

## DISPUTE RESOLUTION SERVICE

D00009931

### Decision of Independent Expert

EMI Records Limited

and

Mr Philip Gahan

#### 1. The Parties:

Lead Complainant: EMI Records Limited  
27 Wrights Lane  
London  
W8 5SW  
United Kingdom

Respondent: Mr Philip Gahan  
Flat 5  
Deal  
CT14 7DX  
United Kingdom

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

bluenoterecords.co.uk (“the Domain Name”)

#### 3. Procedural History:

The Complaint was submitted to Nominet on 26 May 2011 and was validated and notified to the Respondent on the same date. The Respondent was informed in the notification that it had 15 working days, that is, until 17 June

2011 to file a response to the Complaint. On 27 May 2011 the Respondent filed a Response. On 31 May 2011 the Complainant filed a Reply to the Response. The case proceeded to the mediation stage. On 20 June 2011 Nominet notified the parties that mediation had been unsuccessful and invited the Complainant to pay the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy"). On 20 June 2011, the Complainant paid the fee for an expert decision. On 24 June 2011, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 24 June 2011.

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

Capitol Records LLC ("Capitol") and the Complainant are wholly owned subsidiaries of EMI Group Limited. Capitol is the owner of the record label and brand BLUE NOTE which has a history dating back to 1938. Capitol refers to the BLUE NOTE record label as "Blue Note Records". Capitol is the proprietor of numerous trade mark registrations for the word mark BLUE NOTE in countries from Afghanistan to Zimbabwe including United Kingdom registered trade mark number 900658 registered on 19 October 1966 in international class 9.

The Respondent is an individual based in Deal, Kent. The Respondent registered the Domain Name on 12 April 2010. At the time when the Complaint was filed, the website associated with the Domain Name offered music CDs, DVDs and books for sale via the affiliate programme provided by the retail website Amazon.co.uk. At the date of this Decision, the website associated with the Domain Name stated 'Domain For Sale' in prominent red letters and featured a Google Checkout payment link with the legend 'Buy Now'.

#### **5. Parties' Contentions**

##### **Complainant**

The Complainant asserts that Capitol has rights in a name which is identical or, in the alternative, is similar to the Domain Name. Capitol's trade mark is incorporated in the Domain Name.

The Complainant submits that the Respondent is using the Domain Name to profit from Capitol's reputation in its Blue Note label and notes that some of Capitol's Blue Note recordings are included on the Respondent's website but it also includes products with which there is no association with the Blue Note label including "Let Them Talk" (Warner Bros), "AC/DC Live At The River

Plate” (Sony BMG) and “Guitar For Dummies”. The Complainant states that all products on the Respondent’s website are displayed on pages headed “Blue Note Records” and that the site also includes a section on the history of Capitol’s Blue Note record label.

The Complainant states that the website associated with the Domain Name is affiliated to Amazon.co.uk which means that Amazon pays the Respondent a percentage of any qualifying sales made through the website. The Complainant notes that the Respondent advocates the Amazon affiliate scheme as a way to make money on the Respondent’s other website.

### **Respondent**

The Respondent is sorry and disappointed that the Complainant considers the Domain Name is abusive; it was not and never intended to be so. It was because of the Respondent’s high regard for this jazz genre that he set up the associated website. The Domain Name was registered over twelve months ago so the Respondent cannot understand why the Complainant has chosen to complain now. Regarding the statements on the Respondent’s other website the Respondent notes that there is nothing on that website about music, records or Blue Note.

The Respondent seeks “nothing less than £5,000” from the Complainant by way of reimbursement for “the initial loss of earnings and for the twelve months of work put into the website.”

### **Complainant’s reply to response**

The Complainant submits that the Respondent’s website and Domain Name first came to the Complainant’s attention on 24 May 2011 when a music industry colleague enquired whether the website was anything to do with the Blue Note label. The Complainant notes that the Complaint was filed on 26 May 2011.

The Complainant asserts that as the Respondent took it upon himself to register a domain name that clearly included the name of a famous jazz label of which he was already aware, then profited from the use of that name, it is the Respondent who should be reimbursing the Complainant. The Complainant states that the Respondent’s offer is therefore declined.

## **6. Discussions and Findings**

### **General**

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely that:

- (i) the Complainant 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**

Paragraph 1 of the Policy provides that Rights means "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

The first issue for the Expert here is the fact that the rights relied upon by the Complainant evidently do not belong to it but instead belong to a different company in its corporate group, namely Capitol. A number of decisions under the Policy have considered whether Rights which may technically be owned by a different company in the same corporate group are sufficient to allow a Complainant to assert 'Rights' for the purposes of the paragraph 2(a)(i) of the Policy. In *Seiko UK Limited -v- Designer Time/Wanderweb*, DRS 00248, the Appeal Panel held that: "The requirement to demonstrate 'rights' is not a particularly high threshold test. It is satisfied in our view by the assertion of Seiko UK Limited that it is duly authorised by the trade mark owner to use the mark and to bring the Complaint. Where a complainant is a subsidiary or associated company of the trade mark proprietor, such an assertion will in our view generally be sufficient to demonstrate 'rights' in the absence of any good reason to doubt the veracity of that assertion".

While *Seiko* was decided under a previous version of the Policy, the Rights element has not changed to any extent which would affect or alter this general proposition. Accordingly, the Expert will adopt this approach in the present case. However, complainants would do well to remember that the more reliable course of action is that set out in paragraph 1.1 of the DRS Experts' Overview which deals with the question as follows:

**(a) "Who should the Complainant be? (b) When is it necessary or appropriate for there to be more than one Complainant?"**

(a) The Complainant should be the owner/licensee of the Rights in the name or mark, which the Complainant contends is identical or similar to the domain name in dispute. Surprisingly often, complaints under the DRS Policy ("the Policy") are lodged in the names of persons and entities not demonstrably the proprietor of the relevant Rights.

(b) For example, when the Rights relied upon are owned or shared by one entity but used by a group or associate company whose business is disrupted or confusingly connected with the Respondent. Another example could be in circumstances where the Rights relied on have been licensed and, depending on the facts, it may be desirable for both the Licensor and Licensee to be Complainants. If more than one Complainant is named, it is important that the Complaint nominates one of them as the transferee of the domain name in the event that the Complaint succeeds.”

In the present case, applying the *Seiko* approach, the Expert has no reason to doubt the veracity of the Complainant’s assertion that it is part of the same corporate group as Capitol and by implication that it is duly authorised by Capitol to use the mark and to bring the Complaint. Furthermore the Respondent has not taken issue with the Complainant’s submissions on this point. It is clear to the Expert that Capitol, being an associated company of the Complainant, has extensive rights in registered trade marks in the words BLUE NOTE covering a wide variety of jurisdictions including the registered trade mark noted in the Factual Background section above. As such, the Expert finds that the Complainant has Rights in this name.

Clearly the term BLUE NOTE is not identical to the Respondent’s Domain Name but is it similar? For the purposes of comparison, the first (.uk) and second (.co) levels of the Domain Name are disregarded as being wholly generic. Likewise, white space in the Complainant’s mark is not of any significance as it is not permissible to have spaces in a domain name. Accordingly, the only difference between the name or mark BLUE NOTE and the Domain Name is the addition of the generic word “records” in the latter. In the Expert’s opinion, this word does nothing to distinguish the Domain Name from the trade mark, not only because it is generic but also because the trade mark relates to a recording company/record label and the term “records” is frequently applied to those organisations (including, it would appear, by Capitol itself in describing the history of the Blue Note record label). As such, in the Expert’s view, the additional word tends to strengthen the association between the Domain Name and the trade mark.

In these circumstances, the Expert finds that the Complainant has proved to the satisfaction of the Expert that it has Rights in a name or mark which is similar to the Domain Name.

### **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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

As noted in the Factual Background section, the Respondent has changed the use of the website associated with the Domain Name. It now states prominently that the Domain Name is for sale. No asking price is provided. This change appears to be connected with the Respondent's proposal in the Response that the Complainant may wish to purchase the Domain Name for "nothing less than £5,000". The Expert notes that the Complainant has declined this proposal. Nevertheless, the Expert does not understand the Complainant to be relying on the offer for sale as part of its case that the Domain Name is an Abusive Registration. The Complainant's submissions instead focus on the previous use to which the Domain Name was put by the Respondent, namely the operation of a retail website selling music CDs and the like, some of which related to Capitol's BLUE NOTE catalogue of recordings but others of which related to the catalogue of some of Capitol's competitors.

In the Expert's opinion, the Complainant's submissions and evidence make a strong case that the Respondent has used the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant, as contemplated by paragraph 3(a)(ii) of the Policy and thus that the Domain Name is an Abusive Registration. Clearly a website retailing music products under the name "Blue Note Records" is highly likely to be confused with the BLUE NOTE record label which has a long history and is well known among aficionados of jazz music. The Respondent has however intensified the potential for confusion still further by providing a section on the history of the record label thus inevitably and perhaps deliberately creating the appearance of a close association between the record label and the website.

The Respondent states that he has had no abusive intent and that he registered the Domain Name because of his "personal high regard for this jazz genre". The Respondent also focuses on the fact that the Domain Name was registered for over a year before the Complaint was filed and that there is nothing on the Respondent's personal website relating to music, records or BLUE NOTE. In the Expert's view none of these submissions support a finding that the Domain Name is not an Abusive Registration.

The Respondent's motivation for registering the Domain Name may have been entirely based upon his high regard for the jazz genre but this does not alter the fact that the Domain Name has been used in a manner which points in the direction of Abusive Registration as noted above. The Respondent's submission would perhaps make more sense if there was evidence that the

website associated with the Domain Name had been operated solely in tribute to the BLUE NOTE record label but this is not the case here and, on the contrary, the Respondent's site appears to have been entirely devoted to a commercial purpose predicated on and profiting from confusion with Capitol's trade mark.

With regard to the Respondent's submission that he used the Domain Name for twelve months prior to the filing of the Complaint, there is nothing in the Policy which excuses an abusive use simply because it has taken place over any particular period of time. The Policy contains no limitation period. Finally, while the Expert agrees with the Respondent that his personal site does not mention anything about music, records or BLUE NOTE, the Expert also accepts the Complainant's submission that it does provide some insight into the Respondent's use of the Domain Name in that the website describes how to make "easy money" using Amazon and eBay affiliate programmes. While the use of a website to provide an affiliate store is not abusive in itself, in the Expert's opinion the manner in which the Respondent used such a site, creating confusion with Capitol's BLUE NOTE record label, took unfair advantage of the Complainant's Rights and thus constitutes an Abusive Registration in terms of the Policy.

## **7. Decision**

The Expert finds that the Complainant has proved that it has Rights in 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 therefore directs that the Domain Name be transferred to the Complainant.

**Signed** .....  
Andrew D S Lothian

**Dated** 4 July, 2011 .....