

Harman International Industries Inc –v- Patrick Joleys

Nominet UK Dispute Resolution Service

Harman International Industries Inc –v- Patrick Joleys

Decision of Independent Expert

1. Parties

Complainant: Harman International industries Inc

Address: 8500 Balboa Boulevard, Northridge, California

Postcode: 91329

Country: USA

Respondent: Patrick Joleys

Address: 54 Highland Brow, Galgate, Lancaster, Lancashire

Postcode: LA1 0NB

Country: England

2. Domain Name:

Harmankardon.co.uk (“the Domain Name”)

3. Procedural Background:

The Complaint was lodged with Nominet on 11 January 2002. Nominet validated the Complaint and notified the Respondent of the Complaint in a letter dated 15 January 2002 and informed the Respondent that the Complaint was deemed to have been received by him on 16 January 2002, and that he had 15 working days within which to lodge a Response. The Response therefore had to be lodged by 6 February 2002. The Respondent failed to respond. Mediation not being possible in those circumstances, Nominet so informed the Complainant and in a letter dated 13 February 2002 the Complainant sent to Nominet the appropriate fee for a Decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On 21 February 2002, Nick Rose, the undersigned, (“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 matter that ought to be drawn 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):

Paragraph 15b of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”) provides, inter alia, that “if, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in this Policy or the Procedure, the Expert will proceed to a Decision on the Complaint”.

There is no evidence before the Expert to indicate the presence of exceptional circumstances; accordingly, the Expert will now proceed to a Decision on the complaint and notwithstanding the absence of a Response.

Further, Paragraph 15c of the Procedure provides that “*if, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure... the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate*”.

The Expert must therefore consider what inferences it would be appropriate to draw from the absence of a Response in this case.

There may be various reasons why the Respondent has failed to respond. However, the Expert is influenced by the fact that the Respondent has given Nominet false contact details, that is Ann Nonymous. Having given false contact details, an inference can be drawn that the Respondent has chosen not to contest the Complaint as the Respondent intended to conceal his true identity when registering the domain name. This is a matter that the Expert will return to when considering the merits of the Complaint below.

As for the facts set out in the Complaint, it seems to the Expert that the probable facts speak for themselves and that the facts asserted by the Complainant and set out in the next following section are indeed facts.

5. The Facts

The Complainant is a company incorporated in the United States of America. No details are given in the Complaint as to the nature of the Complainant’s business. Annex A to the Complaint is a copy of a trade mark registration for Harman-Kardon in the name of Harman-Kardon Incorporated, a company understood to be a wholly

owned subsidiary of the Complainant in Class 9, dated 15 July 1970, which is for “electrical and electronic apparatus and instruments, all included in Class 9, sound recording and sound reproducing apparatus and instruments, sound amplifiers, radio and television apparatus and instruments, public address systems, loud speakers; and parts and fittings included in Class 9 for all the aforesaid goods”. It appears therefore that the Complainant deals in electrical products of the type described in the trade mark registration.

The mark HARMAN-KARDON is the subject of UK trade mark registration number 937754 in the name of Harman-Kardon Inc, which is a wholly owned subsidiary of the Complainant. The mark “HARMAN KARDON” is also the subject of a community trade mark registration number 001546415 in the name of the Complainant.

On 10 November 1999 the Respondent registered the Domain Name although the name of the Registrant, which appears in the WHOIS database search is Ann Nonymous.

On 18 September 2001 the Complainant’s agents, Boulton Wade Tenant, wrote to the Respondent, drawing his attention to its rights in the trade mark HARMAN KARDON, and drawing attention to the registration of the Domain Name harmankardon.co.uk and invited comments by the Respondent by 3 October 2001. The Respondent did not reply.

6. The Parties contentions:

Complainant:

The substance of the Complaint is short and the main points are as follows:

1. The Complainant has a community trade mark registration for the trade mark “HARMAN KARDON” and its wholly owned subsidiary Harman Kardon Inc has a UK trade mark registration for HARMON-KARDON. The registered trade marks are virtually identical to the harmankardon.co.uk domain name. Photocopies of the UK registration and renewal certificates, and official confirmations of the relevant assignment and change of name documents are all attached as Annex A. A photocopy of the registration certificate for the community trade mark is attached as Annex B. The Complainant also has numerous trade mark applications and registrations for HARMAN KARDON or minor variants in many jurisdictions worldwide and attached as Annex C to the Complaint is a list of these applications and registrations, extracted from the Complainant’s internal records. The Complainant’s trade mark rights therefore pre-date the registration of the Domain Name by the Respondent.

2. It is submitted that the Domain Name should be considered an abusive registration in the hands of the Respondent because the names “Harman” and “Kardon” are both unusual, and the combination of the two is unique and function solely as an identifier of the Complainant or its subsidiary, Harman Kardon Inc. The Complaint attaches at Annex D the first two pages of results from a Google search engine, limited to pages from the UK, for the terms “Harmankardon” and “Harman Kardon”. It is submitted, as can be seen from the Google search, that these terms serve only to identify the product sold under the Complainant’s and its subsidiaries HARMAN KARDON trade mark. It is submitted that there is no UK registered company trading as either “Harman Kardon” or any similar name and certainly there is no evidence of any such UK registered company. Attached at Annex E to the Complaint is a printout from the United Kingdom Companies House database showing the absence of any such company registration.
3. Apart from the Complainant or its subsidiaries, there are no other trade mark applications or registrations for the mark HARMAN KARDON, either on the United Kingdom or the Community Trade Mark Registers for any goods or services.
4. Only the Complainant and its subsidiary Harman Kardon Inc have enforceable rights in the United Kingdom in the mark HARMAN KARDON. It is submitted that the Respondent has no connection whatsoever with the Complainant or its subsidiary and therefore the Respondent can have had no legitimate reason for registering the Domain Name harmankardon.co.uk.
5. It is submitted that the Domain Name is a blocking registration according to paragraph 3aiB of the Policy.
6. It is also submitted that the Domain Name unfairly disrupts the business of the Complainant under paragraph 3aiC of the Policy.
7. It is submitted that all these circumstances indicate that harmankardon.co.uk is, in the hands of the Respondent, an Abusive Registration.
8. Finally, it is submitted that because the Respondent has given Nominet false contact details, then, according to paragraph 3a(iv) of the Policy this is a circumstance indicating an abusive registration. WHOIS data indicates that the Registrant’s name is “Ann Nonymous”. It is submitted that, on the balance of probabilities, this is not a true indication of the identity of the Registrant. This is confirmed by the fact that Nominet have now released contact details for the Registrant’s administrative contact as shown in Annex F, which reveals

the Respondent's name as Patrick Joleys and his details are attached to the Complaint as Annex F.

9. On 18 September 2001 the Complainant's agents wrote to the Respondent at the address provided by Nominet by special delivery mail (i.e. registered post) to draw his attention to the Complainant's registered trade mark rights. A copy of that letter is attached to the Complaint as Annex G. The letter was returned to the sender on 15 October 2001 by the Royal Mail as undeliverable and a copy of the returned envelope is attached as Annex H. The Complaint then repeats the fact that the Respondent has given Nominet false contact details, although it is not clear whether this last reference is to the address provided by the Respondent to Nominet and the fact that the envelope was returned and marked, it appears, "no such address", or whether this is another reference to the false name given, i.e. Ann Nonymous.

Respondent

The Respondent has not responded.

7. 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 first limb of that task is straightforward in this case. The complainant is the proprietor of registered trade mark rights in the mark HARMAN KARDON and its wholly owned subsidiary, Harman Kardon Inc owns UK trade mark rights in the mark HARMAN-KARDON. The Domain Name comprises the name or mark harman kardon and the suffix .co.uk. The Expert has determined that the suffix, .co.uk is of no relevance and can be ignored. The Expert therefore finds that the Complainant has 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 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 3 of the Policy. There is no suggestion that the Domain Name is in use in any ordinary sense (i.e. connected to an internet facility for email or website purposes) nor that the Respondent has engaged in a pattern of making Abusive Registrations.

The potentially relevant “factors” in this case, from those set out in paragraph 3 of the Policy are as follows:

- (i) Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:
 - 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 Name;
 - B as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C primarily for the purpose of unfairly disrupting the business of the Complainant.
- (iv) It is independently verified that the Respondent has given false contact details to us.

The factors referred to in (i) involve identifying the Respondent’s purpose in making the registration. The factor referred to in (iv) above does not involve identifying the Respondent’s purpose.

The Expert will now consider each of these factors in turn.

The Complainant does not assert that the Respondent has registered or otherwise acquired the Domain Name for the purpose set out in paragraph 3(a)(i)A. The Expert will not therefore consider this factor further.

The Complainant does assert the Domain Name is a blocking registration according to paragraph 3(a)(i)B. However, the Expert finds that, simply because the Domain Name is in fact preventing the Complainant from registering this Domain Name does not mean that the Respondent has registered the Domain name to achieve that purpose.

The Complainant then asserts that the Domain Name has been registered for the purpose of unfairly disrupting the business of the Complainant under paragraph 3(a)(i)C of the Policy. Although the registration of this Domain Name may well be unfair to the Complainants, there is no evidence to suggest that this is the primary purpose of the Registrant when registering this Domain Name.

The Complainant then asserts the Domain Name should also be considered an Abusive Registration due to the fact that the Respondent has given Nominet false contact details and the Complainant asserts that according to paragraph 3(iv) of the Policy this is a circumstance indicating Abusive Registration. However, that is not what 3(a)(iv) states. This paragraph states that “it is independently verified that the Respondent has given false contact details to us (i.e. Nominet).” In this case, there has been no independent verification that the Respondent has given false contact details. In the absence of such independent verification the Expert cannot conclude that there is sufficient evidence to satisfy the factor described in paragraph 3(a)(iv).

However, the list of factors set out in paragraph 3 of the Policy is a non-exhaustive list. The Expert can therefore consider whether there is anything else about the conduct of the Respondent, or the facts of this case, which can justify the Expert coming to the conclusion that in the hands of the Respondent the Domain Name is an Abusive Registration. The Expert finds that whether or not the Respondent has given false contact details does not, in this case, require independent verification. It is obvious that the pseudonym “Ann Nonymous” is a false contact detail. It is also obvious that the true identity of the Registrant is indeed the details given to Nominet for the administrative contact, that is Patrick Joleys, the Respondent to this Complaint.

To succeed, the Complainant must satisfy the Expert that the Domain Name is an Abusive Registration. The Expert concludes that the Respondent has given Nominet false contact details, being the name of the Registrant. The Respondent, in attempting to conceal his identity, has attempted to prevent the Complainant from challenging the registration and/or attempting to obtain a transfer of the registration. In seeking to prevent any legitimate challenge to the registration, the Expert concludes the registration was unfairly detrimental to the Complainant’s trade mark rights and is therefore an Abusive Registration.

The Expert should also add that, although there is no evidence to suggest the Respondent's purpose in registering the Domain Name, was one of the three purposes set out in paragraph 3(a)(i) of the Policy, the Expert concludes that there is no obvious reason why the Respondent could possibly be justified in registering the Domain Name for any legitimate purpose. The Domain Name comprises a distinctive made up name. It is identical to the Complainant's trade mark. There is no other UK company using the inventive word which comprises the Complainant's trade mark. In the hands of the Respondent the Domain Name constitutes a threat hanging over the head of the Complainant and there are many obvious and potentially damaging uses to which the Domain Name could be put.

The Complainant therefore has made out a prima facie case that the Domain Name is an Abusive Registration, the Respondent has a case to answer and the Respondent has given no answer. Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy on the basis that it was registered in a manner which, at the time when the registration took place, was unfairly detrimental to the Complainant's rights.

8. Decision

In the light of the foregoing findings, namely that the Complainant has rights in respect of the 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, harmankardon.co.uk be transferred to the Complainant.

Nick Rose

8 March 2002