

## DISPUTE RESOLUTION SERVICE

D00013963

### Decision of Independent Expert

BSW Berleberger Schaumsoffwerke GmbH

and

Durabella

#### 1. The Parties

Lead Complainant: BSW Berleberger Schaumsoffwerke GmbH  
Am Hilgennacker 24  
Bad Berleberg  
57139  
Germany

Respondent: Durabella  
Westgarth  
Bertram Drive  
Baildon  
Bradford  
West Yorkshire  
BD17 7NR  
United Kingdom

#### 2. The Domain Names

regupol.co.uk

#### 3. Procedural History

I can 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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

11 March 2014 16:50 Dispute received

12 March 2014 09:20 Complaint validated

12 March 2014 09:33 Notification of invalid complaint sent to complainant

12 March 2014 09:48 Dispute opened  
12 March 2014 10:35 Notification of complaint sent to parties  
25 March 2014 17:30 Response received  
25 March 2014 17:30 Notification of response sent to parties  
26 March 2014 11:05 Reply received  
26 March 2014 11:06 Notification of reply sent to parties  
26 March 2014 11:08 Mediator appointed  
31 March 2014 13:56 Mediation started  
16 April 2014 12:58 Mediation failed  
16 April 2014 12:59 Close of mediation documents sent  
24 April 2014 09:16 Expert decision payment received

#### **4. Factual Background**

- 4.1 The Complainant is a German company which produces various products including flooring products.
- 4.2 The Complainant is the owner of Community Trade Mark number 009523366 for the word mark REGUPOL which was filed on 29 October 2010.
- 4.3 The Respondent is a company based in the United Kingdom which also supplies flooring products. The Respondent has in the past been a customer for the Complainant's REGUPOL products and ordered them directly from the Complainant.
- 4.4 The Domain Name was registered on 8 June 2010.
- 4.5 The Domain Name currently points to the Respondent's website [www.durabella.co.uk](http://www.durabella.co.uk) which offers flooring products. The REGUPOL product is not listed on the [www.durabella.co.uk](http://www.durabella.co.uk) website.

#### **5. Parties' Contentions**

##### **Rights**

- 5.1 The Complainant contends that it has Rights in a name or mark which is similar or identical to the Domain Name for the following reasons:
- 5.1.1 The Complainant owns the community trade mark registration number 009523366 for the word mark REGUPOL in classes 17, 19 and 27 (the "Trade Mark").
- 5.1.2 The Complainant contends that earlier versions of the Trade Mark have been used and registered by them since at least 1971 and the Trade Mark is used as a mark of origin for a material developed by them
- 5.2 The Respondent contends that DURABELLA has become the generic name for a particular type of floor and that REGUPOL is used in a similar fashion albeit to a much lesser degree.

##### **Abusive Registration**

- 5.3 The Complainant contends that the Domain Name is an Abusive Registration for the following reasons:

- 5.3.1 The Respondent used to be a customer in the UK for the REGUPOL product but the Respondent has not placed any orders with the Complainant for some time. The Domain Name is currently used to re-route traffic to the Respondent's website where a competing product is offered.
  - 5.3.2 The Complainant contacted the Respondent on 14 January 2014 and received a response on 21 January 2014 from Steve Brooke of the Respondent declining to discontinue the re-routing and stating "I am prepared to sell the domain at the right price - at this time I value this much sought after domain at somewhere in the region of £21,000. I would happily sell you this domain for a similar price".
  - 5.3.3 The redirection to a competing site is an abusive activity.
  - 5.3.4 The Complainant is not aware of any other use of the word REGUPOL other than to designate its product.
- 5.4 The Respondent contends that the Domain Name is not an Abusive Registration for the following reasons:
- 5.4.1 The Complainant approached the Respondent to utilise the Respondent's knowledge of the market sector and infrastructure and to infiltrate the UK market. The Respondent thought that it was essential to obtain the Domain Name but the Complainant declined to do so and the Respondent took it upon itself to register the Domain Name. The Complainant started to supply products to competitors of the Respondent and the Respondent was therefore obliged to seek alternatives to the Complainant's product albeit that it continued to offer the Complainant's product alongside other products.
  - 5.4.2 When individuals enter the Domain Name they will come to the Respondent's site which offers a whole range of products including some of which are similar to REGUPOL. If a client asks for a particular REGUPOL range the Respondent will give a price based on the rates available for that product and the Respondent may well offer alternatives which it feels may be more appropriate but if a client chooses REGUPOL the Respondent will provide it as they have no reason not to.
  - 5.4.3 The Respondent's conduct is not trading off, or an abuse of the REGUPOL name it is offering a commercial alternative and the Respondent uses the internet solely as a tool to push these alternatives to the prospective clients.
  - 5.4.4 The main websites that utilise REGUPOL will have subscripts which use the word DURABELLA which the Respondent cannot police as DURABELLA has become the generic name for a particular type of floor and REGUPOL is used in a similar fashion albeit to a much lesser degree.
- 5.5 The Complainant has replied to the Respondent's response as follows:
- 5.5.1 the Respondent acknowledges that the Domain Name was originally registered by the Respondent as an agent for the Complainant;
  - 5.5.2 The Respondent acknowledges that the website to which the Domain Name now redirects does not contain any information whatsoever about the REGUPOL product and it follows that the advertising use to which the

Domain Name is being put is misleading and therefore an abuse within the terms of the Policy.

- 5.5.3 Advertising is misleading when it deceives or is likely to deceive the person to whom it is addressed and which, by reason of its deceptive nature is likely to affect their economic behaviour. The Respondent is showing the person to whom the website is addressed information concerning competing products and this is being done with the clear intention of affecting their economic behaviour by inducing them to buy products offered on the regupol.co.uk website instead of the REGUPOL product which was the subject of their initial interest when they entered the URL regupol.co.uk.
- 5.5.4 The Complainant asserts that REGUPOL is a valid trade mark indicating a specific product having a specific origin.

## **6. Discussions and Findings**

- 6.1 Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:
- 6.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- 6.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

## **Rights**

- 6.2 As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- 6.3 The definition of Rights in the Policy is 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.*
- 6.4 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.
- 6.5 The Complainant's Community Trade Mark for the word mark, REGUPOL and the Complainant's trading history under the name REGUPOL are strong indications that the Complainant has Rights in this name or mark. Against this, the Respondent argues that REGUPOL is name which has become generic and therefore presumably is in common usage. The Respondent has not however provided any evidence to support this assertion and it is denied by the Complainant.
- 6.6 Therefore, in light of the Complainant's Community Trade Mark registration, its prior use and given the low threshold nature of the test for Rights it is difficult to make any other finding than that the Complainant has Rights in the word or mark REGUPOL.
- 6.7 If the .co.uk prefix is disregarded then the Domain Name is identical to the word or mark in which the Complainant has Rights, i.e. the name or mark REGUPOL.

6.8 I therefore conclude that on the balance of probabilities the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

### **Abusive Registration**

6.9 Abusive Registration is defined in Paragraph 1 of the Policy 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

6.10 This definition requires me to determine consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.

6.11 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.

6.12 The Policy provides that it is for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

6.13 In order to make a finding of Abusive Registration under the Policy it has been said that there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's Rights. In some cases where the name in which the Complainant has Rights is particularly well known this will be fairly obvious and straightforward while in other cases where the name in which the Complainant has Rights is less well known and/or where there are other meanings or uses which can be made of the name this will require substantial evidence from the Complainant.

6.14 It is clear in this instance that the Respondent was well aware of the existence of the Complainant and of the name in which the Complainant has Rights at the time the Domain Name was registered and subsequently when the Respondent began to use the Domain Name to re-direct traffic to its own site. This is accepted by the Respondent in its Response and therefore I need not discuss it any further.

6.15 The Complainant's case is that the Respondent is using the Domain Name to redirect internet users to a website that competes with the Complainant in relation to flooring products and that the Respondent's use of the Domain Name is misleading.

6.16 Evidence of Abusive Registration includes the following under Paragraph 3(a)ii of the Policy:

*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;*

- 6.17 The Experts' Overview states in relation to confusion under Paragraph 3(a)ii of the Policy:

*... 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,...*

*...In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.*

*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)...*

- 6.18 In this case the Domain Name contains the name or mark in which the Complainant has Rights without adornment. Further the Respondent is using the Domain Name to re-direct users to its own site which, the Respondent accepts, contains details of products that compete with the Complainant's products and does not contain details of the Complainant's products. Given these facts it is clear to me that potential customers of the Complainant will arrive at the Respondent's site by using the Domain Name (or a url containing the Domain Name). Having done this they will either simply leave or go elsewhere having realised that it is not the Complainant's site or they will look at and may purchase the products being advertised on the Respondent's site. In both scenarios so called initial interest confusion will have occurred although in the second scenario the confusion will go further than that. In either scenario (absent any defence that the Respondent may have) the Respondent's actions amount to an Abusive Registration.
- 6.19 Given all of the above, I am satisfied that on the balance of probabilities the Respondent has used the Domain Name in a manner which takes unfair advantage of and/or which is unfairly detrimental to the Complainant's Rights. Unless the Respondent is able to show the existence of the kind of factors listed under paragraph 4 of the Policy, it follows that the Complainant will have established, on the balance of probabilities, that the Domain Name is an Abusive Registration.
- 6.20 I will now look at the arguments put forward by the Respondent to see whether it is able to rebut this prima facie finding of an Abusive Registration.
- 6.21 The Respondent's case is that the Complainant (1) should have registered the Domain Name when it had the chance, (2) that it would supply REGUPOL products if requested, (3) that it is using the Domain Name to provide commercial alternatives to

REGUPOL when it redirects queries to [www.durabella.co.uk](http://www.durabella.co.uk) and (4) that the REGUPOL name is in some way generic.

6.22 In relation to the Respondent's first point it is true that domain names are generally registered on a first come first served basis. However, this does not mean that it is acceptable to register or use domain names that unfairly take advantage of or are detrimental to third party rights and the Policy has been put in place and developed to provide a low cost and relatively informal way of addressing such issues.

6.23 As regards the Respondent's second and third points evidence against a domain name being an Abusive Registration includes the following under Paragraph 4(a)iA of the Policy:

*Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:*

*used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services.*

6.24 The Experts' Overview in relation to Paragraph 4(a)iA of the Policy states that an "offering of goods or services" will not be "genuine" when:

*...designed to take unfair advantage of or damage the Complainant's rights/business.*

6.25 In this case the Respondent's website does not even advertise the Complainant's products on its website. Its use of the name in which the Complainant has Rights simply cannot be genuine. Indeed I have no doubt that this use is designed to take unfair advantage of the Complainant's REGUPOL brand.

6.26 In relation to the Respondent's fourth point, evidence against a domain name being an Abusive Registration also includes the following under Paragraph 4(a)ii of the Policy:

*The Domain Name is generic or descriptive and the Respondent is making fair use of it.*

6.27 I have said previously that the Respondent has provided no evidence of the generic nature of REGUPOL and it makes nothing more than a bare assertion. In the absence of an evidential basis it is not possible for me to find that the Domain Name is generic or descriptive.

6.28 I am not satisfied that the arguments put forward by the Respondent are sufficient to outweigh the prima facie conclusion that the Complainant has established, on the balance of probabilities, that the Domain Name is an Abusive Registration.

**7. Decision**

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

**Signed Nick Phillips**

**Dated 21 May 2014**