a domain name consisting of a trademark and a pejorative term is considered confusingly similar to the trademark since the pejorative word typically does not serve to obviate confusion for the purposes of this element. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.3.

Here the distinctive element of the Domain Name is the Complainant's trademark. The word "Singapore" does nothing to distinguish the Domain Name from that trademark. Although the message likely to be conveyed to fluent English speakers by the pejorative word "scam" is that the Domain Name is not associated with or authorized by the Complainant, not all Internet users are fluent English speakers.

In similar circumstances in *National Westminster Bank PLC v. Purge I.T. and Purge I.T. Ltd.*, [WIPO Case No. D2000-0636](#) (August 13, 2000) the Panel concluded in relation to the domain name <natwestsucks.com>:

"The first and immediately striking element in the Domain Name is the Complainant's name. Adoption of it in the Domain Name is inherently likely to lead some people to believe that the Complainant is connected with it. Some will treat the additional "sucks" as a pejorative exclamation and therefore dissociate it after all from the Complainant; but equally others may be unable to give it any very definite meaning and will be confused about the potential association with the Complainant".

Adopting this approach, the Panel finds the Domain Name to be confusingly similar to the Complainant's trademark.

The Complainant has established this element of its case.

### **B) Rights and Legitimate Interests**

Paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if

established by the Respondent, shall demonstrate the Respondent's rights to or legitimate interests in the Domain Name for purposes of paragraph 4(a)(ii) of the Policy, *i.e.*

- (i) before any notice to the Respondent of the dispute, the use by the Respondent of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business or other organization) has been commonly known by the Domain Name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

If the Complainant first establishes a *prima facie* showing of absence of rights or legitimate interests in respect of the Domain Name on the part of the Respondent, the evidentiary burden shifts to the Respondent to show by concrete evidence that he does have rights or legitimate interests in the Domain Name. See *Cassava Enterprises Limited, Cassava Enterprises (Gibraltar) Limited v. Victor Chandler International Limited*, WIPO Case No. D2004-0753.

The Panel respectfully adopts the reasoning of the learned panellist in *Alsace Croisieres SA v. John Livingstone / Write Place Publications Inc.*, WIPO Case No. D2013-2025 (croisieuropeusucks.com):

“The Panel is aware of the diversity of opinion expressed as to whether rights or legitimate interests arise for criticism sites as expressed in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”).

Firstly, it is noted that there are many UDRP decisions where the respondent argues that the subject domain name is being used for a free speech purpose but the panel finds that it is primarily a pretext for commercial advantage. This does not appear to be the case in the present proceeding. There are no advertisements on the Respondent's Website, there is no evidence that the Respondent is a competitor of the Complainant, nor is there any evidence that the Respondent has operated this website for any commercial purpose.”

The circumstances of the present case are similar to those in *Alsace Croisieres*. There are no advertisements on the Respondent's website. The Complainant concedes that the Respondent is not a competitor of the Complainant and that the Domain Name is not being used for the purpose of the Respondent's business.

The material provided by the Complainant indicates that the Respondent registered the Domain Name containing the word “scam” which inherently denotes criticism of the Complainant and that the Respondent is not attempting to impersonate the Complainant or misleadingly to divert consumers but is using the Complainant's trademark in the Domain Name to identify the Complainant for the purpose of operating a genuine, non-commercial website that criticises the Complainant. Such use of a trade mark is generally described as “fair use”. The Panel accepts the Complainant's assertion that the Domain Name is not meant to promote the Respondent's business interest, but to carry a message to viewers and internet users regarding the Complainant.

The Panel adopts the statement in *Howard Jarvis Taxpayers Association v. Paul McCauley*, WIPO Case No. D2004-0014:

“The Policy is designed to prevent abusive cybersquatting, but ... it cannot extend to insulating trademark holders from contrary and critical views when such views are legitimately expressed without an intention for commercial gain.”

It is beyond the proper scope of this proceeding for the Panel to determine whether the Domain Name and the content of the Respondent’s website are defamatory nor whether the defences of justification or fair comment provided under Singapore defamation law are available to the Respondent.

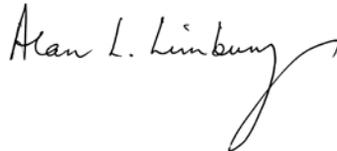
Therefore, the Panel finds that the Complainant has failed to establish that the Respondent has no rights or legitimate interests in respect of the Domain Name.

**C. Registered and Used in Bad Faith**

Given the Panel’s finding in relation to the previous element, it is not necessary to make a finding under this element.

**6. Decision**

Because the Complainant has failed to establish that the Respondent has no rights or legitimate interests in respect of the Domain Name, the Panel declines to order cancellation of the Domain Name.



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Alan L. Limbury  
Panelist

Dated: June 23, 2016