

DISPUTE RESOLUTION SERVICE

D00015854

Decision of Independent Expert

Aldi Stores Limited

and

Mr Matt Bonner

1. The Parties

Complainant: Aldi Stores Limited
Holly Lane
Atherstone
Warwickshire
CV9 2SQ
United Kingdom

Respondent: Mr Matt Bonner
11 Rutland avenue
Manchester
Greater Manchester
M20 1JD
United Kingdom

2. The Domain Name

<aldityres.co.uk> (“the Domain Name”)

3. Procedural History

24 April 2015 16:30 Dispute received
27 April 2015 13:07 Complaint validated
27 April 2015 13:20 Notification of complaint sent to parties
15 May 2015 02:30 Response reminder sent
15 May 2015 12:15 Response received

15 May 2015 13:15 Notification of response sent to parties
21 May 2015 02:30 Reply reminder sent
22 May 2015 10:36 Reply received
22 May 2015 10:39 Notification of reply sent to parties
22 May 2015 10:39 Mediator appointed
28 May 2015 09:25 Mediation started
30 June 2015 10:11 Dispute resolved during mediation
09 February 2016 14:59 Dispute opened
09 February 2016 15:05 Mediation failed
09 February 2016 15:05 Close of mediation documents sent
19 February 2016 01:30 Complainant full fee reminder sent
25 February 2016 10:20 Expert decision payment received

Expert Declaration

I 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.

4. Factual Background

The Complainant is a company registered in England and is an operator of supermarkets. It is a licensee of the registered trade mark ALDI which is owned by its associated company, Aldi GmbH & Co. KG, registered in Germany.

The German company's trade mark registrations include Community Trade Mark number 002071728 for ALDI, registered on 14 April 2005 with a filing date of 27 December 2000 and registered for numerous classes of goods and services.

The Domain Name was registered on 29 January 2013.

The Complainant has submitted evidence by way of a screen shot that on 24 April 2015 the Domain Name resolved to a webpage which stated:

“2014 Copyright. All rights reserved. The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew or the domain owner maintain any relationship with the advertisers. In the case of trademark issues please contact the domain owner directly (contact information can be found in whois). Privacy Policy”

5. Parties' Contentions

Complaint

The Complainant states that it has traded in the UK under the ALDI mark since at least 1988 and that it is the owner of substantial goodwill and reputation in the UK. It states that it has engaged in a sustained period of expansion in recent years and submits copies of media and industry reports which refer to its rank, market share and

brand recognition. The reports include a YouGov BrandIndex report which ranks the Complainant as the top ranked UK supermarket brand for 2014 and refers to its “increasing sales and continued expansion... thanks to heightened consumer perception of the supermarket.”

The Complainant submits that it has rights in respect of a name or mark which is identical or similar to the Domain Name. It states that the Domain Name consists of its internationally renowned mark ALDI together with the term “tyres” and that anyone navigating the Domain Name will expect to reach an online Aldi store or at any rate a website operated by the Complainant.

The Complainant refers to the webpage mentioned above and submits that, while no sponsored links are currently included, the website may be used for sponsored links in the future, thereby taking unfair advantage of the ALDI name and mark to generate advertising income for the Respondent.

The Complainant submits that the Respondent has used the Domain Name in such a way that people are likely to be confused into believing that the Domain Name is registered to, operated by or otherwise associated with the Complainant (paragraph 3(a)(ii) of the Policy).

In the alternative, the Complainant submits that the Respondent acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant and/or for the purpose of selling it to the Complainant for valuable consideration in excess of his out-of-pocket expenses (paragraphs 3(a)(i)(C) and (A) of the Policy).

The Complainant requests a transfer of the Domain Name

Response

The Respondent submits that he has tried to contact the Complainant to resolve this dispute. He also states:

“I’m happy to release the domain name but am looking for financial compensation as I bought the domains and thus will be out of pocket if they are simply released.”

Reply

The Complainant states that it did receive an email communication from the Respondent but that the Respondent has failed to respond to subsequent correspondence. It repeats that the Respondent appears to be seeking compensation in excess of his out-of-pocket expenses. It adds that the Respondent is also the registrant of the domain name <aldi.com> and submits that the Respondent has therefore engaged in a pattern of abusive registrations (paragraph 3(a)(iii) of the Policy).

6. Discussions and Findings

The Complaint falls to be determined according to the Policy and the Nominet DRS Procedure. Under paragraph 2 of the Policy:

- “(a) *A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, that:*
- (i) the Complainant 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.*
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “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.”*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has established that it is the licensee of registered trade mark rights in the mark ALDI. I also find on the evidence provided by the Complainant that the mark ALDI is widely known in the UK and that the Complainant's brand commands substantial reputation and commercial goodwill.

Ignoring the formal suffix “.co.uk”, the Domain Name consists of the term “aldi” and the term “tyres”. There is no evidence that the term “aldi” is a dictionary term or that it has any meaning in commerce other than to refer to the Complainant's brand. The term “tyres” is descriptive and is not effective to distinguish the Domain Name from the Complainant's mark.

I therefore find that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

Abusive Registration

The Respondent has advanced no reason for his choice of the Domain Name. I infer in all the circumstances that the Complainant registered the Domain Name in the knowledge of, and in order to take advantage of, the Complainant's widely known trade mark ALDI, i.e. by attracting Internet users to his website because of the reputation and goodwill of the ALDI mark.

I also find that, in the circumstances evidenced by the Complainant, the Respondent is using or threatening to use the Domain Name for the purpose of a parking page containing sponsored links which are liable to produce revenue for the Respondent.

In the circumstances, I find that the Respondent is using the Domain Name in a manner which takes unfair advantage of the Complainant's Rights. In particular, the Respondent is 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 (paragraph 3(a)(ii) of the Policy).

I therefore find that the Domain Name in the hands of the Respondent is an Abusive Registration.

7. Decision

I have concluded that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds and I direct that the Domain Name <aldityres.co.uk> be transferred to the Complainant.

Signed: Steven Maier

Dated: 11 March 2016