

## **Dispute Resolution Service**

**DRS 16466**

### **Decision of Independent Expert**

**REPI S.p.A**

and

**Nick Thompson**

#### **1. Parties**

Complainant : REPI S.p.A.  
Via Beniamino Franklin, 2  
LONATE CEPPINO (VA)  
21020  
Italy

Respondent : Mr. Nick Thompson  
7 Moor Mead Road  
Twickenham  
Middlesex  
TW1 1JS  
United Kingdom

#### **2. Domain Name**

repi.co.uk (the "Domain Name")

### **3. Procedural Background**

On 3<sup>rd</sup> September 2015 the Complaint was lodged with Nominet UK Limited (“Nominet”) and on 4<sup>th</sup> September 2015 it was validated. On 4<sup>th</sup> September 2015 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising him to log into his account to view the details of the Complaint, and giving him 15 business days within which to lodge a Response on or before 25<sup>th</sup> September 2015. On 23<sup>rd</sup> September 2015 Nominet sent a Response reminder.

On 25<sup>th</sup> September 2015 the Respondent responded. On 28<sup>th</sup> September Nominet informed the Complainant that the Response was available to be viewed via the Complainant’s online services account, and inviting it to Reply to the Response on or before 5<sup>th</sup> October 2015. On 1<sup>st</sup> October 2015 Nominet sent a Reply reminder. Nominet did not receive a Reply.

Mediation documents were generated for the Complaint, and mediation commenced on 16<sup>th</sup> October 2015. Mediation was unsuccessful and concluded on 6<sup>th</sup> November 2015. On 23<sup>rd</sup> November 2015 the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 27<sup>th</sup> November 2015 Mr. Niall Lawless (“the Expert”) was appointed to act as Expert in this dispute, he is required to give his Decision by 18<sup>th</sup> December 2015. Mr. Lawless has confirmed that he knew of no reason why he could not properly accept the appointment, and knew of no matters which ought to be drawn to the attention of the parties which might appear to call in to question his impartiality and -/- or independence.

### **4. Outstanding Formal -/- Procedural Issues**

There are no outstanding formal or procedural issues.

### **5. Factual background**

The Complainant, REPI S.p.A. is a company existing under the laws of Italy and having its principal place of business in Lonate Ceppino (VA). It is a manufacturer of liquid colours, additives, UV stabilizers and dosing units for thermoplastic and polyurethane materials. The Complainant is the owner of community, international and national registered trademarks for “REPI” and it has registered and used the domain names <repi.it>, <repi.com>, <repi.eu>, <repi.ru> and <repi-usa.com>. The Respondent, Mr. Nick Thompson, is an individual who has registered domain names for investment purposes. The Respondent registered the Domain Name on 17<sup>th</sup> April 2000.

## **6. The Parties' contentions**

### The Complainant

The Complainant seeks transfer of the Domain Name. The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration because:-

- the Respondent knew of the Complainant's activity and trademark when he registered the Domain Name, and he had actual or at least constructive knowledge of the Complainant and its trademark.
- the use of its trademark in the Domain Name makes it difficult to infer that the Respondent has a legitimate use for the Domain Name, and no plausible explanation exists as to why Respondent selected the disputed domain name other than to trade on the goodwill of Complainant's trademark.
- the Respondent has registered many domain names, and several of these contain renowned trademarks belonging to others.
- the Respondent's detention of the Domain Name for about 15 years is passive holding, which infers bad faith registration.
- the Respondent's registration of the Domain Name is hindering it, penalising it, and disrupting its business.
- the Respondent's registration of the Domain is misleading internet users and creating a likelihood of confusion with the Complainant's trademarks and domain names.
- the Respondent has never received any authorisation to sell products or services under the Complainant's trademark in any form, and the Respondent's registration of the Domain Name prevents it from using the Domain Name to reflect its trademark "REPI".

### The Respondent

The Respondent says that the Domain Name is not an Abusive Registration because:-

- the Complainant's trademarks and trading name do not constitute a universal and international right to ownership of any domain name that contains the word 'REPI'.
- the Complainant has not provided evidence that he knew of the Complainant's reputation, and that such an assertion is incorrect.



- the domains listed by the Complainant as evidence of a pattern of Abusive Registration is entirely conjecture on its part and is factually incorrect, and the domains listed by the Complainant were registered with the permission of the brand owners.
- whereas he has used the Domain Name for some e-mail-related purposes connected to event registration, and for web service hosting, he has not used the Domain Name in any manner that is detrimental to the Complainant's business.
- his reason for registering the Domain Name was unrelated to the Complainant, and was not an abusive registration under Nominet's policy.

The Respondent says that the Complainant is seeking to acquire domain names by force in foreign markets as and when it enters them, and asks the Expert to consider this complaint to be a case of attempted reverse domain name hijacking.

## **7. Discussions and Findings**

### **7.1 General**

Nominet's DRS Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

### **7.2 Complainant's Rights**

The Complainant is REPI S.p.A. and is the owner of community, international and national registered trademarks for "REPI". The Complainant's company name and its registered trademarks are identical to the Domain Name. The Complainant has registered and used the domain names <repi.it>.

<repi.com>, <repi.eu>, <repi.ru> and <repi-usa.com>. Because of the above, I decide that, ignoring the ".co.uk" suffix for this purpose, the Complainant has Rights in respect of a name or mark that is identical to the Domain Name.

### 7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy, but it does not state under which part (s) of the Policy. Under Paragraph 3 - Evidence of Abusive Registration - guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

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

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(A). 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;

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainant has Rights;  
or

3(a)(i)(C). for the purpose of unfairly disrupting the business of the Complainant;

3(a)(ii). 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 ...”

#### Respondent knew of Complainant's activity and trademark

The Complainant says that the Respondent knew of the Complainant's activity and trademark when he registered the Domain Name, and that he had actual or at least constructive knowledge of Complainant and its trademark.

The Complainant supports this contention by saying it has been using REPI as its company name in the UK since 1996; it registered the REPI trademark in 1998 and this has enjoyed protection in the UK



since then; that since 1999 it has published company information on the Internet, using the URL www.repi.it; and it has registered several domain names incorporating “REPI”.

The Complainant says that the *“REPI trademark has been used since the seventies and in the UK at least since the year 1998.”*

The Respondent says that the Complainant’s assertion that he must somehow have known of REPI S.p.A. at the time of registration is far-fetched and incorrect.

I recognise that the Complainant may enjoy some considerable good reputation within the market in which it operates, and which it has built up through hard work over 40 years but, in my view, “REPI” is not a brand, company name or trademark that today enjoys recognition with the public at large in the UK. The Complainant has produced insufficient evidence to persuade me to the contrary, let alone that the Respondent must have been aware of the Complainant in April 2000, when the Respondent registered the Domain Name.

Because of that, I accept that the Respondent was unaware of the Complainant when he registered the Domain Name.

#### Legitimate use of the Domain Name

The Complainant says that the use of its trademark in the Domain Name makes it difficult to infer that the Respondent has a legitimate use for the Domain Name, and that no plausible explanation exists as to why Respondent selected the disputed Domain Name other than to trade on the goodwill of Complainant’s trademark.

The Respondent says that his reasons for registering the Domain Name were:-

- to allow his customers to expand their brand and product portfolio.
- he was considering personal business ventures where a short brand name and domain name could be useful.
- because there was a reasonable investment value to owning short and catchy .co.uk domain names.

Paragraph 4 (d) of the Policy provides:-:-



*“Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits”.*

The Respondent says that in April 2000 he became *“aware that there were no .co.uk domain names with three letters still available for registration, and that the number of four letter domains was dwindling quickly”* and he recognised that it would *“be beneficial to purchase some short, catchy and pronounceable domain names, while short ones were still available”*.

The Respondent describes the task of choosing a four-letter phonetically pleasing domain name, which is a catchy or easy-to-remember word, or which could be used as an acronym, as a soul-destroying process.

The Expert considers such a process to be part of the intellectual investment that can create domain name value. Provided that the registration of the domain name is not abusive, the more attractive the English language combination of letters, the more valuable the domain name will be.

The Respondent is someone who trades in domain names and under the Policy that is of itself unobjectionable. Trading can be an entirely legitimate reason for registering and holding the Domain Name.

#### Registration of many domain names

The Complainant says that the Respondent has registered many domain names, and several of these contain renowned trademarks belonging to others.

The Respondent says that the list of domain names produced by the Complainant as evidence of a pattern of Abusive Registration is entirely conjecture on its part and is factually incorrect, and that the domain names listed by the Complainant were registered with the permission of the brand owners.

The Complainant has provided no evidence that the Respondent’s involvement with the registration of other domain names is abusive.

#### Passive holding

The Complainant says that the Respondent’s detention of the Domain Name for about 15 years is passive holding, which infers bad faith registration.

I am required to decide the Domain Name dispute using the Policy, and not the ICANN Uniform Domain-Name Dispute Resolution Policy (UDRP).

Notwithstanding that, as discussed in the WIPO case *Telstra Corporation Limited -v- Nuclear Marshmallows* WIPO Case No D2000-0003, passive holding under the UDRP can, in certain circumstances, constitute a domain name being used in bad faith. *“The concept of a domain name “being used in bad faith” is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith”.*

The circumstances that led the Administrative Panel to decide that the respondent's passive holding of the domain name amounted to the respondent acting in bad faith do not apply in this dispute. In the *Telstra* case, the circumstances were:-

- The complainant's trademark had a strong reputation and was widely known. In this dispute, as outlined above I have decided that “REPI” is not a brand, company name or trademark that would enjoy recognition with the public at large in the UK.
- The respondent provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name. In this dispute, whereas the Respondent has not demonstrated good faith, as outlined above the Respondent has provided legitimate reasons for registering the Domain Name. Trading in domain names for profit is of itself unobjectionable.
- The respondent had taken active steps to conceal its identity, by operating under a name that was not a registered business name and the Respondent had actively provided, and failed to correct, false contact details, in breach of its registration agreement. In this dispute, there is no evidence that the Respondent has failed to comply with Nominet’s domain name registration requirements.

Because of the above, I decide that the Respondent’s long-standing registration of the Domain Name does not infer bad faith registration.

#### Disruption

The Complainant says that the Respondent’s registration of the Domain Name is hindering it, penalising it, and disrupting its business. It also says that the Respondent’s registration prevents it as the holder of the trademark “REPI” from reflecting the mark in the Domain Name.





I accept that the Respondent's registration of the Domain Name deprives the Complainant of the opportunity to use it. However, Nominet operates a "first-come, first-served" system of domain name registration, and the Complainant has not established that, at the time when the registration took place or subsequently, the Domain Name took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

#### Confusion

The Complainant says that the Respondent's registration of the Domain Name is misleading Internet users and creating a likelihood of confusion with the Complainant's trademarks and domain names.

The Respondent says that, whereas he has used the Domain Name for some e-mail-related purposes connected to event registration, and for web service hosting, he has not used the Domain Name in any manner that is detrimental to the Complainant's business.

Under the Policy one of the factors which may evidence that the Domain Name is an Abusive Registration is 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 not provided any evidence of confusion or lost business.

The Domain Name is not resolving to any website that could cause confusion with the Complainant's trademarks and domain names. I accept the Respondent's evidence that he has not used the Domain Name in any manner that is detrimental to the Complainant's business.

#### Authorisation to sell products or services under the Complainant's trademark

The Complainant says that the Respondent has never received any authorisation to sell products or services under the Complainant's trademark in any form, and the Respondent's registration of the Domain Name prevents it from using the Domain Name to reflect its trademark "REPI".

As a Nominet Expert, I am not required to consider whether the Respondent's activities amount to an infringement of the Complainant's trademark. Expert Decisions are to be determined by reference to

the Policy and not the law in respect of trademark infringement, for example as noted in Deutsche Telekom AG v Lammtara Multiserve Limited Appeal Decision (DRS 05856).

If trademark infringement is a pressing concern, the Complainant has an option of pursuing the matter in Court which it has not done. It is not the role of Nominet's DRS to act as a potential substitute for litigation in relation

For the Complainant to succeed it must demonstrate that the Domain Name is an Abusive Registration, and it has failed to do so.

#### Reverse Domain Name Hijacking

The Respondent says that the Complainant is seeking to acquire domain names by force in foreign markets as and when it enters them, and asks the Expert to consider this complaint to be a case of attempted reverse domain name hijacking.

Whereas the Complainant has not succeeded, the Complaint is genuine and it makes sense. The Complainant has not put the Respondent, as a trader in domain names, to unnecessary expense. I do not consider the Complaint to be a bad faith attempt to deprive the Respondent of the Domain Name, and decide that that is not a case of attempted reverse domain name hijacking.

#### 7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name identical or similar to the Domain Name, but that the Complainant has not proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

### **8. Decision**

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is not an Abusive Registration, the Expert directs that the Domain Name registration will therefore remain with the Respondent.

**Niall Lawless, Nominet Expert**

**4<sup>th</sup> December 2015**