Panel Decision for dispute CAC-ADREU-004158

Case number	**CAC-ADREU-004158**
Time of filing	**2007-01-12 12:49:54**
Domain names	**silmarillion.eu, thesilmarillion.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**The JRR Tolkien Estate Limited**

Respondent

Organization / Name	**Haik Tonoyan**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

1. The Panel is not aware of any pending or decided proceedings related to the Disputed Domain Names.

FACTUAL BACKGROUND

2. The Respondent registered the Disputed Domain Names on 8 April 2006, the second day of the Landrush registration period.

3. The Complainant is a UK company administering the intellectual property rights in and in connection with the works of the famous author, the late Professor JRR Tolkien, the author of the Lord of the Rings.

A. COMPLAINANT

Complainant
4. The Complainant contends it has Rights in the name Silmarillion, to which it says the Disputed Domain Names, silmarillion.eu and thesilmarillion.eu, are identical or confusingly similar. It contends the Respondent lacks any rights or legitimate interests in the Disputed Domain Names, which it says were registered and are being used in bad faith.

5. The Complainant relies on the following to support its claim to Rights.

5.1. Its Rights as the owner of the following registered trade marks for SILMARILLION; the UK national mark, 2380653 registered on 18 December 2004 and the Community Trade Mark (CTM), 4393071 registered on 18 April 2005, both in classes 09, 16, 28 and 41.

5.2. Rights at common law protected in English law by the cause of action for passing-off, based on worldwide goodwill and reputation arising from use of the name as the title of the literary work “The Silmarillion” by the Professor (whose rights are administered by the Complainant and Mr. Christopher Tolkien (who has appointed the Complainant his agent), which work has been translated and sold in 30 languages in over 90 countries.

6. The Complainant submits the Respondent has no rights or legitimate interest in the disputed domain names. In particular:

6.1. The Respondent has pointed the Disputed Domain Names at websites on which the Respondent has posted and made available free of charge and without restriction, the full text of “The Silmarillion” in HTML, RTF and TXT format. The websites also include additional literary material by Mr. Christopher Tolkien also subject to copyright.

6.2. The Respondent has no connection with the Complainant and has received no consent, permission or licence from the Complainant to use its registered or unregistered marks or to reproduce or make available the copyright works.

6.3. The Complainant's solicitors sent a cease and desist letter to the Respondent on 5 January 2007 demanding take down of the literary works and transfer of the Disputed Domain Names. The Respondent made no reply. The Respondent has no rights and flagrant copyright infringement cannot be a legitimate interest.

7. As to bad faith the Complainant says:

7.1. Use for flagrant copyright infringement cannot be other than bad faith and the failure of the Respondent to respond to the Complainant's solicitors' letter of 5 January 2007 is additional evidence of this.

7.2. The Respondent by its unadorned use of the Complainant's registered and unregistered marks impersonates the Complainant. The representation made is that the sites are owned, controlled or authorized by the Complainant. This "initial interest confusion" is sufficient of itself for bad faith however in addition, the sites fail to include any disclaimer. In the circumstances, the Respondent has used the Disputed Domain Names in a manner which has confused and/or is liable to confuse members of the public. This is inherently detrimental to the Complainant and to the integrity of its registered and unregistered marks and is evidence of bad faith.

B. RESPONDENT

8. The Respondent failed to submit a conforming Response in the requisite time period. More particularly, the Respondent filed the Response electronically on 1 February 2007. On 2 February he was advised of the need to file a hard copy with a signature.

9. Again on 22 March 2007, the Respondent was asked to submit the hardcopy within 7 days. He did not do so and was notified that he was formally in default on 2 April 2007. On 10 April 2007, both parties were advised of the default.

10. The rules of procedure for these administrative proceedings are designed to create a fast and simple dispute resolution service. Parties are asked to provide signatures as a minimum of evidence of the truth of bare statements made in submissions. While an overly pedantic approach should not be taken, blatant non compliance is not acceptable either.

11. §10(a) of the ADR Rules provides that where there is a failure to comply with a time period, the Panel is to proceed to a decision on the Complaint and may consider the failure as grounds to accept the claims of the other party. Given the many opportunities the Respondent was given to correct the situation, I have decided not to allow the unsigned Response into evidence and shall treat this as a default matter.

12. In any event, I note the Response consisted of two points: (1) the Disputed Domain Names were available; and (2) the copyrighted work was obtained from elsewhere on the internet. Neither constitute any basis for a defence and therefore the outcome would have been the same even had I allowed the Response into evidence.

DISCUSSION AND FINDINGS

13. Article 22(1)(a) of Commission Regulation (EC) No 874/2004 of 28 April 2004 ("the Policy Regulation") allows a party to initiate an ADR procedure where a registration is speculative or abusive, as defined in Art. 21.

14. This allows for revocation where the name is identical or confusingly similar to a name in respect of which a right is recognised or established by national or Community law and where registered without rights or legitimate interest and registered or used in bad faith. This is reflected in §11(d) of the ADR Rules.

15. Policy Regulation Art. 21(2) provides examples of how legitimate interest may be demonstrated (echoed in §B11(e) of the ADR Rules), and Art. 21(3) provides examples for bad faith (echoed in §B11(f)).

16. The Complainant clearly has Rights recognized by English and Community law in its CTM and national mark and unregistered rights arising from its worldwide use of the name in trade protected under English law. I find that the Complainant has the requisite Rights.

17. Turning now to legitimate rights and interests, it is necessary to determine if any of the factors in §B11(e) of the ADR Rules apply:

“Any of the following.. shall demonstrate the Respondent’s rights or legitimate interests to the domain name for purposes of Paragraph B11(d)(1)(ii):

(1) prior to any notice of the dispute, the Respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

(2) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;

(3) the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law. ”

18. While it is possible to make legitimate and fair use of names of well known individuals, including authors, and titles of literary works, this is not such a case and I accept the Complainant’s submission that the Respondent’s use makes a misrepresentation that the site is connected to the Complainant and is in some way “official.” Without disclaimer and using the first person singular to suggest that Mr. Christopher Tolkien has written the text; this is not fair or legitimate and is misleading and confusing. I do not find rights or legitimate interest.

19. As to bad faith, the Complainant relies primarily on §B11(f)(4):
“(4)the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent’s website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent.” I note that in the Response, the Respondent boasts of the Google ranking for the sites. I find bad faith made out.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the Complaint is Granted

the domain name SILMARILLION, THESILMARILLION be transferred to the Complainant

PANELISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2007-05-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant sought the transfer of the domain names silmarillion.eu and thesilmarillion.eu based on a Community Trade Mark and a national UK registered mark. The Complainant also relied on its unregistered mark based on the worldwide use of the name, the title of a famous literary work, the rights to which are administered by the Complainant. The Complaint alleged lack of rights or legitimate interest and bad faith on the basis that the Respondent was using the domain names to point to sites at which it was engaged in blatant copyright infringement by reproduction and making available the work. The Respondent was in default. The Complainant was granted.