

## **DISPUTE RESOLUTION SERVICE**

**D00021034**

**Decision of Independent Expert**

**Amcol International Corporation**

and

**Max Gattie**

### **1. The Parties:**

Complainant: Amcol International Corporation  
2870 Forbs Avenue  
Hoffman Estates  
Illinois  
60192  
United States

Respondent: Max Gattie  
46 Burlington Street  
Hulme  
Manchester  
M15 6HQ  
United Kingdom

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

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

24 January 2019 10:52 Dispute received  
24 January 2019 11:25 Complaint validated  
24 January 2019 11:31 Notification of complaint sent to parties  
12 February 2019 09:14 Response received  
12 February 2019 09:15 Notification of response sent to parties  
15 February 2019 01:30 Reply reminder sent  
20 February 2019 10:31 Reply received  
20 February 2019 10:32 Notification of reply sent to parties  
20 February 2019 10:34 Mediator appointed  
21 February 2019 12:11 Mediation started  
13 March 2019 12:36 Mediation failed  
13 March 2019 12:36 Close of mediation documents sent  
14 March 2019 09:45 Expert decision payment received

### 4. Factual Background

For almost 28 years the Complainant, its parent and sister companies have used the Bentomat mark in connection with the manufacture and supply of flexible, impermeable barriers. The Complainant owns trade mark registrations for the word mark Bentomat in the UK and around the world. These include UK Trade mark registration 1424766 registered on 13 March 1992 for "*Waterproof membranes for use as ground liners; waterproof membranes comprising clay together with one or more rubber or plastics membranes for use as ground liners, the rubber or plastics predominating.*" There is also an international trade mark registration 883546 designating the European Union and the UK, which was registered on 7 December 2005 in respect of "*flexible water-impermeable barrier sheet comprising bentonite clay retained by fibrous material*".

In addition to its trade mark registrations the Complainant has acquired a reputation in the UK and worldwide for its Bentomat barrier products through its extensive sales, advertising and marketing.

The Respondent recently acquired the Domain Name registration from a third party referred to in this Decision as 'X'.

There is a history of past dealings between X and the Complainant. X resold Bentomat products that he purchased from the Complainant. In summary, in September 2018 the Complainant objected to the allegedly unauthorised use by X of its Bentomat trade marks. The Complainant also objected to X's then ownership and

use of the Domain Name. On 3 December 2018, X undertook to remove the website that the Complainant had complained about, change his company name and not to use the Bentomat mark again. X did however refuse to transfer the Domain Name to the Complainant.

The Respondent has acquired the Domain Name from X. There is some dispute about the date of this transfer, which is discussed below. The Respondent says that he acquired it on 30 November 2018. The Complainant contends that it was transferred to the Respondent after this date.

The Respondent has worked in design and marketing for over 20 years and operates several small enterprises. He intends to use the Domain Name in connection with a prototype mat for the assembly of sushi/sashimi dishes and associated Japanese-style culinary products. The Domain Name is currently being used to resolve to a website. The site makes clear that it is under development. It features photographs of Japanese-style food and refers to;

“Bento Mat  
Japanese style kitchen and dining  
Come back soon see our exciting range for 2019”.

## **5. Parties’ Contentions**

### *The Complaint*

The Complainant asserts Rights in the Bentomat trade mark through its registered rights and the goodwill that has been generated by its extensive use of the mark for almost 28 years.

The Complainant contends that in the hands of X (the previous owner), the Domain Name was an Abusive Registration because it was used in a way which was likely to confuse people or businesses into believing that the Domain Name was connected to the Complainant. Whilst acknowledging that this is not directly relevant to the Respondent, the Complainant submits that this behaviour is part of a pattern aimed at preventing the Complainant from registering the Domain Name.

It is alleged that the Domain Name is also an Abusive Registration in the hands of the Respondent because it was transferred from X to the Respondent to frustrate the Complainant’s registration of the Domain Name and leaves open the possibility that further abuse could occur to disrupt the business of the Complainant. On 16 January 2019, the Complainant emailed the Respondent in the following terms:

“We view this domain as an abusive registration and the transfer as having been made in bad faith in an attempt to frustrate the domain dispute procedure, we told him we were about to file. We also believe that you are holding this domain

knowing of the dispute and on behalf of [X] to assist in that abuse and have no bona fide intention to use the domain.”

The Complainant elaborates on this email making the following submissions in the Complaint:

The Respondent may be a friend or acquaintance of X or someone of whom X has influence.

X selected the Domain Name to benefit from the Complainant’s trade mark and the Respondent knew this.

The Domain Name resolves to a website and this has been done to suggest that the site is intended to be used for a commercial purpose. This is in bad faith and is a false attempt to provide a legitimate reason to own the Domain Name. There is no evidence of any preparations to make such use and the factual situation suggests that there has never been a bona fide intention by the Respondent to use the Domain Name. The Respondent has not before being made aware of the Complainant’s cause for complaint used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services.

The theme of Japanese kitchen and dining has been chosen because “bento” has a meaning relates to a “single portion take-out or home-packed meal common in Japanese cuisine” (definition cited from Wikipedia). However, there is no such thing as a Bento Mat. The Domain Name is not therefore generic or descriptive.

The Complainant also states that a customer searching for the Complainant’s products using the term Bentomat will be presented with the Domain Name and will access the Respondent’s site. They may not be confused after accessing the site, but they will have been led there to the potential benefit of the Respondent and/or the detriment of the Complainant.

#### *The Response*

The Respondent denies having a commercial relationship with X other than the purchase of the Domain Name and states that he has had no previous connections with the Complainant.

He insists that the purchase of the Domain Name was bona fide and was not an attempt to frustrate the Complainant. The Complainant’s dispute with X has no bearing on the Domain Name registration and has nothing to do with the Respondent or his interests.

The Respondent submits that his business has no connection with the Complainant or its business activities. There is no intention to use the Domain Name in the same field of activity as the Complainant. The suggestion that the Respondent will return the Domain Name to X or will repurpose it to operate in the same field as the Complainant is entirely within the Complainant's imagination.

The Respondent says that he is making a legitimate use of the Domain Name and this does not take unfair advantage of nor is it unfairly detrimental to the Complainant's Rights. The term "bento" is a generic term for a Japanese lunchbox. "Mat" refers to bamboo mats used for the assembly of sushi. The juxtaposition of bento and mat in the Domain Name refers to Japanese culinary products. The Respondent is promoting a boutique line of Japanese cookware. Hard evidence is difficult to provide with a start-up venture.

### *The Reply*

The Complainant maintains that the Respondent's business venture is no more than a smokescreen to continue to block the Complainant from registering the Domain Name. No evidence is provided about the terms of the transfer of the Domain Name by X. Evidence would have been easy to provide if it were a genuine transaction and it is notable by its absence.

The submission is that the Respondent knew of the dispute between the Complainant and X when the Domain Name was transferred, and the transfer was consequently in bad faith. The WHOIS entry for the Domain Name was only changed after 8 January 2019. If the Respondent were a genuine purchaser, he would have taken steps to ensure that a change of ownership was recorded immediately. The change was only made after the Complainant had made a WHOIS data request and the change appears to have been done by X. The Respondent says he has no commercial relationship with X but does not deny knowing him. The Respondent does not deny knowledge of the dispute.

The Complainant points out that no evidence is provided about the Respondent's business. One would expect corroborative documentation such as business plans or design drawings. No credible evidence has been provided for the absence of such evidence.

If the Respondent had genuine plans for the Domain Name, arrived at wholly without reference to the rights of the Complainant or knowledge of the dispute with X, it should have produced evidence to show that they were genuine and were not dreamt up simply to defeat the complaint.

The Complainant contends that, even if the Respondent had no knowledge of the dispute and the Complainant, the position does not change that he has not proven a good faith reason to own a domain that is the same as the Complainant's mark. The Domain Name would still be abusive as it is blocking the Complainant from

registering it. It was abusive before transfer and remains so after the transfer (however arms-length/genuine or otherwise it was).

## **6. Discussion and Findings**

The Complainant must establish on the balance of probabilities, that:

it has Rights in respect of a name or mark which is identical or similar to the Domain Name, (as defined in Paragraph 2 of the Policy) and

the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in Paragraph 2 of the Policy).

### Rights

Rights are defined in Paragraph 1 of the Policy as follows;

*"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 Complainant has established that it has Rights in the Bentomat mark. These are conferred by its UK trade mark registrations. It is also clear that the extent of use of the mark by the Complainant over a 28-year period has conferred unregistered Rights in the goodwill that has been generated.

The Complainant's mark is identical to the Domain Name. It being customary to ignore the ".co.uk" suffix.

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

It should be noted that the Rights in the Bentomat mark have been established in relation to the Complainant's established business, namely geosynthetic clay liners. The evidence does not establish that the Complainant's mark is so well known that its distinctiveness carries over into other, unrelated, areas of business. This does not affect the finding of Rights, but it will be relevant to Abusive Registration which is considered below.

### Abusive Registration

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

"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. 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 Complainant has sought to conflate its dispute with the previous owner of the Domain Name, X, with this Complaint. It asserts that the Respondent was on notice of the dispute when it acquired the Domain Name and suggests that he was party to a transaction in bad faith aimed at circumventing the DRS Policy and preventing the Complainant from registering the Domain Name. It also suggests that the submission that the Respondent is preparing to use the Domain Name is a smoke screen also designed to block the Complainant.

There is however no evidence that X and the Respondent are connected or that they have acted in concert. The Expert will accordingly disregard X's activities in this Decision. It may very well have been that X's own conduct in relation to the Domain Name was an Abusive Registration. However, that does not automatically contaminate the Respondent's position if he acquired the Domain Name in good faith and without notice of the previous dispute. If he did, the Complainant's concerns that the Domain Name may be open to further abuse through X's indirect interference falls away.

#### *Acquisition of the Domain Name*

The DRS Policy provides:

A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

- 5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - 5.1.1.1 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;
  - 5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or
  - 5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

The Complainant's case largely rests on its contention that the transfer of the Domain Name did not take place until after the Complainant had brought this to the attention of X's advisers on 8 January 2019. The inference the Complainant draws from this is that the transfer was an attempt to frustrate a complaint to Nominet under the DRS Policy. The Complainant's factual submissions are that following X's refusal to transfer the Domain Name to it in December 2018, the Complainant prepared a Complaint under the Nominet DRS Policy. A data release request was prepared and informed the Complainant that on 8 January 2019 X was still the registrant of the Domain Name. The Complainant was subsequently informed by X's agents that following notification of the data request, X had transferred the Domain Name to a new owner. The Complainant then made a fresh data release request and were informed that the Domain Name was now registered in the Respondent's name. This, the Complainant submits, suggests that the transfer took place on or immediately after 8 January 2019, possibly in anticipation of this complaint to Nominet. The Expert has confirmed with Nominet that the Domain Name was transferred to the Respondent on 8 January 2019.

Correspondence relating to the dispute between X and the Complainant and their respective advisers is exhibited at Annex 2 to the Complaint. Contrary to the assumption that the transfer took place with the intention of frustrating the DRS Complaint against X is a letter dated 4 December 2018 from X's trade mark agent to the Complainant's trade mark agents in which X's agent writes:

“However, I understand that our client is no longer the owner of this domain and it is now in use in relation to a different and unrelated business. As such, any concerns surrounding use of the domain name should be dispelled.”

This suggests that an agreement to transfer the Domain Name was in place on or before 4 December 2018. In its submissions, the Respondent asserts that the Transfer occurred on 30 November 2018.

In considering this issue, regard must be had to the Nominet Terms and Conditions of Domain Name Registration. Clause 7 provides as follows:

7.1 A domain name is not an item of property and has no “owner”.

Clause 11 of the Terms and Conditions includes the following provisions:

11.3 if you want to transfer your domain name to someone else, you must:

11.3.1 use our current published transfer process; .....

11.4 if you do not transfer your domain name in accordance with our published transfer process there will be no valid transfer of your domain name, and no document or agreement attempting or claiming to transfer your domain name will have any effect.



On the balance of probabilities, the Expert finds that there was an agreement to transfer the Domain Name on or before 4 December 2018. Given the Respondent's submission that he acquired the Domain Name on 30 November the Expert accepts that the agreement was between X and the Respondent. The agreement did not transfer ownership because a Domain Name is not an item of property under the Nominet Terms and Conditions. The transfer of the registration occurred on 8 January 2019.

Given that the agreement to transfer was in place on or before 4 December 2018 (over a month before the Complainant's data release request was made) the Complainant's case that the agreement was made primarily to frustrate the Complainant's attempts to register the Domain Name is not established on the balance of probabilities.

Even if the Complainant had been able to establish that the decision to transfer occurred as a result of X being put on notice of the potential Complaint, this would only have constituted an Abusive Registration under Paragraph 1 of the Policy if the Complainant were able to establish that the Respondent and X were acting in concert. However, there is no evidence that the agreement to transfer, or the transfer itself, resulted from anything other than an arms-length transaction between unconnected parties. The Expert acknowledges that the Respondent has provided no corroborative evidence about the terms on which he purchased the Domain Name (beyond asserting that there was no other commercial relationship between X and himself). But he is not required to do so. The onus is on the Complainant to establish its case on the balance of probabilities with cogent evidence. The Complainant's case against the Respondent relies on inference and it is circumstantial. It does not account for the information in the agent's 4 December 2018 letter that the Domain Name had been "transferred" at that time.

The Complainant has also failed to establish that the primary motivation of the Respondent in acquiring the registration amounted to an Abusive Registration. The Respondent states that he has had no previous dealings with the Complainant and there is no evidence that the Respondent acquired the registration with intent to target the Complainant's business or to associate himself with that business.

In contrast, the Respondent has provided a plausible explanation for his acquisition of the Domain Name. It is a good fit for his new business selling a boutique line of Japanese culinary products.

It has not been established on the balance of probabilities that the Respondent acquired the Domain Name with the primary motivation of blocking the Complainant's registration or of unfairly disrupting its business. Accordingly, the Expert does not find that the Respondent's acquisition of the Domain Name was Abusive.

### *Use of the Domain Name*

The Respondent is using the Domain Name in connection with a prototype website that he says will be used to market and sell his culinary products. The Expert visited the website on 29 March 2019. It indicated that it is under development (“come back soon”) but the overall look and feel of the site is stylish.

Paragraph 5 of the Policy provides:

A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows ....

5.1.2 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;

The Complainant has produced no evidence that customer confusion has taken place. In fact, its submissions recognise that on reaching the Respondent’s website a customer may not be confused after accessing the website. The Complainant’s case is that the Respondent is taking unfair advantage of the Complainant’s Rights in the Bentomat mark to attract custom to its website.

Paragraph 8 of the Policy sets out how a Respondent may demonstrate that the Domain Name is not an Abusive Registration. It provides:

A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

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

8.1.1.1 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; ....

8.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it;

The Expert finds that the Respondent has made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods (paragraph 8.1.1.1). The Expert’s finding of demonstrable preparations is based on the information that is to hand, namely the design of the Respondent’s website which has a distinctive look and feel suggesting that an effort has been made to create a

professional image for the new business. The Expert has taken into account the Complainant's submission that there is no evidence that the Respondent's plans are underway and no credible reason for the omission but, on balance, she finds that the prototype website itself is sufficient to provide such evidence. The Respondent has indicated that other evidence will be difficult to obtain because his venture is a start-up business. The Complainant's suggestion that the Respondent's plans have been dreamt up solely to defeat the Complainant are therefore rejected. There is no evidence to support this contention.

However, it has not been established that the Respondent's preparations began before the Respondent was aware of the Complaint as required under paragraph 8.1.1.1. The timing is tight here, but the Respondent could easily have confirmed that his website predated his being placed on notice of the Complaint (which seemed to occur on 16 January 2019), but he has not done so. The Expert accordingly finds that, although there are demonstrable preparations to use the Domain Name in the course of trade, the Respondent has not established that he falls cleanly within paragraph 8.1.1.1 of the Policy.

In relation to paragraph 8.1.2, the Expert does not find the Bentomat mark to be generic or descriptive of the Respondent's intended project range. "Bento" and "mat" are both terms commonly used in connection with Japanese cookery, as the parties appear to agree. However, the juxtaposition of the terms is syntactically unusual. This creates a new combination which has brand significance in the sense that it is capable of distinguishing the Respondent's culinary products from generic bento lunch boxes or culinary mats that are produced by other businesses. The Respondent cannot therefore avail himself of paragraph 8.1.2 of the Policy. The Bento mat mark is a clever and appropriate choice of brand for the new venture given the nature of the product line he will be selling.

Paragraph 8.1.1.1 and 8.1.2 are non-exhaustive factors that would show that use of a Domain Name is not abusive. Ultimately, the decision on Abusive Registration turns on whether the Respondent's website and business venture are taking unfair advantage of the Complainant's Rights or is causing unfair detriment to it.

### *Unfair Advantage*

On the one hand, the Domain Name is a made-up word which raises at least an inference that it will be associated with the Complainant as its originator. The Expert accepts that there is a high level of brand recognition associated with the Complainant within its established (and related) specialised fields of activity. On the other hand, the Complainant has not produced evidence which would show that its association with Bentomat transcends this field of business. The trade mark registrations are limited to waterproof membranes and flexible water-impermeable barrier sheets. There is no evidence to suggest that the mark has acquired the status of a well-known mark that has come to be associated with the Complainant on non-similar products. The dissimilarity in the Parties' products means that there can be

no automatic finding that the Respondent will be taking advantage of the Complainant's Rights by using the Domain Name in a non-related business sector.

Where a customer is aware of the Complainant's mark there may be initial interest confusion, but it is extremely unlikely that someone looking for geosynthetic clay liners will be diverted into purchasing a sushi mat or a similar culinary product.

On the other hand, the Respondent has given a plausible explanation for his acquisition of the Domain Name which suggests that it is an appropriate freestanding brand for his new venture which is not dependent on associations with the Complainant for its impact.

Based on these facts the Expert finds on the evidence before her that the Respondent's use of the Domain Name does not take unfair advantage of the Complainant's Rights.

#### *Unfair Detriment*

The remaining question is whether the fact that the Complainant is blocked from registering the Domain Name is causing unfair detriment to its Rights. The Complainant is concerned that further abuse could occur, or the Domain Name could be transferred back to X. On the Expert's findings, the Respondent was a bona fide transferee of the Domain Name without notice of the dispute with X. He has a plausible reason for the choice of name and has prepared to use it in the course of trade for a business that is unrelated to the Complainant's field of activity. There is negligible potential for confusion between the Complainant and the Respondent on the facts and it has not been established that the Respondent is acting in concert with X nor that there is any specific reason to suggest that abuse will occur.

Considering these facts, the Expert finds that the Complainant is not suffering unfair detriment as a result of the Respondent's registration or current use of the Domain Name.

Of course, in future should the Respondent use the Domain Name in a way that takes unfair advantage of the Complainant's Rights or causes unfair detriment to them it will be open to the Complainant to make a new complaint to Nominet. This Decision has been arrived at on the evidence available to the Expert at the current time.

## **7. Decision**

The Complainant has established on the balance of probabilities that it has Rights in respect of a name or mark which is identical or similar to the Domain Name, but it has not established on the balance of probabilities that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complainant's request for transfer is accordingly refused. The Domain Name will remain in the hands of the Respondent.

**Signed:** Sallie Spilsbury

**Dated** 9 April 2019