

DISPUTE RESOLUTION SERVICE

D00017131

Decision of Independent Expert

Dematic GmbH

and

Jack Ha

1. The Parties:

Complainant: Dematic GmbH
Lyoner Strasse 9
Frankfurt
Hessen
60528
Germany

Respondent: Jack Ha
No.176 Chestenter Road
Cambridge
Cambs
DT9 6NX
United Kingdom

2. The Domain Name(s):

dematic.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 which might be of such a

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

The following steps have taken place in this matter:

23 February 2016 16:11 Dispute received
24 February 2016 08:42 Complaint validated
24 February 2016 08:51 Notification of complaint sent to parties
17 March 2016 08:26 No Response Received
17 March 2016 08:40 Notification of no response sent to parties
29 March 2016 12:13 Expert decision payment received

4. Factual Background

The following facts appear from the documents submitted to me and which I find as proven and which form the basis of my Decision:

- i. The Complainant is a business specialised in the area of logistical systems solutions, targeted at automating other businesses' distribution centres, warehouses and factories.
- ii. It has focused its operations on the clothing industry.
- iii. It trades under the name, "Dematic".
- iv. It is the registered proprietor of a number of trade marks including <DEMATIC> registered in the USA on 4 June 2002 under number 2,574,799.
- v. The Respondent registered the Domain Name on or about 29 January 2016.
- vi. The Respondent is using the Domain Name to operate a website which purports to be an on online shop called "The Soccer Shop" and appearing to sell replica soccer sports clothing.
- vii. The Respondent has provided incorrect geographical addresses to Nominet which are unknown by the postal service and cannot be located using Google Maps.

5. Parties' Contentions

The Complainant makes the following submissions:

- i. The Respondent registered the Domain Name long after the Complainant acquired its Rights.
- ii. The Domain Name is identical with the Complainant's Rights, apart from the addition of the suffix reflecting the top level domain (".co.uk").
- iii. The operation of an online shop selling replica sports clothing is taking unfair advantage of the Complainant's Rights.
- iv. As the Domain Name is identical with the Complainant's Rights, visitors to the website will likely be confused as to whether it is authorised, operated or otherwise sanctioned by the Complainant.
- v. The Respondent's use of the Domain Name is unfairly trading on the Complainant's Rights.

- vi. The Respondent has no legitimate or other business interest in using the Domain Name and so it is likely that the Respondent is using the Domain Name to take unfair advantage of the Complainant's Rights by trading on the Complainant's goodwill.
- vii. Accordingly, the Complainant requests that the Domain Name be transferred to it.

The Respondent made no response.

6. Discussions and Findings

Any complainant in the Nominet DRS procedure must prove, on the balance of probabilities, that he has Rights and that the respondent's registration or continued registration of a domain name, is an "Abusive Registration". I shall look at each of these concepts in order.

Rights

"Rights" are defined in the DRS 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*".

Under paragraph 2(a) of the DRS Policy, a complainant must show that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*".

Where there are registered trade marks demonstrating the existence of Rights, it is relatively simple to show the existence of those trade marks by exhibiting a copy of the relevant certificate. As the Experts Overview¹ states at paragraph 2.2,

"... Bare assertions will rarely suffice. The Expert needs to be persuaded on the balance of probabilities that relevant rights exist. ...

If the right arises out of a trade mark or service mark registration, a copy of the registration certificate or print out of the registry database will suffice ..."

I accept the Complainant's evidence of a trade mark registration in the USA: this alone would suffice; however, the Complainant has also attached what appears to be a printout from WIPO showing the status of the trade mark <DEMATIC> in a large number of other countries including Denmark, Spain, the UK, Finland, Sweden and other countries besides.

I accept this evidence as showing that the Complainant has Rights as required by the DRS Policy.

¹ The Experts Overview is a distillation of Experts' Decisions given under the Nominet DRS Policy and provides a helpful summary of how the DRS Policy is applied in practice.

Abusive Registration

The DRS 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;”*

The Respondent has not of course made any formal or other response in these proceedings. However, I have had the benefit of seeing the website operated at the Domain Name, and attach as the Annex to this Decision a copy of the website at the Domain Name as at the time of writing this Decision.

The Complainant has relied on a number of grounds to show that the use here is an Abusive Registration. Paragraph 3 of the DRS Policy contains a non-exhaustive list of those factors which can be evidence of an Abusive Registration.

Those grounds from the DRS Policy which are relevant are the following.

Paragraph 3(a)(i)(C) – for the purpose of unfairly disrupting the business of the Complainant

I have accepted the Complainant’s evidence showing that it is engaged in the logistics business and is focused on providing services to the clothing sector. I accept that the Respondent has been – and still is – using the Domain Name to host a website which purports to be an online shop called, “The Soccer Shop”.

The name “Dematic” is not obviously one which would be applied to soccer or soccer clothing. It is not even a regular English word. The Respondent has not provided any sort of information or explanation which would explain the choice of name.

However, on the basis of these factors, it seems improbable that the registration was made primarily to disrupt the Complainant’s business, as the Complainant is in a completely different line of business altogether. While I accept that the Complainant is providing services to businesses operating in the clothing sector, most consumers would not be aware of this and would not confuse the Complainant with the actual producer of clothing or, in particular, sports clothing or, to be really precise, replica soccer clothing of well known soccer clubs’ “strips”. Equally, businesses going to the Respondent’s website operating under the Domain Name would not be sending business to the Respondent that they might otherwise send to the Complainant.

I find this ground therefore unproven.

Paragraph 3(a)(ii) – 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

In this case, it is rather different. I accept the Complainant's submissions that it is closely associated with the clothing sector, albeit in the context of providing logistical services to that sector.

However, this paragraph invites me to look at the matter from the context of not only a consumer but also a business. I have no evidence of actual confusion, but I am also asked to consider whether there might be potential confusion. The paragraph is drafted very broadly – I have to ask whether the confusion does not just relate to businesses potentially thinking that the Domain Name is actually owned or operated by the Complainant, but whether it might in some way be authorised by it, or even just in some way connected with it.

I take into account the fact that there is no obvious connection between the name “Dematic” and soccer or soccer clothing and that “Dematic” is not a regular English word. I take account of the fact that the Complainant is known by that name and trades under it using its Rights.

I therefore conclude that there is the risk of potential confusion arising among businesses, which might be confused into thinking that the Complainant was in some way authorising a new line of business (namely, soccer clothing) or was lending its support to such an enterprise. Given that the Complainant operates in the area of logistics, there is in my view, a real risk of confusion in that third parties might think that the Complainant was providing its services for the purposes of the logistical operations behind the Respondent's online shop.

I therefore find this ground made out on the balance of probabilities.

Paragraph 3(a)(iv) – it is independently verified that the Respondent has given false contact details to Nominet

The Experts Overview says of this ground,

“Delivery service or post office certification will certainly suffice, but it is not necessary to obtain formal verification. An authoritative letter, email or note from a third party explaining how the contact details are known to be false will usually suffice.”

I have before me returned copy mail and the Complainant has also provided copy screenshots of attempted Google Maps searches for either of the addresses provided by the Respondent. It is possible that the address at “Chestenter Road” is a mistake for “Chesterton Road” as noted on the copy envelope in my documents, however, the postcode is not one used in Cambridge and so it is still the case that the address actually given is not apparently a real one.

From this evidence, I accept that the Respondent has provided inaccurate contact details to Nominet and I find this ground made out.

Evidence demonstrating that there is no Abusive Registration

Paragraph 4 of the DRS Policy contains a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. It is explicitly stated that the list is non-exhaustive and so I have considered the whole matter from a general perspective as well as looking at the factors actually listed in paragraph 4.

I find that none of the factors in paragraph 4 is applicable to this matter, and that there are no other factors relevant to show that the Domain Name is not an Abusive Registration.

My conclusion is that there is no evidence before me to indicate that the Domain Name is anything other than an Abusive Registration.

7. Decision

I find that the Complainant has Rights identical to the Domain Name and that the registration and/or use of the Domain Name by the Respondent is an Abusive Registration.

I direct that the Domain Name be transferred to the Complainant.

Signed Richard Stephens

Dated 19 April 2016

ANNEX

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<http://www.dematic.co.uk/>[11/04/2016 10:54:49]