

DISPUTE RESOLUTION SERVICE

D00009605

Decision of Independent Expert

Hambleton Bard Ltd

and

Youngs

1. The Parties:

Lead Complainant: Hambleton Bard Ltd
Cobnar Wood Close
Chesterfield
S41 9RQ
United Kingdom

Respondent: Youngs
Cross Street
Bradley
Bilston
WV14 8DL
United Kingdom

2. The Domain Names :

hambletonbard.co.uk
belvino.co.uk
smartstill.co.uk
smart-still.co.uk
tooheys.co.uk

3. Procedural History:

21 February 2011 22:25 Dispute received
23 February 2011 08:17 Complaint validated
23 February 2011 08:20 Notification of complaint sent to parties
16 March 2011 11:20 Response received
16 March 2011 11:20 Notification of response sent to parties
17 March 2011 12:11 Reply received
24 March 2011 12:27 Notification of reply sent to parties
24 March 2011 12:28 Mediator appointed
04 April 2011 15:28 Mediation started

11 April 2011 17:32 Mediation failed
11 April 2011 17:32 Close of mediation documents sent
15 April 2011 15:41 Expert decision payment received

4. Factual Background

The Complainant, Hambleton Bard Limited, is a limited company that was incorporated at Companies House on 2 January 1975. It manufactures and sells home brew products. The Respondent, Youngs, is a retailer in home brew products. The Respondent is the registrant of the following domain names:-

Domain Name	Date of registration
hambletonbard.co.uk	28/05/09
belvino.co.uk	21/04/10
smartstill.co.uk	28/10/10
smart-still.co.uk	21/04/10
tooheys.co.uk	21/04/10

which are together referred to in this decision as the Domain Names.

The domain names belvino.co.uk and smart-still.co.uk are directed to the Respondent's web site at www.youngshomebrew.co.uk. The domain names smartstill.co.uk and tooheys.co.uk are directed to parking pages operated by Sedo. The domain name hambletonbard.co.uk cannot be found.

5. Parties' Contentions

5.1 Complainant

The Complaint, so far as is material, is summarised below.

5.1.1 Rights

hambletonbard.co.uk

The Complainant has rights to this name because it was registered as Hambleton Bard Limited at Companies House on 2 January 1975. The Complainant's main web, which was registered on 31 July 2000, is at www.hambletonbard.com. The web site at that domain name has been active since March 2001.

belvino.co.uk

The Complainant created the unregistered mark Belvino in 2002 and has actively traded using that mark since then.

smartstill.co.uk and smart-still.co.uk

The Complainant created the unregistered mark SmartStill in 2002 and has actively traded using that mark since then.

tooheys.co.uk

Tooheys is a brand name belonging to Lion Nathan, a brewery of New Zealand/Australia. The Complainant has been the UK agent for their home brew products since 2006.

The Respondent has been a customer of the Complainant's in the past but there is now only a small amount of trade. The Respondent has bought a small number of Belvino products over the years. The Respondent has never bought any Tooheys or SmartStill products. The relationship between the Complainant and Respondent is now more about being competitors than a supplier-customer relationship.

5.1.2 Abusive Registration

The Respondent has engaged in an ongoing pattern of registering other home brew companies' trade marks and company names as domain names and pointing them to their own web site. Apart from the Domain Names there is also the domain name smart-still.com. The Respondent has abused many others lately including:-

- www.ritchieproducts.com - owned by the Respondent but now re-pointed to Ritchie Products, a wholesaler and the real owner after a complaint.
- www.vintnersreserve.co.uk - a trademark from Canada, the agents in the UK are Ritchie Products Ltd and the Respondent does not sell this product. The web site was owned by the Respondent and was a malicious registration, which was closed after a recent complaint.

Since early 2010 the Respondent has systematically abused other companies' trade marks and company names. These offences are actively continuing, as is borne out by the fact that smartstill.co.uk was registered as recently as 28 October 2010.

The Complainant believes that the Respondent is intentionally misleading customers who may think they are contacting the manufacturer of the Complainant's products. In February 2011 the Respondent sent a mailshot in which they offered to trade one of the Complainant's trade marked products (which they then removed from the market) for their own trade marked system. Customers who surf to what they think is the Complainant's web site (www.hambletonbard.co.uk) and contact "us" via the details there will go to the Respondent's web site and they are then told that there is a shortage of the Complainant's products on the market (alternatively, they are not made anymore etc) and they are offered a competing product. There has indeed been a shortage, the reason for this being that the Respondent has actively removed the Complainant's products from the market.

The Complainant seeks a transfer of the Domain Names.

5.2 Respondent

The Response, so far as is material, is summarised below.

The Domain Names were purchased to protect brands that the Respondent represented. The Respondent is prepared to transfer the Domain Names at the administration cost of £25 per Domain Name. The Respondent was not contacted directly by the Complainant.

5.3 Reply

The Reply, so far as is material, is summarised below.

- The Respondent is one of the Complainant's customers but did not seek, and was not given, authority to register the name Hambleton Bard as a domain name which was re-directed to the Respondent's partially completed web site.
- The Respondent has purchased a small number of Belvino kits from the Complainant but they do not represent this brand in any way other than as one customer out of a total of 300 customers.
- The Respondent has never purchased any SmartStill products nor have they published anything about this brand name.
- The Complainant represents Tooheys in the UK and has never sold any Tooheys products to the Respondent. The Respondent has never sold or, in any way, represented Tooheys.
- The Complainant did contact the Respondent's office by telephone on 30 April 2010 to complain about the registration of hambletonbard.co.uk. The re-direction to the Respondent's web site was temporarily stopped but was later resumed. The Complainant was not at that stage aware of the registrations of the other Domain Names.

6. Discussions and Findings

6.1 General

In order for the Complainant to succeed it must (pursuant to Paragraph 2 of the Policy) prove to the Expert, on the balance of probabilities, both that:

it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

The meaning of 'Rights' is clarified and defined in the Policy in the following terms:

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.

An Abusive Registration is defined in the Policy as follows:

Abusive Registration means a Domain Name which either:

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

has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors which may be evidence of an Abusive Registration is set out in paragraph 3 of the Policy. There is a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration at paragraph 4 of the Policy.

6.2 Rights

The Complainant claims to own unregistered rights in four brand names - Hambleton Bard, Belvino, SmartStill and Tooheys – all of which are used in connection with the promotion and sale of beer and wine making kits. The Respondent has not challenged the Complainant's assertion that it has rights in those brand names but argues that the Complaint should not succeed because the Domain Names were registered in order to protect brands that the Respondent represented.

The Nominet DRS Expert Overview ('the Overview') states as follows:-

[T]he relevant right has to be an enforceable right (i.e. a legally enforceable right). Bare assertions will rarely suffice. The Expert needs to be persuaded on the balance of probabilities that relevant rights exist. The Expert will not expect the same volume of evidence as might be required by a court to establish goodwill or reputation, but the less straightforward the claim, the more evidence the better (within reason – this is not an invitation to throw in the 'kitchen sink').

For the purposes of establishing an enforceable right in an unregistered mark goodwill needs to be contrasted with mere use. Evidence that a mark has been used is not of itself enough to prove goodwill. The Complainant needs to go further by demonstrating that the mark is relied upon to identify the origin of the goods. The Overview supports this proposition by stating that, in the case of an unregistered right, the Complainant will ordinarily need to produce evidence to show that (a) it has used the mark for a not insignificant period and to a not insignificant degree **and** (b) the mark is recognised by the purchasing trade/public as indicating the goods or services of the Complainant.

Hambleton Bard

This issue of rights in relation to Hambleton Bard is straightforward. Hambleton Bard has been the corporate name of the Complainant since 1975. The Complainant has produced advertising and promotional material in support of its claim to have rights in the name Hambleton Bard. The material consists of pages archived in March 2001 from the web site at hambletonbard.com and a Hambleton Bard brochure from 2006. One of the archived web pages produced by the Complainant contains the statement:-

Hambleton Bard is the leading manufacturer of superfast winekits in Europe.

The evidence shows that the Complainant has used the name Hambleton Bard in connection with its home brew business for at least 10 years and through the advertising and promotional activities the mark has become recognised as indicating the goods or services of the Complainant. The Expert is satisfied that the Complainant has enforceable rights in the mark Hambleton Bard which, for these purposes, is identical to the Domain Name hambletonbard.co.uk.

Belvino

The Complainant asserts that it 'created' the unregistered mark Belvino in 2002 and it has used that mark since then as part of its trading activities. The Complainant has produced archived web pages which show that Belvino winemaking kits were promoted via the Complainant's web site at hambletonbard.com from 2002. The following text appears on the Complainant's web site underneath a picture of a Belvino winemaking kit:-

Hambleton Bard is the leading manufacturer of superfast winekits in Europe. We have developed yeasts and nutrients optimized for fast fermentation whilst retaining all the qualities of the fruit. This will produce well balanced wines in one week only.

Belvino winekits in the standard version will include English/Swedish instruction and labelling but can be equipped with instructions and labelling in any language. We always welcome export enquiries.

The Complainant's web site thus makes a clear representation to the purchasing trade/public that the Complainant is responsible for the character and quality of Belvino winekits. The Expert is satisfied on the evidence that the mark Belvino has been used by the Complainant and is recognised by the purchasing trade/public as indicating the goods or services of the Complainant. The Expert therefore finds that the Complainant has enforceable rights in the name Belvino which, for these purposes, is identical to the Domain Name belvino.co.uk.

SmartStill

The Complainant's case in relation to the mark SmartStill is very similar to the case put forward in relation to the mark Belvino. The Complainant asserts that it 'created' the unregistered mark SmartStill in 2006 and it has used the mark ever since. The Complainant has produced pages archived in January 2007 from the web site at www.smartstill.com. The following appears under the section headed 'Where To Buy':-

Where to buy a SmartStill home countertop distiller.

StillSmart home distiller is sold in many countries - here's a list of where to get it.

Are you a retailer already selling SmartStill – and not on the list? Contact us – of course you should be there! And we are very happy if you link back to us!

A number of organisations are listed on the web site as retailers of the SmartStill product. The Complainant is one of 3 businesses listed as a retailer of the SmartStill home distiller in the United Kingdom. The 'Contact Us' link - contained in the text that is reproduced above - leads to a page with an email address of contact@smartstill.com. This evidence suggests that the Complainant is one of a number of 'approved' sources of the SmartStill product.

The Complainant has produced a WHOIS search result for the domain name smartstill.com. This shows that the domain name smartstill.com was registered by the Complainant on 24 July 2006. On the face of it, this suggests that the Complainant's right to use the mark SmartStill went beyond the right to promote and sell SmartStill products and extended to the right to use that mark for the purposes of a domain name registration.

The Complainant has also produced evidence which shows that it has offered the SmartStill product to the public since 2006 through its own advertising and promotional material. There is a full page advertisement for the SmartStill water purifier in the 2006 edition of the Hambleton Bard brochure. The initials 'TM' appear next to the word SmartStill, although it is not suggested by the Complainant that SmartStill is a registered mark. It may be the initials 'TM' were added to give the

impression that there was something official or approved about the Complainant's supply of the SmartStill products.

The evidence that the Complainant is the owner of the goodwill in the mark SmartStill is rather thin but, such as it is, it is consistent with the Complainant's assertion that it owns the goodwill in the name SmartStill.

The Expert finds, on the balance of probabilities, that the Complainant does have enforceable rights in the name SmartStill which, for these purposes, is identical to the Domain Name smartstill.co.uk and similar to the Domain Name smart-still.co.uk.

Tooheys

The Complainant's case on 'rights' in relation to the mark Tooheys is put on the basis that it is the UK agent for the foreign manufacturer of Tooheys home brew products. The Complainant says that the Tooheys mark belongs to Lion Nathan, a brewery of New Zealand/Australia, and that it has been the UK agent for that organisation since 2006.

The Complainant might have enforceable rights in the goodwill granted pursuant to a contract (such as an agency agreement) or because it is held out in the UK as the sole source of the products. However, it is necessary to consider the evidence that has been adduced by the Complainant in order to determine whether the 'rights' requirement has been made out.

The evidence clearly shows that the Complainant has used the mark Tooheys in connection with home brew products since 2006 but, as indicated above, evidence of mere use is not direct evidence of goodwill. The 2006 edition of the Complainant's brochure includes a number of Tooheys products and the following statement:-

Tooheys have now made their recipes available as beer kits and we are proud to represent this commercial quality kit from down under.

In support of its contention to be the UK agent of the third party rights holder, the Complainant has produced a copy invoice from Lion Nathan dated 18 September 2007 but this is of limited evidential value. It shows that the Complainant purchased 4 different types of Tooheys products - it is not evidence that the Complainant is the sole UK agent for Tooheys home brew products.

The issue of who owns the goodwill in a particular mark can be rather unclear when a number of businesses are involved in the supply chain which results in the goods being made available to the purchasing trade or public. To avoid such uncertainty one would normally expect the underlying contractual documentation (be it a licence, distribution agreement, agency agreement or franchise agreement) to contain express provisions about the ownership of the goodwill. The Complainant has not produced a copy of the agency agreement with the third party owner of the goodwill in the Tooheys mark. The invoice that has been produced simply does not address the issue of ownership of the goodwill.

The Overview makes it clear that the Expert needs to be persuaded on the balance of probabilities that relevant rights exist and that bare assertions will rarely suffice. It says that in the case of a licensee evidence of the licence will be sufficient. The Appeal Panel in DRS 00248 (seiko-shop.co.uk) felt that the 'rights' requirement was satisfied by an assertion by the complainant in that case that it was duly authorised

by the trade mark owner to use the mark and to bring the Complaint. The Appeal Panel said that where the Complainant is a subsidiary or associated company of the trade mark proprietor, such an assertion would generally be sufficient.

The evidence in this case (which goes beyond showing use of the mark Tooheys) consists of a statement on the Complainant's web site that it is a representative of the third party rights holder and an invoice for the purchase by the Complainant of a quantity of Tooheys products. There is nothing of any substance from the rights holder itself from which any inferences can be drawn about ownership of the goodwill. The Overview says that if the right is contractual the Expert will need to see evidence of the contract. The agency agreement has not been produced and it is not asserted by the Complainant that it was duly authorised by the owner of the goodwill to use the mark for the purposes of bringing a Complaint under the DRS.

It may be that the registration and use of the name Tooheys by the Respondent is abusive but that is a matter to be taken up by the owner of the goodwill or an authorised third party. The Complainant has failed to produce sufficient evidence of its right to take up that fight.

The Expert is not satisfied on the evidence that the Complainant has shown that it has enforceable rights in the mark Tooheys. Therefore, the Complaint in relation to the Domain Name tooheys.co.uk falls at the first hurdle and must be dismissed.

6.3 Abusive Registration

In light of the above findings, the Expert is concerned with establishing whether the registration and/or use by the Respondent of the domain names hambletonbard.co.uk, belvino.co.uk, smartstill.co.uk and smart-still.co.uk is abusive. The two primary complaints are made under paragraphs 3(a)(ii) and 3(a)(iii) of the Policy.

Paragraph 3(a)(ii)

This paragraph reads as follows:-

Circumstances indicating that the Respondent is using 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.

For these purposes, the "confusion" is confusion as to the identity of the person/entity behind the domain name. In effect, the Complainant's case is that an Internet user is likely to believe that the Domain Name belongs to, or is in some way connected with, the Complainant. The Overview discusses 'initial interest confusion' and phrases the issue by asking the following question:-

Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant?

If the answer to that question is yes then the Internet user will have been drawn to the web site by use of the mark of the Complainant and that is not a "legitimate" use of the mark.

The Appeal Panel in DRS 07991 (toshiba-laptop-battery.co.uk) considered the concept of 'initial interest confusion' and summarised the principles that apply in the following terms:-

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 contents 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.*

Whilst it is not automatically unfair for a reseller to incorporate a trade mark into a domain name it is relatively straightforward if the domain name is identical to the mark (i.e. without any adornment) and it cannot sensibly refer to anyone other than the Complainant. The Respondent has registered the brand names Hambleton Bard, Belvino and SmartStill as domain names without any adornment and that falsely implies a commercial connection to the Complainant. The addition of a hyphen in the case of smart-still.co.uk makes no material difference.

The Respondent's case is that it registered the Domain Names to protect the brands that it represented. However, the Respondent made no attempt to attach a non-descriptive term to the Complainant's marks in order to indicate that it was simply a retailer of the Complainant's goods thereby avoiding the risk of 'initial interest confusion'. For example, if the Respondent had registered 'we-stock-belvino-products.co.uk' then the likelihood of any 'initial interest confusion' would have been significantly reduced.

The most plausible motivation for the registration of the Complainant's marks as domain names was to exploit the 'initial interest confusion' and thereby attract customers or potential customers of the Complainant for the Respondent's own commercial benefit. The fact that the domain names belvino.co.uk and smart-still.co.uk are currently directed to the Respondent's web site puts this beyond doubt. As the Overview points out, it does not matter that immediately upon arriving at the web site the Internet user becomes aware there is no connection to the Complainant as the user will still have been deceived.

The Expert finds that the registration of the Domain Names hambletonbard.co.uk, belvino.co.uk, smartstill.co.uk and smart-still.co.uk is an Abusive Registration.

Paragraph 3(a)(iii)

This reads as follows:-

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.

The Overview provides some useful guidance on this paragraph as follows:-

The purpose behind this paragraph is to simplify matters for a Complainant, where the only available evidence against the registrant is that he is a habitual registrant of domain names featuring the names or marks of others. However, there is a divergence of view among Experts as to what constitutes a pattern for this purpose.

One view, as expressed by the Appeal Panel in DRS 04884 (maestro.co.uk), is that the mere fact that a registrant has some objectionable domain names in his portfolio cannot of itself be enough to render the domain name in issue an Abusive Registration. To get the benefit of this provision, the Complainant must show that the domain name in issue is part of a conscious policy on the part of the registrant. There must be evidence to justify the linking of the domain name in issue to the other objectionable domain names. The link may be found in the names themselves and/or in the dates of registration, for example.

The contrary view is that the pattern does not need to result from any conscious policy on the part of the Respondent. If the domain name in issue is a well-known name or mark of the Complainant and the Respondent is the proprietor of other domain names featuring the well-known names or marks of others, the pattern is likely to be established, even if there is no obvious link between the names or the manner or their dates of registration.

In practice this difference of view is unlikely to have much of an impact. If the domain name in issue is a well-known trade mark of the Complainant and there is no obvious justification for the Respondent being in possession of the domain name, it is probable that the Complaint will succeed on other grounds.

The Respondent's own case is that it registered the Domain Names in order to protect brands that it represented. The Complainant relies upon the following domain names which were also registered by the Respondent in support of its complaint under paragraph 3(a)(iii):-

Domain Name	Registrant	Date of registration
smart-still.com	Youngs	21/04/10
ritchieproducts.com	Youngs	28/05/09
vintersreserve.co.uk	Youngs	29/03/10

According to the web site at www.ritchieproducts.co.uk - which is referred to in the Complaint – Ritchie Products is 'one of the UK's leading home brew wholesalers' and one of its lines is 'Vintners Reserve'. The Respondent has registered domain names that comprise the brand names Ritchie Products and Vintners Reserve without any adornment which is consistent with its conduct in relation to the Domain Names. The Respondent has no apparent rights in the domain names listed above.

The evidence clearly shows that the Respondent operated a conscious policy of registering domain names which correspond to well known brand names in the home brew market in which the Respondent has no apparent rights and that the Domain Names are part of that pattern. Accordingly, the complaint under paragraph 3(a)(iii) has been made out which supports the finding of Abusive Registration.

Other grounds of complaint

The Complainant says that the Respondent has been actively removing the Complainant's products from the market but the Expert makes no finding on this point as it is not necessary to do so for the purposes of determining this dispute.

7. Decision

hambeltonbard.co.uk

The Expert finds, on the balance of probabilities, that the Complainant has rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that the Domain Name hambeltonbard.co.uk be transferred to the Complainant.

belvino.co.uk

The Expert finds, on the balance of probabilities, that the Complainant has rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that the Domain Name belvino.co.uk be transferred to the Complainant.

smartstill.co.uk

The Expert finds, on the balance of probabilities, that the Complainant has rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that the Domain Name smartstill.co.uk be transferred to the Complainant.

smart-still.co.uk

The Expert finds, on the balance of probabilities, that the Complainant has rights in a mark which is similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that the Domain Name smart-still.co.uk be transferred to the Complainant.

tooheys.co.uk

The Expert is not satisfied that the Complainant has rights in a mark which is identical or similar to the Domain Name. The Expert directs that no action be taken with regard to the Domain Name tooheys.co.uk.

Signed Andrew Clinton

Dated 19 May 2011