

DISPUTE RESOLUTION SERVICE

D00020884

Decision of Independent Expert

Stelrad Limited

and

Mr Mark Hughes

1. The Parties:

Complainant:

Stelrad Limited
69-75 Side
Newcastle Upon Tyne
Tyne And Wear
NE1 3JE
United Kingdom

Respondent:

Mr Mark Hughes
Wirral
Cheshire
CH63 9LH
United Kingdom

2. The Domain Name(s):

stelrad.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 might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

30 November 2018 Dispute received
03 December 2018 Complaint validated
03 December 2018 Notification of complaint sent to parties
05 December 2018 Response received
05 December 2018 Notification of response sent to parties
10 December 2018 Reply reminder sent
13 December 2018 No reply received
18 December 2018 Mediator appointed
18 December 2018 Mediation started
07 January 2019 Mediation failed
07 January 2019 Close of mediation documents sent
08 January 2019 Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 9 June 2004.

Based on the parties' submissions (see section 5 below), I set out below the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant has been in business under the name Stelrad for more than 20 years. It supplies radiators.
- b. The Complainant operates a website at www.stelrad.com .
- c. The Complainant owns an EU trade mark registration for STELRAD, dating from April 1996.
- d. The Respondent directed the Domain Name for a period of time to the website www.myson.co.uk, belonging to a competitor of the Complainant.
- e. The website www.stelrad.co.uk is currently a parking page and the Respondent does not intend to use the Domain Name for radiators and similar products.

5. Parties' Contentions

Complaint

The Complainant's contentions are as follows:

The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:

- (1) The Complainant is a company registered at Companies House under the name Stelrad Limited, and has been since 31 May 1988.
- (2) The Complainant is part of the Stelrad Radiator Group, a group of radiator companies based throughout Europe.
- (3) The Complainant operates a website at www.stelrad.com.
- (4) The Complainant owns an EU trade mark registration for STELRAD, No. 000209601, with application date 1 April 1996 and registration date 4 December 1998.

The Domain Name, in the hands of the Respondent, is an abusive registration:

- (1) The Respondent is not known to the Complainant.
- (2) The Domain Name is being used to unfairly disrupt the Complainant's business by being redirected to a website of its competitor Myson at www.myson.co.uk
- (3) The Domain Name is being used in a way which will confuse people into believing that it is controlled by the Complainant. Because the Domain Name is identical to the Complainant's name, people seeking to access a website at that address will think the website is part of the Complainant's group when this is not the case. With the Domain Name redirecting to www.myson.co.uk , people will be misled into believing that Myson is part of the Complainant's group.

Response

The Respondent's contentions are set out below:

- (1) The Respondent was previously the managing director of Zorille Limited, a plumbing and heating supply company which was dissolved in July 2018. Zorille sold a number of different products, but primarily radiators, including radiators of both the Complainant and Myson.
- (2) The Domain Name was purchased with the intention of creating a sales site specifically for Stelrad radiators and towel rails. However, this project was put on hold.

- (3) The Domain Name was purchased by the Respondent in good faith because his company was at the time selling a significant volume of Stelrad radiators and was in direct contact with the Complainant over trading terms and stock availability.
- (4) The Domain Name was directed to the Complainant's stelrad.com website for a considerable period of time.
- (5) The Respondent concedes that the Domain Name should not be directed to the website of any other radiator manufacturer. The redirection to myson.co.uk was an oversight.
- (6) The Respondent accepts that the Domain Name will not be used, without the consent of the Complainant, for sales of products falling within those covered by the Complainant's STELRAD trade mark registration, namely radiators and other heating apparatus. However, the Respondent is legally entitled to use the Domain Name for any other products or services.
- (7) The website at stelrad.co.uk is currently parked and the Respondent currently has no plans to use it.
- (8) The Respondent invites the Complainant to contact him to discuss potential future licensing or full purchase of the Domain Name.
- (9) The Complainant's company name is irrelevant to domain name ownership rights.
- (10) The Complainant's trade mark registration gives it no rights in respect of usage of the Domain Name for products which fall outside that registration.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it 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 (as defined in paragraph 1 of the Policy).

Complainant's Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the name and mark Stelrad. These rights comprise the Complainant's trade mark registration, together with goodwill arising from its trade

under the Stelrad company name and stelrad.com website. The Respondent contends that a company name does not give rise to relevant rights. Mere registration of a company name at Companies House (or another company registry) does not of itself create rights for this purpose- see, for example the decision in DRS 16594 (polo.co.uk). However, actual trading under a company name, as the Complainant has done, gives rise to goodwill in that name, and such goodwill is a legally protectable right.

Disregarding the generic .co.uk suffix, the Domain Name is identical to the name and mark in which the Complainant has Rights.

I therefore find that paragraph 2.1.1 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the 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 is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The relevant factors under paragraph 5 on which the Complainant relies are as follows:

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.3 for the purposes of unfairly disrupting the business of the Complainant;

5.1.2 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"

Disregarding the .co.uk suffix, the Domain Name is identical to the name and mark of the Complainant. When a domain name is identical to the name or mark of a complainant, without any adornment, barring exceptional circumstances this is almost inevitably going to lead to people being confused into believing that the domain name is owned or authorised by the complainant. There are no exceptional circumstances in this case.

It is clear to me that any use which the Respondent could make of the Domain Name is likely to cause people to be confused into believing that the Domain Name belongs to the Complainant or is connected with, or authorised by, the Complainant in some way. Even if the Respondent were to use the Domain Name for a website, the content of which makes clear that it is not in fact connected with the Complainant, the nature of the Domain Name would still be likely to give rise to what is known as "initial interest confusion". This is the type of confusion whereby people believe that they are accessing a website belonging to someone else, i.e. the Complainant, and are only disabused of that confusion after spending time reviewing the website. "Initial interest confusion" has been found in several DRS decisions to be a relevant type of confusion for the purposes of the DRS Policy.

In fact, the Respondent has admitted that it directed the Domain Name to the website of a competitor of the Complainant, namely Myson. It is obvious that this will have caused initial interest confusion and/or people being misled into believing that the Domain Name belongs to the Complainant and that Myson is connected in some way with the Complainant.

The Respondent's position is now that it will not use the Domain Name for radiators or other similar products which the Complainant deals in. It follows from this that the Respondent will either maintain a website parking page under the Domain Name or use it for a website for products which are not the same as the Complainant's. In either case this will give rise to at least in initial interest confusion.

With regard to the latter, the Respondent contends that the Complainant's trade mark registration gives it no rights in respect of usage of the Domain Name for products which fall outside that registration. As it happens, that is incorrect - infringement of a registered trade mark is not limited to use of the trade mark for the identical products covered by the trade mark registration; and, subject to certain conditions, there can be infringement if the trade mark is used for similar or even dissimilar products. But more fundamentally the criterion under the Policy is whether or not the Domain Name is an Abusive Registration under the definition in paragraph 1 of the Policy (set out above), not whether use of the Domain Name constitutes trade mark infringement.

Taking into account the parties' submissions, I therefore conclude that the factor under paragraph 5.1.2 of the Policy applies. Because of this- together with the other findings below- and the conclusions flowing from it, I do not need to make a finding on whether or not the factor under paragraph 5.1.1.3 also applies.

Paragraph 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. I find that none of these factors apply in this case, and that there is no other evidence that the Domain Name is not an Abusive Registration.

In light of the above, the registration and use of the Domain Name will clearly have been unfairly detrimental to the Complainant's Rights. This is most obviously the case in relation to the redirection of the Domain Name to the website of a competitor of the Complainant. People using the website address www.stelrad.co.uk would have been looking for the Complainant and its products. On arriving instead at the website of its competitor Myson, there will have been a real risk of at least some of them purchasing

a Myson product instead or at least being diverted or distracted from making a purchase of one of the Complainant's products. Alternatively some of those people are likely to have mistakenly concluded that Myson is part of the same group of companies as the Complainant.

In addition, any website under the Domain Name is outside the Complainant's control. Since any such website will be perceived by consumers as belonging to, or connected with the Complainant, it follows that everything related to that website will reflect on the Complainant. The combination of this reflection with the Complainant's lack of control is itself inherently detrimental to the Complainant's rights.

Moreover, the website under the Domain Name is currently a parking page. Some people accessing it are likely either to believe that the Complainant is no longer in business; or to give up looking for the Complainant and either not purchase a radiator (or similar) at all or purchase one from a different company. Any of these outcomes is unfairly detrimental to the rights of the Complainant.

This means that the Domain Name is an Abusive Registration under paragraph 1 of the Policy.

7. Decision

Having found that the Complainant has Rights in respect of a name which is identical to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *stelrad.co.uk* be transferred to the Complainant.

Signed

Dated: 4 February 2019

Jason Rawkins