

## DISPUTE RESOLUTION SERVICE

D00010738

### Decision of Independent Expert

Schlüter-Systems Ltd

and

Mr Robert Wilkins

#### 1. The Parties:

Complainant: Schlüter-Systems Ltd  
Units 4-6 Bardon 22  
Beveridge Lane  
Coalville  
Leicestershire  
LE67 1TE  
United Kingdom

Respondent: Mr Robert Wilkins  
1 Hatfield Close  
London  
IG6 2JJ  
United Kingdom

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

ditramatting.co.uk

### **3. Procedural History:**

10 January 2012 14:29 Dispute received  
11 January 2012 13:33 Complaint validated  
11 January 2012 13:36 Notification of complaint sent to parties  
16 January 2012 08:20 Response received  
16 January 2012 08:20 Notification of response sent to parties  
19 January 2012 01:30 Reply reminder sent  
23 January 2012 08:02 Reply received  
23 January 2012 08:08 Notification of reply sent to parties  
23 January 2012 08:08 Mediator appointed  
02 February 2012 14:16 Mediation started  
02 February 2012 14:33 Mediation failed  
02 February 2012 14:36 Close of mediation documents sent  
20 February 2012 10:17 No expert decision payment received  
06 March 2012 08:31 Expert decision payment received

### **4. Factual Background**

- 4.1 The Complainant Schlüter-Systems Ltd is a UK-registered company, and a wholly owned subsidiary of Schlüter-Systems KG (a German-registered company).
- 4.2 The Complainant's group of companies manufactures and distributes under-floor matting, which is designed to protect tiles from water spillage. The matting is a patent-protected product, designed to catch water which seeps through bathroom tiles, eliminating tile cracking, and creating a waterproof flooring in bathrooms.
- 4.3 The Complainant was incorporated in 1993, and has since used the registered trade mark SCHLÜTER. It sells its product both directly, and through a network of distributors within the bathroom/tile industry. In 2010 the company had a turnover of £4,324,985.00.
- 4.4 The Schlüter-Systems group sells a particular kind of waterproofing membrane under the mark DITRA, which has been used for over 20 years. The product is used for tile and natural stone installation. It incorporates a vapour pressure equalisation layer to accommodate moisture occurring at the underside of the substrate, and an uncoupling layer for problematic substrates.
- 4.5 Both SCHLÜTER and DITRA are registered as Community Trade Marks. The registrations are held in the name of Schlüter-Systems KG.
- 4.6 The Domain Name was registered by the Respondent, a Mr Robert Wilkins, on 4 May 2011. At the time of the Complaint, the website at

[www.ditramatting.co.uk](http://www.ditramatting.co.uk) apparently consisted of one page, with a picture of the Ditra matting, and the wording “*Schlüter-DITRA Matting. I have used it, and it worked for me!*”, with in smaller font “*you are here, because like thousands of others are not sure if Ditra Matting is required for your tiling project!*”. After that was the question “*so human speaking, do I need to use Ditra Matting or I can get away without it?*”, and a short explanation as to when Ditra Matting might be appropriate. The website suggested that, in certain circumstances, another product might be more suitable. The page concluded with a box which contained the following: “*I have received lots of e-mails asking me: where to buy Schlüter-DITRA Matting and how much it costs? The company I bought it from is called Vista Tiling Limited. They supported my tiling job from start to finish, so to show my appreciation I am happy to recommend Vista Tiling as your first point of contact for all your Ditra Matting needs. When it comes to price, I bought my 30m role of Schlüter Ditra Matting for £195.30*”.

- 4.7 At various places on the website, when the expression “Ditra Matting” was used, it was accompanied by a hyperlink to another website at [www.vistatiling.co.uk](http://www.vistatiling.co.uk), which offered the DITRA matting product (and other products, including other Schlüter products) for sale at what were described as “trade prices”.
- 4.8 Since the Complaint, the [www.ditramatting.co.uk](http://www.ditramatting.co.uk) website has been changed, so that it now features what is said to be an “*independent forum about Ditra Matting*”. The only two topics posted are “*so human speaking, do I need to use Ditra Matting, or can I get away without it?*” and “*where to buy Schlüter-DITRA Matting and how much it costs?*”. The forum has two members, and only two posts, both made on 13 January 2012, two days after the Complaint was filed with Nominet.

## **5. Parties’ Contentions**

### Complainant’s Submissions

#### Rights

- 5.1 The Complainant relies upon the registration of the Community Trade Mark DITRA and the use of that mark (as described above) for over 20 years. It says that the Domain Name “is directly related to” its DITRA Matting product.

#### Abusive Registration

- 5.2 The Complainant says that the lack of contact details on the [www.ditramatting.co.uk](http://www.ditramatting.co.uk) website and on the WHO IS details “may indicate that the Respondent is not acting honestly because they are hiding their identity.” The Complainant also says that it has tried to

contact the Respondent by numerous e-mails, asking him to abide by the Complainant's online selling policy, but without any response.

- 5.3 In view of the hyperlinks on the [www.ditramatting.co.uk](http://www.ditramatting.co.uk) website to [www.vistatiling.co.uk](http://www.vistatiling.co.uk) website, the Complainant says that it is likely that there is a link between the Respondent and the latter site, although it has not been able to verify this.
- 5.4 The Complainant also says that it only permits distributors to sell its items directly over the internet with appropriate installation guidance, because Ditra Matting is a specialist product which must be fitted by a trained professional. The advice on the [www.ditramatting.co.uk](http://www.ditramatting.co.uk) website (such as it is) is said to be incorrect.
- 5.5 The use of the Domain Name is said to be “primarily harmful” to the Complainant’s reputation for 3 reasons. Firstly, by registering the Domain Name which encompasses the Complainant’s trade mark, and the goods for which the mark is protected, there is confusion in the market place. Secondly, because of the incorrect information and installation tips on the website, which the Complainant says acts as a technical advice/referral portal, the information on the site “could be misconstrued by the users”. Finally, the website provides links to an unauthorised seller ([www.vistatiling.co.uk](http://www.vistatiling.co.uk)) which sells DITRA products to customers without installation advice, ignoring the Complainant’s official distribution policy.
- 5.6 The Complainant also refers to having received several telephone calls from customers “asking about the [www.ditramatting.co.uk](http://www.ditramatting.co.uk) website”, referring to the absence of technical advice and also the “poor” technical advice on the website.
- 5.7 The Complainant concludes by saying that “by way of duping the customer into believing that they are the official Schlüter brand, the Respondent is unfairly directing customers to an unauthorised seller”.

### The Respondent’s Submissions

#### Rights

- 5.8 The Respondent does not dispute the Complainant’s claim to have Rights under the DRS Policy (“the Policy”).

#### Abusive Registration

- 5.9 The Response is relatively brief, and therefore is set out below in full:-

*“This complaint is a nonsense. I have registered it to show my appreciation to that company, I have bought Ditra Matting myself from Vista Tiling, and they have been more than helpful!”*

*Take this website as any other forum where people talk about tiling products. I have given my thoughts on this site and it is not misleading, I can think whatever I like about any tiling products and I can discuss them online the way I understand about them.*

*I do not discourage others from using your products, nor represent them as I was Schluter Systems!*

*As of my first sentences: “so human speaking, do I need to use Ditra Matting, or I can get away without it? There are two key areas (for us, homeowners) where DITRA will help!”*

*Don’t miss that bit “for us, homeowners”!*

*Of course there are no contact details on the site, would you put your contact details on all forums you comment?*

*I am now interested in nominet’s decision about this complaint. And if it’s in your favour, of course I will take the website down.”*

- 5.10 Although the Response is ambiguous, the Expert understands the Respondent to be saying that the website is intended to show his appreciation of Vista Tiling (by his use of “that company”), but otherwise it is a forum where “homeowners” (such as himself) can discuss tiling products, including DITRA Matting. It is not intended to suggest any connection directly with the Complainant.

#### The Complainant’s Reply

- 5.11 As is noted above, on 13 January 2012 the website [www.ditramatting.co.uk](http://www.ditramatting.co.uk) was changed from its previous form, into one which has the appearance of a forum website. The Complainant suggests that this change was deliberate, in order to match the contents of the Respondent’s Reply, allowing people to post comments about tiling products.
- 5.12 However, the Complainant notes that there is currently only one member of the forum, the Respondent himself. Therefore, the change was a deliberate response to the Complaint.
- 5.13 The Complainant suggests that this change shows that the Respondent “is acting dishonestly” with regard to these proceedings by making the change, and that the change itself is prima facie evidence that the Respondent knew that the original website was also “dishonest”. The fact that the change has been made for the purpose of the Complaint leads the Complainant to believe that if its Complaint is unsuccessful, the Respondent would simply revert back to the previous form.

- 5.14 Finally, the Complainant suggests that the revised version of the website will still damage its business, as the forum will provide incorrect installation advice, and by the use of suggestion, guide the forum members to Vista Tiling.
- 5.15 The Complainant seeks the transfer of the Domain Name to itself.

## **6. Discussions and Findings**

- 6.1 In order to succeed in these proceedings, paragraph 2.b of the Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that :
- i. the Complainant has Rights in respect of names or marks which are 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

- 6.2 The Complaint fails to distinguish between the Complainant itself (the UK company), and its German parent company, Schlüter-Systems KG. The trade mark relied upon (the Community Trade Mark for DITRA) is registered in the name of the German parent, not in the name of the UK subsidiary, and the Complaint makes no attempt to explain why that means that the Complainant itself has Rights in the DITRA name or mark. However, the Complaint does refer to the Complainant's own trading within the United Kingdom, which appears to be substantial, and the question of ownership of Rights is not disputed by the Respondent. In the circumstances, the Expert is prepared to accept that the Complainant has Rights in DITRA, and also that the additional wording in the Domain Name "matting" is descriptive of the product in question. The Expert is therefore prepared to accept that the Complainant has Rights in the name or mark DITRA which is similar to the Domain Name.

### Abusive registration

- 6.3 The Policy contains, in paragraph 3.a a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4.a of the Policy contains a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. Those latter factors include, at paragraph 4.a.i .C: "before being aware of the Complainant's cause for complaint (not necessarily the "complaint" under the DRS), the Respondent has.... made legitimate non-commercial or fair use of the Domain Name", and at paragraph 4.a.ii "the Domain Name is generic or descriptive and the Respondent is making fair use of it." Under paragraph 4.b the Policy

provides that “fair use may include sites operated solely in tribute to or in criticism of a person or business”.

- 6.4 The Complainant does not try to identify relevant factors under paragraph 3.a. However, the most relevant factor would appear to be that set out in paragraph 3.a.ii: “circumstances indicating that the Respondent is using or is 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”.
- 6.5 The Complaint refers to evidence of confusion, specifically a customer having been confused by the Domain Name on 11 November 2011, but there is no detail provided as to who the customer was, what the confusion was or how it arose. The Complaint also refers generally to “confusion in the market place” as a result of the combination of the trade mark DITRA and “matting”, but entirely without any detail. The Complaint also refers to “several telephone calls from customers” (without saying who those are, or when the calls took place), asking whether the Complainant knew of the website, and querying whether the Complainant was happy for online sales to take place without technical advice, and also whether the Complainant advocated the “poor” technical advice being given online.
- 6.6 Given the lack of detail provided by the Complainant, it is difficult for the Expert to assess whether there has actually been any confusion caused by the website itself. The limited details of the “several telephone calls from customers” would suggest to the Expert that they were probably calls from other distributors, who were concerned about the website because of its failure to abide by the Complainant’s online selling policy (which is referred to by the Complainant on several occasions, but not evidenced in any way). However, if so, it seems unlikely that those distributors were in any way “confused”.
- 6.7 In its Reply, the Complainant also refers to the change in the website as a result of the Complaint, which it says shows “dishonesty” both in responding to the proceedings, and in respect of the original registration. The use of such an emotive term on several occasions by the Complainant’s professional representatives is not easily justified. However, it is not clear what conclusion the Expert is supposed to draw from that allegation in terms of the application of the wording of the Policy, even if it were justified.
- 6.8 As to the “advice” provided on the earlier version of the website, the Complainant says that it is “incorrect” installation advice, which would lead to the product failing its purpose. However, the Complainant does not explain in what respect information is incorrect, nor is it obvious why providing incorrect information would lead the registration itself to be abusive, within the wording of the Policy.

- 6.9 The Complainant also asserts that “by way of duping the customer into believing that they are the official Schlüter brand, the Respondent is unfairly directing customers to an unauthorised seller”. It is not entirely clear to the Expert what aspect of the Respondent’s conduct or use of the Domain Name the Complainant is addressing here, particularly as the Complainant is only able to speculate as to the Respondent’s involvement with the Vista Tiling site. So far as the [www.ditramatting.co.uk](http://www.ditramatting.co.uk) website itself is concerned, it does not seem possible to draw the conclusion that either version of the website suggests a direct link with the Complainant. However, it does appear that there may be the possibility of “initial interest” confusion which might be caused by the Domain Name itself. Also, the hyperlinks are likely to lead to customers indirectly to another site which could be regarded by customers as either possibly having a connection with the Complainant, or at least being an authorised reseller of the Complainant’s products. If, as the Complainant suggests, there is in fact a link between the Respondent and the Vista Tiling business, then that might be sufficient to amount to confusion within the meaning of paragraph 3.a.ii of the Policy.
- 6.10 The Respondent’s explanation of the site’s purpose is less than convincing. The suggestion that the website is (in either form) a forum where people talk about tiling products is not borne out by the facts. The second version of the website has clearly been introduced in response to the Complaint. However, even in that form, it can in no way be said to be a genuine forum for talking about tiling products. Given that the Domain Name contains the Complainant’s trade mark, and product description, it is unrealistic to expect that anyone will want to visit the site, except for the purposes of trying to find out about (and presumably in most cases, seek to purchase) the Complainant’s product.
- 6.11 If, as appears to be the case, the Respondent is seeking to justify the site and its links to the [www.vistatiling.co.uk](http://www.vistatiling.co.uk) website, by his explanation that he was appreciative of the service he had had from Vista Tiling, then in the Expert’s view, that does not amount to “fair use” of the Domain Name within the meaning of the Policy, because it is not operating “solely in tribute to or in criticism of” the Complainant or its business. Instead, it appears to be primarily aimed at extolling the virtues of Vista Tiling, as a source of the Complainant’s products. The Domain Name is in any event not generic or descriptive, because of its use of the Complainant’s trade mark, and it is difficult to avoid the inference drawn by the Complainant (which the Respondent does not refute) that there must be some kind of connection between the Respondent and Vista Tiling, which would mean that the purpose (or at least a primary aim) of the website is to generate sales through the hyperlinks to the [www.vistatiling.co.uk](http://www.vistatiling.co.uk) website.
- 6.12 Therefore, although the Expert is not convinced by a number of aspects of the Complaint (which is lacking in both detail and supporting

evidence, and is not particularly focused on showing Abusive Registration within the wording of the Policy), he is even less convinced by the Respondent's explanation. As far as the Expert can tell from the screenshot provided by the Complainant, the original version of the [www.ditramatting.co.uk](http://www.ditramatting.co.uk) website would appear to have had 6 links through which consumers would be directed to the [www.vistatiling.co.uk](http://www.vistatiling.co.uk) website, by clicking on the words "Ditra Matting". In the circumstances, it seems to the Expert, on balance, that it must have been the Respondent's intention to take advantage of the Complainant's mark, by inducing customers firstly to visit the [www.ditramatting.co.uk](http://www.ditramatting.co.uk) website, and then to follow the hyperlinks to the [www.vistatiling.co.uk](http://www.vistatiling.co.uk) website, in the belief that the latter site is either one directly connected with the Complainant, or one which is authorised by the Complainant to offer the Complainant's products for sale. In acting in that way, it seems to the Expert that the Respondent is intending to cause confusion, and the Respondent cannot rely upon the mitigating factors set out in paragraph 4.a of the Policy.

- 6.13 The Expert therefore finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration, within the meaning of the Policy.

## **7. Decision**

- 7.1 The Expert finds that the Complainant has Rights in the mark DITRA which is similar to the Domain Name, and further that the Domain Name in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name should be transferred to the Complainant.

**Signed Bob Elliott**

**Dated 16 March 2012**