

**DISPUTE RESOLUTION SERVICE**

**DRS 7779**

**Decision of Independent Expert**

**OSRAM GmbH KG**

and

**OSRAM BIKES**

**The Parties**

Complainant: OSRAM GmbH KG  
Address: c/o Steffen Siguda  
Hellabrunner Str. 1  
Muenchen  
Bayern

Postcode: 81543 DE  
Country: Germany

Respondent: Osram Bikes  
Address: 1 Armadale Villas  
Southwood Road  
Ramsgate  
Kent

Postcode: CT11 OAR  
Country: United Kingdom

**The Domain Name**

osram-bikes.co.uk

**Procedural History**

1. The following is the brief procedural history of this dispute:-

30 September 2009 Complaint received and validated. Notification of complaint sent to the parties.

22 October 2009 No Response received. Notification of no response sent to the parties.

4 November 2009 Expert decision payment received by Nominet.

## **The Parties**

2. The complainant is OSRAM GmbH KG (“the Company”), a company incorporated under the laws of Germany and a member of the OSRAM group of companies. It is one of the 2 leading lighting manufacturers in the world, with over 38,000 employees, supplying customers in approximately 150 countries, with 49 manufacturing plants in 19 countries.

## **The Respondent**

3. The details of the registration held by Nominet on the publicly available part of its database are as follows. The identity of the registrant, i.e. the Respondent, is ‘Osram Bikes’, the ‘registrant type’ is ‘unknown’ and the registered address is 1 Armadale Villas, Southwood Road, Ramsgate, Kent, CT11 OAR. The Domain Name was first registered on 8 December 2008. The Complaint and extracts from the web-site downloaded by the Expert on 22 November 2009 (see below) indicate that Osram Bikes is a business started by one Jason Oram (“Mr Oram”) in 2008, which is based in Ramsgate, Kent and provides bicycle repair services. The postal address of the business given on the web-site is the same as the registered address held by Nominet.

## **Parties’ Contentions**

### The Complaint

4. The Company says that it owns a number of UK trademarks in the word ‘OSRAM’, including:-

No. 282003 of 11 April 1906, for class 11.

No. 330828 of 2 February 1911, for classes 6,9,11,15 and 16.

No. 574688 of 26 January 1937, for classes 5,9,10,11 and 21.

The Company owns 116 trademarks throughout the world and on 17 April 1906 the word OSRAM was registered as a trademark for ‘electrical incandescent and arc lamps’. Due to the extensive international use of its trademarks, they have become internationally well-known. The notoriety of

the OSRAM mark has been recognised in a number of WIPO cases concerning .com domain names including the word osram. The company owns in excess of 141 domain names based on the word OSRAM, including 3 .co.uk registrations (osrampowerleds.co.uk, osram-product-training.co.uk and osram-os.co.uk).

5. The registration osram-bikes.co.uk is an Abusive Registration for the following reasons. The Company has attempted to contact the owner of the domain name by email, without success. Obviously, that web address was not registered for private use, but for selling services and products. To choose a domain name including a famous trademark like 'osram' is an excellent way to create traffic for the site at the expense of the internationally known Company. This means that the popularity of the Company is exploited for promoting the domain osram-bikes.co.uk. This domain, not owned by the Company, will be associated closely with OSRAM and will gain considerably in popularity. Most likely visitors to the web-site osram-bikes.co.uk will be misled into thinking that 'osram bikes' could be part of the Company, or sponsored by it.
6. There are no legal grounds for the selection of this domain name. The name of the founder of 'osram bikes' was J Oram, without the letter 's'. Thus, there is no reason to use the well-known trademark in the name of the firm and in the domain name. The Respondent is not a distributor of the Company and no licence agreement exists between it and the Company. The use of the word 'osram' in the domain name osram-bikes.co.uk causes confusion and is misleading.

#### The Response

7. There has been no Response.

#### **Further Information**

8. On 22 November 2009 the Expert downloaded extracts from the web-site operating at [www.osram-bikes.co.uk](http://www.osram-bikes.co.uk). No web-pages had accompanied the Complaint and the Expert considered that the Decision in this matter should take account of the contents of that site. On 26 November 2009, Nominet issued the following requests pursuant to paragraph 13a of the DRS Procedure -
  1. Could both parties please refer to the extracts from the web-site at [www.osram-bikes.co.uk](http://www.osram-bikes.co.uk) downloaded by the Expert on 22 November 2009. Is there anything that either party wishes to say in connection with the dispute (DRS 7779 osram-bikes.co.uk) arising out of the contents of those extracts? If so, any such information to be provided to Nominet by 4pm on Friday, 4 December 2009.

2. Can the [Company] please refer to the following sentence in the Complaint,

“We tried several times to connect by email, but no reply was made ever by the owner of osram-bikes.co.uk.”

Could the [Company] please (1) produce copies of the emails referred to, (2) identify the email address or addresses used and (3) state why an email sent to such address or addresses was likely to come to the attention of the Respondent or other person in question. Such information and documents to be provided to Nominet by 4pm on Monday 30 November 2009.

3. The information and copy emails supplied by the [Company] pursuant to paragraph 2 above to be copied to the Respondent by Nominet as soon as practicable upon receipt and the Respondent to have until 4pm on Friday 4 December 2009 to state whether or not those emails were received and if so when they were received.
9. The Company supplied emails on 30 November 2009, which were forwarded by Nominet by email to the address [info@osrambikes.co.uk](mailto:info@osrambikes.co.uk), as had been the Request made on 26 November 2009. However, both emails were returned to Nominet as undelivered. The information supplied on behalf of the Company on 30 November 2009 confirmed that 3 items of correspondence (see paragraphs 10 and 12 below) had been sent to the Respondent at this email address, that being the address given on the Respondent’s web-site. The Company also made various points on the contents of the web-site, which were little different to those made in the Complaint.
10. A further request (“Request 2”) was directed by the Expert pursuant to paragraph 13a on 8 December 2009, which required that, so far as the Respondent was concerned, it be delivered by Special Delivery post to 1 Armadale Villas, Southwood Road, Ramsgate, Kent, CT11 0AR, the registered address for the Domain Name. This request stated, -
  1. Could the [Company] please state whether and if so when returned email delivery notices were received by it in respect of any of the emails produced by it to Nominet on 30 November 2009, being the email and letter each dated 29 May 2009 and the email dated 15 June 2009, such information to be supplied by 4pm on Tuesday 15 December 2009.
  2. The Respondent to have until 4pm on Tuesday 15 December 2009 to -
    - i) state whether or not the emails referred to in paragraph 1 above, being those accompanying this Request, were received and if so when they were received.

- ii) say anything it wishes in connection with the dispute (DRS7779 osram-bikes.co.uk) arising out of the extracts from the web-site at [www.osram-bikes.co.uk](http://www.osram-bikes.co.uk) downloaded by the Expert on 22 November 2009 accompanying this Request.
11. Request 2 was served by Nominet on the Respondent on 8 December 2009, in the manner directed. Mr Oram telephoned Nominet. He spoke to Ms Madeline Stamp, a member of Nominet's DRS Team. He told her that he had received 'the letter' from Nominet and wondered what it was about. He said that he had seen the other correspondence from Nominet but had decided to ignore it. (He did not refer specifically to the correspondence sent from or on behalf of the Company.) He was told that a complaint had been submitted about this domain name, that an expert had been appointed to the case and had asked for some information from him, that he should read the letter and if he wanted to respond to send an email to [drs@nominet.org.uk](mailto:drs@nominet.org.uk). On 15 December 2009 Nominet received the following email from Mr Oram (from an address other than info@osram-bikes.co.uk), -

osram/bikes.co.uk

responding to letters that have been sent osram bikes is a club website for local riders in the thanet area we did not sell any products as funds were short website has been shut down and is no longer operating

many thanks

jason oram

Request 2 was not served on the Company until 17 December 2009 and I directed that it be given until 12 noon on Monday, 21 December 2009 to respond. By an email to Nominet dated 18 December 2009 sent on behalf of the Company by its lawyers (see paragraph 12 below), it stated that the 3 items of correspondence had not been returned as undelivered or otherwise returned through the email system.

12. The emails produced were written by Hofstetter, Schurack & Skora ("HSS"), Patent Attorneys and Lawyers from Munich, acting on behalf of the Company. The first was dated 29 May 2009, addressed to info@osram-bikes.co.uk. There was a second communication from that firm addressed to info@osram-bikes.co.uk on that date. This was a letter. Both communications asked the owners of the business named as Osram Bikes to cancel their registration at [www.osram-bikes.co.uk](http://www.osram-bikes.co.uk) by 10 June 2009. Each stated that, among other things, HSS's client OSRAM GmbH owned the trade mark OSRAM throughout the world, that the name of the founder of the business Osam Bikes was J. Oram and that there was no reason to use the name of the well-known trade mark in the name of the firm, which was neither a distributor nor a licensee of the Company. Use of the name

osram in that business name was confusing and misleading and the owners of the business were trading on the name of the well-known trade mark OSRAM, leading people wrongly to believe that that the business was, for example, sponsored by OSRAM. There was a further email from HSS dated 15 June 2009, addressed to [info@osram-bikes.co.uk](mailto:info@osram-bikes.co.uk), in similar terms to the email and letter dated 29 May 2009, requiring that the registration be cancelled by 19 June 2009. The further information supplied by the Company stated that the emails and letter had been emailed by HSS to the address [info@osram-bikes.co.uk](mailto:info@osram-bikes.co.uk), which was the contact email address given on the Respondent's web-site.

## Discussions and Findings

13. Notification of the Complaint by Nominet was sent to the Respondent on 30 September 2009 by Royal Mail Special Delivery post to 1 Armadale Villas, Southwood Road, Ramsgate, Kent, CT11 OAR.
14. In view of this postal service at the address shown in the domain name register database entry for the Domain Name, the Complaint has been validly served under paragraph 2a of the DRS Procedure. I add that in view of the telephone conversation between Mr Oram and Ms Stamp, I find that the Complaint did come to his attention and therefore to the attention of the Respondent: see paragraph 21 below.
15. Notification of the Complaint by emails sent on 30 September 2009 to [info@osram-bikes.co.uk](mailto:info@osram-bikes.co.uk) (the email address held by Nominet for the Respondent) and [postmaster@osram-bikes.co.uk](mailto:postmaster@osram-bikes.co.uk) were returned to Nominet undelivered. However, for the purposes of notification of the Complaint, this does not matter, in view of the valid postal service.
16. The Complainant is required under clause 2b of the Policy to prove to 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.

### Does the Company own Rights?

17. By paragraph 1 of the Dispute Resolution Policy ("the Policy"), -

*'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.'*

I find that the Complainant owns the following UK trade marks in the name OSRAM, first registered in the dates appearing below -

No. 282003 of April 1906, for class 11.

No. 330828 of 2 February 1911, for classes 6, 9, 11, 15 and 16.  
No. 574688 of 26 January 1937, for classes 5, 9, 10, 11 and 21.

These Rights are in respect of a name or mark, namely OSRAM, which is similar to the Domain Name, osram-bikes.co.uk.

### Is the Registration Abusive?

18. The Company also bears the burden of establishing on the balance of probabilities that the registration was abusive. Paragraph 1 of the Policy states, -

***'Abusive registration means a Domain Name which either:***

- i. was registered or otherwise acquired in a manner which, at the time when the registration or other 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.'*

Paragraph 3 of the Policy states -

### ***'3. Evidence of Abusive Registration***

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:-*
  - i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:  
A....  
B....; or  
C. for the purpose of unfairly disrupting the business of the Complainant.*
  - ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to, the Complainant.'*

Paragraph 4 of the Policy states, -

### ***'4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration.***

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:*

- i. *Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:*
    - A. *used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;*
    - B. *been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or*
    - C. *made legitimate non-commercial or fair use of it.*
  - ii. *The Domain Name is generic or descriptive and the Respondent is making fair use of it.*
- .....'

19. I accept the Company's case set out in the Complaint concerning the details of its worldwide business. What about the Respondent? I refer to the following extracts from the website of 'Osram-Bikes.co.uk', which domain name is posted on the web-pages from the web-site as a legend in large white writing on a black background. Those pages include the following -

**Osram bikes**

Welcome to Osram bikes, Thanet's online cycle shop and repairs. At this point in time we are only taking on repairs as our online store is coming very soon. .... 16<sup>th</sup> Jan – Official opening of Osram bikes repair shop. ..

**About us**

Osram Bikes was started in 2008 by Jason Oram; as a local youth worker and a Trials rider .. he always had a passion for [the] biking industry and always wanted to have a business in the sport. With 5 years of experience in cycle maintenance [sic] and know the industry [ sic] so well Jason opened a local repair shop in Thanet with the help of his managers Mike and Stella Andrea. Now Jason hopes to expand his business with an online store and a local bike shop which specialises in trials and bmx bikes.

**Services**

Do you live in Thanet? Does your Bike [sic] need a service or has a repair issue? Then Osram bikes is the place to come

**Contact Us**

Email – [info@osrambikes.co.uk](mailto:info@osrambikes.co.uk)

...

Our main office is:

1 Armadale Villas



Southwood Road  
Ramsgate  
Kent  
CT11 0AR.

The site also advertised the 'official opening' of 'Osram bikes repair shop' on 16 January 2010.

20. In light of these extracts from the Respondent's web-site I find that the Respondent was until very recently an online business trading under the name of 'Osram Bikes', using the Domain Name for a web-site to advertise its services.
21. The Domain Name was first registered on 8 December 2008. Osram Bikes was started by Mr Oram in 2008. Osram Bikes is, as I infer from the contents of the web-site, Mr Oram trading under that business name either on his own or with others. The business has been based in Ramsgate, Kent, providing bicycle repair services.
22. Paragraph 15c of the DRS Procedure provides that, -

If, in the absence of special 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.

Paragraph 5a of the DRS Procedure provides that, -

Within 15 days of the date of commencement of proceedings under the DRS, the Respondent shall submit a Response to us.

Paragraph 13a provides, -

... the Expert may request further statements or documents from the Parties ...

23. The Respondent decided to ignore the Complaint. That might have been because he has no interest in the Domain Name because the business has ceased trading. Even so, it would have been easy for Mr Oram to have explained in a sentence or so why the name 'osram' had been chosen as part of the Domain Name. He chose not to do so.
24. The Respondent also maintained a silence in the face of emails, which as I find were sent and delivered to the Respondent by HSS on behalf of the Company. Both the email and the letter of 29 May 2009 asked the owners of the business named as Osram Bikes to cancel their registration at [www.osram-bikes.co.uk](http://www.osram-bikes.co.uk) by 10 June 2009. Each stated that, among other things, HSS's client OSRAM GmbH owned the trade mark OSRAM throughout the world, that the name of the founder of the business Osram Bikes was J. Oram and that there was no reason to use the name of the well-known trade mark in the name of the firm, which was neither a

distributor nor a licensee of the Company. Use of the name osram in that business name was confusing and misleading and the owners of the business were trading on the name of the well-known trade mark OSRAM, leading people wrongly to believe that that the business was, for example, sponsored by OSRAM.

25. The further email of HSS dated 15 June 2009 was sent and received by the Respondent and was in similar terms to the emails sent on 29 May 2009, requiring that the registration be cancelled by 19 June 2009.
26. Thus, from the early Summer of 2009 the Respondent chose not to answer allegations that have been put concerning the reasons why the word 'osram' has been used as part of the business name and the intended consequences of that use. I find it likely that the Respondent still had a commercial interest in the Domain Name in May and June 2009. The web-site was still offering repair services on 22 November 2009, with a view to opening an online shop. The site also advertised the 'official opening' of 'Osram bikes repair shop' on 16 January 2010. I infer that the reason why there has been no substantive response to the allegations now made on 4 occasions is because there is no answer to them.
27. It is worth setting out the main thrust of the allegations in the Complaint, namely –

Obviously, that web address was not registered for private use, but for selling services and products. To choose a domain name including a famous trademark like 'osram' is an excellent way to create traffic for the site at the expense of the internationally known Company. This means that the popularity of the Company is exploited for promoting the domain osram-bikes-co.uk. This domain, not owned by the Company, will be associated closely with OSRAM and will gain considerably in popularity. Most likely visitors to the web-site osram-bikes.co.uk will be misled into thinking that 'osram bikes' could be part of OSRAM GmbH KG, or sponsored by it.

There are no legal grounds for the selection of this domain name. The name of the founder of 'osram bikes' was J Oram, without the letter 's'. Thus, there is no reason to use the well-known trademark in the name of the firm and in the domain name. The firm is neither a distributor of the Company and no licence agreement exists between it and the Company. The use of the word 'osram' in the domain name osram-bikes.co.uk causes confusion and is misleading.

28. I make the following findings. At the time when the Domain Name was first registered on 8 December 2008, the Respondent was aware of the Company's well-known brand name. I accept that the domain name was chosen to create traffic for the site at the expense of company behind the well-known OSRAM mark.
29. I also find that it was intended by the Respondent at the time of first registration of the Domain Name that the popularity of the Company's

brand would be exploited for promoting the domain osram-bikes-co.uk. It was intended that this domain would be associated closely with OSRAM and would gain in popularity as a result. The Respondent also intended that visitors to the web-site at www.osram-bikes.co.uk would be misled into thinking that 'osram bikes' could be part of the company behind the OSRAM brand, sponsored by it or to have some other commercial connection with that brand. That intention is evidenced by the subsequent use of the Domain Name for the Respondent's web-site business, and by the Respondent's silence in the face of the allegation that such was its intention.

30. There might have been possible explanations of why the name Osram was chosen, apart from that alleged by the Company. For example, it might have been said that Osram was an amalgam of J.Oram and some other name or some like explanation. Had an explanation been given, its truth or falsity would have been considered and a finding made one way or the other. However, no explanation has been given.
31. Again, it might have been thought that there is no obvious connection between lights and bicycle repairs: that it was unlikely that the Respondent would have wanted to create the impression of such a connection in the minds of visitors to its web-site. However, the allegation that this was precisely the intention of the Respondent has not been denied and is not inherently improbable.
32. For example, persons browsing the internet for bicycle repair or sales services would suffer initial interest confusion in seeing the Domain Name containing the same letters as the well-known brand name OSRAM. They might well think it is a site worth visiting, because it had some connection with the OSRAM brand, a mark of quality.
33. I now consider the subsequent use of the Domain Name, after its first registration. I bear in mind the contents of the web-site. In view of my finding that the Respondent intended that his choice and use of a domain name confusingly similar to the OSRAM brand should confuse people or organisations into believing that there was a connection, the likelihood is that visitors to the Respondent's web-site thought that one did exist. That inference is reinforced by the fact that, as I find, the Respondent has traded under the name Osram Bikes since at the latest December 2008. I also take into account the Company's unanswered assertions that use of its trademark in the context complained was confusing and misleading and that the Respondent was trading on the name of the well-known trade mark OSRAM, leading people wrongly to believe that that the business was connected to OSRAM, for example being sponsored by it.
34. The findings made in paragraphs 19-33 above show that the registration is an Abusive Registration. Both limbs of the definition under paragraph 1 of the Policy are satisfied. As far as the first limb under paragraph 1 is concerned, the listed ways of establishing abusive registration in paragraph 3 are non-exhaustive. Although the registration was not primarily for the purpose of unfairly disrupting the business of the complainant, the

registration was made with full knowledge of the complainant's brand and with the intention of making use of the accrued goodwill in that name. It took unfair advantage of the complainant's Rights by making use of the registered name to confuse visitors to that domain into believing that there was some kind of commercial connection with the complainant. That unfair advantage would be caused by initial interest confusion, when persons seeking bike repair services browsed the internet to identify bike repair services; and also by what I have found to be the intended trading use of the Domain Name (to set up a web-site suggesting a connection with the OSRAM brand), to trade on the back of the complainant's goodwill.

35. The second limb of the definition under paragraph 1 of the Policy has been made out in the respects set out in paragraph 3a.ii. That is to say, the Respondent has used 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 to, the Complainant. The fact that the Respondent now says that there is no intention to continue to use the Domain Name in the manner complained of does not turn the registration into a non-abusive registration. The whole of the intended and actual use to date is relevant and, to the extent that it is relevant, I do not consider that the Company should be required to take at face value the Respondent's statements as to its intentions, made very late in the day.
36. In view of the findings of fact that I have made, none of the factors in paragraph 4 of the Policy apply.
37. I conclude that the Domain Name was registered in a manner which, at the time when the registration took place, took unfair advantage of the Company's Rights and also, that it has been used in a manner which has taken unfair advantage of the Company's Rights.

## **Decision**

38. The Expert finds that the Complainant has Rights in a name or mark which is similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. The Expert therefore directs that the domain name 'osram-bikes.co.uk' be transferred to the Complainant.

**STEPHEN BATE**

**21 December 2009**