

**DISPUTE RESOLUTION SERVICE**

**D00009579**

**Decision of Independent Expert**

**DC Comics/WB**

and

**Ms Lucie Riley**

**1. The Parties:**

Complainant: DC Comics

c/o Warner Bros. Entertainment Inc.  
4000 Warner Blvd.  
Burbank, CA 91522  
Los Angeles  
United States

Respondent: Ms Lucie Riley

Blackpool  
Lancashire  
FY2 0LH  
United Kingdom

**2. The Domain Name(s):**

batmanlive.co.uk

**3. Procedural History:**

14 February 2011 20:11 Dispute received  
16 February 2011 13:27 Complaint validated  
16 February 2011 13:31 Notification of complaint sent to parties

21 February 2011 09:52 Response received  
22 February 2011 14:31 Notification of response sent to parties  
28 February 2011 13:28 Reply received  
01 March 2011 09:43 Notification of reply sent to parties  
01 March 2011 09:44 Mediator appointed  
07 March 2011 16:49 Mediation started  
07 March 2011 16:52 Mediation failed  
07 March 2011 17:30 Close of mediation documents sent  
09 March 2011 11:11 Expert decision payment received  
15 March 2011 Expert Issues paragraph 13a Request for further statement  
17 March 2011 Complainant provides further statement

#### **4. Factual Background**

- 4.1 The Complainant is a partnership recognised under the law of New York<sup>1</sup>. It is well known in the United States and elsewhere as, inter alia, the publisher of comics featuring various “superhero” characters, one of whom is Batman. Batman first appeared in an issue of “Detective Comics” and later in his own solo title. Over 1,500 issues have been published under some form or other of the Batman name
- 4.2 The Complainant is the owner of various trade marks that comprise or incorporate the word “Batman”. These include:
- (i) Community trade mark no 2974673 for the word “Batman” in classes 3, 5, 6, 9,12 ,16, 18, 20,21, 24, 25, 27, 28, 29, 30, 32, 35, 36, 37, 38, 39, 41, 42 and 43 filed on 13 December 2002 and with a registration date of 12 April 2005; and
  - (ii) Community trade mark no 38125 in classes, 3, 9, 14, 16, 25, 28, 30, 32,and 41 filed on 1 April 1996 and with a registration date of 8 September 1998.
- 4.3 The Respondent is an individual from Blackpool. She registered the Domain Name on 20 April 2010. As at the 11 February 2011 the Domain Name was being used to display a website that appeared to promote the sale of tickets to “Spider-Man, Turn off the Dark”, a musical in previews on Broadway.
- 4.4 As at the date of this decision, this website no longer appears at the Domain Name. Instead, a single page is displayed that displays the text “Unknown error”

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<sup>1</sup> This was not clear from the Complaint as filed, which simply referred to “DC Comics” without further explanation. However, in a further statement filed on 17 March 2010 in response to a request issued under paragraph 13(a) of the DRS Procedure, the Complainant confirmed its formal legal status, provided further evidence in relation to its ownership of the marks and corrected one of the factual assertions made in the initial Complaint.

## 5. Parties' Contentions

### Complaint

- 5.1 The Complainant claims that on 26 August 2010 various news outlets reported that the Complainant was in talks to develop the character of Batman into a live stage production tentatively called "Batman Live". However, the evidence exhibited to the Complaint (and the Complainants further allegations about timing of the registration) suggest that the reference in the Complaint to "26 August 2010" is in error and it intended to allege that these press reports were on 26 April 2010.
- 5.2 The Complainant refers to its registered trade marks and cites various cases, some of which were decided under the UDRP, which are said to be authority for the proposition that "[t]he primacy of Trademarks over infringing domain names has been routinely asserted, recognised and enforced".
- 5.3 It claims that the Domain Name is "practically identical, and at the very least similar" to its trade marks. It refers to *Travellers Exchange Corp. Ltd v. New DRS 08756* and *Hal Beheer BV v. Ian Walmsley t/a First Hosting DRS 03911*. It claims that as a result, "the test for confusing similarity is met".
- 5.4 On the issue of abusive registration, the Complainant asserts that the web page displayed from the Domain Name involved the Respondent using the Domain Name to offer competing services in the same class of goods and services "to which the Complainant offers worldwide renown". This is said to fall with Section 3(a)(i)C of the DRS Policy. Further, it contends that the registration "also confuses consumers into believing the Domain Name is operated and authorised by the Complainant" and that this is "in violation of DRS Policy Section 3(a)(ii)".
- 5.5 Further, the Complainant contends that the "Respondent's election to register the Domain Name with absolutely no contact information evidence an abusive registration". This appears to be a reference to the fact that the Respondent elected for the non-trading individual or consumer opt-out provided for by the Nominet Terms and Conditions of Domain Name Registration.
- 5.6 The Complainant claims that the Domain Name was registered a mere two days after it was reported that Complainant was considering a live Batman stage show, which is said further to evidence abusive registration.
- 5.7 The Complainant further contends that the Respondent "breached her registration agreement with her registrar ... by using the registrar's services to commit, aid or abet [a] violation or infringement of copyright, trade mark, patent, design or database right of other intellectual property right" and refers in this respect to paragraph 7 of the Acceptable Use Policy of Namesco, the registrar through which the Respondent registered the Domain Name.

- 5.8 Lastly, the Complainant claims that the fame of its trade marks is such that the Respondent “undoubtedly possessed actual knowledge of [its trade marks] prior to registration”.

#### Response

- 5.9 The Response is very short and it is convenient merely to reproduce the substantive part of that document in full. It reads as follows:

“I did register the domain at the given date to start a small fan based event on the web for the new Batman Live show, it is correct [I] had heard about the show via various websites.

While the show is not yet available in the UK [I] did forward to the website shown in the exhibit for other comic fans to look at what was happening with the Spiderman show in America, just like Batman this other comic based show looked just as interesting as Batman and was currently performing at the time of forward.

I'm bitterly disappointed that DC Comics wishes to take this action. This is perhaps another barbaric action of huge corporate companies that try to squash individual web users.

As DC Comics has shown they own batmanlive.com why if batmanlive.co.uk is so important to them, didn't they register it at the same time?”

#### Reply

- 5.10 In its Reply the Complainant asserts that the “Respondent’s unsubstantiated claims that she intends to use the Domain Name for a fan site devoted to [the] Complainant’s stage show cannot overcome the ample evidence of her abusive registration”. Reference is made in this respect to the decision in *Stoneygate 48 Limited, et al v Marshall* DRS3844.
- 5.11 The Complainant also contends that the Respondent reference to the fact that the Complainant did not choose to register the Domain Name “lacks merit”. The Complainant cites *Ryanair Limited v Coulston* DRS 3655.

## **6. Discussions and Findings**

#### General

- 6.1 To succeed under the Policy, the Complainant must prove first, that it has Rights in respect of a “name or mark” that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the

Expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

*"Abusive Registration means 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."*

### Complainants' Rights

6.3 I accept that the Complainant owns a number of word marks for BATMAN including two Community Trade Marks. The most sensible readings of the Domain Name are as the words "Bat" "Man" and "Live" in combination, or as the words "Batman" and "Live" in combination, in each case together with "co.uk".

6.4 The test under the Policy is whether the relevant name or mark is identical or similar to the Domain Name. It is not one of confusing similarity as the Complainant at one point appears to suggest<sup>2</sup>. I am satisfied that there is sufficient similarity in this case where the third level of the Domain Name (i.e. the "batmanlive" element) can sensibly be read as the entirety of the Complainant's mark to which the word "live" has been added.

6.5 The Complainant has made out the requirements of paragraph 2(a)(i) of the Policy.

### Abusive Registration

6.6 There is only one fact in dispute in this case. The Respondent contends that the Domain Name was registered for the purposes of a fan site. The Complainant contends that the evidence of how the Domain Name has been used shows that this is not the case.

6.7 It is common ground between the parties that the Respondent registered the Domain Name with the intention of referring to the Complainant's comic character and thereby the Complainant's mark. There is also no dispute that at the time that the Domain Name was registered that the

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<sup>2</sup> The concept of confusing similarity is used under the UDRP and the word "confusing" was deliberately avoided by the framers of the Nominet Policy. However, whether this difference in wording makes any difference in practice is questionable. See for example, the analysis in *Research in Motion Limited v. One Star Global LLC* WIPO D2009-0227

Respondent was aware of the Complainant's plans to offer a stage show incorporating that character under the name "Batman Live".

- 6.8 Further, although not expressly admitted by the Respondent, there is no real dispute that the Respondent chose that name for the Domain Name with a view to drawing internet users to her website. The question is whether that registration and use was fair.
- 6.9 From the Response it would appear that the Respondent believes she has done nothing wrong in registering a domain name that the Complainant had chosen not to register. I am prepared to accept that the Respondent honestly believed that this was the case. Nevertheless, regardless of whether she had that belief, I have little doubt that the registration and use in this case was an abusive one as that term is understood under the Policy.
- 6.10 First, the Domain Name in this case was not actually used for a fan site. It was instead used to promote a different show involving a different comic character from a different comic book stable from that of the Complainant. The Respondent claims that this was because other comic fans could "look at what was happening with the Spiderman show in America". However, regardless of the Respondent's intentions, the page displayed was not commentary on that show but a page that appeared to promote the sale of tickets for that show. It cannot be "fair use" of a person's mark within paragraph 4(b) of the Policy to use that mark to pay tribute to a competing or unrelated business to that mark, even if the fans of the business using the mark may also be fans of that competing business.
- 6.11 Second, even if this Domain Name had been used for a genuine fan website, this is still likely to have been an abusive registration. The issue of when and what circumstances a trade mark can be legitimately used for a fan site was first addressed in some detail by the Appeal Panel in *Hanna-Barbera Productions, Inc -v- Graeme Hay* [2002] DRS 00389. The Appeal Panel held that the use of the domain name <scoobydoo.co.uk> was abusive. At the heart of the reasoning in this decision was the conclusion by the three person panel that the use of a domain name that was in that case essentially identical to that of the complainant, amounted to "impersonation" and that "impersonation can be rarely fair". The wording of the Policy was slightly different at the time of the *Hanna Barbera* decision, but the analysis in that case still holds good.
- 6.12 It also does not matter for this purpose that when an internet user reaches the website operating from the Domain Name it is clear that the website is unconnected with the trade mark owner. The initial interest confusion arising out of the Domain Name that draws the internet user to the website is sufficient. As is recorded at paragraph 3.3 of the DRS Experts' Overview:

"Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the

Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

(See also the decision in *Björn Borg Brands AB v T'imarco* DRS 6806 and the *Hanna Barbera* case supra).

- 6.13 In the present case, the addition of the words “live” to the mark BATMAN does not sufficiently distinguish the Domain Name from the mark so as to prevent such initial interest confusion. Indeed, the Respondent appears to have deliberately chosen the phrase “Batman Live” for the Domain Name, given that this was the exact term that it seemed likely that the Complainant would use for its show. This is a clear case of improper impersonation.
- 6.14 In the circumstances, the Complainant has made out the requirements of paragraph 2(a)(ii) of the Policy.
- 6.15 In coming to this conclusion in this case, I have been un-persuaded by the argument by the Complainant that there is also an abusive registration because there has been a breach by the Respondent of the intellectual property warranty contained in the registration agreement with her registrar. Similar arguments are often used with different degrees of success in UDRP proceedings<sup>3</sup>. Regardless of whether they are useful in that context, I believe it is a contention that is unhelpful under the Policy.
- 6.16 The reason is that whilst there is some overlap between the law of trade mark infringement and passing off and the tests to be satisfied in proceedings under the Policy, the two things are not the same. In the circumstances Appeal Panels have stated on a number of occasions that allegations of infringement and references to local law on the question of infringement are to be discouraged (see *Comité Interprofessionnel du Vin de Champagne v Steven Terence Jackson* DRS 4479 and *Seiko UK Limited v Designer Time/Wanderweb* DRS 248). Claiming that there has been a breach of an intellectual property warranty in a registrar contract essentially is just another way of arguing that there has been an abuse because there is infringement. It also seeks to elevate what is simply a protective measure for a registrar in a contract to level of importance on the question of abuse that it does not merit.

## **7. Decision**

- 7.1 I find that the Complainant has Rights in a trade mark, which is identical or similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name, <batmanlive.co.uk>, should be transferred to the Complainant.

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<sup>3</sup> In such cases the argument usually is that there has been a breach of paragraph 2 of the UDRP which is incorporated into the relevant registration agreement.

**Signed Matthew Harris**

**Dated 22 March 2011**