

DISPUTE RESOLUTION SERVICE

D00012519

Decision of Independent Expert

Robot Wars Limited

and

Mr Denys Ostashko

1. The Parties:

Lead Complainant: Robot Wars Limited
3rd Floor
20 Bedford Street
Covent Garden
London
Greater London
WC2E 9HP
United Kingdom

Complainant: Robot Wars LLC
PO Box 388
Holbrook
New York
NY 11741
United States

Respondent: Mr Denys Ostashko
Sales@BuyDomainNames.co.uk
Apt 433, Chynoweth House
Trevisson Park
Truro
TR4 8UN
United Kingdom

2. The Domain Name:

robotwars.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

22 February 2013 16:48	Dispute received
25 February 2013 11:04	Complaint validated
25 February 2013 11:10	Notification of complaint sent to parties
14 March 2013 01:30	Response reminder sent
19 March 2013 08:28	Response received
19 March 2013 08:29	Notification of response sent to parties
22 March 2013 01:30	Reply reminder sent
26 March 2013 09:53	Reply received
26 March 2013 09:56	Notification of reply sent to parties
26 March 2013 09:57	Mediator appointed
02 April 2013 09:40	Mediation started
10 April 2013 14:26	Mediation failed
10 April 2013 14:37	Close of mediation documents sent
15 April 2013 11:46	Expert decision payment received

4. Factual Background

I have derived the factual background described below from the parties' submissions.

- The First Complainant is a UK registered company. The Second Complainant is a company incorporated under the laws of the State of New York, USA.
- The First Complainant's business includes the creation and distribution of television programmes for the UK market and the organisation of live events within the UK. The Second Complainant is the ultimate parent company of the First Complainant.
- Between 1997 and 2004, the Complainants' business was responsible for the production of a TV series called "Robot Wars" and "Robot Wars Extreme" and the staging of live arena events associated with the TV series. The TV programme and events involved "fighting robots". In addition, a wide range of related merchandise was sold through licensees. The TV series was broadcast on UK terrestrial television channels and became popular. The TV series was also broadcast in a large number of other countries around the world.
- Until August 2006 one of the Complainants was the registrant of the Domain Name. The website to which it resolved was popular, attracting over 4 million hits in 2004 alone.
- In 2004, the last of the Robot Wars TV series was broadcast and it appears that the Complainants then decided to cease or at least suspend active use of and their involvement in the business related to the Robot Wars brand.

- When the Domain Name was due for renewal in August 2006, the Complainants took the deliberate decision not to renew it.
- The Respondent has a business involved in the buying and selling of domain names. He has developed software that tracks domain names that are not being renewed by their current registrants and he will then consider registering those domain names himself as soon as they become available.
- The Respondent has three previous adverse DRS decisions against him, all of them being decided in 2007.
- On 15 August 2006, the Respondent registered the Domain Name when it was not renewed by the Complainants. Since then it has been offered for sale generally by the Respondent and in the meantime has been "parked", resolving to a website holding page which earns click-through income for the Respondent via third party sponsored advertising links.
- The third party sponsored links automatically displayed on the holding page were initially based on the phrase 'robot wars' which was automatically derived from the Domain Name and was used by the Respondent as the default setting when setting up the page.
- In March 2009, the Complainants registered a Community trade mark for ROBOT WARS for a wide range of goods and services.
- On 5 August 2010, a cable television channel called "Dave" began showing repeats of the first series of Robot Wars Extreme to UK audiences. Since then, Dave has aired repeats of the first series of Robot Wars Extreme and more recently it has aired repeats of the second series of Robot Wars Extreme.
- In February 2011, the Complainants successfully applied to the UK Intellectual Property Office to invalidate a third party's registration of a UK trade mark for ROBOT WARS dating from June 2006 on the basis that it had been applied for in bad faith and its use would amount to passing off.
- Between 2010 and 2012 the Respondent had communications with a competitor of the Complainants called Roaming Robots Limited about the possible sale of the Domain Name. The contact appears to have been initiated by Roaming Robots Limited.
- In October 2012 the Complainants' solicitors contacted the Respondent alleging that the Respondent's registration and use of the Domain Name infringed the Complainants' intellectual property rights and requested that the Respondent transfer the Domain Name to the Complainants. In response, the Respondent offered to sell the Domain Name to the Complainants and invited them to make an offer for the Domain Name based on its market value price. In addition, the Respondent modified the holding page where the Domain Name was parked in an attempt to ensure that the page did not advertise any goods or services of the sort covered by the Complainants' trade mark registration.
- On 5 February 2013, the Complainants entered into a licence agreement with Roaming Robots Limited and through that are once again involved in the promotion

of live robot-fighting events. In addition, the Complainants maintain an interest in the revival of the Robot Wars TV format in the UK.

5. Parties' Contentions

The Complainants' Complaint

In the Complaint, the Complainants made the following contentions, supported by relevant exhibits:

- The Complainants own rights in the name / mark ROBOT WARS in the UK and throughout the world.
- The Respondent registered the Domain Name on 15 August 2006. The Whois record states that the Respondent's contact email is "sales@BuyDomainNames.co.uk" which has led the Complainants to believe that the Respondent's business is the sale and purchase of domain names.
- In 2007 three successful complaints (DRS4620, DRS04448 and DRS04719) were brought against the Respondent in relation to domain names he had registered between October 2005 and September 2006.
- The DRS4620 (roadrunner.co.uk) decision against the Respondent makes it clear that at the time that complaint was made (18 April 2007) the Respondent owned, *inter alia*, the following domain names: kinder.co.uk, bbcradio.co.uk, fcukonline.co.uk, scotlandtoday.co.uk, aolsearch.co.uk, axahealthcare.co.uk, ntlbroadband.co.uk and eastendersbbc.co.uk (the "Respondent Domains"). The Complainants contend that these domain names could not be used for any other purpose other than to take unfair advantage of the goodwill built up by the underlying trade mark owners.
- Following registration of the Domain Name on 15 August 2006 the Respondent parked the Domain Name in such a way that income could be generated through "click-through" payments to competitor websites.
- The Complainants' solicitors contacted the Respondent on 3 October 2012 requesting that he transfer the Domain Name to the Complainants. Following this correspondence, the Respondent altered the website located at the Domain Name so that these "click-through" links no longer appeared.
- At all material times the Domain Name was "available to buy".

The Complainants' Rights

- The Complainants have registered and unregistered trade mark rights which are identical to the Domain Name within the meaning of paragraph 2(a)(i) of the DRS Policy. In particular:
 - The Second Complainant owns a Community Trade Mark with effect in the UK for ROBOT WARS (CTM 8145311) which has a filing date of March 2009 and covers goods and services in classes 7, 9, 16, 28 and 4. Although this registration post-dates the Domain Name registration, it merely reflects the Complainants' significant pre-existing unregistered rights.

- The Complainants' unregistered rights in ROBOT WARS arise due to their long use of the name in relation to a popular television series (as well as subsequent live events) in the UK and throughout the world.
- The Complainants are between them the originators and/or developers of a television format based on the concept of fighting robots. Within that format, robots compete for supremacy in battle-style contests within an arena. A pilot episode based on the Complainants' fighting-robots format was created in 1995 and entitled "Robot Wars". In 1997 the BBC commissioned a first series of six episodes based on the Robot Wars pilot episode. The first series was filmed in November 1997 before a live audience. In 1998 the BBC broadcast the first series of Robot Wars.
- The first series of Robot Wars was broadcast in a prime-time slot on BBC2 in 1998 and attracted television audiences of around 4 million viewers. In or around early 1999 a second series of Robot Wars was watched by a television audience of typically between 4.5 and 6 million. A further four series of Robot Wars were broadcast by the BBC from 2000 to 2003, with 24 episodes in 2000 and 32 episodes in each of 2002 and 2003. A final season aired on Channel 5 in 2003/2004. The Robot Wars programmes have since been broadcast in 45 other countries around the world.
- Between 2001 and 2003 the BBC broadcast two series based on the same format as Robot Wars entitled "Robot Wars Extreme". The first series of Robot Wars Extreme was broadcast between 26 October 2001 and 8 February 2002 and the second series was broadcast between 9 May 2003 and 3 October 2003. Both series of Robot Wars Extreme included at least 15 episodes which were originally broadcast on BBC Choice and then later repeated on BBC2.
- Historically, the Complainants owned the Domain Name and the website to which it resolved attracted over 4 million hits in 2004 alone. The Complainants decided not to renew their registration of the Domain Name in or around 2006, shortly after which the Respondent registered the Domain Name.
- The first of a large number of Robot Wars branded live events run by the Complainants took place in 2000 (the "Live Events"). In 2001 the Live Events ran at eight separate venues, with 35 performances and 4,000 seats per show.
- A marketing company called Mentorn Media Limited ("Mentorn") worked in conjunction with the Complainants and the BBC in order to produce the Robot Wars television programmes.
- In or about 1999, the ROBOT WARS mark was licensed to Mentorn for use on a wide range of Robot Wars merchandise and BBC Worldwide was appointed licensing agent. It was agreed that the Complainants would own all goodwill as a result. The Complainants and/or their licensees promote the Robot Wars brand in relation to toys, clothing, videos/DVDs, computer games, stationery; and robot-making kits.
- The Complainants and/or their licensees also promote the Robot Wars brand through the Live Events and the Robot Wars Club. The brand is

closely controlled by the Complainants who issued, in or about 2000, a style guide for licensees of the ROBOT WARS mark.

- The result of the efforts that were made to promote the ROBOT WARS programme meant that a survey of the top ten children's characters carried out around 2001 showed that ROBOT WARS was the number one character for boys aged between seven and nine above The Simpsons, Harry Potter and even Pokemon.
- Attendees at the Live Events spent an average of £4.20 each on ROBOT WARS branded merchandise. One of the toys marketed under the ROBOT WARS mark won the UK Toy Retailers Association's 2001 Boys Toy of the Year. In 2003 the gross wholesale income from the licensed merchandise alone was over £6 million.
- A Robot Wars club (the "Robot Wars Club") for fans of the Robot Wars programme was established by the Complainants in 1998 and had gained 40,000 UK members by 2000.
- After the last Robot Wars series was broadcast in 2004, fans of the show established The Fighting Robot Association or FRA, which continues to this day – see www.fightingrobots.co.uk (the "FRA Website"). The FRA Website contains a detailed history of ROBOT WARS, running to some 9 pages of A4 text. This history states that "*ROBOT WARS is now a global phenomenon*" and "*UK Robot Wars has been incredibly successful, not just the television side of it, but also because it sells a wide variety of merchandise*".
- On 5 August 2010, the television channel "Dave" began showing repeats of the first series of Robot Wars Extreme to UK audiences. Since then, Dave has aired repeats the first series of Robot Wars Extreme and more recently it has aired repeats of the second series of Robot Wars Extreme. The website for Dave contains a section about Robot Wars, along with user comments such as "*Cannot begin to say how pleased I am. Would be even more amazing if you could bring back a new series!*" and "*Great to see it back on TV, sign up a new series Dave!*".
- The television channel Dave is still showing repeats of Robot Wars and the Complainants are still involved in the promotion of live robot-fighting events (via their licensees, Roaming Robots Limited).
- On 28 February 2011, Mr David Landau, sitting as a Hearing Officer of the Registrar at the UK Intellectual Property Office, heard a dispute in relation to ROBOT WARS in which a third party had applied for the trade mark ROBOT WARS in 2006 and the Complainants had raised objections on grounds of bad faith and intended passing off.
- While the full details of the dispute are mainly irrelevant to this Complaint, it is important to note that in his decision of 2 March 2011 (the "Decision"), Mr Landau declared that the Complainants owned substantial goodwill in ROBOT WARS as at 17 June 2006 (and also thereafter). The Complainants rely in particular on the following findings of fact made by Mr Landau:

- (a) "It is not considered that either Robot Wars LLC or Robot Wars Limited abandoned any goodwill that they had in a business conducted by reference to the sign ROBOT WARS." *(paragraph 49 of the Decision)*;
- (b) "Taking into account the nature of the trade, the tradition in that trade of reviving brands, the continuing existence of all of the undertakings involved in the television programme and the success of the television programme, there was no abandonment of the goodwill in relation to the television programme and the live events related to it." *(paragraph 49)*;
- (c) "At both material dates [17 June 2006 and 22 April 2009; see paragraph 44 of the Decision] there was still a reputation in respect of the television programme ROBOT WARS." *(paragraph 50)*;
- (d) "The licensing agreements, with the reversion rights, and the witness statement of Mr Leach show that the goodwill in the business identified by use of the sign ROBOT WARS and the format of the show was owned by [the Second Complainant]. ... This goodwill relates to a television programme and live events identified by the sign ROBOT WARS in which model vehicles fight with each other. In relation to the television programme at both material dates this was a substantial goodwill, and still is." *(paragraph 51)*;
- (e) "The nature of the services of the registration and the identity of the trade mark with the sign used by LLC in relation to its goodwill, means that misrepresentation is inevitable." *(paragraph 52)*;
- (f) "Damage in passing-off can take a number of forms. In this case, taking into account the reputation of the earlier sign and the services, damage is likely to occur as *[sic]* possible:
- (i) By the injury which is inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business.
 - (ii) Erosion of the distinctiveness of [the Second Complainant's] sign.
 - (iii) By the restriction of the ability to exploit the goodwill....

- In the circumstances, the Complainants are between them the owners of substantial UK goodwill in the ROBOT WARS mark in relation to television programmes and the Live Events (including toys, clothing, videos/DVDs, computer games, stationery and robot-making kits) featuring fighting robots as at 17 June 2006 and 22 April 2009 and 2 March 2011 (the latter being the date of the Decision).
- There are no third party companies incorporated in the UK that include the words ROBOT WARS (the First Complainant is the only UK incorporated company to use

ROBOT WARS as part of its company name). There are no third party registrations for ROBOT WARS that have effect in the UK (the only other ROBOT WARS mark found on the UK register was invalidated as a result of the Decision).

- Although the words ROBOT and WARS separately could describe multiple goods or services, the combination ROBOT WARS is unusual and can only be used to describe goods and services relating to "fighting robots". It is precisely this sector in which the Complainants have attained substantial goodwill as made clear by the Decision.
- The Complainants are still, via their licensees, involved in live robot fighting events (and the sale of associated merchandise) under the Robot Wars brand. Further, the Complainants maintain significant interest in the revival of the Robot Wars format in the UK. In the circumstances, the Complainants' aforesaid UK goodwill in the ROBOT WARS mark continues to the present date and still forms an integral part of the Complainants' business.

Abusive Registration

The Complainants contend that the Domain Name is an Abusive Registration as defined in paragraph 1 of the DRS Policy as the Respondent registered the Domain Name for the following reasons:

Paragraph 3(a)(i)(A) of the DRS Policy – 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.

- The Complainants contend that given the substantial goodwill the Complainants had in ROBOT WARS as at 15 August 2006, it is inconceivable that the Respondent did not have the Complainants in mind when registering the Domain Name. The Complainants believe that the Respondent obtained the Domain Name solely because he appreciated that the substantial goodwill the Complainants had established in the ROBOT WARS name would make the Domain Name a valuable asset to him.
- From the screenshots of the Respondent's website to which the Domain Name resolved it is clear that the Respondent was willing to sell the Domain Name. Although the buying and selling of domain names, per se, does not constitute an Abusive Registration, the buying of domain names for the purpose of selling, renting or otherwise transferring the domain names to the Complainants or a competitor of the Complainants at a profit does constitute an Abusive Registration.
- The fact that the Respondent also owned the Respondent Domains is indicative of this behaviour. None of these domains could be used for any purpose other than to take unfair advantage of the goodwill built up by the underlying trade mark owners. The Respondent clearly registered these domains with the view of selling them on for a profit or for using them in such a way as to enable the Respondent to make a profit through such use.
- Further, the Respondent's administrative contact email address for the Domain Name is "sales@BuyDomainNames.co.uk". As a result, the Respondent makes it clear to any potential purchaser of the Domain Name that (i) he is in the business of buying and selling domain names, and (ii) it is likely that the domain name to which the Whois record relates i.e. the Domain Name is available for sale. Any contact is made via the "sales" division of Buy Domain Names.

- During initial correspondence between the parties, the Respondent invited the Complainants to make an offer for the purchase of the Domain Name. The Respondent provided no indication as to what value he placed upon the Domain Name. However, an indication of the value contemplated by the Respondent can be seen at www.utterfly.co.uk, a website owned by the Respondent which specialises in "domain name development, domain catching, domain auctions and domain consulting". Visitors to this website are invited to make offers for premium domain names and the website displays indications of the highest offers placed for particular domain names (e.g. the highest offer to date for liverpool.co.uk is stated as at least £200,000 and the highest offer to date for radio.co.uk is stated as at least £70,000). The website also contains a link to an article entitled "*Why £10,000 For A Domain Name Is Still Cheap?*".
- It is clear that if the Complainants attempt to purchase the Domain Name now (or had tried to do so soon after the Respondent registered the Domain Name) the Respondent would only accept a substantial sum. The content of www.utterfly.co.uk suggests that the Complainants would now have to pay at least £10,000. However, the fact that the highest offer to date for liverpool.co.uk stands at over £200,000 (and has presumably not yet been accepted by the Respondent) suggests that the Respondent might demand considerably more than £10,000. These amounts far exceed the out-of-pocket costs that the Respondent would have incurred in acquiring and using the Domain Name.
- The Complainants are therefore concerned that they could be held to ransom for a domain name which includes a URL that is identical to the name/mark they already own.
- Additionally, the Complainants contend that while the Respondent was awaiting a buyer of the Domain Name, he parked the Domain Name and used it as a "click-through" site. This situation benefitted the Respondent who would have received commission in the form of click-through payments. The receipt of such payments meant that the Respondent was taking unfair advantage of the fact that customers seeking goods and services of the Complainants might enter "robot wars" into their search engine in the expectation that they would be taken to the Complainants' site. This advantage is unfair because it amounts to unauthorised exploitation of the brand recognition and goodwill of the Complainants' ROBOT WARS rights.
- The only sensible conclusion has to be that the Respondent therefore registered the Domain Name with the ultimate view of selling it for a profit. However, whilst awaiting a purchaser of the Domain Name, the Respondent has used the Domain Name to make a profit by taking unfair advantage of the Complainants' goodwill.

Paragraph 3(a)(ii) of the DRS Policy – 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, or operated or authorised by, or otherwise connected with the Complainant.

- As a result of the Complainants' substantial goodwill in ROBOT WARS, any use by the Respondent of the Domain Name 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 pursuant to paragraph 3(a)(ii) of the DRS Policy.

- Initial Interest Confusion: The Domain Name is identical to the mark in which the Complainants have rights and is without any adornment (other than the generic domain suffix). Commonly, internet users will visit websites either by way of search engines or by guessing the relevant URL. There is a severe risk that internet users guessing the URL for the Complainants' website will inevitably guess the Domain Name for that purpose (either as a result of the Complainants' rights in the name or merely because it is the same as both Complainants' company names). The speculative visitor to the Respondent's website will be visiting it in the hope and expectation that the website is operated or authorised by, or otherwise connected with the Complainant. The chance of this occurring is further increased by the fact that the Complainants used to own the Domain Name and operated the website to which it resolved at www.robotwars.co.uk.
- Even if it is immediately apparent to the visitor to the website located at the Domain Name that it is not in any way connected with the Complainants, the visitor has been deceived. The visitor will have been "sucked in" by the Domain Name. Paragraph 3.3 of the DRS Experts' Overview states that initial interest confusion is, in the view of the overwhelming majority of Experts, a possible basis for a finding of Abusive Registration.
- The Complainants therefore contend that the Domain Name is being held by the Respondent as an instrument of fraud. The registration of the Domain Name by the Respondent incorporates the Complainants' registered trade mark and was not authorised by the Complainants. The registration and use of the Domain Name falls within the definition of an instrument of fraud as set out in *British Telecommunications plc v One in a Million* [1998] 4 All ER 476, whereby the mere act of unauthorised registration of a well-known or registered trade mark is evidence of an intention to deceive. As a result of the substantial goodwill owned by the Complainants, any use of the Domain Name by the Respondent or any potential purchaser other than the Complainants is likely to deceive and cause confusion among the public.
- This is the natural conclusion of the combination of paragraphs 3(a)(i)(A) and 3(a)(ii) of the DRS Policy. This is further evidenced by considering some of the Respondent's other registrations in existence at the same time, namely the Respondent Domains, which all relate to domains that contain a well-known trade mark (e.g. BBC along with a generic term for the goods). There can be no doubt that these registrations are so blatantly aimed at the owner of the corresponding trade marks that they could not have been registered accidentally.
- Actual Confusion: A screenshot of the website to which the Domain Name resolved dated 28 October 2007 (the earliest screenshot available to the Complainants) (the "Earliest Screenshot" reveals the following:
 - the sponsored/click-through links include links to competitors of the Complainants. In particular, www.battlekits.com, www.robotwars.tonetunes4u.com and www.target.com;
 - the page contains the following text: "this resource is dedicated to everything about robotwars.co.uk. Try related searches or type your query in the search box and we hope you find what you are looking for";
 - the two most "popular searches" were for "*Robot Wars*" and "*Robotwars*";

- there are three different locations on this single page that allow the user to "click-through" to the results page for searches for "Robotwars" and "Robot Wars" (top, bottom and right hand side of the page); and
- the page states that "*this domain may be for sale*".
- Other screenshots taken from the website to which the Domain Name resolved (between October 2007 and January 2013) show similar results (the "Other Screenshots").
- Including "click-through" links to third party sites on the website to which the Domain Name resolves is likely to lead consumers to believe that the goods and services being offered on these "click-through" sites are connected with the goods and services being offered by the Complainants. In particular, the Complainants draw attention to the following sites found by "clicking-through":

Accessed via the Earliest Screenshot of the Domain Name

- (a) *www.battlekits.com* which sells robot-making kits (screenshot dated 14 July 2007 - the URL address <http://web.archive.org/web/20070714061356/http://www.battlekits.com/> evidences this date);
- (b) *www.target.com* which sells a variety of goods, including toys and clothing (screenshot dated 24 August 2006);
- (c) *www.robotwars.tonetunes4u.com* which sells ringtones (no screenshot is available but the Complainants confirm that any ringtones sold by this site would not have been endorsed by them);

Accessed via the Other Screenshots of the Domain Name

- (d) *www.robotevents.com* which provides information on robot fighting events (screenshot dated 12 October 2007);
 - (e) *www.store.foxanime.com* which sells DVDs (screenshot dated 26 September 2008 - the "click-through" link contains the Complainants' exact trade mark yet has no connection with the Complainants);
 - (f) *www.shopping.com* which sells a variety of goods, including toys and clothing (screenshot dated 20 September 2006); and
 - (g) *www.electronickits.com* which sells robot-making kits (screenshot dated 2 September 2006).
- The links at (a) to (g) above all relate to third party sites that are in direct or indirect competition with the Complainants and sell products that the Complainants sell themselves under the Robot Wars brand.
 - The fact that the most popular search using the search tool provided at the Domain Name is for "Robot Wars" or "Robotwars" which are identical to (i) the Complainants' company name, (ii) the trade mark registration owned by the Second Complainant, and (iii) the Complainants' brand in which substantial

goodwill has been established, is indicative that consumers who accessed the site were looking for the official website of the Complainants or for goods and services connected with and endorsed by them.

- Although the Respondent has now removed these links from the website located at the Domain Name, by searching under the most popular search terms ("Robot Wars" and "RobotWars") using the search box provided, competitor links are displayed including www.robotbits.co.uk and www.quasarelectronics.co.uk. The Respondent has therefore simply added an additional but obvious step that is required to get the same result.
- In any case, the fact the Domain Name has ceased such direct activity does not render the past use non-abusive. There are numerous decisions under the DRS Policy in which a finding of an Abusive Registration is based on past use (e.g. the decision of the Appeal Panel in DRS00389 where the Panel were of the view that the Expert was entitled to look at all use of the Domain Name even when the manner of use of the Domain Name had changed).

Paragraph 3(a)(i)(B) of the DRS Policy – As a blocking Registration against a name or mark in which the Complainants have rights.

- The Complainants contend that the Respondent has registered the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has rights pursuant to paragraph 3(a)(i)(B) of the DRS Policy.
- As any actual use of the Domain Name would amount to trade mark infringement and/or passing off, there is no legitimate reason for the Respondent to hold the Domain Name other than to block the Complainants' use of it (or to make an illegitimate profit from it).
- By holding the Domain Name, the Respondent is preventing the Complainants from using such a domain name. Due to the unregistered and registered rights that the Complainant possesses in ROBOT WARS in the UK, the Complainants should have the right to own the Domain Name. There is no legitimate purpose to which the Respondent could put the Domain Name.

Paragraph 3(a)(iii) of the DRS Policy – 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.

- At the relevant time, the Respondent also owned the Respondent Domains, all of which contain a well-known trade mark (e.g. "BBC" along with a generic term for the goods). These registrations are so blatantly aimed at the owner of the corresponding trade marks that they could not have been registered accidentally.
- The Domain Name is simply another example of this, albeit worse because the inclusion of the additional generic term is not present. A similar conclusion was reached in DRS4620 in relation to the Respondent. The underlying complaint was made on 18 April 2007.
- The Respondent has appeared in the "Nominet 3 Cases Respondent Table", resulting in a presumption of Abusive Registrations in accordance with paragraph 3(c) of the DRS Policy. Although the three decisions relate back to 2007, this is precisely the

relevant period as all three decisions concerned the Respondent's behaviour when registering domains between October 2005 and September 2006. This is the same period in which the Respondent registered the Domain Name. The facts and behaviour of the Respondent are analogous to this Complaint.

- In summary, there is no reason why the Respondent might be said to have been justified in registering the Domain Name. As ROBOT WARS is a well-known mark used by the Complainants in the course of its business and is a name in which the Complainants have substantial goodwill, the Domain Name cannot denote any entity other than the Complainants and there can be no legitimate use of the Domain Name by anybody but the Complainants.

Respondent's Response

The Respondent responded to the Complaint and said, in summary:

- The Complainants might have obtained some goodwill attached to their use of the generic phrase 'robot wars' in relation to a TV show, however the Domain Name is a generic and descriptive phrase with the sole meaning of *'fight or battle between robots'* and the Respondent is making a fair use of it.
- "War" is variously defined in the dictionary as meaning a state of usually open and declared armed hostile conflict between states or nations; a period of such armed conflict; a state of war; the art or science of warfare; weapons and equipment for war; soldiers armed and equipped for war. Based on the above meaning of 'war', fighting between armed or equipped robots is unanimously called 'robot wars'.
- The term 'robot wars' was conceived and coined years before the Complainants' existence. The Respondent has exhibited various documents and refers in particular to the following:
 - 'Robot wars' started to appear in a published literature as early as in the 1960s;
 - there was a popular arcade game developed in 1981 called "Robot wars";
 - the Bulletin of the Atomic Scientists in November 1968 on page 35 refers to 'Robot wars' as a future concept of new weapons or wars where instead of humans there will be robots fighting;
 - 'Robot Wars' is a 1993 American science fiction film directed by Albert Band and written by Charles Band and Jackson Barr;
 - the 'Robot Wars' concept is non-original and has been hugely popular in the well-known series of Transformers (aired since the 1980s); and
 - by analogy, 'Star Wars' is a well-known term and a world-renowned trade mark of Lucasfilm. However, since 'star wars' is also a generic and descriptive term, the rights of the trade mark holder cannot be extended automatically to domain name registrations. The domain name starwars.co.uk is indisputably owned and used by a third-party not related to Lucasfilm.
- The Complainants are not being honest in asserting that *"Although the words ROBOT and WARS separately could describe multiple goods or services, the combination ROBOT WARS is unusual and can only be used to describe goods and services relating to 'fighting robots'"*. The Complainants mix a false and a true statement by saying that the

phrase is unusual, which is false (as it has been used in Sci-Fi literature for decades) and then correctly state that the phrase can only describe '*robots fighting*' (which is logical by definition as 'fighting' is a synonym, another meaning of 'war').

- The Complainants have knowingly chosen a generic and descriptive term to be associated with and therefore must accept that their use of the term will not be exclusive and they must expect to have to possibly co-exist with other uses.
- The Complainants wholly base their claim on unregistered rights preceding the Domain Name registration in 2006 and preceding the Complainants' trade mark registration in 2009.
- Based on the definition of 'Rights' in the DRS Policy, with unregistered rights the Complainants are required to satisfy the Expert that the term 'Robot Wars' has acquired a secondary meaning, as being distinctive of the Complainants, at least in relation to certain goods or services.
- The Complainants have provided some evidence of their use of 'Robot wars' in relation to a TV show featuring robot combat. However, the concept of fighting robots cannot be exclusively attributed to the Complainants as 'Robot combat' has become a popular sport and several television shows broadcast robot fights.
- The Complainants have failed to provide any evidence for the scale of their other uses of 'Robot wars' in relation to Toys, Games, DVDs or other merchandise.
- The Complainants have failed to prove that 'Robot Wars' has obtained a secondary meaning besides its dictionary meaning of 'Robot Fighting' or 'Fighting Robots' (or other synonyms), in particular:
 - The secondary meaning of 'Robot Wars' must be related to the Complainants' certain goods or services and not to a mere fact of 'robot fighting'.
 - The secondary meaning must clearly differentiate the Complainants' goods or services from generic uses of 'robot wars' and the Complainants fail to establish this.
 - The TV show made by the Complainants only relates to the generic meaning of 'robot wars'. The Complainants have only established rights to the TV show titled 'robot wars' but not to the generic meaning of 'robot wars' or 'fighting robots'.
 - The Complainants have failed to demonstrate that a statistically substantive number of the general public would recognize the 'robot wars' phrase in connection with the Complainants' goods or services.
 - The ROBOT WARS trade mark was granted to the Complainants after the registration of the Domain Name and was distinctive of the goods for which registration was sought. However "Robot Wars" is not a mark which is the exclusive preserve of the Complainants.
 - The Complainants have failed to demonstrate that they have used the name or mark in question for a not insignificant period and to a not insignificant degree in connection with distinctive goods or services in the seven years after the Domain Name was registered on 15 August 2006.

- Based on the above list of exhaustive factors, the Complainants fail to establish Rights in the Domain Name.
- The Domain Name registration is not abusive.
- Paragraph 3(a)(i) of The DRS Policy can not apply because the circumstances set out in paragraphs 3(a)(i) all concern a registrant's motives at the time of registration of the domain name and the Domain Name was not registered with the Complainants in mind. In particular:
 - The Respondent became aware of the Domain Name when looking through the list of expired domain names about to be released from previous registrants.
 - The Respondent identified and picked up 'robotwars.co.uk' as being a domain which might have a resale value due to its generic "sci-fi" potential and because similar domain names in popular extensions (such as .com) were already taken.
 - The Respondent was not aware and had never heard of a TV show called 'Robot Wars' at the time of the Domain Name's registration. The Respondent has been resident in the UK only since Spring, 2001 (years after the TV show was at its peak) and never owned (and still doesn't own) a TV, as he considers broadcast TV to be an outdated technology, instead opting for a projector and on-demand services for his entertainment needs.
- There was no abusive intent, in particular:
 - Even if the Respondent had been aware of the Complainants, there could not be any abusive intent when registering the Domain Name because the Complainants themselves had decided that they no longer required the Domain Name and had not paid the renewal fees which led to the expiration and subsequent release of the Domain Name to be available for any willing members of the public to register.
 - Considering that the Complainants did not need the Domain Name any longer, the Respondent could not have registered it with an abusive intent towards the Complainants. The Complainants have confirmed in the Complaint that they ceased all activities related to the "Robot Wars" TV show and its merchandise in 2004. A Wikipedia article exhibited by the Complainants shows that it was a matter of public knowledge that the TV show had ceased to exist in 2004 and that the Complainants' assets and goodwill in the 'Robot wars' show was wound up and sold to anyone willing to pay, including their 'robot combat' competitors.
 - At the time of registration of the Domain Name the Respondent was not aware of any of the above and registered the Domain Name based on its generic potential.
 - Trading in domain names and registering domain names with a view to a possible future sale is not abusive according to the DRS Policy.
 - The DRS Appeal panel in the Verbatim case took the view that for a registration to be labeled "Abusive" there had to be something morally reprehensible about the Respondent's behavior, a view more recently adopted in DRS 07066 (whistleblower.co.uk).

- To satisfy Paragraph 3(a)(ii) of the DRS Policy, the Complainants must prove 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 Complainants:
 - The Complainants have not used 'robot wars' in relation to any goods or services to any significant degree since registration of the Domain Name by the Respondent. As the Complainants state, their only use of 'robot wars' was in relation to show repeats on a TV channel called 'Dave'. This use is very insignificant use as the cable TV channel 'Dave' is a very specific TV channel with a very limited audience, of which the majority of the UK population must be unaware (including the Respondent).
 - The Complainant applied for registration of a trade mark for ROBOT WARS in relation to certain goods and services only in 2009, three years after the Domain Name was registered by the Respondent. Accordingly, the Respondent could not have been aware of the Complainants' registered rights in "robot wars" until it received the letter from the Complainants' representatives, which was sent on 3 October 2012. All uses of the Domain Name referenced in the Complaint pre-date this letter and were made when the Respondent was unaware of the Complainants' recently established registered rights or any previous goodwill in "robot wars". In the meantime, the Domain Name being generic and descriptive, the Respondent was making a fair use of it (as sale of traffic is a fair use according to the DRS Policy).
 - If the Complainants had really been concerned about the Respondent's use of the Domain Name, they should have contacted the Respondent or initiated a dispute much earlier than seven years after the Domain Name's registration. The Complainants were not concerned about the Respondent's use of the Domain Name at all and are only pursuing the Domain Name now when they have recognized a fresh need for the Domain Name (perhaps for a possible show revival). But instead of acquiring the Domain Name based on its fair market value from its current legitimate owner, the Complainants are attempting to extort the Domain Name by way of a manufactured dispute.
 - If the Complainants were truly concerned by the use of the Domain Name, they would have visited the website to which it resolved during the seven years period and have created screen shots of any questionable appearance or abusive use on the holding/parking pages. Instead, in their exhibits the Complainants rely on a commercial service www.domaintools.com, which collects website snapshots at certain time intervals. The Complainants are fishing for any possible past evidence to help build their case. However, the pages displayed in the evidence were never of a concern to the Complainants over all those years.
 - When initially contacted by the Complainants' solicitors, the Respondent checked the parking page and as a precaution made a screen shot of how the page looked at that time including all sponsored links displayed. The Respondent then modified the page to a plain looking page to ensure that the page does not accidentally advertise any goods or services of third parties covered by the Complainants' trade mark registration. The Respondent performed this action immediately after learning about the Complainants' newly registered rights which the Complainants established 3 years after the Domain Name was registered by the Respondent.

- Parking a domain name is an entirely legitimate practice and sale of traffic (i.e. connecting domain names to parking pages and earning click per view revenue) is not of itself objectionable, in accordance with paragraph 4(e) of the DRS Policy.
- The Domain Name was always displaying sponsored links based on its generic phrase of 'robot wars' which is automatically derived from the Domain Name and is used as a default setting. If the Respondent would have really intended to profit from the Complainants' goodwill, he would have configured the Domain Name to display targeted advertisements based on 'robot wars show', 'robot wars dvd' or other similar keywords related to the Complainants.
- As evidenced from a saved screen shot taken on 16th October 2012 before the parking page was re-configured to a plain page, all displayed sponsored links were not related to anything covered by the Complainants' registered or unregistered rights.
- The Respondent owns a large quantity of domain names and it is impractical for him to monitor all of the parking pages. Moreover, the Respondent had no reason to view the parking page for the Domain Name until hearing from the Complainants. However, the Complainants, who must have been aware since 2006 of the website to which the Domain Name resolved, made no objection to the site's content and use in seven years.
- Even if the parked page contained sponsored links to competitors of the Complainants, it would still be considered fair use because such use took place when the Respondent was unaware of the Complainants' Rights:
 - In the DRS Appeal Panel's decision in DRS 04962 (MySpace Inc v Total Web Solutions Limited) it was stated: *"To date experts and Appeal panels have reasonably consistently taken the view that if a registrant acquires a domain name in advance of the coming into existence of the complainant's rights, the registrant is entitled in principle to hold onto the domain name and to use it, notwithstanding that confusion of the 'initial interest' variety may be inevitable. Similarly, experts and Appeal panels have concluded that in such circumstances it is not of itself abusive for the registrant to demand a high price from the complainant for transfer of the domain name in recognition of its enhanced value. Problems only arise for the registrant if he actively does something to take advantage of his position. In the case, for example, the registrant sought to rack up the price by threatening to transfer the domain name to a competitor of the complainant."*
 - In the decision in DRS 09331 (JD Sports Fashion Plc vs Mr Denys Ostashko (the Respondent)) under similar circumstances the Expert ruled that: *"I have found that the Respondent acquired the Domain Name 'innocently' without knowledge of the Complainant's Rights. In such circumstance I regard the Respondent's use of the Domain Name to point through to a holding page to be fair use of the Domain Name in accordance with paragraph 4(a)(i)C of the Policy, even if it contained sponsored links to the Complainant's competitors. This is also consistent with the statement of the Appeal panel in DRS 05856 (Deutsche Telekom AG v Lammtara Multiserve Limited): "Abusive Registration connotes culpable behavior akin to knowing wrongdoing" "6.34 In this respect, as set out at paragraph 6.25(c), after notification of the Complainant's*

rights, the Respondent directed the Domain Name to a parking page with a plain search box. I do not regard this to be an objectionable use of the Domain Name."

- The Complainants rely on initial interest confusion, however it does not apply in this case. In particular:
 - Tony Willoughby, Chair of the Panel of Experts writes in the "*Dispute Resolution Service – Experts' Overview*" on the meaning of initial interest confusion: "*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'".
 - It is essential to highlight "*cannot sensibly refer to anyone else*" in the quotation above, as "initial interest confusion" only applies when "*the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else*".
 - In the case of the generic Domain Name 'robotwars.co.uk', which has plenty of other uses and references not related to the Complainants (as evidenced above), it would not be expected that users visiting the website to which the Domain Name resolves are necessarily looking to find the Complainants. Therefore initial interest confusion cannot occur.
 - As it is known by the general public and fans of the TV show that it has long ago ceased to exist, they are not expecting to find the Complainants operating under the URL address of the Domain Name, especially as the Complainants have neglected and decided not to renew it.
- The Complainants claim "Actual confusion" in the Complaint. By definition, 'confusion' referred to in paragraph 3(a)(ii) of the DRS 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*"? In this case the answer is "No". It becomes clear from the very first seconds observing the website (which is only a holding page consisting of links to other websites) that the Domain Name cannot be operated by the Complainants who would otherwise be publishing information related to the TV show or its "robot wars" merchandise.
- To satisfy Paragraph 3(a)(iii) of the DRS Policy the Complainants must show 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. In that respect:

- The Complainants have looked through all DRS cases brought against the Respondent and found three old cases which were decided against him. All three cases relate back to 2007. According to the DRS Policy, *"there shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the Complaint was filed."* Six years after the last case against the Respondent was decided, there cannot be a presumption of Abusive Registration based on the past history. Even criminal offences are considered to be 'spent' after five years.
- The three domain names in the cases that were decided against the Respondent were 'ucan.co.uk', 'csma.co.uk' and 'roadrunner.co.uk'. As it can be clearly seen, these domain names do not correspond to well-known names or marks and they do not form a pattern.
- The Complainants claim that between October 2005 and September 2006 the Respondent has registered domain names related to some well-known trade marks and that the Domain Name is *"simply another example of this"*. The Complainants list eight domain names allegedly registered by the Respondent at that time. The domain names are kinder.co.uk, bbcradio.co.uk, fcukonline.co.uk, scotlandtoday.co.uk, aolsearch.co.uk, axahealthcare.co.uk, ntlbroadband.co.uk and eastendersbbc.co.uk. The Complainants contend that these domain names could not be used for any other purpose other than to take unfair advantage of the goodwill built up by the underlying trade mark owners.
- The Respondent accepts that at some point in time he was a registrant of these domain names but rejects the claim made by the Complainants in regard to their use. Out of the eight domains names, the Respondent is currently a registrant of kinder.co.uk and scotlandtoday.co.uk. Both domain names are generic and descriptive dictionary word domain names for which the Respondent has never received any complaints.
- The Respondent is no longer the registrant of the other listed domain names. Because the Complainants do not know what possible arrangements or relationships there were between the Respondent and the corresponding right holders, the Complainants cannot make contentions as to the purpose of these domain registrations. What is important is that the Respondent was never subject to a dispute for any of them.
- In the period between October 2005 and September 2006, the Respondent was registering about 50 domain names per month. All of these domain name registrations were registrations of domain names which had existed before but were then allowed to expire by their previous owners. The Respondent has developed software for ordering expired domain names and, for instance, in the same August 2006 period when the Domain Name was registered, the Respondent was also able to catch expired registrations of other generic domain names such as smudge.co.uk, cheaphostels.co.uk, starfish.co.uk, sexymodels.co.uk, premier.co.uk, management.co.uk, properly.co.uk and others.
- The Respondent currently owns about 1,400 domain names. If the Respondent was indeed engaged in a pattern of abusive domain registrations, there would have been more successful DRS cases against the Respondent than the three DRS cases dating back to 2007.

- To satisfy paragraph 3(a)(iii) of the DRS Policy, it must be shown that the Respondent *"is engaged in a pattern of registrations"*. This part of the DRS Policy does not apply to past domain name registrations of the Respondent but deals with domain names that are currently registered by the Respondent.
 - Even if the Respondent was engaged in a pattern of domain registrations which correspond to well-known names or trade marks (which is not the case but to consider this hypothetically) the Domain Name does not form a part of any such pattern, as the Domain Name is a generic and descriptive domain name which does not correspond to a well-known name or mark.
- The Respondent believes that the Complainant is trying to reverse-hijack the Domain Name (without offering to pay a fair market value for it) and that the Complaint is filled in bad faith:
 - The Complainants are concealing some important facts and make deceitful statements: In their Complaint, the Complainants state *"It is clear that if the Complainants attempt to purchase the Domain Name now (or had tried to do so soon after the Respondent registered the Domain Name) the Respondent would only accept a substantial sum. The content of www.utterfly.co.uk suggests that the Complainants would now have to pay at least £10,000. However, the fact that the highest offer to date for www.liverpool.co.uk stands at over £200,000 (and has presumably not yet been accepted by the Respondent) suggests that the Respondent might demand considerably more than £10,000. These amounts far exceed the out-of-pocket costs that the Respondent would have incurred in acquiring and using the Domain Name."* This is speculation and completely untrue and deceitful, as the Complainants are perfectly aware of the asking price of the Domain Name.
 - In the Complaint, the Complainants state *that "the Complainants are still involved in the promotion of live robot-fighting events (via their licensees, Roaming Robots Limited)." John Findlay, director of Roaming Robots Limited has contacted the Respondent several times over the course of last 3 years with enquiries to purchase the Domain Name. The most recent contact was made in November, 2012, one month after the Complainants' solicitors have requested transfer of the Domain Name from the Respondent.*
 - The Respondent had suspected that "Roaming Robots Ltd" must be connected to the Complainants. He noted to John Findlay that he thinks they are operating together, but John Findlay denied any connection.
 - The Respondent had honestly informed Roaming Robots Ltd as a potential buyer of the Domain Name that there were lawyers trying to dispute the Domain Name's registration. Because the Respondent still believed that there was a connection between them, the asking price of the Domain Name was quoted to be higher than what it would have been if the Complainants' lawyers had not tried to bully the Respondent and waste his time. The price quoted was £4,500. The Respondent believes it to be a fair price reflecting the Domain Name's secondary market valuation. Even with the price quoted, the Respondent was prepared to negotiate further, writing to Roaming Robots Ltd that *"you can also let me know the price you are happy to pay"*.
 - Based on the facts above and considering that Roaming Robots Ltd is a licensee of the Complainants, they would not have been able to seek acquisition of the Domain Name without the Complainants' awareness or even direct involvement.

- In the Complaint, the Complainants further stated that "*the Complainants are therefore concerned that they could be held to ransom for a domain name*", when they are perfectly aware of the quoted amount being a modest sum, especially when considering their high lawyer's fees.
 - It is incomprehensible to see the Complainants resorting to dishonest speculation about the Domain Name's asking price and trying to make the appointed Expert believe that the Respondent is acting unreasonably and inadequately.
 - The domain name robotwars.com is not owned by either of the Complainants. The Complaint states that "*the Second Complainant is a company incorporated under the laws of the State of New York, USA*". The Complainants have never disputed the registration of robotwars.com, which at the moment resolves to a website that contains many game-related advertisements and is offered for sale and is owned by a prominent domain name investor, (Mrs Jello, LLC)
 - The Respondent believes that the Complainants are perfectly aware that they cannot / are unable to dispute the robotwars.com domain name as "robot wars" is a generic phrase and it is harder to prove bad faith (i.e. abuse) under the UDRP Policy. The Complainants seem to be only interested to acquire the .uk version of the domain name by a way of manufactured dispute, whilst being perfectly content with similar use of the .com version.
- Based on the above facts, the Complainants' claim of the Domain Name being an Abusive Registration is unjustified. For the abuse to be established, it is important to demonstrate that, at the time of registration, the Respondent had the Complainants in mind and that there was "intent"; that the Respondent was aware of the Domain Name's use being detrimental to the Complainants' Rights. Instead, the exact opposite is the case, with the Respondent's good intent evidenced by a prompt acknowledgement of the Complainants' registered rights and compliance to ensure that the Domain Name can co-exist with such rights peacefully.

The Complainants' Reply

In their Reply, the Complainants made the following points:

- No Generic Meaning
 - The only evidence of generic use identified by Respondent is a single reference in '*Bulletin of Atomic Scientists*'. The Complainants deny 'Robot Wars' was ever widely used in this way. A single use in one bulletin does not prove a generic term. If 'Robot Wars' was generic, the Respondent would have found more than a single example. Further, the Bulletin is a US publication and therefore no UK use is evidenced.
 - Whilst the Respondent's definition of 'War' is accepted, the Complainants dispute, as a result, '*fighting between armed or equipped robots*' is unanimously called 'robot wars'. It is one thing to consider the definitions of ROBOT and WARS separately, combine them and come up with a possible meaning of ROBOT WARS. However, this doesn't mean the term is commonly used in that way. Whilst ROBOT and WARS are descriptive terms the combination is unusual and has no generic meaning.

- The Respondent relies on an arcade game by Apple (1981) and a film (1993) each called ROBOT WARS. Neither of these used ROBOT WARS in a descriptive or generic way. ROBOT WARS is being used as a brand identifier to distinguish these products from other third party games or films. These examples therefore do not demonstrate any generic or descriptive use of 'robot wars'. Further, in 2006 (the date the Domain Name was registered by the Respondent) these products were no longer sold and therefore do not undermine the Complainants' goodwill in ROBOT WARS at this time.
 - Further, the Wikipedia entry that the Respondent relies upon in relation to the ROBOT WARS film was sourced from http://www.imdb.com/title/tt0107979/?ref_=fn_al_tt_2 (see 'external references' section of Wikipedia entry). This page incorrectly uses the Complainants' logo. It is assumed IMDb thought the film was connected to the Complainants. This illustrates how easy it is for actual confusion to occur.
 - Reference to Transformers is irrelevant. Transformers does not make any use of ROBOT WARS as a brand or generically.
 - The Complainants are not claiming a monopoly over the sport of robot combat (where radio controlled robots do battle). Third parties are free to set-up their own 'robot combat' events under their own brands. The sport is not known as 'robot wars' but as 'robot combat'. The link http://en.wikipedia.org/wiki/combat_robot cited by the Respondent confirms this.
 - The Respondent attached a graph from Google Books illustrating the use of 'robot wars' in books between 1930 and 2008. The references prior to 1995 are extremely low (<0.0000001%). One would expect larger figures if 'robot wars' was generic. Further, it is unclear how 'robot wars' was used (for example, they could be references to the game by Apple) or if they were published in the UK. The references increase dramatically after 1995. It is no coincidence that ROBOT WARS first aired in 1995.
- Secondary Meaning
 - Even if it is concluded that 'Robot Wars' has a generic meaning, there is now an acquired secondary meaning in that it denotes the goods and services of the Complainants. The Decision of the UK IPO referred to in the Complaint makes it clear that Complainants have substantial goodwill in ROBOT WARS. The Decision confirmed this existed in 2006, 2009 and 2011 and is sufficient to prevent third parties using ROBOT WARS to promote 'robot combat' events.
 - The Respondent admits in his Response that the *'Complainant has established rights to the TV show 'Robot Wars'* and that the trade mark 'Robot Wars' is distinctive of the goods for which registration was sought.
 - It is denied that the Complainants failed to provide evidence for toys, games, DVDs or other merchandise: The Complaint and its attached exhibits confirmed as follows:
 - In 2003, gross wholesale income from merchandise was more than £6 million;
 - In 2001, ROBOT WARS was the number one character for boys (7-9);

- Attendees at Live Events spent £4.20 (average) on merchandise;
 - One specific toy had sales of £2.5 million in a six week period;
 - UK Toy Retailers association's 2001 Boys Toy of the Year;
 - The FRA Website states "*ROBOT WARS is now a global phenomenon*" and "*UK Robot Wars has been incredibly successful, not just on the television side, but also because it sells a wide variety of merchandise*";
 - Merchandise was sold in shops, at Live Events and via www.robotwars.co.uk which had over 4 million hits in 2004;
 - 10% of all UK toys were sold via www.robotwars.co.uk or through the Robot Wars Club (accessed via www.robotwars.co.uk); and
 - In 2002, the ROBOT WARS Game Boy game achieved #2 in the charts, 120,000 ROBOT WARS books were sold and there were 35 licensees with 200+ product lines
 - To the extent 'Star Wars' has a generic meaning, it is clear it has obtained a secondary meaning and is now intrinsically linked to the film. www.starwars.co.uk sells fancy dress costumes of characters from STAR WARS. It is unclear if these are genuine. It is not for the Complainants to second guess Lucasfilm's position in this regard.
- Abusive Registration
 - The Complainants do not believe the Respondent was unaware of ROBOT WARS in 2006:
 - It is reasonable to assume that the Respondent, as a commercial purchaser of domain names, would have carried out due diligence into the Domain Name. In 2006, a Google search for 'ROBOT WARS' would have revealed the Complainants' extensive reputation. A search of UK Companies House would have revealed Robot Wars Limited.
 - DRS 4620 (roadrunner.co.uk) makes it clear the Respondent was carrying out searches of UK Companies House and the internet in 2006 (Paragraph 2, Page 4, Schedule 2).
 - Despite the Respondent stating he has only been in the UK since 'Spring 2001', he incorrectly asserts that this was after ROBOT WARS was at its peak. To the contrary, ROBOT WARS was very much in its peak in 2001. In 2001, it was in its 4th series and enjoyed a 16% share of total terrestrial TV ratings. Further, ROBOT WARS was global with programmes and merchandise sold in 30+ countries.
 - Whilst the Respondent states he does not own a television, he was aware of popular BBC television programmes in 2006 (he registered eastendersbbc.co.uk). At its peak, Robot Wars was the most popular BBC2 programme.
 - The Respondent admits he '*became aware of the Domain Name when looking through the expired list about to be released from previous*

registrants'. He was therefore aware that a third party previously owned the Domain Name. As a purchaser of domain names for use as 'pay per click' sites the Respondent would surely have investigated the previous use prior to purchase. He would have been interested to know the number of hits the site received. www.robotwars.co.uk got 4 million hits in 2004 alone.

- The Respondent admits he knew that other popular extensions of the Domain Name (.com) were taken. From this admission we presume that the Respondent did carry out due diligence (he identified that other domains were taken). From 1995-2006 robotwars.com was owned by Complainants.
- The Respondent admits that he purchased the Domain Name with the intention of reselling it. The Respondent asserts he was attracted to the Domain Name due to its generic sci-fi potential. However, on acquiring it he parked it and used it to link to third party websites. The roadrunner.co.uk DRS decision makes it clear that at this time the Respondent had control over the type of products these links referred to (he selected 'car parts' for roadrunner.co.uk). However, none of the 'sponsored links' on the original www.robotwars.co.uk webpage mentioned science fiction. Instead they use ROBOT WARS to promote products, including 'Robot Wars Ringtones' and 'Robot Wars Toys'.
- The Domain Name robotwars.co.uk is different to the Respondent's generic domain names cheaphostels.co.uk, sexymodels.co.uk, etc. These domains describe the type of products or services offered at the website. The Domain Name robotwars.co.uk offers no such indication.
- The Respondent's behavior in 2006.
 - The Respondent admits that he owned bbcradio.co.uk, fcukonline.co.uk, aolsearch.co.uk, axahealthcare.co.uk, ntlbroadband.co.uk, nokiaringtones.co.uk, channel4racing.co.uk and eastendersbbc.co.uk. DRS 4620 confirms the Respondent owned these in November 2006. The Respondent fails to offer any legitimate explanation why he registered these. This is because he does not have one. DRS 4620 formed this opinion: *'those 12 are so blatantly aimed at the owner of the corresponding trade mark that they could not have been registered accidentally and furthermore the website pages for each of them contain matter which is clearly directed at the business of the owner of the trade mark'*. The Domain Name robotwars.co.uk falls within this pattern.
 - The Respondent asserts that the three negative decisions against him are irrelevant since they are from 2007. The Complainants disagree. The Respondent registered the Domain Name in 2006 and these decisions illustrate his behavior in 2006. Further, the roadrunner.co.uk and CSMA.co.uk DRS decisions are analogous to this complaint.
 - The Respondent states the *'Complainant looks through all cases brought against the Respondent and finds 3 old cases'*. This is misleading. There are only 4 in total (the fourth not being from 2006).

- No Abandonment
 - The UK IPO decision makes it clear that the Complainants at no point abandoned rights in ROBOT WARS and that substantial goodwill exists (and existed in 2006). Just because the Complainants decided not to renew the Domain Name cannot justify the Respondent registering the Domain Name and using it to advertise non-affiliated products. Otherwise, brand owners would need to register (and retain) their brand for every domain suffix.
 - It is denied that the Complainants ever stated that they would not make any further series. ROBOT WARS is very much part of the Complainants' plans. They have recently licensed ROBOT WARS to be used in relation to live events and are looking to re-launch the series. It is common for a television series to be rested and revived. Examples include Doctor Who, Gladiators, Red Dwarf and Strictly Come Dancing. Further, ROBOT WARS is repeated today on Dave. It is denied that people would be unaware of Dave. Dave is one of the more popular satellite channels (it gets more viewers than MTV and UK Gold).
 - The Complainants have never consented to the Respondent using ROBOT WARS nor have they done any act to imply that he was so entitled.
 - In DRS 1147 the Expert considered that a delay of 13 years' in bringing the Complaint was not of significance.
- Allegation of Bad Faith
 - The Respondent suggests the Complainants were aware of the asking price for the Domain Name when they wrote the Complaint. This is not true. In any case, the price offered to Roaming Robots ("RR") exceeds the Respondent's reasonable out of pocket expenses.
 - On 5 February 2013, the Complainants entered into a licence with RR. Prior to this there was no relationship between the Complainants and RR. RR was simply another competitor promoting live 'robot combat' events under its ROAMING ROBOTS brand.
 - Prior to the Complainants' solicitors receiving the Respondent's submission neither the Complainants nor their solicitors were aware of any correspondence between the Respondent and RR. RR was acting in its own capacity. However, this highlights the concern. If RR had purchased the Domain Name it would have used it to promote its live events to the detriment of the Complainants.
 - The Complainants' solicitors have since contacted RR who confirmed that they first had contact with the Respondent in September 2007 when the Respondent informed them that he had received a 'fair number of previous offers' and that he wanted at least £6000 (£6000 is above the Respondent's reasonable out of pocket expenses). Subsequently this was reduced to £4,500 in November 2012 following second contact between RR and the Respondent.

- The Respondent's strategy was clearly to sell the Domain Name for an inflated price to the Complainants' competitors and, until his price was met, use it to generate money by taking unfair advantage of the Complainants' goodwill.
- Whilst not relevant, the Complainants are (and already were) taking legal action against Mrs Jello in relation to robotwars.com.

Discussions and Findings

General

In order to succeed the Complainants must prove, on the balance of probabilities, two matters, i.e. that:

1. The Complainants have 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.

These terms are defined in the Nominet DRS Policy as follows:

- **Rights** means rights enforceable by the Complainants, 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 Complainants' Rights; or
 - ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainants' Rights.

Complainants' Rights

The first point to make clear is that for the purpose of establishing the existence of Rights it does not matter whether those Rights came into existence before or after the registration of the Domain Name. That distinction only becomes potentially relevant when deciding whether or not the Respondent's registration or subsequent use of the Domain Name took unfair advantage of or caused unfair detriment to those Rights.

The Complainants have the benefit of a Community trade mark registration for ROBOT WARS and that is clearly sufficient to establish Rights for the purposes of the DRS.

However, the issue of whether or not the Complainants also had prior unregistered Rights, and in particular at the time of the Respondent's registration of the Domain Name in August 2006, has been the subject of extensive submissions by the parties. In this case, that question is relevant to the issue of whether or not the Respondent's registration or subsequent use of the Domain Name was abusive and I will therefore also consider that question.

There can be no doubt that between 1998 and 2004 the Complainants made very extensive use of the ROBOT WARS name both in the UK and elsewhere. The Respondent says the name ROBOT WARS is entirely generic, being descriptive of the concept of "robot fighting". The Complainants acknowledge that each separate word is a common generic word but say the combination of them is fanciful and has no such generic meaning and is distinctive per se. At the very least, the Complainants say that the name has acquired a secondary meaning as a result of their extensive use of it.

Whilst the Respondent has been able to point to some limited other uses of the phrase "Robot Wars" predating the Complainants' use of it from 1998, the extent and nature of those other uses falls well short of establishing that, as at 1998, it had become the common, generic term to describe the concept of physical contests between robots. However, it is a term that does at least allude to such a concept and is therefore somewhat descriptive of it. But the Complainants have put forward substantial evidence of extensive use of the ROBOT WARS name, including on mainstream UK television as the name of a TV show that became reasonably popular and ran for several years.

The nature and extent of the use made of the name by the Complainants was such that, even if it was not inherently distinctive on day one of its use by the Complainants in 1998, it will have quickly established a secondary meaning as being distinctive of the Complainants' TV series and, subsequently, the associated live events.

The other relevant issue is whether or not those unregistered Rights still existed when the Respondent registered the Domain Name in August 2006. That question is raised because the Complainants' TV series ended in 2004 and there appears to have been no continued use of the ROBOT WARS name by the Complainants between then and August 2006. However, the goodwill in and associated with a brand does not cease overnight when active use of it stops. Depending upon the circumstances, such goodwill can remain for many years. As the Complainants rightly point out, it is common in particular for television series to be brought back after a gap of many years.

I have no doubt that, after the quite extensive use made of the ROBOT WARS name by the Complainants between 1998 and 2004 in relation to a popular TV show, a period of about two years of non-use is insufficient for the goodwill generated by that previous use to have entirely or even largely evaporated. I also note that the UK Intellectual Property Office came to the same conclusion when deciding that a third party registration of the name made in June 2006 should be revoked.

In the circumstances, I find that the Complainant does have Rights in the name ROBOT WARS being a name or mark which is identical to the Domain Name, ignoring the .co.uk suffix. I further find that those Rights existed in unregistered form as at August 2006 when the Domain Name was registered by the Respondent.

Abusive Registration

The Three Strikes Rule

The first preliminary issue to deal with arises because the Respondent has had three previous adverse DRS decisions made against him. This has been pointed out by the Complainants but, as the Complainants' rightly acknowledged, whilst the decisions all related to domain names registered by the Respondent in 2005 and 2006 i.e. around the same period as his registration of the Domain Name, the adverse DRS decisions were all made in 2007.

As the Respondent rightly commented, the "three strikes rule" in Paragraph 3(c) of the DRS Policy only applies if three adverse decisions were made within two years of the current

Complaint. Had they been so, then the effect of Paragraph 3(c) is to reverse the burden of proof by introducing a rebuttable presumption that the registration of the Domain Name will also have been abusive. As the adverse decisions were more than two years ago, the rule has no application and the Complainants still have the burden of proof.

Delay in bringing the DRS Complaint

The second preliminary issue to deal with is whether or not waiting for 6 or 7 years from the registration of the Domain Name before bringing any complaint has any relevance. The Complainants have touched upon this issue in their Reply and point to a previous DRS Decision where a delay of 13 years was said not to be significant. The added factor here is that the Complainants voluntarily gave up their registration of the Domain Name in 2006 thus allowing the Respondent to pick it up, and then waited a significant period of time until late 2012 before making any form of complaint to the Respondent in an attempt to retrieve it.

I do not believe such a delay is, of itself, determinative. However, it might be a factor to take into overall account, and it could carry additional weight if there had been any previous indication by the Complainants that they had abandoned any claim to the name corresponding to the Domain Name or they had done anything directly or indirectly to encourage the Respondent to believe that was so. But there is nothing to indicate that to be the case here.

Did the Respondent's initial registration of the Domain Name in August 2006 take unfair advantage of or was it unfairly detrimental to the Complainants' Rights?

The Complainants rely on Paragraph 3.a.i.A and 3.a.i.B of the DRS Policy and say that the registration of the Domain Name was for the purpose of blocking the Complainants from having the Domain Name themselves or selling it to the Complainants or their competitors for an inflated price over and above the cost of its acquisition and use.

It should be made clear that there is nothing objectionable at all in principle about having a business buying and selling domain names for a profit. That is now a well-established and legitimate business practice.

To rely on Paragraph 3.a.i.A and 3.a.i.B of the DRS Policy the Complainants must be able to prove that it was likely that the Respondent was, at the very least, aware of the Complainants and their claimed Rights and had them in mind when registering the Domain Name. The Complainants say that it is inevitable the Respondent must have been aware of the Complainants' Rights in the ROBOT WARS name when he registered the Domain Name. This is flatly denied by the Respondent. He says he only came to the UK in 2001 and has never owned a television set. He says the first time he had ever heard of the Complainants or their claimed Rights was when their solicitors wrote to him in October 2012.

The Complainants rely on Paragraph 3(a)(iii) of the DRS Policy and say 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 Complainants point to other domain names registered by the Respondent around the same time as the Domain Name being kinder.co.uk, bbcradio.co.uk, fcukonline.co.uk, scotlandtoday.co.uk, aolsearch.co.uk, axahealthcare.co.uk, ntlbroadband.co.uk, eastendersbbc.co.uk, nokiaringtones.co.uk and channel4racing.co.uk.

The Respondent makes a point based on the use of the present tense in Paragraph 3(a)(iii) of the DRS Policy, which says that it must be shown that the Respondent "*is engaged in a pattern of registrations*". He therefore says that this part of the DRS Policy does not apply to past domain name registrations of the Respondent but only those that are, at the time of the

Complaint, currently registered by the Respondent. He says he only retains two of the domain names relied on by the Complainants (kinder.co.uk and scotlandtoday.co.uk).

I do not accept the point the Respondent makes. The relevant time for assessing the situation is the time when the Domain Name is registered or acquired by the Respondent and whether or not, at that time, it formed part of any relevant pattern of registrations. It is irrelevant that some or all of the relevant domain names have subsequently been sold or otherwise transferred or abandoned.

Whilst, the Complainants' TV show that ran until 2004 was reasonably popular, it was involved in a relatively niche area of "robot fighting" and, as such, I do not believe it was likely to have been a household name in the UK in 2006 (such as BBC, French Connection/FCUK, AOL, AXA Insurance, NTL, Nokia, Channel 4 and the "Eastenders" TV show) and therefore make the Respondent's awareness of it almost inevitable.

The Complainants face two other problems in establishing that the registration of the Domain Name was part of the pattern for which they contend. First, as pointed out by the Respondent, two of the domain names (kinder.co.uk and scotlandtoday.co.uk) are much more in the nature of generic names / words rather than being well-known trade marks. Secondly, as pointed out by the Complainants, for all but one of the other domain names that do include a well-known trade mark, they are followed by a generic descriptor i.e. radio, online, search, healthcare, broadband, ring tones and racing. That is not the case for the Domain Name. The Complainants say that just makes the registration of the Domain Name even worse. But in my view, what it means is that the Domain Name does not follow the same pattern. The final domain name in the claimed pattern of registrations is eastendersbbc.co.uk. But one domain name does not make a pattern. In any event, it is the name of a well-known TV show followed by the channel on which it is broadcast. For the Domain Name to have followed the same pattern it would have been robotwarsbbc.co.uk or robotwarschannel5.co.uk.

The Respondent points out that he is involved in buying large numbers of domain names and was attracted to the Domain Name because of its general potential (and therefore value) in the field of science fiction. That is certainly plausible.

The Respondent also makes the telling point that he buys domain names that are being released back into general circulation because the current registrants have not renewed them. The Complainants admit that the failure to renew it was a deliberate decision and not some oversight. The fact is that the Complainants already had the Domain Name but, at the time, no longer wanted it. That makes it very difficult for the Complainants to allege and prove that the likely reason why the Respondent registered the Domain Name at that time was because he thought it would block the Complainant from having it or that he could sell it back to them for a sum well in excess of the cost for which the Complainants could simply have paid to renew it.

Finally, the Complainants have put forward no evidence to suggest that the Domain Name was registered by the Respondent in order to sell it to their competitors for an inflated price. On the contrary, whilst the Domain Name was parked and made generally available for sale, there is no evidence that since 2006 the Respondent made any direct attempts to sell it to any of their competitors. There was some communication between 2010 and 2102 with one competitor, but that seems to have been initiated by the competitor and not the Respondent. In any event, if the Respondent waited as long as four years before offering it to a competitor, that does not help the Complainants to demonstrate that this was likely to have been the Respondent's original intention all along.

In the circumstances, I find that the Complainants have failed to prove, on the balance of probabilities, that the Domain Name was registered or otherwise acquired by the Respondent

in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainants' Rights.

Has the Domain Name subsequently been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainants' Rights?

The case therefore falls to be decided on whether or not the Complainants have proved that the subsequent use of the Domain Name by the Respondent has been abusive.

The Complainants rely upon Paragraph 3(a)(ii) of the DRS Policy i.e. that there are 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, or operated or authorised by, or otherwise connected with the Complainants.

The only use made of the Domain Name by the Respondent is that it has been parked on a holding page that made it clear the Domain Name was for sale and in the meantime generated click-through income from third party sponsored advertising links.

As is made clear by Paragraph 4(d) of the DRS Policy, trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities, and each case will be considered on its merits.

In addition, Paragraph 4(e) of the DRS Policy confirms that the sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:

- i) the nature of the Domain Name;
- ii) the nature of the advertising links on any parking page associated with the Domain Name; and
- iii) that the use of the Domain Name is ultimately the Respondent's responsibility.

I cannot see that the Respondent has done anything objectionable just by making it clear on the parking page that the Domain Name may have been generally available for sale.

The Complainants point out that several of the sponsored link advertisements appearing on the holding page related to businesses that competed with them. The Respondent says that when he first parked the Domain Name he used the default setting of the name itself without choosing any additional keywords to generate particular types of sponsored links. In addition, when the Complainants' solicitors first contacted him in October 2012, he took immediate steps to make the parking page blank so that it would not accidentally automatically generate sponsored links relating to businesses selling any goods or services covered by the Complainants' Community trade mark rights.

The Complainants responded to the latter point by saying that the parking page still retained a search box facility and that could be used to generate the same type of sponsored links as before, so now it was now just a two-step process rather than one automatic one. But that does require the visitor to make a particular search choice once at the website, rather than being automatically faced with the competitor sponsored links as soon as they arrive at the website.

I believe the Respondent's action in making the parking page "blank" of sponsored advertisements was a genuine effort on his part in response to receiving the solicitor's letter.

However, I can and should take into account the totality of the use that has been made of the Domain Name and the nature of the parking page both before and after the sending of the solicitor's letter in October 2012. If that were not the case, a respondent could always avoid the consequences of his actions under the DRS Policy by waiting until actually challenged, but sit back and reap the financial benefit generated by inappropriate content being featured on the parking page in the meantime.

The Respondent says he owns a large quantity of domain names and it is impractical for him to monitor all of the parking pages, and he had no reason to view the parking page for the Domain Name until hearing from the Complainants. However, the fact remains that the Respondent is ultimately responsible for the content of the parking page whether he monitors it or not, and he cannot deliberately turn a blind eye to it.

The Complainants also rely on the concept of "initial interest confusion" and both parties have made reference to the DRS Experts' Overview published on the Nominet website to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet's panel of independent adjudicators, have dealt with those issues to date and identifying any areas where Experts' views differ.

As both parties have referred to the relevant section of the Overview but drawn different conclusions from it, I have set out below what it says in section 3.3 of the Overview.

"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.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privalege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decision in DRS 00248 (seiko-shop.co.uk)."

The Complainants rightly point out that the Domain Name is identical to the name in which they have Rights and say that this is a clear case where initial interest confusion is relevant. The Respondent on the other hand highlights the reference to "cannot sensibly refer to

anyone else" in the Overview and says that this means initial interest confusion only applies when *"the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else"*. He says that "Robot Wars" can and does refer to others, so initial interest confusion cannot apply in this case.

I do not agree with the Respondent. He has not been able to identify many other relevant uses of "Robot Wars" but in any event he is taking what is said in that part of the Overview out of context. The Overview goes on to say that, in that case, there is bound to be a severe risk that a search engine will return the URL for the website connected to the Domain Name or the user will guess it to be that and visit the site in the hope and expectation that it is *"operated or authorised by, or otherwise connected with the Complainant"*. The Overview does not say that such a situation is the only time there will be a severe risk of initial interest confusion, just that such a risk is bound to happen in that situation. Clearly, there can be situations where Rights in the name or mark exist but the name or mark will only sensibly refer to one particular person or business to a particular niche section of Internet users who are interested in the relevant person or business, but it might mean nothing at all to others who are not. In those situations, there can still be a severe risk that a substantial proportion of Internet users will be a victim of initial interest confusion.

The Respondent also appears to have misunderstood the potential relevance of initial interest confusion. He says that the Complainants cannot make good their allegation of actual confusion having occurred because *"it becomes clear from the very first seconds observing the website (which is only a holding page consisting of links to other websites) that the Domain Name cannot be operated by the Complainants"*. But initial interest confusion, if it is happening, is actual confusion and it does not matter that the confusion is dispelled as soon as the content of the website is viewed. It was actual confusion that drew the user to the website in the first place.

The Respondent goes on to say that, even if the parking page contained sponsored links to competitors of the Complainants, it would still be considered fair use because such use took place when the Respondent was unaware of the Complainants' Rights.

The Complainants challenge the Respondent's claim that he was unaware of their existence or their Rights until their solicitors wrote to him in October 2012. They say that, as a purchaser of domain names for use as 'pay per click' sites, the Respondent would surely have investigated the previous use prior to purchase. But that is just speculation and not necessarily the case. Many purchasers of domain names buy them in bulk through auctions by reference to generic categories or by using automated software.

The Complainants say that a previous DRS decision involving the Respondent (DRS 4620 - roadrunner.co.uk) makes it clear the Respondent was carrying out searches of UK Companies House and the internet in 2006. But in that case, the DRS Decision indicates that the Respondent conducted those searches when preparing his response to the complaint, not in advance of first acquiring the domain name.

For support, the Respondent relies on the DRS Appeal Panel's decision in DRS 04962 (MySpace Inc v Total Web Solutions Limited) where it was stated: *"To date experts and Appeal panels have reasonably consistently taken the view that if a registrant acquires a domain name in advance of the coming into existence of the complainant's rights, the registrant is entitled in principle to hold onto the domain name and to use it, notwithstanding that confusion of the 'initial interest' variety may be inevitable. Similarly, experts and Appeal panels have concluded that in such circumstances it is not of itself abusive for the registrant to demand a high price from the complainant for transfer of the domain name in recognition of its enhanced value. Problems only arise for the registrant if he actively does something to take advantage of his position."*

But that deals with the case of the lucky registrant who benefits from the innocent windfall of an increase in the value of a domain name caused by a complainant subsequently starting to

use a name or mark that corresponds to the respondent's pre-existing domain name. But in this case, the Respondent did not acquire the Domain Name in advance of the coming into existence of the Complainants' Rights. Those Rights had been in existence since 1998, some eight years before his acquisition of the Domain Name.

The Respondent also relies on a previous DRS decision involving himself as a respondent. He points out that in DRS 09331 (JD Sports Fashion Plc vs Mr Denys Ostashko (the Respondent)) under similar circumstances the Expert ruled that: *"I have found that the Respondent acquired the Domain Name 'innocently' without knowledge of the Complainant's Rights. In such circumstance I regard the Respondent's use of the Domain Name to point through to a holding page to be fair use of the Domain Name in accordance with paragraph 4(a)(i)C of the Policy, even if it contained sponsored links to the Complainant's competitors. This is also consistent with the statement of the Appeal panel in DRS 05856 (Deutsche Telekom AG v Lammtara Multiserve Limited): "Abusive Registration connotes culpable behavior akin to knowing wrongdoing" "6.34 In this respect, as set out at paragraph 6.25(c), after notification of the Complainant's rights, the Respondent directed the Domain Name to a parking page with a plain search box. I do not regard this to be an objectionable use of the Domain Name."*

The Expert in the DRS 09331 case relied upon the part of the Appeal Panel decision in DRS 04962 (*MySpace Inc v Total Web Solutions Limited*) referred to above, even though the Expert acknowledged that (as in this present case) the Respondent did not acquire the relevant domain name in advance of the coming into existence of the complainant's Rights.

The Expert in that case also said that the approach adopted was consistent with the statement of the Appeal panel in DRS 05856 (*Deutsche Telekom AG v Lammtara Multiserve Limited*): *"Abusive Registration connotes culpable behaviour akin to knowing wrongdoing"*.

But in DRS 05856, the Appeal Panel also went on to make it clear that, in their view, *"the test of abusive registration under the Policy has to have an objective element to it, but not all unintentional infringement will avoid a finding of abusive registration."* The Panel gave the specific example of a respondent who adopts an ostrich approach of having his head in the sand being unlikely to get much sympathy from any Expert.

The DRS 05856 case was also decided under the previous version of the DRS Policy which did not have any equivalent of Paragraph 4(e) of the current Policy, which expressly deals with parking page content and confirms that *"that the use of the Domain Name is ultimately the Respondent's responsibility"*.

In addition, I also note Section 2.4 of the Overview, in which it is stated as follows:

"The body of expert decisions under the Policy is developing and certain principles are emerging. The section of the Appeal decision in DRS 04331 (verbatim.co.uk) dealing with 'knowledge' and 'intent' sets out one panel's views on that topic. However, new domainer practices (e.g. automated bulk transfers of domain names) are becoming commonplace and to the extent that the Verbatim decision suggests that for a finding of Abusive Registration, the Respondent must have had knowledge of the Complainant and/or its Rights at the relevant time, it is now thought by some Experts that that might overstate the position.

A particular area of current debate among the panel of Experts is the extent to which the concepts of unfair advantage and unfair detriment as set out in the definition of Abusive Registration [paragraph 1 of the Policy] embrace a subjective element. The members of the Appeal panel in the Verbatim case took the view that for a registration to be labelled "Abusive" there had to be something morally reprehensible about the Respondent's behaviour, a view more recently adopted in DRS 07066 (whistleblower.co.uk). Others have expressed the view that what is or is not fair can be judged wholly objectively and that to gain or cause damage by way of trade mark infringement is necessarily unfair irrespective of the motives of the Respondent.

To date this divergence of view has emerged primarily in the cases where the Complainant's trade mark rights have post-dated registration of the domain name - a very small proportion of the overall body of cases."

This is not one of those cases where a complainant's Rights have post-dated the respondent's registration of the domain name in issue.

My view is that it is right to require a complainant to demonstrate, on the balance of probabilities, that a respondent at least had knowledge or awareness of the complainant in order to get home under the first limb of the definition of Abusive Registration. That limb deals with the manner of the initial registration or acquisition of the relevant domain name by a respondent, and that necessarily requires some level of subjective knowledge or intent by the respondent at the time.

However, the second limb of the definition of Abusive Registration concentrates more on the effects of the subsequent use of the Domain Name. In my view, it would be going too far to say that it can never be made out in the absence of a respondent's knowledge of a complainant or its Rights.

But it does require the manner of the use of the relevant domain name to be unfair, by either taking unfair advantage of being unfairly detrimental to the Complainants' Rights. The requirement of unfairness in the manner of use brings into play an assessment of the particular circumstances of each case. It is possible that the same nature and scale of advantage taken or detriment caused might be unfair in one case but not in another.

In this case, the Respondent has made an unequivocal denial of any knowledge of the Complainant or its Rights prior to receiving the letter of complaint from the Complainants' solicitors, and he has put forward what is at least a plausible explanation of his particular circumstances to support that denial. For an Expert to reject a respondent's clear denial of knowledge, some pretty solid evidence has to be produced in support by a complainant.

I have to say I have found this case to be finely balanced. In favour of the Complainants it can be said that name "Robot Wars" is not as descriptive as is claimed by the Respondent. In addition, the Respondent clearly was aware that the Domain Name was previously owned by someone else and it is likely from the sale price of £6,000 suggested by the Respondent in 2007 to have been a significant earner for the Respondent and that fact might lead a domainer like the Respondent to investigate the reason for the success of the site or behave in an ostrich-like manner and therefore be fixed with Nelsonian knowledge.

But the Respondent has flatly denied any knowledge of the Complainants' or their Rights and explained that he only came to the UK in 2001; he has never owned a television set; he thought the Domain Name had general application to science fiction; he owns a large number of domain names and does not have time to monitor all of their respective parking pages; he did not add any keywords to the default setting to configure the Domain Name's parking page to display any form of particularly targeted advertisements; he did not monitor the Domain Name's parking page; and he took immediate and appropriate action to make the page blank as soon as the Complainants first made contact with him.

On balance, I do not believe that the evidence and points put forward by the Complainants has discharged the burden of proving that it was more likely than not that the Respondent was aware of the Complainants and their Rights when he used the Domain Name by parking it with a default setting of keywords limited to the domain name itself for the purpose of receiving click through income from automatically generated sponsored links.

But that does not necessarily determine the issue when the sponsored links that were then created did in fact include links to competitors of the Complainants selling the same sort of goods and services as those covered by the Complainants' registered and unregistered Rights.

I am also conscious that there may have been some level of initial interest confusion occurring over the period of the Respondent's use of the Domain Name to link to a parking page.

But in assessing the overall fairness of the manner of the Respondent's use of the Domain Name, I am ultimately swayed by the facts that a) the Complainants deliberately choose to give up the Domain Name in 2006 and b) after six subsequent years of uninterrupted and unchallenged registration and use of the Domain Name by the Respondent, he did take immediate action to make the parking page "blank" of any automatically generated sponsored links relevant to the Complainants' competitors as soon as he received the first letter of complaint from the Complainants' solicitors informing him of their Rights.

In the circumstances, I cannot say that the Complainants, who have the burden of proof, have proved that the Respondent's use of the Domain Name was, in the circumstances of this case, abusive.

Finally, the Respondent also accused the Complainants of bad faith in attempting to reverse hijack the Domain Name. I have no hesitation in rejecting that contention.

6. Decision

For the reasons outlined above I find that the Complainants have proved, on the balance of probabilities, that they have Rights in respect of the name ROBOT WARS, being a name or mark which is identical or similar to the Domain Name, but that the Domain Name, in the hands of the Respondent, is not an Abusive Registration.

In the circumstances I order that no action be taken in respect of the Domain Name.

Signed

Dated 14 May 2013

Chris Tulley