

DISPUTE RESOLUTION SERVICE

DRS 07187

Decision of Independent Expert

Procter & Gamble Business Services Canada Company

and

Gregory Brine

1. The Parties:

Complainant: Procter & Gamble Business Services Canada Company

Address: C/O Stewart McKelvey
Stirling Sales
Suite 900, 1959 Upper Water Street, PO Box 997
Nova Scotia
Halifax
Postcode B3J 2X2
Country: Canada

Complainant Representative:
Gemma Williams
D Young & Co
Briton House, Briton Street
Southampton, Hampshire
SO14 3EB
United Kingdom

Respondent: Gregory Brine
Address: Natraj Building
The Tanneries
London
Postcode: SE1 3XG
Country: United Kingdom

2. The Domain Name(s):

oral-b.co.uk

3. Procedural History:

A copy of the Complaint was received in full by Nominet on 28th April 2009. Nominet validated the Complaint and notified the Respondent of the Complaint.

No Response has been received and therefore informal mediation was not possible.

On 9th June 2009 the Complainant paid the fee to obtain the expert decision pursuant to paragraph 21 of the Nominet Dispute Resolution Service procedure ("the Procedure")

On the same date, Peter Davies, the undersigned ("the Expert"), confirmed to Nominet that he knew no reason why he could not properly accept the invitation to act as the 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 question his independence and/or impartiality.

The Respondent has not submitted a response to Nominet in time (or at all) in compliance with paragraph 5(a) of the Procedure.

Paragraph 15(b) of the Procedure provides, inter alia, that "*if, in the absence of exceptional circumstances, a party does not comply with any time periods laid down in the policy of this procedure, the Expert will proceed to a decision on the Complaint*".

Nominet appears to have used all of the available contact details to try to bring the Complaint to the Respondent's attention. There are thus no exceptional circumstances involved and I will therefore proceed to a decision on the Complaint notwithstanding the absence of a Response.

3. Factual Background

The Complainant is a subsidiary of The Proctor and Gamble Company and is the Registered Proprietor of United Kingdom trade mark registrations for trade marks comprising the term ORAL B as follows:

1148558 ORALB,
1081450 ORAL-B,
1080419 ORAL-B,
1080420 O R A L - B,
978701 ORALB.

The Complainant also owns several Community Trade Mark Registrations and Applications for trademarks comprising the term ORAL B. In conjunction with its parent and sister companies the Complainant is the owner of domain name registrations that contain the element ORAL B worldwide, including:

www.oralb.com

www.oral-b.com
www.oralb-la.com
www.oralb.co.uk

Annual turnover figures for products bearing the ORAL-B trademark in the United Kingdom for 2007-08 are approximately £120,400,000.

The Respondent is identified in the “Whois” Directory as the registrant of the Domain Name, which was registered on 27th October, 2005. No Response has been received to this Complaint.

There is to the Complainant’s knowledge, no prior relationship between the Registrant and the Complainant.

The Domain Name presently directs to a website providing search facilities and links to third party websites offering dental and dentistry products and services.

4. Parties’ Contentions

4.1 Complainant

The Complainant submits that it has rights in a name which is identical or similar to the Domain Name and sets forth the following matters in support of its claim.

The Complainant is an active trading subsidiary of The Procter & Gamble Company, which is a well known Fortune 500 company and a global corporation. manufacturing a wide range of consumer goods.

The ORAL B trademark was first used in the USA in 1950. The Complainant assumed ownership of the ORAL B trade marks in 2005 from its now sister company Gillette and continues to build up a substantial reputation in the ORAL-B trademarks as a result of their use in the United Kingdom and European Union. The Complainant’s products are aimed at the mass market and are available through a wide range of retailers, including online stores.

The Complainant enjoys significant market reputation and goodwill in ORAL-B products, as revealed in their sales performance and customer satisfaction and awareness surveys, and is the market leader for tooth care products.

ORAL-B products are promoted on the website www.oralb.com which was registered by the Complainant’s sister company Gillette on 9 July 1995. This website receives on average more than 3600 visitors each day.

The Complainant further submits, for the reasons set out below, that the Domain Name is abusive in the hands of the Respondent.

The Complainants have established significant goodwill in the ORAL-B trademark in the United Kingdom and the European Community. Its several trademark registrations for ORAL-B and the substantial sales of products bearing the ORAL-B trademark in the United Kingdom all support the contention that the Respondent must have been aware that the name ORAL-B denoted the Complainant’s

predecessor's products and trade marks, which are now owned by the Complainant.

The Complainant believes that the Domain Name was registered primarily to stop the Complainant's predecessor registering it to reflect its trademark rights and legitimate business interests in the United Kingdom as the logical UK companion to its oralb.com domain name.

The Domain Name directs to a website providing search facilities and links to third party websites offering dental and dentistry products and services. It is believed that the Respondent derives income by directing Internet traffic to these third party dental and dentistry websites. The Respondent is trading on the reputation of the Complainant's brand to attract consumers seeking dental products or services to his website where they are referred to third party sites offering alternative dental products and services to those offered by the Complainant, thereby deriving income for the Respondent.

As the Respondent does not appear to trade in person under the domain name oral-b.co.uk, the Complainant believes that the Respondent has no legitimate interest in the Domain Name.

The registration of the domain name causes detriment to the Complainant's rights by preventing them from using the Domain Name to establish a legitimate website in the United Kingdom, reflecting its business activities in the ORAL-B name in the United Kingdom, and falsely diverting to third party dental or dentistry websites, prospective consumers of the Complainant who should have been led to the Complainant's own website www.oralb.com and ORAL-B branded products. Indeed, consumers consulting the Domain Name could only have been seeking the Complainant's products.

4.2 Respondent

No response has been received.

5. Discussions and Findings

5.1 Rights

General

Under paragraph 2 of the Dispute Resolution Service Policy ("the Policy") the Complainant is required to show, on the balance of probabilities, that;

- (1) it has rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- (2) the Domain Names in the hands of the Respondent are an Abusive Registration.*

The Policy defines rights as including but not limited to "...rights enforceable under English laws."

Complainant's rights

The Domain Name was not registered by the Respondent until 2005. A great many domain names relating to the Oral B brand were registered in earlier years by the Complainant or by the previous proprietor of the brand, but the Domain Name which is the subject matter of this Dispute was not. No reason for this was provided in the Complaint. However, I do not think that this issue seriously undermines the Complainant's claim. The Complainant's trademarks relating to its Oral B brand and the goodwill deriving from its substantial market presence constitute legal rights which were clearly enforceable at the time of the registration of the Domain Name by the Respondent. Accordingly, I find that the Complainant has rights in a name or mark which is identical or similar to the Domain Name.

5.2 Abusive Registration

General

Paragraph 5 a of the DRS Procedure states that

"Within (15) fifteen days of the date of the commencement of proceedings under the DRS, the Respondent shall submit a Response to us"

Paragraph 15 c of the DRS Procedure states that

"If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate."

As no Response has been received from the Respondent, the Expert will proceed in accordance with this Paragraph 15 c of the Procedure.

Abusive Registration is defined in the Policy as

"... a domain name which either

(a) was registered or otherwise acquired in the 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

(b) has been used in a manner which took unfair advantage of, was unfairly detrimental to the Complainant's Rights."

Paragraph 3 (a) of the Policy provides a non-exhaustive list of the factors which may evidence that a domain name is an Abusive Registration including, *inter alia* :

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

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;

B as a blocking registration against a name or mark in which the Complainant has Rights; or

C for the purpose of unfairly disrupting the business of the Complainant;

ii. 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 is registered to, operated or authorised by, or otherwise connected with the Complainant;”

Registration by the Respondent

The prominence of the Complainant's brand, its market presence and its protection via trademark registrations strongly suggest that the Respondent knew of the Complainant and of its rights in the Oral B brand name when the Domain Name was registered.

The site to which the Domain Name refers is clearly related to activity associated with the Complainant's business. It is likely, on the balance of probabilities, that potential customers connecting to the Domain Name would do so expecting to find reference to the Complainant and its branded products. The Complainant asserts that Respondent seeks to take advantage of this initial interest confusion, and presumably benefits financially, by providing users with search facilities to locate alternative dental products and services to those offered by the Complainant. The Expert sees no grounds, on the balance of probabilities, for disagreeing with this assertion.

Paragraph 4 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. On the information available, none of these factors appear to apply and in the absence of a Response, there is nothing to contradict the conclusion that the registration of the Domain Name constitutes an Abusive Registration as contemplated in Paragraph 3 (a) i C and 3 (a) ii of the Policy.

6. Decision

For the reasons set out above, I find that the Complainant has rights in a name which is identical or similar to the Domain Name and that the Registration in the hands of the Respondent is an Abusive Registration. I therefore direct that the name be transferred in accordance with the terms of the Complaint.

Signed: Peter Davies

Dated: 29 June, 2009