

Nominet UK Dispute Resolution Service (DRS)

DRS Number 08447

Sony Computer Entertainment Europe Ltd -v- Pan Zuo

Decision of Independent Expert

1. Parties

Complainant : Sony Computer Entertainment Europe Ltd
10 Great Marlborough Street
London
W1F 7LP
United Kingdom

Respondent : Pan Zuo
Yanshan Daxue 586 Xinxiang
Qinhuangdao
Hebei
066004
China

2. Domain Name

pspgo.co.uk (the Domain Name)

3. Procedural Background

On 25th March 2010 the Complaint was lodged with Nominet UK Limited (“Nominet”). Nominet validated the Complaint on 25th March 2010 and it was sent to the Respondent giving him 15 working days within which to lodge a Response and which was to be on or before 19th April 2010 (this period included 2nd April and 5th April 2010 UK Bank Holidays).

The Respondent did not respond and on the 20th April 2010 Nominet generated the “no response to Complaint” documents. On the 13th May 2010 the Complainant paid the appropriate fee for a Full Decision by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 20th May 2010 Mr. Niall Lawless (“the Expert”) was selected and on 26th May 2010 appointed to act as Expert in this dispute, having confirmed that he knew of no reason why he could not properly accept the appointment and knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question his impartiality and / or independence. He is required to give his Decision by 17th June 2010.

4. Outstanding Formal / Procedural Issues

There are no outstanding formal or procedural issues.

5. The Facts

The Complainant is the European subsidiary of Sony Computer Entertainment Inc. (SCEI) and is responsible for marketing, distribution and sale of PlayStation products throughout Europe, the Middle East, Africa and Oceania. The Complainant currently sells four main consoles: PlayStation 2, PlayStation 3, PSP (PlayStation Portable) and PSP Go. Released in Europe in October 2009 the PSP Go is the most recent console brought to market and is the first version of the PSP to have no physical cartridge drive.

SCEI and the Complainant hold numerous intellectual rights in the PlayStation technology and brands. For example, as far back as 8th December 2000 it obtained trademark protection for the PSP name. On the 29th May 2009 the Complainant made a European Community trademark application for PSP Go.

The Respondent registered pspgo.co.uk on the 29th April 2009.

The Complainant seeks transfer of the Domain Name to it.

6. The Parties’ contentions

The Complainant

The Complainant says that it has a number of European Trademark registrations for PSP and has released several products for the PSP under the branding of “Go”; including for example

Go!Messenger, Go!Puzzle, Go!Cam and Go!Sudoku. The Complainant has a number of European Community Trademark registrations for PSP and in May 2009 made a trademark application for PSPGo.

The Complainant says that the Domain Name (pspgo.co.uk) controlled by the Respondent is an Abusive Registration under Nominet's DRS Policy. It says that the Domain Name it is an Abusive Registration because :-

- It was registered in April 2009 so as to take unfair advantage of SCE's goodwill and cause confusion to the public by pointing to the site of a major competitor Nintendo.
- Its use is likely to confuse and lead the public to either assume that the Respondent's website originates from the Complainant or infer some connection with the Complainant.
- As the public's initial interest in the site would be for the PSPGo product, the website will cause confusion as only the Complainant's competitor's products are displayed and not its own products.
- The contents of the Respondent's website resolved at www.pspgo.co.uk, including the use of the Complainant's PSP trademark are likely to be both trademark and copyright infringement.
- The use of the Complainant's competitor's trademarks on the website is likely to be detrimental to and compromise the Complainant's reputation in general as the public is likely to believe that this website originates from it and that the Complainant is trading off its competitors' names.

Because of the above the Complainant asks that the Expert issue an order directing the transfer of the Domain Name to the Complainant.

The Respondent

The Respondent has not responded.

7. Discussions and Findings

7.1 General

The Nominet DRS Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either :-

- i. 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 Complainant is required to prove to the Expert that the Claimant has Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

7.2 Complainant's Rights

The Complainant holds numerous intellectual rights in the PlayStation technology and brands and it has obtained trademark protection for the PSP name.

One of the Complainant's products is the Sony PSP Go and which is a handheld video game console. The product was an innovation on previous PSP models in that it does not feature a Universal Media Drive but instead uses internal Flash Memory to store pictures, video, and games which can be downloaded from the Sony PlayStation Store.

Because the Complainant has extensively used and promoted its PSP names and marks and because it's handheld video game console is branded PSP Go I decide that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

7.3 Abusive Registration

The Complainant says that the Domain Name (pspgo.co.uk) controlled by the Respondent is an Abusive Registration under Nominet's DRS Policy, but it does not state under which part of the Policy. Under the Nominet DRS Policy Section 3 Evidence of Abusive Registration guidance is given as

to what factors may evidence that the Domain Name is an Abusive Registration. A non-exhaustive list of factors which may evidence that the Domain Name is an Abusive Registration is as follows :-

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(A). 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;

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainant has Rights.

3(a)(i)(C). or the purpose of unfairly disrupting the business of the Complainant;

3(a)(ii). 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.

Registration of the Domain Name

Nominet operates a "first-come, first-served" system of domain name registration and there is no requirement for the Respondent to show that he has Rights in the name (unlike the Complainant, who must prove that). However, it can help the Respondent's case if he can show that he has rights in the name, as it suggests that the registration (and possibly use) of the name is not abusive.

The Complainant says that the Domain Name was registered in April 2009 so as to take unfair advantage of SCE's goodwill and cause confusion to the public by pointing to the site of a major competitor Nintendo.

The Complainant released the PSP Go product in Europe in October 2009 and in Japan in November 2009; it does not provide any information as to when the PSP Go name and product was revealed to the marketplace. I accept that long before the Respondent registered the Domain Name Sony extensively used and promoted its PSP names and marks, but it has adduced no evidence that it used and promoted the PSP Go name prior to April 2009 when the Respondent registered the Domain Name.

However, in light of my finding below in relation to “abusive use”, it is unnecessary for me to address further the Respondent’s intentions at time of registration of the Domain Name.

Using the Domain Name to Confuse

The Complainant says that the use of the Domain Name is likely to confuse and lead the public to either assume that the Respondent’s website originates from the Complainant or infer some connection with the Complainant.

The Domain Name is resolving to the homepage of the website of Nintendo in the UK. The homepage clearly says “Welcome to Nintendo UK & Ireland” and offers rival products and services to those provided by the Complainant.

The Domain Name is being used to link to Nintendo offering products which compete with those offered by the Complainant. Will an Internet user arriving at the website to which the Domain Name is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”?

Most internet users will know that Sony products are not Nintendo products and Nintendo products are not Sony products. Therefore I doubt that the Domain Name is being used in a way which has confused people into believing that the Domain Name is operated by or connected with the Complainant.

Initial Interest Confusion

However, the Complainant also says that as the public’s initial interest in the site would be for the PSPGo product, the website will cause confusion as only the Complainant’s’ competitors’ products are displayed and not its own products.

Many DRS Experts use the concept of initial interest confusion as one of the factors which might evidence an Abusive Registration; but whether or not it exists, and whether its existence suggests an Abusive Registration, will always be heavily dependent on the facts in the dispute.

In respect of “initial interest confusion” the Nominet’s Experts’ Overview says:-

“Commonly, Internet users will visit websites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that

name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the website connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's website will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's website will be visiting it in the hope and expectation that the website is a website "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the website that the site is not in any way connected with the Complainant, the visitor has been deceived".

In this dispute "initial interest confusion" is caused because the customer searches for the Complainant's website via the product name PSP Go intending to buy products or services. The customer locates products supplied by the Complainant's competitor Nintendo and even though realizing that they are not being sold by the Complainant it buys those anyway. Therefore the Complainant loses money.

In this dispute using the Domain Name to offer competing products to the Complainant satisfies the "initial interest confusion" and it is being used by the Respondent to free-ride on the Complainant's significant goodwill and reputation, most probably to earn "pay per click" revenue.

Although many customers may no longer be confused once they reach the Nintendo website this is not relevant as the damage will have already been done. The Domain Name is therefore likely to create initial interest confusion to the detriment of the Complainant.

I decide on the balance of probabilities that even in the absence of evidence of actual confusion the Domain Name has been used in a way which has confused people or businesses and that under the test in Nominet's DRS Policy 3(a)(ii) and that in the control of the Respondent the Domain Name is an Abusive Registration.

Trademark infringement

The Complainant says that the website resolved at www.pspgo.co.uk, including the use of the Complainant's PSP trademark is likely to be both trademark and copyright infringement. I accept

that the Complainant has a substantial investment in having extensively used and promoted its PSP names and marks.

However, whether or not the Respondent's activities amount to trademark infringement, Expert Decisions are to be determined by reference to Nominet's DRS Policy and not the law in respect of trade-mark infringement, for example as decided in Deutsche Telekom AG v Lammtara Multiserve Limited (DRS 05856) Appeal Decision.

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name identical or similar to the Domain Name and that the Complainant has proved, on the balance of probabilities, that the Domain Name, in the hands of the Respondent is an Abusive Registration.

8. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name is transferred to the Complainant.

Niall Lawless, Nominet Expert

28th May 2010