

DISPUTE RESOLUTION SERVICE

D00016416

Decision of Appeal Panel

World Wrestling Entertainment, Inc.

and

Daniel Raad

1. The Parties:

Complainant: World Wrestling Entertainment, Inc.
1241 East Main Street
Stamford
Connecticut
06902
United States

Respondent: Daniel Raad
6 Brinkley Road
Surrey
Surrey
KT4 8JF
United Kingdom

2. The Domain Name(s):

wwe-shop.co.uk (the "Domain Name")

3. Procedural History

On 18 August 2015 Nominet received the Complaint. The following day the Complaint was validated and the Respondent was notified both by email to postmaster @wwe-shop.co.uk and two other email addresses for the Respondent and by special delivery post. The special delivery post notification was returned to Nominet on 16 September 2015 marked "addressee unknown" and the email sent

to the postmaster address failed. The Panel notes that the Respondent's postal address does not include a place name after the name of the road and that instead it appears as "Surrey Surrey". Nominet has confirmed to the Panel that this is how the address details were completed by the Respondent when the Domain Name was registered.

In accordance with its usual practice Nominet conducted all subsequent correspondence by email. The emails sent to the postmaster address failed but there was no indication that emails sent to the other two email addresses were undelivered. The Panel is satisfied that Nominet properly notified the Respondent at each stage in accordance with version 3 of Nominet's *Dispute Resolution Service Procedure* ("the Procedure"). It is the responsibility of registrants to ensure that they provide accurate contact details and that they keep them up to date.

On 8 September 2015 Nominet sent to the Respondent a reminder that it was awaiting his response. On 11 September 2015, no response having been received, both parties were informed that the case would be treated as a no-response case, which meant that the Complainant could choose to request a summary decision in accordance with paragraph 5 d. of the Procedure. On 18 September 2015 Nominet received the Complainant's payment for a summary decision.

On 23 September 2015 the appointed Expert delivered his summary decision and Nominet notified both parties. In his summary decision the Expert said that he was satisfied that the Complainant had shown Rights in respect of a name or mark which was identical or similar to the Domain Name but he was not satisfied that the Domain Name was an abusive registration. The summary decision included the following comments made by the Expert:

"Internet users could reasonably understand the domain name to refer to an outlet selling the Complainant's branded merchandise, not necessarily an outlet belonging to or authorised by the Complainant. Such merchandise could have been lawfully obtained by the Respondent, for example from a licensee of the Complainant, yet neither the Complaint nor the Witness Statement provide for any evidence in support of the Complainant's assertion that the Respondent's website offers counterfeit products.

Given the date of the domain name registration and the use to which it has been put, none of the other claimed grounds for a finding of abusive registration are established."

On 7 October 2015 the Complainant gave notice of intent to appeal against the summary decision and Nominet notified the Respondent. On 28 October 2015 the appeal decision payment was received and the following day the Complainant submitted its Appeal Notice. This notice was accompanied by additional evidence (see below) Nominet notified the Respondent and informed him that he had until 12 November 2015 to respond. No Response was received.

On 16 November 2015 Nick Gardner was appointed as chair of the Appeal Panel with Claire Milne and David King as co-panellists.

Each of Nick Gardner, Claire Milne and David King (the undersigned “the Panel”) has individually confirmed to Nominet that:

“I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties”.

This is an Appeal against a summary decision at first instance in favour of the Respondent. The Panel for this case was appointed to provide a decision on or before 6 January 2016. This process is governed by version 3 of the Procedure and this decision is made in accordance with version 3 of Nominet’s *Dispute Resolution Service Policy* (“the Policy”). Both of these documents are available for inspection on the Nominet website (<http://www.nominet.uk/disputes/drs>).

4. The Nature of This Appeal

Paragraph 10.a. of the Policy provides that: *“The appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters”*. The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits.

For convenience the Panel will continue to refer to the parties as the “Complainant” and “Respondent”.

5. Formal and Procedural Issues

The Complainant has sought to introduce further evidence in the course of the appeal process. This evidence is said to establish that the material offered for sale by the Respondent is fake, in the sense of not being produced by the Complainant or its authorised suppliers. The general rule under the Procedure is very clear: no new evidence on appeal. Paragraph 18c of the Procedure states (with emphasis added) *“An appeal notice should not exceed 1000 words, should set out detailed grounds and reasons for the appeal, but shall contain **no new evidence or annexes**”* and paragraph 18f states (with emphasis added) *“An appeal notice response must not exceed 1000 words, should set out detailed grounds and reasons why the appeal should be rejected but should contain **no new evidence or annexes**”*. This is the general rule, subject to the limited exception set out in paragraph 18h of the Procedure: *“The appeal panel should not normally take into consideration any new evidence presented in an appeal notice or appeal notice response, unless they believe that it is in the interests of justice to do so.”* The Complainant says that the evidence in question is not new as the authenticity of the Respondent’s goods was in issue previously, or if it is new evidence it should in the interests of justice be admitted. The Complainant says this is the case because the Respondent’s activities in selling fake merchandise constitute a criminal offence and should not be allowed to continue.

The Panel considers that the material which has been introduced into the appeal (specifically a witness statement from a Mr Winterroth, whose title is Senior Director, Intellectual Property, of the Complainant) must by definition be “new evidence” within the meaning of paragraph 8f, as it was not before the Expert. In these circumstances the Panel will proceed to decide upon the admissibility of this material (if necessary) by approaching the determination of this appeal as follows:

- i. Should the Appeal be allowed taking into account only the material that was before the Expert? If yes, then questions (ii) and (iii) are redundant and do not need to be considered.
- ii. If however the Appeal is not allowed taking into account only the material that was before the Expert, should the additional material filed on appeal be admitted pursuant to the provisions of paragraph 18f of the Procedure? If the answer to paragraph (i) is in the negative, and the additional material is not admitted then the Appeal must inevitably fail.
- iii. If however the additional material on appeal is admitted does the Appeal then succeed?

The Panel also notes that the Complainant says that because no response was filed then “*under accepted principles it is submitted that the absence of a response from the*

Respondent amounts to an admission of the Complainant’s submissions”. That is not correct. Material promulgated by Nominet explaining the Policy and the Procedure includes the “Experts’ Overview”, a paper the purpose of which is, as it states, “*to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet’s panel of independent adjudicators, have dealt with those issues to date*”. Further reference is made below to various matters where the Experts’ Overview provides relevant guidance. For present purposes paragraph 5.67 is relevant:

“If the Respondent fails to respond to the complaint, is it inevitable that the complaint will succeed?”

No. Whether the Complainant seeks a full decision or a summary decision, it is still necessary for the Expert to be satisfied that the elements necessary to make a finding of Abusive Registration are present. See, for example, the decision in DRS 04635 (martinyale.co.uk), a case where, in spite of the lack of a response, the Complainant failed to establish Abusive Registration to the satisfaction of the Expert. The case was decided under the previous version of the Policy, but the essential criteria remain the same.”

The Panel agrees with this explanation. More generally in the absence of a Response a Panel is likely to regard facts asserted by the Complainant as established, unless it regards them as inherently unlikely or not credible, but will still reach its own conclusions as to the relevant reasoning to be applied to the decision, and not simply accept the Complainant’s submissions in this regard. In the present case the Panel accepts the facts asserted by the Complainant as set out below as being true, and then proceeds to apply the Policy to those facts.

6. The Facts

The Complainant, World Wrestling Entertainment Inc (“WWE”), is a large media entertainment concern with its roots in wrestling. It is based in the USA but now markets media services and associated merchandise worldwide. Its services are often programmes featuring personalities known as “Superstars” and “Divas”, while the merchandise targets fans of these personalities, through T shirts and similar products bearing the personalities’ names and emblems. WWE’s intellectual property is protected by a global portfolio of trade marks, including for example Community Trade Mark Number 2734293 registered on 11 June 2002 in respect of the term WWE. These trade marks are referred to below as the WWE trade marks. The Complainant has registered many domain names throughout the world including the string “wwe”, among them wweshop.com and wweshop.co.uk. The Complainant also has a registered trade mark for the term WWESHOP (US Trade Mark Registration No. 3581284).

The Respondent, Daniel Raad, registered the Domain Name on 12 May 2012. At the time of the Complaint, the Domain Name led to a website selling merchandise which appeared similar to that sold by the Complainant. This website also featured a logo which was similar to the Complainant’s logo. At the time of the Appeal, the Domain Name no longer led to any website.

7. The Parties’ Contentions

In support of Rights in the name, the Complainant points to its rights in the mark “WWE” and the lack of distinctiveness of the addition “shop”.

As to Abusive Registration, the Complainant argues on multiple grounds, in brief:

The Respondent registered the Domain Name primarily in order to sell it for a high price (probably to the Complainant or a competitor of the Complainant).

The Respondent registered the Domain Name primarily as a blocking registration, to prevent the Complainant from registering it.

The Respondent registered the Domain Name primarily to disrupt the business of the Complainant.

The Respondent has used the Domain Name in ways which are likely to lead the public to assume that it is authorised by or connected with the Complainant. In fact, the Respondent has no authorisation from or connection with the Complainant.

The Complaint includes Attachments documenting the Complainant’s trade mark registrations and both its own and the Respondent’s websites, as well as a Witness Statement by the Complainant’s lawyer.

At the Appeal stage, the Complainant stressed a point which was touched on without evidence in the Complaint, namely that the merchandise offered by the

Respondent is counterfeit, and provided additional evidence to document this claim. It asked that this should not be regarded as new evidence (which is not generally permitted in Appeals as explained in Section 5 above) in the interests of natural justice.

The Respondent has not responded to either the initial Complaint or the subsequent Appeal.

8. Discussion and Findings

General

In order to succeed the Complainant must prove, on the balance of probabilities, in relation to the Domain Name, two matters, 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.

First Element – Rights

“Rights” are defined in the Nominet DRS Policy as follows:

“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 Complainant has established it has rights in the terms “wwe” and “wweshop”. The Domain Name is similar to the term wwe, the difference being the addition of a hyphen and the generic word “shop”, which do not in the Panel’s view suffice to distinguish it. Apart from the hyphen, which the Panel does not see as significant in this context, the Domain Name is identical to the term wweshop. It is well established that the .co.uk suffix is to be ignored for the purposes of this assessment. Accordingly the Complainant has established the first element it needs to show.

Second Element – Abusive Registration

Abusive Registration is defined in the Nominet DRS Policy as follows.

“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”

The Panel has no doubt, given the evidence that was before the Expert, that the Domain Name was registered by the Respondent because of its association with the Complainant. It is used (on the evidence that was before the Expert) to advertise and sell a range of WWE related merchandise such as, for example T shirts featuring names and emblems associated with personalities who are promoted by the Complainant. The website in question is effectively an online shop and there is no obvious notification, branding or content which would indicate to visitors that it is unconnected with the Complainant. To the contrary its look and feel broadly replicates that of the Complainant's own website, which was no doubt a deliberate strategy adopted by the Respondent. The Respondent has not been authorised or licensed by the Complainant to carry out this activity. The question is therefore straightforward – to what extent may an unauthorised trader in the goods or services of another person incorporate that other person's name or trade mark in its domain name without that domain name constituting an Abusive Registration?

Not surprisingly this is a question which has arisen on many occasions before in DRS proceedings, including in a number of Appeal cases (see below). The Panel is not bound by these previous cases by any system of strict precedent but believes they should be taken into account, especially where considered reasoning has been applied to the same issue on a previous occasion. As the introduction to the Experts' Overview states: *"While there is no system of precedent under the DRS Policy, for the DRS Policy to be effective there has to be a measure of consistency in the decisions and the panel of Experts does its best in that regard, although, as will be seen below, there are a few areas where differing views prevail. If anyone involved in a dispute under the DRS Policy proposes to rely upon the rationale of any previous DRS decision, the more recent decisions (whether at first instance or appeal level) are more likely to represent current thinking"*. In the present case the Panel finds the previous cases identified below as helpful and directly relevant.

As a starting point simply using the name of another trader is likely to be objectionable. See the Appeal decision in GuideStar UK -v- Wilmington Business Information Limited (DRS 02193) in which the Panel stated:

"Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is".

The reason this is objectionable, so far as the Policy is concerned, is that it is likely to fall within Paragraph 3.a. of the DRS Policy which sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 3.a.ii provides:

"Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or 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;"

It has also been generally accepted that where the Domain Name in question is in substance an unadorned reproduction of a Complainant's trade mark (or a minor variant thereof) without any additional modifying terms, that will suffice to establish such confusion, even if a visitor to the website linked to the Domain Name would realise once they got there that the site itself was nothing to do with the Complainant. See, for example, *Urban Outfitters, Inc. v Lim Chu Ltd* (DRS 10987) concerning numerous domain names that comprised minor typographic variations of <urbanoutfitters.co.uk>.

However the use of an "unadorned" name or trade mark as a domain name as occurred in the above cases is to be contrasted with the situation where a name or trade mark in combination with a modifying term is used – as in the present case (in relation to the Complainant's WWE trade marks).

In the very first Appeal case dealt with by Nominet's DRS procedure - *Seiko UK Limited v Designer Time/Wanderweb* (DRS 00248) (the "Seiko case") one of the central issues concerned the use by a trader of trade marks modified with the addition of the word "shop". The domain names in issue were <seiko-shop.co.uk> and <spoonwatchshop.co.uk> and although under a previous version of the Policy the case is clearly directly relevant to the present case. In the Seiko case the Panel said as follows:

"There are many different traders who may wish to make use of the trade mark of a third party e.g. the proprietor's licensee (exclusive or non-exclusive), a distributor of the proprietor's goods (authorised, unauthorised or 'grey market'), the proprietor's franchisee, or the proprietor's competitor engaged in comparative advertising. There are an infinite array of different factual circumstances which could arise under each of these categories. Accordingly, we are not able to – and we are not going to attempt to – lay down any general rules governing when a third party can make 'legitimate' use of the trade mark of a third party as a domain name. All we can do is decide whether the Expert came to the right conclusion on the evidence and submissions before him. Essentially Seiko's complaint is that Wanderweb's registration of the Domain Names has gone beyond making the representation "we are a shop selling Seiko / Spoon watches" and is instead making the representation(s) "we are The Seiko/Spoon watch Shop" or "we are the official UK Seiko/Spoon watch shop". The latter form of representation is what we understand the ECJ to be referring to when, in the ECJ case C-63/97 BMW v. Deenik, it speaks of creating "the impression that there is a commercial connection between the other undertaking and the trade mark proprietor". An example of a domain name which, in the opinion of some members of the Panel, would make the former but not the latter representation was given by the Expert in paragraph 7.28 of the Decision: "we-sell-seiko-watches.co.uk".

The Panel agrees that if there is support in the evidence for the suggestion that the Domain Names make, or are liable to be perceived as making, the latter representation (i.e. that there is something approved or official about their website), this would constitute unfair advantage being taken by Wanderweb or unfair detriment caused to Seiko. The Panel takes the view that in the light of the evidence before the Expert and in the light of the submissions before him and on appeal, it is just as unfair for Wanderweb to appropriate Seiko's trade marks as a domain name."

Following on from the Seiko case a subsequent Appeal Panel in Toshiba Corporation and Power Battery Inc. (DRS 07991), an appeal decision concerning the domain name <toshiba-laptop-battery.co.uk>, considered the principles applicable to these types of case in more general terms. The Panel stated:

“The view of the majority of the Panel is that the Complainant has not demonstrated, on the balance of probabilities, that the Respondent’s use of the Domain Name would be likely to give rise to any such confusion. The majority panellists do not consider that either the Domain Name itself or the results of a search of the terms in question would be likely to result in any such confusion in the mind of the average Internet user, bearing in mind that a typical search page includes a short description of each “hit” as well as the actual domain name. So far as the name itself is concerned, the majority Panel believes that the Domain Name in this case falls into a very different category from cases involving the “unadorned” use of a trade mark (e.g. <toshiba.co.uk>), where Internet users may be presumed to believe that the name belongs to or is authorised by the complainant. In this case, two extra hyphenated words turn the domain name as a whole into a rather clear description of the main goods on offer at the website (replacement batteries for Toshiba laptop computers). In addition, this lengthy “adornment” may reasonably be seen as atypical of the usage of major rights owners, who are free to use much shorter unadorned names.”

In the toshiba-laptop-battery.co.uk appeal four criteria were identified as being relevant to the determination of whether a reseller’s use of a domain name incorporating a complainant’s trade mark/name is abusive, as follows:

1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent’s use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of “initial interest confusion”¹ and is not dictated only by the content of the website.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller’s incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent’s website.

When addressing whether it would be fair to offer competing goods, the Panel said the following:

“The further issue, however, is whether the fact of the offering of competitive products on the Respondent’s website is sufficient to render the registration abusive, even in the absence of “initial interest confusion”. On this question, the Panel unanimously considers that, if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner’s consent, to accord

¹ For further consideration of “initial interest confusion” see the Appeal Panel decision in Lucasfilm Ltd., LLC and ABSCISSA.COM Limited (DRS 15788).

with the principles stated above that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated."

It seems to the present Panel that the extent to which the incorporation of a modifying term into a domain name will result in the domain name not being confusing within the meaning of Paragraph 3.a.ii of the Policy depends upon the facts of a given case. The Panel does not think it is sensible to try to lay down rigid general rules directed at specific words or terms as cases will depend upon their own facts. However as a matter of broad principle, the Panel considers the position to be as follows in relation to cases where the complaint concerns a domain name where the alleged abuse is said to arise in respect of a website which is used to sell only the genuine goods or services of the complainant.

If:

1. a website is linked to a domain name; and
2. the website is used to sell only the genuine goods or services of a third party; and
3. the third party alleges the domain name is an Abusive Registration; and
4. the third party has relevant Rights in respect of a name or trade mark.

Then:

5. use of the name or trade mark concerned in unadorned form as a domain name is likely to amount to an Abusive Registration.
6. Use of the name or trade mark concerned is also likely to amount to an Abusive Registration if the name or trade mark is combined with a term or terms that results in a domain name which would readily be considered to be that of the owner of the name or trade mark concerned.
7. Such use is less likely to amount to an Abusive Registration if the name or trade mark concerned is combined with a term or terms that results in a domain name which would not readily be considered to be that of the owner of the name or trade mark concerned.

In stating these principles the Panel would add as follows:

8. These are not absolute rules, hence the use of the terms "likely" and "less likely" – all relevant circumstances need to be taken into account and other factors may be relevant and result in a different conclusion being reached. As well as the modifying term itself such factors could include for example: the strength or fame of the name or trade mark in question; the nature and price of the goods or services being offered; the sophistication or otherwise

of the likely consumers of such goods or services; questions of licence or permission; and any relevant contractual arrangements between the parties. Further factors such as the nature, appearance and content of the website to which the domain name is linked, and the extent to which any disclaimers are used on that website, may also be relevant in a given case if it appears appropriate to consider the case on the basis of matters beyond initial interest confusion.

9. As stated above these principles apply where the website in question is selling only the goods or services of the owner of the name or trade mark concerned. If competing or counterfeit products are also or alternatively being sold then still further considerations may apply and a given domain name which would not amount to an Abusive Registration in accordance with these principles may nevertheless be found to be so when such additional considerations are taken into account.

It follows that in any given case the exact point at which a given domain name can be considered to be unobjectionable will depend upon all the facts, including of course the modifying term used. In the Seiko case (above) the Panel thought that “shop” fell the wrong side of the line. In the present case the Panel also considers “shop” to be the wrong side of the line. There is no evidence before the Panel that the letters “wwe” have any other meaning apart from in relation to the Complainant, and they have clearly been adopted by the Respondent, in combination with the term “shop” because of that meaning. The term “shop” itself is simply a very general term suggesting a retail operation – such a term might well be adopted by a trade mark owner to designate a web site which makes available its products for sale and in the opinion of the Panel the domain name wweshop.co.uk might reasonably be thought to be that of the Complainant, particularly when the Complainant operates substantially the same type of on-line retail business itself. The Respondent was no doubt hoping to attract potential customers for products relating to the business the Complainant conducts by using a domain name which, in the opinion of the Panel, would reasonably be considered by those potential customers to be that of the Complainant. That amounts to an Abusive Registration. The Panel reaches this conclusion in relation to the WWE trade marks. The conclusion is further reinforced in that the Complainant also has a trade mark for the term “wweshop” and websites connected to the domain names wweshop.com and wweshop.co.uk - and the Respondent has in substance appropriated that trade mark in its entirety and in that regard at least is simply using an unadorned form of the Complainant’s trade mark (the additional hyphen being a trivial difference).

The Panel reaches the conclusion that the Domain Name is an Abusive Registration on the basis of the original Complaint and the evidence that was filed with it. Accordingly (see section 5 above) the Panel does not need to consider further issues as to the admissibility of the additional material filed by the Complainant at Appeal.

9. Decision

The Appeal is allowed and the Panel directs that the domain name <wwe-shop.co.uk> be transferred to the Complainant.

Signed Nick Gardner David King Claire Milne

Dated 15 December 2015