

Trinity Mirror PLC

-v-

Piranha Holdings

Nominet UK Dispute Resolution Service

DRS 05358

(1) Trinity Mirror PLC (2) MGN Ltd and Piranha Holdings

Complaint Reference Number 5885

Decision of Independent Expert

1. PARTIES:

Complainants: Trinity Mirror PLC and MGN Limited
Both of
One Canada Square
Canary Wharf
London
E14 5AP
GB

Respondent: Piranha Holdings
150 Randall Street
Oakville
Ontario
L6J 1P4
CA

2. DOMAIN NAME:

dailymirrorbingo.co.uk (“the Domain Name”).

3. PROCEDURAL BACKGROUND:

3.1. A hard copy of the Complaint was received in full by Nominet on 7 January 2008. Nominet validated the Complaint and notified the Respondent of the Complaint.

3.2. No Response has been received and therefore informal mediation was not possible.

3.3. On 15 February 2008, Nick Phillips, the undersigned (“the Expert”), confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as the Expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. OUTSTANDING PROCEDURAL ISSUES

4.1 The Respondent has not submitted a response to Nominet in time (or at all) in compliance with paragraph 5(a) of the Procedure.

4.2 Paragraph 15(b) of the Procedure provides, inter alia, that “if, in the absence of exceptional circumstances, a party does not comply with any time periods laid down in the policy of this procedure, the Expert will proceed to a decision on the Complaint”.

4.3 Nominet appears to have used all of the available contact details to try to bring the Complaint to the Respondent’s attention and indeed for the reasons I explain below it is clear that the Respondent was aware of the Complaint but failed to file a Response. Consequently, there do not appear to me to be any exceptional

circumstances involved and I will therefore proceed to a decision on the Complaint notwithstanding the absence of a Response.

4.4 I would add to this that included in the file that I received from Nominet there was some non-standard correspondence between the parties themselves and between the parties and Nominet. I should stress that this correspondence did not form part of an Informal Mediation because the absence of a Response meant that no Informal Mediation could take place nor do I think that there is any other reason why I should not refer to it in this decision. For example I do not consider that it is in the interests of justice that this correspondence be excluded from consideration as is contemplated by paragraph 6a.ii. of the Policy.

4.5 The essence of this non-standard correspondence is that in it the Respondent offers to transfer the Domain Name to the Complainants and indeed returns to Nominet the duly completed and signed transfer forms in order to transfer the Domain Name to the Complainants. The Complainants have however not accepted this offer and has instead opted to pay the applicable fee for this decision. While I find the Complainants' conduct quite unusual, and I would speculate that the Complainants feel that it is important for them to have a decision in relation to the Domain Name which obviously they hope will go in their favour, I can find nothing in either the Policy or the Procedure which prevents the Complainants from doing this and on this basis I therefore intend to go on and make a decision in the normal way.

5. THE FACTS

5.1 MGN Ltd is a wholly owned subsidiary of Trinity Mirror Plc., the UK's largest newspaper publisher.

5.2 The Complainants own a portfolio of over 500 media brands. This includes some 200 local regional newspapers, five national newspapers and well over 300 websites. Two of the best known brands in the portfolio are the UK national newspapers, the Daily Mirror (published every Monday to Saturday) and the Sunday Mirror (published every Sunday). The Daily Mirror is read by over 3,805,000 people daily.

5.3 MGN Ltd, is the registrant of the UK registered trade marks: DAILY MIRROR (504820); THE MIRROR (figurative mark) (2122294); and SUNDAY MIRROR (734316). The Complainants also own a number of domain name registrations including (but not limited to) the following:

dailymirror.co.uk
mirror.co.uk
mirrorbingo.co.uk
mirrorbingo.com
mirrorcasino.com
mirror-poker.co.uk

5.4 The Domain Name was registered by the Respondent on 20 October 2005.

5.5 In April 2005, the Complainant began offering various online services connected to the Daily Mirror newspaper, using the domains listed above including a bingo service using the domain name mirrorbingo.co.uk .

5.6 The Complainants' Mirror bingo service is outsourced to Cashcade Limited a UK based online gambling marketing company which operates an online Bingo service under the brand name "Foxy Bingo" and owns a website at www.foxybingo.com.

5.7 The Respondent is the registrant of the domain name www.foxybingo.co.uk.

5.8 Until 9 November 2007 upon entering the Domain Name into the URL address bar, the user was automatically directed to www.foxybingo.com via an affiliated link. Following the Complainant contacting Cashcade the Domain Name was prevented from resolving to the affiliated foxybingo.com link in this way.

5.9 On 12 November 2007, the Domain Name was resolved to a 'parked' webpage by a host called GoDaddy. After 20 November 2007, the Domain Name was again redirected such that it resolved to the

Complainants' Mirror bingo website at www.mirrorbingo.co.uk via an affiliated link, using the Cashcade/FoxyBingo affiliate service.

6. THE PARTIES' CONTENTIONS

The parties' contentions can be summarised as follows:

Complainants

6.1 In its Complaint, the Complainants make the following submissions:

6.1.1 The Complainants have Rights in a name or mark which is identical or similar to the Domain Name because:

- (a) The Complainants are the registered proprietors of a number of registered trade marks, details of which are set out below but which include a registration for the mark DAILY MIRROR;
- (b) The Complainants have published a daily UK national newspaper since 1903 under the mark 'MIRROR' and/or the 'DAILY MIRROR'.
- (b) The brand names the 'DAILY MIRROR' and the 'MIRROR' are seen as synonymous and indistinguishable by the public.
- (c) The Complainants own the domain names mirrorbingo.co.uk and mirrorbingo.com which are used to provide online bingo related services and which are advertised by means of a prominent tabbed link on the mirror.co.uk as well as in the Daily Mirror and Sunday Mirror newspapers;
- (d) The Complainants' website at mirror.co.uk typically receives approximately 6000 hits per week;
- (e) As a result of all this the Complainants have Rights in MIRROR, DAILYMIRROR and MIRRORBINGO

6.1.2 The Registration is an Abusive Registration under a number of provisions of the Policy as follows;

(a) Paragraph 3(a)(i)

The Complainant contends that the Respondent's registration and subsequent use of the Domain Name falls under paragraph 3(a)(i)(C) of the Policy, in that it unfairly disrupts the business of the Complainant.

Until 12 November 2007, a user entering the Domain Name as a URL address believing it related to the Complainants was automatically directed to the Foxy Bingo website. During this period the Complainants contend that they suffered loss of income as a result of this redirection, and also that the Respondent would have gained a financial benefit as a result of any user who used the bingo services obtained from that link.

From 12 to 20 November the website hosted at the Domain Name contained a large number of click-through links to third party websites. The majority of the click-through links shown on the website hosted at the Domain Name were for competitor online gambling websites (including bingo websites). The Complainants are also concerned that its leading national brand, DAILY MIRROR, suffered loss and damage being associated with other sites offering online gambling services which may not be regulated, are illegal in some jurisdictions or may be insecure.

(b) Paragraph 3(a)(ii)

The Complainants contend that circumstances indicate that use of the Domain Name was also designed to confuse people into believing that the Domain Name was registered to, or otherwise associated with, the Complainants and their own <mirrorbingo.co.uk> bingo service.

Until 12 November 2007, a user entering the Domain Name as a URL address believing it related to the Complainants was automatically redirected to the Foxy Bingo website. During this period the Complainants contend that users would have mistakenly believed they were taken to a website associated with the Complainants and their own <mirrorbingo.co.uk> bingo service.

From 12 to 20 November, much of the text and many of the links hosted at the Domain Name related to either online bingo or online gambling websites, and, as noted above, a number of the click-through links contained on the website at the Domain Name during this time were to pages containing competing products, or at least products within a related business area to that of the Complainants. To the extent that some of the links were related to the sale of the Complainants' online services or products, the user was taken to the site via a series of sponsored links.

After 20 November the Domain Name directed users to the <mirrorbingo.co.uk> website which would make the user mistakenly believe that the Domain Name is connected with the Complainants and is being used, as it was previously, to generate income by directing users to another site, i.e. for a commission.

This means that the Respondent has been and is using the Domain Name to benefit, or attempt to benefit, from the Domain Name's close association with the Complainants and their <mirrorbingo.co.uk> website.

There is no legitimate reason for the Respondent to possess the domain name <dailymirrorbingo.co.uk> and to direct it to these websites either directly or via the PPC site and it is clearly done so in an attempt to profit from the Domain Name's clear association with the business and Rights of the Complainants. The Complainants contend that such use amounts to an Abusive Registration.

(c) Paragraph 3(a)(iii)

The Complainants believe that the Respondent is engaged in a pattern of registration where the Respondent is the registrant of domain names which correspond to well known names or trade marks in which the Respondent has no apparent rights, and that the Domain Name is part of that pattern.

The Respondent owns 20 <.uk> ccTLDs. Of these domains, five are PPC Sites including <www.yahoo-bingo.co.uk> which includes a third party's trade mark. The Respondent also owns the domain names <www.worldpoketouronline.co.uk> and <www.wpt-online.co.uk>, both of which automatically redirect to <www.mansion.com>, an online poker website. They do not however appear to be affiliated in any way to the official World Poker Tour brand, which has the domain name <www.worldpokertour.com>.

The Respondent has registered <dailymirrorbingo.com> and is using it in an identical manner to the Domain Name. Although the WHOIS search lists the registrant as Domains by Proxy Inc, the domain name was registered through GoDaddy.com Inc. In addition, when entered as a URL address, both the Domain Name and <dailymirrorbingo.com> resolve to an address with an identical affiliate reference number: <http://www.mirrorbingo.com/main.php?a=636.101> (a=636.101 being the affiliate reference). Taking both these factors into account it would appear a logical conclusion that the Respondent is also the registrant behind the domain name <dailymirrorbingo.com>.

THE RESPONSE

Respondent

The Respondent has not provided a Response so there are no submissions to consider.

7. DISCUSSIONS AND FINDINGS

General

7.1 Under paragraph 2 of the Dispute Resolution Service Policy ("the Policy") the Complainants are required to show, on the balance of probabilities, that;

- (1) *it has rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- (2) *the Domain Name in the hands of the Respondent is an Abusive Registration.*

Complainant's Rights

- 7.2 The first question I must answer is therefore whether the Complainants have proved on the balance of probabilities that they own Rights in a name or mark that is identical or similar to the Domain Name.
- 7.3 The Policy defines rights as including but not limited to *"...rights enforceable under English laws."* This has always been treated in decisions under Nominet DRS as a test with a low threshold to overcome and I think that that must be the correct approach.
- 7.4 The Complainants have provided extensive evidence of its use of the Daily Mirror and Mirror brand. Additionally, one of the Complainants is the proprietor of registered trade marks in the word marks Daily Mirror and Mirror. The Complainants have also registered and made substantial use of a number of domain names including the domain names, mirrorbingo.co.uk and mirrorbingo.com.
- 7.5 In the circumstances I have no difficulty in finding that the Complainants have Rights in the names DAILY MIRROR, MIRROR and MIRRORBINGO.
- 7.6 I must now decide whether the name(s) in which the Complainants have Rights are identical or similar to the Domain Name, dailymirrorbingo.co.uk. On this issue, the similarities are obvious and I have little difficulty in finding in the Complainants' favour. I therefore find that, on the balance of probabilities, the Domain Name is identical or similar to a name or mark in which the Complainants have Rights.

Abusive Registration

- 7.7 Having concluded that the Complainants have Rights in a name which is identical or similar to the Domain Name, I must consider whether the

Domain Name constitutes an Abusive Registration. Abusive Registration is defined in the Policy as

“... a domain name which either

(a) was registered or otherwise acquired in the 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

(b) has been used in a manner which took unfair advantage of, was unfairly detrimental to the Complainant’s Rights.”

This definition allows me to consider whether the Domain Name constitutes an Abusive Registration at any time and not, for example, just the time of registration/acquisition.

7.8 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may evidence that a domain name is an Abusive Registration. It is worthwhile setting out paragraph 3 of the Policy in full:

“3. Evidence of Abusive Registration

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

i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

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;

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

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

ii. Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

iii. 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;

- iv. *It is independently verified that the Respondent has given false contact details to us; or*
- v. *The domain name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
A has been using the domain name registration exclusively; and
B paid for the registration and / or renewal of the domain name registration.*
- b. *Failure on the Respondent's part to use the Domain Name for the purposes of e-mail or a website is not in itself evidence that the Domain Name is an Abusive Registration.*
- c. *There shall be a presumption of Abusive Registration if the complainant proves that Respondent has been found to have made an Abusive Registration in three (3) or more Dispute Resolution Service cases in the two (2) years before the complaint was filed. This presumption can be rebutted."*

7.9 The Complainants in their submissions expressly rely on paragraphs 3(a)(i)(C), 3(a)(ii) and 3(a)(iii).

7.10 Paragraph 3a of the Policy is a list of non-exhaustive factors which may be evidence that the Domain Names are an Abusive Registration. It is however also relevant to consider in broader terms whether the Domain Name constitutes an Abusive Registrations within the definition set out in the Policy.

7.11 In doing this, I have adopted the reasoning of the Appeal Panel in the case of Thomas Cook UK Limited v. WhitleyBayUncovered (DRS00583). The relevant part of that decision is produced below.

"It seems to the Panel that, given the extent and renown of the Complainant's trade mark, it is stretching credulity beyond breaking point to suggest that the Respondent did not know of the trade mark in question when it sought registration of the Domain Names. Indeed, it is perhaps instructive that there is no suggestion in the communications from the Respondent that it was in fact, unaware of the reputation of the Complainant's trade mark CLUB18-30. Although the Respondent is careful to suggest that the Complainant's proposed use of the Domain Names is open to question (referring to "our concept of the uncovered names") there is no suggestion that the club18-30 part of the Domain

Names was chosen by it for any other reason than it was the Complainant's trade mark.

The Panel, therefore, finds that upon the balance of probabilities the Respondent was aware of the Complainant's trade mark at the time of registration of the Domain Names, and consciously chose to use that trade mark."

7.12 As in the Whitley Bay case, it seems to me that the mark, "DAILY MIRROR" is so well known that it is almost inconceivable that the Respondent did not know of the Complainants' trade marks and Rights generally when it sought registration of the Domain Name. Further, the only possible reason for the Respondent registering the Domain Name could be to take advantage of the substantial goodwill and reputation in the mark, "DAILY MIRROR".

7.13 This is supported by the Respondent's various uses of the Domain Name as described above all of which appear calculated to take unfair advantage of the Complainants' Rights by generating revenue according to the number of people that typed the Domain Name into a browser.

7.14 It follows from this, that on the balance of probabilities, the Respondent must have intended to gain an advantage of some kind by using the Domain Name in such a way and it must follow that this advantage was, "unfair".

7.15 The Complainants have therefore established a prima facie case of Abusive Registration and on that basis I will not, at this stage, go on to consider the detailed points which the Complainants make.

7.16 This is not of course the end of the story. Having found that the Complainants have, on the balance of probabilities, established a prima facie case of Abusive Registration it is now open to the Respondent to rebut this finding by, for example, establishing any of the non-exhaustive factors found under paragraph 4. However, as no Response has been made by the Respondent, such consideration is not possible.

7.17 I therefore find that the Complainants have proved on the balance of probabilities that the Domain Name is an Abusive Registration.

7 DECISION

For the reasons set out above, I find, on the balance of probabilities, that the Complainants have Rights in a name or mark which is identical or similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name be transferred to the Complainants (although I will leave it to Nominet to decide, or preferably agree with the Complainants, which Complainant to transfer the Domain Name to).

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NICK PHILLIPS

5 March 2008