

DISPUTE RESOLUTION SERVICE

D00022676

Decision of Independent Expert

Hypnos Limited

and

Yusuf Zaman

1. The Parties:

Lead Complainant: Hypnos Limited
Longwick Road
Princes Risborough
Buckinghamshire
HP27 9RT
United Kingdom

Complainant: Keen & Toms Partnership Limited
Longwick Road
Princes Risborough
Buckinghamshire
HP27 9RT
United Kingdom

Respondent: Yusuf Zaman
Huddersfield
West Yorkshire
United Kingdom

2. The Domain Name:

<hypnosbeds.co.uk>

3. Procedural History:

The Complaint was filed with Nominet on 27 May 2020. Nominet validated the Complaint and notified the Respondent of the Complaint by post and by email on 27 May 2020, informing the Respondent that the due date for submission of a Response was 17 June 2020.

The Response was filed on 27 May 2020. Nominet informed the Complainant that the due date for submission of a Reply was 3 June 2020. The Complainant filed a Reply on 1 June 2020.

The Mediator was appointed on 4 June 2020. The informal mediation procedure started on 4 June 2020, but failed to produce an acceptable solution for the Parties. On 10 June 2020, Nominet informed the Complainant that it had until 24 June 2020 to pay the fee for the decision of an Expert, pursuant to paragraph 7 of the Nominet Dispute Resolution Policy (the “Policy”). On 22 June 2020, the Complainant paid Nominet the required fee.

On 29 June 2020, the undersigned, David Taylor (the “Expert”), confirmed to Nominet that he was independent of each of the Parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed, which might be of such a nature as to call into question his independence in the eyes of one or both of the Parties.

4. Factual Background

The Complainant is filed jointly in the name of Hypnos Limited and its related company Keen and Toms Partnership Limited. As both entities possess rights in the HYPNOS trade mark, unless specified otherwise, they shall be referred to jointly as the “Complainant”.

Incorporated in 1926, the Complainant is a United Kingdom-based manufacturer of beds and mattresses. For use in connection with the manufacturing and sale of its beds and furniture products, the Complainant has obtained registered rights in the HYPNOS trade mark, including *inter alia* the following:

- United Kingdom Trade Mark No. UK00000727657, HYPNOS, registered on 5 March 1954; and
- United Kingdom Trade Mark No. UK00002618996, HYPNOS, registered on 5 October 2012.

The Complainant has submitted a list of further HYPNOS trade marks, registered in jurisdictions throughout the world.

The Complainant is also the registrant of the domain name <hypnosbeds.com>, which resolves to the Complainant’s principal commercial website.

The Domain Name was registered on 22 August 2012. Prior to the filing of the Complaint, the Domain Name was being used to redirect to the BedWorld website – a competitor of the Complainant. At the time of this decision, the Domain Name resolves to a parking page provided by the registrar, GoDaddy.com, LLC.

5. Parties' Contentions

5.1. The Complaint

The Complainant asserts registered rights in the HYPNOS trade mark.

The Complainant submits that the Domain Name in the hands of the Respondent is an Abusive Registration in that its use, to attract customers to the BedWorld website using the Complainant's HYPNOS trade mark, amounts to infringement of the Complainant's trade mark. The Complainant submits that such use amounts to abusive activity, as defined in paragraph 5.1.1.3 of the Policy, namely that the Respondent has used the Domain Name "for the purpose of unfairly disrupting the business of the Complainant."

The Complainant requests transfer of the Domain Name.

5.2. The Response

The Response consists of the following statement:

"This domain is owned by me, it is not in use but I am happy to sell this domain to the claimant for £2000. Thank you."

5.3. The Reply

The Complainant makes reference to the Response and notes that the Respondent fails to engage with any of the issues raised in the Complaint. The Complainant submits that the Respondent's offer to sell the Domain Name amounts to further evidence of abuse, pursuant to paragraph 5.1.1.1 of the Policy, in that the Respondent registered or otherwise acquired the Domain Name primarily "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." The Complainant asserts that the Respondent's offer is nothing more than an attempt to unfairly extract money from the Complainant.

6. Discussions and Findings

Under paragraph 2.1 of the Policy, for the Expert to order transfer of the Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

“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.”

6.1. The Complainant’s Rights

The Expert finds that the Complainant has established “Rights” in the HYPNOS trade mark, by virtue of its registration and use, both in the United Kingdom and internationally, the details of which are provided in the factual-background section above.

The Domain Name comprises the Complainant’s HYPNOS trade mark in its entirety as its leading element, together with the descriptive term “beds”, under the “.co.uk” domain extension. The Expert finds that the inclusion of the term “beds” does not prevent a finding of similarity between the Domain Name and the Complainant’s HYPNOS trade mark, which remains clearly recognizable in the Domain Name. The Expert notes in this regard that the Complainant’s HYPNOS trade mark is registered in respect of “Bedding (other than bed clothing), mattresses and furniture; and parts and fittings included in Class 20 for all the aforesaid goods.”

The Expert finds the Domain Name to be similar to the Complainant’s trade mark. Accordingly, the Complainant has satisfied the requirements of paragraph 2.1.1 of the Policy.

6.2. Abusive Registration

An "Abusive Registration" is defined in the Policy 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.”

The evidence provided by the Complainant shows that prior to the filing of the Complaint, the Domain Name was being used to redirect Internet users to the website of the company BedWorld, a competitor of the Complainant in the Complainant’s home market. BedWorld is not an authorized reseller of the Complainant’s products, nor has any authorisation been granted to BedWorld to use the Domain Name in such a way.

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Expert notes that the Domain Name corresponds to the Complainant’s principal domain name <hypnosbeds.com>, simply replacing the generic Top-Level Domain “.com” with the United Kingdom country code domain extension “.co.uk”. By using the Domain Name, as described above, the Expert finds that the Respondent has attempted to divert Internet users seeking the Complainant’s website under the “.co.uk” domain extension to the

website of a competitor of the Complainant, unfairly disrupting the Complainant's business, as contemplated by paragraph 5.1.1.3 of the Policy.

The Expert also notes the Respondent's offer to sell the Domain Name to the Complainant for GBP 2,000, and accepts the Complainant's submission that such an offer amounts to further evidence that the Domain Name is an Abusive Registration, indicating that the Respondent registered the Domain Name for the purposes of selling the Domain Name to the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring the Domain Name, within the meaning of paragraph 5.1.1.1 of the Policy.

For the reasons set out above, the Expert finds that the Domain Name in the hands of the Respondent is an Abusive Registration, as it has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. The Complainant has satisfied the requirements of paragraph 2.1.2 of the Policy.

7. Decision

The Complainant has Rights in 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. The Domain Name should therefore be transferred to the Complainant.

Signed David Taylor

Dated 07/08/2020