

Nominet UK Dispute Resolution Service

DRS 000473

Tag Heuer S.A –V- Sm@rtnet Limited

Decision of Independent Expert

1. Parties

Complainant: TAG HEUER S.A
Address: 14 A, avenue des champs-Montants
Marin
Postcode: 2074
Country: CH

Respondent: SM@RTNET Limited
Address: 11-12 Hanover Street
London
Postcode: W1R 9HF
Country: GB

2. Disputed Domain Names

The domain name in dispute is <tagheuer.co.uk>.

3. Procedural Background

On 28 June 2002, the Complaint was lodged with Nominet.uk (hereinafter “Nominet”) in accordance with the Dispute Resolution Service Policy (hereinafter the “DRS Policy”) and hard copies of the Complaint were received in full on 3 July 2002.

On 8 July 2002, having validated the Complaint, Nominet sent a copy of the Complaint to the Respondent and *inter alia* advised the Respondent that it was allowed 15 days within which to respond to the Complaint.

No Response was received.

On 13 August 2002, James Bridgeman was invited to act as Expert in this reference and, having confirmed to Nominet that he knew of no reason why he could not properly accept the invitation and 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, he was appointed to act as Expert in this case.

4. The Facts

The Complainant, a Swiss company engaged in the production of watches and in particular sports watches is the owner of numerous trademark registrations across the world for the trademark TAG HEUER. In particular the Complainant relies on its rights in the United Kingdom trademark registration N° 1251746, TAG HEUER and Device registered in class 14 August 26th, 1985 and International Trademark Registration N°689200, TAG HEUER of March 24th, 1998.

In the absence of a Response there is no information about the Respondent available except for the details provided on the Registrar's WHOIS database and the information provided by the Complainant in the Complaint.

5. The Parties' Contentions

Complainant's Submissions

The Complainant requests a decision that the contested domain name be transferred to the Complainant on the basis that:-

- (a) the said domain name is identical or similar to a mark in which the Complainant has rights ; and
- (b) the said domain name, in the hands of the Respondent, is an Abusive Registration.

The Complainant submits that it has been engaged in the manufacture and distribution of prestigious sports watches, identified by the trademark "TAG HEUER", since 1860.

The Complainant submits that it has an international reputation for the reliability, originality and design of its watches, and it has become the market leader in high-performance sport watches. The Complainant claims to have a world wide distribution network among the best retailers in the world, and in particular in the United Kingdom. Over the next five years, the Complainant plans to expand its network of stores in Europe and to diversify into accessories.

The Complainant submits that it is the official timer to the World Ski and Formula One Championships and is involved in many aspects of sport including sailing and athletics.

During the year 2001, the Complainant opened nine exclusive showrooms for its products in the United Kingdom. The Complainant regards Great Britain as a strategic market for its TAG HEUER branded products and has invested substantial sums in promoting its TAG HEUER branded products in the United Kingdom. Furthermore, the Complainant submits that it has built substantial goodwill by its presence on the Internet since 1995. The Complainant is the owner of the domain names <tag-heuer.co.uk>, <tagheuer.com>, <tag-heuer.com>, <tagheuer.net>, <tag-heuer.net>, <tagheuer.org>, <tag-heuer.org>, <tagheuer.ch>., <tagheuer.de>, <tagheuer.es>, <tagheuer.com.hk>. Said <tagheuer.com> domain name has been the address of an established www site since 1997 and is referenced in the major search engines.

The Complainant submits that the said domain name is identical and/or confusingly similar to trademarks in which the Complainant has rights.

In support of this claim, the Complainant has furnished evidence of its ownership of the above mentioned registrations for the TAG HEUER trademark. The Complainant submits that its rights in the TAG HEUER trademark predate the Respondent's registration of the domain name in issue in these proceedings.

The Complainant submits that the relevant portion of said domain name <tagheuer.co.uk> is composed of exactly the same verbal elements as the Complainant's TAG HEUER trademark and is thus identical and confusingly similar to the Complainant trademark. The Complainant submits that the only difference between the Complainant's trademark and said domain name, is the domain suffix corresponding to the United Kingdom ccTLD. It is submitted that this difference should not be considered relevant for the purpose of determining whether a domain name is identical to a trademark. In this regard the Complainant refers to the decision in Eli Lilly and Company –v- David Clayton (Nominet UK Dispute Resolution Service, DRS 0001, 15 November 2001)

The Complainant submits that the Respondent's registration of said domain name is a blocking registration and consequently an Abusive Registration. The Complainant submits that the Respondent could not have been unaware of the existence of the Complainant's trademark.

Furthermore, the Complainant submits that it is significant that a cease and desist letter sent by the Complainant to the Respondent on 21 November 2001 requesting the transfer the Domain Name has remained unanswered. By registering the Domain Name, the Respondent has blocked the registration of the Domain Name by the Complainant.

The Complainant submits that the British market is a huge part of its business and being deprived of the possibility of having a www site for its TAG HEUER products in this country constitutes a real handicap for the Complainant and for the development of its business. Furthermore the Complainant submits that the Respondent can sell the said domain name to anyone including a competitor of the Complainant.

The Complainant submits that the fact that British users can not reach the site of the Complainant by the most natural way for them, that is by accessing a .co.uk domain name, causes severe damage to the Complainant and is disrupting its business.

The Complainant further submits that the Respondent is engaged in a pattern of making abusive registrations. The Complainant's searches show that the Respondent has registered various domain names incorporating the trademarks of famous brands of watches. In particular, the Respondent has registered the domain names <breitling.co.uk>, <patekphilippe.co.uk>, <rado.co.uk> and <raymondweil.co.uk>. Furthermore the Respondent registered the domain name <ebel.co.uk> on October 23rd 1996. EBEL is a trademark owned by a company associated with the Complainant in the present proceedings. In proceedings brought under the DRS *viz.* Ebel S.A. v. Sm@rtnet Limited (Nominet UK Dispute Resolution Service, DRS 00251, 29 April 2002) the expert decided that the registration was an Abusive Registration and the domain name <ebel.co.uk> should be transferred to the complainant.

Consequently, the Complainant submits that it is obvious that the Respondent is engaged in a pattern of making Abusive Registrations, and that he has specialised in the registering the trademarks of companies manufacturing high-quality watches and jewellery brands as domain names.

The Complainant submits that the Respondent has no rights or legitimate interests in said domain name. The Respondent is in no way affiliated with Complainant, and the Respondent has never sought or obtained the consent of the Complainant to register the domain name with any registrar. The Complainant submits that the Respondent is not a licensee or otherwise permitted to use Complainant's trademarks. The Complainant further submits that the Respondent does not use the Domain Name as part of its legal name, corporate name as any commonly-known identifier.

The Complainant submits that said domain name <tagheuer.co.uk> is not currently used by the Respondent as the address of a www site.

Respondent's Submissions

There was no Response filed by the Respondent.

6. Discussion and Findings:

General

The *onus* rests on the Complainant to prove to the Expert pursuant to 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 domain name in dispute and, secondly, that said domain name, in the hands of the Respondent, is an Abusive Registration, as defined in paragraph 1 of the DRS Policy.

Domain Name and Trademark

The Complainant has established that it has rights in the TAG HEUER trademark. While the United Kingdom trademark registration N° 1251746, TAG HEUER and device relied upon by the Complainant is a device mark, the International Trademark Registration N°689200 relied upon is in respect of the words TAG HEUER *simpliciter* and it clear from the documentation filed in support of the Complaint, that the Complainant has common law rights in the words TAG and HEUER used as a trademark in respect of sports watches.

Since, both the domain name in dispute and the Complainant's trademark are composed of the words "tag" and "heuer" with no other elements, it is clear that they are either identical or similar to each other.

Abusive Registration

The concept "Abusive Registration" is defined in paragraph 1 of the Policy as follows:-

"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."

A non-exhaustive list of factors, which may be evidence that the domain name is an Abusive Registration is set out in paragraph 3.a of the Policy as follows:

"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;
- B. as a blocking registration against a name or mark in which the Complainant has Rights; or
- C. primarily for the purpose of unfairly disrupting the business of the Complainant;"

It is clear from the Complainant's submissions that at the time when the registration or acquisition took place, the Respondent must have been aware of the Complainant's rights in the TAG HEUER trademark.

In the absence of a Response, there is no reasonable explanation forthcoming as to any *bona fide* use the Respondent would have for said domain name. This is particularly so given the strength of the Complainant's TAG HEUER trademark in the market place in the United Kingdom, that the Respondent is in no way affiliated with Complainant, and that the Respondent has never sought or obtained the consent of the Complainant to register the domain name. Furthermore the Complainant has submitted that the Respondent has no rights or legitimate interests in said domain name and this has not been refuted by the Respondent.

The Complainant's explanation is that the registration of the domain name acts as a blocking registration against the Complainant's trademark in the sense that it prevents the Complainant from registering the words "tag" and "heuer" *simpliciter* and in combination in the .co.uk domain. This is a compelling argument and must be accepted in the absence of another explanation.

Furthermore among the non-exhaustive list of factors set out in the Policy which may be evidence that a domain name is an Abusive Registration is that contained in paragraph 3(a)(iii) that "[i]n combination with other circumstances indicating that the Domain Name is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations..." In the present proceedings the Complainant has provided *prima facie* evidence that the Respondent is engaged in such a pattern of making Abusive Registrations as evidenced by the decision of the expert in Ebel S.A. v. Sm@rtnet Limited (Nominet UK Dispute Resolution Service, DRS 00251, 29 April 2002) which were proceedings successfully brought under the DRS against the Respondent in the present proceedings by a company associated with the Complainant.

On the balance of probabilities therefore, and in the absence of a Response, the Complainant has made out a *prima facie* case that the registration is an Abusive Registration.

7. Decision

The evidence before this tribunal has therefore established on the balance of probabilities that the said domain name <tagheuer.co.uk> is identical or similar to a trademark in which the Complainant has rights, and furthermore that said domain name, in the hands of the Respondent, is an Abusive Registration as defined in paragraph 1 of the Policy.

The Complainant's application should therefore succeed. It is hereby directed that said domain name <tagheuer.co.uk> be transferred to the Complainant.