

DISPUTE RESOLUTION SERVICE**D00020874****Decision of Independent Expert**

C. Josef Lamy GmbH

and

Potomac Properties Ltd

1. The Parties:

Complainant: C. Josef Lamy GmbH
Hollerallee 73
28209 Bremen
Germany

Respondent: Potomac Properties Ltd
Suite 4007, 87 Kimber Road
London
SW18 4FS
United Kingdom

2. The Domain Name:

lamyshop.co.uk

3. Procedural History:

On 28 November 2018 the dispute was received, validated and notification of the complaint was sent to both parties. On 17 December a response reminder was sent and on 20 December a response was received and notification of the same was sent to both parties. On 28 December a reply reminder was sent but by 03 January 2019 no reply had been received.

On 07 January a mediator was appointed, and mediation started the next day on 08 January 2019. On 24 January mediation failed and the close of mediation documents were sent to the parties. On 30 January an Expert decision payment was received and the Expert – Tim Brown – was appointed on 05 February.

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.

4. Factual Background

4.1 The Complainant

The Complainant - C. Josef Lamy GmbH - is a manufacturer of pens and other writing instruments. It was founded in 1930 in Germany by the eponymous C Josef Lamy. The company name was changed from Orthos Füllfederhalter-Fabrik to its present name in 1948. The Complainant has been producing writing instruments under the brand name "Lamy" since at least 1952. A summary of the Complainant's history, taken from its website, has been exhibited.

The Complainant's produces over 8 million writing implements per year and its products are sold in over 65 countries around the world. The Complainant has received several awards in relation to its products and a sample of these have been exhibited. The Complainant's turnover in 2016 was more than EUR€110m.

The Complainant has operated websites at www.lamy.de (since 1998) and www.lamy.com (since 2005). Extracts from www.archive.org showing these sites as being active on 06 December 1998 and 22 January 2005, respectively, have been presented by the Complainant. The Complainant has operated a further website at www.lamysshop.com since 2010 and, again, extracts showing this from www.archive.org have been exhibited.

4.2 The Respondent

The Respondent - Potomac Properties Ltd – is a company incorporated in England & Wales in May 2017 with the company number 10795461. The Respondent says that the Domain Name was original purchased by a company called Pirani Investments Ltd t/a Printax, a company incorporate in England & Wales with the number 05172366.

I note that "Pirani" is the Respondent's surname and that both the companies noted above are registered at the same postal address. The Complainant has said that both companies are closely related and the Respondent has not taken exception to this.

I will therefore proceed on the basis that the current registrant - Potomac Properties Ltd – and the original registrant - Pirani Investments Ltd t/a Printax – are controlled by the same person and are, in practical effect, one and the same and I will refer to both collectively as the "Respondent".

The Respondent says that the Domain Name was originally purchased to market the Complainant's products. The Respondent avers that the Domain Name was purchased with the full cooperation of the UK representative for the Complainant as the Respondent was a top tier purchaser of the Complainant's products.

The Respondent narrates that the Complainant became unhappy with the Respondent's shop and asked for it to be closed. The Respondent says that while turnover was high, profit was low, and it therefore decided not to challenge the Complainant's contentions.

The Respondent then stopped paying for the Domain Name's e-shop package with its hosting provider and the Domain Name thereafter reverted to its default settings of pointing to a further web shop operated by the Respondent at www.printax.co.uk. Screenshots of this website have been provided by the Complainant.

4.3 The Parties' relationship

It is clear from the papers before me that the Parties did have a business relationship and it is useful to set this out. I have taken the salient facts from both Parties' submissions.

In 2004, the Respondent took over a business which had been trading as "Printax" and which had held a distributor account with the Complainant. The Complainant has exhibited a letter of introduction from the Respondent to the Complainant dated October 2004. This letter advised the Complainant that it had become the owner of the "Printax" business and that it hoped to carry on doing business with the Complainant as the previous owner had done.

From 2004 to 2015 the Respondent was an authorised retailer of the Complainant's products and a number of purchase orders and invoices between the Parties have been exhibited, alongside archived screenshots showing the website associated with the Domain Name selling the Complainant's products. The Respondent says that the website made clear in multiple places that it was not an official site operated by the Complainant and provided a link to the Complainant's principal website.

From at least November 2013, the previous website at the Domain Name was replaced with a holding page stating that "A new eShop is currently under construction." The business relationship between the Complainant and Respondent ended at some point in 2015.

Around January 2016 a new website branded "Printax" and described as "stationers and full service copy centre" became available at the Domain Name. Screenshots of the current website have been exhibited.

5. Parties' Contentions

I have carefully read both Parties' submissions and reviewed the attached exhibits. I have summarised Parties' salient points where they are relevant to this dispute below.

5.1 Rights – Complainant

The Complainant is the registrant of Community trade mark no. 60681 dated 01 April 1996 for the stylised word "LAMY" in class 16. It is also the registrant of International Registration no. WE1330469 dated 07 September 2016 for the word "LAMYSHOP" in classes 16 and 35. Extracts from the respective trademark databases for the marks have been exhibited.

The Complainant contends that the Domain Name is identical to its LAMYSHOP trade mark, disregarding the domain suffix, and differs from the Complainant's LAMY trade mark only by addition of the generic word "shop". The Complainant avers that the addition of the word "shop" fails to dispel the connection between the Domain Name and the LAMY trade mark; indeed it reinforces the link not only because "shop" implies a location for sale of the Complainant's products but also because the Complainant uses the identical formulation itself in its own domain name, namely www.lamyshop.com.

5.2 Abusive Registration – Complainant

The Complainant avers the Respondent intended, *inter alia*, to prevent the Complainant from reflecting its LAMYSHOP trade mark in a domain name and says that the Respondent must also have known that the Complainant would have wanted to acquire the Domain Name for itself, being the .co.uk equivalent of the Complainant's pre-existing www.lamyshop.com domain name / website.

The Complainant contends that the Domain Name was an Abusive Registration both during the period in which the Respondent was a reseller of the Complainant's products and after the relationship ended.

In terms of the former, the Complainant makes reference to "reseller" cases and refers specifically to the appeal panel in Toshiba Corporation (trading as Kabushiki Kaisha Toshiba D / B / A Toshiba Corporation) v. Power Battery Inc [DRS 7991 - toshiba-laptop-battery.co.uk]. Furthermore, the Complainant refers to the appeal decision in Seiko UK Limited v. Designer Time Wanderweb [DRS 248 - seiko-shop.co.uk] and says the Domain Name will have been confusing in and of itself.

The Complainant says that any such confusion will not have been dispelled when the visitor reached the Respondent's website, saying that Respondent made little effort to distinguish itself from the Complainant. The Complainant says the Respondent's home page appeared to have been branded only with the words "Lamy Fountain Pens & Cartridges".

The Complainant narrates that while there was a disclaimer, this was far from prominent and it is unlikely that most visitors would have taken too much notice of the reference to the site being "the online arm of a London-based stationers & retailer of Lamy Fountain Pens". The Complainant contends that a quick reading of this phrase may imply that the site is the "online arm" of the Complainant.

The Complainant contends that the Domain Name remained an Abusive Registration after the relationship between the Parties ended. The Complainant says that the Respondent was no longer reselling the Complainant's products and the only conceivable purpose of the website associated with the Domain Name was to confuse, attract and profit from internet users by falsely implying a connection with the Complainant.

The Complainant says that while the Respondent has refrained from offering any writing instruments via the website, it still operates in the stationery / printing industry which is obviously closely connected with the Complainant's products and that the Respondent is seeking to capitalise on the Complainant's famous mark accordingly.

5.3 Rights – Respondent

The Respondent contends that the Complaint should be dismissed on the grounds that "Lamy" is not an original name, noting that it is also the name of a town in New Mexico, USA as well as a common surname.

5.4 Abusive Registration – Respondent

The Respondent has set out its relationship with the Complainant (as outlined above) and says that now that the association is over it is looking for further uses of the Domain Name. Such uses include the marketing of Lamy, New Mexico to the general public as "it is a relatively small town and could use the help". The Respondent says it is happy for the Domain Name to resolve to a blank page whilst it creates the site for Lamy, New Mexico.

The Respondent has included a reference to Wikipedia and I note that Lamy, New Mexico is approximately 1.1 square miles in size and had a population of 137 people according to the 2000 census.

6. Discussions and Findings

According to paragraph 2 of the Policy a Respondent must submit to proceedings under the DRS if a Complainant asserts that it 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 Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

I will therefore discuss each of these elements in turn.

6.1 Rights

The Complainant has said that it is the registrant of a trade mark for "LAMYSHOP" and a copy of said mark has been exhibited. As is customary in DRS proceedings, the .co.uk suffix is required only for technical reasons and therefore it can be ignored for the purposes of comparing a domain name to mark.

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

6.2 Abusive Registration

According to Paragraph 1 of the Policy, a domain name is Abusive if it 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 is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

The Parties both agree that there once existed a relationship in which the Respondent acted as a reseller of the Complainant's products and that this relationship has now ended. Such "reseller" cases are common under the DRS and the Complainant has referred to Paragraph 4.8 of the Experts' Overview Version 3 (the "Overview"). The Overview is a document which discusses common issues that arise under the DRS. It is put together by the panel of DRS Experts and includes answers to frequently asked questions and gives an invaluable insight into how Experts have viewed issues that often arise in domain name disputes. It can be found on Nominet's website.

Paragraph 4.8 asks *"Is it possible for a domain name to be abusive, where, despite the fact that it incorporates the Complainant's trade mark, there is no serious risk of any confusion?"* and the answer is extremely pertinent to the present matter and is worth quoting in full:

Yes. It is to be noted that the definition of Abusive Registration condemns not only those domain names, which cause unfair detriment to the Complainant's rights, but also those domain names, which take unfair advantage of the Complainant's rights.

This issue crops up most commonly in the so-called 'reseller' cases, the cases where the domain name registrant is using the domain name to sell the trade mark owner's goods. The generally accepted principles to be derived from the cases, as reviewed by the appeal panel in Toshiba Corporation v Power Battery Inc (DRS 07991) <toshiba-laptop-battery.co.uk> are:

- 1. 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.*
- 2. 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.*
- 3. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.*
- 4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.*

This last point envisages a finding of Abusive Registration in circumstances where there may be no likelihood of any confusion. The use of the domain name for the sale of competing goods was the basis for the finding of Abusive Registration in the Toshiba case, even though a majority of the panel found no likelihood of any confusion ("initial interest confusion" or otherwise). See also the Appeal decision in DRS 16416 (wwe-shop.co.uk) discussing the applicable principles further.

As noted above the Domain Name is identical to the Complainant's registered "LAMYSHOP" trade mark and differs from the Complainant's own online shop's URL by the exchange of the .com top level domain name for .co.uk. I take the view that it is therefore highly likely that web users are likely to be confused by the Domain Name in and of itself. In my view, this alone is enough for the Domain Name to take unfair advantage of or being unfairly detrimental to the Complainant's Rights per paragraph 1 of the Policy and therefore render it an Abusive Registration.

The Complainant has contended that any such confusion will not have been dispelled by the contents of the Respondent's website either before or after the relationship between the parties ended. Having examined the screenshots before me, I agree with the Complainant's view.

While the Respondent was the Complainant's reseller it is possible that it may have had some grounds on which it could possibly legitimately associate itself with the Complainant at that point. However, it is clear that once any relationship came to an end that the Respondent had no right to retain the Domain Name. That the Respondent now uses the Domain Name to sell third party products, unrelated to the Complainant, is clearly unfairly determinantal to the Complainant's Rights and, again, renders the Domain Name an Abusive Registration.

For completeness, I have considered the Respondent's suggestion that it might use the Domain Name to market the New Mexico town of Lamy. Given the context of the Parties' history, previous relationship and use to which the Domain Name is now put, I take the view that any such contention cannot be given much, if any, weight. It appears, on balance, to be a reason that has been artificially created "after the fact" in order to give a air of legitimacy to the Respondent's registration of the Domain Name which simply does not exist.

7. Decision

I find that the Complainant has proved that he has Rights in a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. I therefore direct that the Domain Name is transferred to the Complainant.

Signed

Tim Brown

Dated 11 February 2019