

UNSIGNED



DISPUTE RESOLUTION SERVICE

D00020245

Decision of Independent Expert

Kawasaki Robotics (UK) Limited

and

Iliya Bazlyankov

1 The Parties:

Complainant: Kawasaki Robotics (UK) Limited

Unit 4, Easter Court,

Europa Boulevard

Warrington

Cheshire

WA5 7ZB

United Kingdom

Respondent: Iliya Bazlyankov

London

United Kingdom

2 The Domain Name(s):

kawasakirobot.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, which 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.

- 29 May 2018 02:38 Dispute received
- 30 May 2018 12:51 Complaint validated
- 30 May 2018 12:57 Notification of complaint sent to parties
- 18 June 2018 02:30 Response reminder sent
- 21 June 2018 10:08 No Response Received
- 21 June 2018 10:08 Notification of no response sent to parties
- 26 June 2018 15:50 Expert decision payment received

4 Factual Background

The Complainant is part of the Kawasaki Heavy Industries Group. It has been incorporated in the UK since 12 September 1996. It is the exclusive UK distributor of Kawasaki Robots being industrial robots and their parts. It has used the name Kawasaki Robot as its brand for many years going back to at least 2005. It has also used the Domain Name as its website address as it was the previous registrant of the Domain Name. The Respondent is an individual and registered the Domain Name on 7 May 2018. It is using the Domain Name currently to point to a placeholder website.

5 Parties' Contentions

Complainant

Complainant's Rights

- 5.1 The Complainant states that it is a subsidiary of the Kawasaki Heavy Industries Group which manufactures Motor Bikes, Trains (e.g. the bullet train), super tankers, and other heavy equipment. It explains that as a result of a recent corporate restructuring it (along with the rest of the global robotics group) became a subsidiary of "Kawasaki Precision Machinery." The latter is a subsidiary of Kawasaki Heavy Industries.
- 5.2 It has been incorporated since 1996 and sells and distributes Kawasaki robots and their parts and related services all on a UK exclusive basis for the Group.
- 5.3 It claims its typical annual turnover to be considerably in excess of £1 million and usually significantly more. It claims to have used both the "Kawasaki Robot" name/brand ("the Brand") and the domain "kawasakirobot.co.uk" for many years. It has produced various pictures of its premises inside and out

and posters and brochures showing use of the Brand which refer to the web address as www.kawasakirobot.co.uk.

- 5.4 It has also produced previous versions of its website at the Domain Name from 2005 and 2015 (which it has obtained from using "waybackmachine" website/web archive). It says that during these periods the website and Domain Name serviced its needs 'to provide a url for our mindshare.' The Expert assumes that 'mindshare' is intended to mean branding creating an association with it and its products and services.
- 5.5 The Complainant claims that it had previously owned the Domain Name and had done so for many years. It also claims to own "kawasakirobotics.co.uk". It recently found out that it had lost the Domain Name after what it calls 'a calamity of administrative errors', including a payment error, and had tried many times to renew it on the assumption that it still owned it. It is still not certain as to how it came to lose it. It postulates that the recent change to the corporate structure involving Kawasaki Robotics subsidiaries moving from using local sites to a global site resulted in confusion between the registrant and the web hosting and domain hosting services. This also included a redirection to the main Kawasaki global website at robotics.kawasaki.com.

Abusive Registration

- 5.6 The Complainant claims that it is now prevented from re-acquiring the website at the Domain Name to protect its 'mindshare', brand and its customers from potential fraud and internet confusion.
- 5.7 It states that its existing and potential customers who had received previous emails, brochures and business cards are no longer being re-directed to its company website when they attempt to browse www.kawasakirobot.co.uk. Rather than being redirected to its local section on the group global website (robotics.kawasaki.com), they are now seeing a placeholder website.
- 5.8 It asserts that this is a 'very dangerous situation.' It claims that since the Domain Name is no longer in its control, the potential for internet confusion and potential misuse of the Domain Name is frightening. It gives the example of the new owner setting up an email service using the Domain Name and the risk that its customers might make confidential communications using it.
- 5.9 It claims that, although for historical reasons in the UK it communicates using another domain "kawasakirobotuk.com", the use of the Domain Name by the Respondent is still a huge problem. This is due to the fact that its website was formerly at the Domain Name and recipients of emails from that address now will assume the email is legitimate and from the Complainant when it is not. It suggests that this is likely because the Domain Name is the one that the Complainant uses and has used in the past as its domain and is for example on its brochures.
- 5.10 The Complainant asserts that in its opinion, the domain represents a significant amount of mindshare with many of its existing customers (Toyota, Jaguar Land Rover, Aston Martin, to name but a few) which assume that this web address belongs to it, as it did until the Respondent recently registered it.

- 5.11 It asserts that use of the Domain Name by any entity other than itself will lead to "Significant Internet Confusion" with the public and website visitors assuming that the website is communicating on its behalf or at least on behalf of the Kawasaki Group.
- 5.12 Another issue it claims to face is a Cyber Threat issue to its parent company. It claims that emails from the Domain Name to its parent company could also pose a significant threat. This is because its parent company is vast and even if it is aware that the website at the Domain Name is in the hands of a 3rd party and blocks it from its global website, it is still possible that some communications could slip through the security net, due to the diverse distribution of the subsidiaries.
- 5.13 It states too that potential fallout from GDPR could be a problem with use of the Domain Name. It points out that the current use of the website is just a placeholder website and claims this is already causing it issues with people reporting a problem when clicking on web-links (presumably using the Domain Name) from historical emails, brochures and business cards previously sent to them by Kawasaki UK personnel. It adds that people with the website stored in their favourites and internet history are also 'under threat'. It produces a screenshot of the placeholder site at the Domain Name which is headed "Buy this domain" and also references the Domain Name.

The Response

- 5.14 The Respondent has not filed a Response. The Complainant has paid for a full decision. Even though the Respondent has failed to respond to the Complaint, the Complainant still bears the burden of proving its case. However in the absence of any Response from the Respondent, under paragraph 24.8 of the Policy, since there are no exceptional circumstances here to justify a lack of response the Expert is entitled to draw such inferences from this as she considers appropriate.

6 Discussions and Findings

- 6.1 Under paragraph 2.1 of the Policy, for the Expert to order a transfer of the Domain Name the Complainant is required to demonstrate, on the balance of probabilities that:
- "2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- 2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration."

The Complainant's Rights.

- 6.2 Paragraph 1 of the Policy defines "Rights" 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."
- 6.3 The Complainant appears to have been using the Brand and indeed the Domain Name for a considerable period of time in the UK. It does not appear

to own any registered trade marks for the Brand or derivatives of it. However a quick search at the EUIPO website under the word 'Kawasaki' using one of its trade mark search tools throws up a list of some 38 registered trade marks. Some are device/word marks and some are word marks most of which appear to be owned by other companies in the same Group as the Complainant. This suggests to the Expert that the Brand or at least the distinctive part of it, being the word Kawasaki, is considered by its owners to be valuable and worth protecting. Indeed the Expert herself is aware of the name Kawasaki as a successful brand at least as far as motorcycles are concerned.

- 6.4 The Complainant has also produced evidence of its use of the Brand and indeed the Domain Name itself which date back to at least 2005. It refers to having UK turnover of around a £1 million a year but which often exceeds that amount. It refers to having customers such as Toyota, Jaguar Land Rover and Aston Martin which the Expert notes are large and well-known companies and /or brands in themselves. The Complainant is one company in a much larger Group of companies which are clearly international in their reach. In the absence of a Response, none of the Complainant's assertions as to its use of the Brand and the Domain Name are of course challenged.
- 6.5 In all of the circumstances the Expert considers that the Brand is well known and has significant goodwill and reputation. While the relevant evidence presented in the Complaint and accompanying it was somewhat lacking in detail, the Expert is satisfied from that evidence (as confirmed by her own knowledge and checks) that the Complainant has built up significant reputation and goodwill in the Brand and thus has acquired common law rights in it. It follows that the Complainant has Rights under the Policy in the Brand.
- 6.6 The Policy also requires that the name or mark in which the Complainant has Rights must be identical or similar to the Domain Name. The Domain Name is identical to the Brand other than the addition of the suffix .co.uk. It is well accepted under the Policy that the "co.uk" suffix may be discounted in the relevant comparison.
- 6.7 Accordingly the Expert finds that the Domain Name is identical to a trade mark in which the Complainant has Rights. The Expert therefore finds that the Complainant has Rights in respect of a name which is identical to the Domain Name and so the Expert finds that paragraph 2.1.1 of the Policy is satisfied.

Abusive Registration

- 6.8 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."
- 6.9 A Complainant must prove one or both of these on a balance of probabilities.

- 6.10 As far as paragraph (i) above is concerned it is necessary to determine whether the Respondent was aware of the existence of the Complainant and its Rights at that time and furthermore, had the aim of taking advantage of such Rights (see DRS4331 verbatim.co.uk.)
- 6.11 In this regard the Expert refers to paragraph 5 of the Policy which provides a non-exhaustive list of factors which may be evidence of an "Abusive Registration", including:
- "5.1.6 the Domain name is an exact match (within the limitations of the characters set permissible in Domain Names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."
- 6.12 The Domain Name is an exact match of the Brand being the name in which the Expert has found that the Complainant has Rights. The Kawasaki word as part of the Domain Name does not consist of descriptive or generic terms. As above the Expert considers that the name Kawasaki, as the distinguishing part of the Brand has a significant reputation.
- 6.13 Accordingly the Expert considers that on the balance of probabilities the Complainant's Brand has acquired significant goodwill and reputation. Therefore it seems far-fetched to the Expert that the Respondent should have chosen the Domain Name independently. In view of all of this it is simply not credible in the Expert's opinion that the Respondent registered the Domain Name without prior knowledge of the Complainant or at least its Group of companies and of the name Kawasaki, if not the Brand.
- 6.14 On the balance of probabilities, the Expert is of the view that the Respondent's registration of the Domain Name which is identical to the Brand and was the Complainant's former domain name and website address cannot have been independent of and without prior knowledge of the Complainant's Brand.
- 6.15 It is far more likely that the Respondent was aware of the Brand and thus viewed the dropping of the registration to be an opportunity to acquire the Domain Name as having potential value as a brand and that this was the true reason for the registration. This is made even more likely given the content of the website placeholder page which offers the Domain Name for sale. In the absence of any other explanation for the reasons for the acquisition of the Domain Name the Expert is entitled under paragraph 24.8 of the Policy, since there are no exceptional circumstances here to justify a lack of response, to draw such inferences from this as she considers appropriate.
- 6.16 Based on the facts and evidence here the Expert considers that the Respondent registered the Domain Name in full knowledge of the Complainant's Rights and that it did so in order to take advantage of these.
- 6.17 Accordingly the Expert finds that the Domain Name was registered in a manner which takes unfair advantage of, and is unfairly detrimental to the Complainant's Rights in accordance with paragraph 1 (i) of the Policy above.

6.18 For completeness paragraph 5.1.2 of the Policy states as another ground of Abusive Registration:

'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.'

6.19 The Complainant asserts that use of the Domain Name website by any entity other than itself will lead to "Significant Internet Confusion", with the public and website visitors assuming that the website is communicating on its behalf or at least on behalf of the Kawasaki Group. It points out that the current use of the website is just a placeholder website and claims this is already causing it issues with people reporting a problem when clicking on web-links (presumably using the Domain Name) from historical emails, brochures and business cards previously sent to them by Kawasaki UK personnel. It adds that people with the website stored in their favourites and internet history are also 'under threat'.

6.20 The Complainant has however produced no actual evidence of confusion. Nonetheless it seems to the Expert that such confusion is likely where an internet user is looking for the Complainant and stumbles across the Respondent's site instead. The Domain Name is the very same one which the Complainant had been using for a number of years and is clearly associated with the Complainant and its business in the UK. Given this and the inclusion of the Complainant's Brand in which it has Rights in the Domain Name there is little doubt that customers will believe that it is the site of the Complainant. There is thus at least the likelihood of initial interest confusion which in the Expert's view would also be sufficient for a finding of Abusive Registration in this case.

6.21 The Expert therefore finds that the Domain Name is being used in a manner which is taking unfair advantage of, and is also unfairly detrimental to, the Complainant's rights in accordance with (ii) above.

6.22 In the circumstances the Expert considers that the evidence demonstrates and she is satisfied that the Complainant has succeeded in proving on the balance of probabilities that the Domain Name is an Abusive Registration in accordance with paragraph 5 of the Policy.

7 Decision

The Expert accordingly finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the said Domain Name, in the hands of the Respondent, is an Abusive Registration. Accordingly the Expert directs that the Domain Name is transferred to the Complainant.

Signed *J. Brumme* Dated *26/7/18*
UNSIGNED

