

DISPUTE RESOLUTION SERVICE

D00013172

Decision of Independent Expert

VKR Holding A/S

and

Mr Mark Blainey

1. The Parties:

Lead Complainant: VKR Holding A/S
Breettevej 18
Hørsholm
2970
Denmark

Respondent: Mr Mark Blainey
40 Putney Close
Oldham
Manchester
OL1 2JS
United Kingdom

2. The Domain Name:

velux-repairs.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

06 August 2013 16:24 Dispute received

07 August 2013 12:49 Complaint validated
07 August 2013 13:10 Notification of complaint sent to parties
27 August 2013 02:30 Response reminder sent
30 August 2013 08:24 Response received
30 August 2013 08:24 Notification of response sent to parties
04 September 2013 02:30 Reply reminder sent
09 September 2013 08:53 Reply received
10 September 2013 11:27 Notification of reply sent to parties
10 September 2013 11:27 Mediator appointed
13 September 2013 16:17 Mediation started
11 October 2013 11:03 Mediation failed
11 October 2013 15:22 Close of mediation documents sent
23 October 2013 02:30 Complainant full fee reminder sent
24 October 2013 09:11 Expert decision payment received

4. Factual Background

The Complainant, incorporated in Denmark, manufactures and supplies into the United Kingdom and other countries roof windows and other products under the trade mark VELUX, which it first registered in the United Kingdom on July 28, 1950 in International classes 6 and 19, Registered No. 691115.

The Complainant is also the registrant of numerous domain names incorporating the VELUX trade mark, including <velux.com>, registered on April 19, 1999 and <veluxrepairs.com>, registered on April 24, 2008.

The Domain Name < velux-repairs.co.uk> was registered by the Respondent on 24 January 2013. It resolves to a website offering “a nationwide repair and installation service for velux windows and sky lights”.

5. Parties’ Contentions

Complainant

The Complainant says that, in addition to its registered trade mark rights, through many years of use the Complainant has established common law rights in England in the VELUX trade mark. The resultant reputation and goodwill extend to any goods or services which might be reasonably produced by the Complainant.

The Complainant seeks the transfer to it of the Domain Name because it is an Abusive Registration. It was registered without the knowledge or consent of the Complainant and it was registered and has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights. The Respondent is not authorised or licensed by the Complainant as a dealer of the Complainant’s products or otherwise and there is no affiliation of any kind between the parties.

Unfair advantage

The website to which the Domain Name resolves appears to be a satellite page of the Respondent's main website at www.local-roofer.co.uk. Both websites show the same contact telephone number, both use identical layout and fonts and both contain some identical text. Further, the website to which the Domain Name resolves states: 'The Local Roofer offers a full guarantee on all our velux windows'.

At the 'local-roofer.co.uk' website, the Respondent offers a wide range of services which bear no relation to the Complainant's products. Given the nature of the Respondent's business, the Complainant believes that the Complainant's rights were well known to the Respondent at the time of registration.

The use of the word 'VELUX' as part of the Domain Name is intended to capture a proportion of the Complainant's natural internet traffic, presumably in an effort to boost the Respondent's roofing business. In doing so, the Respondent is taking unfair advantage of the Complainant's rights in its VELUX trade mark.

The Complainant operates a national training programme ('the VELUX Academy') to familiarise tradesmen with VELUX products and provide them with the training and experience needed to carry out their work to a high standard. Those who complete the training receive a diploma, which can be used to demonstrate their competence to potential customers, thereby improving their business. The Respondent has not attended the VELUX Academy, yet his prolific use of the VELUX trade mark and statements such as 'Our skilled craftsmen have the training and experience to ensure we complete all our repair work to the highest standards' on his website (as well as other similarities between the parties' websites) incorrectly suggest that the Respondent has completed this training. The Respondent is thus seeking to increase his income by giving his business a false air of authenticity by taking unfair advantage of the Complainant's rights.

For the avoidance of doubt, use of the Domain Name would be unacceptable in any event, as the completion of the VELUX Academy training course would not entitle the Respondent to use the Domain Name. It is simply a further example of the unfair advantage obtained by the Respondent through unauthorised use of the VELUX mark.

Use of 'VELUX' in the Domain Name gives the incorrect impression that there is a bona fide connection with the Complainant. This is likely to lead to increased sales for the Respondent as a result of initial interest confusion. Such use takes unfair advantage of the Complainant's rights.

Unfair detriment

The Complainant invests substantial resources into maintaining the high standards which its customers expect and for which the complainant's VELUX products have come to be known. The Respondent's use of the Domain Name gives the false impression that the Respondent is affiliated with the Complainant or that the Respondent's services are endorsed, licensed or guaranteed by the Complainant. Any work of inferior quality carried out by the Respondent is

therefore likely to have a damaging effect on the Complainant's reputation and goodwill. In addition, the Complainant's products must be installed according to instructions provided by the Complainant. If the Respondent were to install these products incorrectly this would invalidate the warranty provided by the Complainant. The use of the Domain Name in the manner complained of is therefore unfairly detrimental to the Complainant's rights.

In the 'About Us' section of the Respondent's website, the Respondent states: 'We have a team of expert that cover every type of industrial roofing repairs on skylights, Velux and other roof windows'. The Respondent is therefore using the Domain Name to offer repair and maintenance services in relation to products which are in competition with those of the Complainant. Such use is unfairly detrimental to the Complainant's rights.

Use of the Domain Name to promote the Respondent's business is also likely to erode the distinctiveness of the Complainant's rights, in particular the VELUX trade mark, by reducing the ability of the Complainant's rights to distinguish the Complainant's business from that of other undertakings. This is also unfairly detrimental to the Complainant's rights.

Confusion

The Complainant's VELUX mark is very distinctive. The additional use of the generic suffix '-repairs' as part of the Domain Name does not distinguish the Respondent's business from that of the Complainant. The logo used on each page of the Respondent's website is similar to several of the Complainant's VELUX trade marks. The Respondent has intentionally selected the same red, white and grey colour scheme for his website as that of the Complainant's websites. In the logo on his website, the Respondent has used an almost identical font for the word VELUX to maximise the similarity.

Coupled with the Respondent's extensive use of the VELUX trade mark, the combined effect of these similarities is that the Respondent's use of the Domain Name 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.

The Respondent has no defence to this Complaint because:

- (i) before being aware of the Complainant's cause for complaint, the Respondent has not used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offer of goods or services;
- (ii) the Respondent offers nationwide repair and installation services for roof windows, including VELUX roof windows, so he was aware of the Complainant's rights and cause for complaint long before the Domain Name was registered;

- (iii) the Respondent is not commonly known by the Domain Name or legitimately connected with a mark that is identical or similar to the Domain Name;
- (iv) the unauthorised commercial use of the Complainant's name and marks to promote the Respondent's own business cannot be considered fair use; and
- (v) the Domain Name is not generic or descriptive and the Respondent is not making fair use of it. The distinctive element of the Domain Name is the Complainant's word mark VELUX.

When contacted by the Complainant in March 2013, the Respondent initially agreed to transfer the Domain Name to the Complainant but has failed to do so despite several reminders.

Respondent

The Respondent says he is a Velux specialist who has been installing, repairing and maintaining Velux windows for over 15 years. He advertises services for Velux products that Velux does not provide. The Respondent is not a manufacturer nor does he sell Velux products directly from his site. The Respondent purchases all goods from Velux through the Respondent's suppliers and offers customers a service which they require using Velux's own products, whether replacement parts, complete installations or servicing of Velux products, all purchased from Velux.

Everybody on the Internet who advertises Velux products does so as they wish without question from Velux. Velux however does not want anybody to have a domain name using that name even though people can use that name thousands of times within any other website that they own and that is not a problem.

People who contact the Respondent's website www.velux-repairs.co.uk are made fully aware on every contact form or telephone call that the Respondent is an independent repair and installation specialist. If the Respondent does not manufacture any roof windows and clearly advises all customers that the Respondent is independent of Velux, what is the problem with using this Domain Name? How can thousands of people on the Internet use the Velux brand as they wish but not in a domain name? This does not make sense.

A Google search for Velux reveals hundreds if not thousands of websites with Velux attached pages on them and also websites with Velux in the domain name.

The Respondent's website is called velux-repairs because the Respondent specialises in repairing/maintaining/servicing/installing Velux windows. The Respondent does not use any other roof window products. The Respondent is called velux-repairs because the Respondent repairs Velux windows and only Velux windows.

This is no different from someone who specialises in BMW repairs or Mercedes repairs. For example: www.bmwrepairsbristol.co.uk clearly states that they repair BMW vehicles, not Ford, Citroen or any other brand but BMW. They are not BMW

in Bristol, they are an independent specialist telling their customers that they repair BMW vehicles in Bristol.

The Respondent is simply telling customers that the Respondent repairs Velux windows nationally.

The Respondent chose the Domain Name to direct customers to the service they require, clearly specifying to them the whole time that the Respondent is independent of Velux. The Domain Name states the service that the Respondent offers. The Respondent is not attempting to mislead customers or anybody that the Respondent is Velux. In fact the Respondent is generating more business for Velux. That is why this is such a silly argument.

If it helps, the Respondent says he will gladly put a banner across the top of his website stating that the Respondent is an independent specialist.

Complainant's Reply

The Complainant is not aware of any statement on the Respondent's website which stipulates that the Respondent is an independent specialist. The Respondent has submitted no evidence in support of his assertions.

The Respondent's position that his customers are clearly made aware that he is independent of the Complainant is inconsistent with the way in which his website is presented. If this were the case, the Respondent would not have gone to great lengths to make his website substantially similar in appearance to that of the Complainant.

The Respondent alternatively claims that he informs customers that he is independent of the Complainant when they telephone him. Even if this is correct (which is not admitted and the Complainant notes that the Respondent has submitted no evidence in support of this), by virtue of receiving telephone calls from prospective customers the Respondent has already benefited from the initial interest confusion caused by his website. This type of confusion has been explicitly acknowledged by the Court's decision in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11 in the context of both passing off and trade mark infringement claims.

Even if the Respondent's website did contain a statement that he is independent of the Complainant and/or the Respondent informed his customers of this by telephone, the Domain Name would still be an abusive registration, for the reasons stated in the Complaint. Equally, even if the Respondent obtained no business whatsoever through his website, the Domain Name would still constitute an abusive registration, as its use will have 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.

The Complainant regularly contacts website owners who are believed to be infringing the Complainant's rights and, where appropriate, files complaints under the Nominet DRS or the UDRP in respect of abusive domain name registrations which come to its attention. The Complainant cannot police the internet as a

whole and at any given time there may be other websites which also infringe the Complainant's rights and/or are abusive domain name registrations. However, the existence of such websites is not a defence to this Complaint and is therefore of no assistance to the Respondent. There is no scope for suggesting that the Complainant has somehow consented, whether expressly or by implication, to the existence of such websites.

The Respondent is correct in noting that there are other websites which make use of the VELUX mark in a manner which does not infringe the Complainant's rights and does not constitute an abusive registration. The Complainant has no objection to such use. However, this bears no relation to the use made by the Respondent and is therefore of no relevance to this Complaint.

As to the Respondent's assertion that the Respondent advertises services for Velux products that Velux does not provide, the Complainant is the owner of trade marks registered for services identical to those which the Respondent purports to provide, namely 'VELUX' (CTM 0651869) registered in Class 37 for 'Building construction, repair, maintenance and installation services' since 14 July 2004 and 'VELUX' (fig.) (CTM 5260229) registered in Class 37 for 'Installation, maintenance and repair in connection with windows' since 12 June 2007.

Those trade marks are in use in the UK by the Complainant, its licensees and members of the Complainant's VELUX Installer Partnership scheme, under which use of the VELUX trade marks is permitted in relation to installation services in respect of genuine VELUX products but registration of domain names incorporating the VELUX trade marks is not. Accordingly, even members of the VELUX Installer Partnership scheme (which the Respondent is not) are contractually prohibited from using the VELUX mark in the way that it is being used by the Respondent.

6. Discussions and Findings

Under paragraph 2 of the Dispute Resolution Service Policy ("the Policy") a complainant is required to show, on the balance of probabilities, that;

- (1) it has rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (2) the Domain Name in the hands of the Respondent is an Abusive Registration.

Rights

"Rights" are defined in the Policy 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 Complainant has provided a copy of the certificate of registration of the trade mark VELUX in the United Kingdom, No. 691115, thereby establishing that the

Complainant has rights in that mark enforceable under English law. It is therefore unnecessary to consider whether the Complainant has acquired common law rights in England in that mark.

The VELUX mark is an invented, distinctive word and I find it to be similar to the Domain Name, <velux-repairs.co.uk> since the word “repairs” does nothing to detract from the distinctiveness of the VELUX mark and the hyphen and the “.co.uk” suffixes may be ignored.

The Complainant has established this element.

Abusive Registration

Abusive Registration is defined in the Policy as:

“...a domain name which either;

- (i) was registered or otherwise acquired in the 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.”

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. They include 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.

Paragraph 4(a) of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is not an Abusive Registration. Relevantly for present purposes, these include that the Domain Name is generic or descriptive and the Respondent is making fair use of it.

The essence of the Respondent’s submissions is that the Domain Name does no more than accurately describe the services the Respondent provides in relation to genuine VELUX windows and that this is always made clear to people who complete a contact form on the Respondent’s website or who telephone the Respondent.

The Respondent submits that the Domain Name was chosen because the Respondent repairs VELUX windows. It is therefore clear that the Respondent knew of the Complainant and its VELUX mark when registering the Domain Name.

The colour scheme of the website to which the Domain Name resolves is white, red and grey, as is that of the Complainant’s websites at <velux.co.uk> and <velux.com>.

The Respondent's website features prominently a logo comprising a red background with the word "VELUX" in white capital letters, followed by "Repairs Specialist" [sic] in smaller letters in grey. The Complainant's logo comprises the word "VELUX" in white capital letters on a red rectangle. The font used by the Respondent for the word "VELUX" is very similar to the font used by the Complainant for that word. The shade of red is the same. Both websites feature grey menu tabs. The Respondent's website has a copyright notice at the foot of the home page saying "Copyright © 2013 Velux repairs". There is no reference to a company or other trading name.

The Respondent's website is so similar to that of the Complainant in appearance that it is clear to this Panel that the Respondent is using the Domain Name in a way which is likely to confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The absence of any identification of the Respondent or his company appears designed to give rise to such confusion. Any corrective statements made in response to those visitors to the Respondent's website who complete a contact form or telephone the Respondent cannot retrospectively dispel such confusion.

In light of these findings, it is unnecessary to decide whether the Domain Name, standing alone, generates or would be likely to generate such confusion or whether it conveys no more than that the registrant is a repairer of VELUX windows.

The Complainant has established this element.

7. Decision

I find that the Complainant has proved, on the balance of probabilities, that it has rights in a name which is identical or similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. I therefore direct that the Domain Name be transferred to the Complainant.

Signed Alan Limbury

Dated: November 25, 2013