

**DISPUTE RESOLUTION SERVICE**

**D00010115**

**Decision of Independent Expert**

Fomento De Construcciones Y Contratas S.A.

and

Mr Jonathan Carr

**1. The Parties:**

Complainant: Fomento De Construcciones Y Contratas S.A.  
Asesoria Jurídica – Legal Department  
Fomento de Construcciones y Contratas SA  
Calle Federico Salmón, 13  
Madrid  
Spain

Respondent: Mr Jonathan Carr  
48 Martyns Avenue  
Seven Sisters  
Neath  
West Glamorgan  
SA10 9DS  
United Kingdom

**2. The Domain Name:**

fccenvironment.co.uk

**3. Procedural History:**

A Complaint in respect of < fccenvironment.co.uk> (the “Domain Name”) under Nominet UK’s Dispute Resolution Service Policy (“the Policy”) was received from the Complainant on July 22, 2011 and forwarded to the Respondent by Nominet next day. A Response was received from the Respondent on August 12, 2011 and

the Complainant lodged a Reply on August 22, 2011. An unsuccessful mediation was concluded on September 12, 2011.

On September 20, 2011 the undersigned Alan L. Limbury was appointed as Independent Expert to determine the dispute in accordance with Nominet's Procedure for the conduct of proceedings under the Dispute Resolution Service (the "Procedure"). I confirmed to Nominet that I am independent of the parties and know of no facts or circumstances that might call into question my independence or impartiality in the eyes of the parties.

#### **4. Factual Background**

The Complainant is an international environmental service company operating in many countries, including the UK. It registered the stylized initials FCC as European Community trademarks, Nos. 3669868 on May 24, 2005 and 597302 on November 27, 1998 and the domain name <fccenvironmental.com> on December 19, 2007. Its UK subsidiary, Waste Recycling Group Ltd, registered the domain name <fccenvironmental.co.uk> on September 7, 2010.

On June 28, 2011 in London, the Chairman of the Complainant announced to the annual meeting of the Spanish Chamber of Commerce in Great Britain that the Complainant would combine all of its UK services businesses, including Waste Recycling Group Ltd, under the brand "FCC Environment".

The announcement was publicised by the Complainant in a Press Release the following day, June 29, 2011. That same day the Respondent, trading as "eden environmental", registered <fccenvironment.co.uk> and <fccenvironment.com> ("the two domain names"), the latter not being the subject of these proceedings but being mentioned in the parties' communications with each other and in their submissions in these proceedings.

Companies House records show Eden Environmental Limited as a dormant company, having been incorporated on April 2, 2008 as a business and management consultancy with the Respondent, described as "environmental consultant", as its sole director.

Over the following two days telephone conversations took place between representatives of the Complainant and the Respondent, the substance of which is disputed. The Complainant's version is that the Respondent made it clear that he had read the Press Release before registering the two domain names for the sole purpose of selling them to the Complainant and that he wanted £10,000 for them. The Respondent denies the Complainant's version and says he made it clear the two domain names were needed for a website and were not for sale, "not even for five thousand pounds".

In an email response to a letter dated July 1, 2011 from the Complainant's solicitors seeking transfer of the two domain names and offering compensation of £400, the Respondent, on July 4, 2011, denied infringement of the Complainant's rights, said he was unaware of FCC or the rebranding exercise, and offered to transfer the two domain names for £5,000.

As at 7 July 2011, the Domain Name resolved to a website stating on its 'Home' page:

"Forecasting Climate Change effects on the Environment"

"This blog aims to encourage [sic] discussion on strategy and policy for government, organisations and business focusing on the impacts of climate change".

## 5. Parties' Contentions

### Complainant

The Complainant says the Domain Name is confusingly similar to the Complainant's domain name registrations and that its dominant and distinctive component is identical to the term FCC in which the Complainant has rights.

The Domain Name is an Abusive Registration because:

- (a) the Respondent has admitted that the two domain names were registered for the purpose of selling them to the Complainant for valuable consideration in excess of the costs of registration;
- (b) the Respondent has engaged in a pattern of conduct against the Complainant by registering two separate and almost identical domain names;
- (c) the Respondent has admitted that the two domain names were registered primarily for the purpose of disrupting the business of the Complainant, a competitor of the Respondent; and
- (d) the Respondent has intentionally sought to create confusion between its business and the Complainant's for commercial gain, since consumers are likely to assume, or be confused into believing, that the two domain names are owned or operated by the Complainant.

### Respondent

The Respondent denies the substance of the conversations as alleged by the Complainant and says the registration of the Domain Name was to facilitate the creation of a personal blog entitled: *Forecasting climate change effects on the environment*. This is a bit of a mouthful for a website title, and after a suitable search, <www.fccenvironment.co.uk> was found to be the most appropriate.

The Respondent had never heard or known of the Complainant (a Spanish company) until he received the letter from the Complainant's solicitor. He had previously known of a company called Waste Recycling Group. In responding to the letter, the Respondent explained that he had not been aware of FCC/WRG and their branding exercise. After learning of the Complainant, he offered to transfer the two domain names as a gesture of goodwill, should an alternative be available for his use and adequate compensation be offered. This is not cybersquatting or abusive registration. The Respondent denies registering the Domain Name to

either subvert the business operations of FCC/WRG or to extort money by selling it back to them.

There is no confusion, intended or apparent; no abusive registration; no trade mark infringement and no passing off. Under the Nominet regulations, the Complainant has no right to the Domain Name and the Respondent has every right to the Domain Name. The Respondent is not cybersquatting. The registration is not abusive. The Domain Name is used in a personal capacity. No goods or services are offered or supplied from the Domain Name.

### Complainant's Reply

The Respondent's version of events is highly implausible and disingenuous. The Response is directly contradicted by the Respondent's own correspondence.

The Respondent fails to explain or provide any evidence as to what searches he conducted nor their results. The very least searches he could have conducted would have definitely placed him on notice.

The only reasonable inference to draw is that the Respondent had heard of the announcement that WRG was to be rebranded as FCC ENVIRONMENT, and then carried out a WHOIS search or the like to identify what remaining domain names with FCC ENVIRONMENT as an element had not by then been registered by the Complainant. Accordingly, such a "...suitable search..." would have been geared solely to the Respondent establishing a means by which to make money out of the Complainant from opportunistic registrations.

The Respondent's version of the telephone conversations is not credible. The evidence shows that from the very day when the registration occurred, the Respondent has been seeking to sell the two domain names to the Complainant but only if the Complainant felt compelled to pay a very considerable sum.

The Respondent uses the Domain Name containing the Complainant's FCC mark in relation to the provision of information about the Complainant's core sector, the environment. The average consumer will accordingly assume there is an economic link between the operator of the website and the Complainant. The Domain Name is accordingly liable to affect the function of the Complainant's trade mark as an indication of origin.

## **6. Discussions and Findings**

Under paragraph 2 of the Policy, a complainant is required to show, on the balance of probabilities, that:

- (1) it 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.

### Rights

“Rights” are defined in 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 Complainant clearly has rights in the registered trademark FCC and a reputation in the environmental field. I find that the Domain Name is similar to that mark, since the word “environment” does nothing to detract from the distinctiveness of the FCC mark but rather serves to reinforce it, by describing the very business that the mark evokes. The Complainant has established this element.

### Abusive Registration

Abusive Registration is defined in the Policy as:

“...a domain name which either;

- (i) was registered or otherwise acquired in the manner which, at the time when the registration or acquisition took place, took unfair advantage of, or was unfairly detrimental to the Complainant’s rights; or
- (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

Paragraph 3(a) of the Policy provides a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. These include:

- (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;

On the basis of the parties’ assertions, it is not possible for this Panel to resolve the conflict between them as to what was said in the disputed telephone conversations. Nor is it necessary to do so, since the failure of the Respondent, an environmental consultant since at least 2008, to explain the timing of his registration of the Domain Name - the very day on which the Complainant issued

a Press Release announcing the rebranding of its UK operations as FCC Environment – and the Respondent’s failure to produce any evidence that, prior to that announcement, he had a plan to establish a blog under the Domain Name, lead the Panel to conclude that, contrary to his denials, he did indeed have prior knowledge of the Complainant and of the Press Release, and that he registered the Domain Name primarily as a blocking registration against the Complainant’s FCC mark or for the purpose of unfairly disrupting the business of the Complainant.

Accordingly the Panel finds that the registration is an Abusive Registration.

## **7. Decision**

I find that the Complainant has proved, on the balance of probabilities, that it has rights in a mark which is similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. I therefore direct that the Domain Name be transferred to the Complainant.

**Signed** Alan Limbury

**Dated** October 9, 2011