

Nominet UK Dispute Resolution Service

DRS Number 05711

Parties: Fremantle Media Limited v J McIlroy

Decision of Independent Expert

1. Parties

Complainant: Fremantle Media Limited
Address: 1 Stephen Street
London
Postcode W1T 1AL
Country: UK

Respondent: J McIlroy
Address: 157 Hithermoor Road
Staines
Postcode: TW19 6AU
Country: UK

2. Domain Names

britainsgottalent.co.uk
scotlandsgottalent.co.uk

This domain names are referred to below as the "Domain Names".

3. Procedural Background

A hardcopy of the Complaint was lodged with Nominet on 12 May 2008. Nominet validated the Complaint on the same date and notified the Respondent. In this correspondence Nominet informed the Respondent that it had 15 working days within which to lodge a Response to the Complaint. A hardcopy of the Response was submitted in time on 3 June 2008. This was in a non-standard format because it exceeded the word limit (of 2000 words) provided for by the Nominet Dispute Resolution Procedure (the Procedure). The Respondent was invited to resubmit its Response in the correct format by 6 June 2008 which it duly did. No Reply was served. The dispute not having been resolved in mediation, on 23 July 2008 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy").

Sallie Spilsbury, the undersigned ("the Expert") has confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as Expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the Parties which might appear to call into question her independence and impartiality.

4. Outstanding Formal/Procedural Issues

The Expert was faced with a number of procedural issues.

Both Parties in this matter sought to a greater or lesser extent to submit correspondence and other documentation outside of the Policy and Procedure. Clause 13a of the Procedure provides that the Expert is not obliged to consider any statements or documents from the Parties which she has not received according to the Policy (i.e. the Complaint, Response and any Reply). The Expert is mindful that the DRS Policy and Procedure was devised to offer an efficient and transparent method of resolving disputes in the .uk Top Level Domain. In order to achieve this objective it is important that parties to a dispute use the standard DRS process. Otherwise the complaints process will become unmanageable. In accordance with the Policy and Procedure the Expert is therefore making her decision based on the following documentation only:

- Complaint
- Response
- Complainant's Response to the Expert's Request for a Further Statement under clause 13a of the Procedure
- Respondent's Responses to the Complainant's Further Statement (dated 15 and 18 August 2008)

Applications under 13b

In addition to the submissions which were put forward outside of the DRS Procedure attempts were made to introduce non-standard submissions under clause 13b of the Procedure.

On 28 July 2008 The Complainant sought permission to make a non-standard submission. Clause 13b of the Procedure provides as follows:

Any communication with us [Nominet] intended to be passed to the Expert which is not part of the standard process.... Is a "non-standard submission". Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission. We will pass this explanation to the Expert, and the remainder will only be passed to the Expert at his or her sole discretion. If there is no explanation, we may not pass on the document or information".

Before the Expert had considered this request the Respondent also sought to make a non-standard submission. This was brought to the attention of the Expert on 7 August 2008.

As a preliminary to reaching her full decision the Expert had to decide whether to accept one of both of these non-standard submissions.

The Complainant's Non Standard Submission

The Complainant's explanatory paragraph reads as follows:

Further to the submission of [the Complainant's] Complaint Form on 7 May 2008 and the Respondent's formal response of the 23 May 2008, we received from the Respondent a further letter, dated 11 June 2008. The Respondent's letter covers details and raises issues not previously dealt with by the Respondent in his formal response and to which we feel it only proper to respond in light of our decision to appoint an expert in this matter. Further, in light of further research conducted post receipt of the Respondent's letter we have acquired further evidence of passing off on the part of the Respondent. It is for these reasons that we seek the admission of a further statement and the annexes attached thereto under the "exceptional need" criteria outlined in s13.b of the Dispute Resolution Service Policy.

Having considered the matter the Expert has decided that the Complainant has not demonstrated an "exceptional need" for the non-standard submission. This is for the following reasons:

- The letter of 11 June 2008 to which the Complainant refers is not part of the formal submissions in this matter. For the reasons set out above the Expert is taking no

account of documentation provided outside of the DRS Procedure. It follows that it is unnecessary for the Complainant to make a response to the points made by the Respondent in his letter.

- To the extent that the additional evidence of passing off does not arise from the letter of 11 June 2008, then it is submitted a number of weeks out of time for any Reply and not far short of 3 months after the original Complaint. The explanation is that further research has been carried out by the Complainant. If parties were routinely permitted to add to their submissions in order to strengthen them the efficiency of the DRS service would be severely jeopardised. The Procedure calls for the parties to show “exceptional reasons” for further submissions and in the view of the Expert these should generally take the form of a matter that could not be reasonably foreseen by the parties (e.g. a significant change of use of a disputed domain name by the Respondent). This does not appear to be the case here.
- The Complaint document already includes a reference to passing off and the Expert is accordingly already on notice that this is an issue that she must consider when making her decision.

The Respondent’s non-standard submission

The Respondent’s explanatory paragraph reads as follows:

Further to the submission of Fremantle’s (the claimant) Dispute Resolution Service Complaint Form on the 7th May 2008 and the Claimant’s S13.b Explanatory paragraph response of the 28th July 2008. The Claimant covers raises issues not previously dealt with and I feel I should be given the opportunity to reply to the Expert. While it is not my responsibility to prove anything as I’ve been instructed by Nominet it is Fremantle who have do this, I believe I have already proven our rights to the name on many levels, not least being “totally-transparent” that the site is in no way associated with this show, clearly shown on the footer of “every page” on the britainsgottalent.co.uk site. The alleged further evidence of suggested passing-off is untrue and in part libellous. It is for these reasons that I seek the admission of a further statement, while unlike the Claimant I do not believe there is an “exceptional need” or a case to be answered. I would however like the opportunity, should the expert believe it has to go that far, to answer points raised in the Claimant’s full submission document, criteria outlined at S13.b of the Dispute Resolution Service Policy, which I regard as further evidence of a cynical attempt to discredit me. I contest this is a blatant case of “reverse domain name high-jacking” and an attempt to gain a valuable domain that they knew was registered and in development where they have no rights.

In reality this is not a substantive request to make a non-standard submission. It is made in anticipation of the Expert allowing the Complainant’s 13b request. This has not been allowed and therefore the pre-emptive request by the Respondent is irrelevant.

On 11 August 2008 the Expert sought clarification of a number of facts that were referred to briefly in the Complaint document but which required amplification. The Expert’s request was made pursuant to paragraph 13a of the Procedure and was in the following terms;

“The Expert requests a Further Statement from the Complainant providing information on the matters set out below (all of which arise from the Complaint document).

1. Please supply a brief description of the GOT TALENT format (in particular as it relates to BRITAIN’S GOT TALENT).
2. On what date did NBC announce America’s Got Talent (paragraph 11 of the Complaint)?

3. What is the relationship between the Complainant and Simco Limited (paragraph 10 of the Complaint)?
4. Please substantiate the assertion that the format rights and the goodwill in the GOT TALENT format belong to the Complainant (note this query relates to title only. No further statements are requested concerning the *existence* of goodwill).

The Complainant is requested to supply the above information within 3 working days of receipt of this request.

Thereafter the Respondent shall have 3 working days to respond to the information provided (should the Respondent wish to make a response).

The Parties should note that information provided pursuant to this Request must be limited to the precise issues identified by the Expert. Superfluous information or submissions will be disregarded by the Expert.”

Both Parties responded within the designated timeframe. Where relevant the Parties’ submissions are recorded in section 5 of this decision. The Expert has disregarded superfluous submissions that do not directly relate to her specific requests.

5. The Facts

The Complainant

The GOT TALENT format

The Complainant is the joint owner of the GOT TALENT television format and related trademarks. The co-owner is Simco Limited (which trades as Syco Television). This position is confirmed by a document supplied by the Complainant as part of its Response to the Expert’s 13a Request for a Further Statement. The document is described as an extract from an agreement and is signed on behalf of the Complainant and Simco Limited.

The Complainant submits that the GOT TALENT television format is one of the most recognised television formats in the world today. The format consists of a search for the next best talent act. Anyone who believes they have talent is encouraged to audition for the programme. In the first part of the competition, acts audition in front of a studio audience and a panel of three celebrity judges. The semi-finals and final show are broadcast live and the results are ultimately decided by a public vote. BRITAIN’S GOT TALENT, hosted by the well-known entertainers, Ant and Dec, premiered in the UK on 9 June 2007 and was broadcast daily with a live final on 17 June 2007. The second series ran from 12 April- 31 May 2008.

Enclosed at Annex 4 to the Complaint are statistics showing the percentage of UK viewer ratings of BRITAIN’S GOT TALENT for series 1 and series 2 (up to and including episode 3 of series 2). These show that the percentage of audience share for the programme peaked at 47.9% for the final episode of series 1. The audience share for series 2 is also high (44.4% for episode 2 and 41.1% for episode 3). The show is clearly extremely successful in the UK.

The show BRITAIN’S GOT TALENT had a precursor. The format was originally developed in 2005 as “PAUL O’GRADY’S GOT TALENT” featuring entertainer Paul O’Grady. The show was to be broadcast on ITV and one pilot was produced, although it was never aired. This project was eventually discontinued because of contractual issues.

Before the broadcast of the BRITAIN’S GOT TALENT series in June 2007 the GOT TALENT format was commissioned by NBC in the United States under the name AMERICA’S GOT TALENT. The show was publicly launched in the US on 27 March 2006. A copy of a press

article was attached to the Complainant's 13a submission confirming the approximate date (the article itself is dated 28 March 2006 but refers to the NBC announcement as occurring earlier on "Monday"). The first series of AMERICA'S GOT TALENT ran from 21 June 2006-17 August 2006.

The GOT TALENT brand

The Complainant (together with Simco Limited) is the owner of a United Kingdom registered trade mark for GOT TALENT 2397928 in Nice Classifications 09, 16, 25, 28, 38 and 41. The mark is registered from 27 July 2005. The Complainant has also filed an application for BRITAIN'S GOT TALENT (DEVICE) 2446109 for Nice Classifications 09, 16, 25, 28 and 41, although the application is currently the subject of opposition proceedings. Details of these marks are enclosed at Annex 1 to the Complaint. Annex 2 to the Complaint consists of information about worldwide applications for registrations of the GOT TALENT mark (and variations on it). (It is unclear from the Annex whether these marks are proceeding to registration or whether they are registered.) There is no indication that any applications have been made for the word-only mark BRITAIN'S GOT TALENT or that any applications have been made for SCOTLAND'S GOT TALENT.

An application to register the mark PAUL O'GRADY'S GOT TALENT was made on 9 August 2005. This was refused (Annex 1 to the Complaint).

The Complainant also asserts unregistered rights in the GOT TALENT and BRITAIN'S GOT TALENT marks (presumably co-owned by Simco Limited, although this is not made clear). It states that under the law of passing off the Complainant enjoys the right to prevent unauthorised parties from use of its GOT TALENT mark or from using marks or signs which are confusingly similar to the GOT TALENT mark. Annex 3 to the Complaint is a printout from the search engine Google dated 8 May 2008. It shows that the first ten results for GOT TALENT at that date related to the Complainant's TV format (the top result is for the TV show BRITAIN'S GOT TALENT). The Complainant asserts that the results reflect the popularity of the GOT TALENT television format and the association of "GOT TALENT" with the Complainant's brand.

The Respondent

A Nominet WHOIS search shows that the britainsgottalent.co.uk domain name was registered by the Respondent on 15 September 2006. The scotlandsgottalent.co.uk domain name was registered more recently on 17 June 2007. The Respondent's status is given as "UK Individual".

The Respondent's use of the Domain Names

Britainsgottalent.co.uk

The britainsgottalent.co.uk domain name is used in connection with a website operated by the Respondent. A printout from the website is attached at Annex 5 to the Complaint. The Expert also carried out searches on 10 and 19 August 2008 which confirmed that the format of the website was largely unchanged from the printout attached to the Complaint. When carrying out her searches the Expert noted that a copyright notice was placed at the bottom of the homepage of the Respondent's site (the Respondent states that it appears at the bottom of every page). It reads as follows: **2006, 2007, 2008- www.britainsgottalent.co.uk, the original concept and independent talent portal is not associated with any TV show. All Rights Reserved**

This disclaimer was not shown on the printout provided by the Complainant and the date that it was first used by the Respondent is not clear to the Expert. For the reasons discussed below (section 6 of the decision) this discrepancy makes no difference to the Expert's decision.

The Respondent explains that his Britain's Got Talent concept was conceived in Spring 2006 before the Britain's Got Talent programme was thought of. The idea originated with the Respondent's daughter and was based on her own experiences auditioning with her band and it was also developed from ideas from her favourite websites.

The Respondent describes his concept in the following terms (extracted from the Response); "an Online Entertainment and Talent Community, where talented people can audition and be assessed, where they can be seen by record labels, talent scouts, Web/TV/Media, and A&R people..... We show videos, auditions and opportunities open to the general public from many medias, for site visitors. We publish audition dates, links to shows that offer opportunities for acts, bands, entertainers, even shows that invite audience participation for members. Any reference to this [i.e. the Complainant's show] "or any other show" are freely available rss feeds, news, cms, and are not integral to the site. We provide the facilities for members to: Promote themselves, help each other, rate acts, rate videos, blogs, we have personal profiles where individuals can promote themselves. We run competitions and currently have one to win a recording contract."

In his Response the Respondent states; "I have invested over £30,000 in this site and it has been 2 years of my life and a lot of hard work!!" The Respondent's site is apparently very successful.

Timeline

The Respondent submits that the idea for its website was formed in Spring 2006. The website was in development at least from 2 January 2007 and involved an 8 month build behind secure servers.

Annex 10 to the Complaint consists of extracts provided by the Complainant from a Waybackwhen search carried out on 7 May 2008 for the britainsgottalent.co.uk domain name. This shows that the Respondent's website was updated on January 2 2007, June 17 2007, June 21 2007 and July 4 2007. It does not appear that this domain name was parked in order to earn pay per click income during the development period. The website updates are insignificant until 4 July 2007 at which point a site resembling the Respondent's current site appeared.

The first episode of BRITAIN'S GOT TALENT was broadcast on 9 June 2007.

Scotlandsgottalent.co.uk

The scotlandsgottalent.co.uk domain name does not appear to be linked to the Respondent's website at britainsgottalent.co.uk. Annex 5 to the Complaint shows that a search by the Complainant of this domain name on 8 May 2008 reverted to a revenue earning page hosted by Sedo, a well-known internet services company. The page indicated that the domain name may be for sale. A search by the Expert on 10 August 2008 provided much the same result.

Correspondence between the Complainant and the Respondent

On the 17 April 2008 the Complainant's solicitors wrote to the Respondent seeking the surrender of the britainsgottalent.co.uk domain name.

There is a short history of negotiations between the parties for sale of the domain name against a background in which the Respondent had previously made approaches to the Complainant, Simco Limited, SonyBMG and ITV stating that he was trying to sell britainsgottalent.co.uk. He had also placed a 'For Sale' sign on his website (this now appears to have been removed). Within the negotiations the Complainant asserts that the Respondent sought money in excess of £100,000.00 from the Complainant. The Respondent also told the Complainant that the website was on auction for this figure and that the Complainant would be able to acquire the britainsgottalent.co.uk domain name through the auction. Annex 7 to the Complaint consists of the relevant correspondence between the parties.

The Respondent submits that the approach to the Complainant was due to his health-issues and impending surgery which made him realise he could not carry on with his website. He states that he made the approach to the Complainant in good faith because he wanted to give it first option. He acknowledges that britainsgottalent.co.uk was put up for auction but that the auction had fallen through. The figure of £100,000 is not apparently disputed.

These negotiations did not concern the scotlandsgottalent.co.uk domain name.

5. The Parties' Contentions

Clause 2a of the Policy provides that a Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts according to the Procedure, that:

- i the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights in a mark identical or similar to the Domain Name

Complaint

The Complainant asserts that it has rights in respect of a name or mark that is identical or similar to the Domain Names. In support it relies on its trade marks registration(s) and application(s). It also relies on the goodwill generated by the GOT TALENT and BRITAIN'S GOT TALENT marks arising from the success of its television format in the UK and abroad.

In relation to scotlandsgottalent.co.uk the Complainant asserts that consumers will not see the descriptive word "Scotland" as adding anything unique or original to the trade mark GOT TALENT and that the mark will be associated with the GOT TALENT television format.

Response

The Respondent refers to the Complaint's opposed trade mark application for Britain's Got Talent. He also says that he has been advised that he could challenge the existing registration for GOT TALENT on the basis of prior use. This last point is not elaborated. In his response to the information supplied by the Complainant pursuant to the Expert's 13a request the Respondent queries whether format rights could be co-owned by Simco Limited because Simco "have always historically made it clear that they and only they? devised and own? any programmes they have come up with (sic)" (email from Respondent to Nominet dated 15 August 2008 11:06). In this email the Respondent does acknowledge the possibility that Simco Limited has shared trademarks and world marketing rights with the Complainant (as opposed to format rights). In his response under 13a of the Procedure dated 18 August 2008 the Respondent states that he does not accept the undated (signed) memorandum attached to the Complainant's 13a response as proof of joint ownership of the GOT TALENT format.

Abusive Registration

Complaint

The Complainant considers that having regard to the reputation of the GOT TALENT and BRITAIN'S GOT TALENT marks/brands, the Domain Names have been registered and used by the Respondent to attract legitimate customers of the Complainant to the Respondent's Britain's Got Talent website and that this takes unfair advantage of, and is detrimental to, the Complainant's rights.

Registration

- At the time of Registration of britainsgottalent.co.uk, the Complainant had not aired the first episode of the BRITAIN'S GOT TALENT television show. But the registration of britainsgottalent.co.uk was made after the American television network NBC announced the AMERICA'S GOT TALENT television programme. The Respondent may also have been aware of the earlier PAUL O'GRADY'S GOT TALENT pilot show.
- The Complainant maintains that the British television show was foreseeable by the wider public, including the Respondent. The Complainant has produced many television formats which have originated in one territory and, due to their success; have been licensed in other territories for development. *Family Feud*, *The Apprentice* and *Pop Idol* are examples of formats owned by the Complainant which have regional spin-offs. This is a trend popular in the market to develop regional spin-offs for a domestic audience as well as to license domestic formats in other regions such as *American Idol* or *America's Got Talent* in the United Kingdom.
- The Respondent registered the britainsgottalent.co.uk domain name in full knowledge of the Complainant's rights in the term BRITAIN'S GOT TALENT and GOT TALENT knowing that the vast majority of consumers in the United Kingdom associate the terms BRITAIN'S GOT TALENT and GOT TALENT with the Complainant and its television format. The Respondent has sought to anticipate the inevitable development of the programme in the United Kingdom by registering britainsgottalent.co.uk.
- Subsequently, the Respondent registered scotlandsgottalent.co.uk after the airing of BRITAIN'S GOT TALENT in order to anticipate any development of the GOT TALENT brand in Scotland.

Use

- The Respondent did not and does not intend to use the Domain Name for any other purpose than to mislead consumers by associating its Domain Names with the Complainant's television format and its GOT TALENT brand
- Consumers in the United Kingdom who see the Domain Names listed by a search engine, especially among other legitimate hits, would assume that the Domain Names link to a website belonging to or endorsed by the Complainant.
- Consumers within the United Kingdom seeking information about the Complainant's television show are likely to go directly to one of the Domain Names reasonably expecting to find an official, authorised and/or endorsed website by the Complainant. This explains any popularity the Respondent's website enjoys and as a result the Respondent benefits from the goodwill garnered by the Complainant.
- The Respondent is infringing the Complainant's copyright by displaying on its website imagery and varying numbers of clips taken from the Complainant's television shows, including both America's Got Talent and *Britain's Got Talent*, in combination with the Complainant's mark. This takes unfair advantage of, and is detrimental to, the Complainant's rights. At one point (the Complainant asserts) there were approximately ten clips from the second series of *Britain's Got Talent* available for streaming on britainsgottalent.co.uk. Enclosed at Annex 6 to the Complaint is a copy of the imagery and videos shown on the Respondent's website in which the Claimant claims copyright.
- Despite the Respondent's perception that he is negotiating in good faith, the Complainant submits that the Respondent is seeking to extort an exorbitant sum from the Complainant for britainsgottalent.co.uk. Nominet's Guidance Notes indicate that a Respondent seeking to sell a domain name for a fee greater than the amount for which it was bought is evidence of an Abusive Registration.
- The Complainant notes that at no time has the Respondent mentioned in negotiations between them that he is also in possession of

scotlandsgottalent.co.uk. The Complainant submits that this is evidence of bad character and suggests that the Respondent would have used this domain name for further pecuniary reward either as a pay per click website or to sell at a later date.

- The domain name britainsgottalent.co.uk remained largely undeveloped until 4 July 2007. BRITAIN'S GOT TALENT was first aired shortly before this date on 9 June 2007. The Complainant submits that this is further evidence that the Respondent was cybersquatting until GOT TALENT was developed in the United Kingdom by the Complainant in order for the Respondent to develop the website behind britainsgottalent.co.uk further.

Response

- The concept for the Respondent's site was derived independently of the Complainant. The concept arose in Spring 2006.
- The approach to sell the britainsgottalent.co.uk domain name to the Complainant was not an attempt at extortion. The approach was made due to the Respondent's health issues. The Complainant gave the impression that it wished to negotiate on a commercial basis. The Complainant has made "a great financial investment" in the site (over £30,000) which is a "huge investment" in time and money. The Respondent was not "driven by money" in seeking a deal.
- The allegation that the Respondent is seeking to gain by association with the Complainant is rejected. Set out below are extracts from the Response (there is some duplication from the extracts set out in section 4 of this decision). "Our site does not lead anyone to think that we're associated with [the Complainant], we neither want nor have any need for this....This is also displayed in our t&cs [terms and conditions]. .. We show videos, auditions and opportunities open to the general public from many medias, for site visitors. We publish audition dates, links to shows that offer opportunities for acts, bands, entertainers, even shows that invite audience participation for members. Any reference to this, "or any other show" are freely available rss feeds, news, cms, and are not integral to the site. We provide the facilities for members to: Promote themselves, help each other, rate acts, rate videos, blogs, we have personal profiles where individuals can promote themselves. We run competitions and currently have one to win a recording contract. See our Entertainments News it provides showbiznews, current gigs, films etc. None of this has anything to do with this show! We do this 365 days per year, this is talent spotting for the online generation and something no TV show does (unless they had our site) and by default had our idea!! They have never done anything like this!!!.....
It is patently plain that www.talent.itv.com is the site that represents this TV show and that mine is an (independent) site. Our popularity has NOTHING to do with their business and everything to do with our unique software and hard work put into www.britainsgottalent.co.uk. We review many shows from I'd Do Anything through MTV.... this shows that there are many shows and auditions available to view (clear indication) that this is "NOT" the TV show. Their site WOULD OBVIOUSLY NOT SHOW all of these competitors!"
- The allegation that the Respondent registered the britainsgottalent.co.uk domain name in anticipation of the development of the Complainant's TV show is denied; "When I registered the name on the 15th of September 2006 there was NO show, NO-ONE knew of any show, I picked a name for my website. Are they suggesting that among the other things that I had a crystal ball as well? This is not an Abusive Registration, I registered the name long before they had even thought of this show to develop a British online talent finder." A similar point is made by the Respondent in his 18 August 2008 13a Response.

6. Discussion and Findings

General

Clause 2a of the Policy provides that a Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts according to the Procedure, that:

- i the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The *Complainant* is required to prove to the Expert that both elements are present on the balance of probabilities (clause 2b of the Policy).

The Respondent is accordingly correct when it points out that the Complainant must make out its case. As a starting point it is not for the Respondent to justify its choice of or its use of the Domain Names until the Complainant shows that the Policy is engaged.

This Decision will firstly consider whether the Complainant had demonstrated Rights in the Domain Names.

It will then consider the *britainsgottalent.co.uk* domain name and will address the Complainant's case (i) that the initial registration of that domain name was abusive and (ii) that the Respondent's use of the domain name is abusive. The decision will then consider the *Scotlandsgottalent* domain name.

Complainant's Rights

Rights are defined in clause 1 of the Policy as including but not limited to "rights enforceable under English law.

The Complainant's Rights

GOT TALENT

The Complainant (jointly with Simco Limited) owns a UK trade mark registration in the GOT TALENT mark. This is sufficient to confer rights in the GOT TALENT mark on the Complainant for the purposes of the Policy.

The Expert also finds that in addition to the trade mark registration the Complainant (seemingly jointly with Simco Limited) owns unregistered rights (or goodwill) in the GOT TALENT mark. This finding is supported by the evidence of the success of the international exploitation of the GOT TALENT format and GOT TALENT mark in connection with TV talent shows. The unregistered rights are also sufficient to confer Rights under the Policy.

The next question is whether the GOT TALENT mark is similar to the Domain Names (namely, *britainsgottalent.co.uk* and *scotlandsgottalent.co.uk*) (clause 1 of the Policy requires the Complainant to have Rights in a mark that is identical or similar to the Domain Names). The Expert finds that the GOT TALENT mark is similar to the Domain Names. The prefix of the country name (i.e. Britain and Scotland) in the respective Domain Names localises the GOT TALENT "stem" but it not does not significantly change that stem. The stem remains the dominant feature. It is also customary to ignore the addition of the suffix *.co.uk* to a domain name.

It follows that the Complainant (jointly with Simco Limited) owns Rights under the Policy and that the DRS Policy is accordingly engaged.

Unregistered rights in BRITAIN'S GOT TALENT

The Expert must consider the position if she is incorrect in finding that the GOT TALENT mark is similar to the Domain Names. In this regard the Complainant's case does not rely solely on its GOT TALENT mark. The Complainant also asserts (apparently with Simco Limited) that it owns goodwill in the BRITAIN'S GOT TALENT unregistered mark. It cites the success of the UK programme and the results of a Google search in support of its case that the BRITAIN'S GOT TALENT mark is associated with the Complainant and /or the TV programme in which it jointly owns rights.

The Expert agrees with the Complainant on this point. The popularity of the Complainant's TV programme means that a substantial number of the general public with an interest in light entertainment and/or new entertainment talent will associate the BRITAIN'S GOT TALENT mark with the TV programme in which the Complainant jointly owns rights. This means that the Complainant owns (with Simco Limited) unregistered Rights in the BRITAIN'S GOT TALENT mark. This is identical to the britainsgottalent.co.uk domain name and so gives rise to Rights under the Policy.

Finally on this point the Expert also finds that the domain name SCOTLANDSGOTTALENT.CO.UK is similar to the BRITAIN'S GOT TALENT mark in which the Complainant (jointly) owns Rights. There is a conceptual similarity between "Britain" and "Scotland". When "Scotland" is used in conjunction with the "GOT TALENT" stem it creates a name that would be associated by the public with the famous BRITAIN'S GOT TALENT mark.

The Expert has not placed any relevance on the opposed application for the BRITAIN'S GOT TALENT device mark in reaching this decision.

There is also insufficient information before her about the Respondent's assertion that he has been advised that he could challenge the existing registration for GOT TALENT on the basis of prior use. The Expert has not taken this point into account in her decision. In any event the DRS procedure is not an appropriate mechanism for the determination of disputes about trade mark validity.

It is to be noted that the Expert is proceeding on the basis that the Complainant is correct in stating that the Rights derived from GOT TALENT are owned jointly by it and by Simco Limited. The Respondent has expressed some surprise at joint ownership of format rights but a simple expression of surprise is not in itself sufficient to call the Complainant's submissions into doubt. In any event the Respondent has conceded the possibility that branding rights might be shared by the Complainant and Simco Limited (13a response dated 15 August 2008) and Annex 1 to the Complainant is clear evidence that the UK trade mark registration is owned jointly.

It follows that the Complaint has met the first requirement of the Policy, namely it has shown that it has Rights in a name which is identical or similar to the Domain Names.

Abusive Registration

Abusive Registration is defined in clause 1 of the Policy as follows:

A Domain Name which either:

i was registered or otherwise acquired in a manner, which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights,

OR

ii has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Complainant's case is based on both the Respondent's registration and use of the Domain Names.

The BRITAINSGOTTALENT.CO.UK domain name

Registration

Paragraph 3 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 3.a.i provides:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name...
 - C. for the purpose of unfairly disrupting the business of the Complainant.

The Respondent registered britainsgottalent.co.uk on **15 September 2006**. At that time the Complainant had not aired the first episode of the BRITAIN'S GOT TALENT television show.

In relation to the allegation that registration was abusive the Complainant relies on;

- (i) the aborted pilot show for PAUL O' GRADY'S GOT TALENT (in 2005) and
- (ii) the announcement of AMERICA'S GOT TALENT in March 2006 and the subsequent broadcast of the US programme June-August 2006
- (iii) the fact that the development of regional variations of a successful format is a commonplace practice in the entertainment industry

to support of the assertion that a BRITAIN'S GOT TALENT series was foreseeable by the wider public including the Respondent at the time of the Respondent's registration of britainsgottalent.co.uk. The Complainant goes on to submit that the Respondent then waited until the Complainant had launched its series before making active use of the domain name.

The Respondent puts forward an alternative account for the registration of the britainsgottalent.co.uk domain name. He explains that it was his daughter's idea and was based on other websites and her own experience of auditioning with her band.

Having considered the submissions the Expert finds that the Complainant has **not** proved on the balance of probabilities that the registration of britainsgottalent.co.uk was at the time of its registration an Abusive Registration under the Policy.

A Complainant must show that the initial registration was in bad faith at the time it was made in September 2006. The Expert finds it plausible that the Respondent might have been aware of the existence of (and success) of the US America's Got Talent series when he registered the Britainsgottalent.co.uk domain name. But it would be a significant step further for her to use this finding to infer that the Respondent would have sufficient sophistication about the ways of the entertainment industry to guess that a regional variation of the US series would be produced in the UK. It would mean rejecting the Respondent's explanation for registering this domain name and there is no evidence before the Expert to suggest that this explanation is untrue.

In relation to the negotiations with the Complainant for the sale of the britainsgottalent.co.uk domain name it seems that both parties accept that at one point the Respondent required a six figure sum for the domain name. This would clearly be in excess of the Respondent's out of pocket registration costs and also, on the Respondent's own submissions his costs of developing his website (given as in excess of £30,000). However the wording of the Policy requires the Complainant to demonstrate that the registration of a domain name was made primarily for selling etc for profit. The Expert finds that the Complainant has not made out its case on this point. The Respondent states that he made his offer for sale in the context of what he thought were commercial negotiations and some time after the initial registration of the britainsgottalent.co.uk domain name. He also explains that his motive for offering to sell was his deteriorating health. The fact that at one point the britainsgottalent.co.uk domain name was part of an (unsuccessful) auction does not appear to be of relevance in showing that the registration of the domain name was motivated by bad faith.

The Expert does not draw any inference from the Respondent's failure to mention the scotlandsgottalent.co.uk registration during the negotiations. There could have been many reasons for this and to decide what lay behind the Respondent's silence would be mere speculation.

Accordingly the Complainant's case that the initial registration of britainsgottalent.co.uk was an Abusive Registration under the Policy fails.

Use

The overriding concept behind abusive use is as stated in clause 1 of the Policy:

[The Domain Name] has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors which may be evidence that the use of the Domain Name is an Abusive Registration is given in clause 3a of the Policy. They include the following factor:

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

The Respondent has alleged that this Complaint is a case of reverse domain name hijacking in that the Complainant is seeking to deprive the Respondent of his valuable domain name without paying a fair market value. Under the terms of the Policy the Respondent can only be deprived of a domain name if it is an Abusive Registration. It is important to note that an initial registration of a domain name which was not abusive at the time of registration can subsequently be rendered abusive if a change of use of the domain name infringes a third party's rights. This point was confirmed by the recent DRS appeal decision 04962 **MySpace, Inc v Total Web Solutions Limited**. It follows that a domain name which has been used in

an unobjectionable way can become an Abusive Registration where the use changes to something that is calculated to exploit the fame or goodwill of the Complainant's mark.

Clause 4 of the Policy provides a non-exhaustive list of ways in which the Respondent may demonstrate that the Domain Name is *not* an Abusive Registration. The Respondent mainly presents its case by disputing the Complainant's submissions. Nevertheless implicit within the Response is reliance on some of the matters that are set out in clause 4 of the Policy, as follows:

- I. Before being aware of the Complainant's cause for complaint (not necessarily the "complaint" under the DRS), the Respondent has
 - A. used or made demonstrable preparations to use the Domain Name..... in connection with the genuine offering of goods or services
.....
 - C. made legitimate non-commercial use or fair use of the Domain Name

It follows that if the Respondent was using the britainsgottalent.co.uk domain name at the date that the cause of action arose or had made demonstrable preparations to do so then continued use of the domain name for those purposes would not be abusive under the Policy.

The Respondent's website began operating on 4 July 2007 when a site resembling the current site first appeared. Until that date there was no real activity and the website was effectively dormant so far as a visitor to the site was concerned. The domain name does not even appear to have been generating "pay per click" income for the Respondent. The first episode of BRITAINS GOT TALENT was broadcast on 9 June 2007. For the purposes of this section of the decision the Expert will use the date of the broadcast of the first edition of BRITAIN'S GOT TALENT (9 June 2007) as the date when the Complainant's cause for complaint arose (i.e. the date when goodwill generated by the BRITAIN'S GOT TALENT TV series began to be generated through association of the brand with the TV programme).

There was no active use by the Respondent of the britainsgottalent.co.uk domain name until after the successful first series of the BRITAINS GOT TALENT. This is evidenced on the balance of probabilities by the information supplied by the Complainant (i.e. the waybackwhen search). The Respondent has not demonstrated what preparations he was making behind the scenes to launch his website before the first series was aired beyond a bare assertion that preparations were being made.

It follows that the Expert finds that there was no use of the britainsgottalent.co.uk domain name before the cause for complaint arose (the date of first broadcast) nor is there any sustained suggestion that preparations to use the domain name in connection with a genuine offering of goods and services had been made by that date. Clause 4 of the Policy does not therefore apply.

This does not mean that the use of a domain name is automatically abusive. The Complainant must still make out its case.

The next question is therefore whether the Complainant has demonstrated on the balance of probabilities that the Respondent's use of the britainsgottalent.co.uk domain name is an Abusive Registration.

Has the britainsgottalent.co.uk domain name been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights?

One way in which abusive use can arise is where there are circumstances indicating that the Respondent is using the domain name in a way which has confused people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. There is no direct evidence of any confusion before the Expert. But the Policy does not require this. The issue is whether circumstances indicate that such confusion is occurring. Clearly both the TV programme and the Respondent's website share a common theme- the recruitment of, and publicity for, new talent. The Respondent's website includes footage from the Complainant's TV programme (together with footage from other similar talent show programmes).

The Expert notes (and understands) the Respondent's submissions that there are some differences between the TV programme and the website content. She also notes the inclusion of a disclaimer within the copyright notice on the Respondent's website which seeks to clarify that the site is not connected to any TV programme.

Having studied the Respondent's website (a search carried out on 10 August 2008, a further search on 19 August 2008 and the printout supplied by the Complainant at Annex 5 to the Complaint) the Expert finds that there is a clear potential for confusion between the BRITAIN'S GOT TALENT programme and the Respondent's website. The printout at Annex 5 features the strapline "The Home of Talented Brits" and in smaller type, "The Only Place to Showcase your talent 365 days of the year!" Visitors are invited to view "Latest Britains got talent.co.uk videos". Another strapline states "Britain's Got Talent Featured Artists". There is a clear similarity of concept between the TV programme and the website and the "Britains Got Talent" phrase pervades the website. The disclaimer used by the Respondent is small and is not clearly visible unless a user scrolls down the whole page and scrutinises its content carefully (it also does not seem to have been used at the time that the Respondent printed out Annex 5 to the Complaint on 8 May 2008). The average user of the website is unlikely to pay such close attention to a small disclaimer and the size and lack of prominence of the disclaimer is far outweighed by the dominance of the phrase BRITAIN'S GOT TALENT. The inclusion of footage from BRITAIN'S GOT TALENT and other talent programmes on a similar theme reinforces the impression of a link between the website and the BRITAIN'S GOT TALENT programme. There is accordingly a strong likelihood of confusion between the BRITAIN'S GOT TALENT TV programme and the Respondent's website.

The Respondent must have been aware of the very successful first series of BRITAIN'S GOT TALENT at the time that the website was launched just a few weeks after the conclusion of that first series. He must also have been aware that the domain name and website content meant that his website would be perceived as having a connection with the TV programme. Particularly significant is the decision to stream footage from the BRITAIN'S GOT TALENT programme which, when used in connection with the britainsgottalent domain name, could not avoid the impression of a connection with the TV programme.

Although the Respondent owned the britainsgottalent.co.uk domain name before the UK programme was broadcast this prior ownership did not give him carte blanche to start a new use of the domain name in connection with a website in circumstances where the new use took unfair advantage and exploited the Complainant's rights in the TV show brand. In more technical terms the launch of the Respondent's website amounts to a new use of a domain name which was calculated to take advantage of the Complainant's success. It is an unfair advantage because the owners of the brand rights derive no benefit from this exploitation of their brand.

This finding is reinforced by the advertising revenue that the Respondent is deriving from its website. A printout of the website annexed to the Complaint (Annex 5) features the invitation "Advertise with Us" (this is partly obscured in the printout provided to the Expert). On 19 August 2008 the Expert visited the Respondent's website for a second time and on this occasion she clicked on this link and was invited to "place your banner on this site [Britainsgottalent.co.uk] for one year with unlimited exposure and click through's for less than £2.75 per day! We are currently taking orders for the 50 banners that will be added to the system so move quickly to secure your spot!!" This page also states "50 banners only so be

quick” and “43 sold, so only 7 left so be even quicker”. This is clearly an operation that is designed to exploit and take advantage of the strong brand recognition that is generated by the BRITAIN’S GOT TALENT TV show. It demonstrates quite clearly that the use by the Respondent of its website is at least in part calculated to take unfair advantage of the Complainant’s Rights.

For these reasons the Expert finds that the use of the britainsgottalent.co.uk domain name by the Respondent amounts to an Abusive Registration.

For completeness it should be noted that the Expert has not taken into account the Complainant’s allegations that the Respondent is infringing copyright by showing extracts from the BRITAIN’S GOT TALENT programme. This is because the DRS procedure is not an appropriate mechanism to resolve issues of intellectual property rights infringement.

Scotlandsgottalent.co.uk

This domain name was registered more recently on 17 June 2007- the date that the final of the successful first series of BRITAIN’S GOT TALENT was broadcast and therefore after the Complainant’s Rights in that mark had come into existence.

The scotlandsgottalent.co.uk domain name is not linked to the Respondent’s website. Annex 5 to the Complaint shows that a search by the Complainant of this domain name on 8 May 2008 reverted to a page provided by Sedo’s Domain Parking service.

The timing indicates that the Respondent must have intended to take advantage of the success of the Complainant’s TV series when registering this domain name. The current use of the domain name on a parking page will be generating income for the Respondent which will be at least in part generated by the association in the mind of the public with the BRITAIN’S GOT TALENT programme.

For these reasons the Expert also finds that the use of the scotlandsgottalent domain name is taking unfair advantage of the Complainant’s Rights and is an Abusive Registration under the Policy.

7. Decision

The Expert finds that the Complainant has proved on the balance of probabilities that it owns Rights in respect of a name or mark which is identical or similar to the Domain Names and that the Domain Names in the hands of the Respondent are Abusive Registrations.

Accordingly the Expert finds in favour of the Complainant and directs that the Domain Names are transferred. The Expert notes that the Complainant states that its Rights in the GOT TALENT mark are owned jointly with Simco Limited. The Expert is accordingly ordering a transfer of the domain names to the owners of the Rights in this matter. It would be advisable for the Complainant to liaise with Nominet over the correct identity of the registrant.

Sallie Spilsbury
20 August 2008