

DISPUTE RESOLUTION SERVICE

D00022908

Decision of Independent Expert

Base Protection Srl

and

Andrew Fairbank

The Parties

Lead Complainant: Base Protection S.r.l.

Respondent: Andrew Fairbank

The Domain Name

baseprotection.co.uk

Procedural Matters

1. 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.

2. The following is the procedural history of this case, -

10 August 2020 Dispute received by Nominet;
12 August 2020 Complaint validated;
12 August 2020 Notification of complaint sent to parties;
14 August 2020 Response received;
14 August 2020 Notification of response sent to parties;
19 August 2020 Reply reminder sent;
21 August 2020 Reply received by Nominet;
21 August 2020 Notification of Reply sent to parties;
26 August 2020 Mediator appointed;
16 September 2020 Mediation started;
01 October 2020 Mediation failed;
01 October 2020 Close of mediation documents sent;
09 October 2020 Expert decision payment received;
12 October 2020 Expert appointment.

Factual Background

3. The Complainant is a company registered under the laws of Italy, carrying on business in the UK, mainland Europe and elsewhere in the production and sale of safety footwear. The Respondent is a broker and sales agent for a company called Rolmacon Global Ltd ('RGL'), which has its registered office in the UK and carries on business supporting the worldwide production of rubber and polyurethane machine rollers.
4. The Respondent registered the Domain Name on 16 November 2016. The Domain Name resolves to a website ('the Website') that advertises and offers for sale predominantly safety shoes manufactured by the Complainant. On 9 July 2020, lawyers acting for the Complainant wrote to the Respondent demanding that he transfer the Domain Name. On 16 July 2020, the Respondent offered to transfer it for 10,500 Euros. The Complainant declined to pay that sum and made the present Complaint.

Parties' Contentions

5. Set out below are summaries of the cases presented by the parties. References to the DRS case law and principles from the Experts' Overview referred to in those cases have not been included in the summary but have been taken into account, where relevant. In summary, the Complaint alleges as follows, -

5.1 The Complainant owns two registered trade marks, -

5.1.1 European Union Trade Mark no. 003265063 'Base PROTECTION' (figurative) – Nice classification 9, 25.

5.1.2 International Trade Mark No:1169723 'Base PROTECTION' (figurative) – Nice classification 9, 25.

- 5.2 The Complainant has received several industry awards for its products and its business has grown steadily in Europe. By 2012, it had a turnover of over 12 million Euros and from that time it began exporting to non-European markets in North America, Russia and elsewhere.
- 5.3 The Complainant operates a number of websites such as baseprotection.co.uk, baseprotection.it, baseprotection.fr and baseprotection.de, and also baseprotection.com. The latter generates a significant number of visits and redirects Internet users to the Complainant's website translated into five languages.
- 5.4 The Respondent registered the Domain Name on 16 November 2016 and used it to host a website that is confusingly similar to the Complainant's website, that would lead consumers to believe that it is provided or approved by the Complainant, which is not the case.
- 5.5 When the Complainant became aware of the registration of the Domain Name, it contacted its UK distributor. On 23 October 2019 the distributor informed the Complainant that the Respondent alleged that he had been given 'the green light ... on numerous occasions ...' by an employee of the distributor.
- 5.6 The Complainant was not aware of any authorisation given to the Respondent. In any event, its distributors are forbidden by the contract entered into with the Complainant from registering a domain name that includes a trade mark of the Complainant.
- 5.7 The Complainant then wrote to the Respondent, who demanded £75,000 for transfer of the Domain Name by email dated 23 April 2020. On 21 May 2020 the Respondent reduced his demand to £40,000.
- 5.8 Although the Complainant considered the registration to be abusive, it offered the Respondent 5,000 Euros to settle the matter and secure the transfer. The offer was refused. Following further monetary offers from the Respondent to profit from the sale of the Domain Name a letter was sent to the Respondent on 9 July 2020 from the Complainant's authorised representatives, demanding that the Respondent transfer the Domain Name. On 16 July 2020, the Respondent offered to transfer it for 10,500 Euros. Further correspondence ensued on 24 July 2020, but this did not result in the transfer of the Domain Name.
- 5.9 Following that correspondence the Respondent amended the website in only minor respects, offering discounts for some of the items available for purchase.
- 5.10 The registration of the Domain Name is abusive for the following reasons, -

- 5.10.1 The material part of the Domain Name is identical to the trade marks, 'BASE PROTECTION' and also to the Complainant's official website and its company name.
- 5.10.2 The Domain Name was registered without the consent of the Complainant.
- 5.10.3 The Registrant has also advertised for sale on the Website products of a competitor, Redbacks Cushioning Ltd. This amounts to an unfair advantage.
- 5.10.4 Internet users are likely to believe that the Domain Name belongs to or has been authorised by, the Complainant, particularly as the Domain Name is identical to the Complainant's marks and is without adornment.
- 5.10.5 The match of the Domain Name with the Complainant's trade marks will generate 'initial interest confusion'. Internet users who visit the Website will be further confused as a result of the following, -
- 5.10.5.1 The Respondent has used the font and colours on the Website that are used on the Complainant's website at www.baseprotection.com;
 - 5.10.5.2 the 'About Us' section of the Website has been copied from the website at www.baseprotection.com;
 - 5.10.5.3 the Website includes copies of images of shoes and videos of technologies inserted in the Complainant's products, in each case taken from www.baseprotection.com;
 - 5.10.5.4 the Website contains no disclaimer;
 - 5.10.5.5 the Respondent's address and company data are not indicated in the Website;
 - 5.10.5.6 the Domain Name has been registered in the name of a privacy shield.
- 5.10.6 The Respondent was clearly aware of the Complainant's trade mark when he registered the Domain Name, which he did in order to create an unofficial distribution channel in the UK, 'exploiting the value of the Complainant' and selling products of a competitor of the Complainant, causing a potential loss of

business and creating a blocking registration against a mark in which the Complainant owns rights.

5.10.7 In addition, the Respondent has attempted to sell the Domain Name to the Complainant for a sum in excess of the out-of-pocket costs directly associated with the registration.

6. The Response alleges in summary as follows, -

- 6.1 The Respondent is a broker and sales agent for RGL, which was established in 2015 and carries on business in the support of the worldwide production of rubber and polyurethane machine rollers.
- 6.2 The Respondent made contact with Brian Hyde Ltd. ('BHL'), a UK importer of products made by the Complainant. He met their representative at a trade show in Birmingham and was shown the boots made by the Complainant.
- 6.3 The Respondent considered that these products would give him an opportunity to diversify his business and he carried out an investigation into the market, working closely with BHL to understand what BHL needed to increase sales. The Respondent proposed the idea of an exclusive and dedicated online store for Base Boots. He was told that while the Complainant did sell online in Europe, this was something that was not planned for the UK.
- 6.4 The Respondent purchased the Domain Name and asked BHL to ensure that this was 'OK'. 'The reply was that they could not see any issue and it is OK to continue.' The Respondent was informed orally that the Complainant was 'OK' with this.
- 6.5 The Respondent invested time and money in an online platform – Shopify. He worked long hours to build the Website, to make it into a website worthy of the Base brand. He entered into an agreement with BHL to purchase every boot it bought from the Complainant.
- 6.6 The Respondent was not selling all brands of safety boots, simply those manufactured by the Complainant. He wanted to enhance their brand in the UK.
- 6.7 BHL offered the Respondent access to the 'office photographs' and technical data sheets.
- 6.8 'Without prejudice [the Respondent] agree[s] that elements of the website could have had tighter controls. However, [he] followed the templates that Shopify had provided. ... [He] used the 'About Us' page only to highlight information about the company and ... brand, to show the scale and size of the business and to add confidence to the buyer's experience. In hindsight it should have had a disclaimer about the relationship on the website. I apologise for this and will admit that this

was a genuine oversight. However, as the website is dedicated to one brand I fail to see how promoting Base's own information to promote their own products would be so misleading to a customer that [this] would cause confusion.'

- 6.9 The recent demands of the Complainant are due to the sale of the Complainant to Portwest. Until then, there had been no issues for three years. The Complainant was aware of the Website from the outset.
 - 6.10 The Respondent made sure that the Website was 'OK' on several occasions and 'had conversations with Base prior to 2019 so they must have been aware!'
 - 6.11 The Domain Name has been used for the sole benefit of the Complainant. Numerous examples are given in the Response of brand promotion and also collaboration with the Complainant for new business opportunities.
 - 6.12 The Respondent's use of the Domain Name has not been abusive at all. It was not bought in order to sell it for a profit, or to 'cyber-squat'. The Respondent understands that the Complainant has had a corporate change of mind, and he considered that he should be paid a fair price for the asset that he built up with their authorisation. The Domain Name has not been used to the detriment of the Complainant; quite the opposite.
 - 6.13 The Respondent has not intentionally misled customers or created sufficient confusion to make customers doubt the integrity of the Website, brand or trade mark. He has even handled customer complaints from customers who have bought Base Boots from other merchants who refuse to deal with them.
 - 6.14 To allow the respective companies to part on beneficial terms, the Respondent suggests a transfer of the Domain Name for 8,500 Euros and a refund for the very small amount of stock held.
7. The Reply alleges, -
- 7.1 The Respondent has provided no clear supporting evidence that the Complainant ever authorised his use of the Domain Name;
 - 7.2 The Complainant's distribution agreement with BHL clearly prohibited registration of the Domain Name by BHL and the authorisation by BHL of any third party to do so.
 - 7.3 The Complainant had no direct relationship with the Complainant, as the shoes were bought from BHL.
 - 7.4 The Respondent has never made clear that the Website was operated by him, which has led to confusion in the marketplace.

- 7.5 The time period between registration and the Complainant's first request for transfer of the Domain Name does not amount to acquiescence on the part of the Complainant for the purposes of the DRS and delay on its own is not a ground on which a complaint can be denied.

Discussion and Findings

8. 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 DRS Policy. Therefore, it is not necessary to resolve all the issues raised by the parties.
9. I refer to, and repeat as findings, the contents of paragraphs 3 and 4 above.

What Must a Complainant Prove to Succeed in a Complaint?

10. 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: -
- 10.1 he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- 10.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

11. 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.'*
12. The Complainant has produced the results of trade mark searches relating to two trade mark registrations. One shows a EUTM trade mark no: 003265063, registered on 1 March 2005 and owned by the Complainant, with an expiry date of 21 July 2023 in classes (Nice) 9 and 25.
13. The second search shows an international trade mark no: 1169723 in classes (Nice) 9 and 25, registered on 13 May 2013, with an expiry or renewal date of 13 May 2023.
14. The trade marks each consist of the grey fancy lettering 'Base PROTECTION', with the word 'Base' in the foreground, formed by thick

stylised characters; beneath this, in small characters, is the word 'PROTECTION'; to the left is a grey hexagon with one side open, containing a smaller orange hexagon.

15. The words 'Base PROTECTION' are the same words as those in the relevant part of the Domain Name, the co.uk suffix being ignored for the purposes of the DRS.
16. Therefore, the Complainant has established that it is the owner of those trade marks and has Rights in respect of them. The marks are similar to the Domain Name, because they each include the words 'Base PROTECTION.'
17. As a result, the Complainant has established Rights in respect of a name or mark which is similar to the Domain Name. Accordingly, the Complainant has established that it owns Rights.

Abusive Registration

18. 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;

.....

5.1.6 The Domain Name is an exact match (within the character 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.'

19. 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

.....'

.....

8.4 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.

.....'

20. I have taken into account the DRS case law referred to by the Complainant so far as applicable to this case. I also refer to D00016416, *World Wrestling Entertainment, Inc v. Daniel Raad*, where the DRS Appeal Panel stated, -

... [A]s a matter of broad principle, the Panel considers the position to be as follows in relation to cases where the complaint concerns a domain name where the alleged abuse is said to arise in respect of a website which is used to sell only the genuine goods or services of the complainant.

If:

1. a website is linked to a domain name; and
2. the website is used to sell only the genuine goods or services of a third party; and
3. the third party alleges the domain name is an Abusive Registration; and
4. the third party has relevant Rights in respect of a name or trade mark.

Then:

5. use of the name or trade mark concerned in unadorned form as a domain name is likely to amount to an Abusive Registration.
6. Use of the name or trade mark concerned is also likely to amount to an Abusive Registration if the name or trade mark is combined with a term or terms that results in a domain name which would readily be considered to be that of the owner of the name or trade mark concerned.
7. Such use is less likely to amount to an Abusive Registration if the name or trade mark concerned is combined with a term or terms that results in a domain name which would not readily be considered to be that of the owner of the name or trade mark concerned.

In stating these principles the Panel would add as follows:

8. These are not absolute rules, hence the use of the terms “likely” and “less likely” – all relevant circumstances need to be taken into account and other factors may be relevant and result in a different conclusion being reached. As well as the modifying term itself such factors could include for example: the strength or fame of the name or trade mark in question; the nature and price of the goods or services being offered; the sophistication or otherwise of the likely consumers of such goods or services; questions of licence or permission; and any relevant contractual arrangements between the parties. Further factors such as the nature, appearance and content of the website to which the domain name is linked, and the extent to which any disclaimers are used on that website, may also be relevant in a given case if it appears appropriate to consider the case on the basis of matters beyond initial interest confusion.

9. *As stated above these principles apply where the website in question is selling only the goods or services of the owner of the name or trade mark concerned. If competing or counterfeit products are also or alternatively being sold then still further considerations may apply and a given domain name which would not amount to an Abusive Registration in accordance with these principles may nevertheless be found to be so when such additional considerations are taken into account.'*
21. Many Internet users searching for the Complainant online are likely either to guess the domain name of its website or type the words 'BaseProtection' into a Google or other search engine. The fact that the Domain Name contains the unadorned words of the Complainant's trade marks makes initial interest confusion inevitable. Use of these words implies either that this domain name is that of the Complainant or of a person who has an authorised commercial connection with the Complainant.
22. What will a visitor to the Website see and likely conclude? The 'About Us' section features a photograph of the Complainant's office premises. The accompanying text states, -
- 'Base Protection are an Italian business, steeped in shoe making. Their aim is to design and manufacture the most comfortable safety shoes in the world.*
..... Base Protection has a broader view of comfort that goes beyond foot's wellness, with a level of care and advanced relationship that keeps the customer central to the organization and so affirms what they do.
Base Protection. A Step forward.
- Comfort is what inspired Base Protection ...'*
23. Next to the words 'A Step Forward' appears the large part of the trade mark(s), namely the grey incomplete hexagon enclosing the complete smaller orange hexagon, to the right of which appears (as in the marks) the word 'Base' in the fancy lettering of the marks. The word 'PROTECTION' does not appear below, being replaced by the words 'feel the comfort'. The overall impression conveyed is that these are the Complainant's trade marks.
24. Pages from the Website refer to 'Base PPE'. Other documents in the case show this appears to be the trading name of the distribution business operated by the Respondent with respect to the Complainant's manufactured footwear.
25. However, combined with the About Us section, the impression created is that the Website is operated either by the Complainant or by an entity or business authorised by it, particularly as there is no explanation or disclaimer provided.
26. The Respondent has also used the font and colours on the Website that are used on the Complainant's website at www.baseprotection.com. The two websites are confusingly similar, as a result of the orange and blue horizontal

bars that run across the top part of web pages on both websites, the font used on each website and the photographs that appear on them. These similarities are likely to reinforce the confusion of a visitor to the Website, particularly one who is familiar with the Complainant's brand or website at www.baseprotection.com.

27. The Respondent has made no material changes to the content of the Website either during or since the correspondence that took place between October 2019 and July 2020.
28. I now address the Respondent's case on consent and acquiescence of the Complainant. I refer to the Respondent's email to BHL of 23 October 2019 and to his email to the Complainant of 27 May 2020 and the response to it of 29 May 2020. It is not at all clear or more likely than not that the consent was given to the Respondent to register the Domain Name, as opposed to BHL, with whom the Complainant had entered into a formal distribution agreement. As the Respondent accepts in his email of 27 May 2020, he did not want to approach the Complainant himself and it was BHL who were the 'nominated UK importer and entrusted with the brand in the UK'. For that reason, I do not accept either that he had direct conversations with the Complainant, as alleged in unparticularised assertion to that effect in the Response. Therefore, I find it is unlikely that the consent was given for the Respondent (as opposed to BHL) to register the Domain Name.
29. Even if, contrary to this finding, the Complainant did give a permission for the Respondent (as opposed to BHL) to register the Domain Name, the use made of it has gone far beyond any implied permission to use it to sell the Complainant's branded goods. I do not accept that the further approvals that the Respondent says he obtained from BHL amounted to a consent from the Complainant that he could use the Domain Name in the manner that he has used it. The matters relied on by the Respondent, particularly the 'Okaying' referred to in the Response, do not establish any express permission to do so, let alone any permission for him, as opposed to BHL.
30. Therefore, I conclude that no authorisation was ever given to the Respondent by or on behalf of the Complainant to use the Domain Name in the manner that the Respondent has done. An alternative analysis in law is that in view of the Respondent's actual use of the Domain Name, the Complainant was entitled to terminate any licence that might have existed with respect to use of the Domain Name, and the Complainant did so in the pre-complaint correspondence.
31. Having rejected the Complainant's case of consent or acquiescence, I consider further matters relevant to the issue of Abusive Registration. The Respondent's copying of critical parts of the Complainant's website at www.baseprotection.com, including the About Us section incorporating the large part of its trade mark(s) and the advertising for sale of goods made by a competitor of the Complainant (knee-wear), though not competing products, amount to uses of the Domain Name that take unfair advantage of the Complainant's trade marks and are also unfairly detrimental to those marks.

32. That copying was, as I find, calculated to cause confusion among customers of the Complainant, again generating both an unfair advantage and unfair detriment to the Complainant's two trade marks.
33. The Complainant has therefore established, for the purposes of paragraph 5.1.2 of the Policy, that there are circumstances indicating that the Respondent is using and also threatening to use the Domain Name in a way which has confused and 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. The Respondent has not shown that its use of the Website was authorised by the Complainant and has not established any relevant matters within paragraph 8 of the Policy so as to defeat a finding of Abusive Registration based on paragraph 5.1.2.
34. For these reasons, I conclude that the Domain Name is being and has been used in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights.

Decision

35. The 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.
36. Therefore, the Expert determines that the Domain Name 'baseprotection.co.uk' be transferred to the Complainant.

Signed: STEPHEN BATE

Dated 16.10.20