

Nominet UK Dispute Resolution Service

DRS 00328

Nokia Corporation v LiquidSMS Limited

Decision of Independent Expert

1. Parties

Complainant: Nokia Corporation
Address: Keilalahdentie 4
FIN – 02150 Espoo
Finland
Espoo
Postcode: FIN - 02150
Country: FI
Respondent: LiquidSMS Limited
Address: 1 City Square
Leeds
West Yorkshire
Postcode: LS1 2ES
Country: GB

2. Domain Name

mynokiastuff.co.uk
("the domain name")

3. Procedural Background

The complaint was notified to Nominet on 27 March 2002 and received in full on 28 March 2002. Nominet checked that it complied with the Nominet UK Dispute Resolution Service Policy ("the Policy") and the Procedure for the conduct of proceedings under the Dispute Resolution Service ("the Procedure"). Nominet notified the Respondent of the Complaint on 4 April 2002, and informed the Respondent that it had 15 days within which to lodge a response. The response, dated 16 April 2002, was received by Nominet on 23 April 2002. The Complainant filed a reply to that response on 2 May. 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 on 6 June.

On 11 June 2002 I, Mark de Brunner, agreed to serve as an Expert under Nominet's Dispute Resolution Policy and Procedure. I confirmed that I am independent of each of the parties, and that there are no facts or circumstances that might call into question my independence.

4. Outstanding Formal/Procedural Issues

There are three procedural issues I must deal with at the outset.

First, who is the Respondent? The domain name mynokiastuff.co.uk was registered by Easyspace for SitesBuilder.net on 13 December 2000. SitesBuilder.net is a domain name registered to Mr Rick Clark, Managing Director of LiquidSMS Ltd. Before and during formal proceedings under the Procedure, Mr Clark held himself out as representing LiquidSMS Ltd. I infer that the domain name was registered on behalf of the company. The Complainant has directed its complaint at LiquidSMS Ltd.

The Policy defines the Respondent as the person (which includes a legal person like a company) in whose name or on whose behalf a domain name is registered and against whom the Complainant makes a complaint. LiquidSMS Ltd is the legal person on whose behalf the domain name was registered and against whom the Complainant is complaining. I therefore regard LiquidSMS Ltd as the Respondent.

Second is the treatment of the further evidence from the Complainant included in the case papers – evidence submitted after the rounds envisaged in the Procedure (the complaint, the response, and the Complainant's reply to that response). I was not obliged to consider that further evidence, which concerns the Respondent's offering the domain name for sale. I considered it nonetheless. Had it been material to my decision, it might have been appropriate to invite the Respondent to reply. But it was not material to my decision.

Third, the Respondent refers throughout its response to mynokiastuff.com. I take it that the Respondent means mynokiastuff.co.uk and have interpreted the response in that way.

5. The Facts

I accept the following as facts.

The Complainant makes and sells mobile communications equipment. In 2000 it had nearly a third of the world market in the sale of mobile phones. NOKIA branded products are sold in 119 countries. Worldwide sales in 2000 amounted to EURm 30,376. The Complainant owns 309 registered trademarks that either are simply the word NOKIA or include the word NOKIA. In Interbrand's survey for 2001, NOKIA was ranked the fifth most valuable brand in the world.

The Respondent sells ringtones, logos and picture messages for downloading onto mobile phones. Using the domain names mynokiastuff.co.uk and onmymob.com, the Respondent mainly sells products compatible with Nokia phones.

The domain name mynokiastuff.co.uk was registered by Easyspace for SitesBuilder.net on 13 December 2000. SitesBuilder.net is a domain name registered to Mr Rick Clark, Managing Director of LiquidSMS Ltd.

The domain name onmymob.com has existed since at least 19 March 2001. Between October 2001 and January 2002, LiquidSMS Ltd became the registered owner of onmymob.com. For a period before March 2002, mynokiastuff.co.uk resolved to onmymob.com. At some point after 4 March 2002, direct resolution from mynokiastuff.co.uk to onmymob.com was replaced with a 'website moved' page and a hypertext link to onmymob.com. Later still, the hypertext link was removed in favour of direct resolution again.

There is a disclaimer at the foot of the webpage at onmymob.com in the following terms:

Nokia is a registered trademark and is used to determine ringtone, Nokia logo and picture message compatibility only. This service is run by LiquidSMS Ltd.

On 18 January 2002, through its solicitors, the Complainant wrote to the Respondent drawing attention to its rights in the mark NOKIA and asking that the domain name mynokiastuff.co.uk be transferred to it.

6. The Parties' Contentions

Complainant

The Complainant's contentions can be summarised as follows.

- (i) It has rights in the name NOKIA
- (ii) The Respondent has used the domain name mynokiastuff.co.uk to attract visitors to its website by confusing them into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. That makes the domain name an abusive registration.
- (iii) The domain name is now for sale at onmymob.com/e/moved.html alongside mynokiastuff.com, yournokiastuff.com and other domain names incorporating famous brands. This is further evidence that the registration is abusive.

Respondent

The Respondent says that its use of the domain name is justified because

- (i) it shares and sells items mainly for Nokia mobile phones

- (ii) the domain name accurately describes what the Respondent sells
- (iii) mynokiastuff.co.uk is its main consumer website, rather than being a doorway or gateway site
- (iv) there is no intention to confuse or mislead people into believing that mynokiastuff.co.uk is in any way connected with the Complainant. The disclaimer makes that clear
- (v) people are not in fact confused or misled. Common sense tells them that they ought not necessarily to expect mynokiastuff.co.uk to indicate a connection with the Complainant. It points to a survey it ran, and concludes that the results back up the claim that people know that the domain name is not connected with the Complainant
- (vi) the domain name does no harm to the Complainant, indeed
- (vii) use of the domain name generates additional revenue for the Complainant, in that some visitors to the Respondent's website go on to buy products from Nokia.

Like the Respondent, the Complainant sells ringtones, logos and picture messages. The Respondent's view is that

- (viii) in claiming that mynokiastuff.co.uk is an abusive registration, the Complainant's real purpose is to prevent effective competition.

Complainant's reply to Respondent's contentions

The Complainant argues that

- (i) the products offered for sale through the Respondent's website are 'mainly' rather than 'exclusively' for Nokia phones, so the use of the word NOKIA is not descriptive of the site as a whole
- (ii) the key relevant fact is the inclusion of NOKIA in the domain name, rather than the content of the site
- (iii) mynokiastuff.co.uk is no more than a means of attracting custom to onmymob.com
- (iv) the disclaimer is inadequate, and in any event operates after the event (when people have already been misled or attracted through confusion to a website run by the Respondent)
- (v) the survey methodology was flawed, and its results do not support the Respondent's case

7. Discussion and Findings

General

To succeed in this complaint the Complainant must prove, on the balance of probabilities, that

- (i) it 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

The Complainant has registered NOKIA as a trade mark. The Respondent has not at any stage sought to challenge the Complainant's rights in respect of the mark NOKIA. I therefore accept that the Complainant has rights in respect of the mark NOKIA.

The domain name which is the subject of proceedings, however, is mynokiastuff.co.uk. The mark in which the Complainant has rights is not identical to the domain name. But is it similar? The domain name contains NOKIA. It seems to me that – so far as they have an effect at all - the prefix MY and the suffix STUFF increase the emphasis on NOKIA. On any reasonable view, they do not render NOKIA and the domain name dissimilar. I conclude that NOKIA is similar to MYNOKIASTUFF. I therefore find that the Complainant has rights in respect of a mark which is similar to the domain name.

Abusive Registration

The Dispute Resolution Service rules define an 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 contains a non-exhaustive list of factors that may be evidence that the domain name is an abusive registration. Among these are circumstances indicating that the Respondent either

- (i) registered the domain name primarily for the purpose of transferring it to the Complainant for valuable consideration in excess of its costs in acquiring or using the domain name; or
- (ii) 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.

These are essentially the claims of the Complainant.

The Policy also contains a non-exhaustive list of factors that may be evidence that the domain name is not an abusive registration. One factor that can point in that direction is where

- (iii) the domain name is generic or descriptive and the Respondent is making fair use of it

The Respondent relies in part on this in arguing that the registration is not abusive.

I can take each of these in turn.

registration primarily for transfer at profit

The Complainant says that the Respondent's offering the domain for sale is evidence that the registration is abusive. But the key test here is surely one of motive at registration. We know that the Respondent is offering the domain name for sale now, but in itself that tells us nothing about why it registered the domain name in the first place. There is simply no evidence to suggest that the domain name was registered primarily for the purpose of subsequent transfer at a profit, and I do not accept that the offer for sale alone tells us anything about the nature of the registration.

It may be the Complainant had in mind another factor in the Policy's non-exhaustive list of factors which may be evidence that the domain name is an abusive registration:

in combination with other circumstances indicating that the domain in dispute is an abusive registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making abusive registrations.

Whether or not the list of domain names for sale through onmymob.com reflects a pattern of registrations (I simply do not know the circumstances surrounding each) no evidence has been submitted that any pattern would be made up of abusive registrations. Again, I draw no conclusions from this about the registration of the domain name that is the subject of these proceedings.

confusion

The Complainant says that the domain name is being used in a way that has confused people into believing there is some connection with the Complainant. The Respondent says that there is no confusion: the domain name accurately describes what it sells and, by implication, its use of the domain name is fair.

No direct evidence of confusion has been submitted. Indeed the Respondent cites the results of a survey to back up its assertion that there is no confusion - that people know the site is not connected with the Complainant. But it is a slightly odd survey. Of around 8,000 replies, 94.5% were from people who said they knew the website was not connected with Nokia, and that the products were Nokia-compatible rather than made or sold by Nokia. But presumably all that tells us is that by the time they came to complete the questionnaire, they were aware there was no connection. I have not been shown the questions or the form in which they were asked, but it seems to me reasonable to infer that questions like this could in themselves point to the answers the Respondent was hoping for. Of course, as the Complainant points out, to fill in the questionnaire people will have come to the site and read the disclaimer. I do not, therefore, regard the survey as evidence that there is no confusion. In the absence of satisfactory direct evidence either way on the question, I must draw conclusions from the facts before me.

The Respondent says that common sense should be sufficient to avoid confusion (because people would not reasonably infer that MYNOKIASTUFF indicates a connection with the Complainant). But it is not clear to me that that is common sense. It seems to me entirely reasonable that common sense might lead people to expect MYNOKIASTUFF to indicate goods or services made or sold by Nokia.

The Respondent goes on to argue that, in any event, the disclaimer is sufficient to eliminate confusion. That may be right – though the disclaimer does not seem to me wholly free from ambiguity. But even if it is right, the fact that confusion needs eliminating means that it has already arisen. The Complainant draws my attention to the decisions in *Nokia Corporation v Just Phones Ltd* (DRS 00058; domain name *nokiaringtones.co.uk*) and *Nokia Corporation v Andrew Stone* (DRS 00068; domain name *nokiagsm.co.uk*) and argues these support its view that the use of NOKIA in the domain name is intended only to mislead and confuse. Those cases of course turn on their own facts. Here, though, I accept the Complainant's point that, by the time people read the disclaimer, confusion may already have occurred – traffic may already have travelled to the site on a misapprehension. Telling people in small print once they have arrived that they may not have reached the destination they were expecting to reach is, quite literally, too little, too late.

The Complainant argues that even if people searching for domain names including – for example – 'nokia ringtones' knew that those domain names were unconnected with Nokia, that would not be enough to avoid the charge that the domain name was an abusive registration. On the contrary, I think if people knew there was no connection there would be no confusion and, as a factor, that would point towards the domain name's not being an abusive registration. But in this case the evidence

suggests to me that people would not know that the domain names were unconnected with the Complainant. Some people are likely to be confused, so there is no need to take a final view on what would happen if they weren't.

fair use of a generic or descriptive domain name

The Complainant says that it is the inclusion of the word NOKIA in the domain name that is the relevant fact, not the content of the site. I do not entirely accept that, because it seems to me that the content of the site is relevant to the question whether the domain name is merely generic or descriptive. That is a key question, because fair use by the Respondent of a generic or descriptive domain name may be evidence that a domain name is not an abusive registration. Is the Respondent making fair use of a domain name that is merely generic or descriptive?

The answer to that question would, I think, be finely balanced if the Respondent was selling products made by the Complainant. Arguably, then, MYNOKIASTUFF would be adequately descriptive of the products on offer at the website (or at least of the majority of them). But it is not clear to me that what the Respondent sells is 'Nokia stuff'. It sells ringtones, logos and picture messages that can be downloaded onto Nokia phones (and phones made by other manufacturers). I think it would be more accurate to say that the Respondent sells Nokia-compatible stuff, rather than Nokia stuff. That seems to me to be an important distinction, because it means that NOKIASTUFF (with or without the prefix MY) is not, here, an appropriate generic or descriptive label.

The Complainant says that as the Respondent sells items compatible with other manufacturers' phones too, NOKIASTUFF is not descriptive of the site as a whole. I do not accept that argument, because it does not seem to me that the sale of non-'Nokia stuff' at the margins would render the description inaccurate. But as I do not regard the Respondent as selling NOKIASTUFF at all (but rather as selling, at most, NOKIA-compatible stuff) I do not think this is any help to the Respondent's case.

other arguments

The Respondent asserts that mynokiastuff.co.uk is not merely a gateway or doorway site – that it stands on its own. The Complainant argues that, one way or another (by direct resolution or hypertext link) mynokiastuff.co.uk has essentially been a means to draw people to the Respondent's website at onmymob.com. The Respondent does not help itself by referring throughout its submission to mynokiastuff.com as being its main consumer website. But ignoring that, and treating the references as being to mynokiastuff.co.uk, the evidence before me is that mynokiastuff.co.uk has been used to draw traffic elsewhere. I accept that evidence.

The Respondent argues that the domain name does no harm to the Complainant – indeed that it generates the Complainant additional revenue. Apparently some of those who completed its survey spent money on the Complainant's equipment. The Respondent claims this is as a direct result of visits to its website. I find that unconvincing. The survey would have had to work very hard to distinguish purchases

made because of visits to the website, from purchases that would have been made in any event. From the evidence before me, I do not have any confidence that the survey would have been equal to the task of making that distinction. Whether the domain name does harm to the Complainant is essentially a question for me – though more precisely what I am deciding is whether the domain name took unfair advantage of or was unfairly detrimental to the Complainant's rights.

The Respondent claims that, in arguing the registration is abusive, the Complainant's true purpose is to prevent effective competition. But again the question for me is not whether competition is effective, but whether the domain name is an abusive registration as defined by the Policy.

conclusion on the nature of the registration

The onus is on the Complainant to prove, on the balance of probabilities, that the domain name is an abusive registration. It is clear to me – from submissions by both the Complainant and the Respondent – that people are likely to have been confused into believing that the domain name is in some way connected with the Complainant. I do not accept that the domain name is generic or descriptive or that the Respondent is making fair use of it. In my judgement, the only reasonable conclusion is that the domain name has been used in a manner which took unfair advantage of the Complainant's rights in the NOKIA mark. It follows that the domain name, in the hands of the Respondent, is an abusive registration.

8. Decision

I find that the Complainant has rights in respect of a mark which is similar to the domain name, and that the domain name, in the hands of the Respondent, is an abusive registration.

In the light of those findings, I direct that the domain name mynokiastuff.co.uk be transferred to the Complainant.

Mark de Brunner

27 June 2002