

**DISPUTE RESOLUTION SERVICE**

**D00016210**

**Decision of Independent Expert**

NAF NAF

and

Herrold van der Weide

**1. The Parties:**

Lead Complainant: NAF NAF  
6/10 BOULEVARD FOCH  
EPINAY S/SEINE  
FRANCE  
93800  
France

Respondent: Herrold van der Weide  
van Laarstraat 10  
Hardenberg  
7773AD  
Netherlands

**2. The Domain Name(s):**

nafnaf.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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

07 July 2015 14:24 Dispute received  
07 July 2015 15:11 Complaint validated  
07 July 2015 15:20 Notification of complaint sent to parties  
24 July 2015 02:30 Response reminder sent  
29 July 2015 11:00 No Response Received  
29 July 2015 11:00 Notification of no response sent to parties  
31 July 2015 13:55 Expert decision payment received

Although Nominet sent the Complaint to the Respondent on 7 July 2015 and followed this with a response reminder sent on 24 July 2015, no response to the Complaint has been provided by the Respondent in accordance with paragraph 5(a) of the Procedure.

The Complainant paid Nominet for a full expert decision on 31 July 2015.

#### **4. Factual Background**

- 4.1 The Complainant, NAF NAF, is a French registered company, which was initially launched in 1973, some 40 years ago. It owns a UK subsidiary namely NAF NAF Limited. It is a French based fashion company and sells inter alia clothes, bags and other accessories under its name and trademark NAF NAF.
- 4.2 The Complainant's products are marketed in over 40 countries through 561 stores/points of sale worldwide, as well as via online boutiques. It has its own website at "nafnaf.com" and also offers its products for sale at various websites of third party partners. The latter include by way of example next.co.uk, zalando.co.uk, sarenza.co.uk and fashiongonerogue.com.
- 4.3 The Complainant owns numerous registered trademarks which include the sign NAF NAF alone or combined with other elements in various countries around the world. For example it has had the UK registered trademark number 1511699 for NAF NAF in class 25 for clothing, footwear and headgear and a UK registered trademark number 1511698 also for NAF NAF (word only) in class 9 for spectacles and sunglasses etc., both since 28 August 1992. It also owns the Community registered trademark number 6446926 dated 16 November 2007 for the words NAF NAF, and the International trademark Registration no. 1125971 dated 19 July 2012, for the word NAF NAF, designated for the European Union. Lastly it has protection under French law and by Article 8 of the Paris Convention for the sign NAF NAF as a well known trademark. As above the Complainant also owns the UK company NAF NAF Limited.
- 4.4 Furthermore the Complainant owns numerous Domain Names using or incorporating the words NAF NAF alone or combined with other elements. For example NAFNAF.com, NAF-NAF.com, NAF-NAF.co.uk and NAF-NAF.uk.
- 4.5 The Respondent registered the Domain Name on 29 November 2013. The Complainant's agents sent a cease and desist letter to the Respondent by email on 1 October 2014. This communication set out the basis for the

Complainant's claim that its trademark rights were being infringed by virtue of the use of the Domain Name by the Respondent and requested that the Domain Name be transferred to them. On 24 October 2014 the Respondent replied by email that his lawyer had advised him that the Complainant "probably" could not claim the Domain Name and suggested that the costs of a law suit could be more than €5,000. Further he would only be willing to transfer the Domain Name for the sum of €3,750. If that could be agreed he would then hand over the Domain Name within 10 business days of the payment.

- 4.6 After some further email correspondence the Complainant's agent then proposed on 22 November 2014 that €250 to be paid to the Respondent to try to settle the matter amicably. It was also made clear that this would require to be done using Escrow Services. Again after some further reminders by the Complainant's agent, an agreement was reached with the Respondent on 16 February 2015 whereby a payment of €1,000 would be paid for transfer of the Domain Name. The Complainant then proceeded to secure the transaction online through escrow.com. Despite this the Respondent did not transfer the Domain Name and requested instead a further amount of €2,600 on 27 March 2015. He indicated that this was on the basis that his Domain Name provider/the company hosting the Domain Name wanted him to pay the amount of €2,600 as a condition of any transfer. The Complainant then proceeded to file this complaint with Nominet on 7 July 2015.

## **5. Parties' Contentions**

- 5.1 In summary the Complainant argues that the Domain Name in the hands of the Respondent is an Abusive Registration in reliance on paragraph 2(a) (ii) of the Policy as "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 ..."
- 5.2 In support of its complaint the Complainant has submitted evidence of its registered trademarks, its Domain Name registrations, screenshots of websites where its products are offered for sale under the name NAF NAF and details of its company registrations in France and in the UK.
- 5.3 The Complainant also states that the Respondent has no rights or legitimate interest in respect of the Domain Name since it has no prior rights, such as trademarks or a corporate or trade name. The Complainant also confirms that

the Respondent has not been authorised by it to use the registered trademark NAF NAF.

It also states that given the repute of the trademark NAF NAF, at least in the United Kingdom, that the Respondent must have been aware of the existence of the Complainant's prior rights. As such it alleges that the Respondent registered the Domain Name to benefit from the notoriety of the trademark NAF NAF and from the significant investment made by the Complainant to build its brand image in the UK and on the web, for commercial gains.

It also argues that by registering the Domain Name the Respondent has prevented it from reflecting its mark in a corresponding Domain Name.

### **The Respondent**

- 5.4 The Respondent has not submitted a response to the Complaint.

## **6. Discussions and Findings**

### **General**

- 6.1 To succeed the Complainant has to prove pursuant to paragraph 2 (a) of Nominet's DRS Policy ("the Policy"), on the balance of probabilities that:

- (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 Taking each of these in turn:

### **Complainant's Rights**

- 6.3 Paragraph 1 of the Policy defines "Rights" as including, but not being limited to "Rights enforceable under English law or otherwise..."

- 6.4 Disregarding the generic .co.uk suffix, the Domain Name is identical to the Complainant's registered trademarks and registered company name in France and in the UK (disregarding the 'Limited'). The Complainant has a number of registered trademarks including the sign NAF NAF and its registered company name includes this sign. The Expert has also been provided with evidence that the Complainant's products are marketed extensively via numerous online boutiques. Notably the Complainant relies on WIPO case no. D2007-1175 "NAF NAF v Hostmaster Hostmaster" where the Panel stated that it accepted that "NAF NAF is a brand of considerable repute and that at least by the time that the Domain Name was registered it had become known in many countries around the world." The Complaint in that case was filed on 7 August 2007. In view of all of the above, the Expert is satisfied that the Complainant has Rights in respect of a name which is identical to the Domain Name.

## Abusive Registration

- 6.5 Under paragraph 1 of the Policy, Abusive Registration means 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 took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”
- 6.6 The Complainant relies on in particular paragraph 3 (a) (i) of the Policy, which stated that an Abusive Registration is established when “the Respondent has registered or otherwise acquired the Domain Name primarily:
- A For the purpose 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...”
- 6.7 The Respondent registered the Domain Name on 29 November 2013. It does not appear to have any legitimate interests or rights to the name NAF NAF. Neither has it used the Domain Name since then. It is clear that the Complainant has an established brand reputation in the sign NAF NAF. Thus it is highly unlikely that the Respondent would not have been aware of the existence of the Complainant and its brand name NAF NAF at the time of its registration of the Domain Name. Thus on the balance of probabilities the expert finds that the Respondent would so have been aware. The sign NAF NAF is also an invented term or brand as opposed to being in any way descriptive or generic. This suggests that it was a deliberate decision by the Respondent to register the Domain Name in order to take advantage of the Complainant’s Rights.
- 6.8 The email correspondence which has taken place between the Complainant’s agents and the Respondent since its registration of the Domain Name on 29 November 2013, demonstrates clearly in the Expert’s view that the Respondent was/is seeking to sell the Domain Name to the Complainant for a sum in excess of any reasonable out-of-pocket costs associated with its acquisition or use of the Domain Name. Indeed, despite the sum of €1,000 having been agreed between the Complainant and the Respondent for transfer of the Domain Name to the Complainant, the Respondent subsequently changed its mind and sought a further €2,600. It has not provided any evidence as to why this sum represents its out-of-pocket costs. It is clear to the Expert on the balance of probabilities therefore that the Respondent is seeking to profit from the sale of the Domain Name in which he has no legitimate rights or interests. Thus in the Expert’s view the

requirements of paragraph 3 (a) (i) A of the Policy is established on the balance of probabilities.

- 6.9 In addition the Respondent has by registering the Domain Name prevented the Complainant from registering it itself and/or using it for its own purposes. As such the Expert also finds on the balance of probabilities that the requirements of paragraph 3 (a) (i) B are satisfied.
- 6.10 Accordingly the Expert has reached the view on the balance of probabilities that the requirements of paragraph 1 of the Policy are satisfied.

## **7. Decision**

- 7.1 The Expert finds, on the balance of probabilities, that the Complainant has Rights in a name which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore the Expert directs the Respondent to transfer the Domain Name to the Complainant.

Signed ..... G GRASSIE .....

Dated ... 6/8/2015 .....