

Nominet UK Dispute Resolution Service

DRS 00251

EBEL S.A. and Sm@rtNet Limited

Decision of Independent Expert

1. Parties:

Complainant: EBEL S.A.
Address: Rue de la Paix 113
La Chaux-de-Fonds
Country: Switzerland

Respondent: Sm@rtNet Limited
Address: 11-12 Hanover Street
London
Postcode: W1R 9HF
Country: United Kingdom

2. Domain Name

EBEL.co.uk

3. Procedural Background

The Complaint was lodged with Nominet on February 15, 2002. Nominet validated the Complaint and notified the Respondent of the Complaint by letter dated February 22, 2002 informing the Respondent that it had 15 days within which to lodge a response. The Respondent failed to respond within this deadline (or at all). On March 19, 2002 Nominet wrote to the Complainant confirming that the Respondent had failed to file a Response and further that the Complainant had until April 4, 2002 to formally request (and pay the appropriate fee for) an expert decision founded on the Complaint. On April 4, 2002 the Complainant confirmed its request for an expert decision and on April 8, 2002 the appropriate fee was received in full by Nominet pursuant to the Nominet UK Dispute Resolution Service Procedure (the "Procedure").

On April 12, 2002 Tom Thomas the undersigned (the "Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Outstanding Formal/Procedural Issues:

The Expert considered two factors:-

- a) Payment of the appropriate fee for the decision was received by Nominet some 4 days after the date on which payment should have been rendered.

Paragraph 21c of the Procedure provides that if Nominet does not receive the appropriate fee from the Complainant within 10 days of receipt by the Complainant of notice from Nominet that an expert is to be appointed, “Nominet will deem the Complaint to be withdrawn”.

Paragraph 12a of the Procedure states inter alia that “Nominet may in exceptional cases extend any period of time in proceedings under the Dispute Resolution Service”. In this case the correspondence on file suggests that instructions were given by the Complainant to wire transfer the funds to Nominet within the deadline and that the delay in receipt by Nominet of the fee was attributed to the time taken to effect a transfer of funds through the wire transfer process. Although the Expert queries whether such a reason for delay in rendering payment would always constitute exceptional circumstances, the Expert is persuaded by the fact that the instructions to effect the wire transfer were given within the deadline and the fact that the funds were received shortly after the expiry of the deadline.

- b) The Respondent has failed to submit a response to Nominet in time (or at all) in accordance with paragraph 5a of the Procedure.

Paragraph 15b of the Procedure provides, inter alia that “If in the absence of exceptional circumstances a Party does not comply with any time period laid down in this Policy or the Procedure, the Expert will proceed to a Decision on the complaint”.

In this case the correspondence sent by Nominet to the Respondent was returned to Nominet with the legend “not known at this address” on the envelope. Is this then an example of exceptional circumstances referred to in paragraph 15b of the Procedure? In the Expert’s view it is the responsibility of the Respondent (or in this case the Respondent’s Officers) to ensure that up to date address details are maintained with Nominet. Failure to ensure that this is done should not in the Expert’s view be allowed to impede the progress of a validly raised complaint. The Expert therefore finds that there are no exceptional circumstances in this case for the purpose of paragraph 15b.

Accordingly, the Expert will now proceed with a decision on the Complaint notwithstanding the delay in payment of the appropriate fee by the Complainant and notwithstanding also the absence of a response from the Respondent.

Paragraph 15c of the Procedure provides that “if in the absence of exceptional circumstances a party does not comply with any provision in the Policy or this Procedure... the Expert will draw such inferences from the parties non compliance as he or she considers appropriate.”.

Although in this case the immediate reason for the Respondent’s failure to submit a response is clear, i.e. the Respondent’s failure to maintain up to date contact details with Nominet, the reason for that failure may be based on a variety of factors. In the circumstances therefore the Expert has drawn no special inferences from the absence of a response to the Complaint. The Expert is satisfied that the probable facts asserted by the Complainant set out in the following section may be treated, for the purpose of this decision, as facts.

5. The Facts:

Established in 1911 the Complainant is a well known manufacturer of wrist watches and associated goods and clothing under the brand name "EBEL." The Complainant's products are distributed in 65 countries throughout the world. The Complainant has had an established trading presence in the United Kingdom for more than 20 years selling its products through some 125 sales outlets throughout the country.

The Complainant is the proprietor of a variety of trade marks relevant to the U.K. including at least one U.K. registered trade mark for the word "EBEL" registered in 1979.

The Complainant owns a number of domain names including EBEL.com and EBEL.ch (registered in April 1997 and February 1996 respectively) and since 1997 the Complainant has maintained a website at www.ebel.com.

On October 23, 1996 the Respondent registered the Domain Name although so far as the Complainant is aware the Respondent has made no use of the Domain Name since its registration.

On November 21, 2001 a representative of the Complainant wrote to the Respondent requesting the transfer of the Domain Name intimating to the Respondent that failure to transfer the Domain Name would result in the initiation of legal action. The Respondent did not reply to the Complainant's letter.

6. The Parties' Contentions:

Complainant:

The Complainant's contentions are as follows:

1. The Complainant is the proprietor of a number of registered trade marks for the mark "EBEL".
2. The Complainant operates a website at www.ebel.com and has done so since 1997. Furthermore the Complainant has had a presence on the internet since 1995.
3. The Domain Name is similar to trade marks and domain names in which the Complainant has rights.
4. By registering the Domain Name the Respondent must have been aware of the Complainant's rights in the trade mark EBEL and by registering the Domain Name the Respondent has blocked the Complainant's ability to register the Domain Name for itself.
5. The U.K. market represents a substantial part of the Complainant's business and not having a website in Britain constitutes a real handicap for the Complainant and its development.
6. The fact that British residents cannot reach a website operated by the Complainant via the Domain Name causes severe damage to the Complainant.
7. The Respondent has registered various domain names relating to well known brands of wrist watch including tagheuer.co.uk, patekphilippe.co.uk and breitling.co.uk and that such a conduct represents a pattern of abusive registration on the part of the Respondent.

8. The Respondent has no rights in the name “EBEL” and has no association or connection with the Complainant which could give rise to such rights.
9. The Respondent does not use the Domain Name as part of its legal name or corporate name or as part of its trading identity and the Domain Name is not used by the Respondent as part of any website address. In making this admission the Complainant acknowledges the provisions of paragraph 3b which state that failure to use a domain name is “not in itself evidence that the Domain Name is an abusive registration.”.

Respondent:

The Respondent has not responded.

7. Discussion and Findings:

General

In accordance with paragraph 2 of the Nominet UK Dispute Resolution Policy (the “Policy”) the Respondent must submit to proceedings under the Dispute Resolution Service if, in respect of a domain name, the Complainant satisfies 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.”

Definitions of “Rights” and “Abusive Registration” are provided in paragraph 1 of the Policy.

Complainant’s Rights

The Complainant is the proprietor of a number of registered trade marks comprising of the word “EBEL” and is the proprietor of a number of domain names including EBEL.com and EBEL.ch.

When comparing any name or mark in which the Complainant has rights with the Domain Name, the first and second level suffixes of the Domain Name, being generic in nature, are to be discounted.

In light of the Complainants longstanding proprietary interest in the name EBEL, the Expert is satisfied that the Complainant has rights in a name which is identical to the Domain Name.

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 a decision took place took unfair advantages 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 Policy provides (at paragraph 3a) a non exhaustive list of a factors which may be evidence that a domain name is an Abusive Registration. Of these factors there is no inference or assertion in the Complaint of any of the circumstances referred to in paragraphs 3a(ii) or 3a(iv) thus leaving the Expert to consider paragraphs 3a(i) and 3a(iii) in turn.

Paragraph 3a(i) refers to:-

"Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:-

- A Primarily for the purpose 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;
- B As a blocking registration against the name or mark in which the Complainant has rights; or
- C Primarily for the purpose of unfairly disrupting the business of the Complainant;"

In terms of paragraph 3a(i) the Complainant makes no assertion to which paragraphs 3a(i)A or 3a(i)C may apply. The Complainant does however assert that the Respondent's actions fall within paragraph 3a(i)B as blocking registration although the evidence provided by the Complainant in support of this assertion is limited.

The Complainant maintains that the Respondent must have been aware of the Complainant's rights in the name "EBEL" at the time of registration of the Domain Name and as such the Respondent's intentions must have been specifically to prevent the Complainant from registering the Domain Name itself. In addition the Complainant asserts that "not having a website in this country [United Kingdom] constitutes a real handicap for the Complainant and for its development" and that the fact that the Complainant's website cannot be accessed via the address www.ebel.co.uk causes "a severe damage to the Complainant". The Complainant provides no evidence to clarify or justify the nature of the handicap or damage it has suffered in either regard. The fact that the Complainant's complaint was raised some 5 years after the Domain Name was originally registered and some 4 years after the launch of the Complainant's website at www.ebel.com suggests to the Expert that there has been no material, impediment or damage to the Complainant's business as a result of the registration of the Domain Name by the Respondent.

Furthermore the Complainant's submission includes details of the ebel.com domain name indicating that it was registered in April 1997, i.e. after the Domain Name was registered. Whilst the Expert has some sympathy with the Complainant's argument that the Respondent must have been aware of the Complainant's trade mark rights at the time of registration of the Domain Name, the fact that the Respondent did not also register the

domain name ebel.com at the same time suggests to the Expert that the Respondents motive for registering the Domain Name was not to block the Complainant's use of its trade mark. In the Expert's view the Complainant has failed to produce sufficient evidence to support a finding of Abusive Registration under paragraph 3a(i)B alone.

Turning to paragraph 3a(iii), this states that:-

“In combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations.”

In the Complaint the Complainant has provided evidence showing that the Respondent has registered at least three other domain names relating to well known brands of wrist watch. All of these domain names were registered on the same date as the Domain Name. There is no evidence to suggest that the Respondent has any right to use any of the trade marks in relation to which the other domain names were registered nor any association with the proprietors of those trade marks. Normally the Expert would not consider the mere ownership of other domain names by the Respondent to represent a pattern of making Abusive Registrations. However given that all of the domain names registered relate to a single market sector, the Expert is satisfied that in this case a pattern of Abusive Registrations has been substantiated by the Complainant.

If a pattern of making Abusive Registrations exist in this case, to succeed under paragraph 3a(iii) other circumstances must also exist indicating that the Domain Name is an Abusive Registration. In this case the Expert has taken two factors into account. Firstly, the Expert considers the Complainant's trade mark “EBEL” to be, in trade mark parlance, a designed word which has no separate meaning or usage in the English language other than as a trade mark. Secondly, since the Respondent registered domain names in respect of a number of well known wrist watch brands all on the same date, it is inconceivable to the Expert that the Respondent registered the Domain Name other than for the purpose of taking advantage of or exploiting the Complainant's trade mark rights.

On balance therefore the Expert is satisfied that the distinctive nature of the Complainant's trade mark and the circumstances in which the Domain Name was registered constitutes sufficient grounds to indicate that the Domain Name in dispute is an Abusive Registration and that in conjunction with the Respondent's pattern of making Abusive Registrations the Domain Name is an Abusive Registration for the purpose of paragraph 3a(iii) of the Policy.

8. Decision:

The Expert finds that on the balance of probabilities the Complainant has rights in a name which is identical to the Domain Name and that the Domain Name in the hands of the registrant is an Abusive Registration. The Expert therefore directs that the Complaint in relation to the Domain Name be allowed and the Domain Name transferred to the Complainant.

29th April 2002

Tom Thomas

Date