

# Nominet UK Dispute Resolution Service

DRS 00386

K-Tel Entertainment (UK) Limited and Keith Sturgeon

## Decision of Independent Expert

### 1 Parties

The Complainant is K-Tel Entertainment (UK) Limited of K-Tel House, 12 Fairway Drive, Greenford, Middlesex UB6 8PW. The Respondent is Mr Keith Sturgeon of 21 Coppice View, Green Lane, Heathfield, East Sussex TN21 8YS.

### 2 Domain Name

The domain name in dispute is **k-tel.co.uk** ("the Domain Name").

### 3 Procedural Background

A Complaint in respect of the Domain Name under Nominet UK's Dispute Resolution Service Policy ("the Policy") was received from the Complainant on 3 May 2002 and forwarded to the Respondent by Nominet on 8 May 2002. No response was received from the Respondent and on 31 May Nominet notified the parties that it would appoint an Expert to determine the dispute on receipt from the Complainant of the applicable fees in accordance with paragraph 5d of Nominet's Procedure for the conduct of proceedings under the Dispute Resolution Service ("the Procedure"). The applicable fees were received from the Complainant on 6 June 2002. I was appointed as Independent Expert as of 13 June 2002 and confirmed to Nominet that I was independent of the parties and knew of no facts or circumstances that might call into question my independence in the eyes of the parties.

### 4 Formal/procedural issues

Paragraph 15b of the Procedure provides that if, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or Procedure, the Expert will proceed to a Decision on the Complaint. I find that there are

no exceptional circumstances. Under Paragraph 15c of the Procedure I am entitled to draw such inferences from the Respondent's non-compliance with the Procedure as I consider appropriate.

## 5 The Facts

The Complainant is a well-known record company with offices in numerous countries around the world including the UK. It is a wholly owned subsidiary of K-Tel International Inc ("K-Tel International") which also has other subsidiaries.

According to the Nominet WhoIs database, the Domain Name was registered by the Respondent on 11 December 1999. It resolves to a web page promoting the internet services of freenetname.

## 6 The Parties' Contentions

### ***Complainant***

- (a) K-Tel International is the registered proprietor of a number of UK and US trade marks for K-TEL and in the USA for K-TEL EXPRESS. K-Tel International and its subsidiaries (together "K-Tel") have used the K-TEL mark since 1968 and since then have built up a substantial goodwill in the music and media sector in this mark. K-Tel was the inventor of the concept of compilation albums and the name K-TEL is widely known throughout the world as a result. K-Tel spends and has spent significant sums in marketing its goods including television advertising campaigns.

K-Tel owns a wide variety of domain names encompassing the k-tel name.

The Complainant contends that it has trade mark rights in K-TEL and that the Domain Name is identical or similar to those marks.

- (b) The Respondent has registered the Domain Name as a blocking registration against K-Tel in that K-Tel has a legitimate interest in registering the Domain Name and it was (or should have been) foreseeable to the Respondent that K-Tel would wish to do so. The Respondent had no other reason for or genuine interest in registering the Domain Name.

In correspondence with the solicitors for K-Tel, the Respondent contended that he is using the email address and that he chose the Domain Name because his "name is Keith and he deals with telephonic communications". However, he failed to provide any evidence that he has been legitimately trading under the name 'K-Tel'. He registered a UK company under the name K-Tel Services Limited but a company search shows that it is a dormant company and therefore not trading. Although the Respondent claims that the Domain Name is "... a genuine use of his own name to further his own business.com" the Complainant submits that it would have been logical for the Respondent to register his own name (keithsturgeon.co.uk) to use as a personal e-mail address and not the Domain Name.

- (c) The Complainant further contends that the Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the business of Complainant since the domain name resolves to a "freenetname" web page including invitations to register domain names and to set up websites. Use of the Domain Name in this way is damaging to the business and reputation of Complainant. In addition, the Respondent is using an email address [keith@k-tel.co.uk](mailto:keith@k-tel.co.uk) so that he may receive e-mails intended for the Complainant without any obligation to forward mis-directed e-mails to the Complainant. This could have the effect of disrupting the Complainant's business.

### ***Respondent***

The Respondent has not filed any response to the Complaint.

## 7 Discussion and Findings

### ***General***

Although K-Tel Entertainment (UK) Limited is named as the Complainant, it purports to bring this complaint on its own behalf and on behalf of K-Tel International and its subsidiaries (already together referred to as "K-Tel"). The Complainant is represented by Denton Wilde Sapte, solicitors, and I have no reason to doubt that they are properly authorised to bring this complaint on behalf of K-Tel. I therefore approach this

complaint on the basis that K-Tel is the Complainant.

In order to succeed, K-Tel has to prove to the Expert on the balance of probabilities pursuant to paragraph 2 of the Policy, 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, second, 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***

K-Tel has registered trade mark rights in the name K-TEL and I therefore find that the Complainant does have rights which are identical to the Domain Name.

### ***Abusive Registration***

That leaves the second limb of the requirement on the part of the Complainant. 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 was registered or otherwise acquired or 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 3a of the Policy. These include circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name

- (i) as a blocking registration against a name or mark in which the Complainant has Rights; or
- (ii) primarily for the purpose of unfairly disrupting the business of the Complainant;

In its submissions, the Complainant relies only on these two factors and no attempt is made to support the contention that the Domain Name is an Abusive Registration on any other basis.

Taking these factors in reverse order, the Complainant has suggested that there is a risk that its business may be disrupted as a result of the registration of the Domain Name by

the Respondent because the Domain Name resolves to a web page of freenetname and use of the Domain Name in this way is damaging to the business and reputation of the Complainant. However, it has not produced any evidence whatsoever that the primary purpose of the Respondent in registering the Domain Name was to disrupt its business or even that the registration has in fact caused any such disruption. Although there is also a concern that emails intended for K-Tel may be mis-addressed and be sent to the Respondent @k-tel.co.uk there is no evidence that this has in fact happened in the period since the Domain Name was registered. I find that the Complainant's contention that the Respondent acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant is not made out.

So far as the first submission is concerned, K-Tel faces the further difficulty that, although the Respondent's registration of the Domain Name is in fact blocking K-Tel from registering the Domain Name, there is no direct evidence that the Respondent registered the Domain Name for that purpose. In my view that is the essence of the indicative factor set out in the Policy.

The Complaint is somewhat lacking in substance and matters are finely balanced. However, K-TEL is a well-known, long established, registered trade mark and, in all the circumstances, there is a very strong inference that the Respondent did in fact register the Domain Name as a blocking registration.

The Respondent has not filed any response to the Complaint and has not therefore attempted to demonstrate that the Domain Name is not an Abusive Registration. I also find that there is no credible evidence in the correspondence with the Respondent's solicitors that he has used or prepared to use the Domain Name in connection with a genuine offering of goods or services or that he has been commonly known by the name K-Tel or that he has a legitimate connection with that mark. The suggestion that he registered the name because his name was Keith and he deals in telephonic communications is wholly unconvincing.

In the circumstances, I find that the Domain Name was registered in a manner which was unfairly detrimental to the Complainant's Rights.

8 Decision:

Accordingly, I find that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore determine that the Domain Name be transferred to the Complainant K-Tel Entertainment (UK) Limited.

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Ian Lowe  
27 June 2002