

DISPUTE RESOLUTION SERVICE

D00017252

Decision of Independent Expert

Nudura Corporation

and

Jason Colling

1. The Parties

Complainant: Nudura Corporation
27 Hooper Road, Unit #10
Barrie
Ontario
L4N 9S3
Canada

Respondent: Jason Colling
17a Prospect Terrace
Willington
Crook
DL15 0DT
United Kingdom

2. The Domain Name

<nudura.co.uk> (“the Domain Name”)

3. Procedural History

Expert’s Declaration: 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.

23 March 2016 13:16 Dispute received
23 March 2016 14:47 Complaint validated
23 March 2016 14:51 Notification of complaint sent to parties
31 March 2016 10:00 Response received
01 April 2016 16:11 Notification of response sent to parties
06 April 2016 02:30 Reply reminder sent
11 April 2016 13:18 Reply received
11 April 2016 13:18 Notification of reply sent to parties
11 April 2016 13:19 Mediator appointed
15 April 2016 10:56 Mediation started
06 May 2016 15:42 Mediation failed
06 May 2016 15:42 Close of mediation documents sent
18 May 2016 02:30 Complainant full fee reminder sent
20 May 2016 16:15 Expert decision payment received
20 May 2016 17:11 Expert appointed: Steven A. Maier

Having reviewed the Complaint, Response and Reply in this case I concluded that, while both parties had made submissions potentially of relevance to their case, neither had provided adequate particulars or evidence in support of certain of those matters. I therefore made a procedural direction on 25 May 2016, under paragraph 13 of the Nominet DRS Procedure (“the Procedure”), that each party provide further information addressed to certain specified issues by 1 June 2016, with each party being at liberty to reply to the other’s further submissions by 8 June 2016. The parties were reminded that in the event of their non-compliance, the Expert would draw such inferences as he considered appropriate.

The Complainant provided a further statement on 1 June 2016 but no further submission or reply was received from the Respondent.

4. Factual Background

The Complainant is a corporation located in Canada. It is a supplier of integrated concrete forms and other materials used in the construction industry.

The Complainant is the proprietor of Community Trade Mark (“CTM”) number 003686748 for NUDURA, registered on 8 July 2005, with a filing date of 8 March 2004, in Classes 17, 19 and 41.

The Domain Name was registered on 9 March 2004.

There is no evidence that the Domain Name has ever resolved to any active website.

5. Parties' Contentions

The Complainant

The Complainant states that the name and trademark NUDURA has no generic or everyday meaning and that it is an invented term which represents a formwork product unique to the Complainant.

The Complainant submits that the Respondent registered the Domain Name the day after it lodged its application for its CTM. It states that the Respondent could have learned of its application from the Trade Marks Journal or a similar source.

The Complainant alleges that the Respondent attempted to sell the Domain Name to it for \$50,000; but has failed despite my procedural direction to provide any acceptable evidence in support of this allegation.

The Complainant submits that, in addition to the Domain Name, the Respondent registered the domain name <arxx.co.uk> on the same day, 9 March 2004. The Complainant states that ARXX is a trademark of one of its competitors, Airlite Plastics Company, and that the two registrations must be more than coincidental.

The Complainant alleges that the Respondent has a history of complaints against him under the Nominet DRS; but again despite my procedural direction has failed to provide any particulars of this.

The Complainant seeks a transfer of the Domain Name.

The Respondent

The Respondent denies having registered the Domain Name with knowledge of the Complainant's trademark application: he states that he had neither a crystal ball nor inside information.

The Respondent states that he has used the Domain Name for the purpose of email and has plans to use it in the future. However, he provides no evidence or further particulars in this regard.

The Respondent states that domain names are open to the public to register and accuses the Complainant of bullying tactics.

The Respondent did not respond to my procedural direction, which afforded him the opportunity to explain his choice of the Domain Name and his reason for having registered the domain name <arxx.co.uk>.

6. Discussions and Findings

The Complaint falls to be determined according to the Nominet DRS Policy ("the Policy") and the Procedure. Under paragraph 2 of the Policy:

- “(a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, 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.
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “Abusive Registration” means 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.”*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has established that it has registered trade mark rights in the name and mark NUDURA. The Domain Name is identical to the Complainant's trademark save for the formal suffix “.co.uk” which is typically to be disregarded for the purposes of paragraph 2(a)(i) of the Policy. I therefore find that the Complainant has Rights in respect of a name or mark that is identical to the Domain Name.

Abusive Registration

The Complainant's trademark was registered after the Domain Name and, despite my procedural direction, the Complainant has failed to show that the product name “Nudura” had any commercial reputation in the United Kingdom such that the Respondent was likely to be aware of the Complainant or its product at the date he registered the Domain Name.

However, the Complainant relies on its CTM application. While the Respondent states that he was not aware of the Complainant's application, I am satisfied from my own enquiries that it is possible to view CTM applications as submitted to the European Intellectual Property Office as early as the day after filing.

The Domain Name is identical to the Complainant's trademark and I find that it is an invented name which had no meaning in business at the date of registration of the Domain Name other than to refer to the Complainant's product and intended trademark registration.

The Respondent was given the opportunity to provide an explanation for his choice of the Domain Name but has failed to respond to that direction. The Domain Name is a *prima facie* impersonation of the Complainant and the Respondent has provided no evidence of any legitimate use of, or intention to use, the Domain Name.

I also find that the Respondent registered the domain name <arxx.co.uk> on the same date as the Domain Name and that the name "Arxx" relates to one of the Complainant's competitors' products. The significance of this is that it renders the Respondent's registration of the Domain Name highly unlikely to have been coincidental or unrelated to the Complainant's product.

In all the circumstances, I infer that the Respondent was aware of the Complainant's CTM application and registered the Domain Name with the intention of taking unfair advantage of the Complainant's Rights in that mark, including any future Rights. While a trademark application can not of itself give rise to Rights for the purposes of paragraph 2(a)(i) of the Policy (as clarified by paragraph 1.9 of the DRS Experts' Overview), there is no reason in my view why taking unfair advantage of anticipated Rights (e.g. in a brand name that has been announced or is being prepared for trade) should not amount to Abusive Registration for the purposes of paragraph 2(a)(ii).

The fact that the Domain Name has never resolved to any active website has no bearing on my conclusions concerning Abusive Registration.

Nor is it necessary in my view to determine under precisely which sub-paragraph of paragraph 3 of the Policy the Respondent's conduct may fall (e.g. whether he registered the Domain Name primarily as a "blocking registration" or with the intention of selling it to the Complainant for an inflated price). For the reasons set out above, I am satisfied for the purposes of paragraph 1 of the Policy that the Domain Name was registered in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

I therefore conclude that the registration in the hands of the Respondent is an Abusive Registration.

7. Decision

The Complainant has established that it has Rights in respect of a name or mark that is identical to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds and I direct that the Domain Name <nudura.co.uk> be transferred to the Complainant.

Signed: Steven A. Maier

Dated: 15 June 2016