

DISPUTE RESOLUTION SERVICE

DRS 010898

Decision of Independent Expert

Cosmetica Cosbar, S.L.

and

Mr Andrew Carr

1. The Parties:

Complainant:

Cosmética Cosbar S.L.
Vall d'Aran 15
El Prat del Llobregat
Barcelona
08820
Spain

Respondent:

Mr Andrew Carr
8 Millbeck Close
Off Leventhorpe Lane
Bradford
West Yorkshire
BD8 0EZ
United Kingdom

2. The Domain Name:

<montibello.co.uk> (“the Domain Name”)

3. Procedural History:

09 February 2012 13:24 Dispute received
10 February 2012 12:33 Complaint validated
10 February 2012 12:55 Notification of complaint sent to parties
05 March 2012 08:10 Response received
05 March 2012 08:10 Notification of response sent to parties
13 March 2012 09:04 Reply received
13 March 2012 09:05 Notification of reply sent to parties
13 March 2012 09:06 Mediator appointed
15 March 2012 10:54 Mediation started
20 March 2012 14:44 Mediation failed
20 March 2012 15:57 Close of mediation documents sent
29 March 2012 09:51 Expert decision payment received

4. Factual Background

The Complainant is a Spanish company. It sells cosmetic products under the mark MONTIBELLO in the UK and throughout Europe. It sells only to professional beauticians and hairdressing salons through approved distributors.

The Complainant is the proprietor of various trade mark registrations for the mark MONTIBELLO, and other marks incorporating or similar to that term, dating from 2005. These include Community Trade Mark number 5632476 for MONTIBELLO registered on 12 February 2008, in various Classes, for cosmetic products and other goods and services related to those products.

The Respondent was an appointed UK distributor of the Complainant's goods from 2006. He registered the Domain Name on 10 November 2006. He ceased to be a distributor in about February or March 2011. Upon the termination of the relationship, a dispute arose between the parties concerning the repurchase of unsold stock by the Complainant and the transfer of the Domain Name by the Respondent.

According to a screenshot obtained by Nominet, at the date of the Complaint the Domain Name resolved to a 'directory' website which included links to organisations trading under the name 'Montebello' and similar names.

5. Parties' Contentions

The Complaint

The Complainant submits that the Domain Name is identical to its registered trade mark MONTIBELLO.

It further submits that its marks are used extensively throughout Europe and are known to the purchasing public. It provides evidence of trade fair stands, promotional materials and invoices.

The Complainant submits that the Domain Name in the hands of the Respondent is an Abusive Registration. The Respondent had no right to register the Domain Name in his own name in the first place, but while the parties had an agreeable commercial relationship the Complainant made no objection. Now that the relationship has ended, and the Complainant wishes to appoint a new UK distributor, it is abusive for the Respondent to refuse to transfer the Domain Name. Furthermore, the Respondent agreed to transfer the Domain Name to the Complainant but has failed to do so.

The Complainant submits that the continued use of the Domain Name by the Respondent is abusive because it threatens to disrupt the Complainant's business. In particular:

- (1) it would prevent any future UK distributor from using the Domain Name to develop the UK market; and
- (2) it will create confusion in the marketplace as customers will inevitably believe that the Domain Name is owned or controlled by the Complainant.

The Complainant makes no submissions concerning the Respondent's current use of the mark, save that the Respondent is refusing to transfer it.

The Complainant seeks a transfer of the Domain Name.

The Response

The Respondent states that he registered the Domain Name before his company was appointed as the Complainant's distributor. The Complainant exported to the UK before his company was appointed, yet the Complainant failed to register the Domain Name at that time. The Respondent purchased the Domain Name "in good faith as an individual" as it was readily available.

Furthermore, the Complainant has allowed other similar domain names to be registered, e.g. <montibello.eu> which was registered by a Polish hairdressing company. Nor has the Complainant registered other available names such as <montibello.org> and <montibello.net>.

The Complainant made no objection to the Respondent's registration and use of the Domain Name until after the relationship between the parties was terminated. Furthermore, all the Complainant's distributors use ".com" domain names.

The name Montibello is "mentioned on the internet several times" in connection with unrelated products (the Respondent does not provide examples). The Respondent intends to use the name in connection with the import of wine from South Africa.

The Complainant agreed to repurchase stock worth £10,000 from the Respondent, but reneged on that agreement and also introduced the transfer of the Domain Name as a condition. The protection of the brand is not the Complainant's genuine objective.

The Complainant has offered to buy the Domain Name for EUR 1,000, which demonstrates that there is no substance to its claims.

The Complainant never contributed financially to the promotional or marketing activity under the Domain Name and can not therefore claim to be entitled to the name.

The Respondent had no involvement with the skincare sector prior to his dealings with the Complainant and has had none since. His activities will not therefore pose any threat to their brand.

The Reply

The Complainant states that the parties first met in 2005 and that the Respondent placed his first order in January 2006. Clearly the Respondent knew of the Complainant's trade mark when he registered the Domain Name and cannot claim to have registered it in good faith.

The Complainant disputes the relevance of the Respondent's other arguments. The Domain Name was registered by the Respondent in the light of the commercial relationship between the parties and for the purpose of selling the Complainant's goods. Now the relationship has been terminated, the Domain Name should be transferred.

6. Discussions and Findings

This Complaint falls to be determined under the Nominet Dispute Resolution Service Policy ("the Policy") and the Nominet Dispute Resolution Service Procedure ("the Procedure"). Under paragraph 2 of the Policy:

- "(a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, 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.**
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."*

Under paragraph 1 of the Policy the term "Rights":

“includes, but is not limited to, rights enforceable under English law...”

Also under paragraph 1 of the Policy, the term “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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 sets out a non-exhaustive list of factors that may be evidence that it is not. However, all these factors are merely indicative of, and subject to, the overriding test of an Abusive Registration as set out above.

Rights

The Complainant has established that it has registered trade mark rights in the mark MONTIBELLO, including Community Trade Mark number 5632476 registered on 12 February 2008, in various Classes.

Ignoring the formal suffix “.co.uk” the Domain Name is identical to the Complainant’s mark.

Accordingly, the Complainant has established for the purposes of paragraph 2 of the Policy that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

The Respondent claims that he registered the Domain Name “in good faith as an individual” prior to any formal appointment as the Complainant’s distributor. The Complainant disputes this, stating that the Respondent had met the Complainant and placed an order prior to registering the Domain Name. In my view the precise chronology is unimportant as it is clearly to be inferred that the Respondent knew of the Complainant’s brand and registered the Domain Name with the Complainant and its goods in mind. Furthermore, the Respondent used the Domain Name to sell the Complainant’s goods in the UK as its distributor for a period of five years.

The term “montibello” is distinctive in nature and the Complainant has provided evidence that it is distinctive of the Complainant’s goods. There is no evidence that the term is generic or merely descriptive. While the Respondent states that there are unrelated references to the term on the internet, he does not provide details. The Domain Name consists of the term “montibello” in an unadorned form with the suffix “.co.uk”. In the circumstances, on the evidence available to me,

including the evidence of the use made of the Domain Name since registration, I find that there is a significant likelihood that an internet user typing the URL www.montibello.co.uk, or clicking on a search result comprising that URL, will do so in the expectation of finding the Complainant's website or a site authorised by the Complainant.

In the light of this, I find that the circumstances set out in paragraph 3(a)(ii) of the Policy are present in this case, 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.”

This conclusion follows from the nature and prior use of the Domain Name and, in this particular case, I do not consider the Respondent's present or likely future use of the Domain Name to be significant. The Domain Name consists of the Complainant's trade mark in an unadorned form. There is no evidence that the Domain Name has any association other than with the Complainant and its goods and it is not clear to me how the Respondent could now make any legitimate use of the name without the Complainant's consent. The Respondent provides no explanation of why he would intend to use this, rather than any other, domain name in connection with the import of South African wines.

I also accept the Complainant's contention that the Respondent's continuing use of the Domain Name prevents any new UK distributor of the Complainant's goods from using that name. In the circumstances, the Respondent's retention of the name has the effect of blocking the Complainant's or its distributors' legitimate future use of the Domain Name.

So far as the Respondent's contentions are concerned, I do not consider it to be relevant that the Complainant made no objection to the Respondent's registration and use of the Domain Name prior to the termination of the parties' commercial relationship. While that relationship continued, the Respondent used the Domain Name with the Complainant's tacit if not express consent. Upon the termination of the relationship that consent was withdrawn.

The Respondent argues that the Complainant did not contribute financially to the promotion of the Domain Name, but absent any agreement to the contrary, any financial investment in the name by the Respondent was at the Respondent's own risk.

Nor do I consider it relevant that the Complainant did not register other domain names including the term “montibello” or may not have pursued complaints against other parties. The point of significance is that the Domain Name, which is the subject-matter of this Complaint, is being used in a manner which is likely to cause confusion and/or to block the Complainant's future use of the Domain Name.

The merits of the dispute between the Complainant and Respondent concerning the repurchase of stock are beyond the scope of this procedure. There is no evidence of any agreement by the Complainant to purchase the Domain Name. It is clear that the Complainant did offer to pay the Respondent EUR 1,000 for the Domain Name as an alternative to commencing this Complaint. In my view this was an attempt to resolve the matter on a commercial basis and is not, as the Respondent claims, evidence that the Complainant has no case.

I conclude in all the circumstances that, since the date of termination of the commercial relationship between the parties, the Respondent has used the Domain Name in a manner that took unfair advantage of or was unfairly detrimental to the Complainant's rights. Accordingly, the Domain Name in the hands of the Respondent is an Abusive Registration.

7. Decision

The Complainant has established for the purposes of the Policy that it has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly the Complaint succeeds and I direct that the Domain Name <montibello.co.uk> be transferred to the Complainant.

Signed: **Steven A. Maier**

17 April 2012