



NOMINET

DISPUTE RESOLUTION SERVICE

D00015788

Decision of Appeal Panel

Lucasfilm Ltd., LLC

and

ABSCISSA.COM Limited

1. The Parties:

Complainant:
Lucasfilm Ltd., LLC
c/o Nabarro LLP
125 London Wall
London
EC2Y 5AL
United Kingdom

Respondent:
ABSCISSA.COM Limited
Union House
Kennetside
Newbury
Berkshire
RG14 5PX
United Kingdom

2. The Domain Names:

The domain names in issue and the dates on which the Respondent registered or acquired each of them are as follows:

starwars.co.uk
star-wars.co.uk

22 January 2003
19 March 2003

| | |
|-------------------|--------------|
| star-wars.uk | 25 July 2014 |
| star-warsco.co.uk | 25 July 2014 |
| star-warsco.uk | 25 July 2014 |
| starwars.uk | 25 July 2014 |
| starwarsco.co.uk | 25 July 2014 |

The domain names registered in 2003 are referred to below as the “2003 Domain Names”. The domain names registered in 2014 are referred to below as the “2014 Domain Names”. Together the 2003 and 2014 Domain Names are referred to as the “Domain Names”

3. Procedural History

This is an Appeal against the decision of Steve Ormand (the “Expert”) issued on 5 July 2015 in favour of the Complainant. Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

The procedural history of relevance to this Appeal is as follows:

| | |
|----------------|---|
| 14 April 2015 | Complaint received |
| 29 April 2015 | Response received |
| 6 May 2015 | Reply received |
| 1 June 2015 | Mediation failed |
| 5 July 2015 | Expert’s decision in favour of the Complainant ¹ |
| 10 August 2015 | Appeal Notice filed |
| 21 August 2015 | 13.b. filing by the Respondent (see below) |
| 25 August 2015 | Appeal Response |
| 26 August 2015 | Appeal Panel appointment |

Nick Gardner, Anna Carboni and David King (together, “the Panel”) have each made a statement to the Nominet Dispute Resolution Service in the following terms:

“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 such a nature as to call in to question my independence in the eyes of one or both of the parties.”

¹ The Expert in his decision found that the Complainant had Rights in the mark STAR WARS, which was a mark that was identical or similar to each of the Domain Names. He then concluded the Domain Names were each Abusive Registrations. The Expert declined to find that delay on the part of the Complainant was a factor which altered this conclusion. He ruled that the Domain Names should all be transferred to the Complainant. The full text of the Expert’s decision is available on Nominet’s website.

4. The Nature of This Appeal

Paragraph 10.a. of the Policy provides that: “The appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters”. The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits. Therefore it is not necessary to analyse the first instance decision in any detail.

For convenience the Panel will continue to refer to the parties as the “Complainant” and “Respondent”.

5. Formal and Procedural Issues

The Respondent has filed a supplemental statement in accordance with paragraph 13.b. of the Procedure. Having read the initial explanatory paragraph the Panel decided it would read the entire statement. In its discretion the Panel has decided to admit this statement. This is because:

- The substance of the statement is to advance a case (not previously before the Expert) that the starwars.co.uk domain name had previously been registered by the Complainant and then allowed to lapse.
- This allegation is not disputed.
- This new case puts the starwars.co.uk domain name on the same footing as the star-wars.co.uk domain name, where such a case (as to the Complainant’s prior ownership and subsequent lapse) had been advanced before the Expert.
- It seems to the Panel desirable to consider the case on the correct, undisputed facts, and allowance of the submission does not materially alter the nature of the case as a whole.

The Respondent appears now to suggest that the 2014 Domain Names may be transferred to the Complainant on a “without prejudice” basis. The Panel is not entirely sure what the Respondent means in this regard. The Complainant appears to assume that the Respondent has simply conceded in relation to the 2014 Domain Names and says they can be transferred without further consideration. The Panel is not sure that is correct and in the interests of certainty and finality proposes to deal with the 2014 Domain Names in this Appeal. In this regard the Panel rejects the suggestion made by the Respondent that the 2014 Domain Names should properly be dealt with in separate proceedings. The parties in relation to all of the Domain Names are the same, the same trade mark is relied upon and the underlying facts are common in large measure to all of the Domain Names. Paragraph 3.d. of the Procedure clearly allows a complaint to relate to more than one domain name, providing that all such domain names are registered to the same respondent, as is the case here. It is however convenient for this decision to consider firstly the position in relation to the 2003 Domain Names,

which are at the heart of this case, and then consider the 2014 Domain Names separately.

6. The Facts

The Complainant is a film and television production company founded by the filmmaker George Lucas in 1971. The Walt Disney Company acquired the Complainant in 2012 at a valuation of \$4.06 billion.

The Complainant has produced six films in the well known “Star Wars” saga (the films were released chronologically in a different order from the timeline of events depicted in the saga, hence the apparent inconsistency in the dates shown below):

Star Wars: Episode I - The Phantom Menace (1999)
Star Wars: Episode II - Attack of the Clones (2002)
Star Wars: Episode III - Revenge of the Sith (2005)
Star Wars: Episode IV - A New Hope (1977)
Star Wars: Episode V - The Empire Strikes Back (1980)
Star Wars: Episode VI - Return of the Jedi (1983)

The Complainant's latest film is known as “Star Wars: Episode VII - The Force Awakens” and is due for release in December 2015.

The Respondent runs a business in the United Kingdom which trades as “Jokers Masquerade” and which sells fancy dress costumes. Its main website is to be found at www.joke.co.uk. The Domain Names are all used in respect of web addresses which redirect to a web page found at <http://starwars.co.uk/>, that advertises the Respondent's business as follows:

Welcome to the Jokers' Masquerade collection of Star Wars costumes and dress up accessories. Here you will find a Star Wars costume for child or adult alike and including your pet dog! We do not supply character figures or toys, but we do sell costume kits and even lightsabers.

Please note that by clicking on any link of this page, you will be directed to the appropriate product on our main Jokers' Masquerade fancy dress website.

Underneath this statement is a series of images of Star Wars costumes and accessories which relate to characters from the Star Wars films, and even further down the page, amongst further information about the Star Wars costumes, is the following text:

Jokers' Masquerade has the largest online collection of adult fancy dress costumes and Halloween costumes in the UK today. We also stock a huge selection of fully licensed authentic Star Wars costumes and accessories. We have been selling on the Internet since 2001 and there are over 10,000 costumes and accessories to choose from for any fancy dress idea or theme. There is a whole section devoted to Starwars costumes and you will find

costume ideas for all the popular characters within the Star Wars universe to suite [sic] all budgets.

Clicking on any of the costume images on this page re-directs the visitor to sub-pages within the Respondent's main joke.co.uk website, which offer for sale fancy dress outfits that relate to characters from the Star Wars films. It is also possible from these sub pages to access other areas of the Respondent's website selling products relating to other well-known film brands, unrelated to the Star Wars films.

7. Matters not in dispute

It is convenient to identify matters that at least so far as this Appeal is concerned are not in dispute. These are as follows:

- a) The Complainant has Rights in the trade mark "Star Wars" (see discussion below).
- b) The Complainant's films are well known.
- c) Each of the Domain Names is either identical or similar to the Complainant's trade mark.
- d) At no time has the Complainant authorised the Respondent to use the term "Star Wars" in relation to its business.
- e) All of the "Star Wars" products offered by the Respondent are genuine products in the sense they are all produced under licence from the Complainant.²
- f) The Respondent has carried out that aspect of its business which utilises the Domain Names since 2003.
- g) Each of the 2003 Domain Names was at one stage prior to the Respondent's registration in 2003 registered by the Complainant. Those registrations were allowed to lapse at some date prior to the Respondent effecting its registration.

8. The Parties' Contentions

The Complaint

Rights

As mentioned above, it is not in dispute that the Complainant has Rights in the trade mark "Star Wars" and that each of the Domain Names is either identical or similar to the Complainant's trade mark. The Panel therefore does not propose to set out in detail the Complainant's submissions on its Rights.

Essentially, in its Complaint, the Complainant relied on its well-known films in the Star Wars saga and a number of registrations covering a range of goods and

² There is an allegation that one product offered by the Respondent was unauthorised by the Complainant, but the Panel regards the evidence in support of this allegation as unproven and proposes to discount it.

services for its trade mark including five UK trade mark registrations and one Community trade mark registration registered between 1984 and 2001.

The Complainant said that, leaving aside the generic suffixes “.co.uk” and “.uk”, the Domain Names comprised the term STARWARS either joined together, with a hyphen separating the two words or with the addition of the letters “co” which made little or no difference to the overall impression or impact of the Domain Names.

Abusive Registration

The Complainant said that the Domain Names all resolved to the Respondent’s website at www.starwars.co.uk offering for purchase costumes of characters from the Star Wars saga and that the Domain Names were registered by the Respondent without the Complainant’s authority. It said that, in light of the reputation of the trade mark and content of the Respondent’s website, the Respondent must have been aware of the Complainant’s existence and rights at the time of registration of the Domain Names.

The Complainant said that the 2014 Domain Names were registered very shortly after it wrote to the Respondent on 12 June 2014 to put the Respondent on notice of its rights and to demand transfer of the 2003 Domain Names. It said that registration of the 2014 Domain Names, in the face of its prior objection, represented a clear intention to acquire domain names as blocking registrations against a name in which the Complainant had Rights and to unfairly disrupt the Complainant’s business.

The Complainant asserted that, as the Domain Names incorporated its trade mark, which could not sensibly refer to anyone else, there was a severe risk that a search engine being used for its trade mark would produce high up the list the URL for the websites connected to the Domain Names. In this respect the Complainant quoted from the document published by Nominet which provides an overview of Experts’ approach to issues arising under the Policy and Procedure (available at <http://www.nominet.uk/disputes/resolving-domain-disputes/drs-guidance>) (the “Experts’ Overview”).

The Complainant said that, similarly, since the Respondent had made slight variations to the Complainant’s trade mark there was a risk that an Internet user guessing the URL for a website owned by the Complainant would end up at the Respondent’s website. Thus speculative visitors to the Respondent’s website would do so in the hope and expectation that the website was operated or authorised by, otherwise connected to, the Complainant.

The Complainant said that the confusion caused was evidence of Abusive Registration and was compounded by the content of the Respondent’s website. It noted that the Domain Names all resolved to the Respondent’s website where users could purchase Star Wars costumes and accessories. It said that, through the search facility and drop down menus at the home page, the website then directed visitors to a wide range of goods offered by the Respondent which had no connection to the Complainant or its trade mark. The Complainant asserted that the Domain Names were being used to attract users to the Respondent’s business

in order to sell the Respondent's goods to those users and that, rather than use its own www.joke.co.uk website, the Respondent had chosen to use the Domain Names in order to benefit from the "pulling power" of the Complainant's trade mark. Thus the Respondent was taking advantage of the reputation of the Complainant's trade mark for financial gain and there was serious potential for disruption to the Complainant's business. This disruption was increased by the fact that the Respondent's website had offered unlicensed goods alongside licensed "Star Wars" products. The Complainant said that it had confirmed this by obtaining a test purchase of an unlicensed product (a double ended sword) from the Respondent's website.

The Complainant also considered that registration of the Domain Names had the effect of blocking the Complainant from registering the Domain Names. The goods offered on the Respondent's website were of the same type as those provided by the Complainant through the website of its parent company The Walt Disney Company at www.disneystore.co.uk/star-wars/mn/1339001 and were covered by the Complainant's trade mark registrations.

Lastly, the Complainant submitted that the Respondent was engaged in a pattern of registrations where the Respondent was the registrant of domain names which corresponded to well-known names in which the Respondent had no apparent rights (a factor constituting evidence of Abusive Registration in paragraph 3.a.iii. of the Policy). In support the Complainant said that a search of the Nominet database revealed that the Respondent was the registrant of the following domain names which incorporated the trade marks of third party brand owners:

- <austinpowers.me.uk>
- <littlebritaincostume.co.uk>
- <power-ranger.co.uk>
- <harrypottercostume.co.uk>
- <batmanfancydress.co.uk>

The Response

The Respondent contended that, after ten years of the Respondent being the registrant of the starwars.co.uk Domain Name, the Complainant was now trying to obtain the transfer of this Domain Name so that it could obtain the shorter starwars.uk Domain Name.

In support the Respondent said that starwars.co.uk was initially registered to a third party on 22 January 2003, that it was transferred to the Respondent on 23 March 2005 and that the Respondent paid the original registrant an amount of money in consideration of the transfer. Further, star-wars.co.uk was initially registered on 1 May 1997 to a now dissolved company and it appeared that this Domain Name was transferred to the Complainant on 14 June 2001 and subsequently was in a Detagged status from 22 October 2001 and in the public domain until the Respondent registered it on 19 March 2003. The Respondent asked: (1) why the Complainant did not register the starwars.co.uk and star-wars.co.uk Domain Names in these earlier years; (2) although star-wars.co.uk was transferred to the Complainant in 2001 why the Complainant let it lapse into Detagged status later that year; and (3) in 2001 when star-wars.co.uk was

transferred to the Complainant, why did the Complainant not register the starwars.co.uk Domain at that time? The Respondent's conclusion was that the Complainant must have been aware of the starwars.co.uk and star-wars.co.uk Domains and have decided that they were not important to the Complainant.

The Respondent said the correspondence from the Complainant's agent in June 2014 only referred to the starwars.co.uk Domain and the Respondent responded asking why the Complainant was making such a demand some ten years after the Respondent became the Registrant and suggesting that the reason was that Nominet had introduced the shorter .uk domain just two days prior to the date of the Complainant's agent's letter. Thus the Respondent assumed that the Complainant wanted to register the shorter starwars.uk domain but discovered that the right to do so would remain with the Registrant of starwars.co.uk until 2019. The Respondent believed that, if Nominet had not released the shorter .uk domain, the Complainant would never have instigated this DRS case.

The Respondent said that, in the response to the Complainant's letter, it also asked why it had not received a similar letter in respect of star-wars.co.uk and if similar letters had been sent to the Registrants of the .org.uk and .me.uk derivatives. The Respondent concluded that the Complainant had no interest in the shorter star-wars.uk Domain and that it was only interested in the shorter starwars.uk Domain.

The Respondent noted that star-wars.org.uk had not been registered as at 29 April 2015 and went on to ask if DRS complaints had been made in respect of starwars.me.uk, star-wars.me.uk and starwars.org.uk, which were all registered by third parties. The Respondent had been trying to contact one of the Registrants to this end but, at the time of preparing the Response, it could not establish if that Registrant had received any communication from the Complainant's agent or from Nominet.

The Respondent concluded that, although the Complainant could show Rights, it had failed in its own due diligence to exercise those Rights in previous years and that its motivation was to obtain the shorter starwars.uk Domain.

The Respondent asserted that the Domain Names had only been used to host a portal website that redirected to its Jokers' Masquerade website which only sold legitimate and licensed Star Wars merchandise purchased from the Complainant's authorised manufacturer. The Respondent said that the websites had never sold or linked merchandise to any other third party or that the Domain Names had been offered for sale, rent or other reward due to their trade marked name.

The Respondent's primary domain was joke.co.uk. The Respondent said that, with due diligence, it registered the joke.uk, jokeco.co.uk and jokeco.uk domain names because it became apparent that, unless it did so, it could become exposed to cybersquatting or other competitor mischief thereby gaining unfair advantage. The Respondent gave an example where this had happened to a competitor. The Respondent said that this is why it registered the starwarsco.co.uk and starwarsco.uk Domains and not as a reaction to the Complainant's letter.

The Respondent denied that the Domain Names linked to pages on its website offering goods not connected with the Complainant. It said that any hyperlink from the Domain Names had a click-through URL of <http://www.joke.co.uk/star-wars-costumes/>, which was a dedicated landing page for Star Wars costumes and that, although there were other costumes on the website the landing page contained genuine licensed costumes. The Respondent also contested the Complainant's claim to have purchased an unlicensed product from its site.

The Respondent confirmed that, in 2003, 2004, 2005 and 2006, it registered a number of domains for search optimisation engine (SEO) purposes and built portal websites and said that this was a common tactic used by SEO companies. The Respondent denied that it had infringed any third parties' rights.

The Respondent acknowledged and accepted the Complainant's trade marks but denied that the Domain Names were abusive. The Respondent said that the Domain Names had never been used for any illegitimate means.

The Respondent said that the existing <http://www.starwars.co.uk> portal web page and associated URLs that link to it had been dormant for many years although, due to the release of the Complainant's new film in December 2015, it was planned for an overhaul and facelift.

Lastly, the Respondent offered to transfer the shorter starwars.uk Domain Name to the Complainant provided that the Complainant agreed that the Respondent could continue to use the hyphenated and non-hyphenated longer .co.uk Domains to sell and promote legitimate Star Wars branded merchandise.

The Reply

As regards delay in bringing the Complaint, the Complainant said that there was no limitation period for filing complaints, that delay alone was not a ground for denying a complaint and that there must be some reason as to why the delay should lead to a finding against the Complainant.

The Complainant said that the Respondent was aware of the Complainant's Rights both at the time of registration and subsequent use of the Domain Names and that the Complainant had done nothing to allow the Respondent to believe that it was entitled to use the STAR WARS trade mark for its own benefit. Further the Respondent was aware of the Complainant's explicit objection to use of the Domain Names from the date of the correspondence in 2014.

The Complainant referred to *Emirates v Michael Toth* (DRS 8634) in which the appeal panel said "*The generally held view amongst Nominet experts (and UDRP panellists) is that delay alone is not a ground on which a Complaint may be denied*". The Complainant noted that the appeal panel accepted that there might be a case for delay or acquiescence to a complaint amounting to a defence under the Policy where the delay was such as to prejudice the proper consideration of the issues but, in this case, there was no such prejudice. The Respondent had not alleged that there would be any such prejudice or that the delay had in any way impeded the Respondent's ability to defend the case; nor had the Respondent alleged that there had been any acquiescence on the part of the Complainant

which had in some way caused detriment to the Respondent. The Complainant referred to Novartis AG v C Blatchley T/A The Discount Lens Co (DRS 13281) in which the Expert emphasised that he must consider whether “*a decision to ignore the delay or not will bring about a result which is, in all the circumstances, unfair or unconscionable*”. The Complainant submitted that there was no reason why it should be unfair or unconscionable for it to now seek to prevent the Respondent from continued unauthorised use of its STAR WARS trade mark, nor had any such reason been offered by the Respondent.

The Complainant said that in numerous DRS cases, the registration of domain names essentially identical to a complainant’s trade mark had been held to be abusive even if the domain names were used for websites selling the complainant’s own products. This was because of the impression given that the registration and subsequent use were authorised or otherwise approved by the complainant when it was not.

The Complainant submitted that, in this case, the position was even worse because the Respondent was not selling only the Complainant’s products and the Complainant disputed the Respondent’s contention that the Respondent’s website only sold Star Wars branded costumes and did not link to any other third party merchandise. It said that clicking on any link on the website www.starwars.co.uk would take a user to the Respondent’s website at www.joke.co.uk/star-wars-costumes/, on which a further click on any of the links on the drop-down menu would take the user to merchandise of third parties. This would therefore draw users to the Respondent’s website purely as a result of the attraction of the STAR WARS trade mark and those users would then very likely end up purchasing goods which either had no connection to the Complainant or were unlicensed goods. In many cases these circumstances had been held to be Abusive Registration. The Complainant said that in Epson Europe BV v Cybercorp Enterprises (DRS 03027) the appeal panel considered that “*confusion that may arise, irrespective of the content of the respondent’s site, merely as a result of the adoption of a domain name incorporating the complainant’s mark, can legitimately be taken into account and that this so-called “initial interest confusion” is an admissible species of confusion in DRS cases*”.

The Complainant said that the Respondent appeared to be suggesting that the Respondent registered the starwarsco.co.uk and star-warsco.uk domains to prevent cybersquatters or competitors from taking unfair advantage of its business. The Complainant disputed this suggestion and said that the Respondent had no reputation or goodwill in STAR WARS to be taken advantage of by third parties. The registration of seven separate STAR WARS domain names incorporating the Complainant’s trade mark suggested to the Complainant that the Respondent was attempting to corner the market in “.uk” domain names incorporating the Complainant’s trade mark. The Complainant quoted from a UDRP case which stated “*the respondent must not try to corner the market in relevant domain names, thus depriving the trade mark owner of the opportunity to reflect its own mark in a domain name*” and said that this was further evidence of Abusive Registration.

As evidence of the test purchase of an unlicensed Star Wars product from the Respondent’s website, the Complainant submitted a copy of an invoice for the

purchase of a “Double Ended Sword (with sound) RED”, which it stated (without explanation) was not a licensed product.

Lastly, the Complainant said that the Respondent’s intention that the website to which the Domain Names resolved was to receive “an overhaul and facelift” due to the release of the Complainant’s new film in 2015 was further evidence of the Respondent’s intention to benefit from the “pulling power” of the STAR WARS trade mark and to take advantage of the Complainant’s reputation for its own financial gain.

Appeal Notice

The Respondent challenges the Expert’s findings in respect of 3.a.i.C. and 3.a.ii. of the Policy and the Complainant’s delay and says that it will demonstrate that time must be of the essence.

3 a i B of the Policy

The Respondent wishes “the shorter .uk Domains” to “be transferred without prejudice”, the decision to be reversed for both the 2003 Domain Names and all *co.co.uk Domains to be expunged from the Complaint and to be tagged as RESERVED. The Respondent submits that each Domain Name should have a decision made on its own merit and not batched as one complaint.

The Respondent says that, following Nominet’s release of the .uk suffix on 10 June 2014, as part of its company strategy, it registered its .uk Domains in order to use them as URL shorteners within Twitter and Google Adwords. As due diligence mandated a threat that competitors could hijack malformed URLs (consumers missing the period to truncate) the Respondent registered starwarsco.co.uk, fancydressco.co.uk, jokeco.co.uk and others. The Respondent says that this was not a blocking technique but a positive initiative to secure derivatives and that, if it had not done so, someone else would have. The Respondent gave an example of this happening to another competitor. The Respondent strongly refutes “blocking tactic” accusations and says that the Domains were registered in good faith and within fair use.

3.a.i.C., 3.a.ii. of the Policy and delay

The Respondent refers to the Expert’s decision in which the Expert stated that the “name Star Wars” is “a unique term cloned by the Complainant for the purposes of a science fiction film released in 1977”. The Respondent highlights the year “1977”.

The Respondent also quotes from the Expert’s decision in which the Expert said “*The generally held view amongst Nominet experts (and UDRP panellists) is that delay alone is not a ground on which a Complaint may be denied*”. The Respondent submits that the Emirates v Michael Toth case limits to eight years and that, although the Novartis AG v C Blatchley case limits to 14 years, the focus of the latter case was that the respondent registered the domain name seven months before the filing date of the complainant’s UK trade mark.

The Respondent says that the Complainant's timing and/or delay in bringing its complaint is paramount in its appeal and that it is reasonable to conclude that time is of the essence. In support the Respondent notes that Nominet released the shorter .uk suffix on 10 June 2014, some two days before receipt of the Complainant's letter, which made no reference to the star-wars.co.uk Domain. The letter required the Respondent to release the starwars.co.uk Domain immediately, otherwise a DRS complaint would be filed. The Respondent says that the pertinent point is the short two day timescale and the one Domain.

The Respondent says that, on 8 February 2005, it acquired the starwars.co.uk Domain from John Stamford, who was the initial Registrant from 22 January 2003. The Respondent submits that the Complainant had no interest in this Domain since 1977, passing the August 1996 epoch of the Nominet public WHOIS (nineteen years ago), through 2003 and its registration to Mr Stamford until now and asks why this was so.

The correspondence from the Complainant in 2014 made no reference to starwars.co.uk which was registered on 1 May 1997 to a company and subsequently transferred to Lucasfilm Limited on 14 June 2001. This Domain was DETAGGED from 22 October 2001 and not renewed. The Respondent registered it on 19 March 2003 from its public availability status. The Respondent concludes that the Complainant had no interest in the star-wars.co.uk Domain since 2001, some fourteen years ago, and that the Complainant let it lapse.

The Respondent concludes that the Complainant had no interest in either of the 2003 Domain Names until the release of the shorter .uk suffix and it is the Respondent's strong opinion that the Complainant tried to register the starwars.uk Domain around 10 June 2014 to find that it was reserved to the Registrant of the starwars.co.uk Domain. The Respondent says that the Complainant must have made WHOIS queries in respect of the 2003 Domain Names over the past nineteen years and, if so, would have previously registered or filed a Complaint.

The Respondent also makes comments on Rights, refers to communication it has had with the Registrants of starwars.org.uk and star-wars.me.uk and says that neither Registrant has received a complaint. The Respondent says that starwars.org.uk has not been registered and that this testifies that, although the Complainant may have Rights, the only interest is the starwars.co.uk Domain in order to obtain the shorter starwars.uk Domain.

The Respondent queries why, if the Complainant has interest in the STAR WARS mark, no actions have been instigated against other suffix derivative registrants, why star-wars.org.uk remains unregistered, and why the Complainant let starwars.co.uk lapse on 19 March 2003. The Respondent says that it cannot find any case where a complainant lets a Domain lapse, then files a complaint.

The Appeal Notice ends with a brief summary of the Respondent's conclusions on the above issues including a statement that the Respondent's opinion and of many peers is that the Complainant has waived Rights after such an extended period of abstinence.

Appeal Response

The Complainant says that it appears from the Appeal Notice that the Respondent:

- (1) agrees to the transfer of the starwars.uk, star-wars.uk and star-warsco.uk Domain Names (the “Short Domains”) to the Complainant;
- (2) considers that it is not appropriate for the Appeal Panel (and was not appropriate for the Expert) to rule on the star-warsco.co.uk and starwarsco.co.uk Domain Names. The Respondent appears to want these two Domain Names to be removed from consideration in the context of this complaint, which would then leave the Complainant to file a separate complaint in respect of them; and
- (3) considers that the Appeal Panel should reverse the Expert’s decision in respect of the 2003 Domain Names, which should not be transferred to the Complainant.

On this basis, the Complainant submits that it is not necessary for the Panel to consider its case on the Short Domains.

As regards the other four Domain Names, the Complainant submits that the Expert’s decision is correct for the reasons given by the Expert and that there is no basis or need for the star-warsco.co.uk and starwarsco.co.uk Domain Names to be considered in the context of a separate complaint. All the Domain Names are registered in the name of the same entity and are objected to by the same complainant in reliance on the same Rights, exactly the type of case which is suitable for a single decision and, contrary to the Respondent’s assertions, where appropriate the Expert distinguished between the various Domain Names and treated them differently.

The Complainant does not address each paragraph of the Appeal Notice since (as with the Respondent’s Response) in its view the majority of points raised are either irrelevant or give no indication as to why the Complaint should not succeed. However, it wishes to comment on the points below.

The Complainant says that the comments made by the Respondent under the heading “3.a.i.B. of the Policy” (blocking registrations) only relate to the Short Domains (which the Respondent has agreed to transfer) and to the star-warsco.co.uk and starwarsco.co.uk (which the Respondent wants to be removed from the Complaint). The Complainant says that, in any event the Expert correctly found that *“it is difficult to see any legitimate purpose in the Respondent’s 2014 registrations, unless the Respondent’s registration and use of the 2003 Domain Names is in fact a fair and legitimate registration and/or use, and registration of the 2014 Domain Names was for the purposes of an extension to that fair use”*. The Complainant submits that the Expert correctly found that the registration and use of the 2003 Domain Names was not a fair and legitimate registration and/or use.

The Complainant says that, in relation to 3.a.i.C. and 3.a.ii. of the Policy, the Respondent repeats what it said in its Response. The Complainant refers to its

Reply and the Expert's decision in this regard, together with the additional points below.

As regards the Respondent's comments on the Complainant allowing starwars.co.uk Domain to lapse in 2003, the Complainant submits that there are a number of cases in which an Expert had previously allowed the domain name in issue to lapse. The Complainant cites Hazel Murphy v Keith Dutton (DRS 6342) in which the Expert found:

"The Respondent takes the view that under a first come first served system, such as that operated by Nominet, he has the right to register and use any suitable domain name that he wishes. It is the very nature of a first come first served system that anyone can register a domain name that is available and they are then able to use that domain name. That of course is not an end to the matter because when someone registers a domain name they agree to abide by Nominet's terms and conditions which include a provision that the registrant is bound by the DRS Policy and Procedure. In effect, the registrant signs up to a process that allows a subsequent challenge by a third party (who has to establish some legitimate interest by satisfying the rights test) to challenge the registration and/or use of the domain name on the basis that it is, in the hands of the registrant, an Abusive Registration".

The Complainant says that there are many reasons why a domain name registrant may allow a registration to lapse – whether through inadvertence or economy or otherwise and that doing so does not in any way authorise a subsequent registrant taking unfair advantage of the previous registrant's rights in a trade mark.

The Complaint says that, so that a distracting (and, in any event, entirely irrelevant) argument is put to bed, it confirms that the release of the shorter .uk domain name extension played no part in its decision to file the Complaint. The Complainant says that, when it asked its new advisors to recover the starwars.co.uk Domain, searches revealed that the other six Domain Names had been registered by the Respondent. That is why those other six Domain Names form part of the Complaint and why the star-wars.co.uk Domain was not referred to by the Complainant's former advisers.

Finally, in relation to delay, the Complainant emphasises that the Respondent has still not offered any reason why it should be unfair or unconscionable for the Complainant now to seek to prevent the Respondent from continued unauthorised and unfair use of the STAR WARS trade mark. The Complainant submits that no such reason exists.

The Respondent's 13.b. Submission

In Section 5 of this decision, the Panel has decided to allow the Respondent's request to make a submission under paragraph 13.b. of the Procedure. Details of the submission are therefore set out below.

The Respondent says that, in its Response and Appeal Notice, it had put forward the position that the non-hyphenated starwars.co.uk Domain Name was previously

registered to John Stamford who the Respondent perceived to be the original registrant from January 2003. However, this turns out not to be correct.

The Respondent says that, in August 2015, Nominet confirmed that it does not undertake research on behalf of parties to the DRS and does not make historical registration information available to third parties unless it is specifically requested to do so. The Respondent had assumed that the Expert would have had access to this historical information but that is not the case.

The Respondent has now established that both the 2003 Domain Names were registered to the Complainant during the years 2000 and 2001, not renewed and let lapse into an abandoned state until 2003 when registered respectively by Mr Stamford and the Respondent.

The Respondent submits that this information is critical and that it further endorses that the Complainant had no interest in either of the 2003 Domain Names from 2001 and that it abandoned them, waiving its Rights. The Respondent says that Common Law stipulates that abandoned property is generally deemed to have been abandoned if it is found in a place where the true owner likely intended to leave it, but is in such a condition that it is apparent that he or she has no intention of returning to claim it. Abandoned property generally becomes the property of whoever should find it and take possession of it first.

The Respondent submits that its Response and Appeal Notice would be more forceful of waived Rights via abandonment if it were privy to more detailed historical information of starwars.co.uk in 2001. The Respondent still believes that the Complainant has no interest in any of the contested Domain Names other than the shorter starwars.uk suffix Domain.

The Respondent repeats the outcome it requires as set out in its Appeal Notice and says that it cannot find any similar case where a complainant abandons a domain then files a DRS complaint of abuse after twelve years.

9. Discussion and Findings

General

In order to succeed the Complainant must prove, on the balance of probabilities, in relation to each of the Domain Names, two matters, 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.

These terms are defined in the Nominet DRS Policy 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.

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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

First Element – Rights

It appears that there is no dispute between the parties about this issue – it is accepted that the Complainant does have Rights in respect of the name and mark STAR WARS and that this is identical or similar to each of the Domain Names. For completeness the Panel notes that the Respondent appears to take issue in this regard with the fact that the Complainant has not asserted its Rights against various other domain names which include the term “starwars” in their name, but it does not so far as the Panel can see actually dispute that the Complainant has Rights. Were there any doubt about this the Panel would in any event hold that the Complainant has such Rights. Accordingly the Complainant succeeds in establishing this limb of its case.

Second Element – Abusive Registration

It is quite clear that the Respondent chose the 2003 Domain Names because of their correspondence to the Complainant's STAR WARS mark and that it thought they would be useful or effective for that part of its business which involved selling fancy dress costumes relating to the Star Wars films. The Panel agrees with the Complainant that this was use of the “pulling power” of the Complainant's trade mark to attract business.

Paragraph 3.a. of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The most directly relevant of these to the present circumstances is 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;”

The Expert's Overview explains this as follows:

“The ‘confusion’ referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it 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”?

It has been generally accepted that where the Domain Name in question is in substance an unadorned reproduction of a Complainant's trade mark (or a minor variant thereof) without any additional modifying terms, that will suffice to establish such confusion, even if a visitor to the website linked to the Domain Name would realise once they got there that the site itself was nothing to do with the Complainant. See, for example, Urban Outfitters, Inc. v Lim Chu Ltd (DRS 10987) concerning numerous domain names that comprised minor typographic variations of <urbanoutfitters.co.uk>.

See also the Appeal decision in GuideStar UK -v- Wilmington Business Information Limited (DRS 02193) in which the Panel stated:

“Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is”.

The Panel in the present case agrees with that view and considers it equally applicable to a domain name which corresponds to a famous and well known trade mark belonging to a complainant. It does not matter that any visitor who reaches a website linked to the domain name may then realise it is not the trade mark owner's website. To quote the Overview again:

“Commonly, Internet users will visit web sites 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 web site 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 web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site “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 web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name. In the High Court decision Och-Ziff Management Europe Ltd v Och Capital LLP [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being “a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant's conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase”. In that case the

court held that initial interest confusion is legally actionable under European trade mark legislation.”

In the present case although the term “starwars” is not the name of the Complainant it is a term which is well known and widely recognised as describing the Complainant’s films and the Panel considers the above stated principles are equally applicable.

The Panel is aware that subsequent to the publication of the Experts’ Overview and the passage quoted above, the doctrine of “initial interest confusion” was further considered by the Court of Appeal in Interflora v Marks and Spencer [2014] EWCA Civ 1403. In that case the Court stated:

“154. As the passage of the main judgment we have cited immediately above makes clear, the judge considered the doctrine of initial interest confusion in some detail in his judgment in Och-Ziff Management Europe Ltd v OCH Capital Ltd [2010] EWHC 2599 (Ch), [2011] ETMR 1. As he there explained, initial interest confusion is an expression which derives from US trade mark law and has been used to encompass a range of situations, and the doctrine it identifies is highly controversial. For the purposes of that decision, he defined it (at [87]) as confusion on the part of the public as to the trade origin of the goods or services in relation to which the impugned sign has been used arising from use of the sign prior to purchase of those goods or services, and in particular confusion arising from use of the sign in promotional or advertising materials. He went on to hold (at [101]) that, as so defined, it was actionable under Article 9(1)(b) of the Regulation.

155. In our judgment it is not helpful to seek to import the doctrine of initial interest confusion into EU trade mark law, at least so far as it applies to the use of a sign the same as or similar to a trade mark as a keyword in an internet referencing service, and it has the potential positively to mislead. We say that for the following reasons. The Court of Justice has already enunciated in clear and unambiguous terms the test that must be applied under the Directive and the Regulation in determining whether the accused sign has an adverse effect on the origin function of the trade mark. As we have seen, it did so first in Google France in addressing Article 5(1)(a) of the Directive (and Article 9(1)(a) of the Regulation) and then again in BergSpechte and Portakabin in addressing both Article 5(1)(a) and (b) (Article 9(1)(a) and (b)). In either case it must be shown that the advertisement does not enable an average internet user, or enables that user only with difficulty, to ascertain whether the goods or services referred to therein originate from the trade mark proprietor or an undertaking economically connected to it or, on the contrary, originate from a third party. Of course, Article 5(1)(a) and Article 9(1)(a) also afford protection against use in this way of a sign identical to the trade mark if that use is liable adversely to affect one of the other functions of a trade mark, as the Court elaborated in its decision in Interflora (CJEU).

156. These tests have been formulated by the Court with great care and reflect the importance of trade marks in developing a system of undistorted competition whilst recognising that their purpose is not to protect their proprietors against fair competition. Moreover, the Court has acknowledged that internet advertising on the basis of keywords corresponding to trade marks is not inherently objectionable

because its purpose is, in general, to offer to internet users alternatives to the goods or services of the trade mark proprietors. The tests enunciated by the Court therefore incorporate appropriate checks and balances. In particular, the national court is required to consider the matter from the perspective of the average consumer, a concept we have discussed, and to decide whether the advertiser has enabled that average consumer to ascertain the origin of the advertised goods or services and so make an informed decision. We would emphasise it is not the duty of such advertisers to avoid confusion.

157. Returning now to the doctrine of initial interest confusion, it is, as the judge recognised, highly controversial and, as he also recognised, it has been applied to a range of situations in which a sign which is the same as or similar to a registered trade mark is used by a third party in advertisements for goods or services for which it is registered. They extend from, at one end of the spectrum, initial attraction of consumers based upon some kind of association of advertised goods or services with those of the trade mark proprietor or even mere diversion, to, at the other end of the spectrum, initial confusion which gives rise to a real risk that consumers will actually buy the advertised goods or services even though they know they are not the goods or services of the trade mark proprietor. Second, and significantly, it does not incorporate the checks and balances to which we have referred.

158. In our view the doctrine of initial interest confusion is therefore an unnecessary and potentially misleading gloss on the tests the Court has articulated and we think it should perform no part of the analysis of our national courts in claims of the kind before us. We consider the judge was therefore wrong to approach the matter as he did.”

Whilst there are similarities between aspects of the Policy and trade mark law it is in the view of the Panel important to note that the Policy is not a replication of trade mark law. As the introduction to the Experts’ Overview puts it

“Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the registrant’s use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy. Nonetheless, if the DRS Policy and the law are too far apart, the DRS Policy will inevitably lose some of its value. Rights owners or domain name registrants (depending upon the nature of dispute) may prefer the expense of litigation to the likely result under the DRS Policy.”

As the Panel understands it the Court of Appeal’s decision in the *Interflora* case (supra) is directed at cases involving the use of trade marks as “key words” in relation to Internet advertising. Whether the criticism of “initial interest confusion” is of wider and more general application is not for the Panel to say. However so far as the Policy is concerned the Panel is of the view that in relation to domain names, initial interest confusion remains a relevant and helpful concept and is applicable in determining whether or not a registration is Abusive.

In this regard the use of an “unadorned” trade mark as a domain name is to be contrasted with the situation where a trade mark with a modifying term is used. Thus in Toshiba Corporation and Power Battery Inc. (DRS 07991), an appeal

decision concerning the Domain Name <toshiba-laptop-battery.co.uk>, the Panel stated:

“The view of the majority of the Panel is that the Complainant has not demonstrated, on the balance of probabilities, that the Respondent’s use of the Domain Name would be likely to give rise to any such confusion. The majority panellists do not consider that either the Domain Name itself or the results of a search of the terms in question would be likely to result in any such confusion in the mind of the average Internet user, bearing in mind that a typical search page includes a short description of each “hit” as well as the actual domain name. So far as the name itself is concerned, the majority Panel believes that the Domain Name in this case falls into a very different category from cases involving the “unadorned” use of a trade mark (e.g. <toshiba.co.uk>), where Internet users may be presumed to believe that the name belongs to or is authorised by the complainant. In this case, two extra hyphenated words turn the domain name as a whole into a rather clear description of the main goods on offer at the website (replacement batteries for Toshiba laptop computers). In addition, this lengthy “adornment” may reasonably be seen as atypical of the usage of major rights owners, who are free to use much shorter unadorned names.”

The Panel in the present case agrees with this approach. It follows that in the view of the Panel the unadorned use of “starwars.co.uk” or “star-wars.co.uk” does amount to a use that 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” within the meaning of paragraph 3.a.ii. of the Policy. The Panel observes that the same analysis would not be the case if the domain name was for example “starwars-fancy-dress.co.uk”³.

The Panel concludes that this was the case both when the 2003 Domain Names were registered, and in relation to their subsequent use.

Other Considerations

The question that then arises is whether the particular circumstances of this case are such as to mean that, despite this finding, the Domain Names are not Abusive Registrations. There are three different factors to be considered. The first is the abandonment of the earlier registration that the Complainant held for the 2003 Domain Names. The second is whether the Complainant’s alleged non-action against various third parties precludes a finding in its favour in this case. The third factor is delay generally, and the length of time that has elapsed between the Respondent registering the 2003 Domain Names and the filing of the present Complaint.

It is to be noted that the Complainant has provided very little factual information about these matters. It has not explained the circumstances which resulted in its abandonment of the 2003 Domain Names nor has it said when it became aware of the Complainant’s use of the 2003 Domain Names. It in effect says that these

³ Whether or not the registration or use of such a name could be abusive for other reasons, for example the availability of other non-Star Wars costumes on the Respondent’s website, would involve further consideration of the facts but does not need to be decided here.

matters are not relevant. It accepts that delay might be a relevant consideration if it in some way impeded the Respondent's ability to defend its position, but says that is not the case here. It also appears to accept (at least impliedly) that delay might be relevant if it involved some sort of affirmative indication to the Respondent that the Complainant was prepared to allow its conduct, but again says that is not the case here.

Abandonment of the 2003 Domain Names

There are many potential domain names open to brand owners to adopt. Assuming a brand owner seeks to acquire one or more domain names that are identical to a given brand it is then faced with a choice between general, non country specific top level domains ("TLDs") (such as for example .com names) and country code TLDs. It may then also have a choice within such TLDs as to available sub-domains (such as here .co.uk).

Country code TLDs broadly correspond to the international standard ISO 3166-1 listing of two letter designations for countries, with some variations (including ".uk" – the ISO designation for the United Kingdom is "gb"). There are nowadays approximately 290 country code TLDs in existence. There is also an increasingly wide range of non-country-specific TLDs available (there are now over 700 of these with more being added).

Given this background (and noting that the position was somewhat simpler in 2003) the Panel considers that it cannot be the position that the question of whether a registration is Abusive depends on whether or not a brand owner has sought to obtain the relevant registration itself, or having at one time obtained a registration allows it to lapse. Brand owners are entitled to prioritise what domain names they acquire, keep and use. They do not have to register or hold onto every domain name containing their brand name in order to be able to assert that other registrations for that brand name are abusive. The system of registration of domain names is not a system of property as such, but rather a contractual system of registration, where (in broad terms) any third party can obtain, without any checks, an unregistered domain name which corresponds to a person's name or brand. Just because that latter person has not itself registered its name or brand as a domain name within the relevant TLD, or has allowed a previous registration for the domain name to lapse, does not mean that it consents to that domain name being used by third parties, or that third parties are free to adopt that domain name and use it in a way which otherwise amounts to an Abusive Registration.

Contrary to the Respondent's submissions the Panel does not consider the dropping of a domain name registration by a brand owner to be analogous to a person leaving tangible property (for example old furniture) by the wayside where any passerby can take it. Nor is it analogous to the concept of "adverse possession" in relation to real property, where actual occupation of land without consent may, after time, defeat an anterior title. A property owner in those examples would know (or be advised) that they would not be able to reclaim the property concerned, based on the law that has developed in relation to tangible and real property. In contrast, a brand owner who drops a domain name registration does so in the knowledge that any third party who chose to re-register

the domain name would have to enter into a registration agreement which contains measures designed to enable the brand owner to obtain the cancellation or transfer of the domain name if it is an Abusive Registration.

The Panel accordingly does not consider that the Complainant's prior registration and abandonment of the 2003 Domain Names at some earlier date precludes a finding now that the 2003 Domain Names are Abusive.

Lack of Action against Third Parties

The Panel considers that the fact that the Complainant has not brought complaints or other proceedings in relation to other domain names which include the term "starwars" (assuming for these purposes that the allegation is true) should not preclude the Complainant from succeeding in this Complaint. A complainant is not required to fight its battle on all possible fronts but can choose which action to take. Its choice will no doubt be influenced by a multiplicity of factors, most of which will probably not be known to a Panel considering a given case. A Panel simply has to decide the case before it on its own merits. Conceivably there might be cases where there are so many other domain names in existence and use that a Panel could conclude that the scale is such as to render the registration before it non abusive, but in the present case the evidence before the Panel does not establish that type of situation.

Delay Generally

As a starting point in relation to this issue the Panel notes that the Policy itself says nothing about delay, nor does it contain any provisions requiring a Complaint to be brought within a specific time limit after the date of registration of a domain name. The Expert's Overview also contains no guidance on this issue. The Panel also notes that as a matter of English law delay per se would not prevent an action to restrain ongoing acts of trade mark infringement⁴. Whilst a Complaint under the Policy is not the same as an allegation of trade mark infringement it does seem to the Panel that the same broad approach to delay is desirable. It would be undesirable for the Policy to be applied in such a way as to preclude a complaint purely on the basis of delay, if the effect was to force the Complainant to undertake litigation in relation to the same set of facts, and where the litigation was not barred by delay. The circumstances in which delay and other related considerations may operate as a defence to litigation are considered further below. Overall however the Panel considers that, where the use complained of is ongoing, then delay alone should not automatically preclude a complaint being brought.

It is nevertheless the case that the list of factors which may lead to a finding that a domain name is not an Abusive Registration, as set out in paragraph 4 of the Policy, is said to be non-exhaustive. The Panel concludes that in principle, depending upon the relevant facts, this means that it is open to the Panel to reach a finding that whilst delay does not automatically bar an action, delay in a specific case might be such as to mean that an otherwise Abusive Registration is

⁴ Delay may however act as a bar for damages in respect of events which occurred prior to the relevant limitation period.

acceptable. Whether in the particular circumstances of a given case that is the position would depend upon individual facts.

This approach seems to the Panel consistent with that adopted in Emirates v. Michael Toth (DRS 08634), an appeal decision concerning the Domain Name <emirates.co.uk>. In that case the Panel stated:

“The Panel accepts that there may be a case for delay or acquiescence amounting to a defence to a complaint under the Policy but is not at all satisfied that this is such a case. The delay is not such as to prejudice the proper consideration of the issues. Even if the Respondent could properly claim to have acted on the assumption that the Complainant had no objection to his registration and use of the Domain Name, we do not consider that he has suffered any unfair prejudice as a result of the delay. As we have found, he cannot be said to have developed a proper business under the Domain Name or a “genuine offering of goods or services” in the sense of paragraph 4aiA of the Policy. Rather, its use has been for click-through traffic and as a place holder for a valuable domain name. The Panel finds that the Respondent has not in reality developed a business under the Domain Name in the belief that the Complainant had no objection to his using it or with the encouragement of the Complainant.”

There is no suggestion in the present case that the delay has in any way prejudiced the Respondent’s ability to advance its case. Nor so far as the Panel can see has there been any unfair prejudice to the Respondent as result of the delay. It is the case that the Respondent has used the 2003 Domain Names in relation to a genuine offering of goods, but that has only been as an entry point for an on-line shop which is actually found on its main web site at www.joke.co.uk. It has had the benefit of the use of the 2003 Domain Names over its period of use and it is now a relatively straightforward business for the Respondent to adopt an alternative domain name for the same purpose if it wishes, or simply to continue with its business of selling Star Wars fancy dress items through a sub-domain of its main website. It also seems likely to the Panel (though no evidence has been adduced on the point) that a considerable proportion, possibly the majority, of the Respondent’s customers will be “one off” purchasers. Further issues in relation to delay might arise in relation to a domain name which had over time built up its own goodwill amongst regular customers, though any such case would require further consideration of the facts. In the present circumstances it is difficult to see why delay on its own should preclude the Complainant from now succeeding in its Complaint.

By way of ‘cross-check’, the Panel has considered whether the facts of the case would be such as to support a defence based on laches or acquiescence if a Court had found that the use of the 2003 Domain Names amounted to trade mark infringement or passing off, and was considering whether the delay and associated circumstances were such as to preclude the granting of an order requiring the Respondent to transfer the Domain Name.⁵

⁵ This hypothetical scenario is not to be taken as an indication of the Panel’s views on the merits of a Court action. It is merely used for the purpose of considering whether its proposed approach to the issue of delay is in line with what might happen in Court in a broadly analogous situation.

Laches is an equitable doctrine under which delay can bar a claim for equitable relief, even where there has been a finding of liability. It was discussed in some detail by the House of Lords (the then highest court in the UK, subsequently replaced by the Supreme Court) in a celebrated case about an individual's claim for a share of the musical copyright in the song "A Whiter Shade of Pale", which was brought 38 years after the song was first released: Fisher v Brooker and others [2009] UKHL 41. Lord Neuberger, who gave the lead opinion (with which the other four judges agreed), stated the following at paragraph 64:

"Although I would not suggest that it is an immutable requirement, some sort of detrimental reliance is usually an essential ingredient of laches, in my opinion. In Lindsay Petroleum Co v Hurd (1874) LR 5 PC 221, 239, the Lord Chancellor, Lord Selborne, giving the opinion of the Board, said that laches applied where "it would be practically unjust to give a remedy", and that, in every case where a defence "is founded upon mere delay ... the validity of that defence must be tried upon principles substantially equitable." He went on to state that what had to be considered were "the length of the delay and the nature of the acts done during the interval, which might affect either party, and cause a balance of justice or injustice in taking the one course or the other, so far as relates to the remedy."

Acquiescence was not dealt with separately in any detail in Fisher v Brooker, though Lord Neuberger expressed the view (at paragraph 62) that, at least in cases such as that one, acquiescence does not add anything to arguments of laches and estoppel (the Panel in the present case does not consider it necessary to consider estoppel as a separate doctrine, given that there are no facts in the present case which could be said to support an estoppel claim, nor has the Respondent raised such an argument). As in the case of laches, mere delay in exercising a right is not enough to establish a defence of acquiescence; an extra element is required. Essentially, acquiescence on the part of a claimant seeking to exercise a legal right will not deprive them of the right unless it is of such a nature and in such circumstances that it would be unconscionable of the claimant to rely on it: Shaw v Applegate [1977] 1 WLR 970 (CA).

It can be seen that a court's assessment of arguments based on laches and acquiescence in cases of delay brings into play the same kind of factors as were taken into account in Emirates v Toth, which have already been discussed above in relation to this case. While the length of the delay plays a part, so do the activities and behaviour of each party, as well as the impact on both parties of the relief that is being sought.

In this case, there is no evidence that there would be any more difficulty for the Respondent in re-situating the entry point to his business of selling Star Wars fancy dress items than there would have been if the Claimant had taken action within a short period of the Respondent's first use of the 2003 Domain Names in its business. As stated above, the steps that it would need to take appear to be relatively straightforward. Further, there is no evidence of the Complainant having behaved in a way that would make it unconscionable to act now: in the Panel's assessment, its mere historic inaction (including against certain third parties) – with or without knowledge of the Respondent's activities – is not enough. The Respondent has not suggested that it was encouraged by the Complainant to use the 2003 Domain Names or that the Complainant gave any indication that it

would not take action. In the Panel's assessment, it would be neither unconscionable nor unjust for the 2003 Domain Names to be held to be Abusive Registrations.

Accordingly, the Panel declines to find that delay precludes the 2003 Domain Names from being Abusive Registrations.

The 2014 Domain Names

Like the 2003 Domain Names, two of the 2014 Domain Names, <star-wars.uk> and <starwars.uk> comprise the unadorned famous trade mark of the Complainant followed by a generic internet suffix. They also both point to the Respondent's web page at <http://starwars.co.uk/>, promoting the Respondent's business in selling Star Wars and other fancy dress costumes, and leading to the Respondent's main www.joke.co.uk website. Given that the Panel has already found the <starwars.co.uk> Domain Name to be an Abusive Registration, the same result is inevitably reached in relation to these two Domain Names.

The remaining three Domain Names <star-warsco.uk>, <star-warsco.co.uk> and <starwarsco.co.uk> differ only in the addition of "co" to the end of the "starwars" or "star-wars" element. They too point to the Respondent's web page referred to above. In the Appeal Notice, the Respondent submitted that the reason for acquiring these Domain Names was in order to capture malformed URLs which internet users sometimes type in, e.g. by omitting the full stop before the "co" of ".co.uk" and to acquire derivative domain names which third parties might otherwise register in order to get close to its core "starwars" and "star-wars" based domains. In the Panel's view, the added "co" element does not provide the Respondent with any additional argument for escaping the conclusion that these Domain Names are also Abusive Registrations.

Pattern of registrations

Under paragraph 3.a.iii. of the Policy, one of the factors that may indicate that a domain name is an Abusive Registration is that 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 trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

The Complainant relied on the Respondent's registration of five other domain names containing recognisable names of film and TV characters and brands (such as Austin Powers, Harry Potter and Batman) as evidence of a pattern of registrations of which the Domain Names formed part. Given the findings made above, the Panel does not need to make a finding in this regard. However, it observes that three of the five domain names relied on contain the word "costume" or "fancydress" after the brand concerned, and could potentially be distinguished on that basis, and – in contrast to the Domain Names in issue – none of them (at least currently) appears to direct internet users to separate web pages relating to costumes for that brand. Therefore, the Panel declines to make a finding of a pattern of registrations in relation to those third party domain names.

10. Decision

The Appeal is dismissed. The Panel finds that the Complainant has Rights in respect of a name or mark which is identical or similar to each of the Domain Names and that the Domain Names, in the hands of the Respondent, are Abusive Registrations. Accordingly, the Panel directs that the Domain Names be transferred to the Complainant or its nominee.

Signed: Nick Gardner

Anna Carboni

David King

Dated: 07 October 2015