

**DISPUTE RESOLUTION SERVICE**

**D00015068**

**Decision of Independent Expert**

Aldi Stores Limited

and

Mr Ivan Miller

**1. The Parties**

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

Respondent: Mr Ivan Miller  
2 Metro Triangle  
Birmingham  
B7 5QT  
United Kingdom

**2. The Domain Name**

aldionlineshopping.co.uk

**3. Procedural History**

3.1 On 18 November 2014 the complaint was received. On 19 November 2014 the complaint was validated and notification of it sent to the Respondent. On 25 November 2014 the response was received and notification of it sent to the Complainant. On 28 November 2014 a reply reminder was sent and on 1 December 2014 the reply was received. On 2 December 2014 notification of the reply was sent to the Respondent and the mediator was appointed. On 10 December 2014 the mediation started and on 19 December 2014 the mediation failed. On 23 December 2014 the Expert decision payment was received.

3.2 I, Patricia Jones ("the Expert"), 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.

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

- 4.1 The Complainant is a supermarket that trades under the ALDI mark. The Complainant was incorporated on 25 November 1988. The Complainant's website is at [www.aldi.co.uk](http://www.aldi.co.uk).
- 4.2 The Respondent is a UK individual who is involved in the provision of delivery services. The Domain Name was registered on 30 October 2014.
- 4.3 On 18 November 2014 the following message was on the web site at the Domain Name:

*"2014 Copyright. All Rights Reserved.*

*The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain owner maintain any relationship with the advertisers. In case of trademark issues please contact the domain owner directly (contact information can be found in whois).*

*Privacy Policy"*

However, despite this message, no sponsored listings were displayed.

#### **5. Parties' Contentions**

- 5.1 I set out below a summary of what I regard to be the main contentions of the parties.

##### **The Complainant's complaint**

- 5.2 The Complainant contends that it and Aldi GmbH & Co. KG ("Aldi GmbH"), a company registered under the laws of Germany, have Rights in the ALDI mark. The Complainant relies on the following:
- (a) The Complainant says that Aldi GmbH owns a number of well-known registered trade marks for marks comprising the ALDI name. The Complainant states that details of a number of registrations are submitted with the complaint. However these details appear to have been omitted from the evidence submitted with the complaint<sup>1</sup> and I have not seen them.
  - (b) The Complainant states that it is under common control with Aldi GmbH, is a licensee under the trade mark registrations and is a well known supermarket in the UK that trades under the famous and recognised ALDI name.
  - (c) The Complainant contends that it is the owner of substantial goodwill and reputation in the UK for the retailing of groceries, clothing and other household goods. The Complainant states that company details are submitted with the complaint and refers to the web site at [www.aldi.co.uk](http://www.aldi.co.uk). However, the company details also appear to have been omitted from the evidence submitted with the complaint and I have not seen them.
- 5.3 The Complainant contends that the Domain Name is an Abusive Registration for the following reasons:
- (a) the Respondent acquired the Domain Name for the purposes of selling it to the Complainant or to a competitor of the Complainant for valuable consideration in excess of out-of-pocket expenses;

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<sup>1</sup> The only evidence submitted with the complaint is a screen shot of the web site at the Domain Name on 18 November 2014.

- (b) the Respondent acquired the Domain Name to generate advertising income by hosting advertisements, taking advantage of the Complainant's Rights;
- (c) the Respondent acquired the Domain Name for the purpose of unfairly disrupting the business of the Complainant; and/or
- (d) people are likely to be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

5.4 In support of these contentions the Complainant relies on the following:

- (a) The Complainant states that its Rights pre-date the registration of the Domain Name.
- (b) The Complainant says the Respondent's address appears to be a goods depot or storage site which is not connected to the Complainant or Aldi GmbH. The Complainant is concerned that the Domain Name is intended to be used in conjunction with the unauthorised marketing, distribution or sale of goods under the ALDI trade mark.
- (c) The Complainant argues that when the words "online" and "shopping" [sic] are used with ALDI, an internationally known supermarket, in the Domain Name an inference is drawn that any web site hosted at the Domain Name will be for online shopping at Aldi. The Complainant argues that the Domain Name is likely to be taken by most people as a reference to the Complainant's business and that most people navigating to the Domain Name will be expecting to reach a web site of the Complainant. The Complainant is concerned that consumers who are looking for an online Aldi store may believe that any web site which is hosted at the Domain Name is operated or authorised by or is otherwise connected with the Complainant.
- (d) The Complainant relies on the message on the web site at the Domain Name set out at paragraph 4.3 above. The Complainant says that while no sponsored listings were visible as at the date of submission of the complaint, it is concerned that the Domain Name has been registered to take advantage of its registered trade mark and related rights by generating advertising revenue, even if no further web site is hosted at it.
- (e) The Complainant argues that the Respondent has no obvious justification for having 'aldi' in the Domain Name other than to now sell the Domain Name to the Complainant or to a competitor of the Complainant for more than his out-of-pocket expenses, the name ALDI being extremely well known and valuable.
- (f) The Complainant further argues that the Respondent threatens to disrupt the business of the Complainant by preventing the Complainant from reflecting the ALDI trade mark in a corresponding domain name and interfering with the Complainant's online activities at [www.aldi.co.uk](http://www.aldi.co.uk).

#### **The Respondent's response**

5.5 The Respondent's response is so brief that it is repeated verbatim below:

*"Why should the complaint not succeed?"*

*Thank you for the enquiry I would like to confirm we perched the domain names with the intentions to offer a national deliver home service to the retail industry as we are a delivery company delivering throughout the UK. We currently service Argos/ and Maplin, and more just to give an idea of what we do we work with an company*

*operating in London service many of the retails in the UK. So are proposal will be to include Aldi in our service along side all other home delivery retailers so creating an competitive end service to the consumer and the retailer."*

### **The Complainant's reply**

5.6 The Complainant replies as follows:

- (a) The Complainant contends that the response does not address the arguments in the complaint and does not cite or rely on any facts which correspond to the factors listed in the Nominet Dispute Resolution Service Policy ("the Policy") which may be a potential defence. The Complainant says the response deepens its concern about the Respondent's intended use of the Domain Name.
- (b) The Complainant says the absence of malicious intent is not a bar to a finding of an Abusive Registration.
- (c) The Complainant contends that the Respondent has admitted to acquiring the Domain Name for the purposes of generating revenue by carrying on a business which would make unauthorised and infringing use of the Complainant's trade marks, that is in the Domain Name itself, almost certainly on any web site hosted at the Domain Name or in the course of operating any e-mail based service via the Domain Name. The Complainant argues that any such activities carry a real risk of consumer confusion and/or would take unfair advantage of and/or cause detriment to the Complainant's trade mark rights.
- (d) The Complainant says that it has not received any proposal from the Respondent to carry this business out in conjunction with the Complainant or any request from the Respondent for a licence to use the Complainant's ALDI trade marks in such a way. The Complainant says that it would not authorise the use of the Domain Name or the ALDI trade marks by the Respondent in relation to such a venture. The Complainant says it is not required to explain its reasons for withholding consent to use of its trade marks by the Respondent; however the Respondent's response merely exacerbates the Complainant's concerns that any web site or e-mail based service hosted at the Domain Name by the Respondent would cause customer confusion and/or is unlikely to be of a quality appropriate to the ALDI brand and trade marks.
- (e) The Complainant states it is deeply concerned about the adverse impact any business carried on via the Domain Name would have on the ALDI brand and trade marks. The Complainant invites the Respondent to voluntarily transfer the Domain Name to the Complainant.

## **6. Discussions and Findings**

6.1 Paragraph 2 of the Policy sets out that for the Complainant's complaint to succeed it must prove to the Expert 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.

6.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

### **The Complainant's Rights**

6.3 Under Paragraph 1 of the Policy, Rights is defined 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". It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.*

6.4 The Complainant relies on its ownership of substantial goodwill and reputation in the UK for the retailing of groceries, clothing and other household goods. However, the company details which may have provided supporting evidence, such as details of turnover, have not been provided (see paragraph 5.2(c)).

6.5 The Complainant refers in its complaint to the web site at [www.aldi.co.uk](http://www.aldi.co.uk) ("the Aldi Web Site"). Paragraph 16(a) of the Nominet Dispute Resolution Service Procedure ("the Procedure") provides that:

*"The Expert will decide a complaint on the basis of the Parties' submissions, the Policy and this Procedure. The Expert may (but will have no obligation to) look at any web sites referred to in the Parties' submissions."*

6.6 Paragraph 5.10 of the 'Dispute Resolution Service – Experts' Overview'<sup>2</sup> explains that:

*"The basic rule is that Experts should not make any investigations of their own. They should make their decisions "on the basis of the parties' submissions, the Policy and the Procedure". The second sentence of paragraph 16(a) enables Experts to view web sites mentioned in the parties' submissions...*

*No party should assume that the Expert will make any investigations to support a bare assertion made in a party's submission. However, there may be occasions where an Expert will find it expedient to conduct a simple online enquiry of a publicly available database, where, for example, an exhibit purporting to support a party's contention does not do so and it appears that the 'error' is a simple oversight and not one of any major significance. In such circumstances, a simple enquiry of that kind may be a proportionate alternative to either ignoring a point made in the submission in question or initiating a further round of submissions by way of requests for further information. .... If, however, an Expert comes by material information as a result of any such enquiry (or indeed by any other means) and proposes to rely upon it in coming to a decision, the Expert will so inform the parties and invite them to make submissions as appropriate."*

6.7 In this case I have viewed the Aldi Web Site as permitted by paragraph 16(a) of the Procedure.

6.8 I am aware from my own knowledge, without making any enquiry, that Aldi is the name of a UK supermarket. The Aldi Web Site states that there are over 500 Aldi stores. The legal notice on the Aldi Web Site gives the Complainant's details. It also states that "*ALDI STORES LTD and our logo are trade marks belonging to us*". The logo on the Aldi Web Site prominently features the ALDI mark. The Aldi Web Site gives details of various awards and endorsements received and of recent TV advertisements.

6.9 I am therefore satisfied that the ALDI mark is recognised by the public as indicating the goods or services of the Complainant and consider that the Complainant has unregistered Rights through use in the name ALDI.

6.10 The Complainant says that Aldi GmbH owns a number of trade mark registrations for

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<sup>2</sup> The 'Dispute Resolution Service – Experts' Overview' provides assistance to participants in disputes under the Policy by explaining commonly raised issues and how Experts have dealt with them.

marks comprising the ALDI name and that it is licensed under these marks. I need to be persuaded on the balance of probabilities that the registered rights asserted exist. However, details of the trade mark registrations have not been given (see paragraph 5.2(a)). As set out at paragraph 6.6, I have some discretion to conduct an on-line enquiry of a publicly available database, for example of the UK trade mark registry, to investigate the position and I could also request the relevant documentation from the Complainant under paragraph 13(a) of the Procedure. However, given my finding at paragraph 6.9, I consider it unnecessary to carry out either of these options and I shall proceed with the complaint on the basis that the Complainant has unregistered Rights in the ALDI mark.

- 6.11 I regard the name ALDI to be identical or similar to the Domain Name (disregarding the .co.uk suffix). I do not consider the addition of 'online shopping' after 'aldi' to be sufficient to distinguish the Domain Name from the ALDI mark. The term 'online shopping' is merely descriptive of internet shopping, 'shopping' being an obvious misspelling of 'shopping', an activity associated with the Complainant's business. The dominant element of the Domain Name is 'aldi'.
- 6.12 Accordingly, I find that the Complainant has Rights in the name or mark ALDI which is identical or similar to the Domain Name.

#### **Abusive Registration**

- 6.13 It now has to be considered whether the Domain Name, in the hands of the Respondent, is an 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.
- 6.14 It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.
- 6.15 Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under Paragraph 1(i) of the Policy as follows:
- i. Circumstances indicating that 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; or
    - C for the purpose of unfairly disrupting the business of the Complainant.
- 6.16 Paragraph 3(a) of the Policy relates to the Respondent's motives at the time of registration of the Domain Name. Accordingly, for there to be an Abusive Registration under paragraph 1(i) of the Policy, it must be established that the Respondent had knowledge of the Complainant and/or its Rights at the time of registration of the Domain Name.

- 6.17 Paragraph 3(a)(ii) of the Policy sets out a non-exhaustive factor which may be evidence that the Domain Name is an Abusive Registration under Paragraph 1(ii) of the Policy, namely circumstances indicating that 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.
- 6.18 In this case the Complainant is a large supermarket trading under the ALDI mark. The Respondent says in his response that the Domain Name was purchased with the intention of offering a national home delivery service to the retail industry and that he proposed to include Aldi in the service. The Respondent therefore registered the Domain Name with Aldi in mind and accordingly at the time of registration the Respondent knew of the Complainant and/or its Rights.
- 6.19 The Complainant relies on the factors set out at paragraphs 3(a)(i)(A) and (B) in support of the Domain Name being an Abusive Registration under paragraph 1(i) of the Policy. However, in my view, taking into account that the Respondent's stated purpose for registering the Domain Name is in connection with a home delivery service, there is no evidence in support of these factors. For example, there is no evidence of any offers to sell the Domain Name to the Complainant or to a competitor of the Complainant.
- 6.20 The Complainant also relies on paragraph 3(a)(i)(C) of the Policy. If the Respondent, with knowledge of the Complainant, registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant, by attracting users to the Respondent's site who were looking for the Complainant and once there potentially diverting users into placing business with the Respondent, this may be an Abusive Registration under paragraph 1(i) of the Policy.
- 6.21 The Complainant uses [www.aldi.co.uk](http://www.aldi.co.uk) for its on-line supermarket site. In my view, there is a real risk that Internet users guessing the URL of Aldi supermarket will use 'aldi' followed by 'online shopping', as this is descriptive of on-line shopping at Aldi. Further, I consider there is a real risk of such Internet users mistyping or misspelling 'shopping' as 'shoping' when they input the URL into their browser such that they find the Respondent's site when looking for the Complainant.
- 6.22 I also consider there is a real risk that Internet users looking for the Complainant will use the search term 'aldi online shopping' and that such Internet users may mistypye or misspell 'shopping' as 'shoping' when they input this search term thereby visiting the Respondent's site.
- 6.23 When Internet users looking for the Complainant reach the Respondent's site they will find a message which refers to sponsored listings (see paragraph 4.3). There is nothing on the site which states that the Respondent, rather than the Complainant, operates the site and accordingly Internet users may believe that they have reached the Complainant's on-line shopping site.
- 6.24 The Respondent states that the Domain Name was registered for the purpose of home delivery services. However, I consider that the Respondent also registered the Domain Name for the purpose of using it for sponsored advertisements, perhaps pending the development of web site content for the home delivery services. Although no sponsored listings were displayed on the web site at the date of the complaint, in my view, the content of the message on the site indicates an intention to display such listings. The Complainant's evidence shows that this message was on the

web site very shortly after the Domain Name was registered and the Respondent has provided no explanation as to why this message appears on the site.

- 6.25 Indeed the web site at the Domain Name has been used for sponsored advertisements. Pursuant to paragraph 16(a) of the Procedure I have viewed the site at the Domain Name and found that it displayed sponsored links relating to the Complainant such as “Aldi Store Locations”, “Aldi” and “Aldi Food Store Phone Number” as well as a sponsored link referring to a competitor. The message set out at paragraph 4.3 was displayed below these listings.
- 6.26 I consider that there is a real risk that the use of the site for sponsored advertisements will divert Internet users who find the Respondent’s site when looking for the Complainant to third party sites and thereby earn the Respondent click through revenue.
- 6.27 Further, if the Domain Name is used as the Respondent indicates in his response for home delivery services then there is a real risk that Internet users looking for the Complainant will believe that they have reached the site for the Complainant’s on-line shopping delivery services and may be diverted into contacting the Respondent.
- 6.28 Accordingly, on the face of it, for the reasons set out above, I consider that the Respondent registered the Domain Name, with knowledge of the Complainant, for the purpose of unfairly disrupting the business of the Complainant such that there is an Abusive Registration under paragraph 1(i) of the Policy.
- 6.29 I also consider that even if Internet users appreciate on visiting the Respondent’s site that they have not reached the Complainant’s site, these users would still have been initially confused into visiting the Respondent’s site in the expectation of finding the Complainant. It is clear that such ‘initial interest confusion’ is sufficient to support a finding of Abusive use of the Domain Name under paragraph 1(ii) of the Policy. This is made clear in paragraph 3.3 of the ‘Dispute Resolution Service–Experts’ Overview’ which sets out the following:

*“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose.*

*In such cases, the speculative visitor to the registrant’s web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name”.*

- 6.30 As set out at paragraphs 6.21 and 6.22 I consider that in this case there is ‘initial interest confusion’ and that visitors to the Respondent’s site will be deceived by the Domain Name into believing that it is connected to the Complainant. Accordingly, on



the face of it, there are circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant such that there is an Abusive Registration under paragraph 1(ii) of the Policy.

6.31 However, before I make a finding of Abusive Registration of the Domain Name, I must bear in mind paragraphs 4(a)(i)(A), 4(a)(i)(B) and 4(e) of the Policy being non-exhaustive factors which may be evidence that the Domain Name is not an Abusive Registration as follows:

4a.i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
- B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

4e Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:

- i. the nature of the Domain Name;
- ii. the nature of the advertising links on any parking page associated with the Domain Name; and
- iii. that the use of the Domain Name is ultimately the Respondent's responsibility.

6.32 In relation to paragraph 4(a)(i)(A) I have found that the registration and use of the Domain Name took place when the Respondent knew of the ALDI mark so I do not consider this factor applies. In relation to paragraph 4(a)(i) (B) there is no evidence to suggest that the Respondent has been known by the name 'aldi' or legitimately connected with this mark.

6.33 As set out above, I consider the Respondent registered the Domain Name, with knowledge of the Complainant, for the purpose of sponsored advertising. In relation to paragraph 4(e) of the Policy, the dominant element of the Domain Name is 'aldi' and the other elements are descriptive ('shoping' being a misspelling of 'shopping'). The message on the web site at the Domain Name anticipates that there may be trade mark issues relating to the sponsored links which appear on the web site, suggesting that the sponsored links will refer, for example, to 'aldi' or be for competing goods and services to those of the Complainant. Indeed, the Domain Name has been used for such sponsored links (see paragraph 6.25). Whilst the Respondent suggests in the message on the site that he is not responsible for the sponsored links as they are generated by a third party and he has no relationship with the advertisers, paragraph 4(e) of the Policy makes it clear that the use of the Domain Name is ultimately the Respondent's responsibility. As set out above, I consider the Respondent is seeking to take advantage of those Internet users looking for the Complainant to earn click through revenue. In such circumstances, I regard the registration and use of the Domain Name to be objectionable under the Policy.

6.34 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraphs 1(i) and 1(ii) of the Policy.

**7. Decision**

- 7.1 I find that the Complainant has Rights in 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.
- 7.2 I therefore direct that the Domain Name be transferred to the Complainant.

**Patricia Jones**

**13 January 2015**