

DISPUTE RESOLUTION SERVICE

D00011527

Decision of Independent Expert

Securimed SAS

and

Value Products Limited

1. The Parties:

Complainant: Securimed SAS
6555 West Good Hope Road
Milwaukee
Wisconsin, WI 53223
United States

Respondent: Value Products Limited
3rd Floor Enefco House
Poole Quay
Poole
Dorset
BH15 1HJ
United Kingdom

2. The Domain Name(s):

<securimed.co.uk>

3. Procedural History:

On 26 June 2012 the Dispute was received, the Complaint validated and notification of it sent to both parties. On 13 July 2012 a response reminder was sent by Nominet to the Respondent and on 17 July 2012 a response was received, notification of which was sent to both parties on the same day. On 20 July 2012 a reply reminder was sent to the Complainant and on 24 July 2012 a reply was received, notification of which was sent to both parties on the same day.

On 24 July 2012 Nominet appointed a mediator and mediation started on 27 July 2012. On 08 August 2012 mediation failed and the close of mediation documents were sent to both parties.

On 14 August 2012 an 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 11527 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 17 August 2012.

4. Factual Background

The Complainant, Securimed SAS, is a company founded in France in 1986. It specialises in the supply of products to the medical and emergency care sectors. From 1986 to April 1999 the Complainant primarily supplied goods through a mail order service. In April 1999 it registered the domain name <securimed.fr> and established a website through which its customers could purchase its products online.

In March 2010 the Complainant was acquired by Brady Corporation, a manufacturing and precision engineering company which operates in 26 countries. According to a number of exhibited press articles, the acquisition was widely reported in the press on 31 March 2010.

Following this acquisition, the Complainant's business expanded into the United Kingdom and other European countries. The Complainant's products are currently sold in the United Kingdom via an company called Welco. Welco is a division of Brady UK Limited, which in turn is a subsidiary of Brady Corporation, the Complainant's parent company.

The Complainant's turnover in the last financial year was in excess of EUR8m and its website at <securimed.fr> attracts in excess of 25,000 visitors per month.

The Complainant is the registrant of the French trade mark SECURIMED which has been in force since June 2004. It was originally registered to an employee of the Complainant but assigned to the Complainant in May 2010 following its acquisition by Brady Corporation.

The Respondent, Value Products Limited, is a company based in the United Kingdom concerned with the sale of medical devices, materials and instruments. The Respondent operates a number of websites through the domain names <justgloves.co.uk>, <firstaid4less.co.uk> and <medisupplies.co.uk>.

According to Nominet's WHOIS database, the Respondent registered the Domain Name on 31 March 2010. Since that date it appears from the exhibited screenshots that the Domain Name has been parked on the registration service provider's "parking page" which displays, among other text, a number of pay per click advertising links relating to various third party websites.

5. Parties' Contentions

Complainant

The Complainant's contentions are as follows:

Complainant's Rights

The Complainant is the registrant of French trademark number 3295074 SECURIMED which has been in force since June 2004. A copy of its assignment from the original registrant to the Complainant in May 2010 has been exhibited. The Complainant says over the past 25 years of trading it has built up substantial goodwill and reputation in the name SECURIMED in France, the United Kingdom and elsewhere in Europe. Copies of the WHOIS entry for <securimed.fr> showing its registration in April 1999 and screenshots of its website at the same domain name have been retrieved from the WayBackMachine at <archive.org> from 2001 and are exhibited.

The Complainant also notes that its parent company, Brady Corporation, has applied for a Community Trade Mark for the term SECURIMED and, again, a copy of the application has been exhibited.

Abusive registration

The Complainant claims that the Domain Name has been registered as a blocking registration against a name or mark in which the Complainant has Rights in terms of Policy 3aiB. The Complainant contends the Respondent knew of its acquisition by Brady Corporation from the press announcements on 31 March 2010. The Complainant says that the Respondent would have therefore known that the Complainant would be likely to expand its business into the United Kingdom and would want to register the .co.uk domain name corresponding to its SECURIMED brand.

The Complainant also contends that the Respondent has previously sought to take unfair advantage of the Complainant's intellectual property rights, which it says is consistent with the Respondent's behaviour in abusively registering the Domain Name. The Complainant notes that a director and co-owner of the Respondent - Mr Hugh McKenna - was the Marketing Director for a division of Brady Corporation that traded under the name SETON from 1988 to 1998.

Brady Corporation established the company Seton Limited (company number 04190853) in 2001. Seton Limited was dissolved on 16 December 2008, although Brady Corporation continued to provide goods and services under the SETON name.

However when Mr McKenna left Seton Limited he started to work as a consultant for a competitor. On 17 December 2008, the day after Seton Limited (company number 04190853) was dissolved, Mr McKenna incorporated a new UK company called Seton Limited (company number 06775839). The Complainant says Mr McKenna intended to trade off the goodwill in the SETON name.

The Complainant notes that Brady Corporation then challenged the formation of Seton Limited (company number 06775839) and it was consequently dissolved in May 2009. A number of documents from Companies House and correspondence between Brady Corporation, Mr McKenna and their respective representatives have been exhibited.

The Complainant claims that these actions demonstrate that the Respondent closely followed the activities of Brady Corporation and had knowledge of the Complainant's acquisition by Brady Corporation and of its rights in SECURIMED.

The Complainant observes that the Domain Name was registered on the same day as Brady Corporation's acquisition of the Complainant was publically announced. The Complainant argues that it would be an extremely surprising coincidence for the Respondent to register the Domain Name on the same date as the public announcement if the Respondent did not have the Complainant in mind.

The Complainant argues that the Domain Name was registered and is being used for the purpose of unfairly disrupting the business of the Complainant in terms of Policy 3aiC. The Complainant says that it is highly likely that the public will use the Domain Name when searching for information about its business and that rather than finding its website customers will reach a pay-per-click website through which the Respondent will be generating income. The Complainant claims that this is likely to cause it loss of customers and revenue.

The Complainant argues that the Respondent is using 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 in terms of Policy 3a.ii.

The Complainant claims that the Domain Name is identical to the Complainant's name and SECURIMED mark and that there is bound to be a significant risk that Internet users will use the Domain Name for the purpose of trying to find the Complainant's website. The Complainant says that, as the visitor has been deceived and confused, such initial interest confusion is a basis for a finding of Abusive Registration.

Finally, the Complainant argues that there are no grounds on which the Respondent can demonstrate that the Domain Name is not an Abusive Registration.

The Complainant contends that the Respondent has not used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services. It says there is no evidence that the Domain Name has been used for anything other than a pay-per-click website since its registration on 31 March 2010 and there is no evidence that the Respondent has made preparations to provide goods or services through it.

The Complainant argues that the name SECURIMED is distinctive of the Complainant and there is no use which the Respondent could make of the Domain Name which would not infringe the Complainant's rights. It says SECURIMED is an invented and distinctive word and the Domain Name contains no additional features which would make it into a descriptive term.

The Complainant says the Respondent has not been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

The Complainant states the Respondent is not making any legitimate non-commercial or fair use of the Domain Name as it resolves to a pay-per-click site through which the Respondent generates revenue. The Complainant says that while pay per click advertisements are not necessarily objectionable, in this case the Domain Name is identical to the Complainant's SECURIMED mark and the registration of the Domain Name was therefore opportunistic.

Respondent

The Respondent's contentions are as follows:

Complainant's Rights

The Respondent notes that the Complainant claims to own rights in the term SECURIMED but that it has only exhibited a French trade mark (number 3295074) and the domain name <securimed.fr>. The Respondent says that these rights are only enforceable in France and would not be enforceable in the United Kingdom.

While the Complainant claims it is a leading supplier of healthcare products in France the Respondent argues that the Complainant has filed no evidence to support this. The Respondent further notes that even if evidence were supplied then the claimed rights would only apply in France.

The Respondent contends that the Complainant is relying on common law rights and passing off to support its claim but that it has not set out a case for passing off and has not satisfied the required criteria.

Abusive registration

The Respondent claims that the Complainant did not own any relevant rights in the United Kingdom at the time the Domain Name was registered and that any plans at that time to expand into the United Kingdom would not be sufficient to demonstrate rights.

The Respondent denies that it knew of the Complainant's acquisition by Brady Corporation and says that the Complainant's assertions on this point are mere speculation and that it has provided no evidence to substantiate them.

The Respondent disagrees that Mr McKenna previously sought to take advantage of the Complainant's rights. The Respondent says it is a reputable company and is not in the habit of adopting names to take unfair advantage of any third party rights.

The Respondent expresses that the date of registration of the Domain Name was purely coincidental and had no bearing on any activities by Brady Corporation. The Respondent says that at the time of registration the Complainant had no rights that could be enforced in the United Kingdom and it considered the Domain Name an apt name for its business.

The Respondent denies that the Domain Name is unfairly disrupting the Complainant's business as it was registered in March 2010 and the Complainant did not become aware of it until January 2012, so could not have disrupted the Complainant's business and was not registered to do so.

The Respondent notes that it is the practice of many organisations to register domain names with a view to deciding how to use them in the future in accordance with any relevant business plan. It says that the fact the Domain Name has not been used does not constitute an Abusive Registration and denies it has used the site for pay per click advertising.

Finally the Respondent denies that the name SECURIMED is distinctive of the Complainant in the United Kingdom.

Complainant's reply

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

Complainant's Rights

The Complainant denies that it has a lack of rights in the United Kingdom and suggests that the Respondent has misinterpreted the Policy. The Complainant feels that regardless of whether or not its rights are enforceable in the United Kingdom, they are sufficient to rely upon in a Nominet complaint.

Abusive registration

The Complainant points out that the Respondent has not provided any explanation why the name SECURIMED was chosen and why the Domain Name was registered on the same date as the announcement of the Complainant's acquisition by Brady Corporation.

The Complainant says that the delay between the Domain Name's registration and its awareness of it does not demonstrate a lack of intention to disrupt the Complainant's business by the Respondent. The Domain Name's registration came to the attention of the Complainant in the course of its plans for further expansion into the UK. It feels this demonstrates that the Domain Name is likely to disrupt the Complainant's business.

The Complainant asserts that it is not credible that the Domain Name was registered in March 2010 for future use in accordance with a business plan and yet, over 15 months later, the

Respondent has been unable to submit evidence to indicate that it has made any preparations for any use.

6. Discussions and Findings

Complainant's Rights

The Complainant has exhibited a French trade mark for the term SECURIMED which has been in force since June 2004. The Complainant has traded under the brand SECURIMED since at least 1986 and has attached evidence to support this contention.

While the Complainant does demonstrate some use of the SECURIMED brand in the United Kingdom it is, in the main, relying on its French rights. The Respondent says that registered or unregistered rights in France are not enough to demonstrate sufficient Rights under Nominet's Policy.

The Policy defines Rights¹ as "...rights enforceable by the Complainant, whether under English law or otherwise..." I think that the Policy is clear that Rights do not have to exist exclusively in the United Kingdom for a complaint to succeed. The words "...or otherwise" are key.

I have also referred to the DRS Expert's overview², specifically paragraph 1.5, which asks "Can an overseas right constitute a relevant right within the definition of Rights?" the overview notes:

Yes. The rights must be enforceable rights, but there is no geographical/jurisdictional restriction. If the Upper Volta Gas Board can demonstrate rights in respect of its name enforceable in Upper Volta, the Policy is broad enough to deal with a cybersquatter, for example, registering <uppervoltagasboard.co.uk>. If it was otherwise, the '.uk' domain would be likely to become a haven for cybersquatters.

The threshold for Rights under the Policy is a low one and I consider that the Complainant's registered French mark is enough to demonstrate sufficient rights.

As is customary in DRS proceedings the .co.uk suffix is required only for technical reasons and is ignored when comparing a mark to a domain name. I see therefore that the Complainant's registered trade mark is identical to the Domain Name.

I 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;

¹ Paragraph 1 of the Policy

² The Experts' overview is a document put together by Nominet's panel of Experts which deals with a range of issues that come up in DRS disputes. It is published on Nominet's website at: www.nic.uk/digitalAssets/53097_DRS_Expert_Overview.pdf

The Policy sets out a non-exhaustive list of factors which may be viewed as evidence that a domain name may be an Abusive Registration and the Complainant primarily relies on three factors. It says the Respondent registered the Domain Name, first, as a blocking registration against a name or mark in which the Complainant has Rights;³ secondly, for the purpose of unfairly disrupting the business of the Complainant;⁴ and thirdly, that there are circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.⁵

From the submissions in front of me it is clear that both parties operate in the same industry - that is the supply of various medical products - and that a director of the Respondent was employed by a division of the Complainant's parent company between 1988 and 1998. I think it is reasonable to conclude on balance that the Respondent was aware of the Complainant, its business and brands prior to the registration of the Domain Name.

The Complainant contends, and Respondent does not deny, that the Domain Name was registered on the same day as it was announced that the Complainant was acquired by Brady Corporation. Brady Corporation is large international company and it was therefore not unreasonable to presume at the point of acquisition that the Complainant would expand into the United Kingdom in the future.

The Complainant has argued that it seems highly unlikely that the registration of a Domain Name identical to its SECURIMED brand and registered trademark on the same day as the announcement of its acquisition by Brady Corporation could have been purely by chance. I am inclined to agree. It does not appear to me that the date of registration was a "mere coincidence" as suggested by the Respondent. I have noted that the Respondent must have been aware of the Complainant's business at the time of registration and the Respondent has not given a reasonable explanation as to why it picked a domain name identical to the Complainant's trading name and registered trade mark, aside from that it was an "apt name" for its business. I observe that SECURIMED does not appear to be a descriptive or generic term. It seems to be a made-up term which appears to be exclusively referable to the Complainant.

In my view it stretches credulity beyond breaking point to suggest that the Respondent picked a domain name identical to the Complainant's made up SECURIMED brand on the same day as the widely reported announcement of the Complainant's acquisition purely by chance. It is implausible that the Respondent did not have the Complainant in mind when it registered the Domain Name.

Since its registration the Domain Name appears to have been configured to resolve to the registration service provider's parking page. The exhibited screenshots show the page has some text relating to the registration service provider and a number of pay per click advertising links.

In my view it is likely that once the Respondent registered the Domain Name it did not configure it further. The resulting page is merely a default parking page provided by the registration service provider. Therefore it is likely the advertisements have been placed by, and are to the benefit of, the registration service provider rather than the Respondent. This would perhaps explain why the Complainant contends the web site has been used for pay per click advertising while the Respondent denies this.

In any event it is my view that the content of the site and the beneficiary of any advertising revenue generated there is not particularly relevant to this matter. The Complainant says that

³ Para 3aiB

⁴ Para 3aiC

⁵ Para 3aii

as the Domain Name is identical to the Complainant's name and SECURIMED mark there is bound to be a significant risk that Internet users will use the Domain Name for the purpose of trying to find the Complainant's website. The Complainant says that such initial interest confusion will deceive and confuse Internet users. On balance, I concur with the Complainant's contentions.

In coming to this view I have referred to Paragraph 3.3 of the Expert's Overview: "Paragraph 3(a)(ii) concerns confusing use of the domain name. What is meant by confusing use?" The Overview notes:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with ... a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

The Overview further observes that:

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix).

As I have noted, the Domain Name is identical to the Complainant's SECURIMED brand and mark with no further adornment. Furthermore the Respondent has not put forward a reasonable explanation for picking this particular name.

With this in mind, it is highly likely that the Domain Name will confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by the Complainant as a result of this initial interest confusion.

Finally, in terms of Paragraph 4 of the Policy⁶ the Respondent has not given any convincing evidence that, for example, it has made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods and services.⁷ The Respondent has not given evidence that it was commonly known or legitimately connected with a mark which is identical or similar to the Domain Name.⁸

Therefore I conclude that the Domain Name, in the hands of the Respondent, is an Abusive registration in terms of Policy 3aii.

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 02 September 2012