

DISPUTE RESOLUTION SERVICE

D00008752

Decision of Independent Expert

Fellowes, Inc.

and

Virtual System Management Ltd

1. The Parties:

Lead Complainant: Fellowes, Inc.
1789 Norwood Avenue
Itasca, Illinois
60143
United States

Respondent: Virtual System Management Ltd
Impulse House, Grove Way
Bury
Huntingdon
Cambridgeshire
PE26 2LS
United Kingdom

2. The Domain Name(s):

fellowes-store.co.uk
fellowesstore.co.uk

3. Procedural History:

- 3.1 A Hard copy of the Complaint was received in full by Nominet on 29th June 2010. Nominet validated the Complaint and notified the Respondent of the Complaint on 30th June 2010.

- 3.2 A Response was received from the Respondent on 20th July 2010 and a Mediator appointed on 28th July 2010. Mediation commenced on 2nd August 2010 but failed on 6th August 2010.
- 3.3 On 24th August 2010 the Complainant paid the fee to obtain an Expert Decision pursuant to paragraph 21 of the procedure for the conduct of proceedings under the Nominet Dispute Resolution Service (“the Procedure”).
- 3.4 On 27th August 2010 Nick Phillips, the undersigned (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as the Expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual Background

- 4.1 The Complainant is Fellowes, Inc.
- 4.2 The Respondent is Virtual System Management Ltd. The Respondent registered the Domain Names on 22nd October 2004.
- 4.3 The Complainant is a manufacturer and supplier of workspace products and solutions such as desk accessories, and shredders which are sold worldwide.
- 4.4 The Complainant was founded in Chicago in 1917 under the name Bankers Box and now has operations in 15 countries including the UK. It changed its name to Fellowes in 1984.
- 4.5 The Complainant is the registered proprietor of a number of trade marks in the UK, Europe and worldwide many of which include the mark FELLOWES.
- 4.6 The Complainant is the owner of, inter alia, the domain names both of which it links to its main site.

Fellowes.co.uk
Fellowes.com
- 4.7 As well as the Domain Names the Respondent is also the owner of over 1,000 domain names which generally appear to refer to office supplies.
- 4.8 The Domain Names currently link to a holding page which is devoid of any content but had previously been redirected to an under construction store front also owned by the Respondent.

- 4.9 The Complainant sent a cease and desist letter to the Respondent by email on 14th September 2009, 16th September 2009 and 28th September 2009. No response was made and the Respondent denies receiving any of these letters.

5. Parties' Contentions

The parties' contentions are as follows:-

Complainant

What Rights you are asserting?

Factual background of the Complainant

Founded in 1917 as the famous Bankers Box Company by Harry Fellowes, Fellowes, Inc. has evolved into a global manufacturer and marketer of workspace products and solutions that enhance security, organization and productivity in today's workplace. These products and solutions include Business machines, Records storage, Workspace accessories, Mobile accessories (Body Glove) and Media labeling (NEATO) to name a few. Fellowes, Inc. is notable for inventing the personal shredder, known globally as the Worlds Toughest Shredders including a new revolutionary paper shredder created by Fellowes in 2008 that puts an end to their customers number one complaint. The Intellishred Series recognized as 100% jam proof. In addition, although Bankers Box records storage was the company's first product line it continues to dominate the market. (see Annex 1).

From its inception in Chicago, Illinois, Fellowes, Inc. currently employs more than 2,700 people throughout the world and has operations in 15 countries, which include subsidiaries and affiliates located in Australia, Benelux, Canada, China, Croatia, France, Germany, Italy, Japan, Korea, Poland, Russia, Singapore, Spain, South Africa and United Kingdom (Respondents location), (see Annex 2).

As the winner of numerous excellence awards in the Corporate, Products, Marketing and Industry categories, Fellowes, Inc. has recently been given the Gold Award for Design Excellence (ADEX Awards) for the Galaxy Binding Machine and the Platinum Award for Design Excellence (ADEX Awards) for the P-58 Shredder. In the Industry category, Fellowes, Inc. has been given the Vendor Award for the Supply Chain Category from Business Depot Canada and from Staples Canada (the world's largest office products company, serving businesses in 27 countries), two (2) years in a row, 2008-2009. Also on the honor roster, is an award in 2008, Supplier of the Year from Office Depot (a global supplier of office products and services, selling to customers in over 49 countries). (see Annex 3).

As provided as Annex 4, are copies of the registered trademarks by which the Complaint is based. The Complainant, Fellowes, Inc., has been the sole owner of the principal trademark and the current published owner of the brand, FELLOWES, at the United States Patent and Trademark Office, USPTO, with the registration number of 1711418 since June 9, 1992 and two (2) trademarks registered at the

UK Intellectual Property Office (TM# 2054866 & E948752) as early as 1996 among all other trademarks used in connection with the famous FELLOWES brand in relation to the goods and services; storage boxes for word processing tapes, computer disks and diskettes; paper and microfilm shredders, stands for shredders, copy holders in the nature of paper holders for typists, looseleaf and string type binders, corrugated fibreboard [sic] products; namely, clothing storage boxes, document storage files, file drawers, file folders, document storage trays, magazine storage files, storage boxes with plastic handles, shipping boxes, and carrying cases, and plastic waste Bags; furniture; namely, shelving, cabinets and non-metal bins for use in storing and organizing documents, books, magazines and clothing; vinyl hanging bags for storing clothing and shoes. (see Annex 4)

In addition to the above trademark, The Complainant, Fellowes, Inc., also has been the sole owner of the Community Trademark CTM and the current published owner of the same brand, FELLOWES, at the Office for Harmonization in the Internal Market, OHIM, with the registration number of 000948752 since March 24, 2000, under the Nice Classifications 7, 11, 16, 18 and 20 (see Annex 5).

The Complainant, also has additional registered trademarks in the U.S. and all over the world (CTM), which includes protection in the United Kingdom as part of the European Union and which is where the Respondent is located, protecting their other brands for their product line, including, the following and as shown in Annex 6.

Trademark	TM Number	Registration Date
NEATO	004456588	5/13/2005
INTELLISHRED	006257216	7/24/2008
BANKERS BOX	002823607	8/8/2002

The domains included in this Complaint contain the Complainant's registered trademark, FELLOWES, in the dominant part of the domain name and the added generic term, STORE which implies that the Respondent sells the products of the Complainant, Fellowes, Inc. In similar circumstances, see DRS04601, Nike International Limited and Robert Morrison, Although store is generic, the Expert considers that it has a clear connection with the Complainant and that nikestore is, therefore, similar to NIKE for the purpose of the Policy. In addition the WIPO decision below agrees with the expert as stated in Decision D2009-0398, G-Star Raw Denim KFT v. xia xinzheng. It is established by numerous decisions made under the Policy that adding a word to a complainant's mark will usually not preclude a finding of confusing similarity. If the word added relates to the complainant's business, it is even more likely to find confusing similarity between the disputed domain name and the complainant's trademark (see Experian Information Solutions, Inc. v. BPB Prumerica Travel (a/k/a SFXB a/k/a H. Bousquet a/k/a Brian Evans), WIPO Case No. D2002-0367). In the present case, the disputed domain name not only contains the Complainant's registered trademark G-STAR in its entirety but adds to the mark a generic word store that implies the sales of the Complainant's of fashion products

A Google search for FELLOWES yields at least 4,020,000 hits. The first result listed in the Complainant's home site, FELLOWES.COM. Other results reference pages within the FELLOWES.COM home site, including sites affiliated with the

Complainant listing their products (see Annex 7). In addition, a search for FELLOWES STORE yields at least 743,000 hits, resulting in the Complainants retail store locator portion of their home site. Furthermore, a simple search for FELLOWES-STORE also results in the same portion of the Complainant's site. (see Annex 8).

These facts, serve to establish that Respondent's domain names are virtually identical to Complainant's trade name and confusingly similar to its registered trademarks.

Why is the domain name an Abusive Registration?

The Respondent has no rights or legitimate interests in respect of the domain name. There is no evidence that Respondent owns registrations for any trademarks containing the terms FELLOWES or FELLOWES STORE The term, FELLOWES or FELLOWES STORE does not serve as the Respondent's trade name, business identity; and Respondent does not provide goods or services that are identified or described by these or similar terms. The Respondent, Virtual System Management Ltd. seems to be in the business of buying and parking domains. They currently own over 136 domains (.com, net. org) the majority of these are generic terms in reference to office supplies and other Trademark holder products within the same industry, [SHREDDERSUPERSTORE.COM, BUSINESS-STATIONERY-SUPPLIES.COM, BOKODELABEL.COM, BOKODESCANNER.COM, BROTHERLABELPRINTERS.COM etc.] (see Annex 9). These sites are only parked sites and do not offer any services or products (see Annex 10).

The Respondent is not a licensee, authorized online Fellowes reseller, nor an authorized representative/ partner of Fellowes, Inc. to register or sell any domain names (or other goods/services of any kind) incorporating Complainant's marks.

Complainant sent a Cease and Desist letter to Respondent Virtual System Management Ltd, on September 14, 2009; September 16, 2009 and a 3rd request made on September 28, 2009, informing Respondent that it was infringing on Complainant's IP rights and allowing the Respondent the opportunity to respond if they have any IP rights. The Respondent was provided with the information of the Complainant's trademark, hence showing proof that Complainant has rights to the brand, (see Annex 11) and a response was never received by the Respondent. See Vertical Solutions Management., Inc. v. webnet-marketing, inc., FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, WIPO Case No. D2000-0009 (WIPO Feb. 29, 2000) (In the absence of a response, it is appropriate to accept as true all allegations of the Complaint). In addition in WIPO case ACCOR v. Pham Manh Ha , Case No. D2007-1855, the panel found that the evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name: Do The Hustle, LLC v. Tropic Web, WIPO Case No. D2000-0624 and the cases there cited. The Respondent has made no attempt to do so.

The Respondent is not using the website in connection with any bona fide offering of goods or services; instead the Respondent has intentionally chosen a domain

name based on a registered trademark in order to generate traffic to an upcoming web site/ storefront and through this procedure potentially generate income or potentially phish. The websites associated with the domain names registered by Respondent is redirected to an under construction store front also owned by the Respondent (http://www.impulsee-store.co.uk/page/Impulse_eStore/CTGY/FELLOWES_STORE) (see Annex 12), where it is noted that the store is currently under development and due for release in the future. Although there does not seem to be any recent archives on the websites for the domain names on www.archive.org, there are archives for the site where these domains are redirected, as shown above and further discussed in Part C. It is obvious that the Respondent is trying to generate revenue off the Complainant's world famous trademark.

The comments above serve to establish that Respondent has no rights, or legitimate interest with respect to the domain name.

The domain name was registered and is being used in bad faith. Respondent registered the domain names, FELLOWESSTORE.CO.UK and FELLOWES-STORE.CO.UK, on October 22, 2004. As stated above, under factual background, the brand FELLOWES has been in use since 1917 and has been a registered US trademark since 1992, (see Annex 4), well before the registration of FELLOWESSTORE.CO.UK and FELLOWES-STORE.CO.UK. In addition, the main home site of the Complainant, FELLOWES.COM has been registered since December 29, 1995 in addition to the FELLOWES.CO.UK domain registered since February 19, 1997. (see Annex 13). As shown in factual background, the Complainant, Fellowes, Inc. has been recognized as a global manufacturer and marketer of workspace products and solutions with offices in over 15 countries including the United Kingdom, where Respondent is located.

The Respondent registered the domain names after 1992 (registered trademark), after 1995 (registration of domain name FELLOWES.COM) even though the Complainant is well known in the business service and product industry (known as World's Toughest Shredder); and that their trademarks are well recognized publicly, including other business products known publicly and carried in office supply stores all over the world. With this recognition, it is unlikely that the Respondent did not recognize or were not familiar with the Complainant's trademarks at the time of registration. To the Complainant's trademark the Respondent has added only a hyphen and the word STORES for FELLOWES-STORES.CO.UK and has omitted the hyphen on "FELLOWESSTORES.CO.UK, which is an essential feature of running a store, thus suggesting that the domain name relates to the availability of the Complainant's products and supporting sites implying that they carry or are associated with the Complainant, for example WWW.SHRED-ME.CO.UK (see Annex 14). This raises the assumption that the domain name was registered for the illegitimate purpose of trading of the name and reputation of the Complainant for commercial purposes and thus in bad faith, for the Respondent clearly had the Complainant in mind when he registered the domain name without permission. As the Complainant has shown by reference to decisions such as Charles Jourdan Holding AG v. AAIM, WIPO Case No. D2000 0403, the very use of such a famous trademark as FELLOWES without any permission shows bad faith by itself. In the absence of any explanation from the Respondent for doing so and in the light of the inherently illegitimate nature of the

Respondent's activities. Furthermore, see also DRS04601, Nike International Limited and Robert Morrison, Under paragraph 3 a i C, there may be Abusive Registration if circumstances indicate that the Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. Under paragraph 3 a ii of the Policy, there may be evidence of Abusive Registration if there are circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. It is extremely likely that people and businesses wishing to access the Complainant's web-site, in fact, visit the Respondent's web-site, in the belief that the web-site is associated with or authorised by the Complainant. The Expert concludes that, on the balance of probabilities, the Respondent has registered the Domain Name in order to take unfair advantage of the Complainant's distinctive trade mark and world-wide reputation. This is Abusive Registration within the terms of the Policy.

As mentioned in the Rights portion of the complaint, the websites associated with the domain names registered by Respondent is redirected to an under construction store front also owned by the Respondent (http://www.impulsee-store.co.uk/page/Impulse_eStore/CTGY/FELLOWES_STORE) (see Annex 12), where it is noted that the store is currently under development and due for release in the future. The website references the Fellowes brand and takes advantage of the goodwill of the Complainant and its well-known trademark although in an under construction state. In WIPO Case D2007-1855, ACCOR v. Pham Manh Ha, the circumstances set out in the Policy, paragraph 4(b) are illustrative, not exhaustive. In the absence of any explanation from the Respondent, the conclusion is to this Panel inescapable that the Respondent registered the disputed domain name for the purpose of taking advantage of the Complainant's goodwill in its well-known SOFITEL trademark and that the respondent's registration and currently inactive use, of the disputed domain name, is intended to further that end. The fact that the disputed domain name is apparently not in active use rather leads to under construction notice, does not alter the Panels finding of bad faith in the circumstances of this case?. See e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

A Reverse Who-is Report also reveals that Respondent has registered more than 140 domains (.COM, .NET, .ORG), (see Annex 9). The majority of these domain names are also well known trademarks in the U.S. and all over the world; BOKODESHOP.COM, BOKODE-STORE.COM, BROTHER-MEGASTORE.COM, BROTHERSUPERSTORE.COM, to name a few, which are either parked to a webhosting site or under construction (see Annex 10). The high number of registrations and registration of well known brands and trademarks evidences speculation in domain name registrations; and registration of one or more domain names that infringe IP rights of others for purposes of speculation is, once again, proof of Respondent's bad faith.

In summary, speculation in the registration of domain names, infringement of Complainant's IP rights, the fact that Respondent registered the domain name after Complainant registered its IP rights, including after the registration of Complainant's main domain name, WWW.FELLOWES.COM, ignoring the numerous requests to Cease and Desist the use of such IP rights as established by the

Complainant, and specifically, as shown above, the domain name was registered and used by the Respondent in order to divert internet users to other websites for the purpose of commercial gain regardless of the Respondent being aware of the infringement, clearly establishes Respondent's bad faith both in the registration and the use of the domain names.

RESPONDENT

Why should the complaint not succeed?

1) The Complainant has claimed that;

The domains included in this Complaint contain the Complainant's registered trademark, FELLOWES, in the dominant part of the domain name and the added generic term, STORE which implies that the Respondent sells the products of the Complainant, Fellowes, Inc.

Whilst it is true that the term FELLOWES is part for the URL's in question, Fellowes, Inc only have control of the trademark term FELLOWES in classes 03, 07, 09, 11, 16, 18, 20. 37 classes are available for the term FELLOWES to be registered. Whilst the Complainant claims that it is implied that the URL's in question sells the products of the Complainant, factually, this has never been the case. To support this fact, the complainant has stated themselves;

Respondent does not provide goods or services that are identified or described by these or similar terms

2) The Complainant states that the Respondent owns a large number of URL's;

The majority of these domains names are also well know trademarks in the U.S and all over the world.

This is untrue as the majority of the Respondents URL's (totalling over 1000) do not contain trademark terms.

A number of successful site are operated on URL's owned by the Respondent that contain trademarks registered within the UK. These sites are developed after firstly gaining consent from the particular manufacturer and trademark owner. There is in place a very long standing and successfully partnership operating in this manner . Development or operation of any site in this manner would not occure without firstly obtaining consent from the trademark owner.

3) The Complainant states;

The Respondent is not a licensee, authorized online Fellowes reseller, nor an authorized representative/ partner of Fellowes, Inc to register or sell any domain names (or other goods/services of any kind) incorporating Complainant's marks.

Whist this may be the case of the Respondent, the operator and publisher of the sites has written consent for the use of the trademark Fellowes logo on their

Internet stores and for the purpose of identifying, marketing and selling Fellowes products.

4) The Complainant states;

Complainant sent a Cease and Desist letter to Respondent Virtual System Management Ltd, on September 14, 2009; September 16, 2009 and a 3rd request made on September 28, 2009, informing Respondent that it was infringing on Complainant's IP rights and allowing the Respondent the opportunity to respond if they have any IP rights.

We did not receive any Cease and Desist letters as claimed by the Complainant and note that the Complainant has made no reference to proof of receipt of their claim any such letters were received.

5) The Complainant States;

The Respondent is not using the website in connection with any bona fide offering of goods or services; instead the Respondent has intentionally chosen a domain name based on a registered trademark in order to generate traffic to an upcoming web site/ storefront and through this procedure potentially generate income or potentially phish.

This is clearly not the case as the URL's in question have not even been published and so could not be used to generate traffic. Enclosed are URL site searches that identify URL's that are published with Google. Both www.fellowesstore.co.uk and www.fellowes-store.co.uk have not been published with Google.

6) The Complainant states;

The websites associated with the domain names registered by Respondent is redirected to an under construction store front also owned by the Respondent (http://www.impulse-estore.co.uk/page/Impulse_eStore/CTGY/FELLOWES_STORE)

Whilst this may have inadvertently been the case in the former complaint, this oversight was immediately corrected upon receipt of the original DRS case. Therefore this claim is now untrue and bears absolutely no relevance to the current Complaint!

Many businesses both large and small operate manufacturer or brand related stores within their own sites. This is demonstrated with the enclosed document of a Google search for the term fellowes store. The original intention on this site was to include a Fellowes Store within the store and URL of Impulse eStore at the URL www.impulse-estore.co.uk. This has for a long time now not been the case and the store has now been closed as clearly stated and has been for a number of years.

7) The URL's in question carry no contents and therefore can not be connected with Trademark classes 03, 07, 09, 11, 16, 18, 20. Charles Fellowes is registered under class 35 with leaves 37 classes of which the term Fellowes can be registered and the URL' in question can be legitimately used.

8) *If at all the URL's would lean towards Trademark class 35 (retail service connected with sale) for which Fellowes have no claim or control.*

9) *The URL's are not being misused and are not even parked with any contents. No revenue of any kind has even been generated from the URL's and the URL's have never produced any 'commercial gain' of any kind.*

10) *It would appear that the Complainant is just throwing as many issues however weak or irrelevant hoping that collectively they will assist in a ruling in their favour. Where as they have mostly been either disproved or are not even relevant.*

11) *The domain names in question were available for purchase before purchased by the Respondant on 22nd October 2004 and are still available for purchase. If the Complainant feels theses are such important URL's, why did the Complainant not purchase them prior to Respondent, and why wait almost six years before attempting to make their claim for them?*

12) *We the Respondent are more then willing to sell the URL's with no 'commercial gain' but just to cover the costs of holding the URL's along with administration charges accrued from both this Dispute Resolution Case as well as the previous case. Therefore, the URL's were available for purchase by the Complainant, and are still available for purchase today at this present time.*

6. Discussions and Findings

General

Under clause 2 of the DRS Policy (“the Policy”) the Complainant is required to show, on the balance of probabilities, that:

- 6.1 It has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- 6.2 The Domain Name in the hand of the Respondent is an Abusive Registration.

Complainant's Rights

- 6.3 The first question that I must answer is therefore whether the Complainant has proved on the balance of probabilities that it owns Rights in a name or mark that is identical or similar to the Domain Names.
- 6.4 The Policy defines Rights as including but not being limited to “...rights enforceable under English law...”. This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that that must be the correct approach.
- 6.5 The Complainant has a number of registered marks for the word FELLOWES which pre-date the Respondent's registration. Additionally, the Complainant clearly has a substantial business under the mark FELLOWES

and has had for some time. It therefore unquestionably has Rights in the name or mark FELLOWES.

- 6.6 Ignoring the first and second level suffixes as I must do, the name in which the Complainant has Rights, FELLOWES, differs from the Domain Names only in the respect that the Domain Names contain the word “store” or “-store”. I do not think that the addition of a descriptive word such as “store” does much if anything to alter the distinctive character of the mark FELLOWES and it is clear that it is the word or mark FELLOWES which is acting as a trade mark rather than the word “STORE” which is simple providing a description or qualification. I therefore conclude that on the balance of probabilities the Complainant has Rights in word or mark which is similar or identical to the Domain Names.

Abusive Registration

- 6.7 Having concluded that the Complainant has Rights in a name or mark which is similar or identical to the Domain Names, I must consider whether the Domain Names constitute Abusive Registrations. An Abusive Registration is defined in the Policy as a Domain Name which *either*:

- (a) 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
- (b) has been used in a manner which took unfair advantage of, or was unfairly detrimental to the Complainant’s Rights.

- 6.8 This definition allows me to consider whether a domain name constitutes an Abusive Registration at any time and not, for example, just at the time of registration/acquisition.

- 6.9 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may evidence that a domain name is an Abusive Registration. It is worthwhile setting out paragraph 3 of the Policy in full:

“3. Evidence of Abusive Registration

- a. A non-exhaustive list of facts which may be evidence that the Domain Name is an Abusive Registration is as follows:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

- A. 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;

- B. as a blocking registration against a name or mark in which the Complainant has Rights; or

- C. for the purposes of unfairly disrupting the business of the Complainant;
- ii 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 of businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;
- iii The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;
- iv It is independently verified that the Respondent has given false contact details to us; or
- v The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
 - A. has been using the Domain Name registration exclusively; and
 - B. paid for the registration and/or renewal of the Domain Name registration
- b. Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is no in itself evidence that the Domain Name is an Abusive Registration.
- c. There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the Complain was filed. This presumption can be rebutted (see paragraphs 4(a)(iv) and 4(c)).

6.10 Complaints such as this where the domain name is a reasonably well known brand together with an obvious and common place description of where those goods may be sold or one particular type of the brand holders goods have traditionally caused some difficulties for Nominet Experts and have been the subject of a number of Appeal decisions. The most recent of these is the decision in *Toshiba Corporation v. Power Battery Inc. DRS 07991* where the overall position was reviewed as follows,

"The more specific issue of the incorporation by resellers of trade marks into Internet domain names has been considered by expert panels under both the Nominet DRS Policy and the UDRP. The key decisions under the DRS Policy are the decisions of the appeal panels in Seiko UK Ltd –v- Wanderweb DRS 00248 which involved the domain name <seiko-shop.co.uk> and one other and Epson Europe BV –v- Cybercorp Enterprises DRS 03027 which involved the domain name <epson-inkjet-cartridge.co.uk> and 13 others.

In the Seiko case the appeal panel upheld the decision of the expert that the relevant domain names be transferred to the complainant. The panel stated that owing to the many different circumstances in which a reseller might be offering the trade mark owner's goods, no hard and fast rules as to incorporation of the trade mark could be laid down and each case must

be examined on its merits. The panel supported the proposition that the use of a trade mark for a domain name without the consent of the trade mark owner for selling genuine products could make the false representation that there was something official or approved about the website. That could in turn constitute unfair advantage being taken of rights in the mark by the user of the domain name.

The Seiko case was decided in part on the ground that the complainant had produced two letters demonstrating actual confusion in the marketplace (albeit that the force of these was disputed). However the panel also observed in closing that, under section 60 of the UK Trade Marks Act, the rightful owner of a trade mark could oppose an application for registration of that mark by an agent or representative. It took the view that on the evidence in the case “it is just as unfair for Wanderweb to appropriate Seiko’s trade marks as a domain name”.

This final observation of the panel does not appear to flow directly from the argument preceding it and it is assumed in any event that the panel in that case did not intend to suggest that, by virtue of section 60 of the Act, any incorporation of a trade mark into a domain name was automatically unfair.

In the Epson Europe case the appeal panel overturned the decision of the expert that the registration of the domain names in question was not abusive. The Panel notes that that case, like the current case, dealt with the sale of replacement parts/consumables rather than primary purchases. That case concerned 14 similar domain names relating to Epson ink and cartridge products and it appeared that the respondent had also registered names relating to Canon, HP and Lexmark products. All the relevant domain names resolved to a site offering printer consumables and related products, but the majority of the products on the site were products competitive with the goods of the complainant.”

6.11 The Appeal Panel in Toshiba also came up with four principles that should be applied in such “reseller” cases. These were as follows:

1 *It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.*

2 *A registration will be abusive if the effect of the respondent’s use of the domain name is falsely to imply a commercial connection with the complainant.*

3 *Such an implication may be the result of “initial interest confusion” and is not dictated only by the content of the website.*

4 *Whether or not a commercial connection is implied, there may be other reasons why the reseller’s incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent’s website.*

6.12 In this case the Domain Names are not currently being used. Indeed, they do not even resolve to a holding page, but simply point at a blank screen.

However, historically, the Domain Names were pointed towards an online shopping site at the website www.impulse-estore.co.uk. The Respondent says that this was done inadvertently and this link was removed as soon as the position was realised.

- 6.13 The website at www.impulse-estore.co.uk does not currently exist. The Complainant has provided some screen shots of it and based on its name and the screen shots I have seen, it seems a reasonable inference that this site would be selling not only the goods of the Complainant, but also other goods. Indeed it is probably likely that different sections of the website would sell goods from different sources.
- 6.14 There are also the large number of other domain names which the Respondent has. There is, of course, nothing wrong with this in itself and most of them appear to be fairly generic names. Some however, for example brotherlabelprinters.com do appear to specifically refer to the goods of another third party.
- 6.15 I am reluctant to base this Decision on the one “positive or “active” use that the Respondent has made of the Domain Names, i.e. the pointing of the Domain Names to the impulse-estore website, particularly as the Respondent says this was done by mistake. However, taken in the round and on the balance of probabilities, the evidence does all stack up to persuade me that the Domain Names must be Abusive Registrations. Put another way, given the one instance of use, albeit disputed by the Respondent and the large number of other domain names which the Respondent holds, it is difficult to think of a credible non-Abusive Registration type use that the Respondent is likely to make of the Domain Names. Everything points to the fact that the Respondent is most likely to use the Domain Names to draw traffic either to a holding/parking page or to a site which sells a range of goods, perhaps including the Complainant’s goods. It is just that the Respondent has not done that yet.
- 6.16 My preliminary conclusion is therefore that very much on the balance of probabilities the Domain Names are in the hands of the Respondent Abusive Registrations. However, that is not quite the end of the story. Having made that finding the Respondent is entitled to rebut it by, for example, making out one of the non-exhaustive list of factors set out in paragraph 4 of the Policy.
- 6.17 I should say at the outset there is nothing in the Response which even comes close to persuading me against my conclusion that the Domain Names are Abusive Registrations. Much of what the Respondent says in its Response does appear to miss the point somewhat and I will not go through each of the Respondent’s points in detail. I will however make some brief comments on the Respondent’s main arguments below.
- 6.18 Firstly, the Respondent makes a number of points about the classes in which the Complainant has registrations for the mark FELLOWES. It is difficult to see how any of these points have any relevance to my determination under the Nominet DRS. I am concerned here with the tests

set out in Nominet's Policy and not with wider questions of trade mark law such as whether what the Respondent is or is not doing falls within the same classes as the Complainant has registrations for. That may well be the sort of thing that a Court would be interested in. The DRS is a contractual process and the rules are set out very clearly in the Policy. A close analysis of the classes in which the Complainant has registrations in is simply not part of that.

- 6.19 The Respondent also argues that it is an authorised online Fellowes reseller and has the written consent of the Complainant to use its trade mark logo on its internet stores. No evidence of this is produced and the Complainant does not comment on it. However, using the Complainant's logo to identify the Complainant's goods is quite a different thing to using the Complainant's name or mark in a domain name which may then be linked to a site or sites selling the goods of not only the Complainant, but other companies as well.
- 6.20 The Respondent suggests that the Complainant has simply waited too long to take this action. The Domain Names were registered as long ago as 22nd October 2004 and have been available for purchase since that date. I am not entirely sure what point the Respondent seeks to make here. There appears to be no suggestion that the Complainant has positively encouraged the Respondent here and I do not see how a mere delay can defeat the Complainant's case.
- 6.21 I therefore do not think that the Respondent has done anything to rebut my finding that the Domain Names in the hands of the Respondent are Abusive Registrations.

7. Decision

I find that the Complainant has proved, on the balance of probabilities, that it has rights in a name or make which is identical or similar to the Domain Names and that the Domain Names are an Abusive Registration in the hands of the Respondent. I therefore direct that the Domain Names should be transferred to the Complainant.

Signed Nick Phillips

Dated 20 September 10