

DISPUTE RESOLUTION SERVICE

D00011175

Decision of Independent Expert

TJL Enterprises Inc

and

Ms Nicki Eftekhari

1. The Parties:

Complainant: TJL Enterprises Inc
156 Granada Ave
Long Beach
California
90803
United States

Respondent: Ms Nicki Eftekhari
30 Musters Road
West Bridgford
Nottingham
UK
NG2 7PL
United Kingdom

2. The Domain Name:

coliccalm.co.uk (the "Domain Name")

3. Procedural History:

On 05 April 2012 the Complaint was received by Nominet, it was validated and notification of the Complaint sent to both parties by email and Royal Mail special delivery. On 26 April 2012 a Response was received and notification of this was sent to both parties on 27 April 2012. On 30 April 2012 a Reply was received and notification of this sent to both parties. On 30 April 2012 a mediator was appointed by Nominet; however mediation both started and failed on 01 May 2012.

On 03 May 2012 the Expert decision payment was received and the Expert, Tim Brown, confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an Expert in DRS 11175 and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties which might call into question his independence and / or impartiality. Nominet accordingly appointed him with effect from 09 May 2012.

4. Factual Background

TJL Enterprises Inc is a company incorporated and based in Long Beach, California, United States. It is concerned with the distribution of a product called "Colic Calm". Colic Calm is a homeopathic remedy employed for the treatment of colic in babies and infants.

The Complainant maintains a United Kingdom registered trademark number 9519436 for the term ColicCalm which has been in force since June 2009. The Complainant also maintains a United States trademark number 3965195 for the term COLIC CALM which has a registration date of 24 May 2011. The United States mark claims a first use in commerce of March 2004.

The Complainant markets and sells its product in the United States. It has not yet started selling or marketing its product in the United Kingdom as it is pending approval for sale by the Medicines and Healthcare products Regulatory Agency (MHRA).¹

According to Nominet's WHOIS database the Domain Name was registered by Ms Eftekhari on 23 December 2008. At the same time the Respondent apparently registered a number of similar domain names incorporating the terms "calmcolic" and "colicsoother".

During 2009 the Respondent attempted to contact the Complainant with the intention of becoming an authorised distributor of the Complainant's products within the United Kingdom. The Complainant did not acknowledge the Respondent's request.

The Respondent appears to have then used the website associated with the Domain Name to either sell the Complainant's own or similar products. The Respondent appears to have stopped selling these products on the website at some point between September 2011 and March 2012.

During the period of the Domain Name's registration the Complainant and Respondent engaged in intermittent correspondence. The exhibited correspondence shows that the Respondent bought supplies of the Complainant's product in amounts which would seem to be too large for mere personal use. The correspondence also narrates that the Respondent appeared willing to sell the Domain Name to the Complainant for a sum in the region of USD\$1,500.

Clearly a settlement was not reached between the parties and the current dispute was brought before Nominet in April 2012.

5. Parties' Contentions

Complainant

The Complainant's contentions are as follows:

Complainant's Rights

As noted in the Factual Background above, the Complainant is the registrant of a United Kingdom trademark for the term ColicCalm which has been in force since June 2009. The Complainant also maintains a United States trademark for the term COLIC CALM which was registered on 24 May 2011. Copies of these marks have been exhibited by the Complainant.

¹ The Medicines and Healthcare products Regulatory Agency is a United Kingdom government agency concerned with the safety and approval of medicines and medical products.

Abusive registration

The Complainant says that the Respondent claimed to have emailed it in 2009 requesting permission to sell its products and, having not received a response, the Respondent assumed that she had the Complainant's implied consent to the use its marks and resell its products by way of the Domain Name.

The Complainant says it approached the Respondent on several occasions to ask her to stop using the Complainant's trademark and selling its products via her website. These approaches resulted in the website associated with the Domain Name temporarily being taken down several times but not permanently.

The Complainant says that when the website was active it used text and trademark-protected material taken from the Complainant's web site at <coliccalm.com>. A number of screenshots taken in 2009 and 2010 have been exhibited.

The Complainant has exhibited a number of pages from online Internet forums relating to children and infants which show members discussing the Complainant's products. These discussions appear to show that members have the impression that the website associated with the Domain Name is an official or approved online outlet for the Complainant's product. The Complainant says that this is evidence that the Domain Name's use by the Respondent has confused web users.

The Complainant says that the Respondent has threatened to damage its brand through a smear campaign and has attempted to extort money from the Complainant.

The Complainant concludes with a number of statements regarding the legality or otherwise of selling a product in the UK which has not been approved by the MHRA.

Respondent

The Respondent's contentions are as follows:

Complainant's Rights

The Respondent does not deny that the Complainant has registered rights in the United States and United Kingdom for the terms ColicCalm and COLIC CALM. However, she says that her registration of the Domain Name in December 2008 pre-dates the registration of the trademarks in question. The Respondent says that the United Kingdom trademark was registered merely to allow the Complainant to bring a dispute to recover the Domain Name.

The Respondent says that the Complainant has not actively used its United Kingdom mark since its registration and she plans to seek its revocation in due course. The Respondent says the present dispute has been brought by the Complainant to pre-empt such action.

Abusive registration

The Respondent says that she attempted to contact the Complainant in 2009 with the intention of becoming its representative in the United Kingdom. As a result the Respondent says the Complainant was aware of her existence and has waited for several years before making a formal complaint against her registration.

The Respondent says that she registered a number of similar domain names, including terms such as "calmcolic" and "colicsoother", at the same time as the Domain Name. The

Respondent says that she was therefore not targeting the Complainant and did not have the intention of doing anything illegal. In any event, the Respondent says that she has traded under the name "Colic Calm UK" and not "Colic Calm".

The Respondent says that having been approached by the Complainant on a number of occasions she twice refused to sell the Domain Name to it. However on the most recent occasion the Respondent says that she directed the Complainant to the website operated by the domain name broker SEDO where the Domain Name was apparently listed for sale. The Respondent says the Complainant declined to purchase the Domain Name.

Complainant's reply

The Complainant's reply to the Response is as follows:

Complainant's Rights

The Complainant concedes that it has not used its trademark or traded in the United Kingdom to date. But it notes that this is because it is currently awaiting approval of its products by the MRHA. Once approval is granted it intends to trade within the United Kingdom under its Colic Calm mark.

The Complainant rejects the Respondent's assertion that the addition of the term "UK" within its apparent trading name distinguishes her use from the Complainant's.

Abusive registration

The Complainant says that when the Respondent did not hear from it regarding her enquiry to become a representative of the Complainant in the UK the Respondent plagiarised the Complainant's website. A number of screenshots from 2009 and 2010 are exhibited.

The Complainant has exhibited an email which it says demonstrates that the Respondent was buying the Colic Calm product to resell.

The Complainant says that it has been working with MHRA and Her Majesty's Revenue and Customs to form a case against the Respondent with regard to her selling the Complainant's products illegally.

6. Discussions and Findings

Complainant's Rights

As noted the Complainant has exhibited a United Kingdom trademark for the term ColicCalm which has been in force since June 2009 and a United States trademark for the term COLIC CALM which was registered on 24 May 2011.

I observe that the Complainant's trademarks came into force after the registration of the Domain Name by the Respondent in December 2008.

The Policy has a low threshold test for rights. The Policy defines Rights² 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 Policy makes no specific reference to the date on which the rights holder must have acquired these rights. A complainant must merely demonstrate that it has Rights.

² Paragraph 1 of the Policy

With this in mind it is my view that Complainant does have sufficient Rights to pass the first test under the Policy. As is customary in DRS proceedings the .co.uk suffix is required only for technical reasons. Whitespace cannot be incorporated in domain names and so is ignored. The Complainant's registered trademarks are therefore identical to the Domain Name.

I note that if a complainant's rights post-date a disputed domain name's registration a complainant may succeed on the first test of the Policy. However the complainant may have difficulties showing the domain name is Abusive in terms of the second test within the Policy. I will address this point in relation to the current matter under the Abusive registration heading below.

I therefore find that in terms of the Policy the Complainant has Rights in respect of names or marks which are identical to the Domain Name.

Abusive registration

Paragraph 1 of the Policy defines an Abusive Registration as 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;

The Policy lays out a non-exhaustive list of factors which may be viewed as evidence that a domain name may be an Abusive Registration. In my view there are two relevant paragraphs which apply to this dispute.

These are, firstly, that there are circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant.³ And, secondly, that there are 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.⁴

Unfair disruption

According to the Complainant's exhibited United States trademark the Colic Calm brand was first used in trade by the Complainant in 2004. It is probable therefore that the Complainant's product would have built up at least a small degree of brand recognition by the time the Domain Name was registered four years later in December 2008.

Both parties agree that they corresponded with each other on a number of occasions after the Domain Name's registration. While the relevant email itself has not been exhibited, the Respondent apparently emailed the Complainant to ascertain whether she could become a "representative" of the Complainant and sell its products in the UK. The Respondent herself says "they [the Complainant] knew from 2008 that we have this domain registered since initially we have made attempts to contact Colic Calm". As noted the Complainant did not respond to the Respondent's email.

It therefore seems highly improbable that the Respondent independently thought of an identical name in isolation and then, early in the Domain Name's registration period,

³ Paragraph 3aiC of the Policy

⁴ Paragraph 3aii of the Policy

attempted to contact the Complainant with a view to representing them in the UK without any prior knowledge of the Complainant, their brand and their unregistered rights in the term Colic Calm. Tellingly, perhaps, the Respondent has provided no evidence that she acted otherwise.

In my view the Respondent's registration and use of the Domain Name with the apparent intention of effectively appointing herself as the Complainant's "representative" demonstrates on balance that the Domain Name was registered with the purpose of unfairly disrupting the business of the Complainant. This is demonstrated by the Respondent's actions in adopting the Complainant's trademark in the .uk domain name space, followed by copying the look and feel of the Complainant's web site and selling the Complainant's product on her site.

With these factors in mind, it is my view that it is not relevant that the Complainant's registered marks post-date the Domain Name's registration. By the time of the Domain Name's registration it is clear on balance that the Respondent was aware of the Complainant and their product.

Confusion

When the Respondent did not initially receive a reply from the Complainant, she appears to have commenced buying the Complainant's products and selling them on the website associated with the Domain Name. From the exhibited screenshots it appears that her website had a very similar look and feel to the Complainant's web site at <coliccalm.com>.

The Complainant has explained that it has not yet started trading in the UK as its product has not yet been approved for sale in this country. It is clear to me that the Complainant intends to trade in the UK once it receives this approval. The Complainant has also said that it does not appoint representatives in the many countries in which it operates. It chooses to sell directly to consumers itself.

The adoption of the Domain Name and the use to which it was put as described above has confused 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 exhibited a number of Internet forum posts which show members of the public discussing the Complainant's products and referring to the Domain Name as a web site at which the product can be bought.

One exhibited comment says *"I have purchased Colic Calm from coliccaim .co.uk for my daughter and they were very fast in shipping and offered a great customer service."*

Another says *"Nothing mentioned below works like Colic Calm. I have tried EVERYTHING you can imagine with my baby and nothing else worked but Colic Calm. I bought mine from www.coliccalm.co.uk."*

In my view these, and the other example exhibited before me, are sufficient to show on balance that people or businesses have been confused into thinking the Domain Name is connected with or authorised by the Complainant.

Potential sale of the Domain Name

Both parties have said that during their later correspondence the sale of the Domain Name was discussed. The Policy notes that registering a domain name "for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant"⁵ can be evidence of an Abusive Registration.

⁵ Paragraph 3aiA

The Complainant says that such offers of sale were an attempt to extort money from it.

I note that parties corresponding prior to a dispute will often discuss the sale of the domain name in question. Offers and counter-offers may be discussed. Such activities are part of normal negotiations and do not in themselves necessarily demonstrate that the domain name's registration was Abusive.

In my view, the Respondent's *primary* intention in registering the Domain Name was to sell the Complainant's product in the UK via the Domain Name, not to sell the Domain Name to the Complainant. Therefore the later negotiations do not in themselves render the Domain Name Abusive.

Demonstrable preparations

In terms of Paragraph 4 of the Policy⁶ the Respondent has not given any convincing evidence that, for example, she has made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods and services.⁷ She has also not given evidence that she was commonly known or legitimately connected with a mark which is identical or similar to the Domain Name.⁸ The Respondent's use of the term "Colic Calm UK" on her website (but not within the Domain Name itself) is not enough to distinguish her website or apparent business name from the Complainant's.

Related domain names

Furthermore, the Respondent's submission regarding her registration of other, similar domain names incorporating the terms such as "calmcolic" and "colicsoother" do not convincingly excuse her registration of the Domain Name.

As I have noted above the Respondent demonstrated an apparent willingness to contact the Complainant soon after the Domain Name was registered. To me this shows on balance that she had the Complainant in mind when she registered the Domain Name. The Respondent herself notes in her submission that she traded as "Colic Calm UK" rather than as "Calm Colic UK" or "Colic Soother UK". It is therefore clear to me that her intention was to use the "Colic Calm" mark in the Domain Name and that the related domains names were merely peripheral registrations.

Conclusion

Given the evidence and submissions before me it is my view that on the balance of probabilities the Domain Name was registered primarily for the purpose of unfairly disrupting the business of the Complainant and that it was used in a way which confused people into believing the Domain Name was registered, operated or authorised by the Complainant.

⁶ Paragraph 4 sets out a non-exhaustive list of factors which may show that a domain name is not an Abusive Registration.

⁷ Paragraph 4aiA of the Policy

⁸ Paragraph 4aiiB of the Policy

7. Decision

Having concluded that the Complainant has Rights in respect of names or marks which are identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I determine that the Domain Name should be transferred to the Complainant.

Signed: Tim Brown

Dated 22 May 2012