

Nominet UK Dispute Resolution Service

DRS 4068

NOKIA CORPORTION V ANDREW STONE

Decision of Independent Expert

1. Parties:

Complainant: Nokia Corporation
Address: IPR
PO Box 226
Postcode: 00045
Country: FINLAND

Respondent: Andrew Stone
Address: 14 Maple Court
Wallace Avenue
Worthing
Sussex
Postcode: BN11 5PZ
Country: GB

2. Domain Name:

nokiagsm.co.uk (“the Domain Name”)

3. Procedural Background:

The complaint was lodged with Nominet on 25 October 2001. Nominet validated the complaint and informed the Respondent of it by notification dated 26 October 2001, sent by both letter and e-mail notifying him that he had 15 days within which to lodge a Response. No Response was received and the postal notification to the Respondent was returned by the Royal Mail to Nominet indicating that the addressee had gone away. No indication was received by Nominet that the e-mail sent to the Respondent was not received by him. Mediation was therefore not possible. The Complainant was informed accordingly and on 29 November 2001, the Complainant paid 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 30 November 2001, 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 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.

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

It is first necessary to deal with any matters arising from the fact that no response has been received from the Respondent.

Clause 5a of the Procedure for the Conduct of Proceedings under the Dispute Resolution Service (“the Procedure”) requires the Respondent to submit a Response to Nominet within 15 days of the date of the commencement of proceedings under the Dispute Resolution Service. Paragraph 15b of the Procedure provides, amongst other matters 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 and paragraph 16a provides that the Expert will decide a complaint on the basis of the Parties’ submissions, the Policy and the Procedure.

Clause 2.3 of Nominet’s terms and conditions for registering a .uk domain name require a Registrant to inform Nominet promptly of any changes to its registered details and to maintain and update any details submitted. The clause expressly provides; “...In particular, it is your responsibility directly or by your Agent to ensure that we have your full and correct postal address”.

In these circumstances, the fact that a notification sent to the Respondent at the address provided by him to Nominet for the purpose of enabling Nominet to communicate with him has been returned by the Royal Mail, particularly when allied to the fact that there is nothing to suggest that the corresponding e-mail notification from Nominet did not reach the Respondent, does not constitute an exceptional circumstance for the purpose of paragraph 15b of the Procedure. It is also noted that a letter sent by the Complainant’s representative to the Respondent was also returned marked “not known at this address”.

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 the Procedure, the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate. Whilst it is not intended to draw any adverse inferences from the Respondent’s failure to respond to the complaint, the starting point for this decision is that the facts asserted by the Complainant are correct.

5. The Facts:

The Complainant is a well-known manufacturer of mobile telephones and other telecommunications products. The Complainant states that its history dates back to 1865, that the Nokia name has been used in relation to telecommunications since the 1980’s and that it has 309 trade marks throughout the world which comprise the word NOKIA or of which the word NOKIA is the dominant feature. These include UK and Community Trade Marks for NOKIA and NOKIA - CONNECTING PEOPLE, most marks being registered in a number of classes. The earliest UK marks for NOKIA were apparently registered in 1993.

The Complainant has submitted evidence relating, amongst other matters, to the value of the NOKIA brand. The Interbrand Annual Survey appended to the Complaint rates it as the fifth most valuable brand in the world. The Complainant has also made assertions in relation to, its

market share (31.6% of the world market in the sale of mobile phones in 2000) and its sales (approximately EUR m 222,876 in the year 2000).

A Nominet WHOIS search shows that the Domain Name was registered by the Respondent on 5th September 2000. It is said by the Complainant that until, at least, 17th October 2001, the Respondent may have rented the Domain Name to a company called Dominet Communications Limited (“Dominet”) which used the Domain Name in relation to a site which offered for sale various mobile telephone accessories such as kits, data cables, ringtones and logos. From at least 22nd October 2001, the Respondent has used the Domain Name as an address which redirects the browser to another website at *www.theguruguide.co.uk*. A Nominet WHOIS search shows this site to have been registered in the name of Mr Andrew Stone on 19th September 2001. It is reasonable, on the facts available, to assume that this is the same person as the Respondent to this complaint. This website offers for sale, amongst other matters, a publication called “The Guru Guide: Unlocking & Firmware Repair of Nokia GSM Mobiles” as well as software for unlocking and repairing many other different types of GSM (that is, Global System, or Standard, for Mobiles) mobile telephones.

The Complainant states that, through its solicitors, it has made contact with the Respondent in an attempt to resolve the dispute but that no response was forthcoming from the Respondent, albeit Dominet wrote to the Complainant’s solicitors by e-mail on 31st August 2001 stating that it rented the Domain Name from the Respondent by payment of a monthly fee.

6. The Parties’ Contentions:

Complainant:

The Complainant asserts that:

1. The Domain Name is identical or similar to the name and mark in which the Complainant has rights.

As more fully set out above, the Complainant asserts extensive rights and trade mark protection for NOKIA and other marks incorporating NOKIA. The Complainant does not assert that it has any registered marks for, or rights in, NOKIAGSM, the name in issue but it says that, the words GSM are purely descriptive, whilst the word NOKIA is neither generic nor descriptive.

2. The Domain Name is an Abusive Registration, as defined by the Policy, because it has been used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant’s rights.

The Complainant states that it has not licenced or otherwise permitted the Respondent or Dominet to use either the Domain Name or its trade marks. It states that the Domain Name is being used solely to attract, for commercial gain, Internet users to Dominet’s website and that neither the Respondent nor Dominet have any rights or legitimate interests in respect of the Domain Name nor have they acquired such rights through use. On this basis, it is said that the Domain Name has been used solely to attract, for commercial gain, Internet users to, initially, Dominet’s and now to the Respondent’s site.

It is also said that the Domain Name has been used to create the impression that Dominet's - and now the Respondent's - website are in some way sponsored, affiliated or endorsed by Nokia Corporation, that the Respondent is taking unfair advantage of the Claimant's goodwill and reputation in the NOKIA trade mark and that the Domain Name has been used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant.

Lastly it is submitted by the Complainant that the use of the Domain Name is unfairly detrimental to its rights in that the incorporation of the whole of the Claimant's trade mark in the Domain Name creates a likelihood of confusion on the part of Internet users and a likelihood that Internet users may associate the NOKIA trade mark with companies other than the Complainant. As a consequence, it is said that the capacity of the Complainant's trade mark to indicate the origin of goods and services will be diluted.

Respondent:

As explained above, the Respondent has not responded.

7. Discussion and Findings:

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert on the balance of probabilities, both that it has rights in respect of a name or mark identical or similar to the Domain Name and 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 Complainant in this case has asserted that it has rights in the word NOKIA and that this name is identical or similar to the Domain Name. In considering whether or not a name or mark is identical or similar to a domain name, it would usually be appropriate not to take into account the domain suffix.

On the basis of the evidence submitted, it is clear that the Complainant has rights in the word NOKIA. Those rights are established from the material submitted with the Complaint. However, this name is not identical to the Domain Name. Is it similar? In considering this issue, regard has to be had to the nature of the differences between the word in which the Complainant has rights, namely NOKIA, and the Domain Name. The first five letters of the Domain Name correspond exactly to the Complainant's name and mark. The remaining three letters comprise the letters GSM. It is material to consider the nature of these letters for the purpose of assessing similarity.

GSM, as the Complainant points out, is a well known abbreviation for Global System (or Standard) for Mobiles. The added letters, then, are essentially descriptive in nature. They are not letters which are, for example, part of any name in relation to which the Respondent might assert rights. They are widely recognised as being closely associated with features of some mobile telephones. It would have been strongly desirable for the Complainant to have adduced evidence to establish that the letters GSM are associated with its mobile telephones. However, the description GSM is in such common usage that it is possible to accept that GSM is a descriptive expression which is as likely to be associated as much with the Complainant's mobile telephones as with those of any other manufacturer.

Not every combination of three letters added to NOKIA would render the composite word similar to NOKIA for the purpose of making a comparison under these rules. However, the addition of a well known 3 letter abbreviation which describes features closely associated with products sold by mobile telephone manufacturers such as the Complainant is such that word NOKIAGSM is considered similar to NOKIA. Accordingly, the Expert finds that the Complainant has rights in respect of a name or mark, which is similar to the Domain Name.

Abusive Registration

The Complainant also has to show that the Domain Name is 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.

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration are set out in paragraph 3a of the Policy. However, these are only examples of conduct which may be evidence that a Domain Name is an Abusive Registration.

Which factors in paragraph 3a might be relevant? It is not asserted that the Respondent has engaged in a pattern of making Abusive Registrations (which can be an indication that the Domain Name is an Abusive Registration under paragraph 3a (iii) of the Policy) or that the Respondent has given to Nominet false contact details (which can be evidence of an Abusive Registration under clause 3a(iv) of the Policy). Accordingly, the only potentially relevant factors are contained in subparagraphs i, and ii, that is

- “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;
- ii Circumstances indicating that the Respondent 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.”

Clause 3 i A is inapplicable; there is no evidence at all that the Respondent’s motivation has been to sell, rent or otherwise transfer the Domain Name to the Complainant or a competitor of the Complainant.

Similarly, clause 3 i B is also inapplicable; there is no evidence that the Respondent's motivation has been to stop the Complainant using the Domain Name or that the Complainant would otherwise have sought to acquire it, were it not for the Respondent's conduct. For much the same reasons, clause 3 i C is inapplicable; whilst the Complainant may not like the Respondent's use of the name, that use does not suggest that the underlying purpose is to disrupt the Complainant's business.

Is clause 3 ii of application? This clause requires evidence of actual confusion on behalf of people or businesses that the Domain Name is being used by the Respondent in a way which has confused people or businesses into believing that the Domain Name is connected with the Complainant. No such evidence has been submitted.

Were the factors set out in Clause 3 a comprehensive list of matters which could amount to an Abusive Registration, the Complainant would fail. However, the factors are not exhaustive; an Abusive Registration, as defined, includes a Domain Name which, "has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights". Accordingly, it is necessary to consider whether the Respondent's use of the Domain Name can be so categorised.

The first requirement of the definition outlined above is actual use of the Domain Name. This is established; even use confined to allowing the Domain Name to forward traffic to another site is sufficient. By allowing the Domain Name to be used for these purposes, the Respondent is doing more than simply passively retaining the Domain Name.

Does the use take unfair advantage of and/or is it unfairly detrimental to the Complainant's Rights? This requires consideration of the purposes to which the Domain Name is being put. For these purposes, it is necessary to comment that the prints of pages at the site of the Domain Name which the Complainant has submitted suggest that the use to which Dominet put the Domain Name earlier this year differs in some respects from the use made by the Respondent of the Domain Name. However, for the purposes of this decision, it is not necessary to consider Dominet's use of the Domain Name because the most relevant use of the Domain Name is that presently made of it by the Respondent rather than any historic use.

The contention by the Complainant that the website operated by the Respondent creates the impression that Dominet's and now the Respondent's website is in some way sponsored, affiliated or endorsed by Nokia Corporation is rejected. It is true that the Respondent is using a Domain Name which would more readily be identified with a site operated by the Complainant than with a third party site promoting electronic books which are intended to assist the user in the unlocking and repair of GSM mobiles sold by the Complainant. Further, the site to which the browser is taken is not disparaging of the Complainant's products. However, there is no content at the site at theguruguide.org.uk which would give a visitor to the site the belief that the site itself has the support or approval of Nokia. In only the most remote manner could it be said, as the Complainant has contended, that the use of the Domain Name has diluted the capacity of the Complainant's trade mark to indicate the origin of its goods and services. Accordingly, it is questionable whether use of the Domain Name is unfairly detrimental to the Complainant's rights.

Does the fact that the site at theguruguide.org.uk sells information in relation to the "Unlocking & Firmware Repair of Nokia GSM mobiles" entitle it to use the Domain Name nokiagsm.co.uk in order to redirect browsers to theguruguide.org.uk? There could be a number of reasons why the Respondent has arranged for the Domain Name to resolve so that traffic to nokiagsm.co.uk is forwarded to theguruguide.org.uk but it is difficult to think of any explanation which does not involve, in some manner, an assumption that the primary intention of the Respondent is to benefit from the use of a Domain Name which incorporates a name in which the Complainant has established trade mark rights. New visitors to the

Domain Name are more likely to be persons who are looking for a site operated by the Complainant than for the Respondent's site. The fact that the Respondent has been given no licence or other authority to use the name creates a presumption that this use takes unfair advantage of the Domain Name. The fact that the products and services sold by the Respondent are directed towards Nokia GSM products does not render the use fair.

Before concluding, it is necessary to consider paragraph 4 of the Policy which indicates grounds by which a Respondent might demonstrate in its response that the Domain Name is not an Abusive Registration. These include, under paragraph 4 a i, that before being informed of the Complainant's dispute, the Respondent has;

- A - used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods and services;
- B - been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- C - made legitimate non-commercial or fair use of the Domain Name.

(Paragraph 4 a ii relates to generic or descriptive names and is inapplicable).

Self-evidently, the nature of the use to which the Domain Name has been put establishes, that the Respondent must have been aware of the Complainant and (in general terms, at least) of its trade mark rights. There is no evidence to suggest that it could have thought other than that the Complainant would have disputed its right to the use of the Domain Name. It is not easy to second-guess what the Respondent might have said had it filed a Response, but there is nothing on the facts which are known which would suggest that the Respondent might have been able to avail itself of paragraph 4 a of the Policy.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration as defined by paragraph 1 of the Policy on the basis that it is being used in a manner which takes unfair advantage of the Complainant's rights.

8. Decision:

In light of the findings that the Complainant has rights in respect of a name or mark which is similar 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, nokiagsm.co.uk, be transferred to the Complainant.

Antony Gold

Date