

DISPUTE RESOLUTION SERVICE

D00022086

Decision of Independent Expert

- (1) Aldi GmbH & Co. K.G.
- (2) Aldi Stores Limited

and

Mr Kolawole Oyinloye

1. The Parties

Joint Complainants:

- 1) Aldi GmbH & Co. K.G
- 2) Aldi Stores Limited

Respondent:

Mr Kolawole Oyinloye

2. The Domain Name

mamia.co.uk

3. Procedural History

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

3.2 The following is a brief procedural history of this case, -

- 21 November 2019 - Complaint received by Nominet;
- 22 November 2019 - Notification of Complaint sent to the parties;
- 11 December 2019 - Response reminder sent;
- 16 December 2019 - Response received by Nominet and notification of Response received sent to the parties;
- 19 December 2019 - Reply reminder sent;
- 24 December 2019 - No reply received;
- 6 January 2020 - Mediator appointed;
- 9 January 2020 - Mediation started;
- 19 February 2020 - Mediation concluded without agreement between the parties;
- 2 March 2020 - Complainant full fee reminder sent;
- 4 March 2020 - Expert decision payment received by Nominet.

4. Factual Background

4.1 The First Complainant is a company registered under the laws of Germany that owns certain rights in the ‘Aldi’ name and brand. The Second Complainant (‘Aldi Stores’) is a company registered under the laws of England and Wales which runs the Aldi supermarket business in the UK from 500 store premises and from the website www.aldi.co.uk (‘the Aldi Stores Website’).

4.2 Aldi Stores was incorporated on 25 November 1988 and as part of its business sells products for babies under the mark and brand ‘MAMIA’. The Respondent registered the Domain Name on 13 May 2013. It relates to a URL that resolves to a one page web-site stated to be ‘.. *under [c]onstruction*’, which contains other written and diagrammatic content pertaining to business strategy and planning.

5. Parties' Contentions

5.1 The Complaint alleges as follows, -

- 5.1.1 The Complainants own a number of trade marks comprising the name MAMIA.
- 5.1.2 Aldi Stores owns a substantial goodwill and has a reputation in the UK for baby-related products sold under the MAMIA mark in its stores and from the Aldi Stores Website, as evidenced by its sustained investment in that brand, consumer awareness of it and the numerous awards and endorsements received from industry bodies such as *Which?*.
- 5.1.3 The Complainants' Rights predate the Respondent's registration of the Domain Name.
- 5.1.4 The Domain Name incorporates the MAMIA trade marks without any other elements and is an unauthorised use of those marks. There is a real risk that the Domain Name, that currently resolves to the landing page 'under construction', will be used to host a website connected to the Complainants' business and the Domain Name could attract web traffic to the Respondent's website from users attempting to access websites associated with the Complainants.
- 5.1.5 Further or alternatively, the way in which the Domain Name has been used is inevitably detrimental to the Complainants' Rights and takes unfair advantage of them. The existence of the Domain Name will lead to frustration and disappointment on the part of consumers interested in or searching for goods associated with the Complainants' MAMIA marks. The distinctive character and reputation of those marks will be harmed by their association with the Domain Name and the business of the Complainants will be unfairly disrupted due to consumers being led away from the Aldi Stores Website.

- 5.1.6 In addition, the mere existence of the Respondent's name on publicly accessible records relating to the Domain Name is itself a misrepresentation that is likely to deceive the public into believing that the Domain Name is controlled by, or connected to, the Complainants.
- 5.1.7 It is to be inferred that the Respondent's real purpose in registering the Domain Name was primarily for the purposes of selling, renting or otherwise transferring it for valuable consideration in excess of the Respondent's out-of-pocket costs of the registration; and/or as a blocking registration, and/or for the purposes of unfairly disrupting the Complainants' business.
- 5.1.8 In the circumstances, the registration of the Domain Name is abusive under each of the two limbs of the definition of Abusive Registration under the DRS Policy of Nominet ('the Policy').

5.2 The Response is brief. It states, -

'Why should the complaint not succeed?

I'm not a solicitor or expert of law but I know your complaint has no grounds. Where were you since I had this website for more than 4 years. Why are you now making the complaint now? I'm not aware that you have any products that was [sic] labelled mamia and when I registered the domain I was not made aware that I could not own the domain. My initial intention was to use this website in the future for elderly home [sic] with mental disordered [sic] and mamia in my country of origin means my sweet mother. I'm a mental health nurse and it's my passion to make this happen. You made mentioned [sic] that I'm using the domain for marketing advantages! This does not make any sense at all because when you click on the site, all you can see is business analysis write up. How does that resemble one of your products? I think this is bullying and intrusion into my privacy! Your response would determine if I will need to involve my solicitor.

.....’

5.3 No Reply was served.

6. Discussion and Findings

6.1 I have taken into account all the facts and matters relied on by each party but have limited the findings in this decision to those necessary to dispose of the dispute in accordance with the Policy. Therefore, it is not necessary to resolve all the issues raised by the parties.

6.2 I refer to, and repeat as findings, the contents of section 4 above.

What must a complainant prove to succeed in a complaint?

6.3 A complainant is required under subparagraphs 2.1 and 2.2 of the Policy to prove on the balance of probabilities that the following two elements are present, namely: -

- he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

6.4 By paragraph 1 of the Policy, -

‘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.’

6.5 The Complainants have produced a written summary of a number of ‘MAMIA’ trade marks alleged to be owned by them, identifying the trade mark numbers

and their dates of registration. An online search of the UK Government Intellectual Property Office (www.trademarks.ipo.gov.uk) conducted by me has shown the following particulars of registrations against two of those trade mark numbers –

6.5.1. Aldi Stores owns the registered UK trade mark number UK00001394319 in the mark ‘MAMIA’, which was first entered on the register on 5 April 1991, and has a renewal date of 9 August 2026. The registration is in class 16 (disposable nappies made of paper) only.

6.5.2 Aldi Stores also owns the registered UK trade mark number UK00003185167 for products in a number of classes, including wipes for babies (class 3), disposable nappies, baby milk (class 5), baby monitors (class 9) and products for babies in those classes of registration and in other classes. This trade mark was registered on 3 March 2017 and its renewal date is 12 September 2026.

6.6 I am satisfied from the evidence provided in the Complaint and its annexes that Aldi Stores also has unregistered rights in passing off deriving from its substantial goodwill and reputation in the name ‘MAMIA’ with reference to products for babies and that this name is distinctive of those products as marketed and sold by Aldi Stores in the UK.

6.7 Therefore, the Second Complainant is the owner of those two trade marks in the word ‘MAMIA’ and also has unregistered rights in respect of that name.

6.8 As a result, the Second Complainant has established Rights in respect of a name or mark which is identical or similar to the Domain Name. Accordingly, the Second Complainant has established that it owns Rights.

Abusive Registration

6.9 By paragraph 1 of the Policy, -

‘an 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 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.'*

By paragraph 5 of the Policy, -

5. Evidence of Abusive Registration

'5.1 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

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

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose 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;

.....’

Paragraph 8 of the Policy provides as follows, -

‘8. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

8.1 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

8.1.1.1 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;

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

8.1.1.3 made legitimate non-commercial or fair use of the Domain Name.

8.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it.

8.2 Fair use may include sites operated solely in tribute to or criticism of a person or business.

.....

8.4 Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.

.....’

6.10 The Respondent says that he had not heard of the Complainants’ MAMIA brand when he registered the Domain Name. The brand is not one that any member of the public will know, like ‘Coca-Cola’ or perhaps even Aldi itself. He has given an explanation as to why he chose the name. It is true that no evidence has been provided by the Respondent that the word ‘mamia’ does mean ‘sweet mother’ in the language of his country of origin. No Reply has been served contesting that assertion and it is not intrinsically improbable.

6.11 Therefore, I accept that the Respondent did not have the Complainants’ brand in mind when he registered the Domain Name. As a result, I do not accept that he registered the Domain Name for the purposes of selling, renting or otherwise dealing in the Domain Name, using it as a blocking registration or to unfairly disrupt the Complainants’ business. In sum, the registration was not abusive within subparagraph (i) of the definition of Abusive Registration.

6.12 The DRS Experts’ Overview (guidance to decision-making under the Policy) states, -

‘The body of expert decisions under the Policy is developing and certain principles are emerging. The section of the Appeal decision in DRS 04331 (verbatim.co.uk) dealing with ‘knowledge’ and ‘intent’ sets out one panel’s views on that topic. and to the extent that the Verbatim decision suggests that for a finding of Abusive Registration, the Respondent must have had knowledge of the Complainant and/or its Rights at the relevant time, it is now thought by some Experts that that might overstate the position.

.....

A particular area of current debate among the panel of Experts is the extent to which the concepts of unfair advantage and unfair detriment as set out in the definition of Abusive Registration [paragraph 1 of the Policy] embrace a subjective element. The members of the Appeal panel in the Verbatim case took the view that for a registration to be labelled “Abusive” there had to be something morally reprehensible about the Respondent’s behaviour, a view more recently adopted in DRS 07066 (whistleblower.co.uk). Others have expressed the view that what is or is not fair can be judged wholly objectively and that to gain or cause damage by way of trade mark infringement is necessarily unfair irrespective of the motives of the Respondent.

To date this divergence of view has emerged primarily in the cases where the Complainant’s trade mark rights have post-dated registration of the domain name - a very small proportion of the overall body of cases.’

- 6.13 In the circumstances of this case, I do not find that there was anything ‘morally reprehensible’ in the Respondent’s registration of the Domain Name (see above). I consider that an objective inquiry is nevertheless appropriate to answer the question whether or not the Domain Name 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, for the purposes of paragraph (ii) of the definition of Abusive Registration.
- 6.14 It is right to observe that the DRS maintains a basic approach of ‘first-come, first-served’ to registration. However, that is subject to the terms of the Policy.
- 6.15 I start with the Domain Name itself. Ignoring the country code suffix “.co.uk” for this purpose, the Domain Name is identical (save as to capitalisation of letters) to the two trade marks and to the name of the brand in which Aldi Stores owns the goodwill with reference to the sale of its baby products.

- 6.16 Aldi Stores first acquired Rights in the name 'MAMIA' in 1991, more than twenty years before the Respondent first registered the Domain Name.
- 6.17 It is true that despite the Domain name having been in existence for more than six years, no direct evidence of confusion has been provided in support of the Complaint. The Respondent also points to the fact that he has not been marketing or selling the products associated with the MAMIA name and brand.
- 6.18 However, some Internet users searching for MAMIA baby products are likely to type the name of the brand into Google or another search engine. Although some customers may know that the products are sold by Aldi and visit the Aldi Stores Website, other members of the public may not know that the products are sold through Aldi supermarkets. Or, if they do know of the connection, they may think that the MAMIA products may be sold through other retail channels and conduct a search against the brand name to find other sources of supply.
- 6.19 Having made that online search, there is a risk that actual or potential customers would type the Domain Name into the address bar of their computer or other device in a mistaken attempt to find out information about MAMIA baby products, or click on a link to the Respondent's website. Others might not bother to conduct an Internet search and type in the Domain Name to their device in an attempt to guess at a domain name associated with the branded products.
- 6.20 As the Domain Name is for practical purposes identical to the MAMIA brand name, all such Internet users are likely to believe that the Domain Name represents an online presence of the business that markets and sells MAMIA products and that the Domain Name is owned and operated or authorised by that business.
- 6.21 Even though the content of the Respondent's website would have the effect of correcting that false impression, the Internet user would have been 'sucked in' and deceived by the name. This 'initial interest confusion' is itself a possible basis of finding abusive registration: DRS Experts' Overview, section 3.3.

- 6.22 In the circumstances, it has been established that the Respondent has used and is using the Domain Name in a way which has confused and is likely to confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with Aldi Stores. Therefore, paragraph 5.1.2 of the Policy has been established.
- 6.23 That is not an end of the matter. What of the case made by the Respondent? It is not clear what he says is the purpose for his website. It seems to be either a website for the elderly with mental health disorders, or as part of arrangements for a home for such members of the public. In either case, the actual content of his website does not mention either of these possibilities. Instead, it refers to quite different, generic business-related, matters. No explanation has been given as to why, if his plans have been to set up a website for persons with mental health disorders, he has taken no actual steps to build that website. For example, even a one-page website might have been expected after what has been nearly seven years since he first registered the Domain Name.
- 6.24 Therefore, this is not a case where the Respondent has ‘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’ (section 8.1.1.1 of the Policy). Nor is it the case that the Respondent has ‘been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.’ The Domain Name has not been used as a tribute site either (paragraph 8.2).
- 6.25 I refer to section 8.1.1.3 of the Policy (see above). The key issue is not whether the use in question is ‘legitimate non-commercial or fair’ but whether that use (commercial or non-commercial) has “taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”: Appeal decision in DRS 00248 seiko-shop.co.uk - paragraph 8.1.
- 6.26 In deciding the issues of unfair advantage and unfair detriment, it is right to take into account the unexplained delay on the part of the Complainants in enforcing through the DRS the Rights that have been relied on in this case. Against that,

the delay has not caused prejudice to the Respondent. A factor in favour of the Respondent is that he does not appear to have changed his behaviour on becoming aware of the Complainants' brand so as to take advantage of the Rights in some way. It follows that I also reject the Complainants' argument that the Respondent is likely to use the Domain Name in some manner that deliberately takes advantage of their marks and brand.

6.27 In cases where a respondent has registered a domain name before the complainant's Rights came into existence and the respondent does nothing to take advantage of those Rights once they do, the registration is unlikely to be abusive even if 'initial interest confusion' is likely: see decision of the Appeal Panel in *myspace.co.uk* at p.13. However, in the circumstances of this case, Rights owned by the (Second) Complainant came into existence more than 20 years before the Domain Name was registered. The likely confusion caused by the Domain Name has been and continues to be detrimental to the Rights of the Second Complainant and disrupting its business. By contrast, the Respondent has shown no real interest in pursuing such plans as he may have or have had in connection with the Domain Name. Even now, seven years after he registered it, the Respondent has been unable to identify any concrete plans that he may have in connection with the Domain Name.

6.28 In all the circumstances, the Domain Name is being and has been used in a manner which has been unfairly detrimental to the Complainant's Rights within the meaning of subparagraph (ii) of the definition of Abusive Registration and the Domain Name is an Abusive Registration.

7. Decision

7.1 The Second Complainant has Rights in a name or mark, which is similar to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration.

7.2 The Lead Complainant is Aldi Stores. It owns the Rights on which my findings are based, including ownership of the UK goodwill in connection with those

Rights. No statement has been made in the Complaint as to which of the Joint Complainants should be the transferee of the registration. In the circumstances, Aldi Stores is the appropriate transferee.

7.3 Therefore, the Expert determines that the Domain Name 'mamia.co.uk' be transferred to the Second Complainant.

Signed

Dated 1 April 2020

Stephen Bate