

DISPUTE RESOLUTION SERVICE

D00012174

Decision of Appeal Panel

Pierre Balmain SA

and

Balmain & Balmain

1. The Parties:

Complainant: Pierre Balmain SA
44, Rue François-1er
Paris
F-75008
France

Respondent: Balmain & Balmain
Waterloo Farm
Charlton Horethorne
Sherborne
Dorset
DT9 4NG
United Kingdom

2. The Domain Name:

<balmain.co.uk>

3. Procedural History

First Instance

The Complaint was received by Nominet on 20 November, 2012 and notified to the Respondent. The Response was received and notified to the Complainant on 10 December, 2012. The Reply was received by Nominet on 14 December, 2012 and notified to the Respondent on 18 December, 2012. Mediation ensued, but failed to result in settlement of the dispute. The Complainant having paid the appropriate fee, on 22 April, 2013 the Expert was appointed to provide a full decision. The decision was issued by the Expert on 3 May, 2013 and sent to the parties by Nominet on 10 May, 2013. The Expert found in favour of the Respondent and directed that no action be taken in respect of the Domain Name.

Complainant's Appeal

On 17 May, 2013 the Complainant notified Nominet of its intention to appeal and paid the requisite 10% deposit. Nominet received the Complainant's Appeal Notice on 22 May, 2013. The Respondent's Appeal Response was received by Nominet and notified to the Complainant on 6 June, 2013.

On 12 June, 2013 Tony Willoughby, Ian Lowe and Anna Carboni (the undersigned, "the Panel") were appointed to the Appeal Panel, each having individually confirmed to the Nominet Dispute Resolution Service 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."

On 14 June, 2013, the Complainant filed a non-standard submission under paragraph 13b of the Procedure that the Panel agreed to consider. The Panel has not felt it necessary to seek any submission in response from the Respondent.

This is an Appeal against a Decision at first instance in favour of the Respondent. The Panel was appointed to provide a decision on or before 24 July, 2013. This process is governed by version 3 of the *Procedure for the conduct of proceedings under the Dispute Resolution Service* ("the Procedure") and the Decision is made in accordance with version 3 of the *Dispute Resolution Service Policy* ("the Policy"). Both of these documents are available for inspection on the Nominet website (<http://www.nominet.org.uk/disputes/drs>).

4. The Nature of This Appeal

The Policy §10a provides that: *"the appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters"*.

The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits.

In addition to the decision under appeal, the Panel has read the Complaint (with annexes), the Response, the Reply, the Appeal Notice, the Appeal Response and the Complainant's non-standard submission of 14 June, 2013.

5. Formal and Procedural Issues

There are no outstanding procedural issues before the Panel.

6. The Facts

The facts are fully and accurately set out in the Expert's decision under appeal. The Appeal documentation comprising the Appeal Notice (described by the Complainant as a "Memoire for Appeal"), the Appeal Response and the Complainant's further submission filed in response to the Appeal Response add nothing to the known facts.

The Complainant is the proprietor of the BALMAIN fashion brand founded by Pierre Balmain in 1945. The Complainant is the proprietor of various trade mark registrations featuring the name "Balmain". The Complainant's first registration of BALMAIN (word) is a French registration filed on 21 December, 1979 covering *inter alia* furniture and textiles. The first registration of BALMAIN enforceable in the UK is a figurative representation of the name, "BALMAIN", registered at OHIM under CTM registration number 1262039, filed on July 30, 1999¹. The specification of goods covers *inter alia* textiles but not furniture.

The Complainant does not manufacture furniture. It made this clear to the Respondent in a letter from its Counsel to the Respondent dated 10 April, 2012.

The Complainant is the proprietor of a very large number (in excess of 200) domain names featuring the name, "Balmain". Its main website is connected to its domain name, <balmain.com>, which it registered on 17 March, 1997.

The Respondent is a partnership of Andrew and Sarah Balmain. It is a family furniture manufacturing business in Dorset, which was founded in 1987. It trades under the business name, Balmain & Balmain.

The Respondent registered the Domain Name on 20 July 1998. The Respondent's trading website is connected to their domain name, <balmainandbalmain.com>, to which the Domain Name resolves. The Respondent registered the domain name, <balmainandbalmain.com>, on 20 February, 2001.

¹ There is an earlier CTM dated 8 October, 1997, but it is a figurative mark featuring the name "Pierre Balmain" and a logo device and it does not cover furniture.

7. The Parties' Contentions

Subject to two issues arising from the Appeal documentation the parties' contentions are fully set out in the Expert's decision under appeal and the Panel does not propose to repeat them here.

First, the appeal documentation has given rise to confusion over the dates of registration of the Respondent's domain names. The Complainant's Memoire for Appeal indicates that the Domain Name was registered after the Respondent's <balmainandbalmain.com> domain name, which is not so, and the Appeal Response states that the two domain names were registered simultaneously, which is also incorrect. On the evidence before the Panel, the Panel is satisfied (and agrees with the Expert) that the Domain Name and <balmainandbalmain.com> were registered on the dates set out in Section 6 above.

In its supplemental filing in response to the Respondent's Appeal Response the Complainant accepts that the Domain Name was registered before the <balmainandbalmain.com> domain name and contends that this is indicative of the Respondent's abusive intent. The Complainant asserts that the Respondent will have been aware of the Complainant when registering the Domain Name and will also have been aware of the Complainant's domain name, <balmain.com>. In the Complainant's submission, the Respondent's subsequent registration of <balmainandbalmain.com> is indicative of the fact that the Respondent realised that the Domain Name was vulnerable to attack and that it needed to have a back-up.

Secondly, the Complainant objects to the Expert's acceptance of the Respondent's assertions as to the Respondent's trading history "on the balance of probabilities" and in the absence of any evidence. It points out that, unlike the Respondent, it filed full evidence giving trading figures and the like.

In summary, the Complainant's case is that, while the Complainant acknowledges the right of the Respondent to use its trading name, "Balmain & Balmain", for the domain name, <balmainandbalmain.com>, it does not accept that the Respondent has any right to the name, "Balmain" on its own). The Complainant contends that "Balmain" means the Complainant and nobody else and that in using the Domain Name for trading purposes, the Respondent is knowingly riding on the back of the Complainant's reputation and goodwill.

The Complainant contends that confusion is inevitable and refers in support of its contention to a passage from the Expert's decision reading:

"It is however the case that the Domain Name corresponds to the Complainant's trade mark, in an unadorned form, save for the second-level domain".co.uk". In the light of this, I accept that there are likely to be internet users who will go to the website at www.balmain.co.uk in the expectation of finding the Complainant's UK website, and that those visitors will then be redirected to the Respondent's site at www.balmainandbalmain.com. The question is whether this "initial interest confusion" renders the Domain Name an Abusive Registration in the hands of the Respondent".

The Respondent denies the Complainant's allegations, contends that the Respondent's use of the Domain Name is a legitimate use of the surname of the partners and that nothing sinister or indicative of abuse lies in the fact that the Domain Name resolves to the Respondent's trading website at www.balmainandbalmain.com. The Respondent further observes that its first trade use of the name, "Balmain", in relation to furniture pre-dates any rights of the Complainant in relation to furniture enforceable in the UK.

The Respondent rejects the Complainant's claim to all domain names featuring the name, "Balmain", and observes that the Complainant could not sensibly stop other members of the Balmain family using the Domain Name for other purposes should they wish to do so. For example, the Complainant could not stop the Respondent's representative, Charles Balmain, from using the Domain Name for a law firm if he wished to do so. The Complainant would not object to a use of that kind, but is very concerned at the Respondent's apparent intent to use the Domain Name for whatever commercial purpose suits the Respondent or other members of the Balmain family.

8. Discussion and Findings

On reading the papers which were before the Expert, namely the Complaint, the Response and the Reply, the Panel would have come to precisely the same conclusion as the Expert for precisely the same reasons as are set out in the Expert's decision.

As indicated above, the Appeal documentation has produced no new facts and very little new argument.

The Complainant's arguments are the same on appeal as they were before the Expert, as listed below.

- (a) The Complainant's brand is very well-known and was well-known in the UK in 1998 when the Respondent registered the Domain Name.
- (b) The Complainant has trade mark rights, which the Respondent is infringing. The Respondent has rights to the name "Balmain & Balmain", the name under which Respondent trades, but not in the name, "Balmain", which means the Complainant and nobody else.
- (c) There is something sinister in the fact that if one enters the Domain Name into the browser, one finds oneself at the Respondent's active website connected to its other domain name, <balmainandbalmain.com>.
- (d) The Respondent's use of the Domain Name has led (or is likely to lead) to confusion of Internet users. The Respondent is knowingly diverting Internet users to its trading website.
- (e) The Respondent has acknowledged that in future the Respondent and/or other members of the Balmain family may feel free to use the Domain Name for other purposes.

The Panel is unable to fault the reasoning of the Expert who dealt with these issues very clearly. His decision of 3 May, 2013 is to be found on the Nominet website.

The first of the new allegations raised on appeal by the Complainant is that the timing of the Respondent's registration of its <balmainandbalmain.com> domain name, some three years after its registration of the Domain Name is indicative of abusive intent on the part of the Respondent. The allegation appears to be that at some stage the Respondent realized that it was infringing the Complainant's trade mark rights and/or that in some other way the Domain Name was vulnerable to attack and decided to register the later domain name to ensure that it had a back-up. At any rate that is how the Panel interprets the allegation, which was expressed in the Reply to the Appeal Response in the following terms:

“According to the supporting evidence provided for by the Appellant with its complaint ... domain name “balmain.co.uk” was registered July 20th, 1998 and “balmainandbalmain.com” February 20, 2001. The latter being registered later precisely shows the abuse in the registration of the disputed domain name by the Respondent

..... by having registered for no valid reason both the disputed domain name and “balmainandbalmain.com”, it appears that the Respondent has not acted in good faith towards the Appellant. It is clear that it was, from the beginning, aware of the Appellant's legitimate rights over the disputed domain name, which the latter has tried in the past years to take over through fair commercial practices.”

The allegation is speculative in the extreme and the Panel sees no merit in it.

The second issue raised by the Complainant on appeal is the Expert's acceptance “on the balance of probabilities” that the Respondent has operated a furniture business under the name, “Balmain & Balmain”, since about 1987, and that it registered and has used the Domain Name in connection with that business since the date of registration of the Domain Name in 1998. The Expert dealt with the matter as follows:

“While the Respondent has not provided evidence of the history and extent of its business activities, its submissions in this regard are not seriously disputed by the Complainant and the existence of the business is evident from the website to which the Domain Name resolves.”

The Panel has also visited the Respondent's website, which seems to be everything that it purports to be (a traditional furniture business founded in 1987) and it is noteworthy that in the Complaint the Complainant makes no reference to any possibility that the business might be a sham or be less long-lived than claimed. While it is perhaps surprising that the Respondent did not provide some supporting evidence beyond the content of the website, which was first introduced by the Complainant, it is for the Complainant to prove its case and if the Complainant had had any serious doubts as to the veracity of the Respondent's assertions in the Response, there are some very simple enquiries that the Complainant could have taken to establish the point.

The Panel is satisfied that the Expert came to a reasonable conclusion on this point, too.

As a final point, the Panel notes that little has been said in the documents as to the Respondent's awareness of the Complainant's BALMAIN fashion brand. The Complainant clearly assumes that the Respondent had heard of it by the time of registering the Domain Name, whereas the Respondent makes no comment on this issue and the Expert did not deal with it in the Decision. Although many cases turn on the ability of the Complainant to show that the Respondent was aware of the Complainant's relevant brand name when it registered a disputed domain name, that is not the case here. The point that the Complainant misses in its submissions is that the Respondent had a legitimate reason to register and use the name BALMAIN in a domain name, based on it being the primary name used in its business (albeit in the form BALMAIN & BALMAIN) and the shared surname of its two partners. That reason would be no less legitimate if the Respondent had been aware of the Complainant's BALMAIN business and brand than if it had not.

In the result the Panel sees no reason to disturb the decision of the Expert and the Appeal fails.

9. Decision

Appeal dismissed. Expert's decision upheld. No action.

Tony Willoughby

Ian Lowe

Anna Carboni

Date: 8 July 2013