

## DISPUTE RESOLUTION SERVICE

D00009440

### Decision of Independent Expert

VKR Holding A/S

and

Mr Paul Omara

#### 1. The Parties:

Lead Complainant: VKR Holding A/S  
Breettevej 18  
Hørsholm  
2970  
Denmark

Respondent: Mr Paul Omara  
18 North Street  
Bexleyheath  
KENT  
DA7 4HR  
United Kingdom

#### 2. The Domain Name(s):

sonnenkraftuk.co.uk

#### 3. Procedural History:



07 January 2011 13:19 Dispute received  
10 January 2011 12:30 Complaint validated

10 January 2011 12:35 Notification of complaint sent to parties  
 12 January 2011 09:38 Response received  
 12 January 2011 09:39 Notification of response sent to parties  
 20 January 2011 09:51 No reply received  
 20 January 2011 09:51 Mediator appointed  
 25 January 2011 12:10 Mediation started  
 10 February 2011 12:54 Mediation failed  
 10 February 2011 12:54 Close of mediation documents sent  
 01 March 2011 10:04 Expert decision payment received

#### 4. Factual Background

4.1 The facts set out in this section are taken entirely from the Complaint as they are not challenged by the Respondent. The Complainant is a Danish company and is the owner of the Sonnenkraft Group, a leading developer and supplier of solar energy solutions. The Complainant has carried on business since about 1993 through the Sonnenkraft Group as a designer and manufacturer of Sonnenkraft solar panels and other products. The Complainant has been supplying its goods and services through the Sonnenkraft Group to the UK market since about 2005. The Complainant's goods and services are supplied to all European markets under the Sonnenkraft brand. The business has grown substantially and Sonnenkraft has become a well-known brand throughout Europe as a leading solar thermal specialist.

4.2 The Complainant has a number of registered trade marks for the mark Sonnenkraft in both plain text and stylised form. The details of the key registrations given by the Complainant are as follows:

Mark text/image	Registered number	Classes	Registered since
SONNENKRAFT	UK 2482347	09 11 37	24 October 2008
 SONNENKRAFT	CTM 1749050	09 11 37	27 September 2001
 SONNEN KRAFT	CTM 413765	09 11 37	30 March 1999

The Complainant has a long list of registrations in other territories details of which are annexed to the Complaint.

4.3 The Complainant is the proprietor of the domains [sonnenkraft.com](http://sonnenkraft.com) and [sonnenkraft.co.uk](http://sonnenkraft.co.uk) as well as a substantial number of other country-specific domains. The Complainant uses its websites to carry on its business and has in particular used [sonnenkraft.com](http://sonnenkraft.com) in this way since it was registered in January 1998.

4.4 The Complainant has common law rights under English law as a result of its business carried on here under the name and mark Sonnenkraft, its goods and services having been advertised and supplied under that name on an extensive scale since 2005. Consequently its name has become extremely well-known in this field as indicating goods or services connected with the Complainant. The Complainant therefore has a substantial reputation and goodwill in the name Sonnenkraft in the UK.

4.5 Magnus Wallin is the managing director of Sonnenkraft Solar Systems GmbH, a subsidiary of the Complainant. In early March 2009 Mr Wallin met the Respondent at Ecobuild 2009, an annual exhibition held at the ExCel Conference Centre in London's Docklands. Mr Wallin discussed with the Respondent the possibility of him reselling Sonnenkraft branded products, alongside other third party branded products, through the Respondent's existing business, Ample Energy Services Limited of Regus House, Victory Way, Admirals Park, Dartford, Kent DA2 6QD. During these discussions Mr Wallin told the Respondent that Sonnenkraft Solar Systems GmbH had appointed a country manager, Mr Imran Khan, to handle the UK market. At a subsequent meeting (of which the date is not given) Mr Khan was introduced to the Respondent. There was no discussion of the Respondent becoming an official distributor or UK national representative of the Sonnenkraft brand. Indeed, it seems to me to be inherently improbable that such a discussion could have taken place as there was already a country manager in place for the UK. Nor was there any discussion of the Respondent registering the Disputed Domain.

4.6 The Disputed Domain was registered by the Respondent on 10 March 2009 without the Complainant's knowledge or consent. The Disputed Domain is currently parked on a domain parking

facility administered by 1&1 Internet Limited and, as far as the Complainant is aware, has been so parked since its registration. The parking site contains sponsored links to other businesses including some which are similar to or directly competitive with those of the Complainant. Visitors to the Disputed Domain are therefore directed to the Complainant's competitors' websites.

4.7 The Complainant first became aware of the Disputed Domain during routine domain surveillance in March 2009 and wrote to the Respondent on 17 March 2009 informing him that it objected to the registration and use of the Disputed Domain as a web portal. The Complainant asked the Respondent to transfer the Disputed Domain to it. There was no response to this letter. The Complainant wrote again to the Respondent on 17 July 2009 repeating its objections and request and informing the Respondent that a failure to respond would be likely to result in a complaint to Nominet. Both letters were sent to the Respondent's address as registered with Nominet for the Disputed Domain (see above).

4.8 The second letter brought forth a response on Ample Energy Services Limited headed paper dated 2 August 2009 and signed by Ruth Brackpool, believed by the Complainant to be the Company Secretary. The letter denied receiving the letter of 17 March, indicated that the Disputed Domain had been dormant since purchase and explained that it had been purchased following the discussions with Mr Wallin referred to above. It went on to say that the existing Sonnenkraft UK company had ceased trading and that Ample Energy Services Limited had been approached to discuss making it "partners of Sonnenkraft in the UK". It said that the plan was that Ample Energy Services Limited would carry on trading but "branch out to advertise ourselves as Distributors of Sonnenkraft products to the UK market". To do so professionally, the letter said, the Disputed Domain and the company name Sonnenkraft UK had been registered. The company is also dormant. In the light of this and the fact that the Disputed Domain was for possible use with Sonnenkraft products as agreed with Mr Wallin and the knowledge of Mr Khan, the letter said that there had been no misuse of the Disputed Domain and there was no need to sign it over to the Complainant. The letter offered to sell the Disputed Domain and asked the Complainant to make an offer.

4.9 In the meantime it appears that the Respondent (I assume this means Ample Energy Services Limited but this is not clear

from the Complaint) placed orders for Sonnenkraft products in May and July 2009 for goods totalling slightly less than €4000 in value. I assume that these orders were fulfilled and paid for although again this is not entirely clear from the Complaint. The Complainant says that when it became clear that the Respondent had registered the Disputed Domain and was not replying to the Complainant's correspondence, it ceased commercial contact with him and no further business has been done between the parties since.

4.10 On 12 November 2010 the Complainant's solicitors wrote to the Respondent in an effort to resolve the dispute without a Nominet complaint. The Complainant offered to pay the Respondent's out of pocket expenses (evidenced in writing) directly associated with acquiring or using the Disputed Domain. If these were appropriate, the Complainant would pay them in return for transfer of the Disputed Domain to it. On 17 November Ms Brackpool replied on behalf of Ample Energy Services Limited indicating that, if the Complainant wished to purchase the company Sonnenkraft UK Limited and the Disputed Domain to the Complainant, they "would consider an offer in the region of £3500 for out of pocket expenses". No documentation to support the figure was supplied despite the specific request in the Complainant's solicitors' letter.

## **5. Parties' Contentions**

5.1 In the light of these facts the Complainant makes the following arguments:

- (1) The Disputed Domain was registered or has been used in a manner which takes unfair advantage of the Complainant's rights contrary to Paragraph 1 of the DRS Policy.
- (2) The Respondent registered the Disputed Domain for the purpose of selling, renting or otherwise transferring it to the Complainant or a competitor for valuable consideration in excess of documented out of pocket expenses contrary to Paragraph 3(a)(i)(A) of the DRS Policy.
- (3) The Respondent registered the Disputed Domain for the purpose of unfairly disrupting the Complainant's business contrary to Paragraph 3(a)(i)(C) of the DRS Policy.

(4) The Respondent is using or threatening to use the Disputed Domain in a way which is likely to confuse people or businesses into believing that the Disputed Domain is registered to, operated, authorised or otherwise connected with the Complainant contrary to Paragraph 3(a)(ii) of the DRS Policy.

(5) The Respondent has not used or made demonstrable preparations to use the Disputed Domain in connection with a genuine offering of goods or services contrary to Paragraph 4(a)(i)(A) of the DRS Policy.

(6) The Respondent is not commonly known by the Disputed Domain name or legitimately connected with a mark identical or similar to the Disputed Domain contrary to Paragraph 4(a)(i)(B) of the DRS Policy.

(7) The Respondent has not made legitimate non-commercial or fair use of the Disputed Domain contrary to Paragraph 4(a)(i)(C) of the DRS Policy.

(8) The Disputed Domain is not generic or descriptive and the Respondent is not making fair use of it contrary to Paragraph 4(a)(ii) of the DRS Policy.

5.2 The first four items are properly alleged as breaches of the DRS Policy. Items (5)-(8) are properly to be regarded not as breaches of the DRS Policy but as evidential indicators that the Respondent is acting in breach of the Policy and I will consider them in that context.

5.3 The Respondent's response to the Complaint is short and to the point (if somewhat ungrammatical). I quote it in full:

“the domain name is parked and what thier say in their letter, is half true, i bought the company in good faith plus the domain name,in a meeting as this has not gone a head, the company name sonnenkraft UK ltd has laid dormant and the domain name, i do not use eather or advertise to drive traffic to my own company. even though 1 and 1 display sonnenkraftuk.co.uk, it got no meaning what so ever and we have no control over this, 1 and 1 do this.

as to the company and domain of sonnenkraft uk ltd will transferred to my son as a clothing company. also we are not the only company that hold the name sonnenkraft in the uk. i think VKR holdings are using they bullying tactics, like thier have in other contries,”

This information is all the Respondent has put forward in defence of his position.

## **6. Discussions and Findings**

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008. Paragraph 1 of that policy defines an 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”

6.2 Paragraph 1 of the DRS Policy also defines “Rights” for the purposes of this procedure as including but not limited to those enforceable under English law. Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and
- (b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.3 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the domain name is an Abusive Registration. The relevant factors for the purposes of the present case are

- “(a)i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

C. for the purposes 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.”

The remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.4 Clause 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. These include the following which are relevant to the present case:

“(a)i. Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS) the Respondent has:

A. used or made demonstrable preparations to use the Domain Name as a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

...

C. made legitimate non-commercial or fair use of the Domain Name.

...

6.5 According to the Appeal Panel decision in the *Seiko* case (DRS 00248) whether a registration is an abusive registration under the DRS Policy is independent of whether a domain registration is an infringement of trade mark and should be decided under the terms of the DRS Policy alone. The same decision also makes clear, however, that the relevant principles of English law should be applied in determining whether the Complainant has Rights under the Policy and that the Policy is founded on the principle of intellectual property rights which should be taken into account.

6.6 The first question in any DRS complaint is whether the complainant has Rights. This, as has been said in many cases, is a low threshold test. In the present case the mark *Sonnenkraft* is not one with which I am familiar. However, the Complainant has



demonstrated that it has trade mark registrations for it and has made unchallenged statements that it has a substantial business in the UK under the mark which would entitle it to bring an action for passing off. In these circumstances there can be no doubt that the Complainant has demonstrated that it has Rights as defined by the DRS Policy.

6.7 It is a pre-requisite of a finding that a domain name is an Abusive Registration under paragraph 3 (other than paragraph 3(a)(iv)) of the DRS Policy that the respondent had some prior knowledge of the complainant's rights in the Domain Name: see the Appeal Panel decision in *Verbatim* (DRS 4331). Here the Respondent admits that it registered the Disputed Domain following contact with the Complainant with a view to doing business under the trade mark which constitutes the distinctive part of the Disputed Domain. Accordingly, this threshold test is also satisfied.

6.8 It is clear from the Respondent's response that it registered the Disputed Domain with the intention of using it to trade under the trade mark Sonnenkraft. Had this been with the Complainant's permission, then it would plainly have been legitimate. The Respondent, however, does not contest that it was not. Accordingly, any such use would be unfairly detrimental to the Complainant's rights and consequently the Disputed Domain is prima facie an Abusive Registration.

6.9 It is less clear that the Respondent registered the Disputed Domain either for the purpose of selling it to the Complainant for more than the Respondent's out of pocket expenses or of unfairly disrupting the Complainant's business. It does not appear that the Respondent in fact registered the Disputed Domain with the intention of selling it at all. On the contrary, he registered it with the intention of using it. He says that his intention was to use it in conjunction with the Complainant. However, on the facts as set out by the Complainant, and not disputed by the Respondent, he can have had no reasonable expectation that his use of the Disputed Domain would have been with the Complainant's consent. In particular, the idea that he was to be appointed to represent the Complainant or become some kind of authorised distributor appears to have no basis in fact. Accordingly, I have to conclude that the Disputed Domain was registered with the intention of unfairly disrupting the business of the Complainant by

so representing himself. I take into account that, his stated purpose for having registered the Disputed Domain having admittedly failed, it is difficult to see why the Respondent did not accept the Complainant's offer to take the Disputed Domain on payment of documented out of pocket expenses. He can have had no further legitimate use for it. His attempt to extract additional monies lends weight to my conclusion that it was registered without a bona fide belief that it could be fairly used.

6.10 As noted above the Disputed Domain is parked on a website which directs visitors to competitors of the Complainant. This is likely to confuse such visitors into believing that there is some connection between the Complainant and the sites to which they are directed and that accordingly the Disputed Domain is in some way connected, operated or authorised by the Complainant. That this will be so even if there is only initial interest confusion is now well-established in DRS jurisprudence. Accordingly, I conclude that the Disputed Domain is also an Abusive Registration on this ground.

## **7. Decision**

7.1 I conclude that the Disputed Domain is an Abusive Registration and I direct that it be transferred to the Complainant.

Michael Silverleaf

5 April 2011