

DISPUTE RESOLUTION SERVICE

D00022595

Decision of Independent Expert

Detas S.p.A.

and

iason AG

1. The Parties:

Complainant: Detas S.p.A.
via Treponti 29
Rezzato
Italy

Respondent: iason AG
Ernst-Heinkel-Strasse 8
Fellbach
Badne-Wuerttemberg
70734
Germany

2. The Domain Name(s):

detasultra.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 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.

24 April 2020 14:03 Dispute received
28 April 2020 11:17 Complaint validated
28 April 2020 11:19 Notification of complaint sent to parties
18 May 2020 02:30 Response reminder sent
18 May 2020 09:36 Response received
18 May 2020 09:36 Notification of response sent to parties
22 May 2020 02:30 Reply reminder sent
26 May 2020 09:04 Reply received
26 May 2020 09:05 Notification of reply sent to parties
26 May 2020 09:06 Mediator appointed
27 May 2020 16:52 Mediation started
27 May 2020 16:59 Mediation failed
27 May 2020 16:59 Close of mediation documents sent
08 June 2020 02:30 Complainant full fee reminder sent
08 June 2020 16:08 Expert decision payment received

4. Factual Background

I find the following facts as proven based on the evidence provided by the parties and they form the basis for my decision:

- i. The Complainant was established as a business originally in Italy and it manufactures electrical components for a variety of industrial purposes.
- ii. The Complainant has protected its name by trade mark protection
 - a. Italian trade mark number 0000722591 was registered on 19 September 1997 in respect of “DETAS”; and
 - b. Italian trade mark number 0001615792 also appears to provide protection in respect of “DETAS” but in combination with a device.
- iii. More recently, in 2019, the Complainant has established a division called “DETASULTRA” for which it has applied for trade mark protection in Italy and internationally (see Annexes 6 and 7 to the Complaint).
- iv. The Respondent is a company established apparently for a variety of business purposes, some in the technical arena (information, videos and internet and other media services) and also telecommunications services as well as seemingly unrelated fields (brokering of insurance and other investments).
- v. The Respondent registered the Domain Name on 21 January 2019: as at the time of writing this Decision, it depicted a man in his middle years of possibly Indian subcontinent appearance and to the left a picture of a condom with a line of text “Detasultra – ultra strong condoms. With love from India – optimized for Europe”. There is some text below in the German language describing the Indian origins of the product though there is an option at the bottom of the page to select English, French or Italian. There is no online

shop as such, nor any information about retail outlets; rather, there is a button which has a “mailto” function allowing an email enquiry to be made about sales.

5. Parties' Contentions

The Complainant makes the following submissions:

- i. The Complainant has been trading under its name since 1978: it is active in various fields including industrial automation, security systems, lighting and road safety and it trades in various West European states including France, Germany and Italy.
- ii. It recently established a division called “DETASULTRA” which specialises in aspects of cable management and security.
- iii. It has gained trade mark protection for “DETAS” in Italy and has applied for trade mark protection for “DETASULTRA” in Italy and internationally.
- iv. It also has domain names including “DETAS.COM” and “DETASULTRA.COM”.
- v. The Complainant submits that the Respondent’s registration of the Domain Name is an Abusive Registration:
 - a. The Domain Name is being used for a purpose that has nothing to do with the Respondent’s main lines of business;
 - b. The average internet user will be confused by the similarity of the Domain Name with the Complainant’s trading styles and marks;
 - c. The website to which the Domain Name resolves include a stock photograph of a man and was recently established after the Complaint while that website under “Impressum” states that the Respondent is involved in “datensicherheit” or “data security”: the website is a front and not a true website trading in condoms;
 - d. The Respondent has never traded under the mark “DETAS” and knew or ought to have known of the Complainant’s Rights in that mark;
 - e. The Domain Name is very nearly identical to “DETAS” and identical to the newer trading style “DETASULTRA”;
 - f. There is no bona fide offering of goods by the website to which the Domain Name resolves.

The Respondent makes the following submissions:

- i. It is the rightful owner of the domain names detasultra.de, detasultra.fr as well as the Domain Name, and also owns domains names in France and Germany using the same name spelled as “detas-ultra”.
- ii. Searches for “DETAS” does not show anything like an exclusive use by the Complainant.
- iii. While the Respondent was established as an internet provider and IT company, it has traded in other services from time to time, including “Squeezy Cards”, geocaching and LTE antennas.

- iv. The Respondent decided to sell condoms sourced from an Indian company called “Detasu Pharmexco”, which explains the origin of the Domain Name and the trading style given to the product.
- v. The Respondent has started to sell condoms, though the market is poor given the coronavirus crisis.
- vi. The Complainant’s trade mark rights relate to classes different from the class in which condoms would find trade mark protection.
- vii. The Complainant has only sought to register “DETASULTRA” subsequent to the emergence of the current dispute.

The Complainant replies making the following submissions:

- i. The Respondent is an internet provider and IT company, and it is unrealistic to accept that it is trading now in condoms.
- ii. There is no evidence of any relationship with a company called “Detasu Pharmexco”.
- iii. The Complainant had been using “DETASULTRA” long before the Respondent intended to register or use the Domain Name, meaning that the Complainant has established prior rights.

6. Discussions and Findings

Rights

The Complainant must show that it has Rights, which are defined 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”*.

The threshold is a relatively easy one to surmount: the Complainant has produced evidence of two Italian trade mark registrations in respect of “DETAS” which is sufficient to establish Rights in this word for the purposes of the DRS Policy. I discount the applications for “DETASULTRA” as they do not currently constitute Rights, being only applications, not actual registrations.

Rights must, by virtue of paragraph 2.1 of the DRS Policy, be *“in respect of a name or mark which is identical or similar to the Domain Name”*. I discount the .co.uk suffix in line with the practice of other Experts.

The Domain Name opens with the self-same word as the Complainant’s Rights and differs only in having the addition of “ULTRA”. “Ultra” is of course a common word used to intensify the meaning of another word e.g. “ultra strong” and indeed the Respondent uses this expression to describe the brand of condoms it claims to be selling on the website to which the Domain Name resolves. The Rights do not have to be identical and similarity will suffice. In this case, I accept that the Complainant’s Rights are similar to the Domain Name for the purposes of the DRS Policy.

Abusive Registration

The Complainant must then show that the Domain Name is an Abusive Registration in the Respondent's hands. 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. *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 5.1 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. While the Complainant has not specifically referred to any particular numbered sub-paragraph(s) under paragraph 5.1, it is essentially claiming that the website to which the Domain Name resolves is effectively a front, and that there is no serious trading in condoms going on.

Before considering the factors enumerated in paragraph 5.1, it is worth stating some basic principles. There is nothing of itself harmful in owning a domain name or even having a portfolio of domain names – simply having a domain name with a word identical to a third party's trade mark is not of itself wrong under the DRS Policy. Following on from that, there is nothing wrong as such with simply buying and selling domain names. These points are made by paragraph 8.4 of the DRS Policy.

A further point is this: having a domain name is not "Rights" for the purposes of the DRS Policy and having a portfolio of similar domain names across a number of different jurisdictions neither proves nor disproves any intention to use any of those domain names for the purposes of legitimate trade. The Respondent points to its ownership of the Domain Name, and in addition owns "detasultra.fr" and "detasultra.de" as well as "detas-ultra.fr" and "detas-ultra.de". Under paragraph 18.1 of the DRS Policy, I am entitled to check any material which is generally available in the public domain, which I have done in verifying the status of those other domain names. It transpires that these last named domains, as at the time of writing this Decision, redirect to a page indicating each is for sale on the sedo.com website, with an asking price of €1,000 each.

Finally, what other dispute processes decide using the rules of different domain name registrars are not direct evidence of how an Expert under the DRS Policy should decide a case, nor is the Complainant's failure to take action in other jurisdictions any evidence pointing either one way or the other as to the strength or weakness of its case in a complaint under the DRS Policy.

Paragraph 5.1.1

This provides three separate grounds for a finding of Abusive Registration. The complete text of this paragraph of the DRS Policy 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;”

The following factors are relevant:

- the Respondent is largely an IT company also active in the area of telecommunications
- it has not provided any evidence to support its assertions that it has worked in other unrelated areas (such as “Squeezy Cards”) and it does seem surprising at first sight that a company ostensibly specialising in IT should suddenly branch out into sales of Indian condoms
- it has not provided any evidence to support its contention that it has made any sales of condoms whatsoever
- it has not provided any evidence to support its contention that it has some sort of connection with an Indian company called “Detasu Pharmexco” whereby it is buying its Indian condoms for re-sale in Europe
- the Respondent’s registration of the Domain Name is very close in time to the launch of the Complainant’s division called “Detasultra”
- given that the Respondent is a specialist IT company, it is surprising that the website to which the Domain Name resolves is so very simple: just a home page, with stock art showing a middle-aged Asian gentleman next to a condom with some German text (albeit available in translation at the visitor’s option) and, most importantly, no online sales engine, just an invite to make an email inquiry
- of all the webpages which the Respondent claims to own, this is the only one now with any sort of home page, the others in France and Germany using either “DETASULTRA” or “DETAS-ULTRA” are all for sale

While there is no evidence of any attempt to sell the Domain Name to the Complainant for an inflated (or any) price (paragraph 5.1.1.1), I have concluded after considering the above factors that the Domain Name in the hands of the Respondent

is indeed an Abusive Registration as, on the balance of probabilities, it was acquired for the purposes of blocking the Complainant from registering the mark itself to reflect its own Rights (paragraph 5.1.1.2) and, in particular, to inhibit the development of the Complainant's new division, Detasultra.

I also find that the Domain Name was registered for the purpose of unfairly disrupting the Complainant's business (paragraph 5.1.1.3), as I do not accept that there is any bona fide intention to sell Indian condoms by means of the Domain Name and the Respondent has not provided any evidence of this beyond its bare assertion to that effect. My conclusion is that the webpage to which the Domain Name resolves is in fact a front to justify keeping the Domain Name before it too is offered for sale like other similar domain names owned by the Respondent. In that sense, it is unfairly disrupting the Complainant's business by purporting to sell something completely different from any line of products in which the Complainant is involved.

Paragraph 5.1.2

I do not think that any reasonable visitor to the webpage to which the Domain Name resolves would come away confused as to whether the Complainant had branched out from cabling and electrical devices into condoms, or that it in some way was authorising the sale of condoms or was connected with that particular line of business.

Paragraphs 5.1.3 to 5.1.6

There is no evidence that these paragraphs are engaged.

Paragraph 8 factors

I have also considered this matter more generally taking account of what the Respondent has said. The Respondent is entitled to point to factors which may be evidence that the Domain Name is not an Abusive Registration. This is dealt with in paragraph 8 of the DRS Policy.

I have already referred to paragraph 8.4, which states that simply dealing in domain names is not of itself illegitimate.

Paragraph 8.1 contains a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. Looking through these,

- I am not satisfied that the Respondent is making a genuine offering of goods as there is no evidence to support that finding (paragraph 8.1.1.1)
- The Respondent has not been known by the Domain Name or anything similar (paragraph 8.1.1.2)
- The use being made of the Domain Name is not "legitimate non-commercial or fair use" of it (paragraph 8.1.1.3)

- The Domain Name is not descriptive or generic at least in the English language (paragraph 8.1.2)

The other paragraphs of paragraph 8 do not on their terms apply.

In this case, I do not find any grounds within the terms of paragraph 8 or otherwise that would justify finding that the Domain Name is not an Abusive Registration in the Respondent's hands.

7. Decision

I find that the Complainant has Rights and that the Domain Name in the Respondent's hands is an Abusive Registration. I order that the Domain Name should be transferred to the Complainant.

Signed: Richard Stephens

Dated 24 June 2020