

**NOMINET UK DISPUTE RESOLUTION SERVICE**

**DRS 8376**

**SmithKline Beecham (Cork) Limited v JN Distribution**

Decision of Independent Expert

**1. Parties:**

Complainant:

SmithKline Beecham (Cork) Limited  
Currabinny,  
Carrigaline,  
County Cork,  
Ireland

Respondent:

JN Distribution  
Apelgatan 20  
Norrkoping  
60125  
Sweden

**2. Disputed Domain Name**

tyverb.co.uk (“the Domain Name”)

**3. Procedural Background:**

3.1 Nominet received the Complaint on 10 March 2010, and the Response and Reply on 1 April 2010.

3.2 Mediation conducted by Nominet failed to resolve the dispute.

3.3 On 15 April 2010, the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

3.4 Cerryg Jones, 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 further confirmed 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.

**4. Outstanding Formal/Procedural Issues (if any):**

There are no other outstanding procedural issues that arise.

**5. Factual Background:**

5.1 The Complainant is part of GlaxoSmithKline plc, the well known pharmaceutical business. One of its products is TYVERB, a prescription product for the treatment of patients with breast cancer.

5.2 It appears from the Complaint, that this product was approved by the European Commission on 10 June 2008, having previously been approved in the US on 13 March 2007 (under the trade mark TYKERB).

5.3 The EU approval was preceded by numerous press articles, examples of which were filed with the Complaint. These were published in advance of the registration date of the Domain Name (31 July 2007).

5.4 Evidence was also filed indicating that the Complainant has registered TYVERB as a trade mark in several countries around the world before the registration date

of the Domain Name, including print-outs from the UK IPO and OHIM for UK Reg No. 2335929 and CTM Reg No. 4195681 for TYVERB.

5.5 The Respondent did not file any evidence or submissions as to its identity or the nature of its business, or activities.

5.6 The Domain Name resolves to the URL [www.tyverb.co.uk](http://www.tyverb.co.uk). On accessing that website, the following message appears:



*More to come soon. Please stay tuned.*

Hosted by Internet Domain Bureau  
[Svenska Export Media](#)

5.7 Svenska Export Media appear to specialise in the registration of domain names together with related services such as domain parking. They appear to be hosting this webpage for the Respondent but are otherwise unconnected.

## **6. The Parties' contentions**

### The Complaint

The Complainant alleges that:

6.1 The Domain Name is a blocking registration against a mark in which the Complainant has Rights. The Complainant says it has plans to start using the

Domain Name in the UK for its product TYVERB and (self-evidently) that this is not possible while the Domain Name is in the hands of the Respondent.

6.2 TYVERB is a coined word with no meaning and the Complainant has not authorised the Respondent to use TYVERB in any way.

6.3 The Respondent has not developed any active website at "www.tyverb.co.uk" or made any other use of the Domain Name "tyverb.co.uk", and "bad faith" is not confined to positive action. The Domain Name was registered on 31 July 2007 and has not yet been used for any legitimate purpose.

6.4 By using a domain name which is identical to the Complainant's TYVERB trade mark, the Respondent is likely to confuse internet users that the Domain Name may connect them to the Complainant's website, or that the Respondent's website is somehow endorsed by, or affiliated with, the Complainant, contrary to the facts. Under these circumstances, it is alleged that the Respondent has intentionally registered the Domain Name to create a likelihood of confusion in an effort to drive traffic to its future site from which it stands to gain financially.

6.5 The Respondent has provided incomplete contact details since the Domain Name has been registered with no email address, fax or phone number.

### The Response

6.6 The Response is very brief, as follows:

"we understand the implications for this case. Since we have not started our intended business, we are willing to transfer the domain if our counterpart is

willing to compensate us for the costs for the domain since 2007. In Swedish currency 8534 SEK”.

### The Reply

6.7 The Complainant says in its Reply that the average cost for obtaining a ".co.uk" is around £3 a year and that in these circumstances the Registrant's request amounts to "bad faith" since the offer (equivalent to £780.00) is in excess of its out-of-pocket costs since 2007.

## **7 Discussion and findings**

### **General – the DRS policy (the Policy)**

7.1 Under paragraph 2 of the Policy, the Complainant is required to prove to the Expert on the balance of probabilities that:

7.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

7.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.2 An Abusive Registration is defined in paragraph 1 of the Policy as a Domain Name which either:

7.2.1 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

- 7.2.1 has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;
- 7.3 Rights are defined under paragraph 1 of the Policy as:
- “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.
- 7.4 The first question that needs to be decided is whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- 7.5 The Complainant has satisfied this test by virtue of the rights conferred on it through ownership of the registered trade marks identified in paragraph 5.4 above.
- 7.6 The next issue to be determined is whether or not the Domain Name, in the hands of the Respondent, is an Abusive Registration. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under the Policy is as follows (so far as may be relevant to this Complaint):
- 7.6.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
- 7.6.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the

Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name; or

7.6.1.2 as a blocking registration against a name or mark in which the Complainant has Rights;

7.6.1.3 for the purpose of unfairly disrupting the business of the Complainant;

7.6.2 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.

7.6.3 It is independently verified that the Respondent has given false contact details to Nominet.

7.7 The Policy makes it clear that failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

7.8 The non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration include:

7.8.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

7.8.1.1 used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services. Here the Respondent has conceded it has not started its business so this factor does not apply;

7.8.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name. Again there is no evidence which might support this conclusion;  
or

7.8.1.3 made legitimate non-commercial or fair use of the Domain Name.

7.9 Connecting domain names to parking pages and earning click-per-view revenue is not of itself objectionable under the Policy either. However, the Expert is required under the Policy to take into account:

7.10.1 the nature of the Domain Name;

7.10.2 the nature of the advertising links on any parking page associated with the Domain Name; and

7.10.3 that the use of the Domain Name is ultimately the Respondent's responsibility.

7.11 I have reached the clear conclusion on the basis of the submissions and evidence before me that the Domain Name in the hands of the Respondent is an Abusive Registration.



7.12 The trade mark incorporated within the Domain Name consists of an invented word. It has been adopted by a wholly unconnected third party. There is no evidence to suggest the choice of Domain Name was mere coincidence, or was connected to any genuine offering of goods or services.

7.13 In the absence of any submission by the Respondent as to why it registered the Domain Name, I agree with the Complainant that, on a balance of probabilities the Respondent's registration is abusive. The evidence suggests that the Respondent's registration was opportunistic, and was designed to take unfair advantage of the reputation of the Complainant's Rights in its trade marks, ultimately by extracting some form of unjustified premium for the Domain Name.

7.13 Further, the Domain Name is the likely guess of any user looking for information about TYVERB in the UK and, as such, this will unfairly disrupt the Complainant's business in respect of this product, and is inherently misleading. In these circumstances, any click-per-view revenue would not legitimise the Respondent's registration under the Policy.

8 Decision:

In the light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent is an abusive registration, I direct that the Domain Name be transferred.

Cerryg Jones

13 May 2010