

## DISPUTE RESOLUTION SERVICE

D00011532

Decision of Independent Expert

EL CORTE INGLES, S.A.

and

Manuel Sanchez

### 1. The Parties:

Lead Complainant: EL CORTE INGLES, S.A.  
Hermosilla, 112. 28009 Madrid  
Madrid  
28009  
Spain

Respondent: Manuel Sanchez  
Sevilla  
Sevilla  
Sevilla  
41 111  
Spain

### 2. The Domain Name:

<elcorteingles.co.uk>

### 3. Procedural History:

27 June 2012	Dispute received
28 June 2012	Complaint validated
28 June 2012	Notification of complaint sent to parties
17 July 2012	Response reminder sent
20 July 2012	No response received
20 July 2012	Notification of 'no response' sent to parties
26 July 2012	Expert decision payment received

## 4. Factual Background

The Complainant is one of Spain's largest businesses. It is a leading retail group with outlets all over the world. It has network of more than 1,317 stores in varying formats and brands: department stores, hypermarkets, supermarkets, fashion shops (Sphera), convenience stores, DIY stores and phone shops. It also has a travel agency business (Viajes El Corte Inglés) and provides insurance services. The Complainant's subsidiaries Sphera and Viajes El Corte Inglés operate in many European and American countries. The Complainant has a turnover of €16.4 billion and employs more than 102,700 people. Given the importance of E-commerce, domain names are very important to the Complainant's business.

The Complainant has two subsidiaries in the UK (EL CORTE INGLES (LONDON) LIMITED and INFORMATICA EL CORTE INGLES (UK) LTD, and has owned the domain name ELCORTEINGLESLONDON.CO.UK since 2005.

The Complainant owns a large worldwide trade mark portfolio including UK and Community registered trade marks many containing the words EL CORTE INGLES including:

- United Kingdom registered trade mark No. 1494731 for EL CORTE INGLES with a filing date of 18th March 1992;
- United Kingdom registered trade mark No. 1494566 for VIAJES EL CORTE INGLES with a filing date of 18th March 1992;
- United Kingdom registered trade mark No. 1029162 for HISPACOR EL CORTE INGLES, S.A. with a filing date of 8th May 1974;
- Community Trademark No. 448415 for EL CORTE INGLES with a filing date of 3rd May 1997; and
- Community Trademark No. 2472389 for EL CORTE INGLÉS BOOMERANG with a filing date of 21st November 2001.

The Respondent appears to be a Spanish individual who registered the Domain Name on 12 January 2012. Little is known about the Respondent, including his address, which appears in the results of a WHOIS query as simply 'Sevilla, Sevilla, Sevilla, 41 111, Spain'. The Respondent has not participated in these proceedings.

Although the Respondent has taken no part in these proceedings, the Expert is satisfied that Nominet has sent the Complaint (and other communications) to the Respondent in accordance with the Procedure.

## 5. Parties' Contentions

*The Complainant*

In its Complaint the Complainant advances the following contentions:

The Complainant has been the owner of exclusive trade mark rights in the words EL CORTE INGLÉS for some considerable time before the Domain Name was registered.

The Complainant submits that the Complainant is a Spanish individual who presumably has full knowledge of the Complainant, and its activities and fame in Spain and is taking unfair advantage of the Domain Name by obtaining illicit revenues through a pay-per-click site. The Respondent's behavior is adversely affecting both consumers and the Complainant who cannot use the Domain Name for its legitimate businesses in the United Kingdom.

The Respondent does not have any rights to the Domain Name. In an effort to demonstrate that the Respondent does not have any registered trade mark rights enforceable in the UK relating to the expression EL CORTE INGLES, the Complainant conducted various online searches of trade mark registers:

a search on IPO.GOV.UK (the online service of the UK Intellectual Property Office) showed only one MANUEL SANCHEZ (Manuel Sánchez Soriano). However the address for this individual is in Barcelona, not Seville. Importantly, this Manuel Sanchez is the owner of UK trade mark, SORISA which has no connection with the Domain Name

moreover, searches on OAMI.EU (the online service of the Office for Harmonization of the Internal Market, OHIM) and WIPO.INT (the online service of the World Intellectual Property Organization) showed several individuals bearing the name MANUEL SANCHEZ holding various trade marks, but again none with any connection to the Domain Name.

Neither the name of the Respondent nor any of the contact details revealed on a WHOIS search suggest any right or legitimate interest in the Domain Name.

Furthermore, the phrase EL CORTE INGLES has no meaning in the English language so the Respondent could not claim any fair use for descriptive purposes in the UK.

The Domain Name includes the Complainant's registered trade mark EL CORTE INGLES in its entirety. The Complainant contends that this could not have been a mere coincidence. It is likely that the Respondent (given his apparent nationality) had in mind the Complainant and its trade marks when he chose the Domain Name. This is particularly so given that the Complainant is a well-known Spanish company with outlets throughout Spain, including Seville where the Respondent apparently resides.

As to the residence of the Respondent, the Complainant says that it is clear that the address given is not accurate in that some elements of a valid

Spanish address (street, number, identification of apartment/flat/establishment) are missing. This itself is a ground for holding that the Domain Name has been registered abusively. Also, the Respondent does not clarify the category of registrant within which he falls (e.g. individual, company, etc.). A presumption of unlawful behavior exists since the holder cannot be easily reached.

The Complainant further contends that registration of the Domain Name is abusive because the Respondent is presumably obtaining illegal revenues from pay-per-click ads having “parked” the Domain Name at SEDO, without any prior authorisation. (The Sedo Policy for UK customers encourage domain name owners to “*check that your domain is not infringing anyone's trademark rights*”). The links shown on the PPC webpage advertise different products which lead to sites in direct competition with the Complainant causing detriment to the Complainant in terms of sales and goodwill, and the misleading of consumers who may believe that the Complainant endorses these advertisements.

Use of a trade mark in a domain name communicates that the domain name is connected to the trade mark owner and is thus likely to confuse irrespective of website content.

Given the Complainant is not able to guarantee the quality and characteristics of the goods available through the website to which the Domain Name points, it contends that there is a very high risk of tarnishment of its trade mark.

The Complainant submits that the Respondent was clearly aware of the Complainant's rights at the time he registered the Domain Name and “parked” it at SEDO, which he did for the purpose of taking unfair advantage of the Complainant's reputation and to obtain illicit earnings, first through pay-per-click and secondly by selling the Domain Name to the Complainant or a third party for a higher amount than the reasonable costs of registration.

### *The Respondent*

The Respondent did not participate in these proceedings and there is therefore no summary of his contentions.

## **6. Discussions and Findings**

Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the Domain Name in issue and that the Domain Name in the hands of the Respondent is an Abusive Registration. Both elements are required.

The fact that the Respondent has not submitted a Response does not mean that the Complaint succeeds by default. The significance of the failure to submit a Response is dictated by paragraph 15.c of the Procedure, which

provides that the Expert will (in the absence of exceptional circumstances) draw such inferences as he or she considers appropriate.

### Complainant's 'Rights'

The meaning of 'Rights' is defined in the Policy as follows: *'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'*.

The Complainant owns several trade mark registrations for, or incorporating, the name EL CORTE INGLES and has made extensive use of such marks. Accordingly, the Expert concludes that the Complainant enjoys Rights in the name EL CORTE INGLES

The Domain Name encapsulates the Complainant's mark EL CORTE INGLES in its entirety and, apart from the suffix '.co.uk', is its only element. The Complainant's mark EL CORTE INGLES is identical to the Domain Name. Accordingly, the Expert is satisfied that the Complainant has Rights in a name or mark that is identical to the Domain Name.

The Expert must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

### Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'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 which *'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights;'*

The considerations which indicate that a domain name constitutes an Abusive Registration are contained in paragraph 3(a) of the Policy. That paragraph contains a non-exhaustive list of factors, including circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which a Complainant has rights, or for the purpose of unfairly disrupting the business of a Complainant.

Other factors suggesting an Abusive Registration include the Respondent 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.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This paragraph lists considerations which would indicate that a

domain name does not constitute an Abusive Registration and is mentioned further below.

The Domain Name is identical to the Complainant's mark EL CORTE INGLES. The Expert concludes that there is a clear likelihood that internet users could be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

Given the nature of the website to which the Domain Name resolves, i.e. a parking page displaying links relating to competitors or competitor products of the Complainant, it might be said that any such initial confusion may dissipate as soon as an internet user arrives at the Respondent's website. However this is no answer to an allegation of Abusive Registration based on confusion. Such initial confusion, or 'initial interest confusion' as it has come to be known, has been held to provide a basis for a finding of Abusive Registration. The recent DRS appeal decision in *Emirates v Michael Toth* (DRS 8634) provides a very useful account of the current position on initial interest confusion. In that decision the Appeal Panel dealt with the issue in this way:

*'Initial interest confusion*

*As the panellist found in the complaint regarding <emirates.eu>, the Respondent's business model depends on attracting Internet users to his website who then generate revenue by click-throughs. Visitors drawn to the site following an Internet search are far more likely to have been looking for the Complainant's website than a general resource on the United Arab Emirates, and are likely to have assumed that the site they were visiting was associated with or authorised by the Complainant. Similarly those accessing the Website directly are very likely to have been users guessing (incorrectly) at the URL of the Complainant's UK website.*

*As paragraph 3.3 of the Nominet DRS Expert Overview (the "Overview") records, "the overwhelming majority of Experts" view "initial interest confusion" as a possible basis for a finding of Abusive Registration,*

*"...the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived."*

In the present case, it is likely that a visitor to the Respondent's website who arrives there by typing <elcorteingles.co.uk> would have been looking for the website of the Complainant, rather than one which displays a variety of links to products and services of others.

In all the circumstances, the Expert is satisfied 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.

Given this finding, it is unnecessary to go on to consider whether there is any alternative basis upon which the Complainant could found an allegation of Abusive Registration.

Whilst it is for the Respondent to advance an answer to the Complaint, which he has not done, the Expert is of the view that in the circumstances of these proceedings, in the hands of the Respondent, it is difficult to conceive of a use of the Domain Name that would not amount to an Abusive Registration. For instance, a cursory review of the albeit non-exhaustive, but nevertheless best guide as to what would not be regarded as an Abusive Registration contained in paragraph 4 of the Policy, would not appear to assist the Respondent in any way.

For instance, paragraph 4.a.i provides (as examples of what may indicate that a domain name is not an Abusive Registration) that:

*'Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:*

- A. 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;*
- B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
- C. made legitimate non-commercial or fair use of the Domain Name;*

The Respondent registered the Domain Name on 12 January 2012. He appears to be a Spanish resident. The Complainant is a very well known Spanish company with a huge presence in the country. It seems inconceivable that the Respondent would not have known of the Complainant or that his registration of the Domain Name would not likely give rise to complaint. In any event, it would be difficult to accept, given the nature of the use made of the Domain Name, (in particular, to attract internet users to a website containing links to competitors or competing products of the Complainant in circumstances where, at least initially, there is a likelihood of confusion), that the Respondent's use was, for instance, fair or in respect of a genuine offering of goods or services.

In all the circumstances, the Expert is of the view that, on the balance of probabilities, the Domain Name in the hands of the Respondent is an Abusive Registration.

## **7. Decision**

The Expert finds that the Complainant has rights in a name or mark that is identical to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration.

Accordingly, the Expert directs that the Domain Name, <elcorteingles.co.uk> be transferred to the Complainant.

**Signed Jon Lang**

**Dated 17 August 2012**