

Nominet UK Dispute Resolution Service

DRS 0341

Zippo Manufacturing Company –v- Ronald Robinson

Decision of Independent Expert

1. Parties:

The Complainant is Zippo Manufacturing Company of 33 Barbour Street, Bradford, Pennsylvania 16701, US. It is represented by Mrs Gill Smaggasgale of W.P. Thompson & Co, Celcon House, 289-293 High Holborn, London WC1V 7HU.

The Respondent is Ronald Robinson of 13 Narbonne Avenue, Eccles, Manchester M30 9DL, UK

2. Domain Name:

The domain name in dispute is zippo-lighters.co.uk (“the Domain Name”).

3. Procedure:

A Complaint under Nominet UK’s Dispute Resolution Service Policy (“the Policy”) in respect of the Domain Name was received by Nominet UK from the Complainant on 10 April 2002. The Complaint was forwarded to the Respondent on 11 April 2002. No response having been received by the Respondent, Nominet notified the parties on 7 May 2002 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 15 May 2002 and Jonathan Turner was appointed expert after confirming that he was independent of the parties and knew of no facts or circumstances which might call into question his independence in the eyes of the parties.

Having reviewed the file, there does not appear to be any procedural deficiency.

4. The Facts:

The Complainant is a well-known American supplier of cigarette lighters under the name Zippo. Its sales of lighters in the United Kingdom in the last few years have

exceeded £2 million per annum. It has registered “Zippo” as a trade mark in respect of pyrophoric lighters and other goods in the UK and other countries.

According to the Nominet Whois database, the Respondent registered the Domain Name on 12 November 2001. The Domain Name currently resolves to a web page headed “www.zippo-lighters.co.uk / the UK’s cheapest web site for zippo lighters”. It goes on to say, after an advertising banner, “We are only days away from launching The UK’s cheapest web site for zippo lighters”. There is no indication on this web page that it is not authorised by the Complainant.

5. The Parties’ Contentions:

The Complainant contends that it has trade mark rights in the name “Zippo”; that the Domain Name is identical or confusingly similar thereto; that the Respondent has no rights or legitimate interests in the Domain Name; and that the Respondent’s ownership and use of the Domain Name is likely to confuse the public into believing that the Respondent is associated with or approved by the Complainant. The Complainant asks for transfer of the Domain Name to itself.

The Respondent has not replied to the Complaint or submitted any other contentions.

6. Discussion and Findings:

To succeed in this Complaint, the Complainant has to prove on the balance of probabilities: first, that it has rights in respect of a name or mark identical or similar to the Domain Name; and, secondly, that the Domain Name is an Abusive Registration as defined in paragraph 1 of the Policy.

As to the first requirement, the Domain Name is clearly similar to the mark “Zippo” in which the Complainant has registered trade mark rights.

As to the second requirement, an “Abusive Registration” is defined in paragraph 1 of the Policy as a domain name which was registered or acquired or which has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights. Non-exhaustive lists of factors which may be evidence that a domain name is or is not an Abusive Registration are set out in paragraphs 3 and 4 of the Policy.

Evidence of Abusive Registration includes 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 (paragraph 3a(ii) of the Policy).

Evidence that a Registration is not Abusive includes use or demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services before being informed of the Complainant’s dispute (paragraph 4a(i)(A) of the Policy).

Taking into account these indications, and the underlying purpose of trade marks of identifying the origin of goods or services, this Expert considers that the registration or use of a domain name which incorporates a well-known trade mark without the express consent of the trade mark owner should not necessarily be regarded as unfair (and hence abusive) where it is genuinely registered and used for the purpose of advertising authentic goods placed on the market under that mark by the trade mark owner. Indeed, the contrary view could give rise to conflict with European Community law as laid down by the European Court of Justice in Case C-337/95 *Parfums Christian Dior v Evora* (Judgment of 4 November 1997) and other cases.

On the other hand, the use of such a Domain Name is unfair where it is liable to cause confusion and to lead consumers to believe that a website and/or its operator are authorised or approved by the trade-mark owner when they are not. In these circumstances, the use of the Domain Name takes unfair advantage of and is likely to be unfairly detrimental to the trade mark.

In this case, the Complainant has not suggested that the Respondent does not genuinely intend to sell authentic Zippo lighters and the Expert will therefore assume that it does so intend. However, there is no indication on the Respondent's web page that it is not operated or authorised by the Complainant, and the Respondent has not disputed the Complainant's evidence that there is a likelihood of confusion. This Expert accordingly finds that consumers are likely to assume that the Respondent is authorised by the Complainant to operate the website, resulting in the Respondent deriving unfair advantage from its use of a Domain Name similar to the Complainant's mark. Furthermore, the banner advertising on the Respondent's site, which is likely to be associated with the Complainant by virtue of the use of the Domain Name, is unfairly detrimental to the Complainant's mark.

This Expert concludes that the Respondent's use of the Domain Name has taken unfair advantage of and has been unfairly detrimental to the Complainant's rights. It is therefore an Abusive Registration within the meaning of the Policy.

7. Decision:

In light of the above findings, that the Complainant has rights in respect of the mark "Zippo" which is identical or similar to the Domain Name and that the Domain name is an Abusive Registration, the Expert decides that the Domain Name, "zippo-lighters.co.uk", should be transferred to the Complainant.

Jonathan Turner

Date