

# Nominet UK Dispute Resolution Service

**DRS 5222**

## Jagex Limited v. Koen van de Bogaard

### Decision of Independent Expert

#### 1. Parties

Complainant: Jagex Limited  
Address: Saint Andrews House  
90 Saint Andrew's Road  
Cambridge  
Cambridgeshire  
Postcode: CB4 1DL  
Country: GB

Respondent: Koen van de Bogaard  
Address: Molenweg 67  
Ewijk  
Postcode: 6644AZ  
Country: NL

#### 2. Domain Name

jagex.org.uk ("the Domain Name")

#### 3. Procedural Background

The Complaint was submitted to Nominet on 12 November 2007. Hardcopies were received in full on the same date and on 13 November 2007 the Complaint was validated by Nominet and sent to the Respondent by post and by email to postmaster@[the Domain Name]. The Respondent was informed in this correspondence that he had 15 working days, that is, until 5 December 2007 to file a response to the Complaint. Nominet's letter to the Respondent was returned by the Netherlands postal service marked "addressee unknown" and "street/number does not exist".

The Respondent did not file a response and the case did not proceed to the mediation stage. On 6 December 2007, the Complainant paid the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Procedure for the conduct of proceedings under the Dispute Resolution Service Version 2 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 2 ("the Policy"). On 7 December 2007, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he

knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality. Nominet duly appointed the Expert with effect from 13 December 2007.

#### **4. Outstanding Formal/Procedural Issues**

##### **No response**

The Respondent has failed to submit a response to Nominet in time in accordance with paragraph 5(a) of the Procedure.

Paragraph 15(b) of the Procedure provides inter alia that "If, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint."

Paragraph 15(c) of the Procedure provides that "If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate."

In the view of the Expert, if the Respondent does not submit a Response the principal inference that can be drawn is that the Respondent has simply not availed himself of the opportunity to attempt to demonstrate that the Domain Name is not an Abusive Registration. This does not affect the primary requirement upon the Complainant, on whom the burden of proof rests, to demonstrate Abusive Registration, nor does it in the Expert's view entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit.

#### **5. The Facts**

The Complainant was incorporated on 28 April 2000 and has since 2001 carried on business of designing, developing and operating online computer games. The Complainant's most well known product is a game known as "RuneScape". The Complainant acquired the goodwill in the name "Jagex" in 2001 (its predecessor in title having traded under the name from 1999) and has since provided services from <jagex.com> including access to its various games. The name "Jagex" is a made-up name.

The Complainant is the proprietor of the following registered trade marks:-

<b>Number</b>	<b>Trade mark</b>	<b>Classes</b>	<b>Filing Date</b>	<b>Registration Date</b>
GB 2302759	JAGEX (Word)	9, 41, 42	13 June 2002	8 November 2002
CTM E2943884	JAGEX (Word)	9, 41, 42	25 November 2002	31 January 2005
US 2860020	JAGEX (Word)	9, 41, 42	27 November 2002	6 July 2004

At June 2006, there were some 4.6 million active registered RuneScape players (those who logged in within the previous two weeks) and some 742,000 RuneScape subscribers (players who pay a monthly fee entitling them to access additional features) worldwide including in the United Kingdom, United States, Canada, China, Australia and New Zealand. The Complainant's turnover over the period 2002 to 2006 was approximately £25 million.

The Respondent registered the Domain Name on 14 June 2006 and elected to opt-out of the whois service as a "non-trading individual".

On 17 October 2006, the Domain Name pointed to the Complainant's website (or reproduced its content) but also displayed advertisements (in Dutch) that were not part of the Complainant's site.

On 28 March 2007, having requested Nominet to release the details of the Respondent, the Complainant's solicitor sent a formal letter to the physical address of the Respondent by recorded delivery. The letter was returned as undeliverable on the basis that the addressee was unknown and that the address did not exist.

As at the date of this Decision, the Domain Name was pointing to a registrar's parking page.

## **6. The Parties' Contentions**

### Complainant

In summary, the Complainant's contentions are as follows:-

#### *Rights*

The Complainant relies on its registered trade marks. The Complainant also relies on common law rights. By virtue of its extensive trading and marketing activities, the Complainant has acquired substantial reputation and goodwill in the name JAGEX such that it is recognised by the public as distinctive of the Complainant and its business. The Complainant has a very high internet profile; a Google search dated 26 July 2006 shows 663,000 references to "Jagex". "Jagex" is a made-up name referable only to the Complainant and all top ten Google results relate to the Complainant.

All RuneScape players will be aware of the Complainant. There are many references to the Complainant on <runescape.com>. All players have to agree to the Complainant's terms and conditions when registering and all customer support email communications are from "@jagex.com" email addresses. The Complainant has generated extensive worldwide press coverage in national and other media. The Complainant's registered trade mark and common law rights in the name JAGEX have been accepted in various UDRP cases.

The Respondent clearly set out to attract business intended for the Complainant. Such activity by the Respondent presupposes that the Complainant's business was known and identified by its name.

"Jagex" is not descriptive of the Complainant's business. It consists of a distinctive and non-obvious combination of the words. The Domain Name is identical to the Complainant's JAGEX trade mark, disregarding the domain suffix.

The Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its trade marks.

#### *Abusive Registration*

The Respondent intended, inter alia, to prevent the Complainant from reflecting its trade mark in the Domain Name and was aware of the Complainant and its business when it registered the Domain Name. The Respondent must also have known that the Complainant would have wanted to acquire the Domain Name for itself.

### *Disruption – 3aiC*

The Respondent registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant by impersonating the Complainant's RuneScape site and profiting from the Respondent's own advertising thereon.

It is inconceivable that the Respondent intended to operate a genuine business with (or had any other genuine reason to use) a domain name which is comprised of a competitor's trade mark.

### *Confusion – 3aii*

The website at the Domain Name is essentially a scheme adopted by the Respondent to confuse, attract and profit from Internet users who are searching for the Complainant's business in search engines, web browsers and otherwise on the Internet.

The Respondent had the Complainant and its business in mind when registering and using the Domain Name: a. the Domain Name comprises the Complainant's distinctive trade mark - it is inconceivable that the Respondent registered the Domain Name independently of that trade mark; and b. the website at the Domain Name points to the Complainant's actual site.

The use of the Domain Name which comprises the Complainant's trade mark is intended by the Respondent to impersonate the Complainant and thereby create a likelihood of confusion in the minds of the public as to an association between the Respondent and the Complainant. Such intention is a factor evidencing an abusive registration independently of 3aii, as has been held in many DRS cases. The Respondent was clearly intent upon commercial gain by placing its own advertising on a version of the Complainant's site. It is difficult to conceive that the Respondent would engage in a scheme such as this for a non commercial purpose.

### *False contact details – 3iv*

The Respondent has used a false registrant address as independently verified by the return of the letter sent to the physical address of the Respondent by recorded delivery. This was clearly an attempt to evade responsibility for its abusive registration.

### *Other factors*

The Respondent claimed to be a "non trading" individual on registration of the Domain Name. That was clearly a false statement as the Respondent is undertaking (illicit) business activities at the Domain Name.

### Respondent

The Respondent has not filed a response.

## **7. Discussion and Findings:**

### General

In terms of paragraph 2(b) of the Policy the primary onus is on the Complainant to prove to the Expert on 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 "includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business". Accordingly there are three questions to consider - (1) whether the Complainant has Rights in the name or mark; (2) if the Complainant does have Rights, whether the name or term in which it has these is wholly descriptive of its business; (3) if not wholly descriptive, whether the name or mark is identical or similar to the Domain Name.

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Under English Law, rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or unregistered rights such as the entitlement to bring a claim for passing off to protect goodwill inherent in any such name or mark.

### Complainant's Rights in the mark JAGEX

The Complainant is the proprietor of UK and European Community registered trade marks in respect of the word JAGEX as set out in the facts at section 5. above. In the Expert's view these are quite sufficient to establish Rights in the name or mark for the purposes of the Policy. It is not necessary therefore for the Expert to consider the Complainant's assertions regarding its common law rights in the mark under this criterion of the Policy.

The second question for the Expert is whether the mark is wholly descriptive of the Complainant's business, namely the designing, developing and operation of online computer games. Clearly, the mark JAGEX is not descriptive of such services in whole or in part.

The remaining question therefore is whether the mark is identical or similar to the corresponding domain names. The first (.uk) and second (.org) levels of the Domain Name can be disregarded as being wholly generic. The Expert is then left with a comparison between the mark JAGEX and the third level part of the Domain Name 'jagex'. On this comparison, the Expert finds that the Domain Name is identical to a mark in which the Complainant has Rights.

### Abusive Registration

Is the Domain Name, in the hands of the Respondent, an 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors which may constitute evidence of Abusive Registration is set out in paragraph 3 of the Policy.

The Complainant's submissions focus on (1) the Respondent's registration of the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (Policy paragraph 3(a)(i)(C)); (2) confusion caused by the Domain Name to Internet users searching for the Complainant's business (Policy paragraph 3(a)(ii) together with Respondent's intention to create likelihood of confusion); (3) Respondent's use of a false contact address (Policy paragraph 3(a)(iv)); and (4) Respondent's false claim to be a "non-trading" individual.

With regard to unfair disruption, it is important to note that the Policy expresses this factor with reference to the Respondent's *primary purpose* in registering the Domain Name. In the present case, the Complainant's evidence demonstrates that the Respondent used the Domain Name to display third party advertising material. In the Expert's view, this indicates a probable financial motive as the Respondent's primary purpose, albeit that it is not known for certain whether the Respondent benefited directly from advertising revenue. This use does not however demonstrate that the Respondent's primary purpose was to cause unfair disruption to the Complainant's business even though such disruption may have been an inevitable consequence of the Respondent's actions.

With regard to confusion, the Policy at paragraph 3(a)(ii) calls for 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. There is no evidence produced by the Complainant that the use of the Domain Name has caused confusion. The Complainant separately argues that the Domain Name is a scheme to profit from Internet users who are confused by the Respondent's impersonation of the Complainant which creates a likelihood of confusion as to an association between the Respondent and the Complainant. While this does not match the exact requirements of paragraph 3(a)(ii) of the Policy, numerous decisions under the Policy have recognised that a demonstration by the complainant of a likelihood of confusion caused by the Domain Name may be sufficient to constitute Abusive Registration (bearing in mind that the factors in paragraph 3 of the Policy are expressed to be non-exhaustive).

In the present case, the Expert is satisfied that the use of the Domain Name as demonstrated by the Complainant's screenshot dated 17 October 2006 would be highly likely to promote confusion among the Complainant's customer base and would cause a significant proportion to believe that the Domain Name was registered to, operated or authorised by, or otherwise connected with the Complainant. Apart from the advertising banner in Dutch, the screenshot shows that the website associated with the Domain Name displayed either identical or very similar content to that found at the Complainant's official website. It is difficult to imagine any motivation for the Respondent to have published a page in these terms other than to cause such confusion in order to profit from it. The Respondent has chosen not to provide any alternative explanation for its past use of the Domain Name. The Expert therefore takes the view that the likelihood of confusion is highly indicative of the Domain Name being an Abusive Registration.

The Complainant also focuses on the use of incorrect contact details by the Respondent. Paragraph 3(a)(iv) of the Policy provides that it may be evidence of an Abusive Registration where 'it is independently verified that the Respondent has given false contact details to us' [Nominet]. Here, the Complainant relies on the return of its solicitors' letter by the Netherlands postal service marked both 'unknown' and 'address does not exist'. As noted above, Nominet's intimation papers in respect of this Complaint, which were also sent to the Respondent's postal address, were similarly returned. Taken on its own, the Expert would be reluctant to make a finding of Abusive Registration on this ground, simply because there are many reasons why letters might be returned including, not least, error on the part of the postal service. However, in the present case, there are two separate letters, one from Nominet and one from the Complainant's solicitors, sent to the address supplied by the Respondent to Nominet on different dates and times, yet which were both returned by the postal service quoting exactly the same reason that the address does not exist. This is sufficient independent verification in the Expert's mind to demonstrate on balance of probabilities that the Respondent has supplied false contact details to Nominet. Again, this is indicative of the Domain Name being an Abusive Registration.

Finally, the Complainant asserts that the Respondent's use of the 'opt out' from Nominet's WHOIS service on the basis that it was a "non trading" individual, despite the use of the Domain Name in connection with commercial advertisements, constitutes Abusive Registration. There is no corresponding factor in paragraph 3 of the Policy and consequently this assertion must be examined within the general definition of Abusive Registration. In the Expert's experience many domain names are inadvertently, wrongfully or accidentally opted

out of the WHOIS by registrants through failure to understand or appreciate the purpose and meaning of the facility. Had the Complainant been able to demonstrate that the present opt out was a deliberate choice on the Respondent's part the Expert might have been able to give its submission more weight. In the present case, however, the Expert has merely the existence of the opt out to go on, and in the Expert's mind this is not sufficiently indicative of Abusive Registration.

Finally, the Expert is also satisfied that the past use of the Domain Name by the Respondent to display the Complainant's website content together with third party advertising material is indicative of the Domain Name being an Abusive Registration within the general definition provided by the Policy. In the Expert's view, such use took unfair advantage of the Complainant's Rights. On this basis, and on the basis that (1) the Domain Name has been used in a manner which was highly likely to confuse people or businesses into believing that the Domain Name was registered to, operated or authorised by, or otherwise connected with the Complainant, and (2) independent verification has been produced that the Respondent supplied false contact details to Nominet, the Expert finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

## **8. Decision**

The Expert finds that the Complainant has proved that it has Rights in a mark identical 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.

**Andrew D S Lothian**

**13 December 2007**