

DISPUTE RESOLUTION SERVICE

D00009245

Decision of Independent Expert

VKR Holding A/S

and

Mr Rob Livesey

1. The Parties:

Lead Complainant: VKR Holding A/S
VKR Holding A/S
Breltevej 18
Hørsholm
2970
Denmark

Respondent: Mr Rob Livesey
Kingfisher Court
South Lancs Industrial Estate
Bryn
Lancs
WN4 8DY
United Kingdom

2. The Domain Name(s):

www.econoloft-velux.co.uk

3. Procedural History:

02	November	2010	16:35	Dispute received
03	November	2010	12:03	Complaint validated
03	November	2010	12:10	Notification of complaint sent to parties
10	November	2010	11:30	Response received
10	November	2010	11:42	Notification of response sent to parties

18	November	2010	12:37	No reply received
18	November	2010	12:37	Mediator appointed
26	November	2010	14:33	Mediation started
01	February	2011	17:29	Mediation failed
08	March	2011	14:33	Close of mediation documents sent
24	March	2011	12:22	No expert decision payment received
13	April	2011	16:32	Expert decision payment received

4. Factual Background

- 4.1 The Complainant is a company incorporated under the laws of Denmark, and is the owner of the VELUX Group which manufactures roof windows and related accessories.
- 4.2 The Complainant carries on business as a designer, manufacturer and importer into the United Kingdom of its VELUX roof windows and other products. It has a presence in other countries throughout the world.
- 4.3 The Complainant has trademarked the name VELUX in various jurisdictions - including the UK trademark No. A691115 (for the word VELUX, registered July 28, 1950) and the Community trademark No. 955609 (for the word VELUX, registered March 31, 2000) (the 'Marks').
- 4.5 The Complainant is the owner of various domain names which incorporate the name VELUX (the 'Name') (including - www.veluxblindsdirect.co.uk; www.velux-blinds.co.uk; www.veluxwindowblinds.co.uk; www.velux.co.uk; and, www.veluxblindsuk.co.uk).
- 4.6 The Domain Name was registered by the Respondent, for use on behalf of a loft conversion company, on 5 November 2007.

5. Parties' Contentions

Complainant:

- 5.1 In summary, the Complainant argues that the Domain Name should be transferred to it because:
- it has Rights in respect of the Name and related Marks that are in effect identical (or at least similar) to the Domain Name.

The Complainant has trademarked the Name in the United Kingdom and the European Union (referred to at paragraph 4.3 above).

The distinctive element of the Domain Name is the Complainant's "well-known" Name and Marks. The prefix 'econoloft-' does not sufficiently distinguish the Domain Name from the Marks. The Domain Name incorporates the Name in which the Complainant has established Rights.

VELUX is a “made-up” word created by the Complainant and is distinctive of the line of products it is used for and is not in any way descriptive.¹

Since 1941, the products of the Complainant have been advertised and sold in the UK. Furthermore, the Complainant promotes its name through sponsorship of events (such as the VELUX 5 Oceans Race, a round-the-world single-handed yacht race).

As a result of the scale of the use and advertising of the Marks, the Name associated with the Marks has become a household name and is recognised by a substantial proportion of the population of the UK as indicating the Complainant’s companies or goods connected in the course of trade with the Complainant.

- The Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in the Nominet DRS Policy (the ‘Policy’).

The Rights were well-known long before the registration in 2007 of the Domain Name by the Respondent, and the Respondent would have been aware of those Rights at the time of that registration.

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 (DRS Policy, paragraph 3(a)(ii)).

The Domain Name was first used by the Respondent to set up a website which offered for sale DVDs and other electronic equipment and has subsequently been used as a portal leading to the Respondent’s own website www.econoloft.co.uk.

The Domain Name is currently ‘parked’ on a domain parking facility administered by UKREG (ukreg.com). The website on which the Domain Name is parked (the ‘Website’) contains sponsored links directing web users, including potential customers of the Complainant, to the websites of other businesses offering their own goods and services.

Potential customers of the Complainant may visit the website attached to the Domain Name and end up clicking on the sponsored links. This is likely to cause damage to the Complainant as a result of reduced internet traffic to its own websites and, ultimately, lost sales.

Also, the purpose of the sponsored links, such as those found on the Domain Name’s parking site, is to generate revenue for the Respondent. It can be inferred that these links will generate revenue for the Respondent on a pay-per-click basis and/or save the Respondent

¹ See Annex E, Nominet Decision DRS 06973.

hosting fees. Accordingly, the use of the Domain Name in this way takes unfair advantage of the Complainant's Rights.

As such, the use of the Domain Name in this way is likely to confuse people or businesses into believing that the businesses advertised by the sponsored links on the Domain Name are registered to, operated or authorised by, or otherwise connected with the Complainant. This is detrimental to the Complainant's Rights as well as its reputation, particularly if the goods or services supplied by the third-party businesses advertised do not meet the high standards expected of the Complainant.

Accordingly, the use of the Domain Name in this way is detrimental to the Complainant's Rights.

Respondent's response:

5.2 The Respondent responded that it has not and does not use the Domain Name and agrees "for the transfer [of the Domain Name] to the other party".

Complainant's Reply:

5.3 The Complainant did not reply.

6. Discussions and Findings

General

6.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the DRS policy (the 'Policy') that, on the balance of probabilities (that is, the Complainant's case is more likely than not to be the true version²):

"(i) The Complainant has Rights in respect of a name or mark identical or similar to the Domain Name; and,

(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration."

6.2 Addressing each of these limbs in turn:

i) Complainant's Rights

6.3 Paragraph 1 of the Policy defines 'Rights' 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;"

² <http://www.nominet.org.uk/disputes/drs/legalissues/>.

- 6.4 The Complainant must have the Rights at the time of the complaint.
- 6.5 The Expert notes that, as referred to at paragraph 4.3 above, the Complainant is the proprietor of a number of Marks in respect of the name 'VELUX', and through advertising campaigns and general longevity (noting that one of the UK trademarks was registered in 1950), has developed considerable goodwill and reputation in the Marks (and also in the Name).
- 6.6 Further, and in agreement with the Complainant, on the balance of probabilities, the prefix "econoloft" or the following hyphen do not sufficiently distinguish the Domain Name from the Marks/Name. (The hyphen in the Domain Name being "essentially irrelevant" in determining and similarity between the Domain Name and the Marks.³) And thus, they should be discounted from the consideration of whether the Domain Name is identical or similar to the Complainant's Marks/Name.
- 6.7 Given those factors, as well as the fact that the requirement to demonstrate 'Rights' is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that at the time of the Complaint, the Complainant had Rights in the Marks/Name, which are similar to the Domain Name. (In concluding the above, the Expert has also disregarded the domain suffix 'co.uk'.)

ii) Abusive Registration

- 6.8 The Expert has considered whether the Domain Name, in the hands of the Respondent, is an Abusive Registration as understood by Paragraph 2 a. ii. of the Policy.
- 6.9 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;"*
- 6.10 In relation to (i) above – the Expert considers there was an Abusive Registration at the time the Domain Name was registered.
- 6.11 The Policy at Paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Policy sets out at Paragraph 3 a. C. that a factor which may be evidence that the Domain Name is an Abusive Registration is circumstances

³ *Parasols Direct v. Cushions Direct Limited*, DRS 00008850 (September 30, 2010).

indicating that the Respondent has registered the Domain Name primarily: “for the purpose of unfairly disrupting the business of the Complainant.”

- 6.12 Given the goodwill and reputation in the Marks/Name, as described for example at paragraph 6.5 above, the Expert agrees with the Complainant that on the balance of probabilities the Respondent would have been aware of the Complainant and its Marks/Name at the time of registration of the Domain Name in 2007.
- 6.13 Further, the Expert is satisfied that the Respondent chose the Domain Name to benefit from the goodwill in the Marks/Name. The Respondent among other things converts lofts to living spaces, and as such (and as indicated in the correspondence between the parties provided to the Expert as an Exhibit to the Complaint), would have known about the Marks/Name as it used the Complainant’s windows to carry out its services.
- 6.14 Thus, the Expert considers that, in this way, the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant’s Rights.
- 6.15 In relation to (ii) above – the Expert considers there was an Abusive Registration through the use by the Respondent of the Domain Name.
- 6.16 The Policy sets out at Paragraph 3 (a) (ii) that:
“[there may be evidence of an Abusive Registration if there are] Circumstances indicating that the Respondent is using [...] 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.”
- 6.17 As evidenced by a Website print-out provided to the Expert, the Respondent has used the Website to offer for sale DVDs and other electronic equipment. Also, albeit evidenced in correspondence between the Parties (and not as a print-out of the Website), the Expert considers that the Respondent has used the Website as a portal leading to the Respondent’s own website at www.econoloft.co.uk.
- 6.18 The Complainant also refers to the Website, at the time of the Complaint, being ‘parked’ on a domain parking facility administered by UKREG (ukreg.com), but no evidence was provided by the Complainant of this. Also, the Expert checked the Website as of the date of his decision but the Website did not show such use. That said, this decision does not turn on this fact and it is sufficient that at least the Respondent used the Website to direct click-through traffic to its website.
- 6.19 On the balance of probabilities, the Expert considers that such representations by the Respondent would have confused and are likely to confuse those accessing the Website into believing that the Domain Name (and the goods offered for sale on the Website through the click-through

mentioned above) are those of the Complainant or are at least authorised by the Complainant: which is not the case.

- 6.20 In this way, the Respondent has taken unfair advantage of the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the Marks/Name in order to generate the web traffic to the Website, and looking to generate traffic to its website on the back of that.
- 6.21 Such use of the Domain Name is also unfairly detrimental to the Complainant as the use of the Website in the way described above has diverted Internet traffic away from the Complainant's website, and thus the Complainant has lost possible sales income.
- 6.22 The Expert has considered whether there is evidence before him to suggest that any of the factors listed at Paragraph 4 of the Policy demonstrate that the Domain Name is not Abusive Registrations but does not consider any are relevant.
- 6.23 Finally, the Expert notes that the Respondent in its response agreed that the Domain Name should be transferred to the Complainant. It is unfortunate that the Respondent did not then take the necessary action to do this, thus leading to this decision.

7. Decision

- 7.1 Accordingly, the Expert finds, on the balance of probabilities, that the Complainant has Rights in a Name and Marks that are similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed Dr Russell Richardson

Dated 26 May 2011