

DISPUTE RESOLUTION SERVICE

D00014472

Decision of Independent Expert

Nova International Limited

and

Mr Daniel Land

1. The Parties:

Lead Complainant: Nova International Limited
Newcastle House
Albany Court
Monarch Road
Newcastle upon Tyne
Tyne & Wear
NE4 7YB
United Kingdom

Respondent: Mr Daniel Land
108 Symphony Court
Birmingham
West Midlands
B16 8AG
United Kingdom

2. The Domain Name(s):

greatbirminghamrun.org.uk

3. Procedural History:

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

02 July 2014 16:29 Dispute received
03 July 2014 12:06 Complaint validated
03 July 2014 12:35 Notification of complaint sent to parties
04 July 2014 12:19 Response received
04 July 2014 12:22 Notification of response sent to parties
09 July 2014 02:30 Reply reminder sent
14 July 2014 08:44 No reply received
14 July 2014 08:45 Mediator appointed
16 July 2014 16:41 Mediation started
28 July 2014 14:45 Mediation failed
28 July 2014 14:46 Close of mediation documents sent
01 August 2014 10:31 Expert decision payment received

4. Factual Background

4.1 The Complainant is a UK Limited Company which creates and runs mass participation sporting events in the UK. It owns a number of UK registered trademarks which incorporate the word "GREAT" to describe the particular sporting event in question. Notably these do not include a registered UK trademark for the term "the Great Birmingham Run" ("the Mark"). One of the events that it runs annually is the Great Birmingham Run ("the Run") which has been staged every year since 2008.

4.2 The Domain Name was registered on 24 October 2012 by the Respondent who is an individual and opted to omit his address from the WHOIS service. The name given and recorded as Registrant is Studio B. The Domain Name is used by the Respondent as the address of his website ("the Site"), which as at the date of the Complaint, was being used to display various photographs relating to the Run. In addition the Site provided hyperlinks to various other websites including sites at studiobirmingham.org.uk, charityzine.co.uk and to various media and charity sites. The Site described itself as "the Great Birmingham Run website." The Domains for the websites above at Studio B and Charityzine are also owned by the Respondent.

4.3 The Complainant's representatives wrote to the Respondent on 4 April 2014 and requested various undertakings in relation to the Domain Name. No response was received further to which a further letter was sent on 23 April 2014 to the Respondent to provide an extension until 2 May 2014 to respond. Again no response was received. The Respondent continues to maintain and use the Domain Name.

5. Parties' Contentions

The parties' contentions can be summarised as follows:-

The Complaint

The Complainant's Rights

- 5.1 The Complainant alleges as follows:- It has substantial goodwill (and reputation) in the trademark GREAT when used in a sporting context. More specifically, it has goodwill in the Mark. Since 1981 it has created and run a large number of mass participation sporting events under its GREAT trademark. These include the Run. Approximately 200,000 people take part in its "GREAT" series of events annually. It also spends significant sums each year on branding, marketing and publicity. The GREAT trademark when used in a sporting context is synonymous with the Complainant's group of Companies and is internationally recognised as referring to its events. There has been National press coverage of some of the events provided by the BBC. It operates a website relating to its events at greatrun.org. One of these events is the Run. It is the largest half marathon in the Midlands and has been staged since 2008 and in 2009 also incorporated the World Half Marathon Championships. It attracts competitors from across the UK and around the world and has generated substantial goodwill. In addition it owns a large number of registered trademarks consisting of the word "GREAT" followed by a geographical indication and suffixed with the nature of the event. The Domain Name is identical to its Mark and very similar to its other registered trademarks.

Abusive Registration

- 5.2 The Complainant alleges as follows:- The Domain Name is being used by the Respondent as its website address to display various photographs and promote photography services. The latter relate to the Run. The Complainant has not authorised this use of the Mark for such promotion. Previous attempts by the Complainant and its representatives to engage with the Respondent with a view to him ceasing such use of the Domain Name have either been ignored or not responded to by the Respondent.
- 5.3 The above use by the Respondent has created or is likely to create confusion in the minds of members of the public as to the affiliation of the Registrant's services with the Complainant's Group. It is thereby exploiting the goodwill and reputation of the Complainant and its Group's business.
- 5.4 The Domain Name is very similar to each of the Complainant's registered trademarks, which have a reputation in the UK. The use of the Domain Name by the Registrant takes unfair advantage of and/or

causes detriment to the distinctive character of the registered trademarks without due cause.

- 5.5 The Registrant has no rights or legitimate interests with respect to the Domain Name. It is simply being used to take advantage of the goodwill, reputation and distinctive character of the Complainant's trademarks (including without limitation its registered trademarks) to promote the Registrant's own photography services.
- 5.6 It is clear that the Registrant registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant and/or the use of the Domain Name by the Registrant is likely to, and is intended to, confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant requests that the Domain Name be transferred into its name.

The Respondent's Response

- 5.7 The Respondent alleges as follows:- He did not know prior to receiving the Complaint that the Complainant owned the trademark "GREAT" in Great Birmingham Run. When people say Great Birmingham Run they generally mean big Birmingham Run, not Nova Birmingham Run. Due to its scale and support by Birmingham City Council it is considered a public event. Now that he has been advised that the word "GREAT" is a trademark he has taken measures to address this and has changed the wording on his website. The website is not used to promote photography services and this is a "an outright lie". The volunteer who took the pictures did so for Charityzine to publish them to raise awareness of the charities involved in the event. There is no photography service being promoted. Why should the Complainant have any say in Charityzine taking pictures of this public event which is all over the news every year and full of independent photos? The Complainant did contact him but he did not ignore it. It sent him a few direct messages on Twitter asking him to reply which he tried to do but Twitter then said that he could only reply to people following him, so what was being asked of him could not be done. He did not receive anything by post (Royal Mail is unreliable in his area).

Abusive Registration

- 5.8 The Respondent alleges as follows:- The Run is generally deemed to be an event of national interest not a trademark private event whose story cannot be covered by independent third parties. Reference is made to http://en.wikipedia.org/wiki/great_birmingham_run. There is no confusion or exploitation. The one and only paragraph on the website (at the top of the home page) states very clearly what the site is about and links to the official commercial source on the event.

- 5.9 The fact that the event is publicised by Birmingham City Council and made to look like a public event is further evidence to why there should be no legal grounds for stopping him producing independent, third party coverage of the event, especially when there are so many charities involved. Charityzine aims to be responsible for covering major charity events in the area and it links to charities involved in the event.
- 5.10 The implication that he may be intending to disrupt the Complainant's business is a joke. What he describes as "the Midlands largest sports event" deserves independent coverage, especially when so many charities are so actively involved and the independent coverage is coming from the key authority on charity news in the region.
- 5.11 There is clearly no confusion, because the one and only paragraph on the site is very clear and cannot be missed and furthermore he has changed it now to be clearer.
- 5.12 The Complaint is refuted and a sincere concise response from the Complainant is awaited. Various web pages are referred to in support of the dispute.

6. Discussions and Findings

General

- 6.1 Under paragraph 2 (a) of the Policy a Complainant must show on the balance of probabilities that:
- (i) it has Rights in respect of a name or mark which is identical or similar to the Domain Name, and that
 - (ii) the Domain Name in the hands of the Respondent is an Abusive Registration.

Rights

- 6.2 "Rights" are defined in paragraph 1 of the Policy as "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights and descriptive terms which have acquired a secondary meaning."
- 6.3 The Complainant has produced a list of sporting events which it states it has created and run all of which use the word "GREAT" as part of their title. These generally use the word "GREAT" followed by a geographical indication and are suffixed with the nature of the event. None of the Complainant's statements which support the high profile nature of the Event, its name and goodwill in it are refuted by the Respondent. Indeed if anything he endorses these facts. As above he

refers to the Event as "the Midlands largest sports event" and states "due to its scale and support by Birmingham City Council it is considered a public event". Nor does the Respondent challenge the existence or validity of the various registered trademarks of the Complainant.

- 6.4 Whilst the Complainant's registered trademarks do not cover the full terms of the Mark they do include the word "GREAT" in association with sporting events, including numerous runs. For example "GREAT MIDLAND RUN". Apart from "GREAT", they include geographical indications and the nature of the sporting events. These terms are descriptive and so, in the Expert's view, the Mark is similar on a conceptual basis to at least some of the registered trademarks.
- 6.5 The Respondent suggests that the Run/Mark is not associated specifically with the Complainant. Whether the public view the Mark and the Run as being exclusively associated with the Complainant specifically has no relevance for the purposes of establishing enforceable rights under the UK law of passing off. It is not necessary to demonstrate that the relevant public will associate the name with a specific entity. (United Biscuits v Asda (1997) RPC 513 at page 533).
- 6.6 In the circumstances the Expert is satisfied that there is sufficient goodwill in the Mark such as to provide the Complainant with unregistered and enforceable trademark rights in it. In addition the registered trademarks are similar to the Mark and also provide the basis of enforceable trademark rights.
- 6.7 The Domain Name incorporates the whole of the Mark. As such it is identical to the Mark.
- 6.8 In the circumstances the Expert is satisfied that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

- 6.9 Under paragraph 1 of the Policy, an Abusive Registration means a Domain Name which either:
 - (i) "was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
 - (ii) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

This definition covers both the time of the registration and later use.

- 6.10 It is sufficient to satisfy either of the above limbs for there to be a finding of an Abusive Registration.
- 6.11 Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. This includes 3 a (i) c which is that it has been registered or otherwise acquired for the purposes of unfairly disrupting the business of the Complainant. This is one of the grounds relied upon by the Complainant. Whilst the Respondent clearly had prior knowledge of the Complainant's Mark and the Run itself, the Expert does not consider on the balance of probability that it registered the Domain Name deliberately to disrupt the Complainant's business. The Respondent is not directly in competition with the Complainant and at least part of its intent in using the Domain Name is a wish to support and promote the Event, as opposed to "disrupt" it.
- 6.12 Another ground for an Abusive Registration under paragraph 3 a (ii) of the Policy is circumstances indicating that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Expert considers here that there is likely to be confusion of people or businesses into believing that the Domain Name is registered to, operated by or otherwise connected with the Complainant. Prospective participants or parties interested in the Run may use search engines to attempt to find the official site for it. As the Domain Name is identical to the name in which the Complainant has Rights, they may use search terms equivalent to or similar to the Mark and may well end up on the Respondent's site. Even though the pre-Complaint version of the Site did refer to the official site for the run and provided a link to it which might dispel any confusion at that point, there would still be initial interest confusion. Once at the Respondent's site users will be exposed to links to other sites, including 2 operated by or associated with the Respondent, which is presumably a benefit for him.
- 6.13 The Respondent's site at the Domain Name as now altered after it received the Complaint states, *"Welcome to Charityzine's collection of photos, records and memorabilia on the Great Birmingham Run, featuring exclusive shots of this half marathon event captured by our own volunteer journalists. Browse our exclusive pictures before visiting the official Bupa Great Run (link) website and don't forget to connect with us on Twitter too. See also, further coverage of the run by mainstream media sources and popular charities listed below. The Great Birmingham Run is Birmingham's biggest multi-charity event and the website exists purely to provide independent coverage of it. Please note that "Great Birmingham Run" is a trademark of Nova International Limited, which we are not affiliated with.*

Temporary Notice: Nova are taking legal action in an attempt to seize ownership of our website, mainly because it is memorably named after the Event that it is about. Yeah, It's about this event of immense public interest, which sees roads close throughout the City every year, and letters from Birmingham City Council sent to every household in the City but we're clearly not pretending to represent the event founders. We tried to explain, they either didn't understand or...". It then provides links to various media sources including Charityzine and to various charities.

- 6.14 Clearly the Respondent is attempting to deal with the Complainant's concerns in its Complaint by making these changes. However there will still, as above in the Expert's view, be initial interest confusion because of the identity of the Domain Name to the name in which the Complainant has Rights.
- 6.15 The argument on which the Respondent appears to be relying on mainly is that its site under the Domain Name, is a form of tribute or fansite. It is suggesting that its use of the Domain Name is in a descriptive sense. In this respect it could try to rely upon Paragraphs 4 (a) (i) C or 4 a (ii) of the Policy.
- 6.16 4 (a) (i) C states "*Before being aware of the Complainant's cause for complaint...the Respondent has: made legitimate non-commercial or fair use of the Domain Name or (ii) the Domain Name is generic or descriptive and the Respondent is making fair use of it*". Paragraph 4 b of the Policy states that "*fair use may include sites operated solely in tribute to...a person or business.*"
- 6.17 In its amended version of the Site the Respondent has deleted reference to Studio B. The Expert has reviewed the Studio B website at studiobirmingham.org.uk. It has listed under Ecommerce Projects a link to Black Workwear which appears to be a niche clothing retail store. It also has a page headed Investment Opportunities whereby investments are sought for its projects. This suggests to the Expert that there is/was some commercial use being made of the Domain Name via this link. This would exclude the possible application of paragraph 4 (a) (i) C as the use is not entirely "non commercial" in nature.
- 6.18 The Respondent claims it was unaware of the Complainant's registered trademarks and in the name Great Birmingham Run before he received the Complaint. However he was aware of the Run, the Mark and of its significant goodwill. This is clear from the terms of his Response to the Complaint. Thus in the Expert's view the Respondent might have been expected to have realised that the "official" organisers of the Run might well have had reason to object to use of the Domain Name before he adopted it. There are a few indications in this case that put in doubt the Respondent's suggestion that he did not think there would be any issue about his registration and use of the Domain Name. These are

that he did not use his own name and address as Registrant, despite the fact that he had done so with the other two domains in which he has an interest being studiobirmingham.org.uk and charityzine.co.uk. The Domain Name is instead registered to the Registrant as Studio B and described as a "UK individual" which has also adopted to have their address omitted from the Whois Service. It seems odd that this has been done specifically in the case of the Domain Name when the Respondent's name and its address are used and listed as the Registrant's details in respect of the Studio B and Charityzine domains. He also failed to respond to the Complainant's lawyers' two letters requesting that he cease use of the Domain Name etc. The Respondent's explanation for that is that he did not receive these letters by post as "the Royal Mail is unreliable in this area" and seems flimsy. In addition he admits that he was contacted by the Respondent on Twitter, but says he was unable to reply as this was impossible as they were not following him. However he was aware that they had tried to contact him, even if not via correspondence, through Twitter. Had the Respondent really wished to do so he would have found a means to make contact with the Complainant other than through the Twitter site.

- 6.19 Even if the Respondent did not realise that the Complainant might have cause for concern about his use of the Domain Name, the Site is not being used solely in tribute to the Run. It also promotes Charityzine and various other organisations to which it contains links. Also the Site, as above, originally contained a link to Studio B. Whilst a number of links are to descriptive media coverage of the Event and to charities, nonetheless the Site is not solely being run as a tribute site. Both the Charityzine and Studio B sites relate to businesses in which the Respondent has interests as he is listed as the Registrant for these domains.
- 6.20 Furthermore it would easily have been possible for the Respondent to achieve its stated aim of being a pure tribute site by using a slightly different and more descriptive domain name.
- 6.21 In DRS06284 which is referred to in the Expert Overview at paragraph 4.8, the domain name was identical to the name in which the Complainant had Rights. It was used for a protest site. A modified domain name could have been used to achieve the same aim of being a protest site. The Appeal Panel in that case held that only in exceptional circumstances would use of an identical name not be unfair use.
- 6.22 Here the Respondent says in its Response "*when people say Great Birmingham Run they generally mean Big Birmingham Run and "the Midlands largest sports event"*". The Respondent could easily have adopted a domain name incorporating terms such as Big Birmingham or Big Midlands Run or even Birmingham Half Marathon and still

achieved his stated aim. Use by him of an identical domain name seems likely to have more success in attracting users.

- 6.23 The Expert has already indicated above that she considers that use of the Domain Name is causing initial interest confusion. Under paragraph 4.7 of the Expert's overview, where use of the Domain Name is causing confusion, it is still possible to make fair use of it where it is the Complainant's trademark. However that paragraph states "*whilst ordinarily, a confusing use of such a domain name will be regarded as unfair it may not be regarded as unfair, where for example the Respondent's use and registration of the domain name predates the Complainant's rights.*" Here that precondition is not met. As there is likely to be confusion, or at least initial interest confusion, where the Domain Name is identical to the Mark in which the Claimant has Rights and the Expert finds on the balance of probabilities that this is an Abusive Registration.
- 6.24 In addition the Complainant argues in the Complaint that the Domain Name is similar to its registered trademarks and they each have a reputation in the UK. As such it argues that the Respondent is taking unfair advantage of and/or causing detriment to the distinctive character of the registered trademarks without due cause.
- 6.25 The Complainant is referring to test for trademark infringement under Section 10 (3) of the Trade Marks Act 1994. In that case there is no need to demonstrate confusion or likelihood of it to establish trademark infringement. Of course the DRS operates on its own set of rules and principles and so the UK Law of Registered Trade Marks is not directly applicable. However in the Expert's view reputation in the Complainant's trademarks here is significant and the test under Section 10 (3) may well be fulfilled, were it to be directly applicable here. The Respondent, as above, has no due cause to use the Domain Name as an identical one to the name in which the Complainant has Rights. It is also taking unfair advantage of its reputation and distinctive character as it uses the Domain Name not just as an address of a pure tribute site but also to attract visitors to its Charityzine, and formerly its Studio B, websites as well as to the other sites to which it links.
- 6.26 The Policy defines an Abusive Registration as referred to above as use in a manner which takes unfair advantage of the Complainant's Rights. This is very similar to the test under Section 10 (3) as above and in the Expert's view on the balance of probabilities is applicable here.

7. Decision

- 7.1 The Expert has found that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that its use by the Respondent is likely to cause confusion or at least initial interest confusion. The Expert also considers that the Respondent's use of the Domain Name takes unfair advantage of the Complainant's Rights.

7.2 Accordingly the Expert finds that the Complainant has Rights in respect of a name or a mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration.

The Expert therefore determines that the Domain Name should be transferred to the Complainant.

Signed GILL GRASSIE

Dated 20/8/2014

