

# Nominet UK Dispute Resolution Service

**DRS 03003**

## **BitTorrent Inc -v- Justice**

### **Decision of Independent Expert**

#### **1. Parties**

Complainant: BitTorrent Inc  
Address: 2325 3<sup>rd</sup> Street  
Suite 218  
San Francisco

Postcode: 94107  
Country: US

Respondent: Justice  
Address: Street  
City

Postcode: A1 1AA  
Country: GB

#### **2. Domain Name**

bittorrent.co.uk

#### **3. Procedural Background**

The Complaint was lodged with Nominet on 30 September 2005. Nominet validated the Complaint and notified the Respondent of the Complaint on 30 September 2005 and informed the Respondent that it had until 24 October 2005 to lodge a Response. A Response was received on 24 October 2005 from a German Lawyer on behalf of DAY Networks Marketing GmbH ("DAY Networks") and forwarded to the Complainant on the same date with an invitation to make any further submission by 2 November 2005. The Complainant filed a Reply on 2 November 2005. On 22 November 2005 Nominet informed the parties that it had not been possible to achieve a resolution to the dispute by Informal Mediation and invited the Complainant to pay the fee to obtain an Expert Decision by 6 December 2005. On 6 December 2005 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").

On 13 December 2005 the undersigned David King ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as Expert in this case and further confirmed that he knew of no matters which ought to be brought to the attention of the parties which might appear to call into question his independence and/or impartiality.

#### **4. Outstanding Formal/Procedural Issues (if any)**

By paragraph 1 of the Policy, "Respondent means the person (including a legal person) in whose name or on whose behalf a Domain Name is registered and against whom the Complainant makes a complaint." The Expert has made enquiries of Nominet as to why the Response to the Complaint has been made by DAY Networks. It appears that DAY Networks claim to have purchased the Domain Name from Justice in about July 2003 and that, by the time the Complaint was lodged over two years later, no transfer form relating to the Domain Name had been submitted to Nominet, despite the fact that the procedure for the transfer of a Domain Name has been published on Nominet's web-site since at least August 2000.

The Domain Name therefore remains registered in the name of the registrant, Justice, and the Complaint has been made by the Complainant on the basis that Justice is the Respondent. In the circumstances, Justice is the Respondent in accordance with the definition contained in paragraph 1 of the Policy and the Expert does not consider it appropriate to take into account the Response made by DAY Networks.

#### **5. The Facts**

In 2001, Mr Bram Cohen, a software programmer in the United States developed a software program which he called "bittorrent". This program has become one of the most widely used tools for downloading files such as movies or software. On 22 September 2004 Mr Cohen incorporated his business as "BitTorrent Inc" in California U.S. and, since then, this company has marketed and distributed the software "bittorrent".

On 27 November 2002, the Domain Name was registered in the name of Justice.

#### **6. The Parties' Contentions**

##### Complainant

In summary the Complaint says:

Since it launch in August 2001, "bittorrent" has been downloaded over 2.2 million times worldwide for version 4.0.1 alone, which has been in circulation a mere six months.

The Domain Name is identical to the Complainant's company name and its trademark. The Complainant's business is commonly known by the name "BitTorrent" both in the UK and throughout the world. BitTorrent's website "www.bittorrent.com" was registered and launched over one year prior to the registration of the Domain Name.

"Bittorrent" is a highly distinctive term, which was selected specifically for its unique and distinctive nature. The Domain Name consists solely of the term "bittorrent" with only the generic country code top level domain extension ".co.uk" appended to it. The Domain Name is therefore identical to the Complainant's name for the purposes of these proceedings.

The Domain Name is identical to the Complainant's trademark. The Complainant was granted trademark registration in the European Community on 11 July 2005 via two Nice Class 9 Community Trade Marks ("CTMs"), one for the term "bittorrent" and the other in the combination of the term and its associated logo, as CTM numbers 004470498 and 004470407. There is another CTM number 3216439, for "bittorrent", registered to DAY Networks Adlassnig & Partner KEG, which is itself currently the subject of a dispute involving over fifty domain names representing misspellings of "bittorrent" with WIPO. DAY Networks' registration of the "bittorrent" mark was a deliberate and calculated attempt to buttress a bogus claim of rights in the Complainant's mark and to exploit unfairly the success of the Complainant's product. There is no evidence that the Respondent has ever been known as, released any products or services named, or had any legitimate rights in, or to, the "bittorrent" name. The Complainant is currently preparing its opposition to the DAY Networks CTM.

“Rights”, as defined in the Policy and Nominet’s Procedure “includes, but is not limited to, rights enforceable under English law.” The “bittorrent” trademark has developed substantial goodwill and reputation in the “bittorrent” name, due to extensive coverage in the British marketplace. These unregistered rights also constitute “Rights” for the purposes of the Policy.

The Respondent has provided false contact details to Nominet. The current WHOIS information lists only the name “Justice” and provides contact information, which is obviously false. The Respondent’s address is cited simply as “Street, City, A1 1AA and no e-mail address, phone number or fax number are shown. Under paragraph 3 iv of the Policy the submission of false contact details is one factor named in the non-exhaustive list of evidence that a registration should be deemed abusive. The Complainant cites the Nominet DRS decision of Calvin Klein Inc v Make (DRS 02163), in which the respondent’s address was invalid, was found to constitute evidence of false contact details and the registration was deemed to be abusive.

The Domain Name has registered or otherwise acquired the Domain Name primarily for the purpose of disrupting the business of the Complainant. The Respondent has adopted an inherently distinctive name which is primarily referable to the Complainant and there is no obvious justification for doing so. This alone is sufficient to shift the burden of proof to the Respondent to explain and show that the registration is not abusive and the Complainant cites the Nominet DRS decisions of Chivas Brothers Limited v David William Plenderleith (DRS 00658) and Netezza v Airpaid Ltd (DRS 02475).

The Complainant requests that the Domain Name be transferred to the Complainant.

#### Respondent

In view of the Expert’s comments in paragraph 4, it is not appropriate to set out or consider the Response from DAY Networks or the Complainant’s Reply to the Response.

### **7. Discussion and Findings:**

#### General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in paragraph 1 of the Policy.

For reasons already given by the Expert, the Respondent in this case is Justice.

#### Complainant’s Rights

With its Complaint, the Complainant has provided copies of Press articles regarding the Complainant and the software “BitTorrent” together with evidence of the extensive downloading of the software since it was launched, registration of www.bittorrent.com on 13 August 2001, incorporation of the Complainant in California on 22 September 2004 and CTM registrations in May 2005. Although the incorporation of the Complainant’s business and registration of its CTMs took place some time after registration of the Domain Name (27 November 2002), Mr Cohen developed the software over one year prior to registration of the Domain Name, he chose to call the software “BitTorrent” and marketed it through his business “BitTorrent” prior to incorporation. In many previous Nominet DRS cases, the threshold for establishing “Rights” has been held to be low. The Expert is satisfied that the Complainant has goodwill in the name “BitTorrent”.

The Complainant has also referred to CTM number 3216439 for the mark “bittorrent” registered to DAY Networks and indicates that this registration is in dispute. The Expert is

unable to make any comment as to which party may have the better right to the mark as disputes of this type must be referred to some other appropriate forum.

The Domain Name is identical to the name of the Complainant and its previous unincorporated business. It is appropriate to discount the domain suffix <.co.uk> which is of no relevant significance and wholly generic and also to discount the capitalisation of certain letters in the name "BitTorrent".

The Expert finds that, for the purposes of the Policy, the Complainant does have Rights in respect of a name or mark which is identical to the Domain Name.

#### 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 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 3 of the Policy. The Complainant relies on two of the factors, first, 3 a iv and, secondly, 3 a i C.

Under paragraph 3 a iv, it may be evidence of Abusive if Registration if it is independently verified that the Respondent has given false contact details to Nominet. It is quite clear that the Respondent has provided an invalid address of "City, Street, A1 1AA, GB", with the effect that the true identity and location of the Respondent is unknown. Nominet's file provided to the Complainant shows that, on 30 September 2005, Nominet attempted to send an e-mail to the Respondent at postmaster@bittorrent.co.uk but this failed. In the view of the Expert, this indicates Abusive Registration in this case. This was also a factor taken into account in the Calvin Klein case (DRS 02163) cited by the Complainant.

Under paragraph 3 a i C, it may be evidence of Abusive Registration if circumstances indicate that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. The Complainant has not specified how its business has been disrupted but the Expert is entitled to take into account all the circumstances of the case. The Expert has already stated that he is satisfied that the Complainant has goodwill in the Domain Name. The Expert can see no good reason for the Respondent having chosen to register such a distinctive name, which was selected by Mr Cohen more than one year prior to the Respondent's registration. For the avoidance of doubt this does not shift the burden of proof to the Respondent but, in any event, the Expert considers that the Complainant has proved its case on the balance of probabilities.

#### **8. Decision**

In light of the above 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 www.bittorrent.co.uk be transferred to the Complainant.

David King

21 December 2005