

Nominet UK Dispute Resolution Service

DRS 01102

Hit Entertainment PLC v SOCOM Limited

Decision of Independent Expert

1. *Parties:*

**Complainant:** *Hit Entertainment Plc*  
**Address:** *149 Tottenham Court Road*  
*Bucks Free Press*  
*London*  
**Postcode:** *W1T 7NF*  
**Country:** *UK*

**Respondent:** *SOCOM Limited*  
**Address:** *20 New Oxford Street*  
*London*  
**Postcode:** *WC1A 1EH*  
**Country:** *UK*

2. *Domain Names:*

*bobthebuilder.co.uk ("the Domain Name")*

3. *Procedural Background:*

*The Complaint was lodged with Nominet on July 9, 2003. Nominet validated the Complaint and notified the Respondent of the Complaint on July 14, 2003 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent provided a Response on July 27, 2003 which was communicated to the Complainant July 29, 2003. Complainant's Reply was received on August 6, 2003. Mediation not succeeding, on September 9, 2003 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").*

*Dawn Osborne, the undersigned, ("the Expert") 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/or impartiality.

4. *The Facts:*

The Complainant is the owner of the UK registered trade mark no 2177979C for a series of Bob The Builder marks and also the owner of the goodwill related to the Bob The Builder children's television programme and associated merchandise. The Bob the Builder television programme was first broadcast in the UK on 12 April 1999.

The Respondent is a dormant company which registered the Domain Name on 12 April 1999 the same day as the Bob the Builder television programme was first aired in the UK. It has not used the Domain Name and has offered it for sale.

5. *The Parties' Contentions:*

Complainant:

The substance of the Complaint is as follows:

1. The Bob The Builder UK trade mark 2177979C has been registered since 1998 in classes 9, 16, 21, 25 and 41 in the name of the Complainant.
2. Bob The Builder is a well known household name. Any person typing in bobthebuilder.co.uk would expect to receive information regarding the Bob the Builder TV programme, merchandising, fan club or other children's activities related thereto. The fact that the Domain Name does not point to any such information will cause confusion on the Internet.
3. The Domain Name was registered by the Respondent in 1999, but has never pointed to a web site. It is a blocking registration preventing the Complainant from registering the Domain Name.

Respondent:

The substance of the Response is as follows:

1. Bob The Builder was not a household name in early 1999 when the Domain Name was registered.
2. The Respondent owned the company Bob The Builder Limited prior to the registration of the Domain Name. It was set up by the Complainant as part of a planned expansion strategy into the Construction industry.
3. No web site has been launched as the company is still dormant. The Complainant is planning for the long term.

4. *The name Bob The Builder was identified by the Complainant in 1998 as a potential trading name for a construction or construction related company of which a 50% shareholder is in fact a chartered builder.*
5. *Through lack of foresight the Complainant is seeking to use the Nominet Policy in bad faith to reverse domain hijack the Domain Name.*

Complainant:

*The substance of the Reply is as follows:*

1. *The character Bob The Builder was established in 1997.*
2. *The TV programme Bob The Builder was first broadcast to British viewers on 12 April 1999, the same day that the Domain Name was registered and four days before the company Bob The Builder Limited was formed. This timing shows that the Respondent was setting out to block the Complainant from registering the Domain Name.*
3. *The Bob The Builder TV programme has become a phenomenal international success. It premiered on Britain's BBC in 1999 and is currently airing on Nick Jr in the US. The programme has become one of the top rated pre-school programmes in Germany, Australia and Japan and is broadcast in more than 130 countries worldwide. In the UK alone 3 million books have been sold as well as more than 2 million videos in 2 years and over 400 licensed products are available. The Bob the Builder name was associated throughout the UK with the Complainant's television character before the registration of the Domain Name and the Bob the Builder Limited company.*
4. *The Respondent has been actively touting the Domain Name to other prospective buyers. The Complainant attached in evidence an e mail from the Respondent to the Complainant's agent which read "We are interested in selling the above name. We also have the Limited Company and we are currently in discussions with an interested party at the moment. Please would you let us know your offer." The Respondent registered the Domain Name for personal gain and to profit from their actions.*

6. *Discussion and Findings:*

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name,

in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

### **Complainant's Rights**

In this case the first limb of that task is straightforward. The Complainant is the proprietor of a UK registered trade mark for BOB THE BUILDER and is also the owner of substantial goodwill in the BOB THE BUILDER name. The Domain Name consists of the name or mark BOBTHEBUILDER and the suffix <.co.uk>. In assessing whether or not a name or mark is identical or similar to a domain name, it is appropriate to discount the domain suffix, which is of no relevant significance and wholly generic.

The Expert finds that the Complainant has rights in respect of a name or mark, which is identical or substantially identical to the Domain Name.

### **Abusive Registration**

This leaves the second limb. Are the Domain Names, in the hands of the Respondent, Abusive Registrations? Paragraph 1 of the Policy defines "Abusive Registration" as:-

- "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."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. There being no suggestion that the Respondent has used the Domain Name or has engaged in a pattern of making Abusive Registrations and there being no suggestion that the Respondent has given to Nominet false contact details, the only potentially relevant 'factors' in paragraph 3 are to be found in subparagraph i which reads as follows:

- i "Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:
  - A. primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a

- competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
- B. as a blocking registration against a name or mark in which the Complainant has Rights; or
- C. primarily for the purpose of unfairly disrupting the business of the Complainant;"

The Expert is of the opinion that the Respondent's conduct and use of the Domain Names is indicative of relevant abusive conduct. The Domain Name is identical or substantially identical to the name of the Complainant's well known television programme. The timing of the registration of the Domain Name, the same day that the Complainant's television programme was aired in the UK indicates that the Respondent did indeed have the Complainant in mind when he registered the Domain Name and indicates that the names were registered to sell for profit to the Complainant, as blocking registrations or to be used to ride on the Complainant's goodwill, thereby disrupting the Complainant's business and taking undue advantage. An e mail has been produced where the Respondent admitted that its intention was to sell the Domain Name to the Complainant's agent or another third party. This confirms the Expert's conclusion that the Domain Name is an Abusive Registration.

Further no substantiated valid reasons have been put forward by the Respondent for registration of the Domain Name. It has produced no evidence that it is in the construction industry. There has been no trade through the dormant company Bob the Builder Limited also set up by the Respondent. Further, the Respondent has produced no explanation as to the choice of the Christian name "Bob". None of the directors of the Respondent company are called Bob or Robert. Finally, the Respondent's assertion that the Bob the Builder Limited company name was registered before the Domain Name is untrue. A quick check at Companies House shows that the Bob The Builder Limited company name was registered 4 days after the Domain Name.

Accordingly, in the view of the Expert in its registration and subsequent attempts to sell the Domain Name the Respondent took unfair advantage of the Complainant's rights.

Accordingly, the Expert finds that the Domain Names is an Abusive Registration within the definition of that term in paragraph 1 of the Policy.

7. *Decision:*

*In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, bobthebuilder.co.uk be transferred to the Complainant.*

\_\_\_\_\_  
September 17, 2003

\_\_\_\_\_  
**Dawn Osborne**

**Date**