

DISPUTE RESOLUTION SERVICE

D00009187

Decision of Independent Expert

Ferrero S.p.A

and

Mr Peter Ross

1. The Parties:

Lead Complainant: Ferrero S.p.A
Piazzale Pietro
Ferrero 1
12051
Alba
Cuneo
Italy

Respondent: Mr Peter Ross
19 Rufflees Avenue
Glasgow
G78 1BB
United Kingdom

2. The Domain Name:

nutella.co.uk

3. Procedural History:

The Complaint was received by Nominet on 18 October 2010 and validated the next day. Notification of the Complaint was sent to

both parties on 19 October 2010. On 10 November 2010 a Response was received and notified to the parties. A Reply was received by Nominet on 18 November 2010 and notified to the parties on the same day. The Complaint was not resolved at the mediation stage and the fee to obtain an independent Expert's decision under Nominet's Dispute Resolution Service Policy (the 'Policy') was paid to Nominet on 13 January 2011. Jon Lang was appointed as the independent Expert on 24 January 2011. The Expert confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances that might call into question his independence in the eyes of the parties.

4. Factual Background

The Complainant is the registered proprietor of the word mark NUTELLA, registered at the United Kingdom Intellectual Property Office with number 864485 (the "Mark"). The Mark was filed on 20 May 1964. The Complainant owns numerous other UK and Community registrations containing the word NUTELLA.

The Mark has been in use in the United Kingdom continuously since at least 1968. As a result of the Complainant's extensive use and promotion of NUTELLA products carrying the Mark, the Complainant has built up substantial goodwill and reputation in the Mark in the UK and other countries.

The Domain Name was registered in 2004.

5. Parties' Contentions

The Complaint

- the Complainant has for many years owned substantial rights in the Mark which are enforceable under English law (under registered trade mark law and the common law of passing off) and in other countries.
- The Respondent registered the Domain Name without the Complainant's consent and is not connected to the Complainant in any way.
- The Domain Name was registered in 2004 over 30 years after the Complainant had started selling NUTELLA products displaying the Mark in the United Kingdom.

- The address given by the Respondent upon registration of the Domain Name is set out below:

non of
your business
over here
G78 1PE

- At the time of registration, the Respondent's website to which www.nutella.co.uk pointed, consisted of a single page reading: *"Will have something with you as soon as I can be arsed...until then, piss off!"*
- An investigation into the Respondent's website by investigators in August 2004 reported that it re-routed to a web address containing images displaying the Mark.
- The Respondent must have been aware of the Complainant's rights in the Mark when he registered the Domain Name because the Mark and the NUTELLA brand in general is famous, and has been for a number of years.
- In the light of the Complainant's extensive use and promotion of the Mark, it is not credible that the Respondent came up with the Domain Name independently.

Identity of Mark and Domain Name

- The Domain Name is identical to the Mark in which the Complainant has prior rights.

Abusive Registration and use

- The Domain Name was registered by the Respondent in bad faith and in a manner that took unfair advantage of and/or was unfairly detrimental to the Complainant's rights in that:
 - the registration was primarily to block the Complainant's use of the Domain Name;
 - given the reputation and goodwill that has attached to the Mark, the Respondent must have known that his use of the Domain Name would attract a number of users to his website. Regardless of whether users who access the Respondent's website (having been misled by the Domain Name) remain confused (in thinking it relates to the Complainant), the Respondent will have deliberately

and wrongly attracted users to his website thereby free-riding off the Complainant's reputation in the Mark;

- the Domain Name was registered for the purpose of unfairly disrupting the Complainant's business. Whether or not internet users that had been initially confused conclude that the Respondent's website is connected with the Complainant, they will have been frustrated in their attempt to access and/or will have been prevented from accessing the Complainant's website. This is disruptive of and damaging to the Complainant's business.
 - the Respondent can have no credible legitimate reason for registering or using the Domain Name;
 - the Respondent provided false contact details when registering the Domain Name;
 - by registering a domain name incorporating the Mark, a household name which denotes the Complainant and nobody else, the Domain Name inherently misrepresents that it is registered or otherwise connected with the Complainant and amounts to 'an instrument of fraud'.
- *None of the factors in paragraph 4 of the Policy, which may suggest a domain name is not abusive apply, in particular:*
 - the Respondent has at no point used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services;
 - the Respondent has at no point been legitimately connected with a mark which is identical or similar to the Domain Name;
 - the Respondent has made no attempt at legitimate non-commercial or fair use of the Domain Name;
 - it is not credible that the Respondent was unaware of the Complainant, its rights (including the Mark) and cause for complaint before the Domain Name was registered, and it is also not credible that the Respondent coincidentally chose to use a Domain Name that is identical to the Mark;

The Response

The Respondent asserts as follows:

- Prior to March 2004 the Domain name had been registered to another personal user for approximately two to four years.
- That in March 2004 he accidentally stumbled upon the Domain Name which had been available for quite some time.
- This was 'exciting' as he had been '*a full fledged fan of the product mark*' but had no idea it '*was a "trademark", nor did I know what one was*'.
- As far as the Respondent was concerned, it appeared the Complainant had no intention of using the Domain Name '*as they were already using all sorts of their marked domain names. Just like other marks, these cannot possibly registered under every suffix. So I assumed this was the case and it was fine for me to register this for personal use*'.
- The Respondent registered the domain using 123-reg with the intention of using it for fan Email.
- There have been many uses for the Domain Name and it went through many '*face changes. From Amusing sites to information sites. ALL for personal use, NEVER for any commercial gain. I have yet to earn one shilling from this. Making fair use of the domain has always been my foremost desire*'.
- The Respondent suggests that the Complainant has '*been viewing the said domain name for quite a number of years before initiating any investigation*'.
- As to the message "*Will have something with you as soon as I can be arsed...until then, piss off!*", the Respondent says '*To ONLY list this message that had been left on the home page for a minimal time-scale I think is very pedantic*'.
- As to the allegation of bad faith, the Respondent says '*There has never been bad faith in using the domain name, why would I have bad faith in a product that I have been an adoring fan of for over twenty five years? How can I take unfair advantage of the complainants rights when I don't even know them? As stated, there has never been any profits made from said domain name, and never would be either*'.

- As to other allegations of the Complainant, the Respondent says:
 - he would never 'block' use of the Domain Name;
 - he did not register the Domain Name *'for profitable reasons. The only thing I supplied were fan named Email address free of charge'*;
 - the Respondent felt that the trademark notice on his website, with a link to Ferrero *'was sufficient enough for anyone looking for the official site'*;
 - The Respondent says that the Domain Name has been easily obtainable by the Complainant for over a decade and that *'if they contacted me personally. I would have been delighted to co-operate with 100% affection and passion'*, that it would have been simple for the Complainant to contact him and that had they done so they could have come to an amicable settlement for a *'speedy transfer. Or indeed share the domain name for use for the fan Email, and allow Ferrero full WEB access. From Tuesday 9th November 2010, I have forwarded the domain name to www.ferrero.com to demonstrate this willingness to share'*;
 - The Respondent concludes his Response by stating that *'Its fans like me that want to be part of the community and do all he can for the mark. I have for most of my youth and adult life promoted this mark. Online and offline, people know me as the nutella fan. It is part of who I am, and it just saddened me that I was not approached before now to be part of a brand that makes me who I am today'*.

The Reply

- The Respondent states that in 2004 he *'accidentally stumbled upon the domain name and had no idea this was a "trademark", nor did I know what one was'*. But a screenshot from his website on 10 February 2005 *'notes "Nutella are trademarks and copyright of Ferrero, Italy". Similarly a screen shot from 31 August 2005 states "Ferrero are whole copyright holders and own the trademarks for nutella."* The Respondent also mentions a footer containing a trademark notice.
- It is clear from the Response that the Respondent was aware

of the Complainant, its rights and cause for complaint before the Domain Name was registered.

- The Complainant does not consider the Respondent's failure to earn any money from registering the Domain Name to be of any relevance.
- As to the message "*Will have something with you as soon as I can be arsed... until then, piss off!*" which the Respondent suggests was left for only a short period of time, in fact this message appeared for almost three months from June 2004 to September 2004.
- The Complainant acknowledges that the Respondent has '*forwarded the domain name to www.ferrero.com*' but notes that a WHOIS search still indicates that the Respondent is the registrant of the Domain Name.

6. Discussions and Findings

Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's 'Rights'

The meaning of 'Rights' is defined in the Policy as follows: *'Rights means 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 Complainant enjoys long-standing registered and unregistered rights in the mark Nutella by virtue of its extensive trading activities in the UK and elsewhere and of course its trade mark registrations. Indeed, the existence of Rights appears now to be accepted by the Respondent.

Ignoring the prefix 'www' and suffix '.co.uk', the Complainant's mark and Domain Name are identical. Accordingly, the Expert is satisfied that the Complainant has Rights in a name or mark that is identical to the Domain Name. Accordingly, the Expert must now consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'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 which *'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights;'*

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 3 of the Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily as a blocking registration against a name or mark in which the Complainant has rights, or for the purpose of unfairly disrupting the business of the Complainant.

Other factors suggesting an Abusive Registration include the Respondent 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.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This includes circumstances indicating that before being aware of the Complainant's cause for complaint, the Respondent has made legitimate non-commercial or fair use of the domain name.

At the heart of the Complaint is the allegation that the Respondent knew of the NUTELLA brand when he registered the Domain Name and its use causes internet users to be confused (as to the relationship between the Domain Name and the Complainant), at least initially i.e. before arriving at the site to which the Domain Name points. This, it is said, is disruptive and damaging to the Complainant's business and unfairly detrimental to its rights. The Complainant also says that the Respondent had no legitimate reason for registration of the Domain Name and that he provided false contact details.

At the heart of the Response are the assertions that whilst the Respondent knew of the NUTELLA brand, he did not know of the Complainant's rights, that he has not derived any commercial gain from the registration and whilst he has used the Domain Name for various purposes, all are for personal use. Moreover, (presumably

by the very fact of its availability), the Respondent did not think the Complainant intended to use the Domain Name. The Respondent, being an *'adoring fan'* of Nutella, denies bad faith and questions how he can take unfair advantage of rights he does not know exist. It is clear that the Respondent feels the Complainant's reference to the message that appeared on his web site at one time, (referred to earlier) is a little unfair.

Dealing with the Complainant's case first, the Expert is of the view that there is sufficient evidence to support a finding of Abusive Registration, absent any countervailing factors. The Domain Name is identical to the Mark and it seems likely that confusion could easily arise - a substantial number of users presented with a list of search results which contained the address of the Respondent's website i.e., the Domain Name, might suppose that there was some connection with the Complainant. To this extent, the user has been misled. The fact that the confusion may dissipate as soon as a user arrives at the website to which the Domain Name points, is no answer. This initial confusion, or 'initial interest confusion' as it has come to be known, can provide a basis for a finding of Abusive Registration. The recent DRS appeal decision in Emirates v Michael Toth (DRS 8634) provides a very useful account of the current position on initial interest confusion. In that decision the Appeal Panel dealt with the issue in this way:

'Initial interest confusion

As the panellist found in the complaint regarding <emirates.eu>, the Respondent's business model depends on attracting Internet users to his website who then generate revenue by click-throughs. Visitors drawn to the site following an Internet search are far more likely to have been looking for the Complainant's website than a general resource on the United Arab Emirates, and are likely to have assumed that the site they were visiting was associated with or authorised by the Complainant. Similarly those accessing the Website directly are very likely to have been users guessing (incorrectly) at the URL of the Complainant's UK website.

As paragraph 3.3 of the Nominet DRS Expert Overview (the "Overview") records, "the overwhelming majority of Experts" view "initial interest confusion" as a possible basis for a finding of Abusive Registration,

"...the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may

well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name."

The Panel also notes that in a recent decision of the English High Court in Och-Ziff Management Europe Limited v OCH Capital LLP ([2010] EWHC 2599 (Ch)) Mr Justice Arnold held that "initial interest confusion" was actionable under Article 9 of the Community Trademark Regulation. The concept cannot be said to be well-founded only under US law as suggested by the Respondent in his Second NSS of 21 September.

Accordingly, the Panel would find that the Domain Name was probably registered and has certainly been used in a manner that takes unfair advantage of the Complainant's Rights in the name EMIRATES.'

Turning to the position of the Respondent, the most obvious countervailing factor would be appear to be that described in paragraph 4(a) iC of the Policy, namely that before being aware of the Complainant's cause for complaint, the Respondent has made legitimate non-commercial or fair use of the Domain Name. The Complainant is of the clear view however, that the Respondent was well aware of the Complainant, its rights and cause for complaint before the Domain Name was registered.

The existence, scope and effect of rights, particularly intellectual property rights, is not always a simple matter. Moreover, it is not always obvious where there is, or might be cause for complaint. It therefore appears perfectly possible for the Respondent, who the Expert assumes is not familiar with intellectual property rights, to be aware of a brand, to be even an 'adoring fan' of a brand, without being aware of the legal rights that attach to it. It is also possible for a lay person to refer to rights, by way of a disclaimer, without really understanding the full extent of those rights or what they mean. And the fact that a Complaint has not itself registered a domain name, could suggest that if someone else did so, it would have no complaint. So it is perfectly possible that the Respondent may not have known of the Complainant's rights or cause for complaint when he registered and began using the Domain Name.

However, the Respondent must still show legitimate non-commercial or fair use. Were the Respondent, for instance, operating a genuine tribute site (and using the website for no other

purpose), that would likely qualify as fair use. But he is not. He has used the Domain Name (or website to which it points) for all sorts of purposes as the Respondent himself describes, 'there have been many uses for the Domain Name it went through many 'face changes. From Amusing sites to information sites. ALL for personal use, NEVER for any commercial gain.'

The Respondent appears to be a man with a keen sense of humour (given, among other things, the contact details provided on registration of the Domain Name which, if independently verified as false, as surely they must be, would be reason enough to evidence an Abusive Registration). He is also an 'adoring fan' of Nutella. Indeed, he says that *'I have for most of my youth and adult life promoted this mark. Online and offline, people know me as the nutella fan. It is part of who I am, and it just saddened me that I was not approached before now to be part of a brand that makes me who I am today'*.

Given his love of the brand, the Expert hopes that the Respondent will understand that other fans of Nutella, searching for their favourite spread on the internet, would rather end up at the official Nutella site directly, rather than via his site having nothing much to do with Nutella, particularly when those other devotees may, at the time of realising they are in the wrong place, be met with a message like the one earlier posted *'Will have something with you as soon as I can be arsed...until then, piss off!'* or some other 'information' having nothing at all to do with Nutella.

Whilst the Expert is prepared to accept that the Respondent's primary purpose in registering the Domain Name was not to 'block' registration or unfairly disrupt the business of the Complainant, it is clear that a user arriving at the Respondent's site as a result of 'initial interest confusion' has not only been misled (temporarily) into believing that he is being transported to a Nutella site, he faces at best a site having no sensible connection with the purpose of his search and at worst one which may cause offence. In the Expert's view, this is an unfair use of the Domain Name.

Accordingly, the Expert is satisfied that, regardless of what the Respondent knew or didn't know at the time of registration or subsequently as to the Complainant's rights or cause for complaint, the Respondent is not making legitimate non-commercial or fair use of the Domain Name.

In all the circumstances, the Expert is satisfied that in the hands of the Respondent, the Domain Name is an Abusive Registration.

7. Decision

The Expert finds that the Complainant has rights in a name or mark that is identical to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the domain name, nutella.co.uk be transferred to the Complainant.

Signed Jon Lang

Dated 11/02/2011