

DISPUTE RESOLUTION SERVICE

D00017073

Decision of Independent Expert

Aldi Stores Limited

and

Greg Saunderson

1. The Parties:

Lead Complainant: Aldi Stores Limited
Holly Lane
Atherstone
Warwickshire
CV9 2SQ
United Kingdom

Complainant: Aldi GmbH & Co. KG
Complainant/O Freeths LLP, 3rd Floor Colmore Plaza
20 Colmore Circus
Queensway
Birmingham
West Midlands
B4 6AT
United Kingdom

Respondent: Greg Saunderson
6 Station Row
Burstwick
Hull
East Yorkshire
HU12 9JW
United Kingdom

2. The Domain Name(s):

aldi-direct.co.uk
alddirect.co.uk
("the Domains")

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

09 February 2016 14:44 Dispute received
10 February 2016 11:33 Complaint validated
10 February 2016 12:05 Notification of complaint sent to parties
19 February 2016 16:05 Response received
19 February 2016 16:05 Notification of response sent to parties
24 February 2016 01:30 Reply reminder sent
01 March 2016 11:39 No reply received
01 March 2016 11:41 Mediator appointed
04 March 2016 13:39 Mediation started
29 April 2016 15:46 Mediation failed
29 April 2016 15:46 Close of mediation documents sent
09 May 2016 16:15 Expert decision payment received

4. Factual Background

The Complainants are part of a group of companies which operate the Aldi chain of supermarkets. The Complainants are collectively referred to below as "the Complainant" except insofar as it is necessary to refer to them separately.

There are over 500 Aldi outlets in the UK.

In 2014, the Complainant was ranked as the top UK supermarket brand by YouGov BrandIndex.

The Complainant owns numerous trade marks for ALDI including EU Trade Mark No. 1954031 filed 15 November 2000 in classes 35 and 38.

The Domains were registered on 6 August 2015.

The Domains were used for a GoDaddy parking page with diverse sponsored links.

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant has generated substantial goodwill and reputation in its name.

The Domains consist of the Complainant's trade mark plus the additional word "direct" which denotes an online shopping presence of the Complainant. Such use of the Complainant's mark takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights by misleading Internet users into believing that the Domains are operated or authorised by the Complainant in accordance with paragraph 3(a)(ii) of the Policy. The Respondent has profited from the sponsored links at the websites associated with the Domains.

The Domains are part of a pattern of registration of domain names corresponding to well-known names or trade marks in which the Respondent has no apparent rights, for the purposes of paragraph 3(a)(iii) of the Policy. The Respondent also owns aldi-direct.com, aldidirect.com and aldidirect.eu.

The Domains were acquired for the purposes of unfairly disrupting the business of the Complainant in accordance with paragraph 3(a)(i)(C) of the Policy.

Complaint

The Response simply states: "I would like to resolve this complaint."

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domains and, second, that the Domains, in the hands of the Respondent, are abusive registrations (as defined in paragraph 1 of the DRS Policy).

Complainant's Rights

The meaning of "Rights" is defined in the DRS Policy in the following terms:

"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 Rights in the term “Aldi” arising from its registered trade marks. The Complainant has also demonstrated Rights in the form of unregistered trade mark rights in that name deriving from its extensive use thereof.

The trade mark is similar to the Domains, each of which consists of the Complainant’s trade mark followed by the generic term “(-)direct”.

Abusive Registration

Do the Domains constitute Abusive Registrations in the hands of the Respondent? Paragraph 1 of the DRS 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

The Domains consist of the Complainant’s distinctive trade mark plus the term “direct”.

It is difficult to conceive of any explanation for the registrations other than that the Respondent intended to create a misleading association with websites where the Complainant sold its goods direct to the public.

The Respondent has not offered any alternative explanation or even denied such allegations by the Complainant. The Respondent simply says that he would like to resolve the dispute.

In those circumstances, I have little difficulty in concluding that the Domains come within the first limb of the definition of “Abusive Registration” above in that they were registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or were unfairly detrimental to the Complainant's Rights.

It is unnecessary to consider the second limb of the definition of “Abusive Registration” as these are disjunctive requirements.

7. Decision

I find that the Complainant has Rights in a mark which is similar to the Domains and that the Domains are, in the hands of the Respondent, Abusive Registrations. I therefore direct that the Domains aldidirect.co.uk and aldi-direct.co.uk be transferred to the Complainant.

Signed: Adam Taylor

Dated: 25 May 2016