

DISPUTE RESOLUTION SERVICE

D00011955

Decision of Independent Expert

Crumpler Serious GmbH

and

College Cameras Ltd

1. The Parties:

Complainant: Crumpler Serious GmbH
CRUMPLER
GROUND FLOOR
35 NEW OXFORD STREET
LONDON
WC1A 1BH
United Kingdom

Respondent: College Cameras Ltd
Parcllwyd
Ponthirwaun
Cardigan
Ceredigion
SA43 2RJ
United Kingdom

2. The Domain Name(s):

we-sell-crumpler.co.uk

3. Procedural History:

25 September 2012 19:01 Dispute received
26 September 2012 09:14 Complaint validated
26 September 2012 09:19 Notification of complaint sent to parties
02 October 2012 13:02 Response received
02 October 2012 13:02 Notification of response sent to parties
05 October 2012 02:30 Reply reminder sent
09 October 2012 08:25 Reply received
09 October 2012 08:28 Notification of reply sent to parties
09 October 2012 08:28 Mediator appointed
12 October 2012 10:05 Mediation started
16 November 2012 15:49 Mediation failed
16 November 2012 15:50 Close of mediation documents sent
28 November 2012 01:30 Complainant full fee reminder sent
04 December 2012 10:18 Expert decision payment received

I was appointed as Independent Expert on 4 December 2012 and have confirmed to Nominet that I am independent of the parties and know of no facts or circumstances that might call into question my independence in the eyes of the parties.

4. Factual Background

The Complainant, Crumpler Serious GmbH, asserts that it is the official representative (in Europe) of Samesame Limited which is the registered proprietor of Community Trade Mark No E6871404 for the word 'CRUMPLER' in classes 14, 18 and 25, filed in April 2008, and also No E916494 in the same classes, filed in August 1998, for a device which incorporates the word 'CRUMPLER'. I note that the OHIM website records Samesame Co Limited (my emphasis) as the registered proprietor.

The Complainant, with the consent of Samesame Limited, is the registrant of a number of domain names including crumpler.co.uk. The Nominet whois tool identifies that domain as being registered on 18 July 2000.

According to the Nominet whois tool the Domain Name was registered by the Respondent in December 2004. It is indicated in the Complaint that at some point the Domain Name was pointed to a "World of Bags" website on which goods originating from Crumpler Serious GmbH were sold. This does not appear to be disputed by the Respondent, although at some point such use ceased and the Respondent asserts that it is not now actively using the Domain Name.

The Respondent relies upon a letter dated 30 November 2004 sent to it by 'Crumpler Europe'. It is unclear whether the entity sending the letter is either the Complainant, Samesame Limited or another related entity, although I do not take it to be alleged by the Complainant that the sender did not have the

legal right to send the letter. The letter deals with the Respondent's entitlement to use the 'CRUMPLER' trade mark and recites the following:

On reflection and in consideration of the work that College has put into Crumpler and our products and as a very specific exception we are willing to let College Camera use the Crumpler Brand, Trademark, Logo and Logotype in the manner outlined below.

- 1. College Cameras may use the name 'Crumpler' in the URL address as a marketing tool. The word Crumpler cannot come first, i.e. crumpleronline, crumplerdirect and so on. Acceptable names for a marketing URL would be **welovecrumpler, lovemelovemycrumpler, wesellcrumpler, college4crumpler** and so on. Please come back to us if you come up with another name that you would like to use so we are kept in the loop."*

The Complainant asserts that by a letter dated 4 June 2009 Samesame Co Ltd terminated the agreement contained within the letter of 30 November 2004.

5. Parties' Contentions

a. Complaint

In support of its claim to Rights, the Complainant relies upon its status as the 'official representative' of the proprietor of the registered trade marks referred to above and its ownership of certain domain names including crumpler.co.uk. It does not expressly assert (which is unfortunate and not very helpful), although it is implicit in the Complaint, that it believes that the Respondent is using a sign identical or similar to the name in which it has Rights.

In support of the claim that the Domain Name is an Abusive Registration the main points made by the Complainant (in summary) are that the Respondent:

- (i) is not an affiliate and visitors to his site will not be directed to an official site;
- (ii) is not an official seller of the Complainant's goods;
- (iii) intends to profit from the unlawful use of the Complainant's trade mark to attract business to his website for commercial gain by creating a likelihood of confusion for internet users;
- (iv) has infringed the trade marks previously and has modified its behaviour previously.

b. Response

The Respondent does not challenge the Complainant's claim that it has Rights.

In defence of the Complaint the main points made by the Respondent (in summary) are that:

- (i) the letter of 30 November 2004 gives permission for its use of the Domain Name;
- (ii) it has addressed any complaints made by the Respondent as to its use of the CRUMPLER mark in a timely fashion;
- (iii) if the Complainant wishes the Domain Name to be transferred to it, the Respondent is entitled to be compensated for its lost investment.

c. Reply

The Complainant asserts the following main points (in summary):

- (i) The agreement contained within the 30 November 2004 letter has been terminated.
- (ii) It has not agreed to compensate the Complainant for a transfer of the Domain Name in the event that the agreement is terminated.

The Complainant requests that the Domain Name be transferred.

6. Discussions and Findings

a. General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark 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).

The Complainant must make out its case to the Expert on the balance of probabilities.

b. Complainant's Rights

The DRS Policy defines Rights as follows:

"Rights means 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 Respondent does not challenge the Complainant's claim to have Rights. In my view the Complainant has not adequately asserted that it does in fact have Rights in the trade mark registrations that it refers to, having provided no evidence of any license agreement or consent from the proprietor, Samesame Co Ltd, and the references that it has made to the proprietor misstate the proprietor's name (omitting the Co). I am not therefore satisfied that the

Complainant has produced sufficient evidence to allow me to conclude that it can rely on registered rights. However, it is the registrant of the domain name crumpler.co.uk. Whilst (again unhelpfully) it provides no evidence of its use of that domain name, I am mindful that it is generally accepted by Experts appointed under the DRS that the threshold test for proving the existence of Rights is quite low and further that that the registration and use of that domain name is not challenged by the Respondent. I am therefore satisfied, although only just, that the registration and use of the domain name crumpler.co.uk by the Complainant is sufficient for the Complainant to succeed in proving that it has Rights. As will be seen below, I do not consider that the issue of the Complainant's being able to prove that it had Rights is determinative of this Complaint in any event.

For the purpose of analysing whether the Domain Names are identical or similar to the name or mark in which rights are claimed, one must ignore the .co.uk suffix. The comparison is therefore between 'CRUMPLER' on the one hand, and 'WE-SELL-CRUMPLER' on the other. In my opinion the Complainant has established that it has Rights in a mark similar to the disputed Domain Names.

c. Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above.

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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

In most circumstances where a Respondent has registered a domain name that is identical or similar to a name or mark in which the Complainant has rights, the name or mark is well known or distinctive and the Complainant and mark were known to the Respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration. However the extent to which a party who is reselling the goods or services of a complainant, can legitimately use a domain name incorporating the Complainant's trade mark or name, has been the subject of much deliberation by Experts and has been dealt with in several appeal decisions. This is in part because of general legal principles regarding the legitimate use of another party's trade mark to denote

its goods/services, exhaustion of trade mark rights once goods have been put on the market, and the specific provisions within the Policy concerning a genuine offering of goods (Para 4(a)(i)(A)) or fair use (Para 4(a)(i)(C)).

In the seiko-shop.co.uk appeal decision (DRS00248) the panel said the following:

“The Panel agrees that if there is support in the evidence for the suggestion that the Domain Names make, or are liable to be perceived as making, the latter representation (i.e. that there is something approved or official about their website), this would constitute unfair advantage being taken by Wanderweb or unfair detriment caused to Seiko.”

The panel also dealt with an issue arising under paragraph 3(a)(i)(C) of the Policy, which provides that a registration will be abusive if there are -

“i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

C. for the purpose of unfairly disrupting the business of the Complainant”.

The issue was how the word “primarily” should be interpreted, and the panel concluded that:

“In our view ‘primarily’ is not the same as ‘only’ and although a domain name registrant may start out with the best of intentions, if the effect of his actions is to give rise to confusion and to disrupt a Complainant’s business then he has fallen foul of this paragraph in the Policy.”

Reseller use was also considered in a case concerning Epson ink cartridges (DRS 03027). The panel confirmed that initial interest confusion was an “admissible species of confusion in DRS cases” and then went on to deal with what the correct approach should be where the respondent was a reseller. It said:

“9.4.9 The question of whether the (misleading) impression of a commercial connection is created is a question of fact in each case. There is, however, a marked difference between selling the genuine products of another party under its registered trade marks in order to identify the goods as being those of the trade mark owner, or making legitimate comparative uses in accordance with honest commercial practices in such matters, and the Respondent’s practice of adopting a multiplicity of web site addresses incorporating the trade mark for general promotional purposes, to divert customers to the Respondent’s website, irrespective of whether or not the business includes the sale of such genuine or compatible goods.”

Both the Seiko and Epson cases were considered in the toshiba-laptop-battery.co.uk appeal (DRS 07991). Four criteria were identified as being relevant to the determination of whether a reseller's use of a domain name incorporating a complainant's trade mark/name is abusive, as follows:

1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.

When addressing whether it would be fair to offer competing goods, the panel said the following:

"The further issue, however, is whether the fact of the offering of competitive products on the Respondent's website is sufficient to render the registration abusive, even in the absence of "initial interest confusion". On this question, the Panel unanimously considers that, if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner's consent, to accord with the principles stated above that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated."

In the absence of any relationship between the Respondent and the Complainant, I would have had little hesitation in concluding that the use of the Domain Name would be likely to lead to confusion and as such the registration would be Abusive. However in the present case, the proprietor of the registered trade marks consented to the registration and use of the Domain Name in its 30 November 2004 letter. Whilst it is asserted that a subsequent letter terminated that consent, it is unclear to me on the materials that I have seen, whether the proprietor was in fact entitled to terminate that agreement or what entitlement if any the proprietor or the Complainant has to seek the transfer of the Domain Name under the agreement. In my view the Respondent's use prior to the making of the complaint falls within paragraphs 4(a)(i)(A) - (C) of the Policy, namely a genuine offering of goods under the Domain Name; been commonly known by the name or legitimately connected

with it; or legitimate fair use of the Domain Name, given the initial consent of the trade mark proprietor. It is also possible that the use made with the proprietor's consent may have been such to dispel any likelihood that visitors of the site would be confused into believing that the site was operated by the trade mark proprietor or the Complainant. I am also mindful that the site is no longer active and does not appear to have been active at the time the Complaint was filed.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name which is similar to the Domain Names <we-sell-crumpler.co.uk> but that the Domain Name in the hands of the Respondent is not an Abusive Registration. The Complaint therefore fails.

Signed : Simon Chapman

Dated: 02 January 2013