

Nominet UK Dispute Resolution Service

DRS Number 033665

B E T W E E N:

THE JRR TOLKIEN ESTATE LIMITED

Complainant

- and -

TOLKIENET.COM

Respondent

Decision of Independent Expert

1. Parties

Complainant: The JRR Tolkien Estate Limited
Address: 9400 Garsington Road
Oxford Business Park
Oxfordshire
Postcode: OX4 2HN
Country: GB

Respondent: Tolkienet.com
Address: Not known
Postcode: Not known
Country: Not known

2. Domain Name

jrrtolkien-co.uk

3. Procedural Background

3.1.1 The Complaint, which is a complaint of Abusive Registration under the Dispute Resolution Procedure (“the DRS”) of Nominet UK (“Nominet”), and is dated 8 May 2006, was posted by Nominet to the Respondent under cover of a letter dated 9 May 2006. The covering letter included the following paragraphs:-

“A copy of the complaint is attached to this letter, which is deemed to have been received by you on 10 May 2006 (please refer to paragraphs 2(a) and 2(e) of the Procedure).

In accordance with the Procedure, you have 15 working days, ie until 1 June 2006 to respond to the complaint. In order to be valid, your response must comply with the Procedure, and must be received by Nominet in both hard copy and electronic form.”

3.1.2 The Respondent did not respond by 1 June 2006 or at all. In a letter dated 2 June 2006 Nominet wrote again to the Respondent, referring to the letter dated 9 May 2006 and to the failure of the Respondent to submit a response within the deadline, and communicating that in the circumstances, this dispute would not go through the Informal Mediation stage of the Dispute Resolution Service, but would be referred to an independent expert for a decision if JRR Tolkien Estate Limited paid the appropriate fees by 16 June 2006 - a condition which was fulfilled.

3.1.3 By letter dated 7 June 2006 I was appointed with effect on 14 June 2006 to provide a Decision under Nominet UK’s Dispute Resolution Policy (“the Policy”). I am required to send my decision to Nominet no later than 28 June 2006.

3.1.4 I have been provided with the following materials:-

- Dispute History
- Complaint
- Standard correspondence between Nominet and the parties
- Companies House print outs for parties.
- Register entry for jrrtolkien.co.uk
- Nominet WHOIS query result for jrrtolkien.co.uk
- Printout of website at www.mycashnow.me.uk.
- Copy of Nominet UK’s Policy and Procedures.

4. **Outstanding Formal Procedural Issues**

4.1 There are no outstanding formal or procedural issues.

5. **The Facts**

5.1 The domain name was registered by the Respondent on 23 July 2003.

6. **The Parties' Contentions**

Complainant

6.1 The Complaint of Abusive Registration is in the following terms:-

The Complaint

"I confirm that Domain Name(s) in dispute are identical or similar to a name or mark in which I have Rights.

I confirm that Domain Name(s) in the hands of the Respondent is an Abusive Registration

(1) Rights in a name and/or mark:

- (a) The Complainant is responsible for the administration of the rights in the works of the late author, Professor JRR Tolkien. Professor Tolkien's works have been widely published under the marks JRR TOLKIEN and TOLKIEN since the publication of *The Hobbit* in 1937, and there is a vast world-wide market for books and other products sold under the TOLKIEN and JRR TOLKIEN marks. The best known work, *The Lord of The Rings*, was first published in 1954; it has been translated into 36 languages and an estimated 100 million copies have been sold worldwide. Hugely successful licensed motion pictures based on *The Lord of the Rings* were released in 2001, 2002 and 2002. The motion picture rights and associated merchandising rights are currently held by The Sael Zaentz Company and New Line Cinema.
- (b) The Complainant is the proprietor of registered UK and Community trade marks for TOLKIEN, JRR TOLKIEN, JRRT and RONALD TOLKIEN. See the summary details and case details at Exhibit 1.
- (c) These trade marks form a part of the Complainant's world-wide portfolio of trade mark registrations, which includes trade marks for TOLKIEN, JRR TOLKIEN, JRRT and RONALD TOLKIEN registered in Australia, Canada, New Zealand, South Africa and the USA. See the summary details at Exhibit 2.
- (d) The Complainant's trade marks are licensed to a world-wide exclusive licensee, HarperCollins, and are used extensively under that licence in connection with the sale of audio tapes, calendars, maps and other merchandise, as well as books. See the examples at Exhibit 3.
- (e) The Complainant has pending applications around the world for the registered trade marks TOLKIEN, JRR TOLKIEN, JRRT and RONALD TOLKIEN. See the summary details at Exhibit 4.

- (f) The Complainant is registrant of the 38 domain names listed at Exhibit 5 that are identical or similar to the Domain Name. The Complainant's domain name registrations include JRRTOLKIEN.COM, JRRTOLKIEN.INFO, JRRTOLKIEN.NET and JRRTOLKIEN.ORG. TOLKIEN.CO.UK is used by the Complainant's licensee, HarperCollins. WHOIS details for selected domain names and print-outs from WWW.TOLKIEN.CO.UK are included at Exhibit 5.
- (g) The Complainant's name is THE JRR TOLKIEN ESTATE LIMITED, and this has been registered at Companies House since 24 March 1997. Companies House since 24 March 1997. Companies House details are included at Exhibit 6.
- (h) By virtue of the matters set out in Paragraphs 1(a) and 1(d) to 1(g), the Complainant has unregistered, common law rights in both TOLKIEN and JRR TOLKIEN, and has for many years been exclusively entitled to the goodwill associated with those brands.
- (i) The Domain Name comprises the Complainant's trade mark JRR TOLKIEN plus the .oc.uk suffix. Accordingly, the Domain Name is identical to the Complainant's trade mark JRR TOLKIEN, and is similar to the Complainant's trade marks TOLKIEN, JRRT and RONALD TOLKIEN.

(2) Abusive Registration:

- (a) The Domain Name was registered by the Respondent on 23 July 2003 (see the WHO IS details and print-out from www.tolkienet.com at Exhibit 8, which says that "*jrrtolkien.co.uk currently points to our J.R.R. Tolkien information section, within Lothlorien, but future possibilities include a dedicated website, and expansion of Tolkienet's current information, an online tribute book to the man himself, a multi-language resource-locator, etc...*")
- (b) The Domain Name has not yet been used for any of these purposes, and continues to be used to link to the Tolkien tribute site at www.tolkienet.com. Print-outs showing the re-direction page under Domain Name and pages from the website at www.tolkienet.com are attached at Exhibit 9.
- (c) The www.tolkienet.com website is a tribute site dedicated to JRR Tolkien and his works, and includes the kinds of features typical of such tribute sites, including biographical and bibliographical information. Tolkien-related artwork, and hyperlinks to other Tolkien-themed websites.
- (d) The address details for the Registrant are omitted from the Nominet WHOIS database, and the registrant's name is given as

“Tolkienet.com”. Accordingly on 4 January 2006, the Complainant wrote to the administrative contact for TOLKIENET.COM requesting transfer of the Domain Name. The Complainant received no reply, and wrote against on 18 January 2006. Again, the Complainant received no reply. Copies of these letters and the WHO IS search for TOLKIENET.COM are at Exhibit 10.

- (e) The Complaint refers below to the Decision of the Nominet Appeal Panel in SCOOBYDOO.CO.UK (DRS 00389), a copy of which is at Exhibit 11. The Complainant is aware that one of the relevant provisions of the Policy, paragraph 4(b), has been amended since the SCOOBYDOO.CO.UK decision, in that there is no longer any provision shifting the burden of proof to the Respondent where an identical name is used for an unauthorised tribute site. However, the Complainant notes that in that decision the Panel observed that, notwithstanding the effects of the old paragraph 4(b), it would still have reached a decision in favour of the complainant in that case (see page 16). The Complainant submits that this case should be decided in the same way and on the same basis as the SCOOBYDOO.CO.UK case.
- (f) The Domain Name is an Abusive Registration in the hands of the Respondent because its acquisition by the Complainant and subsequent use, as detailed above, took unfair advantage of and was unfairly detrimental to the Complainant’s Rights. In particular, 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”* contrary to paragraph 3.a.11 of the DRS Policy, as detailed below.
 - (i) JRR TOLKIEN, has no meaning independent of the name of the author JRR Tolkien and his works. Because of the nature of the Respondent’s interests, the Respondent should be assumed at the date of registration of the Domain Name to have been aware that the JRR TOLKIEN brand belonged to the Complainant.
 - (ii) The Respondent does not have a licence to any identical or similar registered or unregistered trade mark and does not enjoy any other form of Right in relation to the Domain Name. In other words, the Respondent has no Rights in the Domain Name.
 - (iii) Use of the Domain Name by the Respondent to direct visitors to its website creates the impression to a significant number of visitors of the site that it is an official site associated with and/or operated and/or licensed by the Complainant. The Respondent has impersonated the Complainant by selecting the Domain Name. As the Panel in SCOOBYDOO.CO.UK

observed, “*impersonation can rarely be fair*” (page 16). This is a clear case of “*initial interest confusion*”.

- (iv) This effect of the use of the JRR TOLKIEN trade mark in the Domain Name is compounded by the use of other Tolkien-related trade marks on the website. Different sections of the website are titled using the registered trade marks LOTHLORIEN and RIVENDELL, which are held by The Saul Zaentz Company (see Exhibit 7). www.tolkienet.com includes a disclaimer of association in the following terms “*This site is in no way affiliated with ... the Tolkien Estate*”. This is however buried in the terms and conditions (see Exhibit 9) and would not come to the attention of most visitors to the website.
- (v) The Respondent, in consciously selecting the Domain Name, has unfairly benefited from the Domain Name’s association with the Complainant to the detriment of the Complainant. The facts echo SCOOBYDOO.CO.UK, where the view of the majority of the Appeal Panel was that “*In the context of a tribute site, the vice is in selecting a domain name, which is not one’s own name, but which to one’s knowledge is identical to the name of another, which has been selected precisely because it is the name of that other and for a purpose which is directly related to that other. For a tribute or criticism site, it is not necessary to select the precise name of the person to whom one wishes to pay tribute or criticise. In this case, the domain name could have been ‘ilovescoobydoo.co.uk’, for example.*” (page 16).
- (vi) The majority of the Panel in SCOOBYDOO.CO.UK was clear that the presence or absence of trading activities over the website did not in itself affect whether a domain name constitutes an Abusive Registration. Moreover: “*... the Panel is of the view that on the balance of probabilities there must have been an advantage to the Respondent of some kind. Whether or not that ‘advantage’ has led to financial gain is irrelevant. The question is as to whether the advantage he has taken has been fair.*” In this case, the advantage is not fair because, simply put, the Respondent is and plans to take unnecessary advantage of our client’s famous trade mark to further its own interests.
- (vii) The metatags to the www.tolkienet.com website also make unfair use of the Complainant’s trade marks as well as the associated trade marks owned by The Sael Zaentz Company (see Exhibit 7 and Exhibit 12).
- (viii) Although fair use *may* include sites operated solely in tribute, the particular use of this particular Domain Name does not constitute fair use for the reasons given above and in particular because the Domain Name is unnecessarily identical to the extremely distinctive JRR TOLKIEN trade mark in which the Complainant has Rights. In any event, it is

not clear that the Domain Name was registered with a view to use for a purpose which is to be “*solely in tribute*” to Professor Tolkien. The comments of “Manwe” in the print-out at Exhibit 8 suggest quite the contrary.

(ix) The Complainant does not claim that Respondent’s actions in this case are dishonest, but notes that, as the Panel in SCOOPYDOO.CO.UK stated, “*honest intentions are not enough*”.

(g) In light of the preceding submissions, the Complainant submits that use of the Domain Name by the Respondent has been abusive and in such a manner as to cause confusion within the meaning of paragraph 3.a.ii of the DRS Policy and take unfair advantage of and/or be unfairly detrimental to the Complainant's Rights pursuant to paragraph 1.ii of the DRS Policy.

Respondent

6.3 As stated above, the Respondent has not submitted any Response.

7. **Discussion and Findings:**

General

7.1 Under paragraph 2a of the Policy the Respondent is required to submit to proceedings if a Complainant asserts to Nominet in accordance with the DRS Procedure that

“i. *The Complainant has 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.*”

7.2 Under paragraph 2b of the Policy a Complainant is required to prove both these elements on the balance of probabilities.

7.3 Paragraph 1 of the Policy defines “*Rights*” as including but not being limited to, “*rights enforceable under English law*”. This definition is subject to a qualification which is not material.

Complainant’s Rights

7.4 The Complaint (which is signed and includes a statement of truth and to which there is no challenge) and the documentation provided with it, in my opinion demonstrates that the Complainant has been the proprietor of

7.4.1 registered UK and community trade marks for TOLKIEN from 10 August 2001.

7.4.2 registered community trade marks for JRR TOLKIEN since 2 April 2004.

7.5 I consider and find as a fact that that TOLKIEN is similar to, and JRR TOLKIEN (excluding the “co.uk”, suffix) is identical to, the Domain Name. Accordingly, I am satisfied that the conditions of paragraph 2a of the Policy are satisfied.

7.6 In the circumstances it is unnecessary to consider that alternative bases (including the pending or foreign trade mark registrations, registered domain names and common law rights) upon which the Claimant asserts that it has “Rights”.

Abusive Registration

7.7 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.”*

7.8 The Policy provides:

“3 Evidence of Abusive Registration

a A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is 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 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;
 - 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;
 - iv It is independently verified that the Respondent has given false contact details to us; or
 - v The domain name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
 - A has been using the domain name registration exclusively; and
 - B paid for the registration and/or renewal of the domain name registration.
- b Failure on the Respondent's part to use the Domain Name for the purposes of e-mail or a website is not in itself evidence that the Domain Name is an Abusive Registration.
- c There shall be a presumption of Abusive Registration if the Complainant proves that Respondent has been found to have made an Abusive Registration in three (3) or more Dispute Resolution Service cases in the two (2) years before the Complaint was filed. This presumption can be rebutted (see paragraph 4 (c)).

4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

- a A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:
 - i Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has
 - A used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;
 - B been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or
 - C made legitimate non-commercial or fair use of the Domain Name; or
 - ii The Domain Name is generic or descriptive and the Respondent is making fair use of it.
 - iii In relation to paragraph 3(a)(v); that the Registrant's holding of the Domain Name is consistent with an express term of a written agreement entered into by the Parties; or
 - iv In relation to paragraphs 3(a)(iii) and/or 3(c); that the Domain Name is not part of a wider pattern or series of registrations because the Domain Name is of a significantly

different type or character to the other domain names registered by the Respondent.

- b Fair use may include sites operated solely in tribute to or criticism of a person or business.*
- c If paragraph 3(c) applies to succeed the Respondent must rebut the presumption by proving in the Response that the registration of the Domain Name is not an Abusive Registration.*

7.9 The facts asserted in sub-paragraphs (a) to (d) and (f)(iv) of paragraph (2) of the Complaint are supported by the exhibits referred to and are not challenged. There is no reason to doubt the accuracy of those assertions, and accordingly I accept them as being factually correct.

7.10 It is apparent from paragraph 2(g) of the Complaint that the Complainant seeks to rely upon paragraph 3(a)(ii) of the Policy. The Complainant asserts that visitors to the Respondent's site (to which the Domain Name is linked) have been confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. No example has been provided. Nevertheless the Complaint is verified by a statement of truth and signed, and it is not challenged. Further, the assertion is inherently plausible. It is very likely that there have been many persons interested in Tolkien and/or his works who have found their way to the Respondent's site in the mistaken belief that it is connected with the proprietor of his estate and/or works i.e. an official or licensed site. Whilst there is a "disclaimer" it is buried in terms and conditions. It could not prevent "initial interest confusion". Therefore I am satisfied on the balance of probabilities, and find as a fact, that the Respondent has used and 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. Even in the absence of actual confusion, there is a likelihood of confusion, and that, in my judgment is capable of being sufficient to constitute an Abusive Registration - the list of factors set out in paragraph 3 of the Policy is expressly stated to be non-exhaustive.

7.11 The Complainant accepts that the Respondent's site is being operated as a tribute site but not that it is being operated "solely" as such a site. I am prepared to assume that the site is being operated "solely" as a tribute site. This is capable of constituting "fair use". Nevertheless in circumstances such as apply in the present case the operation of such a site may still take unfair advantage of and/or be unfairly detrimental to a person with Rights in a name which is identical or similar to the Domain Name. The decision of the Nominet Appeal Panel in SCOOBYDOO.CO.UK (DRS00384), ("SCOOBYDOO") cited in the Complaint, is an example of such a case, although it is important to note that the facts of that case were different to those in the present case and that the wording of the Policy has changed since it was decided.

7.12 In SCOOBYDOO the majority of the Appeal Panel commented that:-

"... in the context of a tribute site, the vice is in selecting a domain name, which is not one's own name, but which to one's knowledge is identical to the name of another, which one has selected precisely because it is the name of that other and for a purpose which is directly related to that other. For a tribute or criticism site, it is not necessary to select the precise name of the person to whom one wishes to pay tribute or criticise. In this case the domain name could have been 'ilovescoobydoo.co.uk', for example.

Taking the Domain Name in these circumstances arguably amounts to impersonation of the owner of the name or mark. Substantial numbers of people will have visited the Respondent's website (the Respondent admits to a total of over 37,000 visitors to his site) believing that they were visiting the site of the Complainant, a phenomenon sometimes referred to as 'initial interest confusion'. ... Notwithstanding the Respondent's denial of any advantage, the panel is of the view that on the balance of probabilities there must have been an advantage to the Respondent of some kind. Whether or not that 'advantage' had led to financial gain is irrelevant. The question is as to whether the advantage he has taken has been fair.

Even if there has been no advantage to the Respondent, the Domain Name can still represent an Abusive Registration if it has been used so as to have been unfairly detrimental to the Complainant's rights.

The Panel is unanimous in taking the view that, taking all that into account, such a use as the Respondent has made of the Domain Name cannot be fair. Impersonation can rarely be fair. Additionally, the existence of a network of 550+ email users (including the

Respondent) using the Domain Name as part of their email addresses exposes the Complainant to risk. In the hands of the Respondent and his network of 550+ email users the Complainant's name and mark is out of the Complainant's control. To that extent its goodwill is outside its control. An email user may bring the name into disrepute. The widespread unauthorised use of the Domain Name in this way may well dilute the distinctiveness of the Complainant's trade mark rights. In the Panel's view these are all matters, which the Panel is entitled to take into account when considering whether registration and/or use of the Domain Name has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights. The risk is at present risk and arises both from what the Respondent has done and will, to a greater or lesser extent, continue to do, if permitted to retain the Domain Name. ..."

7.13 To me there are difficulties in a finding that a Respondent has taken unfair advantage of a Complainant's Rights unless the advantage can be identified. Nevertheless I concur with the view that "impersonation can rarely be fair". Where, as here, the Rights are rights of ownership, impersonation, if unchecked, results in the person having Rights in the relevant name losing effective control over the use of the name - something to which, as proprietor, he is entitled. This is necessarily detrimental to those Rights and without some justification (and it is difficult to think what could amount to such justification and none appears from the evidence before me in the present case) in my opinion it is necessarily unfair. As was indicated in SCOOBYDOO, a tribute site can function perfectly satisfactorily without adopting a name which is identical or similar to the name to which tribute is being given or made.

7.14 Accordingly, in the terms of paragraph 1 of the Policy I am satisfied and find that the Domain Name:-

7.14.1 was registered in a manner which at the time when the registration took place was unfairly detrimental to the Complainant's Rights.

7.14.2 has been used in a manner which was unfairly detrimental to the Complainant's Rights.

8. **Decision**

8.1 For the reasons give above, I find that the Domain Name was registered in a manner which at the time when the registration took place, and has been used in a manner, which was unfairly detrimental to the Complainant's Rights and, in the hands of the Respondent, is an Abusive Registration.

8.2 The Complainant has requested the transfer of the Domain Name. On the basis of the material before me I consider that that is an appropriate remedy and accordingly that the Domain Name should now be transferred to the Complainant as it requests.

Signed.....

David Blunt QC

23 June 2006