

NOMINET UK DISPUTE RESOLUTION SERVICE

DRS 04596

DECISION OF INDEPENDENT EXPERT

1. Parties

First Complainant : Ricoh Company Limited
Address : 3 - 6
1 Chome
Naka-Magome
Ohta Khu
Tokyo
Postcode : 143-8555
Country : Japan

Second Complainant : Arena Coventry Limited
Address : Ricoh Arena
Phoenix Way
Foleshill
Coventry
Postcode : CV6 6GE
Country : GB

Respondent : Paul Edwards
Address : 51 Hawkes Mill Road
Coventry
Postcode : CV5 9FQ
Country : GB

2. The Domain Name

coventryricoharena.co.uk

3. Procedural Background

3.1 On 3 April 2007 the Complaint was lodged with Nominet in accordance with the Nominet UK Dispute Resolution Service Policy (“the Policy”).

Hard copies of the Complaint and its attachments were received in full by Nominet on 4 April 2007.

3.2 On 4 April 2007 Nominet validated the Complaint. On the same day it sent a copy of the Complaint to the Respondent, and *inter alia* advised the Respondent that the Procedure for the conduct of proceedings under the Nominet UK Dispute Resolution Service (“the Procedure”) had been invoked and allowed the Respondent 15 working days within which to respond to the Complaint.

3.3 No official Response was received from the Respondent by Nominet by 1 May 2007. On 10 May 2007 the relevant fee was received by Nominet from the Complainants in order for the matter to be referred to an independent expert for a decision.

3.4 On 15 May 2007 a non-standard submission was received from the Respondent by Nominet.

3.5 On 16 May 2007 Bob Elliott was selected and duly appointed as Expert and the file was transmitted to the Expert pursuant to paragraph 11 of the Procedure.

4. Outstanding Formal/Procedural Issues

4.1 The non-standard submission from the Respondent referred to at paragraph 3.4 above was sent under cover of an explanatory paragraph as required under paragraph 13.b of the Procedure, explaining that the Respondent had missed the deadline for an official Response because he did not receive anything through the post, and that he had not picked up or noticed emails sent to the email contact details provided in connection with the Domain Name.

4.2 Upon reviewing the file, the Expert has seen copies of emails between the Respondent and Nominet dating from 1 May 2007, in which the Respondent appears to have believed that the deadline for a Response was 13 May 2007 (although it seems that he was confused in that respect, as that deadline was applicable to a parallel complaint through WIPO’s procedures, relating to coventryricoharena.com). Nominet duly clarified

the misunderstanding, but pointed out that the Response period in the respect of the Nominet DRS proceeding had already expired.

- 4.3 It would appear that Nominet has used the correct addresses given by the Respondent in its contact details, for the purposes of communicating the Complaint. In the light of the possible confusion caused by the parallel WIPO .com complaint, the Expert has nevertheless decided at his sole discretion to admit the further statement, pursuant to paragraph 13.b of the Procedure. However, in the light of his decision which appears below, the Expert does not consider it necessary to request any further statements on behalf of the Complainants in reply.

5. The Facts

- 5.1 The First Complainant is a Japanese company, which is a well known designer, manufacturer and supplier of office equipment. Its sales for each of the last five years have exceeded the equivalent of UK £7,000 million.
- 5.2 The First Complainant is the proprietor of a number of trade marks incorporating the word RICOH. These marks date back to 1 November 1967.
- 5.3 The Second Complainant was formed in August 2002 to build and manage a new stadium for Coventry City Football Club, incorporating a hotel, events and conference facilities. The stadium, called the Ricoh Arena holds 40,000 people. The exhibition halls have an 8,000 person capacity and the conference facilities can cater for up to 5,000 people.
- 5.4 The First Complainant acquired the sponsorship and naming rights to the new stadium. In connection with those rights it applied for the UK trade mark RICOH ARENA for a variety of goods and services on 9 May 2005 (although an opposition appears to be pending). The mark was first publicised on 26 April 2005, and has been used extensively since.
- 5.5 A group company of the First Complainant, NRG Group UK Limited, has registered the domains ricoharena.com and ricoharena.co.uk on behalf of the Complainants.

- 5.6 Since its opening in the summer of 2005, the stadium development has proved to be a success, attracting more than one million visitors in the first 12 months, and hosting a number of well known pop groups. It has also been used for football matches, with attendances in excess of 15,000, as well as hosting an England and Germany under 21 football match. As a result of such use, as well as other brochures and advertising, the mark RICOH ARENA is said to have acquired a substantial goodwill and reputation.
- 5.7 The Respondent registered the Domain Name on 24 August 2005. The Second Complainant became aware of the Domain Name in November 2006 (at the same time as becoming aware of the domain name coventryricoharena.com). The Domain Name and its .com equivalent resolve to a website whose Home page begins with “a warm welcome to the **unofficial** site about what is happening in and around The Ricoh Arena”. The site contains details of events, latest football news, facilities, travel, local teams, “your shout”, and a separate disclaimer page.
- 5.8 There are a number of links on the website, one of which is to a website selling hotel rooms (www.superbreak.com). Although the website refers to the Second Complainant’s own Arena Hotel as being bookable through the Superbreak website, it apparently was not (although other local hotels were bookable). The Respondent’s website’s home page also includes the title “Ricoh Arena stadium parking, events, exhibition events at the Ricoh Arena Stadium, Gig’s in Coventry and Coventry City news” as the header of the page, and “RICOH ARENA” and “FOOTBALL CONCERTS EXHIBITIONS” appear at the top of the page.
- 5.9 On 8 November 2006, the Complainants’ Representative wrote to the Respondent in respect of the Domain Name using the details available from the Nominet WHOIS query result, asking the Respondent to transfer the Domain Name to the Second Complainant. There was no reply to that letter.
- 5.10 The Respondent appears to run a business known as Core Design Communications, based in Coventry (which is currently advertised on the

Respondent's website).

6. The Parties' Contentions

Complainants' Submissions

Rights

6.1 The Complainants say that they have established rights in the trade marks RICOH and RICOH ARENA, and that the Domain Name is very similar to the First Complainant's registered RICOH trade marks, and its currently unregistered rights in the RICOH ARENA trade mark.

6.2 The Complainants state that these are enforceable legal rights falling within the definition of "Rights" under the Policy, which pre-date the date of registration of the Domain Name.

6.3 The only difference between the Domain Name and the corresponding trade marks is the addition of the descriptor "Coventry Arena" (in the case of the RICOH trade mark) and "Coventry" (in the case of the RICOH ARENA trade mark). The Complainants say that the word "Coventry" is merely descriptive of a city in the United Kingdom where the Ricoh Arena is situated.

Abusive Registration

6.4 The Complainants rely primarily upon the Respondent using the Domain Name in a way which is likely to confuse internet users into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants. In support of this, the Complainants contend that the Respondent's website does not simply provide information about the Ricoh Arena – it is a commercial site which seeks to trade on the goodwill and reputation which subsists in the RICOH and RICOH ARENA trade marks.

6.5 The Complainants believe that internet users seeking information about the Second Complainant may enter the words "CoventryRicoHarena" into their browser, or enter those words into an internet search engine, and would be diverted or directed to the Respondent's website, offering services which are in competition with the Second Complainant's. The

Complainants submit that this will confuse internet users as to the true origin of the site, and that it may lead to lost advertising revenue, lost sales, dilution of the exclusivity of the Complainants' trade mark, and harm to the goodwill and reputation of the Complainants, trading on the considerable goodwill that subsists in the trade marks RICOH and RICOH ARENA, which the Respondent was aware of, when he registered the Domain Name.

6.6 As regards the disclaimer on the Respondent's website, the Complainants say that this is inadequate to dispel the initial interest confusion which would lead internet users to the website, and refer to the decision of the Appeal Panel in *Hanna-Barbera Productions Inc v Graeme Hay* DRS 00389 – scoobydoo.co.uk (where there was a similar disclaimer on the Respondent's website).

6.7 The Complainants say that the predominate use of the website in this case is to generate advertising revenue. There are a number of advertisements on the website itself, and there is a section of the website devoted to the purposes of gaining further paying advertisers. There are also a number of sponsored links, and the potential development of other links to other websites, including a list of other conference facilities in the Coventry area, which not only potentially damages the Second Complainant's business but also provides scope for further revenue through advertising and sponsored links.

6.8 In addition, the Complainants also contend that the Respondent's primary purpose for registering the Domain Name was that of unfairly disrupting the Complainants' business, not least because of the links to websites offering other conference facilities in the Coventry area.

6.9 The Complainants seek the transfer of the Domain Name (they do not specify which Complainant should be the transferee, although the Expert notes that the Complaint in the equivalent .com WIPO proceeding asks for transfer to the Second Complainant).

Respondent's Submissions

6.10 In his non-standard submission, the Respondent refers to the site only

being a guide site, with links to other sites for more specific details, and RSS leads from the BBC's website for football updates.

- 6.11 The Respondent says that the site is aimed at being interactive with the local community, and that it was not intended to be in competition to "the Ricoh Arena", instead as a local person the Respondent "felt that the official site didn't do justice to the great facility that had been built in our City". The Respondent further says that he is not "financially gaining from using [the Complainants'] name which is not the case".

7. Discussion and Findings:

General

- 7.1 In order to succeed in these proceedings, paragraph 2.b of the Policy requires the Complainants to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present namely that:
- i. the Complainants 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.

Complainants' Rights

- 7.2 The Complainants clearly have Rights in both the RICOH and RICOH ARENA trade marks. Although the trade mark RICOH ARENA has not yet been registered, the mark appears to have been used extensively in trade and in advertising, as a result of which it is likely to have acquired substantial goodwill and reputation, which the public will be likely to have associated with the operating company, the Second Complainant.
- 7.3 As regards the difference of the addition of the word "Coventry" between the RICOH ARENA mark and the Domain Name, Coventry is obviously a geographical location, and the Expert accepts the Complainants' submission that, in its use as part of the Domain Name it is merely descriptive of the city in the United Kingdom where the Ricoh Arena is situated. In the circumstances, the Expert is satisfied that the Complainants have established that they (and the Second Complainant in particular) have Rights in a name or mark (RICOH ARENA) which is similar to the Domain Name.

Abusive Registration

7.4 Paragraph 3.a of the Policy contains a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. These include:-

- a) Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 3.a.i.C);
- b) Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (paragraph 3.a.ii).

Both of these sub-paragraphs are relied upon by the Complainants.

7.5 As regards paragraph 3.a.i.C, the Expert is not convinced that the Complainants have made out their case. On balance, it seems to the Expert that it was unlikely that the Respondent had any settled intention of unfairly disrupting the business of the Complainants, and the Complainants do not suggest what motive the Respondent might have had to do so. Registration of the Domain Name itself does not appear to have prevented the Complainants from trading as they wished – on the basis of their own Complaint, an associated company registered the domain names ricoharena.co.uk and ricoharena.com. It was also more than a year following registration before the Complainants became aware of the registration of the Domain Name. In addition, the fact that the website has links to websites offering conference facilities which are apparently in competition to those of the Second Complainant in the Coventry area appears unlikely to damage the goodwill and reputation of the Complainants' own name and trade marks to a significant degree. If there is any such damage, then the Expert regards that as being likely to have been incidental, rather than the primary purpose of the registration of the Domain Name.

7.6 However, as regards paragraph 3.a.ii, the Expert sees little reason to

disagree in principle with the approach of the Appeal Panel in *Hanna-Barbera Productions Inc v Graeme Hay* (DRS 00389 - scoobydoo.co.uk) (the Expert was a member of that Panel). The addition of the word “Coventry” to the name “Ricoh Arena” merely serves to demonstrate its geographical location. Otherwise, the Second Complainant’s trading name has been taken, without adornment, by the Respondent. It may be that the Respondent had in mind some kind of public service in setting up his website, however, that was also the case in DRS 00389, and did not prevent the Panel in that case from coming to the conclusion that the domain name in that case was an Abusive Registration.

7.7 In this case, the Domain Name is clearly intended to refer to the Complainants’ trade marks and business. Inevitably, a number of internet users visiting the site will do so in the expectation that the site is an official site of the Complainants. The Domain Name and the site to which it is connected have apparently been used for the purposes of generating advertising revenue, together with the use of links which are, or may be sponsored links to associated sites. The disclaimer is likely to be ineffective, as by the time it is read, the Respondent will have been likely to have achieved a business opportunity that in most cases he would not otherwise have had.

7.8 In addition, the site is not one which could be described as being operated solely in tribute to or in criticism of the Complainants’ business. It is possible that, in the way the site is set up, it may attract some comments of support or criticism of the Complainants’ business. If so, then such comments would be incidental at best to the primary purpose of the site, which appears to be to link to other resources, and in doing so to attract advertising and possible revenue from linking to such sites, and in doing so to have taken advantage of the repute of the Complainants’ trade marks. In using the Domain Name in that way, the Expert considers that the Respondent’s use has not been fair.

7.9 Therefore, the Expert considers that the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainants’ Rights, within the meaning of paragraph 3.a.ii of the Policy.

8. Decision

8.1 The Expert finds that the Complainants have Rights in the name or mark Ricoh Arena, which is similar to the Domain Name. The Expert further finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

8.2 The Expert therefore decides that the Domain Name should be transferred to the Second Complainant.

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Bob Elliott

25 May 2007