

DISPUTE RESOLUTION SERVICE

DRS 6788

Decision of Independent Expert

RIPLEY ENTERTAINMENT INC

and

GIANT GAMES LIMITED

1. The Parties:

Complainant: Ripley Entertainment Inc.

Address: ATTN: Shana Joseph, Paralegal
7576 Kingspointe Parkway Ste. 188
Orlando, Florida

Postcode: 32819
Country: United States of America

Respondent: Giant Games Ltd

Address: ATTN: David Thurgate
35 Giant Arches Road
Dulwich
London

Postcode: SE24 9HP
Country: United Kingdom

2. The Domain Name(s):

ripley.co.uk

3. Procedural History:

3.1 The Complaint was submitted to Nominet on 27 January 2009 and subsequently validated by Nominet on 2 February 2009.

3.2 The Respondent submitted a response to Nominet on 24 February 2009 with Mediator Suzanne Begley assigned to the matter on 4 March 2009. Complainant did not pay the requisite fee to obtain an Expert Decision pursuant to paragraph 6 of the Nominet Dispute Resolution Service Policy ("the Policy") resulting in the Complaint deemed withdrawn on 19 March 2009. The Respondent subsequently paid for an expert decision with a cheque received by Nominet on 8 April 2009.

3.3 On 8 April 2009, Kathleen Fox, the undersigned ("the Expert"), confirmed to Nominet that she knew of no reason why she could not properly accept Nominet's Invitation to her to act as an Expert in this case and a formal appointment of the Expert was made on 9 April 2009 with David King confirmed as Expert Reviewer also on 9 April 2009.

4. Factual Background:

4.1 In brief, the Complainant is Ripley Entertainment Inc, an international enterprise owning various entertainment attractions throughout the world, most notably the "Ripley's Believe It or Not" wax museums as well as selling more than a million books annually, and has a rather large presence in developing and selling toys and games as well as a cartoon series that is still read daily in 42 countries in 17 languages. The company started nearly 90 years ago as the brain child of Mr. Robert Ripley and prides itself on presenting the "weird and the wacky" of human behaviour and physical oddities and attracts a large number of visitors every year to its various museums. In addition to the Ripley's franchise, the Complainant also owns the worldwide Guinness World Records business interests.

4.2 The Complainant owns many registered trade marks in the UK and European Community including registrations for "RIPLEY'S BELIEVE IT OR NOT", "RIPLEY'S", "RIPLEYS", "RIPLEY'S MIRROR MAZE" and "RIPLEY'S AMAZING MIRROR MAZE". Notably the "RIPLEY'S" registration is a stylised word format (UK 994,029) dating back nearly 37 years to 21 June 1972 and a more recent 19th June 2000 CTM registration for the word mark "RIPLEYS" (CTM 2007334). In addition, the Complainant is the owner of over 200 domain names, including "ripleys.com" and "ripleysbelieveitornot.com"

4.3 The Complainant opened an attraction in London near Piccadilly Circus to great fanfare in August 2008.

4.4 According to the Complainant, it attempted to contact the Respondent in December 2008 in order to resolve their complaint regarding Respondent's use and ownership of the Domain Name however no reply was sent to Complainant by the Respondent.

4.5 The Respondent, Giant Games Limited, describes itself as "a registrant of a large number of generic domains" and registered the disputed Domain Name in 18 June 1998. A search of Companies House records does bring up a company trading in the UK as Giant Games

Limited (Company Reg. No. 01848140) and a review of the Giant Games website (giantgame.co.uk) indicates that the company primarily sells "giant" chess games and draughts (checkers) pieces with a giant chess set and board selling for approximately £400.

5. Parties' Contentions:

The Complainant

5.1 The Complainant's contentions are very straightforward and brief on submission, namely, that the Complainant is the worldwide owner of many trade marks, domain names and business operations and therefore have achieved a certain level of "fame" as a result of the nature and geographic spread of their enterprises. The Complainant contends that the Respondent's registration of the domain name in 1998 constitutes "unauthorised use of [the Complainant's] trademarks and is in violation of ...Policy". The Complainant then states that "this has caused consumers to confuse RIPLEY.CO.UK web address with our web addresses especially since we've opened up a Ripley's Believe it or Not! Museum in Piccadilly Circle [sic] in London August 2008". In brief, the Complainant states that the "domain name in the hands of the Respondent is an Abusive Registration because its causing our UK customers confusions" and "they are abusing our name and are using our name to sell games and whatever else is being sold on their website". The Complainant is looking for a transfer of the Domain Name from the Respondent.

The Respondent

5.2 The Respondent counters the points raised in the Complaint by arguing that the Complainant only began trading in the UK in August 2008 whereas the Respondent registered the Domain Name over 10 years prior to the launch of the Complainant's Ripley's Believe It or Not! Museum in London.

5.3 The Respondent strenuously argued that they were not aware of the Complainant or any of its alleged rights when it registered the disputed Domain Name in June 1998 and remained unaware of the Complainant until contact by same in December 2008. The Respondent contended that the Complainant was not entitled to a monopoly right in "Ripley" as 1) their trade marks utilised the plural or possessive form of that name and 2) it was a common surname as well as being a geographic location in the UK. In support, the Respondent provided an Annex consisting of various listings from the BT telephone listings search for the surname "Ripley" (search parameters limited to Yorkshire and a UK-wide search similarly returned a response of "too many people found"); listings of geographic places called Ripley; listings from the Companies House website of numerous companies utilising "Ripley" in their respective company names; and a Google search illustrating other companies apart from the Complainant incorporating the "Ripley" name as part of their business trading name. The Respondent even presented evidence of the book by Patricia Highsmith and film starring Jude Law and Matt Damon entitled "The Talented Mr. Ripley" in support of their contentions regarding

the generic nature of the Domain Name. The Respondent further argued that the trade mark RIPLEYS or RIPLEY'S has not developed a secondary meaning or level of fame and therefore evidence of abuse would have to be very persuasive which, according to the Respondent, the evidence provided by the Complainant is not of such a high standard.

5.4 The Respondent denied any possibility of confusion by members of the public and if there was confusion that this was the result of the Complainant "adopting a generic word as part of its trademark".

5.5 The Respondent is making fair use of a Domain Name that is generic or descriptive citing the Nominet appeal decision in relation to Wiselnsurance.co.uk (DRS 4889) in support of this contention.

5.6 As a final argument the Respondent then proffers a reverse domain name hijacking and bad faith argument against the Complainant as the Respondent believes that since the Complainant was advised by legal counsel in preparing the original Complaint this meant that Complainant had a duty to ensure their Complaint has at least a reasonable prospect of success before putting a "legitimate Respondent to considerable trouble and expense to deal with it" and since "registrants have duties imposed on them when registering domains, both at the time of registration and subsequently when using domains[i]t is only fair an [sic] equitable that Complainants take similar care before filing speculative and vexatious complaints.

6. Discussions and Findings:

General

In order to succeed, the Complainant must prove, on the balance of probabilities that:-

it has Rights in respect of a name or mark which is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy); ***and***

the Domain Name in the hands of the Respondent, is an Abusive Registration (paragraph 2(a)(ii)) (emphasis added).

Paragraph 2b of the Policy provides that "the Complainant is required to prove to the Expert that ***both*** elements are present on a balance of probabilities" (emphasis added).

6.1 The Complainant's Rights

a. First, it is necessary for the Complainant to show that it has Rights in a name which is identical or similar to the Domain Name. The Policy defines "Rights" as including, but not limited to, "*rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or a term which is wholly descriptive of the Complainant's business.*"

b. Accordingly, it is necessary to consider (1) whether the Complainant has rights in the name RIPLEY, which are enforceable under English law and (2) whether the name is wholly descriptive of the Complainant's business.

c. Does the Complainant have Rights in a name which is similar or identical to the Domain Name which are enforceable under English Law?

d. As it is usual in domain name disputes to disregard the top level or country code suffix, as being a necessary component of a domain name's address, it is necessary to consider whether the Complainant has Rights in the name RIPLEY.

e. As noted in paragraph 3.2 above, the Complainant is the owner of numerous trade mark registrations for RIPLEY'S, RIPLEYS and for RIPLEY'S BELIEVE IT OR NOT wherein the common element is "RIPLEY" in either a plural or possessive format. In this instance and despite Respondent's arguments to the contrary, the Expert is not of the opinion that the plural or possessive nature of the Complainant's trade marks undermines or outright destroys the similarity of their marks in relation to the disputed Domain Name.

f. It is therefore believed that the Domain Name is identical or similar to the Complainant's various trade marks for "RIPLEYS" and "RIPLEY'S", moreover it is worth pointing out that the Complainant also operates and is known by the singular of RIPLEY'S, namely, Ripley Entertainment Inc (emphasis added) and therefore the Domain Name is also identical or similar to the strongly distinctive element in the Complainant's trading name (i.e. RIPLEY).

g. Is the name RIPLEY wholly descriptive or generic of the Complainant's business?

h. The Complainant utilises the name Ripley, in the singular sense (company name) and in the plural and possessive sense by virtue of taking the surname of the founding father, Mr. Robert Ripley, as the basis of its company name, logo and image and use of the word, "RIPLEY" does not denote any wholly descriptive or generic of the Complainant's business enterprises.

i. In the DRS appeal decision of *Seiko UK Limited v Designer Time/Wanderweb* (DRS 00248) it was noted that the requirement to demonstrate "rights" is not a particularly high threshold test. From the evidence provided by the Complainant, the Expert finds on a balance of probabilities that the Complainant has rights in respect of the name RIPLEY by virtue of its trade marks and its length of trading utilizing the company name, Ripley Entertainment Inc.

6.2 Was the Respondent's registration and subsequent use of the Domain Name abusive?

a. 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;

ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights".

b. The Respondent registered the Domain Name over 10 years prior to the Complainant opening up its doors to its enterprise in central London. No evidence was provided by the Complainant that the initial Domain Name registration in 1998 was made for any nefarious purpose related to undermining the Complainant's "Ripley's" enterprises here in the UK or indeed elsewhere nor any evidence provided that the Respondent was even aware of the Complainant's Believe It or Not! enterprises in 1998. The Ripley's Believe It or Not! brand is indeed a well-known institution and does have a certain level of repute or notoriety, but there is no suggestion, even from the Complainant, that "Ripley's" was/is a such household name or had/has taken on such an esteemed reputation as to warrant an assumption that the Respondent must have been aware of its existence or that it has a secondary meaning akin to the "Coca-Cola category of famous names" (see *Mercer Human Resource Consulting Inc. v. IMO International Ltd* DRS 03733) .

c. From the Respondent's evidence, there are a host of categories of "Ripley" that are far reaching and having no connection with the Complainant. For instance, "Ripley" is a both a surname and geographic location in fairly common and widespread use both here in the United Kingdom and across much of the English-speaking world. Even a cursory effort to ascertain the number of individuals with the surname of "Ripley" (or indeed used as a first name) or third party companies utilising the name "Ripley" in its trading name or indeed locations going by the name "Ripley" would indicate that there are perhaps in excess of a million such possible entries. Therefore, although the Complainant has indeed demonstrated it has Rights by virtue of its various trade marks in connection with "Ripley's", "Ripleys" and "Ripley's Believe It or Not", and its company name Ripley Entertainment Inc., it is also highly likely other individuals and companies may also legitimately wish to use the name "Ripley" and also would have similar Rights to use of the word/name "Ripley" (see appeal decision in *Wise Insurance Services Limited v. Tagnames Limited* (DRS 04889)).

d. The Complainant suggests that there have been situations regarding confusion of the domain name and the Complainant's business although no supporting evidence of such confusion was supplied in support of the Complaint. Strictly speaking submission of evidence of confusion is not an absolute requirement under paragraph 3(ii) of the Policy. An Expert is permitted to assess the Respondent's conduct and in so doing if the Expert concludes that confusion could ultimately result then this will be an important factor in determining the abusive nature of

the registration (see *MySpace, Inc. v Total Web Solutions Limited* (DRS 4962) and *Verbatim* (DRS 4331)).

e. The domain name registration system operated via Nominet or indeed any of the other Internet Registry bodies are implemented on a first-come-first-served system and as per the 2008 *MySpace* appeal, this Expert is also reluctant to place any further duty on a registrant who merely had the good fortune to register a name in good faith which subsequently acquires notoriety here in the UK, especially if the Respondent's activities have not attempted to ride on the coattails of the Complainant's notoriety either at the time of registering the Domain Name or through the Respondent's subsequent actions related to the website operated utilising the Domain Name (see *MySpace* DRS 4331).

f. There is no indication that the Respondent had knowledge of the Complainant nor any of its Rights when registering the Domain Name in June 1998 and the current structure/use of the website for "ripley.co.uk" does not on any level attempt to trade off the goodwill or reputation of the Complainant. Indeed there is no evidence that the previous or current use of the Domain Name by the Respondent was/is of such a manner as to take unfair advantage of the Complainant's Rights. A review of the subject website simply provides a search engine query box to direct users to other websites in addition to directing individuals with writing talent to contact the owners of the site should they wish to make a literary contribution for some of their other websites—there appears to be no attempted or indeed overt connection or association of the website with the Ripley's Believe It or Not! enterprises.

g. In brief, there is no evidence presented by the Complainant as per paragraph 3(a) (i) (C) of the Policy that the purpose for registering the Domain Name was primarily for the purpose of unfairly disrupting the business of the Complainant (see *Expedia v. Bluestone Ventures* (DRS 6524)). The Complainant has not made out a convincing case to demonstrate that the registration was in fact abusive or that the Respondent's use of the Domain Name is of such a manner as to take unfair advantage of the Complainant's rights and therefore the Complaint must fail.

6.3 Reverse Domain Name Hijacking

a. A Complainant whether or not thought to be advised by legal counsel is entitled to file a Complaint if they have a good faith belief that they have Rights in a name identical or similar to the subject Domain Name and that use of the Domain Name by the Respondent is taking unfair advantage of the Complainant Rights and such use has become abusive. It is not believed that the Complainant has in this case brought this Complaint in bad faith.

7. Decision

I find that the Complainant has proved on the balance of probabilities that it has Rights in a name or mark which is identical or similar to the Domain Name but that it has not proved, on the balance of probabilities, that the Domain Name is an Abusive Registration in the hands of the Respondent. I therefore direct that no action be taken in relation to the Domain Name.

Signed: Kathleen Fox

Dated: 18 May 2009