

**DISPUTE RESOLUTION SERVICE**

**D00015788**

**Decision of Independent Expert**

Lucasfilm Ltd., LLC

and

ABSCISSA.COM Limited

**1. The Parties:**

Complainant: Lucasfilm Ltd., LLC  
Address: c/o Nabarro LLP  
125 London Wall  
London  
EC2Y 5AL  
Country: United Kingdom

Respondent: ABSCISSA.COM Limited  
Address: Union House  
Kennetside  
Newbury  
Berkshire  
RG14 5PX  
Country: United Kingdom

**2. The Domain Names:**

star-wars.co.uk  
star-wars.uk  
star-warsco.co.uk  
star-warsco.uk  
starwars.co.uk  
starwars.uk  
starwarsco.co.uk (“Domain Name(s)”)

### 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.

14 April 2015	Dispute received
14 April 2015	Complaint validated and notification of complaint sent to parties
29 April 2015	Response received and notification of response sent to parties
5 May 2015	Reply reminder sent
6 May 2015	Reply received and notification of reply sent to parties
6 May 2015	Mediator appointed
11 May 2015	Mediation started
1 June 2015	Mediation failed
1 June 2015	Close of mediation documents sent
8 June 2015	Expert decision payment received

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

### 4. Factual Background

The Complainant is a film and television production company founded by the filmmaker George Lucas in 1971. The Walt Disney Company acquired Lucasfilm in 2012 at a valuation of \$4.06 billion.

The Complainant has produced six movies in the Star Wars saga:

Star Wars: Episode I -	The Phantom Menace (1999)
Star Wars: Episode II -	Attack of the Clones (2002)
Star Wars: Episode III -	Revenge of the Sith (2005)
Star Wars: Episode IV -	A New Hope (1977)
Star Wars: Episode V -	The Empire Strikes Back (1980)
Star Wars: Episode VI -	Return of the Jedi (1983)

The Complainant’s latest movie is known as “Star Wars: Episode VII - The Force Awakens” and is due for release in 2015.

The Respondent sells fancy dress costumes, including Star Wars branded costumes, via its Jokers’ Masquerade website at [joke.co.uk](http://joke.co.uk). The Domain Names are used by the Respondent as portal websites that redirect to its [joke.co.uk](http://joke.co.uk) domain.

The Respondent registered the Domain Names as follows:

star-wars.co.uk	19-Mar-2003
star-wars.uk	25-Jul-2014
star-warsco.co.uk	25-Jul-2014
star-warsco.uk	25-Jul-2014
starwars.co.uk	22-Jan-2003
starwars.uk	25-Jul-2014
starwarsco.co.uk	25-Jul-2014

## 5. Parties' Contentions

### The Complaint

#### *Complainant's Rights*

The Complainant has registered rights in the name STAR WARS and exhibits a number of registered trade marks covering a range of goods and services including:

1. UK trade mark number 1210363 - STAR WARS, registered as of 6 January 1984;
2. UK trade mark number 1233737 - STAR WARS, registered as of 26 September 1988;
3. UK trade mark number 1210447 - STAR WARS, registered as of 28 August 1992;
4. UK trade mark number 2135569D - STAR WARS, registered as of 25 September 1998;
5. Community trade mark number 560029 - STAR WARS, registered as of 2 August 1999;
6. UK trade mark number 2135569B - STAR WARS, registered as of 10 August 2001.

The Complainant asserts that it is well known for its films including the Star Wars saga and the Indiana Jones trilogy, as well as Willow and Labyrinth. The Complainant operates the official Star Wars website at [www.starwars.com](http://www.starwars.com) as a fan page for the Star Wars saga.

The Complainant says that as a result of the use of the Star Wars brand in the UK and worldwide for many years, a very substantial goodwill and reputation has been established in the Star Wars name and trade marks. Furthermore, the Star Wars trade marks symbolise, exclusively, the goods and services of the Complainant and those operating with its authority.

The Complaint asserts that the Star Wars franchise has been phenomenally successful and provides third party evidence that Star Wars: Episode IV was the second most successful film of all-time in the USA (when adjusted for inflation). Furthermore, Episode V is the twelfth most successful film, Episode VI is the fifteenth most successful film, Episode I is the seventeenth most successful film, Episode III is the sixtieth most successful film and Episode II is the eighty-seventh most successful film. The trailer for the forthcoming Star Wars Episode VII movie surpassed 40 million views on YouTube after less than 72 hours online.

Leaving aside the generic suffixes "co.uk" and ".uk", the Domain Names comprise the term Star Wars joined together or with a hyphen separating the two words or with the addition of the letters "co". The letters "co" could be a shortening of the word "company" or reference to the "co" element of the suffix ".co.uk". In either case, the Complainant says, the letters make little or no difference to the overall impression or impact of the Domain Names.

#### *Abusive Registration*

The Complainant says that Domain Names were registered by the Respondent without the authority of the Complainant. The Complainant asserts that in light of the reputation of the Star Wars name and trade marks, and the content of the Respondent's website, the Respondent must have been aware of the Complainant's existence and rights at the time of registration of the Domain Names. Furthermore, the Domain Names incorporate the Complainant's trade mark, which cannot sensibly refer to anyone else and there is therefore a severe risk that a search engine, which is being asked for the Complainant's Star Wars trade mark, will produce high up the list the URL for the websites connected to the Domain Names. The Complainant quotes the DRS Experts' Overview in this respect:

*"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".*

The Complainant further asserts that since the Respondent has made slight variations to the Complainant's Star Wars trade mark, there is a risk that an Internet user guessing the URL for a website owned by the Complainant will land at the Respondent's joke.co.uk website. Thus, speculative visitors to the Respondent's website will arrive in the hope and expectation that the website is operated or authorised by, or otherwise connected to, the Complainant. The Complainant says that this initial interest confusion is compounded by the content of the Respondent's website.

The Complainant notes that the Domain Names all resolve to the Respondent's website which allows users to purchase costumes of characters from the Star Wars saga. These goods include goods of the same type as those provided by the Complainant through the website of its parent company, The Walt Disney Company, at [www.disneystore.co.uk/star-wars/mn/1339001](http://www.disneystore.co.uk/star-wars/mn/1339001). The Complainant asserts that the registration of a competitor's registered trade mark is overwhelmingly indicative of a blocking registration.

The Complainant concludes that the Domain Names are being used to attract users to the Respondent's website in order to sell to those users the Respondent's goods and that the Respondent has chosen to register the Domain Names in order to benefit from the "pulling power" of the Complainant's Star Wars trade mark. Thus, the Respondent is clearly taking advantage of the reputation of the Complainant's Star Wars trade mark for financial gain and there is serious potential for disruption to the Complainant's business.

The Complainant says that it made a test purchase from the Respondent's website of an unlicensed Star Wars product.

The disruption to the Complainant's business is increased by the fact that the Respondent's website at [www.joke.co.uk](http://www.joke.co.uk) offers a wide range of goods offered by the Respondent which have no connection to the Complainant or its Star Wars trade mark.

The Complainant notes that those Domain Names registered on 25 July 2014 (**2014 Domain Names**) were registered very shortly after the Complainant wrote to the Respondent (on 12 June 2014) to put the Respondent on notice of the Complainant's rights and to demand the transfer of the Domain Names which were registered by the Respondent in 2003 (**2003 Domain Names**). The registration of the 2014 Domain Names, says the Complainant, in the face of the Complainant's prior objection, represents a clear intention on the part of the Respondent to acquire those Domain Names as blocking registrations against a name or mark in which the Complainant has rights and to unfairly disrupt the Complainant's business.

Finally, the Complainant says that a search of the Nominet database reveals that the Respondent is also the registrant of the following domain names which incorporate the trade marks of third party brand owners:

<austinpowers.me.uk>  
<littlebritaincostume.co.uk>  
<power-ranger.co.uk>  
<harrypottercostume.co.uk>  
<batmanfancydress.co.uk>

This list of domain names shows that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well-known names in which the Respondent has no apparent rights.

## **The Response**

The Respondent contends that the registration and/or use of the Domain Names are not Abusive Registrations on the basis that, after 10 years of the Respondent being registrant of the starwars.co.uk Domain Name, the Complainant may now succeed in the transfer of the Domain Names so that the Complainant can obtain the shorter starwars.uk Domain Name.

To support this assertion, the Respondent says that the starwars.co.uk Domain Name was initially registered to a third party on 22nd January 2003 and that the Nominet database will show that this Domain Name was transferred to the Respondent on 23rd March 2005. The Respondent paid the original registrant an amount of money in consideration of the transfer. Furthermore, starwars.co.uk was initially registered on 1st May 1997 to a now dissolved company and it appears to have been transferred from that company to the Complainant on 14 June 2001. It further appears that star-wars.co.uk was in a Detagged status as from 22 October 2001 and in the public domain until the Respondent registered it on 19th March 2003. So, the Respondent asks, (1) why did the Complainant not register the starwars.co.uk and star-wars.co.uk Domains in these earlier years, (2) why did the Complainant let its star-wars.co.uk registration lapse into Detagged status, and (3) when the star-wars.co.uk was transferred to the Complainant why did it not register the starwars.co.uk Domain at that time?

The Respondent's conclusion is that the Complainant must have been aware of the starwars.co.uk and star-wars.co.uk Domain Names but, given its actions, they were not important to the Complainant.

In respect of the Complainant's letter and email of 12 June 2014, the Respondent emphasises that this letter only referred to the starwars.co.uk Domain Name. Thus, the Respondent suggests, the Complainant was only making this demand, some 10 years after the Respondent became registrant of the starwars.co.uk Domain Name, because Nominet had introduced the shorter .uk domain just two days prior to the date of the Complainant's letter. So, the Respondent assumes, the Complainant wanted to register the shorter starwars.uk Domain Name but found that the right of registration would remain with the registrant of the starwars.co.uk Domain Name until 2019. The Respondent believes that if Nominet had not released the .uk domain, then the Complainant would not have instigated this Complaint.

The Respondent says that in its response to the Complainant's letter it questioned why it had not received a similar letter in respect to the star-wars.co.uk Domain Name and whether similar letters had been sent to the registrants of the starwars.org.uk, the starwars.me.uk and the star-wars.me.uk domain names. The Respondent concludes that the Complainant had no interest in the star-wars.uk Domain Name and was solely interested in the starwars.uk Domain Name.

The Respondent goes on to ask whether DRS complaints have been raised against the registrants of the starwars.org.uk, the starwars.me.uk and the star-wars.me.uk domain names, and says that he has been trying to contact one of these registrants to this end. The Respondent also noted that star-wars.org.uk has not been registered as at 29 April 2015. Thus, the Respondent concludes that although the Complainant can show Rights in the Star Wars name, the Complainant has failed in its due diligence to exercise those Rights in previous years and it is clear that the motivation is to attain the starwars.uk Domain Name.

The Respondent asserts that its use of the Domain Names is not Abusive because they are only used to host a portal website that redirects to its Jokers' Masquerade website page that only sells Star Wars branded costumes and legitimate and licensed merchandise purchased from the

Complainant's authorised manufacturer. The websites have never sold or linked to any other third party merchandise nor have the Domain Names been offered for sale, rent, lease or other reward due to their use of the Star Wars trade mark.

The Respondent's primary domain for its Jokers' Masquerade business is joke.co.uk. The Respondent notes that with due diligence it registered the joke.uk, jokeco.co.uk and jokeco.uk domain names because it was apparent that unless it did so it could become exposed to cybersquatting or other competitor mischief and that such cybersquatter or competitor could gain unfair advantage. This, says the Respondent, is the reason why he registered the starwarsco.co.uk and star-warsco.uk Domain Names and not as a reaction to the Complainant's letter.

The Respondent denies that the Domain Names link to the Respondent's website where goods with no connection to the Complainant are offered for sale. The Respondent says that any hyperlink from the Domain Names has a click-through URL of <http://www.joke.co.uk/star-wars-costumes/> which is a dedicated landing page for Star Wars costumes. There are other costumes on the Respondent's website, but the landing page contains genuine licensed costumes. The Respondent also denies that the Complainant purchased an unlicensed Star Wars product from his website.

The Respondent says that in 2003, 2004, 2005 and 2006 it did register a number of domain names for search engine optimisation (SEO) purposes and did build portal websites, which was a common tactic as used by SEO companies. The Respondent denies that its registration of the trade marks of third parties is an infringement of those third parties' rights.

The Respondent acknowledges and accepts the Complainant's trade marks but denies that the registrations of the Domain Names are abusive as it has never used the Domain Names for any illegitimate means and this can be demonstrated via the Way Back Archive.

The Respondent says that the existing <http://www.starwars.co.uk> portal web page and associated URLs that link to it have remained dormant for many years, though due to the release of the Complainant's new film in December 2015 it is planned for an overhaul and facelift. The Respondent offered to transfer the starwars.uk Domain Name to the Complainant on agreement that the Respondent can continue to use the starwars.co.uk and star-wars.co.uk Domain Names to sell and promote legitimate Star Wars branded merchandise.

## **The Reply**

In respect of the Complainant's delay in making the Complaint, the Complainant asserts that there is no limitation period for filing complaints and delay alone is not a ground on which a complaint may be denied and that there must be some reason as to why the delay should lead to a finding against the Complainant. Furthermore, the Respondent was aware of the Complainant's Rights both when he registered the Domain Names and when he began use of the Domain Names and the Complainant has done nothing to allow the Respondent to believe that he was entitled to use the Star Wars trade mark for his own benefit and the Respondent was aware of the Complainant's explicit objection to his use of the Domain Names from the time of the Complainant's letter in June 2014. The Complainant refers to *Emirates v. Michael Toth* (DRS 8634) in which the appeal panel said:

*"The generally held view amongst Nominet experts (and UDRP panellists) is that delay alone is not a ground on which a Complaint may be denied".*

The Complainant notes that the appeal panel accepted that there might be a case for delay or acquiescence to a complaint amounting to a defence under the Policy where the delay was such as to prejudice the proper consideration of the issues but, in the present case, there is no prejudice to the proper consideration of the issues and the Respondent has not alleged that there will be any such prejudice nor that the delay has in any way impeded its ability to defend the case or

that there has been any acquiescence on the part of the Complainant which has in some way caused detriment to the Respondent. The Complainant further cites *Novartis AG v C Blatchley T/A The Discount Lens Co.* (DRS 13281) in which the expert emphasised that he must consider whether “*a decision to ignore the delay or not will bring about a result which is, in all the circumstances, unfair or unconscionable*”. The Complainant says that there is no reason why it should be unfair or unconscionable for the Complainant to now seek to prevent the Respondent from continued unauthorised use of its Star Wars trade mark, nor has any such reason been offered by the Respondent.

The Complainant says that in numerous cases, the registration of domain names essentially identical to a Complainant’s trade mark has been held by Nominet experts to be abusive even if the domain names are used for websites selling the Complainant’s own products. This is on the basis that the domain names suggest that the registration and subsequent use of the domain name was authorised or otherwise approved by the Complainant when it was not. In this Complaint, the Complainant says that the position is even worse in that the Respondent does not sell only the Complainant’s products.

The Complainant disputes the Respondent’s contention that the Respondent’s website only sells Star Wars branded costumes and does not link to any other third party merchandise: if a user clicks on any link on the website at [www.starwars.co.uk](http://www.starwars.co.uk) it is taken to the Respondent’s website at [www.joke.co.uk/star-wars-costumes/](http://www.joke.co.uk/star-wars-costumes/); from this page, one further click on any of the links on the drop down menu at the top of the page will take the user to merchandise of third parties. Internet users will therefore be drawn to the Respondent’s website purely as a result of the attraction of the Complainant’s Star Wars trade mark, but these users are very likely to end up purchasing goods which either have no connection to the Complainant or are unlicensed goods, which has been held in many cases to be evidence of Abusive Registration. Furthermore, in *Epson Europe BV -v- Cybercorp Enterprises* (DRS 03027) the appeal panel considered that “*confusion that may arise, irrespective of the content of the respondent’s site, merely as a result of the adoption of a domain name incorporating the complainant’s mark, can legitimately be taken into account and that this so-called “initial interest confusion” is an admissible species of confusion in DRS cases*”.

The Complainant says that the Respondent appears to be suggesting that it registered the Domain Names in order to prevent cybersquatters or competitors from taking unfair advantage of its business. However, the Respondent has no reputation or goodwill in Star Wars to be taken advantage of by third parties. Furthermore, the registration of seven separate Star Wars domain names suggests that the Respondent is attempting to corner the market in “.uk” domain names incorporating the Complainant’s trade mark.

In reply to the Respondent’s request for evidence of the purchase of an unlicensed Star Wars product, the Complainant submitted a copy of an invoice for the purchase made from the Respondent’s website. The Complainant says it has reviewed its licensed products and confirms that the item with the description “Double Ended Sword (with sound) RED” that was sold by the Respondent is not a licensed product.

Finally, the Complainant says that the Respondent’s disclosure of the fact that the website to which the Domain Names resolve is to receive “an overhaul and a facelift” due to the release of the Complainant’s new Star Wars film in 2015 is further clear evidence of the Respondent’s intention to benefit from the “pulling power” of the Complainant’s Star Wars trade mark and take advantage of the Complainant’s reputation for its own financial gain.

## 6. Discussions and Findings

### General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

1. *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
2. *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

### Complainant's Rights

Rights is defined in §1 of the Policy as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

The wholly generic suffixes “.co.uk” and “.uk” are discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name. Furthermore, the use of the hyphen in some of the Domain Names, and the addition of the suffix “co” in others, does not in any way detract from the distinctiveness of the name Star Wars.

The Complainant has set out details of a number of trade marks in the name Star Wars from as early as 1984 in the UK, all of which pre-date the registration of the Domain Names. The Complainant has also evidenced significant rights in the name Star Wars arising from the success of the first film (chronologically) in the series in 1977.

I find that the name Star Wars is not wholly descriptive of the Complainant's business and that, on the papers before me, for the purposes of the first limb of the test in §2 of the Policy, that the Complainant has Rights in the name Star Wars which is identical or similar to the Domain Names.

### Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

1. *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*
2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3a of the Policy:

- i. *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
  - A. *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*
  - B. *as a blocking registration against a name or mark in which the Complainant has Rights; or*

- C. *for the purpose of unfairly disrupting the business of the Complainant;*
- ii. *Circumstances indicating that the Respondent is using 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 Complainant;*
- iii. *The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*
- iv. *It is independently verified that the Respondent has given false contact details to us; or*
- v. *The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:*
  - A. *has been using the Domain Name registration exclusively; and*
  - B. *paid for the registration and/or renewal of the Domain Name registration.*

The Complainant alleges Abusive Registration under a number of the factors in §3 of the Policy:

**§3a i B**

That the Respondent registered or otherwise acquired the Domain Names as blocking registrations against the name Star Wars.

The Respondent does not dispute that the Complainant's Rights existed before his registration or acquisition of the Domain Names and confirms that he was aware of those Rights at the times of registration or acquisition.

The Domain Names each contain the Complainant's trade mark Star Wars; in 2 instances this is unadorned, with the other 5 instances having the addition of a hyphen or the suffix "co" or both.

The Respondent's registration of the 2014 Domain Names occurred following the Complainant's letter to the Respondent in June 2014. The Respondent says that he registered these Domain Names in order to prevent cybersquatting or "competitor mischief", not as a reaction to the Complainant's letter. Nevertheless, it is difficult to see any legitimate purpose in the Respondent's 2014 registrations, unless the Respondent's registration and use of the 2003 Domain Names is in fact a fair and legitimate registration and/or use, and the registration of the 2014 Domain Names was for the purposes of an extension to that fair use.

The Complainant has not shown that the registration or acquisition of the 2003 Domain Names was as blocking registrations.

**§3a i C and §3a ii**

That the Respondent registered or otherwise acquired the Domain Names for the purpose of unfairly disrupting the Complainant's business and that such use has confused, or is likely to confuse, users into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant.

The Respondent says that this is not so as he is selling licensed Star Wars products purchased from the Complainant's licensed supplier. The Respondent relies on §4a i C of the Policy, being one of

the factors that would indicate that the registration/acquisition and/or use of the Domain Names are not Abusive Registrations:

*Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has .... made legitimate non-commercial or fair use of the Domain Name[s].*

The issue of resellers of a trade mark owner's goods incorporating the trade mark in the domain name was considered by the appeal panel in Toshiba Corporation v Power Battery Inc (DRS 07991). The accepted principles arising from that appeal are:

- 1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.*
- 2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.*
- 3. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.*
- 4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.*

The name Star Wars cannot sensibly refer to anyone else other than the Complainant. It is a unique term coined by the Complainant for the purposes of a science fiction film released in 1977 and enhanced as further films have been released. It is highly likely in my view that any user searching for Star Wars and arriving at the Respondent's website will have suffered initial interest confusion and falsely inferred a commercial connection with the Complainant.

I am also satisfied that the Respondent has taken advantage of the "pulling power" of the name Star Wars to attract users to its website via the Domain Names.

In respect of the Complainant's allegation that the Respondent sold an unlicensed product by way of its test purchase, the subsequent submission of the invoice in the Reply is supported by a bare assertion that it was unlicensed. I cannot, on the papers before me, consider that on the balance of probabilities the Complainant has shown this to be the case.

### **§3a iii**

The Complainant says that the Respondent has engaged in a pattern of registrations of domain names which correspond to well known names or trade marks in which the Respondent has no apparent rights and the Domain Names are part of that pattern.

The domain names in question were registered between 2003 and 2006. The 2003 Domain Names were registered or acquired at the start of this period.

However, given the extended period of registration, and the findings of the panel in the Toshiba Corporation v Power Battery Inc appeal, it is not automatically unfair for a reseller to incorporate such trade marks in a domain name and each case must be considered on its facts. There are no facts presented to convince me that, on the balance of probabilities, the Respondent did engage in such a pattern of registrations.

### **Complainant's delay**

The Respondent says that the Complainant's delay between his registering or acquiring the 2003 Domain Names and this Complaint indicates that the Complainant has no interest in the 2003 Domain Names and is only interested in the shorter starwars.uk Domain Name, but has found that the registration of this Domain Name is protected in favour of the Respondent until 2019.

Whether this allegation is correct or not, it has no bearing on this Complaint. The Complainant has Rights in the name Star Wars and the Respondent has been using the 2003 Domain Names in such a way as to cause initial interest confusion. The Complainant correctly cites in the Reply the appeal panel in Emirates v. Michael Toth (DRS Case No. 08634):

*"The generally held view amongst Nominet experts (and UDRP panellists) is that delay alone is not a ground on which a Complaint may be denied".*

The fact that the Complainant has not registered the Complaint for such a length of time is not prejudicial to proper consideration of the issues.

Accordingly, I find that the Respondent's registration and/or use of the Domain Names has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights, and the Respondent's use of the Domain Names has, in the case of all of the Domain Names, caused initial interest confusion, which is Abusive Registration in each case.

## **7. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical and/or similar to the Domain Names, and that the Domain Names, in the hands of the Respondent, are Abusive Registrations, I direct that the Domain Names:

star-wars.co.uk  
star-wars.uk  
star-warsco.co.uk  
star-warsco.uk  
starwars.co.uk  
starwars.uk  
starwarsco.co.uk

be transferred to the Complainant.

**Signed: Steve Ormand**

**Dated: 5<sup>th</sup> July 2015**