

DISPUTE RESOLUTION SERVICE

D00013038

Decision of Independent Expert

Flixster Inc

and

Ronny Schmidt

1. The Parties:

Lead Complainant: Flixster Inc
208 Utah Street
San Francisco
California
94103
United States

Respondent: Ronny Schmidt
Marktstrasse 1
Gaegelow
DE
23968
Germany

2. The Domain Name(s):

flixster.co.uk

3. Procedural History:

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.

03 July 2013 15:24 Dispute received
04 July 2013 11:55 Complaint validated
04 July 2013 12:07 Notification of complaint sent to parties
23 July 2013 02:30 Response reminder sent
26 July 2013 08:22 No Response Received
26 July 2013 08:22 Notification of no response sent to parties
07 August 2013 02:30 Summary/full fee reminder sent
08 August 2013 08:58 Expert decision payment received

4. Factual Background

The Complainant is the provider of the online social movie service, Flixster. It is owned ultimately by Warner Bros. The site was originally launched in the US in late 2005/2006, and in the United Kingdom the social network site www.bebo.com began linking to the www.flixster.com site in January 2006, with a Flixster App being launched on Bebo in 2008. Warner Bros acquired Flixster, Inc in May 2011.

The Flixster site allows users to share film-related content, such as reviews, ratings and recommendations (among other facilities). It is available through a variety of platforms. In December 2012 it had approximately 160 million registered users worldwide, including 15 million in the UK and 849,000 in New Zealand. The site's analytical data show significant numbers of visitors both in 2012 and in 2009, and the site has been the subject of extensive worldwide press coverage.

The Domain Name was first registered by a resident of New Zealand, Gareth Piesse, on 10 August 2009. On 6 December 2012 the Complainant's lawyers wrote to Mr Piesse, asserting their client's trade mark rights, and demanding that he cease use of the Domain Name and transfer it to the Complainant. Mr Piesse did not respond, and instead the Respondent became the registered proprietor of the Domain Name on 13 December 2012. The Complainant has not contacted the Respondent.

At the time of the Complaint the Domain Name redirected the user to the URL ww2.flixster.co.uk, which is a pay-per-click advertising site, with a selection of "related searches" and "sponsored listings". Those include (directly or indirectly)

links to advertisements for a number of sites which compete with the Complainant's business, such as Film Fanatic, Netflix, Lovefilm, and www.nowtv.com, as well as free torrent services.

5. Parties' Contentions

The Complainant

Rights

The Complainant is the owner of numerous trade mark registrations for the FLIXSTER mark throughout the world including Community Trade Mark E856243, with a filing date of 21 September 2009. It also owns a number of domains incorporating the Flixster name (in addition to its primary domain flixster.com). As described above, it has very significant numbers of registered users, and the Complainant claims to have become well known among members of the public as a result of the extensive use of the FLIXSTER mark and "substantial sums" of money spent developing and marketing its services. The Complainant therefore relies both upon registered and unregistered rights in the FLIXSTER name, which is identical to the Domain Name.

Abusive Registration

The Complainant relies upon four of the factors set out in paragraph 3.a of the DRS Policy, as potential evidence of abusive registration. Those are:

1. Confusion among internet users:

"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" (Policy, 3.a.ii);

2. Blocking registrations:

"Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:...as a blocking registration against a name or mark in which the Complainant has Rights" (Policy, 3.a.i.B);

3. Unfair disruption:

“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily...for the purpose of unfairly disrupting the business of the Complainant” (Policy, 3.a.i.C); and

4. Pattern of Registrations:

“The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern” (Policy, 3.a.iii).

The Complainant’s primary submissions are addressed to the issue of confusion. The Complainant highlights the made-up nature of its own name to suggest that it seems highly likely that Mr Piesse must have been aware of the Complainant’s business when he first registered the Domain Name. Whether or not the advertising on the Respondent’s pay-per-click site is generated automatically, the Complainant says that there will be users seeking to locate the Complainant’s services through navigating directly who will be diverted to competing providers of similar services, or there will be initial interest confusion through the Domain Name itself. In either case, there will be damage to the Complainant’s business.

In support of the complaint about blocking registration, the Complainant points out that the Domain Name would clearly be of benefit to the Complainant’s UK business, and it is prevented from using the Domain Name itself in connection with its own products and services targeted at a UK audience.

The complaint relating to unfair disruption repeats the allegations about diverting internet users away from the Complainant’s business, or causing confusion, and asserts as a result that the Complainant’s business has been made to suffer unfair disruption.

The pattern of registrations the Complainant relies upon involves the Respondent’s substantial portfolio of domain name registrations including those similar to other well-known names, such as blokbuster.co.uk, godaddy.co.uk, halfirax.co.uk, madza.co.uk, nickaloden.co.uk, pizzahuy.co.uk, and reanult.co.uk.

The Complainant also has concerns relating to reputational damage as a result of its solicitors receiving a virus alert when they first accessed the Respondent’s website in April 2013.

The Complainant seeks transfer of the Domain Name to itself.

The Respondent

The Respondent has not replied to the Complaint.

6. Discussions and Findings

In order to succeed in its Complaint, in accordance with the Policy, the Complainant needs to establish:

- “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.”*

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”.*

The definition of Rights under the Policy is 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.”

In this case, there can be no real argument about whether the Complainant has Rights under the Policy. Its trade mark registrations and level of recognition and use make it incontestable that it has both registered and unregistered trade mark rights in a name or mark which is identical to the Domain Name. It therefore has Rights under the Policy.

The Respondent has chosen not to contest the Complaint, but even if he had, it is difficult to see what possible valid explanation he (or his predecessor) could have had for registering the Domain Name using the Complainant's made-up name in 2009 (and, in the Respondent's own case, for taking over the registration in 2012), at times when the Complainant was already well-known, attracting many millions of users to its flixster.com website and service. The potential for initial interest

confusion is obvious, but in this case, the problem for the Respondent is compounded by the website at the Domain Name leading visitors directly or indirectly to a variety of websites belonging to competitors of the Complainant.

It is possible that, in failing to respond to the Complaint, the Respondent has decided not to try to defend the indefensible. In the absence of any response, the Expert is left with the relatively straightforward task of deciding the Complaint in the Complainant's favour. The Expert does not necessarily agree with all the submissions on the Complainant's behalf (the submissions regarding blocking registration and intention primarily to unfairly disrupt the business of the Complainant are not fully made out, for example). However, the position regarding potential confusion among internet users seems to be overwhelmingly convincing, and it is not therefore necessary to dwell further on such subsidiary issues.

7. Decision

The Expert finds that the Complainant has Rights in the name or mark FLIXSTER which is identical to the Domain Name, and 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.

Signed Bob Elliott

Dated 15 August 2013