

Nominet UK Dispute Resolution Service

DRS 0426

Harrods Limited -v- Mr George Wilson Decision of Independent Expert

Parties:

Complainant's Details

Complainant: Harrods Limited
Address: 87-135 Brompton Road
Knightsbridge
London
Postcode: SW1X 7XL
Country: GB

Respondent's Details

Respondent: Mr George Wilson
Address: c/o Anthony Hunt
36 Preston Street
Brighton
East Sussex
Postcode: BN1 2HP
Country: GB

Domain Names:

harrodsonline.co.uk; harrods-online.co.uk; harrodsdirect.co.uk; and harrods-direct.co.uk ("the Domain Names")

1. Procedural Background:

The complaint was lodged with Nominet on 30 May 2002. Nominet validated the complaint and notified the Respondent of the complaint by letter and by email addressed to 'postmaster' at each of the disputed domain names and to a separate contact email address for the Respondent on 7 June 2002, informing the Respondent that he had 15 working days (i.e. until 1 July 2002) within which to lodge a Response. No response was received from the Respondent by 3 July 2002. On this date Nominet wrote again to the Respondent by letter and email indicating that the dispute would be referred to an independent expert if the Complainant paid the appropriate fees. Nominet also informed the Complainant accordingly and invited it to pay the fee to obtain an Expert Decision pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy"). The fee was duly paid on 5 July 2002.

On 15 July 2002, Andrew Lothian, 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 matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality. Nominet duly appointed the Expert with effect from 15 July 2002.

2. Outstanding Formal/Procedural Issues (if any):

In terms of paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service ("the Procedure") the Respondent is required to submit a response to Nominet. In this case no such response has been received. The Expert has seen copies of the communications from Nominet to the Respondent and is satisfied that Nominet has complied with the notification provisions of paragraph 2 of the Procedure.

In terms of paragraph 15b of the Procedure the Expert will proceed to a Decision on the complaint if, in the absence of exceptional circumstances, a party does not comply with any time period laid down in the Procedure or the Dispute Resolution Service Policy ("the Policy").

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 notwithstanding the absence of a Response.

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."

In the absence of a Response the Expert must consider whether to draw any inferences from the Respondent's non-compliance with paragraph 5a of the Procedure. The Expert simply notes that the Respondent has failed to make any contribution to the DRS procedure or to address the Complainant's submissions. In the absence of any reply, the Expert will make certain inferences concerning the purpose of registration of the Domain Names as noted in the body of the decision. However, the fact that there is no Response does not affect the primary requirement upon the Complainant who must nevertheless prove the existence of its Rights and of an Abusive Registration on balance of probabilities.

3. The Facts:

1. The Complainant and its predecessors have operated the Harrods Department Store in the Knightsbridge area of London, United Kingdom since about 1849. This principal store provides over one million goods and 50 separate services, typically serving around 35,000 customers every business day. It is a 'mandatory' stop for tourists visiting England.
2. The Complainant and its predecessors have built up goodwill and reputation in the name HARRODS over the period of the principal store's operation and have promoted it internationally for many years. The Complainant makes extensive overseas exports and operates a worldwide international mail order business. The Complainant also operates satellite stores at certain international airports

and its Harrods products can also be found at a Hong Kong department store and within a chain of stores across Japan.

3. The Complainant has actively operated the Internet web site www.harrods.com since 14 February 1999. An online ordering service is offered on the site, access to which was previously provided at the website address www.harrodsonline.com.
4. The Complainant is the owner of a worldwide trade mark portfolio including UK, European Community and US trade marks in respect of the mark HARRODS for various goods and services. One example is the figurative Community Mark for the well-known Harrods logo, being a stylised form of the word 'Harrods', covering use classes 1 to 42 (no. 62414 filed on 1 April 1996 and registered on 23 October 1998). The portfolio also includes a Community mark in respect of HARRODS DIRECT (no. 1281047 filed on 17 August 1999 and registered on 3 April 2002) and one in respect of HARRODS ONLINE (no. 1281153 filed on 17 August 1999 and registered on 6 June 2002). There is also a US mark in respect of HARRODS ONLINE (filed on 15 July 1999 and registered on 17 April 2001).
5. *The World's Greatest Brands*, an Interbrand publication, ranks Harrods at 41st place in its list of the world's top 100 brands.
6. The Complainant has been successful in a number of administrative proceedings under the Internet Corporation for Assigned Names and Numbers' Uniform Domain Name Dispute Resolution Policy (UDRP) in respect of complaints relating to various domain names incorporating the mark HARRODS such as harrodsdepartmentstores.com, harrodsstores.com, harrodswatch.com, harrodsjewelry.com, harrodscloset.com, harrodsgarments.com, harrodsactual.com, harrodshomeshopping.com and harrods.tv.
7. The Domain Names were registered by or on behalf of the Respondent on 22 July 1999.

4. The Parties' Contentions:

Complainant:

The Complainant's submissions are as follows:

1. The Complainant has rights in respect of a name or mark which is identical or similar to the Domain Names. As a result of the quality of the Complainant's goods and services, the tremendous volume of its customers, and the extensive advertisement and promotion of the HARRODS mark, the HARRODS mark is famous, has acquired substantial goodwill belonging exclusively to the Complainant and has come to be and is recognised as an indicia of origin exclusively identified with the Complainant.
2. The Domain Names are identical and/or similar to trade marks in which the Complainant has rights (Paragraph 2(a)(i) of the Policy). The domain names harrodsonline.co.uk and harrods-online.co.uk are identical to the Complainant's HARRODS ONLINE trade marks and the domain names harrodsdirect.co.uk and harrods-direct.co.uk are identical to the Complainant's HARRODS DIRECT trade mark. In addition, all of the Domain Names are similar to the Complainant's HARRODS trade mark.

3. The only differences between the Domain Names and the Complainant's HARRODS trade mark are the addition of the words "online" and "direct" respectively. Given the fact that the HARRODS mark instantly evokes the famous Knightsbridge department store, adding "online" and "direct" merely suggests that Internet users accessing the web sites at www.harrodsonline.co.uk, www.harrods-online.co.uk, www.harrodsdirect.co.uk and www.harrods-direct.co.uk are able to purchase Harrods products either via the Internet, the telephone or through some other medium, such as a catalogue. Thus the commercial impression conveyed to Internet users is that the Respondent's goods or services are sponsored, endorsed or affiliated with the Complainant.
4. Since it is accepted by Nominet Experts in other cases under the DRS that the addition of generic or descriptive terms or words designating the goods or services with which the mark is used does not render domain names generic or descriptive, the Domain Names are also confusingly similar to the Complainant's HARRODS mark.
5. The Complainant submits that the Respondent registered the Domain Names as blocking registrations against the Complainant's names and trade marks. (Paragraph 3(a)(i)(B) of the Policy). By registering the Domain Names the Respondent has prevented the legitimate owner of rights in the names HARRODS ONLINE and HARRODS DIRECT from registering and using the associated Domain Names (the Respondent not having a prima-facie right in the Domain Names or a valid reason for their registration). There is no legitimate purpose for which use of the Domain Names could be made. Abusive Registration can be constituted where a respondent cannot use a domain name without violating the complainant's rights under the applicable law. This is submitted to be the case here, where the Complainant's mark is distinctive and it is unlikely that the Respondent would have selected the Domain Names without knowing of this reputation.
6. The Domain Names suggest a false representation of origin or sponsorship for any associated goods or services and were undoubtedly chosen by the Respondent in an effort to free-ride off the goodwill associated with the Complainant's trade marks (particularly the HARRODS mark), in which the Complainant enjoys exclusive rights.
7. While there is no direct evidence of the Respondent's purpose of registration the Complainant submits that the following reasonable inferences can be drawn: (1) the domain names are so closely connected to the Complainant that it is difficult to conceive of a genuine purpose that anyone not connected with the Complainant could have for registering them; (2) the Respondent is not connected with the Complainant and the Complainant has not consented to the registration of the domain names; (3) the Respondent undeniably had the Complainant in mind at the time of their registration; (4) the Respondent has not used the domain names (the Complainant is aware this cannot of itself constitute an Abusive Registration); and (5) the Respondent has registered more than one domain name.
8. The Complainant does not believe that the Respondent can demonstrate any circumstances that would evidence that the registration of the domain names were not Abusive Registrations for the purpose of Paragraph 4 of the Policy.

Respondent:

The Respondent has not responded.

5. Discussion and Findings:**General**

In terms of paragraph 2b of the Policy the primary onus is on the Complainant to prove to the Expert on balance of probabilities each of the two elements set out in paragraph 2a of the Policy, namely 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.

Complainant's Rights

Does the Complainant have Rights in respect of a name or mark which is identical or similar to the Domain Names? The Policy defines Rights as including but not limited to, rights enforceable under English law (excluding names that are wholly descriptive of the Complainant's business). It is clear from the uncontested submissions of the Complainant that it has extensive rights within the meaning of the Policy, enforceable under English law and otherwise, in the marks HARRODS, HARRODS DIRECT and HARRODS ONLINE, in the form of registered trade marks and goodwill built up over a period of time.

The Policy is silent as to the date by which the Complainant must have acquired the Rights which it asserts. In the view of the Expert it is sufficient for the purposes of paragraph 2a(i) of the Policy for the Complainant to show that it has Rights as at the date of submission of its complaint. By that date the trade marks referred to in the Complainant's submissions had all been registered and would have been enforceable against third parties. However, the trade marks which mirror the wording of the Domain Names and are thereby identical to the Domain Names came into force some time after the Domain Names were registered. Perhaps with this in mind, the Complainant also argues that its HARRODS mark, of evidently longer history, is similar to the Domain Names, which each consist of that mark together with either an 'online' or 'direct' element. These additional elements, the Complainant contends, are either generic or descriptive. The Expert agrees that such elements are not material when placed alongside a mark of the fame and repute of the Complainant's HARRODS mark. While each of the additional elements is widely used in a generic sense to denote 'mail order' businesses it is the 'HARRODS' component which renders the Domain Names distinctive. In the view of the Expert, therefore, the Domain Names each indicate the well known Harrods brand coupled to the generic description of a particular kind of service.

Consequently, for the purposes of paragraph 2a(i), the Expert finds as follows:-

1. The Complainant has Rights in the mark HARRODS ONLINE which is identical to the domain names harrodsonline.co.uk and harrods-online.co.uk;
2. The Complainant has Rights in the mark HARRODS DIRECT which is identical to the domain names harrodsdirect.co.uk and harrods-direct.co.uk; and

3. The Complainant has Rights in the mark HARRODS which is similar to all of the Domain Names. It is not necessary to show 'confusing' similarity as contended for by the Complainant.

In each respect, the Expert has disregarded the second and top levels of the domain names (.co.uk) and the dash characters in harrods-online.co.uk and harrods-direct.co.uk on the grounds that these are wholly generic.

Abusive Registration

Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "Abusive Registration" as:-

"a Domain Name which either:

- i. was registered or otherwise acquired in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR
- ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

The Policy provides a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration in paragraph 3 of the Policy. The Complainant focuses specifically on blocking registrations and, bearing in mind that the list is non-exhaustive, the Complainant also offers additional factors which it believes are indicative of Abusive Registration. The Complainant has provided very detailed submissions which the Expert will consider in turn. The Expert wishes to add at this stage, however, that the vast majority of the Complainant's submissions rather unhelpfully consisted of detailed 'legal' argument based on the Policy and past decisions rather than substantive evidence. There can be no substitute, in the Expert's view, for actual evidence which would assist the Expert in making a determination within the framework provided by the Nominet DRS.

Blocking registration

The Complainant submits that the registration of the Domain Names by the Respondent without a prima facie right or a valid reason prevents the legitimate owner of rights in the names HARRODS ONLINE and HARRODS DIRECT from registering and using the associated Domain Names and thereby constitutes a blocking registration within the meaning of paragraph 3(a)(i)(B) of the Policy.

The term 'blocking registration' has not been defined in the Policy. The Complainant adopts the definition of the Nominet Expert in *Peoplesoft UK Limited v Kane* (DRS 120):-

A blocking registration is a registration that is unwarranted at the time of registration. It is a domain registration that is:

- a) *designed to prevent a legitimate owner of rights in a name from registering and using the associated domain name; and*

b) *carried out in circumstances when Respondent is unable to demonstrate a prima-facie right in the name or valid reason to make the registration.*

A typical example is the registration of the domain name of a party's product by its competitor.

In the Expert's view, the key to understanding whether any particular domain name registration is a blocking registration lies in evidence of the respondent's intent in making that registration (in the definition relied upon by the Complainant, the word 'designed' in paragraph (a) implies a deliberate and conscious intent by the respondent). In the present case, no evidence has been submitted of the Respondent's actual intent or motivation. However, the Expert agrees that there is likely to be no legitimate purpose for which use of the Domain Names could be made in the face of the Complainant's Rights. In the Expert's view this points sufficiently to the Respondent's intent in the absence of an explanation from the Respondent himself. On the Complainant's own admission it has not been able to contact the Respondent to seek his reasons for the registrations. However, the Complainant offers its own suggestion by quoting further from the Nominet Expert's remarks in *Peoplesoft v Kane* (DRS 120):

...cyber-squatters are becoming increasingly aware that an attempt to sell, rent or transfer the domain for money may be evidence of bad-faith and therefore that cyber-squatters are simply registering domain names and sitting on them as blocking registrations hoping that a legitimate owner may offer to buy the domain.

The present Expert has some sympathy with this comment and once again, in the absence of any response or rebuttal from the Respondent, accepts the Complainant's submission that this is the likely reason for registration of the Domain Names.

False representation/abuse of goodwill

The Complainant contends that the Domain Names suggest a false representation of origin or sponsorship for any associated goods or services and were undoubtedly chosen by the Respondent in an effort to free-ride off the goodwill associated with the Complainant's trade marks (particularly the HARRODS mark), in which the Complainant enjoys exclusive rights. This is not a matter specifically provided for in terms of paragraph 3 of the Policy. Paragraph 3 (a)(ii) calls for evidence that the Respondent is using a Domain Name in a way which has confused people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant. The evidence discloses that the Domain Names are not in use in connection with the publication of any website. It may be fair to say that if there were any such use then there would be such a false representation. However, in the absence of evidence of any use and even though the categories of Abusive Registration are not closed, the Expert does not consider that there is a false representation of origin or sponsorship taking place in the present case or that the 'suggestion' of such false representation is sufficient to constitute evidence of Abusive Registration.

Inferences to be taken concerning purpose of registration

The Complainant submits that certain reasonable inferences can be drawn from the Respondent's lack of response, based upon the inferences drawn by the Expert in *Scottish Police Federation v Rolf Carlin* (DRS 00080). Taking each of these in turn:-

- (1) the domain names are so closely connected to the Complainant that it is difficult to conceive of a genuine purpose that anyone not connected with the Complainant could have for registering them.

The Expert agrees with this contention on the basis of the worldwide fame of the Complainant's marks and the extent of the Complainant's Internet activities.

- (2) the Respondent is not connected with the Complainant and the Complainant has not consented to the registration of the domain names.

The Expert accepts this submission on the unchallenged evidence of the Complainant.

- (3) the Respondent undeniably had the Complainant in mind at the time of [the Domain Names'] registration.

The Expert agrees that this contention is highly likely to be accurate, albeit that 'undeniably' is perhaps too strong. However, in the absence of any credible explanation from the Respondent the Expert accepts this submission on balance of probabilities.

- (4) the Respondent has not used the domain names (the Complainant is aware this cannot of itself constitute an Abusive Registration).

The evidence has demonstrated this contention insofar as website use is concerned.

- (5) the Respondent has registered more than one domain name.

The Expert notes that the evidence discloses that four domain names were registered together, each incorporating a well known mark in which the Complainant has Rights. Paragraph 3(a)(iii) of the Policy provides that it may be evidence of Abusive Registration where in combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations. While the Complainant has not made this submission directly (although it has alluded to it in its discussion of *Scottish Police Federation v Rolf Carlin*) it is the Expert's view that a pattern of making Abusive Registrations is demonstrated here on the grounds that there are four domain names, all incorporating the Complainant's mark, all of which the Expert has already found to be blocking registrations.

Given that the Expert has accepted the Complainant's five numbered submissions under this heading, do these on their own make out Abusive Registration? The Expert does not believe that the points constitute a test which can be applied to all DRS cases. In fact, in *Scottish Police Federation v Rolf Carlin* the Nominet Expert drew a total of six points from the available evidence, the sixth being that the Respondent had not taken up the opportunity provided by the DRS to explain his purpose in registering the Domain Name. That Expert considered that the presence of all six factors in the evidence confirmed that the domain name concerned was a blocking registration. In the present Expert's view the lack of a response is also a central factor in this case but as the Expert has already found that the Domain Names were registered as blocking registrations this particular submission does not add anything for the Complainant.

No circumstances available to Respondent under paragraph 4 of the Policy

The Complainant takes each item in turn under paragraph 4 of the Policy in order to demonstrate that the Respondent cannot show that the registrations are not Abusive Registrations. This is largely an anticipatory argument and in light of the Expert's earlier findings it is not necessary to consider it in detail here.

Taking the totality of the Complainant's assertions, the Expert considers that the Complainant has set out an arguable case that the registration of the Domain Names are Abusive Registrations on the grounds that they are blocking registrations within the meaning of paragraph 3(a)(i)(B) of the Policy and that in common with other circumstances indicating that the Domain Names are Abusive Registrations the Complainant has demonstrated that the Respondent has engaged in a pattern of making Abusive Registrations within the meaning of paragraph 3(a)(iii) of the Policy.

The Respondent has not provided any reply to the Complainant's extensive submissions. The Policy provides an opportunity to the Respondent to demonstrate that the Domain Name is not an abusive registration both in terms of the list of factors which are provided in paragraph 4 and (as this list is non-exhaustive) in terms of any other relevant submissions which the Respondent might choose to make. The Respondent has chosen not to take up that opportunity and there is no information before the Expert which adequately addresses or contradicts the arguable case of the Complainant.

The Expert therefore finds that the Complainant has proved on the balance of probabilities that the Domain Names are Abusive Registrations as defined in paragraph 1(i) of the Policy on the ground that at the time when the registrations took place they took unfair advantage of the Complainant's Rights.

Remedy

Paragraphs 10(a) of the Policy and 17(c) of the Procedure anticipate a decision by the Expert that the Domain Name registration be cancelled, suspended, transferred or otherwise amended, or that the status quo be maintained.

The remedy sought by the Complainant is the transfer of the Domain Names to the Complainant and this is accordingly the most appropriate disposal of the case.

6. Decision:

In light of the foregoing finding that the Domain Names are Abusive Registrations the Expert directs that the Domain Names harrodonline.co.uk, harrods-online.co.uk, harrodsdirect.co.uk and harrods-direct.co.uk be transferred to the Complainant.

Andrew D S Lothian

23 July 2002
Date