

DISPUTE RESOLUTION SERVICE

D00010293

Decision of Independent Expert

Mr Christopher Denzil Whitmarsh

and

Mr. Michael Forster Amann

1. The Parties:

Lead Complainant: Mr Christopher Denzil Whitmarsh
Homefields
Hinton Blewitt
Bristol
BS39 5AS
United Kingdom

Respondent: Mr. Michael Forster Amann
41 Rothwell Road
Newcastle upon Tyne
NE3 1TY
United Kingdom

2. The Domain Name:

bubblychampagnecompany.co.uk
thebubblychampagneco.co.uk

("the Disputed Domain Names")

3. Procedural History:

The Complaint was filed with Nominet on 16 September 2011. Nominet validated the Complaint on 19 September 2011 and notified the Respondent by post and by

email, stating that the Response had to be received on or before 10 October 2011. The Respondent filed a Response on 5 October 2011 and Nominet notified the Complainant that a Reply had to be received on or before 13 October 2011. The Complainant filed a Reply on 12 October 2011.

The informal Mediation procedure failed to produce an acceptable solution for the parties and so, on 8 December 2011, Nominet informed the Complainant that it had until 22 December 2011 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy").

The Complainant paid the required fee within the timescale and Nominet therefore proceeded to appoint the next available expert.

On 28 December 2011 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he knew no reason why he could not properly accept the invitation to act as an Expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties which might appear to call in question his independence and/or impartiality.

4. Factual Background

Complainant

The Complainant is Mr Christopher Denzil Whitmarsh, Director of The Bubbly Champagne Company Ltd, a champagne-selling UK private limited company incorporated on 26 January 2010.

On 20 January 2010 the Complainant filed for a UK trade mark in the term THE BUBBLY CHAMPAGNE CO (number 2536994), which was registered on 18 March 2011.

Since November 2009, the Complainant has exhibited his company's champagne-selling business in various trade shows under the name THE BUBBLY CHAMPAGNE CO.

The Complainant registered the domain name <thebubblychampagnecompany.co.uk> on 3 August 2009, which resolves to the www.thebubblychampagnecompany.co.uk website currently used by the Complainant.

Respondent

The Respondent has been trading under the name Lovely Bubbly since around 2005, also selling champagne.

The Respondent uses the domain name <lovelybubbly.co.uk> to point to its www.lovelybubbly.co.uk website. This domain name was registered on 25 May 2005.

The Disputed Domain Names were registered on 9 December 2009 (<bubblychampagnecompany.co.uk>) and on 3 February 2010 (<thebubblychampagneco.co.uk>).

The Disputed Domain Name <bubblychampagnecompany.co.uk> has previously been used by the Respondent to re-direct Internet users to his website www.lovelybubbly.co.uk, as evidenced by the Respondent's solicitor's letter dated 29 July 2011.

The Disputed Domain Names are currently both pointing to a registrar holding page containing sponsored links to websites of competitors of the Complainant.

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant argues that the Disputed Domain Names' essential identifying features are identical to the distinctive components of the Complainant's trade mark in the term THE BUBBLY CHAMPAGNE CO and its company name The Bubbly Champagne Company Limited:

- the Disputed Domain Name <thebubblychampagneco.co.uk> contains the Complainant's trade mark THE BUBBLY CHAMPAGNE CO and its company name The Bubbly Champagne Company Limited in its entirety.
- the Disputed Domain Name <bubblychampagnecompany.co.uk> is quasi identical to the Complainant's trade mark THE BUBBLY CHAMPAGNE CO and to its company name The Bubbly Champagne Company Limited, the Respondent having used the term COMPANY rather than its commonly used abbreviation "CO".

Besides, the Complainant claims the Disputed Domain Names' essential identifying features to be identical to the distinctive components of the Complainant's "*trading style THE BUBBLY CHAMPAGNE CO*".

Abusive Registration

The Complainant explains that it operates, through its company The Bubbly Champagne Company Ltd, a champagne-selling business, and that the websites to which the Disputed Domain Names resolve point to a registrar holding page containing sponsored links to websites of competitors of the Complainant, as evidenced by the printouts made by the Complainant on 16 September 2011.

The Complainant has also produced evidence that the Disputed Domain Name <bubblychampagnecompany.co.uk> has previously been used by the Respondent to re-direct Internet users to its website www.lovelybubbly.co.uk.

The Complainant argues that the Disputed Domain Names are abusive for the following reasons:

The Complainant argues that the trade mark and company name THE BUBBLY CHAMPAGNE CO is properly and uniquely associated with the Complainants in the United Kingdom. The Respondent is a Director of the company Lovely Bubbly Ltd and trades in the same field as the Complainant. It is clear to the Complainant that the Respondent is aware of the Complainant's trading activities in the United Kingdom, as evidenced by the Respondent's solicitor's letter dated 29 July 2011.

The Complainant further argues that the Respondent has registered the Disputed Domain Names in order to benefit from the traffic on the Internet of potential consumers conducting searches for the Complainant's business under www.thebubblychampagne.co.uk and www.bubblychampagnecompany.co.uk search parameters, with subsequent damage to the Complainant's business for the following reasons:

- the Respondent's original intention when registering the Disputed Domain Names was to direct traffic to its own website www.lovelybubbly.co.uk, as evidenced by the Respondent's solicitor's letter dated 29 July 2011.
- the websites to which the Disputed Domain Names resolve display numerous hyperlinks which directly compete with the Complainant's goods, which will disrupt the Complainant's business by diverting business away from the Complainant.

The Complainant explains that such use of the Disputed Domain Names will confuse customers as to the affiliation, sponsorship, or endorsement of the goods advertised on the Respondent's websites. The Complainant further asserts that the Respondent presumably profits from this confusion by receiving click-through referral fees for each redirected Internet user. Such use is prima facie evidence that the Disputed Domain Names are abusive registrations.

The Complainant further asserts that the Respondent registered and is using the Disputed Domain Names in the full and conscious knowledge that:

- the registration and use of the Disputed Domain Names are likely to cause confusion and to deceive customers into mistakenly believing that the Respondent's Disputed Domain Names and websites are offered, authorised, or are sponsored by the Complainant or otherwise affiliated with the Complainant,
- as a consequence of the Respondent's registration and use of the Disputed Domain Names, the Complainant's business will be unfairly disrupted by the redirection of Internet users, which will deprive the Complainant of Internet traffic rightly intended for its website,

- by registering and using the Disputed Domain Names the Respondent is misappropriating the Complainant's goodwill solely for its value derived from THE BUBBLY CHAMPAGNE CO trade mark and name,
- the Respondent will be blocking the Complainant from registering a name in which the Complainant has rights, and
- by registering and using the domain name in this manner, the Respondent's actions are unfairly detrimental to the Complainant's rights in THE BUBBLY CHAMPAGNE CO trade mark and name.

The Complainant further explains that there is no innocent explanation as to why the Respondent should have chosen to adopt the Complainant's trade mark and company name THE BUBBLY CHAMPAGNE CO other than to the detriment of the Complainant. The Complainant is unable to think of any good reason why the Respondent could reasonably be said to have any legitimate rights or interest in the Disputed Domain Names.

Besides, the Complainant argues that the Respondent is not using the Disputed Domain Names in connection with a genuine offering of goods or services, that the Respondent has not been concurrently known by the Disputed Domain Names, and that the Respondent has provided no legitimate non-commercial or fair use of the Disputed Domain Names.

The Complainant further asserts that the Respondent offered to sell the Disputed Domain Names to the Complainant for the sum of £3,000 per Domain Name, as is evidenced by the Respondent's solicitor's letter dated 11 August 2011.

Response

Although the Respondent mistakenly refers in its Response to one of the Disputed Domain Names as <thebubblychampagnecompany.co.uk> (the domain name used by the Complainant), there is no doubt, given the nature of the Response and the surrounding facts and circumstances, that the Respondent made a typographic error and was referring to the Disputed Domain Name <bubblychampagnecompany.co.uk>.

The Respondent asserts, by referring to the arguments set out in its solicitor's letter dated 29 July 2011, that the Complainant replicated the Respondent's champagne-selling business, carried out via the company Lovely Bubbly Ltd and the websites www.lovelybubbly.co.uk and www.lovelybubbly.com, by using the word BUBBLY in its company name and by choosing to directly mimic the Respondent's stand layout, exhibition format and marketing material. The Respondent explains that he therefore registered the Disputed Domain Names in defence of his business.

Besides, the Respondent argues that the Disputed Domain Names were registered prior to the incorporation of The Bubbly Champagne Company Limited, the registration of THE BUBBLY CHAMPAGNE CO as a trade mark and the Complainant's website going live. The registration of the Disputed Domain Names

aimed to protect the search engine optimization (SEO) work he had commissioned to raise the profile of the keywords LOVELY, BUBBLY and CHAMPAGNE.

The Respondent further argues that it offered a solution to the Complainant by offering to sell him the Disputed Domain Names in his solicitor's letter dated 11 August 2011.

The Respondent further claims that there is a pending passing off action between the Complainant and the Respondent

Reply

In addition to the information contained within the Complaint, the Complaint adds the following additional points:

- The Complainant denies the Respondent's claim that the Complainant commenced a business replicating the Respondent's business, and attached to its Complaint a selection of photographs showing the Complainant's stand at various events the Complainant has attended to demonstrate that the material used is generic.
- The Complainant asserts that the Respondent's objection to the adoption of the Complainant's use of the word BUBBLY in relation to its champagne-selling business is unsustainable. The word BUBBLY is a common word for champagne in the United Kingdom. The Respondent trades under the business name LOVELY BUBBLY LIMITED and the fact that the Respondent argued that it registered the Disputed Domain Names to protect his business is an admission that the Disputed Domain Names are abusive registrations.
- The Complainant explains that the Respondent's statement that the Disputed Domain Names were registered in December 2009, prior to the incorporation of Bubbly Champagne Company Limited and the registration of THE BUBBLY CHAMPAGNE CO as a trade mark, is superfluous. The Complainant commenced trading under The Bubbly Champagne Co name in November 2009. The Respondent was clearly aware of the Complainant's business, as its solicitor's letter dated 29 July 2011 shows, and has registered the Disputed Domain Names as a means of diverting legitimate trade from a competitor.
- The Complainant argues that the Respondent's statement that it has offered the Disputed Domain Names to the Complainant for a sum of £3,000 per Domain Name is prima-facie evidence that the Disputed Domain Names are abusive.
- The Complaint denies the Respondent's contention that there is a pending passing off action, and asserts that there are no legal proceedings between the parties. There was a threat of proceedings against the Complainant from the Respondent in 2009, which resulted in the Complainant removing

the wording "hand crafted quality champagnes" from the Complainant's literature, but this was done on a voluntary basis and without prejudice.

6. Discussions and Findings

General

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of a domain names, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"(i) The Complainant 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."

Complainant's rights

The Policy defines Rights as *"rights enforceable by the Complainant, whether under English law or otherwise"*.

In this case, the Complainant has provided evidence that it owns a UK registered trade mark in the term THE BUBBLY CHAMPAGNE CO (see the Factual Background at Section 4 above), and so has proved that it has Rights as defined by the Policy.

The Policy also stipulates that the name or mark in which the Complainant has rights (THE BUBBLY CHAMPAGNE CO) must be identical or similar to the Disputed Domain Names (<thebubblychampagneco.co.uk> and <bubblychampagnecompany.co.uk>). It is accepted practice under the Policy to discount the .CO.UK suffix.

- The Disputed Domain Name <thebubblychampagneco.co.uk>

There is no difference between the Disputed Domain Name <thebubblychampagneco.co.uk> and the Complainant's trade mark. The Complainant's trade mark and the Disputed Domain Name <thebubblychampagneco.co.uk> are thus identical to one another.

- The Disputed Domain Name <bubblychampagnecompany.co.uk>

The only difference between the Disputed Domain Name <bubblychampagnecompany.co.uk> and the Complainant's registered trade mark is the omission of the non distinctive term THE, and the abbreviation of the term COMPANY to "CO". The omission of the non distinctive term THE does not serve to distinguish the Domain Name from the Complainant's trade mark, and as the term "CO" is the abbreviated form of the term COMPANY, this does not create any new meaning or distinctiveness. The Complainant's trade mark and the Disputed Domain Name <bubblychampagnecompany.co.uk> are thus similar to one another.

As a result the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and the Complainant has Rights in respect of a mark which is identical or similar to the Disputed Domain Names.

Abusive registration

Moving on to paragraph 2(a)(ii) of the Policy, Abusive Registration is defined in paragraph 1 of the Policy to mean a domain name which:

"(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(a) of the Policy provides a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. In the Expert's opinion, paragraphs 3(a)(i)(C) and 3(a)(ii) are of relevance in this case, as follows:

- *The Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 3(a)(i)(C))*

As far as paragraph 3(a)(i)(C) is concerned, the Respondent's Response and the facts of the case show that the Respondent was obviously aware of the Complainant, as well as its trade name and business, when he registered the Disputed Domain Names. In this regard, it is not relevant that the Disputed Domain Names were registered prior to the incorporation of the Complainant's company and to the registration of the corresponding trade mark. What matters is that the Registrant knew of the Complainant and of his business.

The Disputed Domain Names are very similar to the trade name used by the Complainant at various trade shows since November 2009 and to the Complainant's company name, and the Respondent acknowledged that he had registered the Disputed Domain Names as a defence of his business after noticing that the Complainant had replicated its champagne-selling business.

It is therefore difficult to think of a plausible explanation as to why the Respondent would have chosen to register Domain Names so similar to the Complainant's trade name and company name if it was not in order to unfairly disrupt the Complainant's business by benefitting from the traffic on the Internet of potential consumers conducting searches for the Complainant's business under www.thebubblychampagneco.co.uk and www.bubblychampagnecompany.co.uk. The Complainant registered his domain name <thebubblychampagnecompany.co.uk> on 3 August 2009, and it is clear that the Respondent was aware of such registration when he decided to register the two very similar Disputed Domain Names, shortening in one of them the term COMPANY to "CO", and omitting in the other the term "THE". By registering the

Disputed Domain Names, the Respondent clearly intended to anticipate potential errors made by Internet users when searching for the Complainant's website.

This is further evidenced by the fact that the Disputed Domain Name <bubblychampagnecompany.co.uk> has previously been used by the Respondent to re-direct Internet users to its website www.lovelybubbly.co.uk, and by the fact that the websites to which the Disputed Domain Names currently resolve display numerous hyperlinks which directly compete with the Complainant's business. This is classic cybersquatting, given the nature of the Disputed Domain Names.

The Expert is therefore satisfied that the Respondent has chosen to register the Disputed Domain Names to unfairly disrupt the Complainant's business.

- *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 (paragraph 3(a)(ii)).*

As far as paragraph 3(a)(ii) is concerned, the Respondent, in the Expert's view, has registered the Disputed Domain Names in order to confuse potential consumers conducting searches for the Complainant's business into believing that the Disputed Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant.

In the Expert's view, the similarity of the Disputed Domain Names to the Complainant's trade mark, company name and trade name lead Internet users conducting searches for the Complainant to assume that the Disputed Domain Names are in some way associated with the Complainant. Indeed, the terms BUBBLY, CHAMPAGNE and COMPANY in the Disputed Domain Names, when combined, become distinctive of the Complainant and his business, even though used separately they may be descriptive.

Besides, the fact that the Respondent previously used the Disputed Domain Name <bubblychampagnecompany.co.uk> to re-direct Internet users to its website www.lovelybubbly.co.uk is further evidence that the Respondent intended to use the Disputed Domain Names to give the false impression that the Domain Names are associated with the Complainant, especially since the Respondent conducts the same type of business as the Complainant on its website.

The Expert is therefore satisfied that the Respondent has chosen to register the Disputed Domain Names to confuse people or businesses into believing that the Disputed Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant.

Finally, it should be noted that this decision only relates to the Disputed Domain Names and that the parties are free to file an action in an appropriate forum concerning passing off or any other cause of action that they may have concerning their competing businesses.

7. Decision

In light of the above findings, namely that the Complainant has Rights in a mark which is identical to the Disputed Domain Names, and that the Disputed Domain Names, in the hands of the Respondent, are Abusive Registrations, the Expert directs that the Disputed Domain Names be transferred to the Complainant.

Signed: David Taylor

Dated: 23 January 2012