



August 11, 2005

Re: Case No. D2005-0538
<royaldutchshellgroup.com
royaldutchshellplc.com
tellshell.org>
Notification of Decision

Please find attached the full text of the decision issued on August 8, 2005 by the Administrative Panel in the above-referenced case.

The Administrative Panel's finding is as follows:

For all the foregoing reasons, the Complaint is denied.

Yours sincerely,

Mussadiq Hussain
Case Manager

COMMUNICATIONS

This notification is being communicated to the Complainant in accordance with the following contact details:

David Crawford
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By the following methods:

- Post/Courier (with original enclosure)
- E-mail (with attachment)

This notification is being communicated to the Respondent in accordance with the following contact details:

Alfred Donovan
847a Second Avenue
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By the following methods:

- Post/Courier (with original enclosure)
- E-mail (with attachment)

A copy has also been communicated to the Registrar listed below:

Tucows

By the following methods:

- E-mail (with attachment)



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Shell International Petroleum Company Limited v. Alfred Donovan

Case No. D2005-0538

1. The Parties

The Complainant is Shell International Petroleum Company Limited, London, United Kingdom of Great Britain and Northern Ireland, represented by David Crawford, United Kingdom of Great Britain and Northern Ireland.

The Respondent is Alfred Donovan, New York, New York, United States of America, who is not separately represented.

2. The Domain Names and Registrar

The disputed domain names <royaldutchshellgroup.com>, <royaldutchshellplc.com>, <tellshell.org> (“the Disputed Domain Names”) are all registered with Tucows.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 18, 2005. On May 19, 2005, the Center transmitted by email to Tucows a request for registrar verification in connection with the Disputed Domain Names. On May 19, 2005, Tucows transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced May 25, 2005. In accordance with the Rules, paragraph 5(a), the due date for Response was June 14, 2005. The Response was filed with the Center on June 14, 2005.

The Center appointed Daniel J. Gervais, Michael D. Cover and Diane Cabell as panelists in this matter on July 14, 2005. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant was until January 1, 2005, the principal company designated within the Royal Dutch/Shell Group of companies (hereafter “the Group”) to hold the Group’s trademark and domain name assets. For the time being, the Complainant remains the owner of the domain names. The Complainant is a global group of energy and petrochemicals companies, operating in more than 145 countries and employing approximately 119,000 people. The principal holding companies within the Group as at today are N.V. Koninklijke Nederlandsche Petroleum Maatschappij (a Dutch company incorporated in 1890, holder of a 60% interest in the Group) and The “Shell” Transport and Trading Company plc (a UK company incorporated in 1897, holder of the remaining 40% interest).¹ Since 1907, when these two companies decided to merge their business interests, the resulting group of companies has been known as the “Royal Dutch/Shell Group of Companies”. On October 28, 2004, it was publicly announced that the boards of these two companies had agreed to propose to their shareholders the unification of the Royal Dutch/Shell Group of Companies under a single parent company, to be called Royal Dutch Shell plc.

Currently the Complainant and affiliated entities are the owner of the “SHELL” trademark in nearly 190 countries of the world, amounting to more than 3,300 registrations. The Complainant is also the owner of the European Community Trademark “ROYAL DUTCH” Number 001305101, registered on September 10, 1999. The “SHELL” trademark has been used since at least 1904 in many countries of the world for a wide variety of petroleum and other products, and as a consequence has become a well-known trademark.

“Tell Shell” is a facility set up in November 1998 to promote feedback from customers, shareholders or any other interested parties on topics and issues relating to Shell, and to enable the Complainant to respond to public concerns and criticism in an open and transparent way. Most communications take place by e-mail.

The Respondent’s website contain criticisms of the Complainant’s activities, notably by providing links to stories reported in the press--the Respondent states that he “is not anti-Shell but is very much opposed, as a Shell shareholder, to any Shell senior management actions which are contrary to Shell’s own much proclaimed ethical code”. Both parties agree that the site does not attempt to pass itself off as official website of the Complainant and generally uses names that can be readily distinguished from the domain name <shell.com> owned and used by the Complainant.

Currently, the Respondent’s main website is located at “www.shell2004.com”. The disputed domain names all redirect to the Respondent’s “www.shell2004.com” website, as do “www.shellnews.net” and “www.shellscandal.com” (also owned by the Respondent). The Complainant has been aware of the site since the beginning.

¹ “Royal Dutch” is the English translation of the principal distinctive elements of the company name “N.V. Koninklijke Nederlandsche Petroleum Maatschappij” and is the abbreviated name by which this company is generally known.

The Complainant has taken the view that the Respondent is entitled to express his opinions and to use the Internet as a medium for doing so. The domain names used by the Respondent and mentioned above (other than the disputed domain names) include elements additional to the name of the company, sufficient to avoid giving the impression that they were domain names owned by the Complainant, and the Complainant has not challenged their use.

The Respondent has not engaged in any trade on the Internet using the mark "SHELL" or any other name or trademark. The Respondent co-founded two Shell related pressure groups. These were publicized in United Kingdom of Great Britain and Northern Ireland with advertisements/announcements in newspapers and magazines and internationally in Time Magazine.

5. Parties' Contentions

A. Complainant

The domain names <royaldutchshellplc.com> and <royaldutchshellgroup.com> registered by the Respondent are essentially identical to the company name "Royal Dutch Shell plc" and the collective name "Royal Dutch/Shell Group".

The Complainant has not registered the mark "ROYALDUTCHSHELL". The reason for this is self-evidently because the function of a trademark is to distinguish the goods or services of one undertaking from the goods or services of others. The name "Royal Dutch Shell" has always been used as a collective name for a related group of companies, the Group's principal trademark being the simple name "Shell" and the associated emblem. Registration of "Royal Dutch Shell" as a trademark would therefore be of questionable validity unless and until there is an intention to use such term as a mark to identify products or services. It is nonetheless a very significant name in the commercial world. "Royal Dutch/Shell" is a name which was originally coined by the two parent companies on the merging of their business interests in 1907, and which has through almost a century of world-wide usage become known exclusively as the name of that group of companies.

The name "Royal Dutch Shell" first appeared as the name of a single company when a dormant English company within the Complainant was re-named "Royal Dutch Shell plc" on October 27, 2004, in order to secure the name for possible future use by the new parent company, subject to the necessary shareholder approval. The Complainant referred the Panel to the WIPO report entitled "The Recognition of Rights and the Use of Names in the Internet Domain Name System", Chapter 7, paragraph 298, which points out that a "trade name may also be registered and separately protected as a trademark".

The Complainant submits that "Tell Shell" has become well-known as a mechanism for communicating with the Complainant, and as a source of information, both positive and negative, about the operations of same.

The Respondent is not, and has never been, commonly known by the name "Royaldutchshell" or any similar name, nor is he an employee or director of any company having this name. Although there is no extant litigation between Shell and the Respondent or with anyone associated with him (there have been several instances of litigation in the recent past), the Complainant believes that the Respondent acquired

the disputed domain names as a mean of increasing his capability to disparage Shell at some time in the future.

The disputed domain names are precisely the names of (a) the intended new principal company of the Group, (b) the name of the Complainant itself and (c) the name of the Group's own website discussion forum. The timing of the Respondent's registration of the domain name <royaldutchshellplc.com>, on October 29, 2004 (the day immediately following the re-structuring announcement), suggests that the registration was made as a direct reaction to that announcement with the intention of pre-empting the Complainant from owning the name. For these reasons the Respondent has no legitimate right or interest in the disputed domain names. He also appears not to be using them for any *bona fide* offering of goods or services. An unsuspecting Internet user looking for information about the Royal Dutch/Shell Group of Companies or about Royal Dutch Shell plc in particular might be tempted to look for <royaldutchshellgroup.com> or <royaldutchshellplc.com> in the expectation that these domain names would direct him to the appropriate website. In fact, they direct him to the Respondent's site where he is presented with much adverse publicity and negative personal opinion. As such, the Respondent, with the intent not for any particular commercial gain, but mainly to further his campaign of adverse publicity against the Royal Dutch/Shell Group of Companies, is using the disputed names to cause embarrassment to the Complainant and prevent them from using the names themselves.

This <tellshell.org> domain name also re-directs to the Respondent's site "www.shellnews.net". The name itself is very descriptive and gives the clear impression that it will enable the user to "tell Shell" something. In fact, it does not put the user in touch with Shell at all, but exposes him to the Respondent's criticism site. The Complainant therefore contends that the Respondent can have no legitimate right or interest in the domain name which, because it directs users to an anti-Shell site, is deliberately misleading.

The Complainant contends that the facts set out in the preceding paragraphs raise a strong presumption that the disputed domain names were registered and are being used in bad faith. They were registered, and are being used, for the purpose of attempting to attract Internet users to the Respondent's website, by creating a likelihood of confusion with a company name, a collective name and the name of a website forum owned by the Group. The Respondent has also been known to refer to himself in terms such as "Alfred Donovan of <royaldutchshellplc.com>, a.k.a. shellnews.net". By referring to himself in this way he is attempting to mislead visitors to his website into thinking that he has some connection with the Complainant or at least that he has some authority to speak on behalf of the Group.

Specifically, in terms of the Policy, paragraph 4(b)(ii) provides that it shall be evidence that a domain name has been registered and is being used in bad faith if the Respondent has "registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent has] engaged in a pattern of such conduct". Previously-decided UDRP cases such as *Revlon Consumer Products Corporation v. Domain Manager, PageUp Communications*, WIPO Case No. D2003-0602 and *The Conde Nast Publications Limited v. Alison Coplen t/a Superior Interiors*, WIPO Case No. D2004-0761, have held that a "pattern" may be evidenced by any repetition of such conduct, even as few as two instances. The Complainant contends that by registering the three disputed names, the Respondent has engaged in such a pattern of conduct, aimed at preventing the Complainant and the Complainant's Group from reflecting their marks in corresponding domain names.

B. Respondent

The Respondent is not trying to prevent the Complainants from getting their own views out to the public.

The domain names are all registered and based in the United States of America, and because the Complaint was served on the Respondent in the United States of America, the Respondent asserts that the Panel should follow US law. There are now many cases decided in the courts of the United States upholding the use of domain names, in the form <trademark.com>, for websites about a trademark holder or trademark holder's products, for example: *Bosley v. Kremer*, 403 F.3d 672 (9th Cir. 2005); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002 (9th Cir. 2004); *TMI v. Maxwell*, 368 F.3d 433 (5th Cir. 2004); *Taubman v. WebFeats*, 319 F.3d 770 (6th Cir. 2003); *Lucas Nursery and Landscaping v. Grosse*, 359 F.3d 806 (CA6 2004); *Ficker v. Tuohy*, 305 F.Supp2d 569, 572 (DMd 2004); *Crown Pontiac v. Ballock*, 287 F.Supp2d 1256 (NDAla 2003); *Northland Ins. Co. v. Blaylock*, 115 F.Supp2d 1108 (DMinn 2000); *Mayflower Transit v. Prince*, 314 F.Supp2d 362, 369-371 (DNJ 2004); *Savannah College of Art and Design, Inc. v. Houeix*, --- F.Supp.2d ----, 2004 WL 3330354 (S.D.Ohio 2004).

Similarly, many UDRP decisions have upheld the use or registration of domain names that were identical to a trademark, by persons other than the owner of the trademark, where the purpose was to mount a website about the owner of the name.

The Complainant does not have trademark rights in respect of the name Royal Dutch Shell plc. No goods or services were offered under that name. The Complainant has not claimed any trademark registration in respect of "TellShell".

As the Complainant concedes, the Respondent's websites have never attempted to pass themselves off as official Shell websites. The Respondent contends that it is unfair for the Complainant to claim that any visitor to the unofficial "www.tellshell.org" site has ever been misled into believing it is the Complainant's site.

While it is true that the vast majority on the Respondent's site are negative towards the Complainant, they are not made by the Respondent but by journalists (news headlines).

None of the disputed domain names were registered or acquired for the purpose of selling, renting, or otherwise transferring the domain name registrations to the Complainant, as the alleged owner of any trademark or service mark claimed to be similar, or to a competitor of the Complainant, for any consideration. The domain names were not registered in order to prevent the Complainant from reflecting any mark in a corresponding domain name and the Respondent has not engaged in a pattern of such conduct. The Complainant and the Respondent are not competitors and the domain names were not registered by the Respondent primarily to disrupt the Complainant's business. None of the disputed domain names were registered by the Respondent in an attempt to attract for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with any mark registered by the Complainant as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. The Respondent has never traded or conducted business on the Internet via any website nor ever sold advertising on any website. The benefit to the Respondent of his website is that it provides him with a low cost

public platform to focus attention on the positive and negative aspects of Royal Dutch Shell and in so doing, engage in his right to freedom of expression.

6. Discussion and Findings

The Panel must balance the Respondent's "fair use" right to express opinions and provide information about the Complainant against the possible confusion of Internet users who reach the Respondent's website (via any of his domain names) thinking they are accessing a site operated by or on behalf of the Complainant, an impression then dispelled by the disclaimer visible at the top of the first page of the site, which includes a link to the Complainant's site.

In accordance with paragraph 4(a) of the Policy, in order to succeed in this proceeding and obtain the transfer of the domain name, the Complainant must prove that each of the three following elements is satisfied:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (see below, section 7.A); and
2. The Respondent has no rights or legitimate interests in respect of the domain name (see below, section 7.B); and
3. The domain name has been registered and is being used in bad faith (see below, section 7.C).

Paragraph 4(a) of the Policy clearly states that the burden of proving that all these elements are present lies with the Complainant.

Pursuant to paragraph 15(a) of the Rules, the Panel shall decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. Moreover, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom, as it considers appropriate.

A. Identical or Confusingly Similar

This question raises two issues: (1) does the Complainant have rights in a trademark or service mark; and (2) is the domain name identical or confusingly similar to such trademark or service mark.

The Complainant has rights in both trademarks SHELL and ROYAL DUTCH. The fact that the latter is not registered in the United States of America does not prevent the Panel from considering it for the purposes of this administrative proceeding. However, the Panel does not consider that the Complainant has established its rights in the mark ROYALDUTCHSHELL. That is a trade name. While it is undeniable that a trade name can also be a trademark, no evidence was produced to show that ROYALDUTCHSHELL is registered or used in such a way as to give rise to common law rights. The same may be said of "TELLSHELL". In that case, there may be common law rights but the Panel does not feel justified to come to that conclusion on the strength of the evidence adduced by the Complainant.

The Panel is aware of the fact that many national laws also protect trade names.² However, the Policy refers to trademarks. See *CBS Broadcasting Inc., f/k/a CBS Inc v. Nabil Z. Aghloul*, WIPO Case No. D2004-0988; *G. Bellentani 1821 S.p.A. v. Stanley Filoramo*, WIPO Case No. D2003-0783; *University of Konstanz v. uni-konstanz.com*, WIPO Case No. D2001-0744; *Sealite Pty Limited v. Carmanah Technologies, Inc.*, WIPO Case No. D2003-0277 (“It is well settled that the Policy does not protect trade names or company names when this is the extent of their use.”) *Ahmanson Land Company v. Vince Curtis*, WIPO Case No. D2000-0859; *Sintef v. Sintef.com*, WIPO Case No. D2001-0507; *Manchester Airport PLC and Club Club Limited*, WIPO Case No. D2000-0638; *Music United.com AG v. J. Nauta*, WIPO Case No. D2000-1019; *SGS Société Générale de Surveillance S.A. v. Inspectorate*, WIPO Case No. D2000-0025. *Contra see Canon U.S.A. Inc., Astro Business Solutions, Inc. and Canon Information Systems, Inc. v. Richard Sims*, WIPO Case No. D2000-0819.

The Panel finds the domain names <royaldutchshellgroup.com> and <royaldutchshellplc.com> confusingly similar to the Complainant’s registered marks. The use of two or more trademarks belonging to the same entity in a domain name, especially in the case of a merger, creates a likelihood of confusion. See *Pharmacia & Upjohn AB v. Monsantopharmacia.com Inc.*, WIPO Case No. D2000-0446; and *Westfield Corporation, Inc and Westfield Limited v. Graeme Michael Hobbs (Dynamic Marketing Consultants)*, WIPO Case No. D2000-0227.

As to the domain name <tellshell.com>, because the Complainant has not proven rights in TELLSHELL, the question is whether the domain name is confusingly similar to the mark SHELL. The mark SHELL is particularly well-known (in spite of the fact that it is also a common word in the English language). Combined with the verb “tell”, which implies that one can “speak to” the Complainant as it were, the Panel finds that a likelihood of confusion exists. This is heightened by the fact that the domain name may be reflected in email addresses.

In the end, “what matters is not the content of the website but the impression left by the disputed domain name in the eye of the public”. See *Sanofi-Synthelabo v. Nicki On*, WIPO Case No. D2003-0871; and *Aventis SA, Aventis Pharma SA v. Nicki On*, WIPO Case No. D2003-0899. The risk of confusion is much greater than in the so-called “sucks” cases. See, e.g., *The Royal Bank of Scotland Group plc, National Westminster Bank plc A/K/A NatWest Bank v. Personal and Pedro Lopez*, WIPO Case D2003-0166.

The Panel thus finds for the Complainant on the first part of the test.

B. Rights or Legitimate Interests

According to paragraph 4(c) of the Policy, a Respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

- “(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

² See the Report of the Second WIPO Internet Domain Name Process entitled “The Recognition of Rights and the Use of Names in the Internet Domain Name System” (available at “<http://arbiter.wipo.int/processes/process2/report/html/report.html>”), paragraph 306.

- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

There are no elements showing that the Respondent is or was commonly known by the domain name. The Respondent is not making or preparing to make a *bona fide* offering of goods or services. The only option available to the Respondent is thus subparagraph (iii) above.

The use of a domain name to criticize a company is *prima facie* fair use. The Respondent is entitled to use the Internet to use his free speech rights and express his opinion in this way, subject to other laws of course (copyright, libel, etc.). However, by reflecting the exact trade names of the Complainant and using the exact name of a facility specifically designed to send messages to or post messages about the Complainant, the Complainant argues that Respondent’s intent is to tarnish the mark. The distinction between constructive criticism and tarnishment can be a difficult one to draw. In this case, there is no evidence that Respondent’s actions are for “commercial gain” or that they are intended to tarnish the Complainant’s mark as required by paragraph 4(c)(iii) of the Policy. The Respondent does own some shares of stock, but the impact of his activities on the value of such shares is presumed by the Panel to be remote. The Panel thus finds that the Respondent has a legitimate interest in the domain names.

A final point on the question of legitimate interest is in order. The Respondent urged the Panel to apply US law. The many cases cited by the Respondent might well exonerate him from liability under the Lanham Act and the Anticybersquatting Consumer Protection Act (ACPA),³ especially if his site is considered *bona fide* noncommercial use, but that is not for this Panel to determine. The Panel also considered the US doctrine of “initial interest confusion”. Without going into full discussion, the doctrine appears to be inapplicable in this case because of the non commercial context⁴.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out four circumstances which, without limitation, shall be evidence of the registration and use of a domain name in bad faith, namely:

- (i) circumstances indicating that Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration

³ The ACPA was added to the Lanham Act (and is codified at 15 U.S.C. § 1125(d)) as an amendment to the Lanham Act to prohibit cybersquatting. “Cybersquatting occurs when a person other than the trademark holder registers the domain name of a well known trademark and then attempts to profit from this by either ransoming the domain name back to the trademark holder or by using the domain name to divert business from the trademark holder to the domain name holder.” *DaimlerChrysler v. The Net Inc.*, 388 F.3d 201, 204 (6th Cir., 2004). Noncommercial use does not prevent the application of ACPA. The use must also be considered *bona fide* and/or fair. See *Bosley v. Kremer*, 403 F.3d 672, 680 (9th Cir., 2005).

⁴ See *Confusion in Cyberspace: Defending and Recalibrating the Initial Interest Confusion Doctrine*, 117 HARV. L. REV. 2387 (2004).

- in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
 - (iii) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
 - (iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product.

There is no evidence to support a claim under subparagraphs (i) or (iii), nor has any direct commercial gain been established, as required by (iv). The Complainant's case thus rests on subparagraph (ii). Arguably, the Respondent is preventing the Complainant from reflecting its trade name and the name of the "tellshell" facility in a corresponding domain name, but then only in respect of the ".com" TLD. There are several other TLDs available to the Complainant. More importantly, based on the record in front of this Panel, those trade names are not protected as marks. In addition, the evidence does not show that the Respondent's intent and purpose was to prevent the Complainant from using his marks, but rather to draw attention to his criticism of the Complainant's activities.

The Panel thus finds for the Respondent on the third part of the test.

7. Decision

For all the foregoing reasons, the Complaint is denied.

Daniel J. Gervais
Presiding Panelist

Michael D. Cover
Panelist

Diane Cabell
Panelist

Dated: August 8, 2005