

Nominet UK Dispute Resolution Service

DRS 05009

Harper Collins Publishers Limited v Jon Smith

Decision of Independent Expert

1. *Parties:*

Complainant: *Harper Collins Publishers Limited*
Address: *103 Westerhill Road*
Bishopbriggs
Glasgow
Postcode: *G64 2QT*
Country: *UK*

Respondent: *Jon Smith*
Address: *Rothbury*
Station Road
Alvescot
Oxfordshire
Postcode: *OX18 2PS*
Country: *UK*

2. *Domain Name:*

tolkien.co.uk("the Domain Name")

3. *Procedural Background:*

The Complaint was lodged with Nominet on September 3, 2007. Nominet validated the Complaint and notified the Respondent of the Complaint on September 3, 2007 and informed the Respondent that it had 15 days within which to lodge a Response. No Response was received. On October 2, 2007 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

Dawn Osborne, the undersigned, ("the Expert") confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

4. The Facts:

The Complainant is the exclusive English language publisher of the literary works of the author JRR Tolkien in the UK and the rest of the world excluding the USA. The Complainant or its predecessors have used the TOLKIEN name for over 70 years in international book publishing. The Complainant has the exclusive right to use the TOLKIEN name as a trade mark in relation to books throughout the world excluding the USA and certain other related products licensed for use throughout the world. The Complainant also has the right to operate the website tolkien.co.uk. This licence is granted by the Tolkien Estate which is the owner, inter alia, of registered trade mark rights in the UK and a Community Trade mark for the TOLKIEN mark.

The Respondent registered the Domain Name on 2 September 2000. It was originally used for a criticism site. In April 2001 the Complainant paid the Respondent £5000 for the Domain Name and the Complainant has controlled the content related to the site ever since. However the formal transfer of the Domain name to the Complainant never took place.

5. The Parties' Contentions:

Complainant:

The substance of the Complaint is as follows:

1. The Complainant is the exclusive English language publisher of the literary works of the author JRR Tolkien in the UK and the rest of the world excluding the USA. The Complainant has used the TOLKIEN name since its acquisition of JRR Tolkien's original publishers Unwin Hyman Limited and George Allen & Unwin (Publishers) Limited in 1990. The Complainant or its predecessors in business have used the TOLKIEN name for over 70 years in international book

publishing. The Complainant has the exclusive right to use the TOLKIEN name as a trade mark in relation to books for the whole world excluding the USA and for certain related licensed products throughout the world. The Complainant also has the right to operate of the website tolkien.co.uk. This licence is granted by the Tolkien Estate which is the owner of, inter alia, registered trade marks in the UK and a Community Trade mark for the TOLKIEN mark. The Complainant has submitted a volume of documentary evidence to show the TOLKIEN mark is used extensively as a trade mark to indicate trade origin. As a result of the above use the Complainant has built up considerable goodwill on behalf of the Tolkien Estate.

- 2. The Domain Name is identical to the TOLKIEN mark in which the Complainant has rights.*
- 3. The Respondent was not connected with the Complainant or the Tolkien estate and did not have permission to use the TOLKIEN name. He has no rights in the Domain Name. He has no registered trade marks and has no goods or services commonly known by the TOLKIEN name.*
- 4. The registration of the Domain Name is a blocking registration registered to create a confusing association with the TOLKIEN mark. The registration was registered or otherwise acquired by the Respondent 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.*
- 5. The Respondent originally used the Domain Name for a tribute/criticism site. In April 2001 the Complainant paid the Respondent £5000 for the Domain Name and the Complainant has controlled the content related to the site ever since. The formal transfer of the Domain name to the Complainant, although envisaged by the agreement, never actually took place. The Complainant has written to the address last known for the Respondent but there has been no reply.*

Respondent:

No response was received.

6. Discussion and Findings:

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

The Complainant is the exclusive licensee of the trade mark TOLKIEN for books throughout the world excluding the USA and certain related licensed products throughout the world. This license is granted by the Tolkien Estate which is the owner, inter alia, of registered trade mark rights in the UK and a Community trade Mark for the TOLKIEN mark. The Complainant thus has rights in the TOLKIEN mark. The Domain Name consists of the TOLKIEN trade mark (plus the generic suffix .co.uk which is disregarded for these purposes). As such the Expert finds that the Complainant has Rights in respect of the TOLKIEN name or mark, which is identical to the Domain Name.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. Potentially relevant 'factors' in paragraph 3 are to be found in subparagraph i and ii, which read as follows:

- i "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 the 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;"
- ii 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."

There is no evidence as to the intention of the Respondent upon registration of the Domain Name, although the Domain Name has been sold to the Complainant, and no evidence that there has been any actual confusing use by the Respondent. However, whilst the circumstances of this case do not fall squarely within the list of factors in paragraph 3a of the Policy, these factors are expressed to be non exclusive. Since the Domain Name was sold by the Respondent to the Complainant and the agreement envisaged that the Domain Name as well as control over the site connected to the Domain Name would be transferred to the Complainant the panellist is satisfied that, while it may be inadvertent, the continuing registration of the Domain Name in the name of the Respondent and the accompanying ability to control the use of the Domain Name gives the Respondent an unfair advantage and is, unfairly detrimental to the Complainant. Accordingly the Panellist finds that the use and registration by the Respondent in these particular circumstances is abusive.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy.

7. *Decision:*

In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, tolkien.co.uk be transferred to the Complainant.

October 16, 2007

Dawn Osborne

Date