

DISPUTE RESOLUTION SERVICE

D00010247

Decision of Independent Expert

Edward Platts t/a Timefactors

and

Mr Martin Schneider

1. The Parties:

Lead Complainant: Edward Platts t/a Timefactors
38 Swanbourne Road
Sheffield
South Yorkshire
S5 7TL
United Kingdom

Respondent: Mr Martin Schneider
Bahnhofstrasse 2
Bielo
CH
2505
Switzerland

2. The Domain Name(s):

precista.co.uk

3. Procedural History:

01 September 2011 14:10 Dispute received
01 September 2011 16:22 Complaint validated
01 September 2011 16:24 Notification of complaint sent to parties
09 September 2011 10:20 Response received
09 September 2011 11:15 Notification of response sent to parties

12 September 2011 09:16 Reply received
12 September 2011 09:17 Notification of reply sent to parties
12 September 2011 09:17 Mediator appointed
19 September 2011 14:04 Mediation started
29 September 2011 11:17 Mediation failed
29 September 2011 11:39 Close of mediation documents sent
03 October 2011 12:16 Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 23 December 2010.

Based on the parties' submissions (see section 5 below) and a review of the materials annexed to the Complaint, set out below are the main relevant facts which I have accepted as being true in reaching a decision in this case:

- (1) The Complainant has traded in specialist watches, both in the UK and internationally, since around 1996.
- (2) The Complainant has a UK trade mark registration for Precista, covering horological instruments (including watches) and dating from September 2003.
- (3) The Complainant has used the Precista name from around September 2004 to date.
- (4) The Respondent is the director of a Swiss company, M7 GmbH ("M7").
- (5) The website *www.precista.com* is connected with M7, and advertises PRECISTA watches, which have no connection with the Complainant.
- (6) M7 filed an International trade mark application, which designated several European countries but omitted the UK.

There is currently no active website at www.precista.co.uk, just a page which states that the website is under construction.

5. Parties' Contentions

Complaint

The Complainant's submissions are as follows:

The Complainant has rights in the Domain Name because:

- (1) The Complainant is a sole trader trading under the name "Time Factors", exclusively online at the address www.timefactors.com.

- (2) The Complainant has been commercialising high-value specialist watches under several brands, in the UK and internationally, online since 1996.
- (3) The Complainant registered the domain timefactors.com on 9 November 1998 and has been continuously commercialising high-value specialist watches under several brands, in the UK and internationally, on a website at that domain since that date. (A print-out of the website from November 1999 is exhibited.)
- (4) The Complainant successfully registered the word mark "Precista" as a UK trade mark (no.2344060) on 23 September 2003 in class 14 in connection with "horological instruments" (including watches). This UK registered trade mark is presently in force. (An extract of the UK Register of Trade Marks is exhibited.)
- (5) The Complainant first marketed a watch model "PRS 53" under the mark "Precista" on his website, and introduced a "Precista" range page (www.timefactors.com/precista.htm) on his website, on or around 4 September 2004. (A print-out of the website from September 2004 is exhibited, together with an independent review from the website www.watcharoo.co.uk.)
- (6) The Complainant has been consistently and continuously using the mark "Precista" in the course of trade since that date, in connection with advertisement and sales of watches in the UK and internationally. (A print-out of the website from November 2005 is exhibited, together with the full Precista section from the Complainant's website as at August 2011.)
- (7) The home page of the www.timefactors.com website and the Precista range section at www.timefactors.com/precista.htm, both advertising goods bearing the Precista mark, as well as UK trade mark (no.2344060), have all been in the beneficial ownership of, and continuously used to date by, the Complainant since the introduction of the Precista range on 4 September 2004, with increasing success.
- (8) The Complainant and his marks, including the Precista mark, have acquired very extensive goodwill, both in the UK and overseas, from customers and collectors of the types of watches in which timefactors.com specialises, as any search for his name and/or the Precista mark in connection with watches will immediately prove, using any search engine.
- (9) In the UK alone, and for watches sold under the Precista mark alone, the Complainant has achieved sales of approximately £300,000 between 2004 and 2011. Considering the highly specialised and niche nature of the Complainant's market, this is a considerable mark of success and indication of goodwill. (A UK sales analysis table is exhibited.)
- (10) The combined evidence shows uninterrupted use of the mark "Precista" for commercial purposes, in connection with watches, over a period of nearly 8 years, beginning on 23 September 2003, by the Complainant.

- (11) Consequently, the Complainant owns (i) an unregistered trade mark right in "Precista"; (ii) a registered right under the UK Trade Marks Act 1994 as amended, both rights in connection with the commercialisation of watches.

The Domain Name in the hands of the Respondent is abusive because:

- (1) The Respondent registered the domain name "precista.co.uk" on 23 December 2010, over 7 years after the Complainant began uninterrupted use of the mark "Precista" for commercial purposes on the Internet, and after the Complainant registered the trade mark Precista in the UK (both accruing to the benefit of the Complainant). (Nominet details of the precista.co.uk domain name are exhibited.)
- (2) The Respondent is Mr Martin Schneider, a Swiss resident and the sole director of M7 GmbH, a Swiss company. Reference is made to the cached moneyhouse website page printout (which is exhibited).
- (3) Neither Mr Schneider nor M7 GmbH are associated with the Complainant in any way, however M7 GmbH has recently begun retailing high-value specialist watches under the mark "Precista" on or via several websites:
- (a) The domain name precista.com is owned by a Swiss Respondent and the single page website at this domain is believed to be owned and/or under the control of Mr Schneider/M7 GmbH, according to reference to M7 GmbH on the page footer. (A print-out of the website page is exhibited.)
- (b) The milwatches.com link on the www.precista.com page redirects to a selection of Precista marked watches advertised for sale on the website at the domain www.milwatches.com. This online retailer is believed to be a distributor of Mr Schneider/M7 GmbH products. (Print-out of pages from the www.milwatches.com website are exhibited.)
- (c) One of the watches on the www.milwatches.com website is the "PRECISTA GMT GTLS Blue – Nato Strap". This same watch is the subject of a recent independent review (May 2011) by a purchaser (a printout of which is exhibited).
- (4) M7 GmbH filed an international trade mark application under the Madrid Protocol, number 1077246, for the mark Precista in class 14 for, inter alia, timepieces and chronometric instruments. (An extract of the International Register of Trade Marks is exhibited.) This international trade mark application claims the priority of an earlier Swiss trade mark, no.609564 filed on 13 December 2010, therefore the international trade mark application is deemed to have been filed on 13 December 2010.
- (5) M7 GmbH omitted the UK from the list of designations in the application. In view of the designation of very many other EU Member States, such as France, Germany and Italy for instance, this omission is manifestly deliberate. The Respondent knew, or was advised, that the Complainant's earlier right, registered UK trade mark 2344060, would prevent the eventual

registration of the UK designation of his international trade mark application.

- (6) There is therefore no doubt that, at least as early as 13 December 2010, thus before the Respondent registered the domain precista.co.uk, the Respondent knew about the Complainant's earlier rights in the UK.
- (7) The mark Precista, which forms the main part of the disputed domain name, is used by the Respondent as a mark in the course of trade, in connection with advertisement and sales of watches on several websites (see above).
- (8) The website currently shown at the disputed domain name is an ISP or Respondent placeholder page. The message on the website is in German. The Complainant states that, translated into English, this advises that the domain name is unavailable and a website is "under construction". (A printout of the website at the disputed domain name is exhibited.)
- (9) Save as to the TLD (.co.uk), the disputed domain name is entirely identical to the Complainant's mark. In view of the above information about the Respondent, his company and their activities, it is clear that the disputed domain name can only correspond to one (or both) of two situations:
 - (a) an abusive registration intended to prevent the Complainant from registering the disputed domain name for commercial purposes; or
 - (b) an abusive registration intended to use the Complainant's mark for the same purpose in connection with identical goods, thereby infringing the Complainant's registered and unregistered rights in the UK.
- (10) Moreover, the mark Precista within the disputed domain name is identical to UK registered trade mark 2344060 and, again in view of the above information about the Respondent, his company and their activities, it is clear that it will eventually be used for commercial gain in connection with the supply of identical goods, all within the meaning of Section 10(1) of the Trade Marks Act 1994 as amended, which relates to direct infringement of a registered trade mark in the UK.
- (11) A serious likelihood of confusion exists on the part of the UK public between the Complainant's mark and the identical mark used by Mr Schneider/M7 GmbH, therefore the disputed domain name. The independent review [referenced under (3)(c) above] makes clear and frequent comments in this context.
- (12) The Complainant believes that the goodwill it has acquired in its Precista mark since September 2003, through its trading activities and permanent online presence, is being damaged by the continued use of the identical mark Precista within the disputed domain name www.precista.co.uk. Moreover, having regard to the circumstances created by the Respondent's conduct since December 2010, this situation constitutes a cause of action under the tort of passing off.

Response

The Respondent filed the following response:

- (1) All statements made in the Complaint are denied, despite the fact that the Complainant owns a UK trade mark "PRECISTA" registered for its "horological instruments". Considering this, the Complainant's exclusive right to use the word "PRECISTA" is limited to the territory of the UK and to the goods "horological instruments".
- (2) The domain name *precista.co.uk* is actually not used, especially not for "horological instruments". Given this, the sole fact that the Respondent owns *precista.co.uk* does not affect the Complainant's trade mark rights in the UK. Besides the mentioned trade mark, the Complainant has no exclusive rights on the name "PRECISTA". Therefore [there is] no legal basis for an abusive registration.

Reply

The Complainant's submissions in reply are as follows:

- (1) The Reply does not add any new arguments or new evidence, and simply seeks to clarify the following facts, for the benefit of Mr Schneider and/or his adviser, who may have difficulty with the English language and/or the present procedure.
- (2) The following facts are entirely clear, in the specifics of the Complaint, in the text of the Complaint, and throughout the evidence adduced in support of the Complaint.
- (3) The Complainant owns the sole UK registered trade mark for the word "Precista", and therefore owns a registered exclusive right in that word in the UK. This fact is irrefutable, as evidenced by a relevant extract of the UK Register of Trade Marks.
- (4) The Complainant owns extensive goodwill in the word "Precista" in the UK, both as the above registered trade mark and as a mark used in the course of trade, and therefore also owns an unregistered exclusive right in the word "Precista" in the UK. This fact has been proven by evidence.
- (5) The fact that the Complainant has used the word "Precista" in the course of trade essentially in connection with "horological instruments" is neither here nor there: no third party has used this word for any purpose in the UK since the Complainant first registered the mark in 2003 and first retailed watches under the mark in 2004. Moreover, other than as a geographical location overseas, the word "Precista" has no specific or generic meaning in any language, and certainly not in English. The word "Precista" is therefore a strong mark, solely associated in the UK with the Complainant.

- (6) The Complainant notes the clear and unambiguous acknowledgement by the Respondent that exclusive rights exist in the word "Precista" in the UK. This is contrary to the Respondent's closing comment, to the effect that the Complainant has no exclusive rights on the name Precista".
- (7) The abusive character of the registration has been proven by evidence and the case is clearly made out. The fact that the precista.co.uk domain is "actually not used" is irrelevant, considering:
- (a) the recent activities of the Respondent in connection with the word "Precista", which he only began using in the course of trade in other jurisdictions recently, very many years after the Complainant, and for goods that are identical to those marketed by the Complainant,
 - (b) the similarly recent "precista.com" domain also owned by the Respondent and which is actually used in the course of trade for goods that are identical to those marketed by the Complainant, very many years after the Complainant,
 - (c) there can be no logical purpose or explanation for the domain registration by the Respondent, other than for eventually using the domain in the course of trade, for goods that are identical to those marketed by the Complainant, thus abusing the Complainant's exclusive rights in the UK.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).*

Complainant's Rights

In light of the factual findings set out in section 4 above, the Complainant has Rights in the name Precista, consisting of his UK trade mark registration and also legally protectable goodwill in the name as a consequence of having used that name in trade for 7 years. Disregarding the generic .co.uk suffix, the Domain Name is identical to the name and mark in which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the 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."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The main factors under paragraph 3a on which the Complainant actually or implicitly relies in this case are as follows:

- "i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A.;*
 - 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"*

The Complainant has traded in Precista branded watches since 2004, both in the UK and internationally. As a consequence, many of the relevant customer base will associate the Precista name with the Complainant's business, a conclusion which is corroborated by the independent review of the Respondent's Precista watch which is exhibited to the Complaint. This review includes the following:

"This is not a Precista as many readers will know it; this watch has been conceived and manufactured by a company other than Timefactors [the Complainant's trading name]"

The fact that the Respondent, through his company M7, is advertising its Precista branded watches (which have no connection with the Complainant's watches) through the website www.precista.com is inherently likely to confuse people into mistakenly believing that there is a connection with the Complainant. Of course that likelihood of confusion arises from the .com domain name and website. However, in light of that website, it is reasonable to conclude, and I do conclude, that the Respondent also intends to use the Domain Name for the same purpose,

and that this will lead to a likelihood of people being similarly misled. In fact, the likelihood of confusion being caused by the Respondent operating a website for watches at www.precista.co.uk is higher, given that it would create an obvious connection with the UK, which is where the Complainant's business is based. On the basis of that conclusion, the factor under paragraph 3aⁱⁱ of the Policy (as set out above) applies.

Even if, which in my view is unlikely, the Respondent registered the Domain Name without any intention to use it for advertising and/or selling Precista watches, it would in that case be a fair inference that the Respondent registered the Domain Name as a blocking registration or to disrupt unfairly the Complainant's business. In other words, the factor under paragraph 3aⁱ of the Policy would apply. I say this because, on the balance of probabilities, I find that the Respondent was aware of the Complainant's business and use of the Precista name at the time when he registered the Domain Name. The Precista name is an unusual one. It has been used by the Complainant for watches over the last 7 years and, since the Respondent has also started using it for watches, it is unlikely that he would have been unaware of the Complainant. This conclusion is reinforced by the Domain Name being a UK domain and the Complainant's business being based in the UK. It is also to be noted that the Respondent has not sought to suggest otherwise in the Response.

In this regard, the Complainant refers to the Respondent having filed an International trade mark application, which designates several EU countries, but not the UK. The Complainant argues that this in itself demonstrates that the Respondent was aware of his business at the time when the Respondent registered the Domain Name. In fact, the Respondent did not file his International trade mark application until April 2011, i.e. after the Domain Name was registered. Nevertheless, this evidence does suggest that the Respondent was aware of the Complainant four months after he registered the Domain Name, and also lends support to the conclusion which I have reached that he was also aware of the Complainant at the time when the Domain Name was registered.

Taking all of the above into account, the registration (and threatened use) of the Domain Name takes unfair advantage of, and is unfairly detrimental to the Complainant's Rights. I find that the Domain Name is therefore an Abusive Registration.

7. Decision

Having found that the Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *precista.co.uk* be transferred to the Complainant.

Signed: Jason Rawkins

Dated: 25 October 2011