

Nominet UK Dispute Resolution Service

DRS 00359

Consorzio del Prosciutto di Parma -v- Vital Domains Limited

Decision of Independent Expert

1. **Parties:**

Complainant: Consorzio del Prosciutto di Parma

Address: Via Marco Dell'Arpa 8/B
Parma
Italy

Postcode: 43100

Country: IT

Respondent: Vital Domains Limited

Address: 133 Oslo Court
Prince Albert Road
London

Postcode: NW8 7EP

Country: GB

2. **Domain Names:**

Parmaham.co.uk; parma-ham.co.uk

3. **Procedural Background:**

The Complaint was lodged with Nominet on 19 April 2002. Nominet validated the Complaint and notified the Respondent of the Complaint on 29 April 2002 and informed the Respondent that it had 15 days within to lodge a Response. A response was received on 6 May 2002 and forwarded to the Complainant on 8 May 2002 with an invitation to make any further submission in reply to the Response by 15 May 2002. The Complainant duly filed a reply on 14 May 2002. On 13 June 2002 Nominet informed the parties that it had not been possible to achieve a resolution of the dispute by Informal Mediation and invited the Complainant to pay the fee to obtain an Expert Decision by 27 June 2002. On 24 June 2002 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

On 27 June 2002, David King, 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 brought to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. **Outstanding Formal/Procedural Issues (if any):**

None.

5. **The Facts**

Parma ham is the English translation of Prosciutto di Parma. It is a product of the Parma region of Italy; it enjoys worldwide fame and reputation and is made according to traditional methods and standards. Under Italian law, the Complainant has legal status and has been entrusted with safeguarding the essential characteristics of the quality of Parma ham.

The Respondent operates a web-site offering domain names for sale.

The Respondent is unconnected with the Complainant.

On December 1999 the Respondent registered the Domain Name of parmaham.co.uk and on 27 January 2000 the Respondent registered the Domain Name of parma-ham.co.uk.

6. **The Parties Contentions**

Complainant:

The Complainant has submitted grounds of complaint which read as follows:

1. The Domain Name(s) in dispute are identical or similar to a name or mark in which the Complainant has Rights.
2. The Domain Name(s) in the hands of the Respondent is an Abusive Registration
3. Background. All written correspondence between the parties is attached hereto at Annex 4. To attempt to obtain the surrender of the domain names to Consorzio, an initial approach was made to the Registrant dated 28 September 2000 outlining the rights of the Complainant in the domain names. Mr Sobati (of the Registrant) called the Complainant's representatives on 2 October 2000 informing them that he was of the opinion that the Complainant did not have rights in the domain names but that he would be prepared to consider an offer to purchase them. On 2 January 2001, the Complainant's representatives wrote to Mr Sobati to repeat the offer to reimburse him for his outlay in registering the two names. On 4 January 2001, the Complainant's representatives received an email from Mr Sobati offering to sell both domain names for a sum of £5,000 (exclusive of VAT) or £3,000 separately (exclusive of VAT). On 19 April 2001, the Complainant's representatives wrote to Mr Sobati with an offer of £3,000 (in total) for the two domain names. On the same day, Mr Sobati replied to the effect that the price remained fixed at £5,000 (exclusive of VAT). The Complainant's representatives sent a holding response to the Registrant while awaiting the Complainant's instructions on 2 May 2001. The Complainant has since been considering how matters might be resolved.
4. As the sum demanded by the Respondent remains unreasonable and it has not been possible to negotiate a more appropriate figure, Consorzio

feels it is now appropriate to invoke the NOMINET UK Dispute Resolution Service with a view ultimately to obtain the transfer of the disputed domain names to them.

5. The Complainant contends that it has rights in respect of a name or mark which is identical or similar to the domain names parmaham.co.uk and parma-ham.co.uk AND that these domain names, in the hands of the Respondent, are Abusive Registrations.
6. The Complainant and its Rights. Consorzio del Prosciutto di Parma is a non-profit making, voluntary association of ham producers of the Parma region of Italy. It is accorded legal status under Italian law and has been specifically entrusted under a Statutory Instrument dated 3 July 1978 with supervisory duties relating to the production of ham in the Parma region in the said region in a particular, traditional manner and to the use of the name 'Prosciutto di Parma' (which translates as 'Parma Ham') and of the special 'Parma' stamp (which is also the subject of the UK certification mark attached hereto at Annex 2) and related seals and device marks which indicate the production method, as provided for under Italian law No. 26 of 13 February 1990 (which superseded law No. 506 of 4 July 1970). In addition to safeguarding the essential characteristics and quality of Parma Ham, Consorzio also promotes the consumption of the product and disseminates knowledge about it in Italy and abroad.
7. Parma Ham is a product which enjoys worldwide fame and reputation. Its popularity in the UK has continued to grow since its introduction into this country, and its status as a superior culinary product is reflected in its high retail value.
8. The term 'Prosciutto di Parma' is the Italian term for 'Parma Ham' in the English language. This is reflected on the registration certificate for Community Trade Mark Registration No. 1116458 PROSCIUTTO DI PARMA (copy attached hereto at Annex 2). The name 'Parma Ham' features on restaurant menus across the world, but the renown of the term does not affect its distinctive character, and it is widely known to denote the ham product regulated by Consorzio. Article 13(3) of EC Regulation 2081/92 refers: 13(3) Protected names may not become generic.
9. Under EU Council Regulation 2081/92 and subsequent Regulation 1107/96 which refers to it (attached hereto at Annex 3), a product name may be registered as a 'protected designation of origin' ('PDO') or as a 'protected geographical indication' ('PGI'). Parma Ham has obtained registration as a 'PDO', which indicates that it is a product which originates from a specific region, in this case Parma, and that it possesses qualities and characteristics which are exclusively due to environmental factors and production methods, and that the processing and preparation of the product takes place within the geographical area in question (i.e. Parma).
10. The Complainant encloses a copy of EC Regulation 2081/92 and would like to refer in particular to the passage at Article 13: It is clear that any use of PROSCIUTTO DI PARMA or the translated name PARMA HAM which has not been authorised by Consorzio is liable to offend against this provision of the Regulation. The unauthorised registration of the domain names parmaham.co.uk and parma-ham.co.uk constitutes 'misuse' of registered names within the meaning of Article 13.

11. Consorzio demands the strict compliance of the authorised producers of Parma Ham with the required methods and standards of manufacture of the product. In its capacity as a regulatory body established by Statute, Consorzio supervises closely the use of the terms 'Prosciutto di Parma' and 'Parma Ham' and undertakes to maintain the standards which authorised producers of the ham product must meet. In particular, it must be vigilant where the 'protected designation of origin' is used without permission to safeguard the quality and reputation of the product for the ultimate consumer. To this end, one of the specific purposes of Consorzio is to prevent any unlawful or irregular use of its trade marks in commerce.
12. Consorzio is the proprietor of several trade mark registrations of its marks. In the UK, it has obtained registration of the certification marks PROSCIUTTO DI PARMA under UK registration no. 1457951 and PARMA (and device) under UK registration no. 1457952, both registered in respect of ham. Both of these marks were filed in 1991. Through the Community Trade Mark system, it has obtained registration of the collective marks PROSCIUTTO DI PARMA under Community Trade Mark registration no. 1116458 and has also registered the mark PARMA (and device) under Community trade mark registration no. 1116458 for the same goods. These marks were filed in March 1999. Extracts from the official on-line databases showing details of these marks are attached hereto at Annex 2.
13. In addition to the rights conferred by registration, the Complainant enjoys substantial Common Law rights in the names PROSCIUTTO DI PARMA and PARMA through the widespread use of them in this country under its authority. Both terms are used in the UK and the public have come to associate these with Consorzio. Any unauthorised use of these names is likely to lead to confusion of the public.
14. Abusive Registration. The Complainant contends that the domain names in the hands of the Respondent are Abusive Registrations in particular because the Respondent has registered the Domain Names primarily 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 Respondents documented out of pocket costs directly associated with acquiring or using the Domain Name; AND that the Respondent is engaged in a pattern of making Abusive Registrations.
15. When either of the two disputed domain names are entered in the address bar, the internet user is directed to a page at www.vitaldomainsforsale.co.uk (copy attached hereto at Annex 5). The web page makes it clear that Vital Domains Limited are in the business of selling domain names and they have stockpiled approximately 8,000 names. This company is therefore engaged in the bulk registration and sale of "quality" names to companies who have an interest in them.
16. It would appear that Vital Domains Limited have, on occasion, chosen to register domain names which are identical or very similar to famous trade marks and which might be offered for sale at a price vastly in excess of out-of-pocket expenses, as is the case in the instant situation. From a brief perusal of the 'showcase' of domain names for sale, the Complainant has noted, for instance, that the domain names cornetto.co.uk, e-

rollerblade.co.uk, l-rollerblade.co.uk, palmcorder.co.uk feature among the names offered for sale alongside parmham.co.uk and parm-ham.co.uk. Cornetto is of course the registered trade mark of Unilever Plc and details of UK trade mark registration nos. 2254622, 1195358, 1195359, 2167470 and Community trade mark registration no. 1483965 CORNETTO are attached hereto at Annex 7. PALMCORDER is of course a well known mark owned by Matsushita Electric Industrial Co Ltd and details of UK trade mark registration no. 1432473 PALMCORDER are also attached hereto at Annex 7. ROLLERBLADE is the well known mark of Rollerblade Inc and also attached hereto at Annex 7 are details of UK trade mark registration nos. 1457921, 1264020, 1457920, 1457919 and Community trade mark registration nos. 1208289, 64063, 64030 and 307983 all of which consist of the mark ROLLERBLADE.

17. This practice of buying and selling for a substantial profit domain names in which a third party has trade mark rights is behaviour of the kind regarded as evidence of bad faith in domain name dispute decisions across a number of dispute resolution forums.
18. Both the current and any future use of the disputed domain name will inevitably cause confusion to internet users for the following reasons:
 - (a) The disputed domain names which have been registered by the Registrant are virtually identical to the Complainant's certification marks PARMA and PROSCIUTTO DI PARMA under which it controls the use and exploitation of the Parma Ham name. Even while the name is not being used in relation to a proprietary web site, internet users would be deceived into believing there is a connection between the Registrant and Consorzio, and that Consorzio approved the registration of the domain names by Mr Sobati.
 - (b) Mr Sobati cannot satisfy any of the tests for demonstrating a legitimate interest in the domain names.
 - (c) No legitimate use of parmaham.co.uk or parma-ham.co.uk can be made by Mr Sobati without the consent of Consorzio because the supply of services under the domain names would
 - (i) be likely to infringe the Complainant's UK and Community Trade Mark registrations of the marks PARMA and PROSCIUTTO DI PARMA contrary to section 10 of the Trade Marks Act 1994 and Article 9 of Council Regulation 40/94/EEC.
 - (ii) be in breach of the provisions identifying Prosciutto di Parma as a 'protected designated origin' and affording protection to registered names.
 - (iii) be likely to constitute passing off in the UK at common law.
 - (d) The instant situation is very similar to that of BT and others v. One in a Million and others [1999] 1 W.L.R. 903 (a copy of which is attached hereto at Annex 6) where the defendants had registered (among others) the domain names marksandspencer.co.uk and marksandspencer.com
 - (e) Internet users seeking information about the Complainant's activities would be likely to search for a site using the disputed domain names. In finding the Registrant's sites if operational, or the Vital Domains web page if not, users would be confused into thinking that they had found the Complainant's site and that it did not promote itself on any other web site:

“Someone coming across <http://www.marksandspencer.co.uk> would naturally assume that it was that of the Plaintiffs.” (‘One in a Million’ case).

19. Conclusion.

- (a) Clearly the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Names parmaham.co.uk and parmaham.co.uk
- (b) The Complainant was using the marks PARMA HAM and PROSCIUTTO DI PARMA and had registered the mark PARMA and PROSCIUTTO DI PARMA prior to the Respondents registration of the Domain Names.
- (c) The Respondent had no purpose in registering the Domain Names other than to sell them to the Complainant or a competitor of the Complainant for valuable consideration in excess of the Respondents out of pocket costs directly associated with acquiring the Domain Name.
- (d) For these reasons the Domain Names in the hands of the Respondents are Abusive Registrations.

The Expert confirms that he has read all the Attachments referred to in the Complainant’s Grounds of Complaint.

Respondent:

The Respondent’s reply to the Complaint reads as follows:

The domain names parmaham.co.uk and parma-ham.co.uk were registered together with many other generic domain names for the purposes of generating traffic to Mr. Reza Sobati’s main site. This later developed into a company called vital domains limited as the marketing potential of such domains made domain names increasingly more like assets. When Mr Grimshaw [the Complainant’s representative] first contacted me concerning these domain names nearly a year and a half ago I agreed that if they sent me proof of their trademark ownership I would hand the domain names over. They failed to do so instead sending me documents pertaining to the "corona ducale" mark of the ancient Grand Duchy of Parma which under Italian law has to be stamped upon their packages as well as their rights to the name 'Prosciutto di Parma' in the UK. I asked Mr.Grimshaw why they had been unsuccessful in obtaining the UK trademark for the term 'parma ham' and his response was that they had never attempted to obtain it. I put it to him that until they did obtain such a trademark,the domains would remain as they are perceived by most people to be, that is generic. This means that they have no more rights to the domain name than say a person who owns a sandwich bar called 'Parma Ham' or even a person who wants to start a recipe site. In reference to the case law cited by the Complainant this is more like champagne.com rather than marksandspencer.com. The past 18 months has seen stop-start attempts by this consortium's legal team to obtain these names. Their own documentation of our correspondence shows that it is they who discontinued negotiations as well as discontinuing a previous attempt to use the DRS. What is disconcerting is Consorzio's litigious approach which has resulted in them spending hundreds of thousands of pounds in failed court cases against UK retailers. It is this legal belligerence which has now prompted practices which vital domains considers to be reverse domain hijacking. The Complainant contends that the registrant is engaged in a pattern of abusive registrations. This is not the case as vital domains ltd has

not received a single complaint to date through the DRS despite having approximately 2000 domains. This is because it is engaged in registering generic names as the list of names on the website vitaldomains.co.uk clearly shows. It should be noted that under Nominet's rules there is nothing illegal about having a lot of names. There are only five domains cited by the complainant out of the many as being examples of abusive registrations. However the products rollerblades, palmcorder and cornettos were all perceived to be generic and in a fair analysis this is an easy enough mistake given the fact that these words like Hoover have crept into the vernacular. In any case vital domains will always return a domain to its rightful owner where a trademark has clearly been obtained for that name. Furthermore the complainant has made unsubstantiated allegations with regards to the original intentions of the registrant when having first registered his domains.

Complainant's reply

The Complainant's representatives' reply to the Respondent's response reads as follows:

We are now in receipt of Mr Sobati's response filed on 6th May 2002. We understand that we must limit this reply to new issues arising out of that response. Mr Sobati claims that we failed to send him proof of trade mark ownership. This is contested. We refer to Annex 4 from our original complaint. It will be noted that specific reference was made in our letter of 28 September 2000 to the complainants trade mark registration no. 1457952 PARMA and a copy of the original registration certificate was also enclosed. We also refer to a telephone conversation with Mr Sobati dated 2 October 2000 (details at Annex 4 as above). Mr Sobati stated that he did not feel that our client had 'any grounds' but indicated that he would be prepared to listen to any offer that we might make for the domain names. I have no record of any other issues addressed in that conversation but would point out that as the complainant has registered the mark PARMA in respect of 'ham', it would be entirely superfluous for them to then seek to register the mark PARMA HAM as such a registration would not extend their rights. The complainants strongly contest Mr Sobati's claim that their marks PARMHAM/ PROSCIUTTO DI PARMA are perceived to be generic. The very fact that the mark PARMA is registered in the UK is evidence against this claim. If Mr Sobati wished to prove this point, he could launch a challenge against the validity of those registered marks. In the original complaint we referred to the protection of the complainants mark PROSCIUTTO DI PARMA as a 'protected geographical indication' and 'protected designation of origin' and referred to Article 13(3) of EC Regulation 2081/92 which states that 'protected names may not become generic'. Furthermore, we enclose attached hereto and marked Annex A a copy of the Regulations relating to the complainants UK certification trade mark registration nos. 1457941 and 1457952 which set out the strict requirements laid down for use of the trade marks in question. The complainant enforces these Regulations to further guarantee that the marks do not become generic. Mr Sobati has no basis on which to claim that our clients mark is generic. Mr Sobati is correct in stating that the complainants discontinued any negotiation with him once it became clear that he would not be prepared to accept the sum of £3,000 in return for an assignment of the two domain names parmaham.co.uk/parma-ham.co.uk. Annexed hereto and marked Exhibit RSG2 are copies of the exchange of e-mails between Mr Sobati and ourselves to this effect. The complainants were not prepared to pay the sum requested for what they feel is 'their' property. It is also correct to state that the complainants previously lodged documents

with Nominet under the disputed resolution service however these proceedings were withdrawn as the complainant wished to take advantage of the amended resolution procedure which recently came into force. These proceedings were of course subsequently filed under that new procedure. Mr Sobati refers to the complainants 'litigious approach' and 'legal belligerence' and claims that the complainant is engaging in 'reversed domain hijacking'. This claim is also strongly contested. It is certainly true to say that they are quite rightly determined to take all appropriate steps to protect their interests in the mark PARMA HAM. It is for this very reason that these proceedings have been entered into. As further evidence of our clients determination to protect their interest we can advise that they are the owners of the domain names prosciuttodiparma.com, prosciuttodiparma.biz, prosciuttodiparma.info, prosciuttodiparma.it, prosciuttodiparma.net, parmaham.biz, parmaham.info, parmaham.it, parmaham.net, parmaham.us, jambondeparma.org, jambondeparma.biz, jambondeparma.info, jambondeparma.org, jamondeparma.biz, jamondeparma.info, parmaschinken.biz, parmaschinken.info, parmaschinken.org, parmaschinken.net, parmaskinken.net, parmaskinken.org and presuntodeparma.biz, presuntodeparma.info. Mr Sobati admits to owning approximately 2,000 domain names. We did not survey all 2,000 marks, but our cursory inspection revealed five other domains which are felt to be 'abusive registrations' in that they consist essentially of registered trade marks. The marks PARMAHAM/PARMA-HAM fall into this category. If Mr Sobati is to be believed in stating that he will 'always return a domain to its rightful owner where a trade mark has been clearly obtained for that name', he should agree to return the domain names parmaham/parma-ham.co.uk to the complainant.

The Expert confirms that he has read all the Attachments referred to in the Complainant's Reply to the Respondent's response.

7 Discussion and Findings:

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are Abusive Registrations as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant has asserted that it has rights in a name or mark, which is identical or similar to the Domain Names. The only difference between the two Domain Names is the hyphen in parma-ham.co.uk. In the circumstances, the Expert does not consider it necessary to carry out a separate analysis in respect of each of the Domain Names. The main issue at this stage is to establish whether, on the balance of probabilities, the Complainant has rights in respect of the name or mark of "Parma ham".

From the evidence available, it is clear that the Complainant enjoys UK and EC trade mark rights in the name "Prosciutto di Parma" and the mark "Parma". The English translation of Prosciutto di Parma is Parma Ham. The Expert does not consider it essential for the Complainant to prove trade mark ownership of the name "Parma Ham" for it succeed on this issue.

In assessing whether or not a name or mark is identical or similar to a domain name, it is appropriate to discount the domain suffix <co.uk> which is of no relevant significance and wholly generic. The Expert finds that, for the purposes of the Policy, the Complainant does have Rights in respect of names or marks which are similar to the Domain Names.

Abusive Registration

Are the Domain Names, in the hands of the Respondent, Abusive Registrations? 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 took unfair advantage of or was detrimental to the Complainant’s Rights.”

A non-exhaustive list of factors, which may be evidence that a Domain Name is an Abusive Registration, is set out in Paragraph 3 of the Policy. The factors set out in Paragraph 3 a i A, 3 a ii and 3 a iii are relevant in this case.

Paragraph 3 a i A reads as follows:

- “i Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:
 - A** primarily 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”

Paragraph 3 a ii reads as follows:

“Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name in dispute is registered to, operated or authorised by, or otherwise connected with the Complainant”

Paragraph 3 a iii reads as follows:

“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”

The Respondent operates a web-site offering domain names for sale. There is nothing inherently wrong with that. The question is did the Respondent register the Domain Names for the purposes of selling them to the Complainant or one of its competitors for more than the cost of acquiring or

using them. It is not disputed that the Respondent offered to sell the Domain Names to the Complainant for a substantial sum when the Complainant challenged the Respondent. However, there are probably many people or businesses, other than competitors of the Complainant, who might be interested in acquiring the Domain Names for perfectly legitimate reasons, which would not infringe the Complainant's rights. On the evidence before him, the Expert cannot conclude that the requirements of Paragraph 3 a i A are satisfied in this case.

With regard to Paragraph 3 a ii, the Complainant considers that both the current and any future use of the Domain Names will inevitably cause confusion to internet users. The Complainant has asserted that, while the Domain Names are not being used by the Respondent in relation to a proprietary web-site, internet users would be deceived in to believing there is a connection between the Respondent and the Complainant and that the Complainant approved the registration by the Respondent. The Expert notes that the Complainant has not produced any evidence that anyone has actually been confused by the registration of the Domain Names by the Respondent. The Expert has visited the Respondent's web-site and notes that that the Respondent is offering for sale a large number of names which appear to be mainly descriptive or generic. In the view of the Expert, it should be apparent to anyone who is directed to the Respondent's web-site, that there is no connection between the Respondent and the Complainant. It should also be noted that Paragraph 3 b of the Policy, states that "failure on the Respondent's part to use the Domain Name for the purposes of e-mail or a web-site is not in itself evidence that the Domain Name is an Abusive Registration". In the circumstances, the Expert does not consider that the requirements of Paragraph 3 a ii are satisfied.

Turning to Paragraph 3 a iii, the Complainant has also alleged that the Respondent is engaged in a pattern of Abusive Registrations in that it has registered domain names which incorporate the registered trade marks of third parties. As the Expert has already noted above, the names on offer at the Respondent's web-site are mainly descriptive or generic. Furthermore, the Expert does not regard this case as similar to the One in a Million case, which involved a portfolio of the trading names of high profile enterprises. In the opinion of the Expert, the evidence available is insufficient to support the view that the Respondent is engaged in a pattern of making Abusive Registrations.

The Expert has also considered Paragraph 4 of the Policy headed "How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration". The provisions of Paragraph 4 a i and b are not relevant in this case and need not be considered in this Decision. Paragraph 4 ii reads as follows:

"The Domain Name is generic or descriptive and the Respondent is making fair use of it."

At all times, the Respondent has taken the view that the Domain Names are generic. The Complainant is adamant that any unauthorised use of the Domain Names would infringe its trade mark rights. It draws attention to the registration of "Prosciutto di Parma" as a "protected designation of origin" under EU Regulation 2081/92, Article 13 3 of which states "Protected names may not become generic". In the opinion of the Expert, this does not prevent the term being regarded as generic in the context of this case. The Expert

believes that, to most people, the term "Parma ham" indicates ham produced in the Parma area. Under the Complainant's Community Registration Mark No. 1116458, the list of goods for which the Complainant has registered its trade mark is expressed to be "Parma ham". It is well established that only generic terms can be specified in the list of goods and services for which a trade mark is registered. In reality, the Complainant's rights in the Domain Names are more in the nature of certification/mark rights than exclusive trade mark rights of the traditional kind. Parma ham is a genus of ham and, therefore, has to be a generic term (using the ordinary dictionary meaning of the term). In the context of the disputed Domain Names, the Expert therefore considers that the term "Parma ham" is indeed generic. In view of the comments already made by the Expert above, the Expert is also satisfied that the Respondent is making fair use of the Domain Names on its web-site as registering generic terms with a view to selling them for a market value is perfectly fair.

8 Decision

In light of the above findings, namely that the Complainant has Rights in respect of names or marks which are similar to the Domain Names but that neither of the Domain Names, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the complaint in respect of each of the Domain Names be refused.

Finally, the Expert wishes to comment on the Respondent's contention that the Complainant's use of the Policy amounts to reverse domain name hijacking. Under Paragraph 1 of Nominet's "Procedure for the conduct of proceedings under the Dispute Resolution Service" ("the Procedure"), reverse domain name hijacking "means using the Policy in bad faith in an attempt to deprive a registered Domain Name holder of a Domain Name". Paragraph 16 of the Procedure provides that, if "the Expert finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking, the Expert shall state this finding in the decision. If the Complainant is found on three separate occasions within a 2 year period to have brought a complaint in bad faith, Nominet will not accept any further complaints from that Complainant for a period of 2 years." For the avoidance of doubt, it is the view of the Expert that the available evidence does not support the Respondent's contention of Reverse Domain Name Hijacking. The Expert does not find that the Complainant has used the Policy in bad faith.