

DISPUTE RESOLUTION SERVICE

D00016736

D00016756

Decision of Independent Expert

I-nvention B.V.

and

Identity Protect Limited

1. The Parties:

Complainant: I-nvention B.V.
Schieweg 83
Delft
2627 AT
Netherlands

Respondent 1 (enjoint.co.uk):

UR Media Limited
Unit 19 Bridge Villa Ind Est , 1 Draycott Road
Tean
Staffordshire
ST10 4JF
United Kingdom

Respondent 2 (e-njoint.co.uk):

Identity Protect Limited (contact: David Wright)
23 Sorrel Close
Uttoxeter
Staffordshire
ST14 8UP
United Kingdom

2. The Domain Names:

enjoint.co.uk
e-njoint.co.uk (together, the "Domain Names").

3. Procedural History:

DRS16736 (enjoint.co.uk)

The Complaint was submitted to Nominet on 6 November 2015. On 9 November 2015, Nominet validated the Complaint and notified it to the Respondent. The Respondent was informed in the notification that it had 15 working days, that is, until 30 November 2015 to file a response to the Complaint.

On 30 November 2015 the Respondent filed a Response. On 3 December 2015, the Complainant filed a Reply to the Response. The case proceeded to the mediation stage.

DRS16756 (e-njoint.co.uk)

The Complaint was submitted to Nominet on 11 November 2015. On 12 November 2015, Nominet validated the Complaint and notified it to the Respondent. The Respondent was informed in the notification that it had 15 working days, that is, until 3 December 2015 to file a response to the Complaint.

On 3 December 2015 the Respondent filed a Response. On 4 December 2015, the Complainant filed a Reply to the Response. The case proceeded to the mediation stage.

Consolidation DRS16736 and DRS16756

On 3 December 2015, the Complainant's representative requested that Nominet merge cases 16736 and 16756. In accordance with paragraph 12(c) of the Policy, Nominet agreed to consolidate the cases on the same date and informed the Complainant's representative that consolidation would apply to both mediation and expert decision if required.

Mediation and Expert appointment DRS16736 and DRS16756

A mediator was appointed by Nominet in the newly consolidated case on 4 December 2015. On 10 December 2015, Nominet notified the Parties that mediation had been unsuccessful and invited the Complainant to pay the fee for referral of the matter for an expert decision pursuant to paragraph 8 of

Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy"). On 15 December 2015, the Complainant paid the fee for an expert decision. On 16 December 2015, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in the consolidated case. Nominet duly appointed the Expert with effect from 21 December 2015.

4. Factual Background

The Complainant in this case is a Netherlands based company which manufactures a range of devices in the category of "electronic cigarettes". Press reports regarding the Complainant's devices state that they contain a vaporiser which converts herbal or biological flavourings into water vapour, for the purposes of inhalation ("vaping") by the user, and that the user may fill the device with ingredients such as dry herbs.

The first Respondent, UR Media Limited, is a United Kingdom limited company engaged in web development. It, or an entity related to it, is a retailer of electronic cigarettes and has been an unofficial reseller of the Complainant's products to the public in the United Kingdom. The second Respondent is a WhoIs proxy or privacy service for which the listed contact is David Wright, one of the directors of UR Media Limited.

The factual background of this case is complex, particularly as it contains two separate domain names registered and used under slightly different but related factual circumstances. The facts thus required considerable scrutiny and disentangling. For ease of reference, the Expert has therefore prepared a chronology of events instead of the more conventional narrative. The chronology has been assembled from the Parties' submissions and evidence, together with the Nominet register database. Where the register data is used, this is specifically identified.

Given the large volume of material presented to the Expert (some 224 pages of evidence, some but not all of which was duplicated between the two cases) the chronology does not contain details of every screenshot and email provided in the Parties' documentary evidence but only lists those that the Expert considered are helpful to an understanding of the background to the dispute and thus are of greatest relevance to the factual matrix.

04/06/2014 Complainant's Benelux trade mark no. 1285438 for the word mark E-NJOINT in class 34 granted. International mark follows claiming priority from this mark.

05/06/2014 Complainant publishes YouTube presentation on its "e-njoint"

vaping product.

- 23/06/2014 Feature on Complainant covering e-njoint brand and product published in UK Daily Mail. Online press coverage also ensues.
- 23/06/2014 e-njoint.co.uk registered to James Bedding (address in Jersey) per Nominet register database.
- 24/06/2014 enjoint.co.uk registered to UR Media Limited (Respondent) per Nominet register database.
- 21/07/2014 Chris Bradbury, director UR Media Limited, registers customer account on Complainant's website.
- 23/07/2014 Chris Bradbury completes first order from Complainant's website (5 disposable display boxes of 12 pcs each).
- 25/07/2014 Chris Bradbury's first order from Complainant delivered.
- 14/01/2015 Chris Bradbury emails Brian Goldstone (Vape Supplies Limited, official UK distributor of Complainant) following up earlier conversation, requesting samples, offering to provide Mr Goldstone with email address trade@ enjoint.co.uk or brian@enjoint.co.uk "if you want as your [*sic*] helping us and [missing from screenshot] hoping to work with each other for the future". Plans meeting for following week.
- 24/01/2015 e-njoint.co.uk transferred to David Wright, director UR Media Limited per Nominet register database.
- 25/01/2015 e-njoint.co.uk transferred to Identity Protect Limited (David Wright as contact) per Nominet register database.
- 18/02/2015 David Wright engages in discussion over email with Brian Goldstone regarding preparations to launch e-njoint.co.uk website, noting "It's looking good I must say". Brian Goldstone replies "yes agree just checked it".
- 16/03/2015 Vape Supplies Limited completes order from entity described as "Enjoint" having the same address as registered office address of UR Media Limited.
- 02/04/2015 David Wright sets up email on e-njoint.co.uk providing email address brian@e-njoint.co.uk for Brian Goldstone.
- 18/05/2015 David Wright emails Brian Goldstone regarding:-
(1) e-njoint.co.uk - noting that he has a two year contract in place with "the guy" for £4,800 total and adding that registrant is looking for "over £10,000 on the domain name". David Wright

says that if UR Media Limited had the money they would buy the domain name "as we need this for Vape Supplies".

(2) enjoint.co.uk - David Wright notes amount of sales on corresponding site and adds "As we have built a good customer service and client relationship we would want a price on this, As a working partnership we would be willing to take a lump sum upfront and a salary for working for Vape Supplies, This site is top on Google so this sites valued the highest on sales. What would you like to offer us on this?"

- 18/05/2015 David Wright emails Brian Goldstone "From that guy" stating that "£1,000 is an insult to my intelligence when we have a contract in place that is worth a further £4,000 to me." Proposes to open talks again only if there is a sensible offer.
- 20/05/2015 David Wright emails 'Ton' at DomainMasters (Complainant's domain name adviser). Asserts a third party owns e-njoint.co.uk. Alleges has been in talks with registrant for months and proposes to offer him £2,000.
- 21/05/2015 e-njoint.co.uk website features statement "e-njoint.co.uk are trading as Vape Supplies Ltd based on the east coast of grimsby [sic], The Official UK and Ireland Distributor of e-njoint's to the wholesale and trade customers throughout the UK".
- 22/05/2015 David Wright emails 'Ton' at DomainMasters stating that e-njoint.co.uk is "In my name now. Let me know where im transferring this too please, I need the payment 1st before I do so" [sic].
- 16/07/2015 David Wright emails Brian Goldstone denying he "is" e-njoint "just because I own the domain" and adds that it has "always been under your name and Vape Supplies name" but that he is now "running it as our company ENJOY VAPING".
- 16/07/2015 Brian Goldstone emails David Wright re enjoint.co.uk saying "you were and still are doing well with enjoint.co.uk from your own account you are top of the premiership with that domain and nobody will overtake you".
- 18/07/2015 Screenshots show e-njoint.co.uk "is now trading as Enjoy Vaping based in Staffordshire, We are the Original E-njoint Sellers throughout the UK."
- 08/09/2015 David Wright emails Brian Goldstone. Proposes a sale of "www.e-njoint.co.uk" for a transfer of domain name and to have "Exclusive Prices to Trade/Wholesale for Enjoy Vaping (enjoint.co.uk) £4,000", or a transfer of domain name,

described as "Buy Out Right" for £8,000.

- 13/10/2015 Screenshot of 'About us' page on website enjoint.co.uk states "We at enjoint.co.uk (Enjoy Vaping) are based in central England in Staffordshire, and distribute E-njoint's to both the end user and to trade customers throughout the UK....The E-njoint is manufactured by an innovative design and manufacturing company known as E-NJOINT B.V., with it's head office in Delft, The Netherlands distinguish itself by providing constant innovation and unique designs of electronic vaporizing products. We are an independent retailer in the UK for E-Njoint B.V."
- 13/10/2015 David Wright emails Menno Contant, CEO of Complainant stating that "Enjoint.co.uk will stay open and new products will be introduced soon. Not much e-njoint stock left. e-njoint.co.uk - will now be a review page on e-joints and I will not monitor good or bad reviews I will let people add real reviews!"
- 10/2015 (approx) e-njoint.co.uk website forwards to enjoyvaping.co.uk from which Respondent sells Complainant's product and products of third parties. enjoint.co.uk website now titled "enjoy vaping" and sells Complainant's product and products of third parties.
- 20/10/2015 Screenshot e-njoint.co.uk website features an "About Us" statement at the bottom of the homepage: "e-njoint.co.uk | Enjoy Vaping is a company based in Staffordshire and we are NOT a part of e-njoint, We Review On Products within the UK. E-njoint TM products are patented worldwide and is a registered trademark of www.e-njoint.com".
- 24/12/2015 When visited by Expert - 'About us' page on enjoint.co.uk website states "We at enjoint.co.uk (Enjoy Vaping) are based in central England in Staffordshire, and sell vaping products to the end user throughout the UK...We at enjoint.co.uk are a sole trader within the uk that also sells and trade other products in the vape world! (Sister Company of the UR Media Ltd Group)". Site offers Complainant's products and third party products for sale.

When visited by Expert - [e-njoint](http://e-njoint.co.uk) website forwards to enjoyvaping.co.uk website. Site offers Complainant's products and third party products for sale.

The email of 8 September 2015 was marked 'without prejudice'. It has been included in this chronology and, if appropriate, may be considered by the Expert in accordance with paragraph 6 of the Policy.

5. Parties' Contentions

Complaint

The Complainant asserts that it has Rights in a trade mark identical or similar to each of the Domain Names and that both of the Domain Names are Abusive Registrations.

The Complainant describes its various registered trade marks for the word mark E-NJOINT. In the case of enjoint.co.uk the Complainant argues that this is identical or similar to the Complainant's mark and in the case of e-njoint.co.uk the Complainant asserts that this is completely identical to such mark. The Complainant also describes its use of E-njoint as a product name and states that it has invested over €1.2 million in development, promotion and sales of such product along with protection and enforcement of its intellectual property rights. The Complainant adds that since its breakthrough press releases it has been significantly known under the name E-njoint and not as I-nvention B.V. The Complainant points out that it owns many domain names in the second level for "e-njoint" including that of its official website "www.e-njoint.com".

The Complainant contends that the Respondent registered both of the Domain Names shortly after the UK "Daily Mail" published a story on the Complainant's product. The Complainant asserts that when Chris Bradbury of the Respondent made the initial order from the Complainant's website, the Respondent agreed to terms and conditions which prohibited the use of the Complainant's website or content and the infringement or violation of the Complainant's intellectual property rights.

The Complainant asserts that the registrant address on e-njoint.co.uk demonstrates a connection between James Bedding, the original registrant, and David Wright as the WHOIS uses the same address as Mr Wright's home address.

The Complainant describes the first contact between its exclusive UK distributor, Vape Supplies Limited and the Respondent in January 2015 and asserts that neither the Complainant nor its distributor asked or paid for any website to be built linking to the Respondent. The Complainant notes that it discovered that the Domain Names were unavailable and were registered to the Respondents only in April 2015.

The Complainant notes that the party responsible for the content at enjoint.co.uk is a company named Enjoy Vaping which it notes is stated to be a sister company of the Respondent UR Media Limited.

The Complainant asserts that various iterations of the Respondents' websites and particularly those between May/June and October 2015 are slavishly copied from the Complainant's original website and use the Complainant's E-NJOINT trade mark in the form of its original logo in a prominent fashion. The Complainant submits that the enjoint.co.uk website contained important parts of the Complainant's brand story and that the Respondent used social media to give the impression that it was the Complainant by posting messages as "Enjoint". The Complainant asserts that in July 2015 the Respondent claimed on its website to be "E-njoint" and presented itself as the official UK distributor of the Complainant. The Complainant says that this constitutes use or threatening to use the Domain Names in a way which is likely to confuse people or businesses into believing that the Domain Names are registered, operated or authorised by the Complainant.

The Complainant notes that between May and October 2015 it attempted to resolve matters amicably with the Respondent but that during that period the Respondent made offers to the Complainant's UK distributor to sell both of the Domain Names for sums between £4,000 and £10,000. With regard to e-njoint.co.uk, the Complainant asserts that David Wright proposed that he would negotiate with James Bedding for its purchase and claimed to be paying a monthly fee therefor. The Complainant asserts that this was a cover for the fact that the Respondent was the original registrant and was responsible for the website content. The Complainant also asserts that on 15 October 2015 the Respondent listed e-njoint.co.uk for sale on the eBay auction website.

The Complainant asserts in the alternative that the Respondent registered the Domain Names to sell them to the Complainant and as blocking registrations. The Complainant states that this is illustrated by the fact that the Respondent engaged in correspondence attempting to sell the Domain Names, stating that he was aware of the value and threatening to offer the products of the Complainant's competitors.

The Complainant concludes that all of the facts show that the Domain Names in the hands of the Respondent are unfairly detrimental to the Complainant's rights and that the Respondent has no rights or legitimate interests in the Domain Names and has no affiliation or authorisation to use them in the manner contended.

Response

The Respondent contends that it registered enjoint.co.uk after reading an article regarding the Complainant's new product. The Respondent states that it contacted the Complainant and showed interest in generating an online store for the UK market. The Respondent submits that the Complainant had no issues with its product being sold on enjoint.co.uk and provided artwork to the Respondent and added the Respondent to the Complainant's list of stores

selling its product. The Respondent produces a screenshot from the Complainant's website showing that its location, company name and the domain name enjoint.co.uk were listed on a page titled "Our stores".

The Respondent states that after a successful remainder of the year it discussed the acquisition of e-njoint.co.uk "with Netherlands" and with the Complainant's UK distributor. The Respondent states that it purchased e-njoint.co.uk on 23 January 2015 after a lot of communication. The Respondent says that it proposed a partnership with the Complainant's UK distributor whereby the Respondent would receive a profit share on sales and the distributor would receive the orders. The Respondent notes that the distributor had input to the site and that it took five months to build.

The Respondent asserts that by the time it heard from the Complainant's domain name advisers it had built a reputable business on enjoint.co.uk on which the Complainant's and third party products are sold. The Respondent says that it was prepared to release this domain name if its costs were reimbursed and that this request was followed by threats of action regarding the Domain Names. The Respondent adds that it then received requests to remove the Complainant's artwork and to remove the details of the UK distributor. The Respondent states that it has complied with both of these requests.

The Respondent concludes that it purchased e-njoint.co.uk on its own behalf but with the agreement of the Complainant and its UK distributor and that it would be content for the Complainant to take this over if the Respondent's costs can be reimbursed. With regard to the enjoint.co.uk domain name, the Respondent asserts that it built and promoted the corresponding site, generating a lot of business in the UK and that this is the Respondent's main primary site for its Enjoy Vaping business.

Complainant's Reply to Response

The Complainant asserts that the Respondent's statements are deceptive and false. The Complainant denies that the Respondent contacted the Complainant before purchasing either of the Domain Names. The Complainant asserts that it is false for the Respondent to say that it registered e-njoint.co.uk on 24 June 2014 as it was registered on the preceding day. The Complainant denies that its UK distributor agreed to the purchase of e-njoint.co.uk and states that in any event the Respondent was the registrant of this domain name from the beginning.

The Complainant states that there was a short contact between the parties initiated by the Respondent in which the Respondent expressed an interest to sell the Complainant's products but that this never came to a meeting and the Respondent was not selected by the Complainant as its UK distributor. The Complainant states that it was unaware of the Respondent having purchased

the Domain Names and denies that it gave any permission for its artwork to be used on the Respondent's website.

With regard to the addition of the Respondent's business and location being added as a store on the Complainant's website, the Complainant states that there are several stores reselling the Complainant's products in the UK and that the address was of a physical store. The Complainant notes that all such stores must comply with a product sales policy and may use specific promotional material but that the copying of the Complainant's artwork and use of its logo and brand story on the Respondent's website or to appear as though the website was that of the Complainant was not permitted.

The Complainant asserts that the Respondent's claim not to know who owned e-njoint.co.uk is false and that the domain name was in the name of or connected to David Wright for the whole time.

The Complainant asserts that the correspondence between the Respondent and the Complainant's UK distributor was carried out on false pretences because e-njoint.co.uk was owned by the Respondent from the outset. The Complainant asserts that the evidence from email copy does not show any consent being given by its UK distributor to the Respondent's website.

The Complainant notes that although changes have been made to the websites associated with the Domain Names, these were only made after the Respondent received a cease and desist letter from the Complainant's lawyers and that there has not been full compliance with the terms of that letter nor any substantive response received from the Respondent thereto.

6. Discussions and Findings

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely 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.

Complainant's Rights

Paragraph 1 of the Policy provides that 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 requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

The Complainant claims Rights in its Benelux mark for the word E-NJOINT and subsequent marks claiming priority therefrom. While the mark relied upon by the Complainant is not registered in the United Kingdom, the Expert is satisfied that overseas rights such as a Benelux registered mark can constitute Rights within the meaning of the Policy in accordance with the discussion on this topic in paragraph 1.5 of Version 2 of the Experts' Overview.

The remaining question is whether such mark is identical or similar to either or both of the Domain Names. The first (.uk) and second (.co) levels of each of the Domain Names are typically disregarded for comparison purposes given that they are generic and required for technical reasons. On this comparison, the Domain Name e-njoint.co.uk is identical to the Complainant's trade mark. The Domain Name enjoint.co.uk is similar to the Complainant's trade mark, in the Expert's opinion, on the basis that this is alphanumerically identical with the exception of the additional hyphen in the Complainant's mark.

The Respondent does not take issue with any of the Complainant's submissions on this particular topic.

In these circumstances, the Expert finds that the Complainant has proved on the balance of probabilities that it has Rights in the mark E-NJOINT and that such mark is identical or similar to the Domain Names.

Abusive Registration

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;

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The essence of the Complainant's case is that the Respondent is using the Domain Names in a way which is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by or otherwise connected with the Complainant, effectively a submission in terms of paragraph 3(a)(ii) of the Policy. The Complainant has a supplemental case that the Domain Names were registered or acquired to sell them to the Complainant, effectively a submission in terms of paragraph 3(a)(i)(A) of the Policy, albeit that this paragraph requires that this be the Respondent's primary purpose. The essence of the Respondent's case is that everything it has done with the Domain Names has been with the consent of the Complainant, that it has built a valuable business on enjoint.co.uk and acquired e-njoint.co.uk because it believed that this would help and improve its business relationship with the Complainant's UK distributor.

The Parties are exercised in their submissions regarding the extent to which the Respondent received permission, encouragement or was otherwise enticed into registering enjoint.co.uk or into acquiring e-njoint.co.uk (or into using either or both of these domain names in the manner contended) by either the Complainant or, in the case of e-njoint.co.uk, its UK distributor. This might be a relevant issue to the question of Abusive Registration if it was determined that the Respondent registered, acquired or used either of the Domain Names, with suitable permission, for the purposes of becoming a reseller for the Complainant in the UK.

For example, a finding of non-abuse has been made in at least one case under the Policy involving a reseller, namely *YJ Europe Limited and YJ (USA) Corporation v. Garling Consulting Ltd* (DRS 013489). In that case, the expert found that the use of the domain name concerned was made initially with the full knowledge of the complainant's exclusive distributor and latterly with the knowledge of the complainant itself. The expert found that this did not constitute Abusive Registration because it was a use in connection with a genuine offering of goods and services before the respondent was aware of the complainant's cause for complaint (per paragraph 4(a)(i)(A) of the Policy). The expert stated that in coming to that conclusion, he had taken note that the respondent's website did not offer competing products. The expert added that had it done so, he might have reached a different conclusion.

In the present case, the evidence is by no means clear as to the extent to which the Complainant or the Complainant's UK distributor encouraged or supported the Respondent's use of the Domain Names. The Complainant categorically denies giving any such consent while saying that anything the UK distributor did was based upon the Respondent's false pretences regarding its ownership of e-njoint.co.uk. It must be noted though that the Complainant appears to have listed both the Respondent's store and the URL of its website (containing one of the Domain Names - enjoint.co.uk) on the Complainant's own website, which might be an oversight or might be taken to indicate some level of approval, and the Complainant's UK distributor does appear to have engaged in actual commercial negotiations with the

Respondent and in correspondence regarding the Respondent's website, including making complimentary remarks by email to the Respondent regarding the website development. It is not entirely clear to the Expert why the Complainant's distributor behaved as it did in its dealings with the Respondent, which are at best ambiguous in expressing an apparent desire to discuss a commercial relationship with a party which is said to be infringing the Complainant's rights.

On the other hand, the Respondent admittedly registered *enjoint.co.uk* on the strength of the press coverage in the UK at a point before it had even approached the Complainant and thus had no permission and no right at that stage to appropriate the Complainant's mark in a domain name. A mere intention to seek commercial relations with a mark holder at a later date cannot in the Expert's mind justify the registration by a third party of a domain name corresponding to that mark before the third party has even opened discussions with the mark holder. As the Appeal Panel in *GuideStar UK v. Wilmington Business Information Limited* (DRS 02193) stated:

"Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is".

Whatever the truth may be on the consent issue, the Expert does not consider that it is necessary to determine the question of express or implied consent in this particular case for the sole reason that the Respondent is no longer using either of the Domain Names in connection with any consent allegedly given or implied by the conduct of the Complainant or the Complainant's UK distributor. On the contrary, the Respondent now uses both of the Domain Names for websites which promote or offer for sale competitive products along with those of the Complainant. There is no evidence before the Expert that either the Complainant or its distributor have ever condoned or consented to the present use by act or implication.

Turning to the more general issue of resellers registering and using domain names incorporating or consisting of a complainant's mark, the Expert notes that this has been considered in several decisions of the DRS Appeal Panel which were most recently drawn together in *Toshiba Corporation v Power Battery Inc.* (DRS 07991) and *World Wrestling Entertainment, Inc. v. Daniel Raad* (DRS 16416). The Appeal Panel in *Toshiba* identified the following principles:-

First, it is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.

Secondly, a registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.

Thirdly, such an implication may be the result of initial interest confusion [defined as confusion that may arise, irrespective of the content of the respondent's site, merely as a result of the adoption of a domain name incorporating the complainant's mark] and is not dictated only by the content of the website.

Fourthly, whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the trade mark in the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.

In addition to expressing these principles, the majority of the Appeal Panel drew a distinction between an "unadorned" use of a trade mark in a domain name (that is, using the mark on its own) and an "adornment" (being the mark with extra descriptive words). The question of what adornment may mean to Abusive Registration (newly defined as "the incorporation of a modifying term into a domain name") was further considered by the Appeal Panel in *Word Wrestling Entertainment*. This question is not strictly relevant here given that both of the Domain Names do not contain such modifying terms - one is alphanumerically identical to the Complainant's mark and the other merely omits the hyphen contained in such mark.

The Appeal Panel in *Word Wrestling Entertainment* itself identified seven principles (expressed as not absolute rules) concerning domain names where the alleged abuse is said to arise in respect of a website which is used to sell only the genuine goods or services of the complainant. Again, that is not the allegation here as the sale or promotion of third party goods is also involved. However, the issue of competing products which are also or alternatively being sold was touched upon by the Appeal Panel in that case as they noted that "still further considerations may apply" in those circumstances.

In the present case, it is the Expert's opinion that initial interest confusion is likely to arise from the use of the Domain Names by the Respondent based upon the exact match or very close similarity between the Domain Names and the Complainant's mark and official website domain. It is highly likely that Internet users searching for the Complainant's UK operations or distribution will identify the Domain Names in isolation as most likely to be those of the Complainant. Furthermore, there are clear instances in the evidence where the wording on the Respondent's websites has, intentionally or otherwise, blurred the absence of a formal commercial connection with the Complainant and has on occasion led to the Respondent effectively describing itself as though it was the Complainant's UK distributor or indeed the Complainant itself. This would inevitably lead to additional confusion upon the Internet user's arrival at the Respondent's websites.

Of greatest significance to this case, however, as outlined above, is the fact that the Respondent currently uses both Domain Names for the sale or at least the active promotion of competing products alongside the Complainant's products. Such use is in the Expert's opinion unfairly detrimental to the Complainant's Rights in the E-NJOINT mark and this view is supported by the fourth *Toshiba* principle and, insofar as relevant to the competing products issue, the Appeal Panel's discussion in the recent case of *Word Wrestling Entertainment*.

In all of these circumstances, the Expert finds that the Domain Names are Abusive Registrations in the hands of the Respondent.

The Expert adds for the sake of completeness that although the parties are much exercised on the subject, the circumstances and timing of the original registration and of the Respondent's acquisition of the e-njoint.co.uk domain name are not issues upon which the Expert needs to reach a conclusion, given that paragraphs 1(i) and 1(ii) of the Policy each provide an alternative basis for a finding of Abusive Registration. For the reasons outlined above regarding the sale and/or promotion of products which compete with those of the Complainant on the websites associated with the Domain Names, the Expert is satisfied (whatever the circumstances of the original registrations) that paragraph 1(ii) of the Policy applies. Each of the Domain Names has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights and accordingly each is an Abusive Registration.

7. Decision

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is identical or confusingly similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are Abusive Registrations. The Expert therefore directs that the Domain Names be transferred to the Complainant.

Signed
Andrew D S Lothian

Dated 11 January, 2016
.....