

## DISPUTE RESOLUTION SERVICE

D00014074

### Decision of Independent Expert

E J Brooks (Europe) Limited

and

The Mercian Labels Group Ltd

#### 1. The Parties:

Complainant: E J Brooks (Europe) Limited  
Edgar House  
Berrow Green Road  
Martley  
Worcester  
WR6 6PQ  
United Kingdom

Respondent: The Mercian Labels Group Ltd  
192-198 Watling St  
Cannock  
WS11 0BD  
United Kingdom

#### 2. The Domain Name:

markitwise.co.uk

#### 3. Procedural History:

- 3.1 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 to 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.

### 3.2 Timeline

10 April 2014 11:35 Dispute received  
10 April 2014 12:20 Complaint validated  
10 April 2014 12:23 Notification of Complaint sent to Parties  
17 April 2014 17:14 Response received  
17 April 2014 17:14 Notification of Response sent to Parties  
24 April 2014 02:30 Reply reminder sent  
29 April 2014 09:09 Reply received  
29 April 2014 09:10 Notification of Reply sent to Parties  
29 April 2014 09:12 Mediator appointed  
02 May 2014 15:32 Mediation started  
12 May 2014 16:17 Mediation failed  
12 May 2014 16:28 Close of mediation documents sent  
20 May 2014 12:51 Expert decision payment received

## 4. Factual Background

- 4.1 The Complainant designs, manufactures and supplies high security and tamper-evident seals and devices. It has traded under its name since July 2003.
- 4.2 The Complainant was previously known as Markitwise International Limited. It changed its name in December 2008 to its current name of E J Brooks (Europe) Limited.
- 4.3 The Complainant is the exclusive UK licensee of the registered Community trade mark for the word mark MARKITWISE. This trade mark was registered on 16 July 2007, in the name of E.J. Brooks Company with an address in the United States of America, under number EU006103121 and classes 16 and 17 (the "Trade Mark").
- 4.4 The Domain Name was previously owned by the Complainant until it allowed its registration to lapse on or around August / September 2013.
- 4.5 The Respondent is a manufacturer of tamper-evident security labels and sealing products, and sells security labels worldwide through a network of specialist distributors to various entities including airlines, retailers, manufacturers, resellers, police, governments, hospitals, forensic experts and pharmaceutical companies.
- 4.6 The Respondent acquired the Domain Name on 21 October 2013, from Sonexo B.V., a third party unconnected with either the Complainant or the Respondent. The Domain Name is being used by the Respondent to "back-link", or redirect Internet users, to its website located at <www.labellock.com>.

## 5. Parties' Contentions

### The Complainant

5.1 The Complainant's contentions are summarised as follows:

### Rights

- 5.2 The Complainant is a global leader in the design, manufacture and supply of high security and tamper-evident seals and devices. It forms part of TydenBrooks Security Products Group, which has a manufacturing, sales and marketing presence in over 50 countries, providing a broad range of security solutions to a wide group of industries, including transportation, retail, agriculture, petrochemical, pharmaceutical, healthcare, commercial airlines, manufacturing and many other industries.
- 5.3 The Complainant trades throughout the UK under various trade marks, including the Trade Mark for which it is the exclusive UK licensee.
- 5.4 The Complainant offers particular goods under the Trade Mark, namely "MARKITWISE PROPERTY MARKING" (the "Product"). The Product enjoys a market leading position.
- 5.5 The Complainant has used the Trade Mark extensively throughout the UK in relation to the classes for which it is registered. The Trade Mark is clearly displayed on the Product as well as on the Complainant's marketing materials. The Complainant set up retail websites to market the Product (and other products) to customers, including one under the Domain Name, which automatically redirected Internet users to its main website at <www.tydenbrooks.eu>.
- 5.6 The Complainant enjoys and benefits from substantial goodwill and reputation in the Trade Mark.
- 5.7 The Domain Name incorporates wording identical to the Trade Mark.

### Abusive Registration

- 5.8 The Domain Name was inadvertently allowed to lapse, and before the Complainant noticed and could re-register the Domain Name it was acquired by the Respondent.
- 5.9 The Respondent is a direct competitor of the Complainant. Both Parties have a significant presence in the UK market for tamper-evident security labels and seals.
- 5.10 The Complainant initiated correspondence with the Respondent on 27 February 2014, asserting rights in the Trade Mark and requesting the Respondent to transfer the Domain Name back to the Complainant. The Respondent replied by email on 28 February 2014, in which it makes

contentions that it repeats and expands upon in its Response (as to which see paragraphs 5.16 to 5.33 below). The Complainant's solicitors issued a pre-action letter to the Respondent on behalf of the Complainant on 5 March 2014. No response to that letter was received.

- 5.11 The Respondent's registration of the Domain Name, which incorporates a competitor's trade mark, after the Complainant had inadvertently allowed its registration of the Domain Name to lapse, and its use of the Domain Name to gain a commercial advantage, is a clear example of bad faith.
- 5.12 The Respondent has acquired the Domain Name for the purpose of stopping the Complainant from using it and to trick the Complainant's customers into using its website. The Respondent's only intention in acquiring the Domain Name and redirecting it to the Respondent's own website is to take advantage of the Complainant's goodwill. This is clear bad faith and there is no link between the Trade Mark and the Respondent.
- 5.13 Consumers of sealant and labelling products use the term MARKITWISE in search engines when trying to locate the Complainant's Product. By registering the Domain Name and redirecting it to the Respondent's website, the Respondent is taking advantage of the Complainant's reputation in its Product and seeking to confuse consumers into believing that their business or products are associated with the Complainant or its Product. Furthermore, the Respondent's website will be listed in search engine results when consumers use the Complainant's Trade Mark via search engines to locate it. This will drive further traffic to the Respondent's website off the back of the Complainant's goodwill.
- 5.14 There is a serious likelihood that the Respondent's use of MARKITWISE will cause confusion in the marketplace as members of the public will believe that its goods and services belong to the Complainant or are associated or otherwise approved by it. This confusion will undoubtedly cause damage to the Complainant's business and goodwill.
- 5.15 Acquisition and use of the Domain Name in the manner described above constitutes an infringement by the Respondent of the Complainant's rights in the Trade Mark.

#### The Respondent

- 5.16 The Domain Name was allowed to lapse by the Complainant around late August / early September. It was then registered by a third party, who the Respondent believes to be Sonexo B.V., a Dutch company which the Respondent had no prior knowledge of or connection to.
- 5.17 On 13 October 2013 the Respondent became aware from the website that the Domain Name resolved to that the Domain Name was for sale, and it made an enquiry to purchase it from the registrant. It would therefore have been also available to purchase by the Complainant should it have wanted to.

- 5.18 On 21 October 2013 the Respondent acquired the Domain Name in good faith.
- 5.19 The sole purpose of the Respondent to register the Domain Name was for its back link profile value to assist the Respondent in its search engine rankings for terms associated with security seals and marking products, a product range that it has sold for many years through its wholly owned subsidiary Mercian Labels Ltd under the Label Lock registered trade mark.
- 5.20 It is widely accepted in the online marketing industry that the historic back link profile of old domains has value in online marketing. The number and quality of back links to a domain name increases its value.
- 5.21 A screen shot dated 26 October 2013 of the Complainant's main website (<www.tydenbooks.eu>) (provided by the Respondent as evidence to its Response) shows that the Complainant was not using no use of the Trade Mark to market any products online under the MARKITWISE name at the time of acquisition of the Domain Name by the Respondent.
- 5.22 This supported the Respondent's belief that the reason the Complainant had chosen not to renew their registration of the Domain Name was that it had continued its re-branding from "Markitwise" to the "Tyden Brooks" trading style post its 2007 acquisition of Markitwise International Limited. This was consistent with the Respondent's observations of the marketing of the Complainant for some years after 2009.
- 5.23 At the time of the Respondent's acquisition of the Domain Name it genuinely believed that the Complainant no longer needed the Domain Name. The Complainant's actions in letting its registration of the Domain Name lapse supported this belief. Further, the Domain Name had not actively been used for a standalone website by the Complainant for some time prior to the Complainant letting its registration lapse, but rather had simply redirected it to its main website homepage.
- 5.24 The Respondent attaches various screenshots of the Wayback Machine dated between July 2009 and May 2013 in evidence to its Response, in order to support its contentions regarding the Complainant's redirection of the Domain Name and lack of recent use of the Trade Mark. The most recent screenshot which evidences the Complainant's active marketing of the old, now unused, "Markitwise" logo and products is dated 14 July 2009. Further, on the "About" page of the Complainant's main website at <www.tydenbrooks.eu>, there is no mention of the acquisition of the Markitwise company or product range as the Complainant has fully integrated the "Markitwise" trading style into its core "Tyden Brooks" name and trading style, despite it listing other acquisitions it has made.
- 5.25 The Complainant stopped actively using the "Markitwise" trading style at least 4.5 years ago and has, to all practical purposes, dropped its use in the marketplace whilst still retaining the legal title to the registered trade mark. Whilst ownership of this trade mark continues until 16 July 2017, the Complainant has in practice ceased to use it and is therefore suffering no

loss whatsoever from the Respondent's use of the Domain Name. The Complainant therefore has no rights in respect of a name or mark which is identical or similar to the Domain Name, as any value in these rights that it may have had has significantly deteriorated to a negligible level.

- 5.26 Immediately after the Respondent's acquisition of the Domain Name, it redirected the Domain Name to its website at <www.labellock.com> selling security sealing products, wholly consistent with the Respondent's original reason for legitimately registering the Domain Name. It has only been used in this manner since the Respondent's acquisition of it. The Respondent has never hosted a website on the Domain Name nor has it used the Trade Mark on its site. It is not passing itself off as the "Markitwise", "E J Brooks" or anything similar. As a reputable business it fully respects other people's intellectual property. The Complainant has provided no evidence in support of its allegations in this regard.
- 5.26 In its correspondence with the Complainant in February 2014, the Respondent challenged the Complainant's allegations that its registration of the Domain Name as abusive. No evidence of alleged abusive use of the Domain Name as offered in return.
- 5.27 When the Respondent was notified of the Complaint, it re-visited the Complainant's website and it showed no products being marketed under the "Markitwise" name.
- 5.28 The Respondent rebuts various aspects of the Complainant's case and there is a lack of evidence supporting these aspects. In particular, it denies that (i) the Complainant has used the Trade Mark extensively throughout the UK, (ii) the Trade Mark is clearly displayed on the Product as well as on the Complainant's marketing materials, (iii) the Complainant enjoys substantial goodwill and reputation in the Trade Mark, (iv) it acquired the Domain Name primarily for the purpose of unfairly disrupting the Complainant's business and to trick customers into using the Respondent's website. As the Respondent does not use the Trade Mark in the marketplace there is no risk of confusion and no risk to the Complainant's business and goodwill. The Respondent has not supplied, promoted, marketed, advertised, sold or offered for sale any goods under the Trade Mark.
- 5.29 With regard to the Complainant's non-renewal of its registration of the Domain Name, the Complainant has provided no evidence to prove that its non-renewal was inadvertent. The Complainant would have received regular email reminders that it chose to ignore. It also had weeks to notice that its allegedly valuable intellectual property was compromised and an opportunity to acquire the Domain Name from Sonexo B.V. prior to the Respondent acquiring it, but it failed to do so. The Respondent believes that the Complainant may have intentionally let the Domain Name lapse as it was redundant, obsolete and of no use to the Complainant and therefore enabled it to save on costs by not renewing it. The fact that it took the Complainant over 5 months to notice that the Domain Name was

no longer redirecting to its website and to contact the Respondent is clear evidence that the Domain Name was not valuable to it.

- 5.30 Whilst the Complainant may now, with the benefit of hindsight, wish that they had renewed the Domain Name to secure its valuable back link profile, this was its mistake, not the Respondent's, and it is not at liberty in this situation to change its mind and force the Respondent to suffer a loss.
- 5.31 The Complainant admits that it used the Domain Name to redirect Internet users to a different website, in support of the Respondent's claim that the only value in the Domain Name is in its back link (redirect) profile. The Respondent is entitled to use the Domain Name in this way in the same way that the Complainant used the Domain Name to redirect users to the Complainant's main website. Use of the Domain Name in this way is legitimate and fair, and not abusive.
- 5.32 The Respondent has not infringed the Trade Mark. In any event, the Complainant's claim under the DRS Policy is connected with alleged Abusive Registration (defined under the Policy) and not with trade mark infringement. Whilst the Respondent accepts that the Complainant enjoys a registered trade mark for MARKITWISE, this does not allow them to automatically take the Domain Name back again.
- 5.33 The Complainant's use of the Trade Mark on its main website in March 2014, as evidenced by the Complainant, was a fabricated and deceptive act to support the Complainant's solicitors' letter of 5 March 2014 in which the Complainant claims legitimate and continued use of the Trade Mark in trade.

#### The Reply

- 5.34 The Complainant repeats a number of its contentions made in its Complaint. I have disregarded these as Paragraph 6(b) of the Procedure makes it clear that any reply by the Complainant must be restricted to *"matters which are newly raised in the Respondent's response and were not raised in the Complainant's complaint"*.
- 5.35 The Complainant does however expand upon the issue of its own use of the Trade Mark in response to the Respondent's allegations that the Complainant is not making any use of the Trade Mark. The Complainant admits that it gradually ceased to use "Markitwise" as a primary trading name following the acquisition of Markitwise Limited by E J Brooks Company in 2007. Since that time the Complainant has traded in Europe primarily under the Tyden Brooks name. However, the Complainant has continued to use the "Markitwise" name and trade mark to refer to its Markitwise property marketing products and has used the Domain Name (until it inadvertently allowed it to lapse) and the related domain <www.markitwise.com> (which it continues to hold) to divert to its primary website at <www.tydenbrooks.eu>. The "Markitwise" logo and products have featured intermittently on the Complainant's primary website in recent years but the Markitwise product has been manufactured and sold throughout that time and its goodwill in the name persists. The

Complainant absolutely denies the Respondent's allegation that the contents of its primary website have ever been altered with a view to "fabricating" evidence for these or any other proceedings.

## 6. Discussions and Findings

### General

- 6.1 The Complainant is required under paragraph 2(b) of the Policy to prove to the Expert, on the balance of probabilities, that:
- (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### Complainant's Rights

- 6.2 Paragraph 1 of the Policy provides that 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*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.3 The Complainant asserts that it is the exclusive UK licensee of the trade mark MARKITWISE, registered as a Community Trade Mark. The Respondent acknowledges this trade mark registration and does not challenge the Complainant's assertion of it being an exclusive licensee.
- 6.4 The question of whether an entity other than the owner of the registered trade mark relied upon can establish Rights for the purposes of the Policy was considered in the case of *Seiko UK Limited -v- Designer Time/Wanderweb*, DRS 00248, in which the Appeal Panel held that:
- "The requirement to demonstrate 'rights' is not a particularly high threshold test. It is satisfied in our view by the assertion of Seiko UK Limited that it is duly authorised by the trade mark owner to use the mark and to bring the Complaint. Where a complainant is a subsidiary or associated company of the trade mark proprietor, such an assertion will in our view generally be sufficient to demonstrate 'rights' in the absence of any good reason to doubt the veracity of that assertion".*



- 6.5 Further, paragraph 1.1(a) of the Expert's Overview<sup>1</sup> acknowledges the position of a licensee and states that "*The Complainant should be the owner/licensee of the Rights in the name of mark, which the Complainant contends is identical or similar to the domain name in dispute.*"
- 6.6 In light of the assertions made in the Complaint by the Complainant regarding its position as an exclusive UK licensee of the Trade Mark and its corporate history and structure, both of which are unchallenged by the Respondent, I am prepared to find that the Complainant has sufficient standing to bring this Complaint.
- 6.7 In addition, although there is a dispute between the Parties in relation to recent use of the mark MARKITWISE by the Complainant (as to which see further below), I am prepared to accept that the Complainant, particularly when trading under its previous name of Markitwise International Limited, will have made some use of the mark MARKITWISE in the UK prior to the Complaint being brought, even though the evidence supporting the actual use is very weak. The Complainant has made contentions that it has used the Trade Mark (MARKITWISE) extensively throughout the UK in relation to specific goods and that the Trade Mark is clearly displayed on the Product, but the only piece of supporting evidence of use of the Trade Mark is a screenshot of a page within the Complainant's website dated 4 March 2014 which is headed "Markitwise Property Marking" and then lists various products including a "Permenant (sic) U.V. Ink Marker" and "The Safeguard Personal Alarm". Neither of the descriptions for these products on this page of the Complainant's website refers or mentions to the mark 'MARKITWISE'. That said, in my opinion the mark is not wholly descriptive of the type of products offered under it, and the Respondent itself admits that it acquired the Domain Name for its redirection value.
- 6.8 The Respondent claims that, as the Complainant has not used this mark for some 4 and a half years, the Complainant no longer enjoys rights in this mark. The fact that the Complainant is an exclusive licensee (unchallenged by the Respondent) of a registered trade mark (acknowledged and admitted by the Respondent), and that the Respondent is only challenging the recent use (i.e. use after 2009) of the mark by the Complainant are in my opinion sufficient to determine on the balance of probabilities that the Complainant has Rights in the mark MARKITWISE. If the Respondent is correct in its assertion that the Complainant has not used this mark since 2009 then these Rights may not be as strong as they were if the Complainant was continuing to actively promote its products under this term beyond that time, but I am satisfied that there is at least some residual value in the mark to the Complainant and the licensor of the mark. This issue is however also relevant to the second limb of the Policy, namely whether the Domain Name, in the hands of the Respondent, is an Abusive Registration and I consider this further under the Abusive Registration section below.

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<sup>1</sup> The Experts' Overview is a document promulgated by Nominet's panel of Experts which deals with a range of issues that come up in DRS disputes and provides parties to DRS disputes with helpful guidance in respect of the Policy and Procedure.

- 6.9 In light of the above, and in particular the low threshold that the Complainant needs to meet in order to establish Rights under the Policy, I am satisfied that the Complainant has Rights in the mark MARKITWISE.
- 6.10 This Domain Name comprises the mark MARKITWISE, in which the Complainant has Rights, in its entirety excluding the generic top level <co.uk> suffix. Accordingly, I find that on the balance of probabilities the Complainant has Rights in respect of a name or mark which is identical to the Domain Name.

### Abusive Registration

- 6.11 Paragraph 1 of the Policy defines “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 has been unfairly detrimental to the Complainant’s Rights.
- 6.12 Paragraph 3 of the Policy sets out a non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may be evidence that the Domain Name is not an Abusive Registration.
- 6.13 The Policy provides 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.
- 6.14 The Complainant relies on paragraphs 3(a)(i)(C) and 3(ii) of the Policy together with a claim that the Respondent’s use of the Trade Mark is an infringement of the Complainant’s rights, to make out its case on Abusive Registration.
- 6.15 The Respondent on the other hand, in attempting to demonstrate that the Domain Name is not an Abusive Registration, makes contentions that in essence focus on paragraphs 4(a)(i)(A) and (C) of the Policy.
- 6.16 At the heart of this case is an interesting question of whether the acquisition of a domain name (a) that comprises a mark which a Complainant has ceased to use, either in its entirety or to a significant extent and (b) that the Complainant allowed (whether inadvertently or otherwise) to lapse, by a Respondent that competes with the Complainant, constitutes an Abusive Registration.

- 6.17 Each of the relevant factors of paragraph 3(a) involves the issue of the relevance of knowledge and intent to a determination of whether a domain name is an Abusive Registration. The Respondent is a competitor of the Complainant and makes reference to the fact that it has observed the marketing of the Complainant for some years post 2009. In light of the fact that the Complainant and the Respondent are in the same, relatively niche, industry of (inter alia) manufacturing and supplying security seals and labels claims, in my view it is inconceivable that the Respondent did not know of the Complainant at the time of acquisition of the Domain Name in October 2013.
- 6.18 However, was the Respondent aware of the Complainant's Rights in the MARKITWISE name at the time that it acquired the Domain Name? According to the Respondent itself, its sole purpose in acquiring the Domain Name was to benefit from the "back link" (redirect) profile of the Domain Name and assist it in its search engine rankings for terms associated with security seals and marking products. As noted above, in my opinion the mark MARKITWISE (in which the Complainant has Rights) is not wholly descriptive of such products and so in acquiring the Domain Name for this purpose the Respondent must have had some knowledge of this mark and, given the Complainant and the Respondent's competing interests, the association between the mark and the Complainant at the time of acquisition of the Domain Name.
- 6.19 In addition, the Respondent sells its products under a completely different mark ("Label Lock") to the one contained within the Domain Name ("Markitwise"). The Respondent is using the Domain Name to redirect Internet users to its website at <www.labellock.com> but this domain name and the website to which it and the Domain Name resolve have no connection with or link to the MARKITWISE mark. There is no link between the mark contained in the Domain Name and the Respondent's business other than the MARKITWISE mark having an association with a competitor of the Respondent.
- 6.20 I therefore consider that, on the evidence before me and on the balance of probabilities, the Respondent had knowledge of the business operated by the Complainant, and specifically of the Complainant's mark MARKITWISE, when it acquired the Domain Name.

Paragraphs 3(a)(i)(C) and 3(a)(ii)

- 6.21 Paragraph 3a.(i)(C) refers to where the Respondent has registered the domain name primarily *"for the purpose of unfairly disrupting the business of the Complainant"*. Paragraph 3(a)(ii) states: *"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"*.
- 6.22 The Respondent contends that it acquired the Domain Name solely to redirect Internet users to its own website at <www.labellock.com> and that

it continues to use (and has only ever used) the Domain Name in this way. There is no evidence of use of the term “MARKITWISE” by the Respondent other than in respect of the Domain Name itself and the Respondent specifically denies that it has supplied, promoted, marketed, advertised, sold or offered for sale any goods under this term.

- 6.23 In light of the finding on the balance of probabilities that the Respondent would have had knowledge of the Complainant and its MARKITWISE mark at the relevant time, and the fact that the Respondent has admitted that it has never traded as “Markitwise” other than in relation to the Domain Name, I am persuaded that the Domain Name was acquired to benefit from the reputation and goodwill of the Complainant and the MARKITWISE mark (even if such reputation and goodwill is limited in this case given the limited use (if any) to which this mark has been put since 2009). By doing so, it is likely to attract internet users who are looking for the Complainant and its MARKITWISE product range to the Respondent’s website, in order that those users would instead conduct business with the Respondent rather than with the Complainant.
- 6.24 The Domain Name comprises the name in which the Complainant has Rights, namely MARKITWISE, in its entirety. The Respondent has not sought to distinguish the Domain Name from the Complainant or its business in any way (commonly known as “unadorned use”).
- 6.25 Further, the Respondent has itself admitted that the value in the Domain Name is in its back link (redirection) profile and will assist the Respondent in its search engine rankings for terms associated with security seals and marking products. The Expert therefore considers there to be a reasonable chance that “initial interest confusion” could apply in this case (i.e. consumers searching online for the Complainant and its business are likely to expect there to be some connection between the website operated under the Domain Name and the Complainant, even before they arrive at that website). As stated in paragraph 3.3 of the Expert’s Overview:
- “the overwhelming majority of Experts view it [initial interest confusion] 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.”*
- 6.26 Given the considerations above, there appears to be an arguable case for the Complainant that the Respondent is using the Domain Name in a way which 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 pursuant to paragraph 3a.(ii) of the Policy.

Paragraphs 4(a)(i)(A) and (C)

- 6.27 Paragraphs 4(a)(i)(A) and (C) state that *“Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has:*
- (A) 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 offering of goods or services;*
- (C) made legitimate non-commercial or fair use of the Domain Name”.*
- 6.28 The Respondent’s case in this regard is that:
- it acquired a domain name which was valuable to it solely for its back link (redirection) profile;
  - the Complainant intentionally let its registration of the Domain Name lapse as it had no need for the Domain Name following its cease of use of the Trade Mark; and
  - the Complainant could have re-acquired the Domain Name before the Respondent did but chose not to do so.
- 6.29 In relation to paragraph 4(a)(i)(A), in light of (a) the Complainant’s Rights in the mark MARKITWISE (albeit limited given its limited, or relative lack of, use since 2009), (b) the fact that the Domain Name comprises this mark in its entirety, (c) the fact that the Respondent and Complainant are competitors, and (d) the use that the Respondent has put and continues to put the Domain Name to since it acquired the Domain Name, I consider that the Respondent’s use of the Domain Name is designed to take unfair advantage of or cause damage to the Complainant’s rights and/or its business and cannot therefore be considered to be use in connection with a genuine offering of goods and services.
- 6.30 The Respondent, in redirecting the Domain Name to its own website which promotes the Respondent’s Label Lock products, is making commercial use of the Domain Name and so the only remaining issue to consider is whether the Respondent has made “legitimate fair use” of the Domain Name.
- 6.31 I am satisfied that the Respondent’s use of the Domain Name will give rise to potential for confusion and at least some disruption to the Complainant’s business. The Respondent’s stated motives in acquiring the Domain Name support this finding. Further, although the Complainant’s Rights in the mark MARKITWISE may be weak (given its diminishing use of the mark and its rebranding exercise), they are not non-existent. It is the exclusive licensee of a trade mark which, to all intents and purposes based on the evidence provided, is registered as a Community Trade Mark. The DRS Policy is not the appropriate forum to be deciding on whether the facts of this case lead to a finding of trade mark infringement and/or determining the validity of a trade mark registration.
- 6.32 In addition, the fact that the Complainant did not renew, or subsequently acquire, the Domain Name does not automatically mean that the Respondent can acquire and use the Domain Name in the manner that it has, and then claim to be making legitimate fair use of it. If the

Complainant and the Respondent were not competitors, and if the Respondent's use had differed to the actual use that the Domain Name is being put (i.e. to simply redirect to the Respondent's website to boost its search engine rankings and maximise the value in the back link profile of the Domain Name), then there could have been an arguable case that the Respondent had made legitimate fair use of the Domain Name. I do not accept that the Respondent's use of the Domain Name in this case constitutes legitimate fair use.

## **7. Decision**

- 7.1 I find that the Complainant has Rights in the mark MARKITWISE which is identical to the Domain Name, and further that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I therefore direct that the Domain Name should be transferred to the Complainant.

**Signed      Ravi Mohindra                      Dated      12 June 2014**