

Nominet UK Dispute Resolution Service

DRS 00394 and 00395 (consolidated)

**DISNEY ENTERPRISES INC -V- ANDREW SOUTH t/a NAMED BY SOUTH**

Decision of Independent Expert

1. **Parties**

Complainant: Disney Enterprises Inc

Address: 500 South Buena Vista Street  
Burbank  
California 91521

Country: United States of America

Respondent: Andrew South (t/a namedbysouth)

Address: 56 Heol Yr Eos  
Penllergaer  
Swansea  
SA4 1BS

Country: GB

2. **Domain Names**

*disneyholiday.co.uk*  
*disneymovies.co.uk*  
*thedisneychannel.co.uk*  
*thedisneyshop.co.uk*  
*thedisneystore.co.uk*  
*ukdisney.co.uk*  
*waltdisneystudios.co.uk*

collectively referred to as “the Domain Names”.

3. **Procedural Background**

DRS00394 (“the First Complaint”) relates to the Respondent’s registration of *disneyholiday.co.uk*, *disneymovies.co.uk*, *thedisneychannel.co.uk*, *thedisneyshop.co.uk*, and *thedisneystore.co.uk*.

DRS00395 (“the Second Complaint”) relates to *ukdisney.co.uk* and *waltdisneystudios.co.uk*.

The First and Second Complaints were lodged with Nominet on 14th May 2002 together with a letter from the Complainant inviting Nominet to exercise its discretion to consolidate the two Complaints. Nominet validated the First Complaint on 14 May 2002 and the Second Complaint on 15 May 2002 and informed the Respondent that it had 15 days in which to file a Response. A Response to the First Complaint was received by e-mail on 10 June 2002. No Response to the Second Complaint was received but Nominet contacted the Respondent, who confirmed that his Response was intended to cover both Complaints.

Nominet agreed to consolidate these cases by e-mail dated 11 June 2002. The Complainant filed a consolidated Reply on 18 June 2002. Informal mediation followed. When that did not resolve the dispute, Nominet notified the parties that an Expert would be appointed if it received the appropriate fee from the Complainant. The fee was received from the Complainant on 11 July 2002.

On 16 July 2002, Antony Gold, the undersigned, (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an expert in this case.

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

None.

**5. The Facts**

The following are accepted as facts which, so far as can be judged, are not in issue between the parties:-

- 5.1 The Complainant (and/or its associated companies) has traded extensively under names which are, or incorporate, the word DISNEY. It has traded under the words WALT DISNEY and DISNEY for over 80 years.
- 5.2 These names (in which the Complainant asserts Rights) are used in conjunction with the Complainant’s business, which includes broadcasting; film and television programme production and distribution and associated merchandise and publications, Disney-theme holidays and the operating of retail outlets and online retailing through websites at *disneystore.com* and *disneystore.co.uk*.
- 5.3 The Complainant is the registered proprietor of a number of registered trade marks in the UK which either are, or include, the word DISNEY and which are registered in various classes. For the purposes of the Complaint, the Complainant is seeking to rely upon the following registered trade marks : DISNEY, DISNEY CHANNEL, DISNEY STUDIOS and WALT DISNEY (“the Trade Marks”). It appears from the Complainant’s evidence that it has registered word-only marks for DISNEY, DISNEY STUDIOS and WALT DISNEY (although it also has two stylised word marks for WALT DISNEY) and a word and device mark for DISNEY CHANNEL. It also has trading names THE DISNEY STORE (or DISNEY STORE) and WALT DISNEY STUDIOS (“the Trading Names”).
- 5.4 A Nominet *whois* search shows that the Respondent registered the Domain Names on various dates between 17 January 2000 and 20 February 2000. All of the Domain

Names are registered to “namedbysouth” with the exception of *ukdisney.co.uk* which is registered in the name of Andy South. The Complainant say that this is a trading name of the Respondent. This appears to be the case from the “business cards” (web pages incorporating the Respondent’s contact details and, in the case of *thedisneystore.co.uk*, an overt offer to sell the Domain Name) which, according to the Complainant, have appeared at the sites to which a number of the Domain Names resolve. The Respondent has not sought to suggest otherwise.

- 5.5 On 17 October 2000, the Complainant wrote to the Respondent requesting the transfer to it of *disneymovies.co.uk* and also requesting full details of the Respondent’s other registrations of domain names incorporating the word DISNEY to date. The Respondent replied by letter of 19 October 2000 claiming that his children were fans of Disney and wished to set up a site “*where other children could share their love of Disney*”. The Respondent said that “*A friend told me that they could not name the site anything Disney, so they bought the domain name “UltimateDomain.co.uk” (named after a game my son plays on the PC), and named the site “UK Disney fan site”. My children then bought several other Disney sounding names out of their pocket money to enable the site to be found by other Disney fans.*” The Respondent’s letter asserted that the Domain Names were not being used in an unfair or detrimental way, but were intended to help the Respondent’s “*children’s education and have some fun*”. It is noted that not all of the Domain Names referred to in the Respondent’s letter resolved to the purported fan site.
- 5.6 The Complainant also made an offer to purchase *waltdisneystudios.co.uk* through a third party domain name registration company on 24 September 2001. The Respondent says that he was offered £1,000, although the Complainant does not comment on this. The Respondent replied to the Complainant’s representative on 19 October 2001, stating that he had received a substantially higher offer for that Domain Name. The offer had been received by the Respondent from a “*city domain name syndicate who see no problem with ownership of this name. They are prepared to pay cash as soon as I sign the Nominet forms. My children are in favour of this deal, and as they own the name this could be the best option so we can invest the money for their future*”.
- 5.7 It is noted that the sites to which the Domain Names resolve no longer accord with the copy pages adduced by the Complainant to its Complaint. Four of the Domain Names (*disneymovies.co.uk*, *thedisneychannel.co.uk*, *thedisneyshop.co.uk* and *thedisneystore.co.uk* ) now resolve to a page giving information about a children’s charity and the remaining three (*disneyholiday.co.uk*, *ukdisney.co.uk* and *waltdisneystudios.co.uk* ) resolve to a blank page which, it appears, merely denotes the ISP’s details. The Complainant has adduced evidence of the appearance of the sites prior to this, and accordingly, the previous uses to which the Domain Names were put are considered for the purposes of this Complaint. These uses are as follows:-

5.7.1 *disneymovies.co.uk*, *thedisneychannel.co.uk*, *thedisneyshop.co.uk*,  
*thedisneystore.co.uk*

These Domain Names at one point resolved to a site at *thecartrader.co.uk* which purported to provide an online service for the buying and selling of cars. The domain name *thecartrader.co.uk* was registered by “namedbysouth” on 2 April 2000.

5.7.2 *disneyholiday.co.uk, ukdisney.co.uk, waltdisneystudios.co.uk*

These Domain Names all resolved to a site headed “UK Disney fan site”. This site was said to be under construction and provided a telephone number and a contact e-mail address of *info@ULTIMATEDOMAIN.co.uk*. The domain name *ultimatedomain.co.uk* was registered for “namedbysouth” on 21 December 1999. The site at *ultimatedomain.co.uk*, like the above Domain Names, resolved to the purported UK Disney fan site, but there is currently no site at that address.

5.7.3 *thedisneychannel.co.uk, ukdisney.co.uk and disneymovies.co.uk*

An offer to sell the above Domain Names was posted to a site which, according to the Complainant, is commonly used to buy and sell domain names. Offers for the above Domain Names were to be made to *sales@UKDomainAuction.com*. A *whois* search reveals that the domain name *ukdomainauction.com* was registered to the Respondent on 31 January 2000. The site is not currently active.

The Respondent claims that he has never sold a domain name through the *ukdomainauction.com* site. The Complainant has provided evidence suggesting that a number of other websites list *ukdomainauction.com* in their listings of sites which buy and sell domain names, although it has not provided any direct or conclusive evidence that any sales have been made.

5.7.4 *ukdisney.co.uk, thedisneystore.co.uk and thedisneychannel.co.uk*

The Complainant claims that the URL’s *ukdisney.co.uk, thedisneystore.co.uk* and *thedisneychannel.co.uk* included a web-created business card of the Respondent (although it does not explain how this was accessed from the sites to which these URL’s resolve) and further, that the only purpose of so doing is to sell the relevant Domain Names. The existence of these pages has not been disputed by the Respondent.

## 6. The Parties Contentions

### 6.1 The Complainant’s contentions can be summarised as follows:-

**it has Rights in respect of marks that are identical or similar to the Domain Names:-**

#### 6.1.1 *disneyholiday.co.uk/disneymovies.co.uk*

These Domain Names, it says, are both similar to the Complainant’s DISNEY trade mark. The Complainant claims that the addition of the words “holiday” and “movies” respectively aggravates the Respondent’s use of the mark since both of the additional words describe the Complainant’s core businesses.

6.1.2 *thedisneychannel.co.uk*

This Domain Name, the Complainant says, is identical (“the” having no significance) - or, alternatively, similar - to the Complainant’s registered trade mark DISNEY CHANNEL. Even if “the” can be regarded as significant, the Complainant says that it was only added by the Complainant because both *disneychannel.co.uk* and *disneychannel.com* had already been registered by the Complainant.

6.1.3 *thedisneyshop.co.uk/thedisneystore.co.uk*

Both of the above names are said to be similar to the Complainant’s DISNEY registered trade mark, and the word “the” is, again, said to be nugatory. The Complainant asserts that the above Domain Names are also identical and/or similar to its trading name THE DISNEY STORE (the word “shop”, it says, being an anglicised version of the word “store”).

6.1.4 *ukdisney.co.uk*

This Domain Name is said to be identical and/or similar to the Complainant’s registered trade mark DISNEY. The Respondent’s use of the mark is said to be aggravated by suffixing the mark with the word “*uk*” because this is said to target the name specifically at the Complainant’s customers/potential customers within the UK.

6.1.5 *waltdisneystudios.co.uk*

This Domain Name is said to be identical and/or similar to the Complainant’s registered trade marks DISNEY, DISNEY STUDIOS and WALT DISNEY, and to be identical to the Complainant’s trading name WALT DISNEY STUDIOS;

The Complainant contends that all of these names are extensively supported by advertising and promotion and that they are all extremely well-known to the general public in the UK.

**the Domain Names are Abusive Registrations because:**

**6.1.6 The Respondent has no rights to the Domain Names**

The Complainant says that the Respondent has no legitimate rights to use the DISNEY names, as evidenced by the fact that it owns no registered trade marks corresponding to the words which comprise the Domain Names, and does not have any connection with identical/similar marks. It contends that the Respondent was fully aware of the Complainant’s rights to the names and deliberately registered variants of them the name it wanted had already been taken. Alternatively, it has been fully aware of the Complainant’s

Rights since the correspondence between the parties referred to at paragraphs 5.5 and 5.6 above and has not used the Domain Names in connection with a genuine offering of goods and services;

**6.1.7 There has been a misrepresentation by Respondent that he is connected with the Domain Names**

The Complainant refers to the Court of Appeal decision in *British Telecommunications plc & Ors v One in a Million Limited & Ors [1998]4 All ER 476* and claims that the Respondent's actions constitute a misrepresentation to persons consulting the Nominet *whois* database that the Respondent is connected to or associated with the Domain Names;

**6.1.8 The Respondent has redirected certain Domain Names to his car dealing business**

Four of the Domain Names (*disneymovies.co.uk*, *thedisneychannel.co.uk*, *thedisneyshop.co.uk* and *thedisneystore.co.uk*) have been used by the Respondent to direct internet users to *thecartrader.co.uk* through which the Respondent sells second hand cars. The Complainant says that the Respondent has traded unlawfully on the Complainant's goodwill by directing users to his own commercial website, which constitutes using those Domain Names in a way which takes unfair advantage of and/or is unfairly detrimental to the Complainant's Rights;

**6.1.9 The Respondent has used the Domain Names for his ULTIMATE DOMAIN business**

The remaining three Domain Names (*disneyholiday.co.uk*, *ukdisney.co.uk* and *waltdisneystudios.co.uk*), which resolved to a UK Disney fan site have, it is said, been used by the Respondent to provide contact details for his domain name speculation business at *ultimatedomain.co.uk*. The Respondent has attempted to sell one of the Domain Names which resolved to this site (*ukdisney.co.uk*), (the reference to an attempt to sell the second of the above Domain Names which appears in the Complaint appears to be an error);

Further, the pages appearing at the sites which are accessed through the above three Domain names are framed copies of the Respondent's website at *ultimatedomain.co.uk* and, it is said, therefore are used primarily for the purpose of the Respondent's business of the sale and purchase of domain names. The Complainant submits that the Respondent is directing internet users to his own commercial enterprises in a way which takes unfair advantage of and/or is unfairly detrimental to the Complainant's rights (para 1(ii) of the Policy);

**6.1.10 There has been a pattern of abusive registrations by the Respondent**

The Respondent appears to be running a business under the name UltimateDomain and/or UKDomainAuction which, it is said, raises a

presumption that the Respondent is registering and selling domain names and engaged in a pattern of making Abusive Registrations (para 3(a)(iii) of the Policy).

#### 6.1.11 Offers for sale of the Domain Names

The Respondent offered three of the Domain Names (*thedisneychannel.co.uk*, *ukdisney.co.uk* and *disneymovies.co.uk*) for sale, giving a contact address at the Respondent's site at *UKDomainAuction.com*. The site is currently inactive, but the Complainant says that until recently it was used by the Respondent as a vehicle for selling domain names. The Complainant says that this site has changed on several occasions, and has provided evidence that the word DISNEY is used in its metatags; the site was also referred to on other websites providing details of sites through which domain names can be bought and sold;

The Complainant says that some of the Domain Names (*ukdisney.co.uk*, *thedisneystore.co.uk* and *thedisneychannel.co.uk*) incorporate a web-generated business card, the only purpose of which, it says, must be to sell the Domain Names. In respect of one of the Domain Names (*thedisneystore.co.uk*) the business card states that the Domain Name is for sale, and gives a contact address at *thedisneychannel.co.uk* which, the Complainant says, suggests that *thedisneychannel.co.uk* is also for sale;

The Complainant asserts that the Respondent registered the Domain Names primarily for the purposes of selling the Domain Names to the Complainant or one of its competitors (para 3a(i)A of the Policy) and/or primarily for the purpose of unfairly disrupting the Complainant's business (para 3a(i)C of the Policy).

#### 6.2 The Respondent's contentions can be summarised as follows:

- 6.2.1 the Domain Name (the Respondent does not make it clear which of the Domain Names he is referring to) was registered as a communications device; those of the Domain Names which are the subject of the First Complaint were registered because the Respondent found that they were available and were likely to become humorous and memorable e-mail addresses for the Respondent's family;
- 6.2.2 the site at *UKDomainAuction.com* was set up when the Respondent first began to familiarise himself with the Internet, in an effort to increase his chances of securing employment through his ability to use the Internet; the Respondent says that he has never sold any domain names through that site;
- 6.2.3 the domain name *UltimateDomain.com* was chosen by the Respondent's son because it is the name of a Play Station game which, the Respondent claims, was a good way of bringing young people to the fan site which had been set up by his children;

- 6.2.4 More domain names were needed to increase traffic to the fan site so the Respondent's children bought *ukdisney.co.uk* and *waltdisneystudios.co.uk* out of their pocket money;
- 6.2.5 The Complainant made an offer to purchase *waltdisneystudios.co.uk* for £1,000, which was refused;
- 6.2.6 The Respondent alleges that the Complainant is a wealthy trade mark owner who is bullying the Respondent, and that he and his children have neither the resources nor the technology available to the Complainant.

6.3 The Complainant's reply can be summarised as follows:-

- 6.3.1 In respect of points 6.2.2 above, three of the Domain Names offered for sale were given a contact address at *ukdomainauction.com*; the fact that the site was rated as a "very good" auction site by a domain name sources website suggests it is unlikely that no names had actually been sold;
- 6.3.2 In respect of point 6.2.4 above, *ukdisney.co.uk* was registered in the Respondent's own name and *waltdisneystudios.co.uk* was registered to namedbysouth;
- 6.3.3 In respect of point 6.2.5, the offer to purchase the Domain Name was made on the Complainant's behalf and the Complainant is not asserting that the Respondent approached it first; the correspondence referred to at paragraph 5.7 indicates that the Respondent told the Complainant's agent he had received a higher offer, it says, constitutes an attempt to pressurise the Complainant into paying more for the Domain Name. Accordingly, this Domain Name has been used in a manner which took unfair advantage of or was detrimental to the Complainant's Rights in the Domain Names.
- 6.3.4 In respect of point 6.2.6 above, the Complainant says that it is simply trying to protect its intellectual property rights and that the reference to its annual turnover was necessary to establish Rights in its trading names;
- 6.3.5 the Complainant says that the Respondent does not explain why four of the Domain Names (*disneymovies.co.uk*, *thedisneyshop.co.uk*, *thedisneychannel.co.uk* and *thedisneystore.co.uk*) resolved to his car trading site;

7. **Discussion and Findings**

In order to succeed, the Complainant must prove, on the balance of probabilities, in relation to each of the Domain Names, that:-

- 7.1 it has Rights in respect of a name or mark which is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy); and
- 7.2 the Domain Name in the hands of the Respondent, constitutes an Abusive Registration (paragraph 2(a)(ii)).

### Complainant's Rights

- 7.3 The Complainant has registered a number of trade marks throughout the world which consist of the word DISNEY, or incorporate that word. For the purposes of assessing the Complainant's Rights, the word marks are of greater materiality than the stylised word or word and device marks. The DISNEY brand is clearly very well known. The Complainant has also adduced evidence of its use of the names DISNEY STORE and WALT DISNEY STUDIOS. It is therefore accepted that the Complainant has Rights in respect of DISNEY, DISNEY CHANNEL, DISNEY STUDIOS and WALT DISNEY as well as DISNEY STORE and WALT DISNEY STUDIOS.

In considering whether the Domain Names are identical or similar to those names in which the Complainant has Rights, each Domain Name will be looked at in turn. The *.co.uk* suffix will not be considered, because it simply denotes the country code.

- 7.4 *disneyholiday.co.uk*

This is not identical to any of the names in which the Complainant has Rights. Is it similar? The use of the suffix HOLIDAY does not render the Domain Name dissimilar to the word DISNEY. HOLIDAY is a generic and descriptive word, particularly having regard to the Complainant's reputation and association with holidays. Therefore, it is accepted that this Domain Name is similar to a word in which the Complainant has Rights.

It is unnecessary to consider the Complainant's submission that the use of the word HOLIDAY aggravates the Respondent's use of this name.

- 7.5 *disneymovies.co.uk*

For the reasons set out above in respect of *disneyholiday.co.uk*, namely that the use of a generic suffix closely associated with the Complainant (in this case, MOVIES) does not render the Domain Name dissimilar, it is accepted that this Domain Name is similar to DISNEY. The assertion of aggravated use does not require consideration.

- 7.6 *thedisneychannel.co.uk*

The Complainant's submission that the word "the" is not of any material significance when considering the similarity between DISNEY CHANNEL and the Domain Name is accepted and it is found that the Domain Name is similar to the Complainant's trading name DISNEY CHANNEL. Speculation as to why the Respondent chose to use "the" as a prefix is irrelevant for the purposes of considering similarity.

- 7.7 *thedisneyshop.co.uk*

It is accepted that the words "the" and "shop" are essentially generic and do not detract from the emphasis on DISNEY, in which the Complainant has Rights; therefore the Domain Name is found to be similar to the word DISNEY.

7.8 *thedisneystore.co.uk*

It is accepted that this Domain Name is identical to the Complainant's trading name THE DISNEY STORE. Once again, speculation as to the Respondent's reasons for including the prefix "the" are irrelevant for these purposes.

7.9 *ukdisney.co.uk*

The Domain Name is not identical to the Complainant's trade mark DISNEY. However, the use of the "uk" prefix can be perceived as associating DISNEY with the United Kingdom. Accordingly, the use of this prefix does not render the Domain Name dissimilar to the Complainant's trade mark and it is accepted that the Domain Name and the mark are similar.

7.10 *waltdisneystudios.co.uk*

It is accepted that this Domain Name is identical to the Complainant's trading name WALT DISNEY STUDIOS.

7.11 Abusive Registration

The DRS rules define an Abusive Registration as a domain name which either:-

- 1(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 (paragraph 1(i) of the Policy); OR
- 1(ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights (paragraph 1(ii) of the Policy).

The Policy also contains a non-exhaustive list of factors that may be evidence that the Domain Names constitute an Abusive Registration. Among these are circumstances indicating that the Respondent registered or otherwise acquired the Domain Names either:-

- 3(a)(i)A primarily 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 Names;
- 3(a)(i)C primarily for the purpose of unfairly disrupting the business of the Complainant; or
- 3(a)(ii) circumstances indicating that the Respondent is using the Domain Names in a way which has confused people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with, the Complainant.
- 3(a)(iii) The Respondent is engaged in a pattern of making Abusive Registrations.

7.12 **Registration (paragraph 1(i))**

The Complainant says that the registration of the Domain Names is a misrepresentation to users of Nominet's *whois* database that the Respondent is connected with the Domain Names (within the meaning of paragraph 3(a)(ii) of the Policy (which is considered below)), and owns goodwill in the marks. The Complainant refers to the decision of the Court of Appeal in *British Telecommunications plc & Ors v. One in a Million Limited & Ors*.

It is not helpful to refer to case law in the context of a Complaint under the DRS because decisions made in the courts are determined on different bases than decisions under the DRS. However, the names in which the Complainant asserts Rights are so internationally well-known that it is difficult to envisage circumstances in which a person unconnected with the Complainant registering the Domain Names could regard itself as having a legitimate right to register the names. One of these circumstances might be, for example, registration for the purposes of setting up a fan site or as a personal/non-commercial communications device. Three of the Domain Names (*disneyholiday.co.uk*, *ukdisney.co.uk* and *waltdisneystudios.co.uk*) have resolved to what may have appeared to be a fan site (which the Complainant says is a sham), but no longer do so.

The Response is unclear and unhelpful. The Respondent has asserted that *ultimatedomain.co.uk* was registered as a means of attracting young people to the proposed Disney fan site. He has also claimed that *waltdisneystudios.co.uk* and *ukdisney.co.uk* were then registered in order to increase traffic to the fan site. This implies that the original site was at *disneyholiday.co.uk* (since it is the only other Domain Name that resolved to the Disney fan site). He says that his motivation for registering the Domain Names which are the subject of the First Complaint was "*because they were available and would become humorous e-mail address [sic] for my family, I have many*". He has also asserted that his children bought some of the names out of their pocket money.

If the Respondent's assertions were true, the reason for registration, whilst it might be to the Complainant's detriment, would not necessarily be unfair nor the registration, of necessity, abusive. The Respondent's claims are implausible, particularly when considered in the context of the uses then made of the domain names. However, for reasons which become apparent below, it is not necessary to make a formal finding about the cases of either party about the Respondent's motives for registration of the domain names, save to say that there is insufficient evidence to find that the primary motive for registration was enable the Respondent to sell the names to the Complainant or one of its competitors or that the purpose of unfairly disrupting the Complainant's business. The Complainant's evidence on the issue of the subsequent attempts to sell some of the Domain Names relates to the use to which the names were later put; this evidence does not directly assist in determining the motive for registration.

In relation to paragraph 3(a)(i)C of the Policy, the Complainant also invites the conclusion that the Respondent's continued warehousing of the Domain Names after it was made aware of the Complainant's Rights would fall within paragraph 3(a)(i)C

of the Policy. Again, warehousing is material to the Respondent's use of the Domain Names; paragraph 3(a)(i)C relates to the Respondent's motives in registering the Domain Names.

Use (paragraph 1(ii))

In order to consider the significance of the various uses to which the Domain Names have been put, for ease of reference, each of the uses to which the Domain Names (or a group thereof) was put will be taken in turn:-

**Redirection to thecartrader.co.uk** (*thedisneychannel.co.uk, disneymovies.co.uk, the disneyshop.co.uk and thedisneystore.co.uk*)

The Complainant says that the Respondent is unlawfully trading on the Complainant's goodwill by using the Complainant's names in order to direct internet traffic to his own commercial website, and as such, takes unfair advantage of and/or is unfairly detrimental to the Complainant's Rights within the meaning of paragraph 1(ii) of the Policy.

Whilst there may be no connection between the goods and services sold by the Complainant, and the Respondent's business, it is reasonable to assume that the Respondent has concluded that, by using the Domain Names in this way he will increase traffic to his online business, even if those searching the internet for DISNEY are unaware that they will be directed to the Respondent's site. The use of these Domain Names in this manner by the Respondent takes unfair advantage of the Complainant's rights.

Furthermore, by using the Domain Names to re-direct internet users to his own site, the Respondent is also using the above Domain Names in a manner which is unfairly detrimental to the Complainant's Rights within the meaning of paragraph 1(ii) of the Policy.

**Use of Domain Names for the Respondent's UltimateDomain business** (*disneyholiday.co.uk, ukdisney.co.uk and waltdisneystudios.co.uk*)

These Domain Names resolved to the "UK Disney fan site" which, the Respondent says, was to be set up by his children. The Respondent also said, in earlier correspondence between the parties referred to at paragraph 5.5 that *disneymovies.co.uk* resolved to the fan site. According to the Complainant's evidence, this Domain Name resolved to the site at *cartrader.co.uk* when the Complaint was submitted and not to the Respondent's purported fan site. It is not known whether *disneymovies.co.uk* has ever resolved to the fan site.

The only use of the Domain Names that the Respondent has attempted to justify is the single-page Disney fan site, which presupposes that all of the Domain Names resolved to that site. They do not, but nowhere in the Response (or even in the extraneous correspondence) does the Respondent explain why some of the Domain Names resolved elsewhere. The Respondent's omission to deal with the Complainant's assertions in full mean that it is impossible not to draw adverse inferences in relation to the "fan site". The reasons why the Respondent says some of the Domain Names resolved to *UltimateDomain.co.uk* are extremely far-fetched.

It is surprising for the Respondent to suggest that internet users searching for Disney information would be more likely to find it if the sites were framed copies of a website named after a Play Station game which has no connection with Disney. It is more likely that the site has had an underlying commercial purpose and the comments concerning redirection made in connection with the Respondent's site at [thecartrader.co.uk](http://thecartrader.co.uk) are of equal application in connection with this site. The conclusion that the fan site is not genuine is reinforced by the references on that page to UltimateDomain, such as "©2000 UltimateDomain" and the contact addresses of [info@ultimatedomain](mailto:info@ultimatedomain) and [webmaster@ultimatedomain](mailto:webmaster@ultimatedomain), and also the fact that site does not appear to have changed for a substantial period.

Accordingly, it is accepted that the Domain Names [disneyholiday.co.uk](http://disneyholiday.co.uk), [ukdisney.co.uk](http://ukdisney.co.uk) and [waltdisneystudios.co.uk](http://waltdisneystudios.co.uk) are being used in a manner which takes unfair advantage of, and is unfairly detrimental to the Complainant's Rights within the meaning of paragraph 1(ii) of the Policy.

### **Pattern of Abusive Registrations**

The Complainant says that because six of the Domain Names are registered to "namedbysouth" (only [ukdisney.co.uk](http://ukdisney.co.uk) being registered to Andy South) and because he also appears to be running a business under the name UltimateDomain and/or UKDomainAuction, this raises a presumption that the Respondent is in the business of registering and selling domain names and engaged in a pattern of making Abusive Registrations (paragraph 3(a)(iii) of the Policy).

However, the Respondent may be legitimately in the business of buying and selling domain names without necessarily being engaged in a pattern of making Abusive Registrations. It cannot be inferred that the Respondent is engaged in a pattern of making Abusive Registration simply because he is apparently using the trading name "namedbysouth" when providing contact details. Evidence about whether domain names were actually sold through [ukdomainauction.com](http://ukdomainauction.com) and/or [ultimatedomain.co.uk](http://ultimatedomain.co.uk) is irrelevant as, at best, it only goes to whether or not the Respondent's business was successful.

For a pattern of making Abusive Registrations to be established, it would be desirable to be able to show instances of Abusive Registrations additional to those which are the specific subject of the Complaint. The Complainant's evidence is insufficient to find that the Respondent has engaged in such a pattern.

### **Offers for sale of the Domain Names**

It is not considered that the "business cards" referred to at 6.11 above necessarily indicate that the relevant Domain Names are for sale. With the exception of [thedisneystore.co.uk](http://thedisneystore.co.uk), they simply provide the Respondent's contact details and a visitor to that site would not necessarily infer that the URL was for sale.

The Complainant refers to paragraphs 3(a)(i)a and 3(a)(i)C of the Policy in relation to these offers for sale, which concern the Respondent's motives for registration of the Domain Names. The Respondent, subsequent to registering the Domain Names, has offered at least four of them for sale whilst maintaining that the Domain Names were taken for personal, non-commercial use. In relation to [waltdisneystudios.co.uk](http://waltdisneystudios.co.uk)

the Respondent has apparently tried to ensure that the Complainant increases its offer for the Domain Name by referring to a competing offer, but the fact that he has not transferred the Domain Names indicates that the existence of the other offer is questionable. It is considered that, for these reasons alone, it is appropriate to find that the Domain Names *thedisneystore.co.uk*, *thedisneychannel.co.uk*, *ukdisney.co.uk*, *disneymovies.co.uk* and *waltdisneystudios.co.uk* have been used in a manner which is unfairly detrimental to the Complainant's Rights within the meaning of paragraph 1(ii) of the Policy.

#### 7.13 **Has the Respondent demonstrated that the Domain Names are not Abusive Registrations?**

The Policy also contains a non-exhaustive list of factors which may be evidence that the Domain Names are not Abusive Registrations. Although the Respondent does not refer to the Policy at all, it is inferred from the Response that the following grounds are relevant, namely that, before being informed of the Complainant's dispute, the Respondent has:-

used or made demonstrable preparations to use the Domain Names in connection with a genuine offering of goods or services (paragraph 4(a)(i)A)

made legitimate non-commercial or fair use of the Domain Names (paragraph 4(a)(i)C.)

Paragraph 4(a)(i)B is not considered to be relevant. The Respondent, so far as can be judged, has never been commonly known by any of the names or legitimately connected with an identical or similar mark, and has not sought to establish this in the Response nor are there any grounds for inferring such a connection.

In relation to use in connection with a genuine offering of goods or services, the Respondent is not considered to have made out its case. He has used certain Domain Names (*thedisneychannel.co.uk*, *disneymovies.co.uk*, *the disneyshop.co.uk* and *thedisneystore.co.uk*) in connection with an apparent car trading business, but the lack of any legitimate connection between the Domain Names and this site means that this is not the type of use which could fall within paragraph 4(a)(i)A. Similarly, use in connection with a business which apparently sells domain names would not fulfil the criteria under this paragraph either.

In the Response, the Respondent refers to the Disney fan site to be set up by his children. This might constitute fair or non-commercial use within the meaning of paragraph 4(a)(i)C of the Policy, were it not for the fact that, even if the site were genuine, not all of the Domain Names appear to have resolved to that site. The Respondent's subsequent conduct in offering at least four of the Domain Names for sale and the use of the Domain Names in connection with unrelated businesses, including, it appears, the sale of domain names means that the made by the Respondent of all of the Domain Names cannot be regarded as legitimate non-commercial or fair use within the meaning of paragraph 4(a)(i)C.

## 8. **Decision**

For the reasons outlined above, I find that that Complainant has Rights in respect of marks which are identical and/or similar to the Domain Names, and that all of the Domain Names, in the hands of the Respondent, are Abusive Registrations.

In light of those findings, I direct that the Domain Names be transferred to the Complainant.

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Antony Gold

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Date