

DISPUTE RESOLUTION SERVICE

D00021190

Decision of Independent Expert

Atrium Innovations Inc.

and

Tamas Butkovics

1. The Parties:

Lead Complainant: Atrium Innovations Inc.
1405 Boulevard du Parc-Technologique
Quebec City
Quebec
G1P 4P5
Canada

Second Complainant: Nestlé S.A.
avenue Nestlé 55
Vevey
1800
Switzerland

Respondent: Tamas Butkovics
VitaFree Health Ltd
4 Green Wall
Lewes
East-Sussex
BN7 2NX
United Kingdom

2. The Domain Name:

gardenoflife.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

07 March 2019 11:48 Dispute received
07 March 2019 12:12 Complaint validated
07 March 2019 12:21 Notification of complaint sent to parties
07 March 2019 15:25 Response received
07 March 2019 15:25 Notification of response sent to parties
12 March 2019 01:30 Reply reminder sent
15 March 2019 11:33 No reply received
15 March 2019 11:38 Mediator appointed
20 March 2019 11:35 Mediation started
18 April 2019 16:29 Mediation failed
18 April 2019 16:30 Close of mediation documents sent
03 May 2019 02:30 Complainant full fee reminder sent
07 May 2019 09:47 Expert decision payment received
07 May 2019 Keith Gymer appointed as Expert with effect from 10 May 2019

4. Factual Background

The Lead Complainant, Atrium Innovations Inc., is based in Canada. Its business is in the development, manufacturing, and commercialisation of science-based nutritional health products. It operates a website at www.atrium-innovations.com.

Established in 2000, "GARDEN OF LIFE" is one of the Lead Complainant's brands. The brand is used in relation to whole food, certified organic and non-GMO nutritional supplements and vitamins. The Lead Complainant operates a website for this brand at www.gardenoflife.com, from which it sells its products globally.

The Lead Complainant is the owner of a number of registered trade marks for GARDEN OF LIFE, including:

UK 2358736 GARDEN OF LIFE – Classes 5 & 44
- filed 19 March, 2004, registered 22 October, 2004

UK 2358953 Garden of Life (figurative mark) – Classes 5 & 44



- filed 22 March, 2004, registered 17 September, 2004

The Second Complainant, Nestlé S.A., is a transnational food and drink company headquartered in Vevey, Switzerland. The Second Complainant acquired the First Complainant for USD\$2.3 billion in 2017.

Whilst the Lead Complainant is the registered proprietor of the registered marks at the date of filing of this Complaint, these marks are in the process of being transferred to the Second Complainant. It is possible that the transfer will take place during this DRS procedure.

Therefore, in order to avoid any doubt about ownership of the related Rights at the point the Expert makes a decision, the Complainants have brought this Complaint in joint names. [Expert's note: Unless otherwise expressly indicated, subsequent references herein to "the Complainant" refer to the Lead Complainant and its rights at the time of filing of the Complaint.]

The Respondent, Tamas Butkovics, is a director of VitaFree Health Limited., (UK Co. No. 7382648) incorporated in September 2010. The Respondent registered the Domain Name on 6 February 2011. When entered in a browser, the Domain Name redirects to the Respondent's company website at www.vitafreeonline.co.uk, where GARDEN OF LIFE branded products and others are offered for sale.

5. Parties' Contentions

Complainant

The Complainant asserts that it has Rights in the term "GARDEN OF LIFE" (including registered trade marks, as identified in Section 4. above) and that the Domain Name is identical to its GARDEN OF LIFE trade mark. The Complainant notes that such registered rights clearly predate the registration of the Domain Name by the Respondent. Further, the Complainant says that the term "GARDEN OF LIFE" has no commonly used generic or descriptive meaning. To demonstrate this, the Complainant has exhibited a search for the term "GARDEN OF LIFE" on the search engine Google.com and noted that all the results relate to the Complainant and its products.

Disregarding the <.co.uk> suffix, the Domain Name is otherwise identical to the Complainant's mark. Accordingly, the Complainant claims to have Rights in respect of a name or mark which is identical to the Domain Name as required under Paragraph 2.1.1 of the DRS Policy.

The Complainant makes a number of contentions in support of its claim that the Domain Name is also an Abusive Registration under Paragraph 2.1.2 of the DRS Policy.

Use of the Domain Name is liable to confuse people or businesses into believing that the Domain Name is connected with the Complainants (cf. Paragraph 5.1.2 of the DRS Policy) [Expert's note: *not* 5.1.1.2 as mistakenly indicated in the Complaint].

The Complainant believes that website visitors will suffer "initial interest confusion", noting that when web users are redirected to the Respondent's web site they are shown a large heading entitled "Garden of Life / vitamins and proteins" and a copy of the Complainant's "Garden of Life" logo. When web users navigate to the Respondent's shop they are presented with a variety of products, including those of the Complainant, and of unrelated, third parties.

The Complainant points out that the Respondent is not, and has never been, an authorised reseller of its products and that the Respondent has not received any approval or permission to use the Complainant's brands or marks, including its GARDEN OF LIFE mark. The Respondent's website also does not include any express disclaimer, and neglects to set out the relationship (or, more accurately, non-relationship) between the Parties in any way.

The Complainant submits that consequently it is reasonable to infer from such use, and the nature of the Domain Name itself (and regardless of whether or not the Domain Name is used for web or email services), that a substantial number of people will be confused into believing that the Domain Name is owned, controlled or endorsed by the Complainant.

The Complainant further makes reference to Paragraph 4.8 of the DRS Experts' Overview, and specifically to the prior DRS Decision in Toshiba Corporation v. Power Battery Inc. [DRS 07991 <toshiba-laptop-battery.co.uk>], addressing the question whether or not it is necessarily unfair for a reseller to incorporate a Complainant's trade mark into a Domain Name.

In summary, the Complainant avers that: the Domain Name is identical to the Complainant's mark rather than being merely incorporated into a clearly distinguishable domain name; the Respondent is not and has never been an authorised reseller of its products; the website associated with the Domain Name offers third party goods for sale; there is no express disclaimer to make it clear to web users that the website is not associated with, or endorsed by, the Complainant.

Consequently, these factors, taken singly or cumulatively, demonstrate that, on balance, the Respondent's use of the Domain Name is unfair.

The Complainant goes on to consider the possible factors, as exemplified under Paragraph 8.1 of the DRS Policy, which might otherwise be considered to demonstrate that the Domain Name is not an Abusive Registration.

Specifically, the Complainant dismisses the possibility that the Respondent could reasonably claim that any of the factors identified under Paragraphs 8.1.1 and 8.1.2 of the DRS Policy might apply to justify its use of the Domain Name

Remedy Requested

The Complainant requests transfer of the Domain Name.

Respondent

The Respondent states that Vitafree Health Limited registered the Domain Name on 6 February 2011 in order to support its sales of Garden of Life products. The Garden of Life product images and logo are used in the website to promote the brand.

As the business is selling Garden of Life products on its website, the Respondent submits that the Domain Name cannot be misleading, as it shows the portfolio of Garden of Life products, which it stocks, and which people can order from it.

The Respondent itself buys the Garden of Life products from authorised resellers in the UK, so this business cannot be challenged.

It is acknowledged that <gardenoflife.co.uk> is redirected to <vitafreeonline.co.uk> and acts as an alias domain at the moment.

The Respondent says that its VitaFree website indicates clearly that it is owned by Vitafree Health Limited, and it is not associated with any company behind the Garden of Life brand.

For these listed reasons, the Respondent cannot see any problem regarding the ownership and usage of the Domain Name, however the Respondent is ready to consider the transfer of ownership of the Domain Name in case an offer is coming from the Complainant.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration

Under Paragraph 18.1 of the Policy, the Expert is required to decide a complaint on the basis of the Parties' submissions and the Policy.

Complainant's Rights

The Complainants have provided evidence of valid UK trade mark registrations, dating from 2004, demonstrating rights in the mark GARDEN OF LIFE.

The disputed Domain Name is "gardenoflife.co.uk".

The absence of spaces in the Domain Name is immaterial, as it will clearly still be read by any English reader as identical to the Complainant's mark (the domain suffixes ".co.uk" are not in this case relevant to the comparison).

The Expert therefore finds that the Complainant has relevant Rights in a name or mark, which is identical to the Domain Name. The requirement of Paragraph 2.1.1 of the Policy is met.

Abusive Registration

The Complainant also must show that the Domain Name 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. 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.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 5 of the Policy. Paragraph 5.1.2 is most relevant to the Complainant's case:

- 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;

Conversely, Paragraph 8 of the Policy provides observations on "How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration", of which the following might have been pertinent:

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;

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

8.1.1.3 made legitimate non-commercial or fair use of the Domain Name.

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

The factors listed in Paragraphs 5 and 8 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

The Expert considers that the Complainant's references to Paragraph 4.8 of the Experts' Overview and, in particular, to the decision in Toshiba Corporation v Power Battery Inc [DRS 07991, <toshiba-laptop-battery.co.uk>] are indeed pertinent to this case. That decision sets out four general principles typically applicable to situations where a reseller has registered a domain name which incorporates a supplier's trade mark:

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.

In the present case, the Domain Name incorporates the Complainant's trade mark identically and in the same format as used by the Complainant for its own .com website. The Domain Name redirects to the VitaFree corporate website which prominently displays the Complainant's trade mark logo and products. That website also offers third party products for sale. Whilst that website does identify VitaFree

Health Limited as the website operator, it provides no express disclaimer of its relationship (or not) with the Complainant's business.

It is not clear whether or not the Respondent operates any email services using the Domain Name but, if it does, there must inevitably be a significant risk that any customers or potential customers of the Complainant might well address emails to <name@gardenoflife.co.uk> rather than <name@gardenoflife.com> with the consequence that emails intended for the Complainant would be misdirected to the Respondent. Whilst there is no suggestion that the Respondent has attempted any intentional "phishing" using the Domain Name, the risk of such misuse (which has certainly been exploited by registrants of domain names using trade marks for financial service businesses) is one strong reason that use by an unrelated party of a domain name which is identical to another party's trade mark in the same line of business is potentially liable to be considered as abusive and unfair under the DRS Policy.

The Respondent's business evidently purchases Garden of Life products from one or other of the Complainant's authorised UK distributors, for legitimate onward resale to the Respondent's customers in the UK. There is no reason to question the legitimacy of such activity.

However, with regard to use of the Domain Name, on balance, the Expert considers the Complainant's arguments to be persuasive in that there is very likely to be customer confusion about the nature of the Respondent's relationship (or not) with the Complainant (including, for example, whether or not the Respondent's business might be owned or controlled by the Complainant, or otherwise specially authorised to register and use the Complainant's trade mark in a UK domain name). Consequently, the Respondent's registration and use of the Domain Name, in the absence of the Complainant's specific authorisation, takes unfair advantage of the Complainant's Rights, and the factors listed under Paragraph 8 of the DRS Policy are not applicable.

For these reasons, the Expert holds that the Domain Name is an Abusive Registration for the purposes of the DRS Policy and that the requirement of Paragraph 2.1.2 of the DRS Policy is met.

7. Decision

Having found that the Complainant has relevant Rights and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert orders that the Domain Name be transferred to the Lead Complainant as the registered proprietor of the cited UK trade mark registrations for the GARDEN OF LIFE marks at the date of this decision.

Signed
Keith Gymer

Dated 30 May 2019