

DISPUTE RESOLUTION SERVICE

D00016102

Decision of Independent Expert

Conair Group Limited

and

Ian Stanway

1. The Parties:

Complainant: Conair Group Limited
Prospect Court
3 Waterfront Business Park
Fleet
Hampshire
GU51 3TW
United Kingdom

Respondent: Ian Stanway
50 Stonebank Road
Kidsgrove
Stoke-on-Trent
Staffordshire
ST7 4HQ
United Kingdom

2. The Domain Name(s):

absolutelybabyliss.co.uk

3. Procedural History:

I can confirm that I am independent of each of the Parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the Parties.

17 June 2015, the Dispute was received.

17 June 2015, the Complaint was validated.

17 June 2015, the notification of the Complaint was sent to the Parties.

06 July 2015, the Response reminder was sent.

08 July 2015, the Response was received.

08 July 2015, the notification of the Response was sent to the Parties.

13 July 2015, the Reply reminder was sent.

14 July 2015, the Reply was received.

14 July 2015, the notification of the Reply was sent to the Parties.

14 July 2015, the Mediator was appointed.

17 July 2015, Mediation was started.

11 August 2015, Mediation failed.

11 August 2015, the close of Mediation documents were sent.

21 August 2015, the Complainant full fee reminder was sent.

21 August 2015, the Expert decision payment was received.

4. Factual Background

- 4.1 The Complainant is a limited company (Company No. 1134488), incorporated in England & Wales and has a holding company named, CONAIR CORPORATION (Company number 06902-7901), which is registered in the U.S. (the 'Holding Company').

[The Complainant, in its response, referred to CONAIR as being a reference to both the Complainant and its Holding Company.]

- 4.2 The Complainant changed its name on 24 April 1998 from "BABYLISS (UK) LIMITED" to "THE CONAIR GROUP LIMITED".
- 4.3 Babyliiss S.A. (France), a subsidiary of CONAIR CORPORATION, has the UK registered trade mark for "BABYLISS" (UK00001095887), registered on 20 May 1978 and a Community Mark for the monochrome rendering of the same (EU 003837201) (the 'Mark').
- 4.4 The Domain Name was registered on 8 March 2009.

5. Parties' Contentions

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

- 5.1 In summary, the Complainant submitted that the Domain Name should be transferred to it for the reasons below.

The Complainant's Rights

- The Complainant submitted that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- The Complainant stated that it *"is a licensee and/or is authorised to use and protect the trade mark registrations"* and is a *"well-known manufacturer and seller in the UK that trades under the famous and recognised BABYLISS name."*
- The Complainant explained that *"CONAIR is the owner of substantial goodwill and reputation in the United Kingdom and Globally for the manufacturing and selling of the household brands "BaByliss" [and others]"* and referenced the website at www.babyliss.co.uk under which the Complainant sells its goods.
- The Complainant submitted that the sale of BABYLISS products *"is very valuable to CONAIR with UK sales of approximately £80 million per year."*
- The Complainant noted that the registration of the Mark pre-dated the registration of the Domain Name.

Abusive Registration

- The Complainant submitted that the Domain Name, in the hands of the Respondent, is an Abusive Registration as the Domain Name has been used and/or was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- The Complainant stated that *"www.absolutelybabyliss.co.uk"* has not been authorised by CONAIR.
- The Complainant stated that, while the Domain Name is registered to the Respondent, its *"ownership"* has been claimed by a *"Mr. Tony Evans."* The Complainant explained that it was its understanding that the website attached to the Domain Name (the 'Website') *"is used for design purpose"* but there is no confirmation on what will

happen to the Website after the design purpose has been completed.

- The Complainant submitted that consumers are likely to be confused into believing the Domain Name is registered to, operated or authorised by, or otherwise connected with CONAIR. The Complainant submitted that "*most people*" navigating to the Website will be expecting to reach a Complainant's website and that those consumers who are looking for an online BABYLISS store may believe that the Website is operated or authorised by the Complainant.
- The Complainant stated that it was also "*concerned that the [D]omain [N]ame may be used in conjunction with the unauthorised marketing, distribution or sale of goods under the BABYLISS trade mark*" and that a third party could use the Domain Name to sell counterfeit BABYLISS products which could present a serious safety hazard with possible bodily injury or damage.
- The Complainant stated that any damage or injury created by counterfeit products could have detrimental damage to its business and the BABYLISS brand, which could have a knock-on effect and damage its business partners; this brand 'damage' could result in lost revenue for them, further resulting in possible losses and labour reduction.
- The Complainant stated that, while "*no sponsored listings are visible as at the date of submission of*" the Complaint, it is concerned that the Domain Name could be used to take advantage of the Mark and related rights by generating advertising revenue, even if no further web site is hosted at it.

Respondent's Response

5.2 In summary, the Respondent submitted that the Domain Name should not be transferred to the Complainant for the reasons set out below.

The Complainant's Rights

- The Respondent noted that "*Absolutely BaByliss*" is a small independent company owned by his client, Mr. Tony Evans, which had been trading "*successfully online*" since 2004 through the domain name "*absolutelybabyliss.com*."
- The Respondent stated that Absolutely BaByliss sells genuine hair and beauty products from BaByliss and other unrelated brands such as Parlux and Wahl.
- The Respondent explained that, in 2009 the website linked to *absolutelybabyliss.com* was re-designed, at which time the Domain Name was registered by him on behalf of and in agreement with Mr.

Evans. In this regard, the Respondent has proposed that the Domain Name is transferred to Mr. Evans rather than the Complainant.

- The Respondent stated that "[w]e" registered the Domain Name to use as a test platform for the new e-commerce system that was being implemented, in order to minimise disruption to the website hosted on the .com domain and to prevent 'domain name hijacking' of the kind the Complainant has accused him of.
- The Respondent submitted that "*the Complainant has had an ongoing relationship with my client over a period of many years as a product supplier to Absolutely BaByliss*" and his client has "*built up a good name for the Absolutely BaByliss company*" that Mr. Evans did not want tarnishing with a "*disreputable domain registration by a third party.*"
- The Respondent "*agree[d]*" that the Complainant had a trade mark that is "*similar to the [D]omain [N]ame*" but noted that the Domain Name is identical to *absolutelybabyliss.com*, a domain that has been operating for over 10 years. The Respondent submitted that, given "*the history of a successful online business selling genuine goods for over 10 years, and a test site of the same name (different gTLD) owned by the same person for nearly 6 years, I think there is evidence enough for my client's reputation.*"

Abusive Registration

- The Respondent stated that the Domain Name has "*only ever been used as a testing platform for the main .com domain*", and is "*usually set up to redirect all web traffic to the main .com domain, where not from my own IP address.*"
- The Respondent stated that, over the last couple of years, Mr. Evans had considered updating the Website again and since the start of this year, they have been in the process of redesigning the site to bring it up to speed with modern web design trends and a fresh new look.
- The Respondent explained that, to allow Mr. Evans to access the site on occasion and provide feedback during this process, he "*removed the redirect and instead put the shopping cart system into 'maintenance mode'.*" The Respondent stated that, after the latest redesign was complete, the web assets would have been transferred to the .com domain, and the Website would only have been used thereafter for testing new plugins to the e-commerce software and in working with any issues arising on the main .com website.
- The Respondent stated that the Complainant "*has had an ongoing relationship with*" Mr. Evans over a period of "*many years as a product supplier to Absolutely BaByliss*" and that, even though the

Complainant has been aware of Absolutely BaByliss for a great length of time, this is the first time that the Complainant has tried to use its power as the rights-holder of the brand name BaByliss against Mr. Evans' company, Absolutely BaByliss.

- The Respondent referenced the Complainant's claim that "*people are likely to be confused into believing the domain name is registered to, operated or authorised by, or otherwise connected with CONAIR*" and submitted that any person visiting the Website has either meant to go to the .com version of the domain or they have "*simply miskeyed the gTLD part of the domain*".
- The Respondent further submitted that "*[i]t is obviously an independent online retailer selling BaByliss products and products from other manufacturers, and the website's own terms and conditions make this clear. No BaByliss logos are used anywhere in the main .com site and the main logo is sufficiently different that no-one can mistakenly think that they have visited a CONAIR site, even more so for the .co.uk site.*"
- In any event, the Respondent submitted that such persons are trying to get to *absolutelybabyliss.com*, a website which the Complainant has had no issue with and which, in no way, makes out to have anything to do with CONAIR or its related companies/websites.
- The Respondent submitted that, while there is a possibility "*in the strictest sense of the term i.e. there is no way to disprove it*" that the Domain Name may be used in conjunction with the unauthorised marketing, distribution or sale of goods under the BABYLISS trade mark, "*the history of the website so far and the close relationship it has to absolutelybabyliss.com strongly precludes this.*"
- The Respondent stated that the Domain Name has "*as far as is possible*" been configured to "*not show up in organic search engine searches*" and that, when the Website is not redirecting, it is set up for search engines not to crawl it. The Respondent stated that a site search on "*any of the big three search engines (Google, Bing, or Yahoo) will return no results for a site search of absolutelybabyliss.co.uk.*" The Respondent provided screen shots it submitted to support this submission.
- The Respondent provided what he termed as "*website visitor statistics for the time period from 2013 onwards*" and stated that "*as can be seen by the zero figures*" this is not a website that somebody can discover through a search engine. [*The Expert notes that, while the Respondent has provided a document purporting to show visitor statistics for the Website using PrestaShop, no explanation has been given as to the context of the print out or the parameters used. The Expert also notes that, from the evidence*

provided, the site had 6 visitors over the period represented, being 1 January 2014 to 6 July 2015.]

- The Respondent stated that the Complainant's reference to "*the selling of counterfeit goods*" was "*an obvious 'appeal to emotion' logical fallacy and attempts to manipulate an emotional response in place of a compelling argument. It is nothing more than scaremongering.*"
- In reference to the Complainant's submission that damage to the BABYLISS brand could have a knock-on effect and damage its business partners, the Respondent submitted that "*this is an appeal to emotion, and [the] website in no way affects ANY employees of CONAIR or its business partners, and never will, and the reputable history should be enough to prove this is the case.*"
- The Respondent noted that the Domain Name has been registered for nearly six (6) years and submitted that no attempt had ever been made to sell, rent, or otherwise transfer the domain to the Complainant. The Respondent submitted that the Website has in no way disrupted the business of the Complainant and has never been used and is "*never going to BE used for anything likely to confuse people or businesses into believing that the domain has anything to do with the Complainant.*"
- The Respondent submitted that, noting section 4(a)(i)(A) of the Policy, before he was aware of the Complainant's cause for complaint, a similar (identical except gTLD) domain owned by Mr. Evans was used to sell genuine goods.

Complainant's Reply

5.3 In summary, the Complainant submitted that:

- while the Respondent has stated that Mr. Evans is the rightful owner of the Domain Name, the Complainant has received no "*official documentation*" that anyone other than Mr. Ian Stanway is the registrant of the Domain Name;
- the registration of the two domains, *co.uk* and *.com*, are two separate issues;
- it can also confirm that Conair has not traded with Mr. Evans since January 2014 and that that account is considered as closed; and,
- it rejected the Respondent's proposal to transfer the Domain Name to Mr. Evans.

6. Discussions and Findings

General

- 6.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities:

"i. [it] has Rights in respect of a name or mark which is identical or similar to the Domain Name; and,

ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration."

- 6.2 Addressing each of these limbs in turn:

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

- 6.3 The Expert considers that, for the reasons set out below, the Complainant has Rights in a mark which is similar to the Domain Name.

- 6.4 Paragraph 1 of the Policy defines "Rights" as:

"[...] 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 must have the Rights in question at the time of the complaint.¹

- 6.5 The Expert considers that, as referenced by the Complainant and summarised at paragraphs 4.1 and 5.1 above, the Complainant has, through its Holding Company, the trade mark registration in respect of "BABYLISS", which is used by the Complainant to promote its goods/services. In this regard, the Expert notes that the Respondent "agree[s]" that the Complainant has a mark similar to the Domain Name.
- 6.6 Further, the Expert considers that the Domain Name prefix "ABSOLUTELY" as a modifier to "BABYLISS" does not sufficiently distinguish the Domain Name from the Mark.
- 6.7 Given those factors, and noting that the requirement to demonstrate 'Rights' is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Mark which is similar to the Domain Name. In concluding the above, the Expert has disregarded the domain suffix "co.uk."
- 6.8 There are references in the Respondent's submission that he has been acting "on behalf of and in agreement with" Mr. Evans and that, in effect, Mr Evans is the proper registrant in this matter. Further, the Respondent

¹ See for example, Nominet Appeal decision, *ghd.co.uk*, DRS No. 03078, at page 9, para 9.2.2.

has submitted that Mr. Evans has, among other things, Rights in the name "ABSOLUTELYBABYLISS" given that Mr. Evans has been successfully trading under that name since the launch of his *absolutelybabyliss.com* website in 2004.

- 6.9 However, the Expert considers that, as the Respondent's name is on record as the registrant for the Domain Name, any consideration of competing Rights in respect of a name or mark which is identical or similar to the Domain Name should be considered in respect of the Respondent rather than Mr. Evans. In any event, and so far as it is necessary, the Expert has consider whether or not there is sufficient evidence that Mr. Evans has competing Rights in in the name "ABSOLUTELYBABYLISS".
- 6.10 The Expert does not consider that either the Respondent or Mr. Evans have competing Rights in respect of a name or mark which is identical or similar to the Domain Name. The Expert notes in this regard that neither person has brought forward evidence that they have a relevant trade mark and, on the balance of probabilities, the Expert does not consider that based on the evidence before him the use of the name "*AbsolutelyBabyliss*" by the Respondent/Mr. Evans has generated goodwill and reputation separate from the Complainant's Mark.

Abusive Registration

- 6.11 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.
- 6.12 Paragraph 1 of the Policy defines "*Abusive Registration*" as a domain name which either:

"i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

ii. has been used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;"

- 6.13 *In relation to i. above*, the Expert considers that the Domain Name was an Abusive Registration at the time the Domain Name was registered.
- 6.14 The Policy, at paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, the Expert considers that the factor set out at paragraph 3 a. i. C. is relevant: namely, where the Respondent has registered the Domain Name primarily "*for the purpose of unfairly disrupting the business of the Complainant;*"
- 6.15 In relation to the above factor, the generally held view amongst DRS Experts, and one the Expert agrees with, is that for the above-mentioned

factor to apply the Respondent should have had knowledge of the Complainant and/or its Rights when registering the Domain Name.

- 6.16 In this regard, the Expert notes that the Complainant and the Respondent (with Mr. Evans) are in the same line of business (i.e. the sale of hair and beauty products). Indeed, as referenced by the Respondent, Mr. Evans has offered and offers for sale not only the Complainant's products but also the products of the Complainant's competitors (e.g. Parlux and Wahl).
- 6.17 Given the above, the Expert considers that the Respondent would have been well aware of the Complainant, and its Mark, at the time of his registration of the Domain Name.
- 6.18 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name to benefit from the Complainant's goodwill and reputation, in order to use it to compete against the Complainant and his company by attracting to any website that was set-up using the Domain Name users who would be looking for the Complainant.
- 6.19 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 6.20 *In relation to (ii) above*, the Expert also considers that the Domain Name was an Abusive Registration as a result of its manner of use by the Respondent.
- 6.21 The Expert considers that paragraph 3 a. ii. of the Policy is relevant, whereby a factor which may be evidence that the Domain Name is an Abusive Registration is:
- "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;"*
- 6.22 The Respondent emphasised at various points in his submission that the Website was "*only ever used as a testing platform*" for the ".com domain", not accessed by web "*visitors*", and "*usually set up to redirect all web traffic*" to Mr. Evans' .com website. However, as of the Decision date and as referenced by the Respondent, the Expert notes that the Website redirects to Mr. Evans' .com website where various goods that compete with the Complainant's can be found for sale (e.g. Wahl).
- 6.23 The Expert considers that anyone accessing the Website would likely be confused, at least initially,² into thinking that the Website is the

² For a discussion of the concept of 'initial interest confusion', please see the DRS Experts' Overview at paragraph 3.3. http://www.nominet.org.uk/sites/default/files/drs_expert_overview.pdf.

Complainant's or is somehow commercially connected with the Complainant.

- 6.24 In this regard, the Expert is not persuaded by the Respondent's argument that a person accessing the Website would soon realise such a mistake (because of, for example, the Respondent's use of a different logo); the damage to the Complainant's business would already have been done. Indeed, the Expert considers that it is likely that at least some persons accessing the Website would have done so only because of the Complainant's goodwill and reputation in the Mark.
- 6.25 The Expert considers that, by using the Domain Name as described above, the Respondent has taken unfair advantage of the Complainant's Rights and such use of the Domain Name is also unfairly detrimental to the Complainant's Rights.
- 6.26 The Expert has considered whether or not there is evidence before him to demonstrate that the Domain Name is not an Abusive Registration (noting, in particular, the submissions made by the Respondent that before he was aware of the Complainant's cause for complaint, a similar (identical except gTLD) domain owned by Mr. Evans was used to sell genuine goods (as per paragraph 4 a. i. A. of the Policy)) but does not consider there is.
- 6.27 In particular, and as set out in the Expert's Overview,³ the circumstances set out in paragraph 4(a)(i) of the Policy are only likely to constitute satisfactory answers to the Complaint if they commenced when the Respondent was unaware of the Complainant's name or mark forming the basis for the Complaint. For the reasons set out at paragraphs 6.16 *et seq.* above, the Expert considers that the Respondent (and as far as it is relevant, Mr. Evans) would have been well aware of the Complainant's mark at the time Mr. Evans set up the .com website.
- 6.28 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

7. Decision

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of the Name/Mark which is at least similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: Dr Russell Richardson

Dated: 17 September 2015

³ At para. 4.2.