



DISPUTE RESOLUTION SERVICE

D00013431

Decision of Independent Expert

Dong Sung Pharm. Co., Ltd.

and

Mr Timothy Hayes

1. The Parties:

Complainant: Dong Sung Pharm. Co., Ltd.
703-17 Banghak-Dong, Dobong-Gu
Seoul
13020
Korea, Democratic People's Republic of

Respondent: Mr Timothy Hayes
Suite 11, 264 Lavender Hill
London
SW11 1LJ
United Kingdom

2. The Domain Name:

beetox.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

16 October 2013 12:55 Dispute received
16 October 2013 13:22 Complaint validated
16 October 2013 13:43 Notification of complaint sent to parties
04 November 2013 01:30 Response reminder sent
07 November 2013 09:51 Response received
07 November 2013 09:51 Notification of response sent to parties
12 November 2013 01:30 Reply reminder sent
14 November 2013 13:48 Reply received
14 November 2013 13:49 Notification of reply sent to parties
14 November 2013 13:50 Mediator appointed
19 November 2013 10:30 Mediation started
03 December 2013 13:33 Mediation failed
05 December 2013 13:41 Close of mediation documents sent
05 December 2013 13:42 Expert decision payment received

4. Factual Background

The Complainant is a South Korean pharmaceutical company. It owns South Korean trade mark registrations for BEESTOX for dermatological pharmaceutical products dating back to 2010 and predating registration of the Domain Name in 2011.

Timothy Hayes and Adam Elabdaly are the founders of Beetox Limited, a UK company formed on 21 November 2012 with a bee venom skin care range. The Respondent's web site attached to the Domain Name offers a range of beauty products under the name 'Beetox'.

5. Parties' Contentions

The Complainant's contentions relevant to the DRS procedure can be summarized as follows:

The Complainant is one of South Korea's leading pharmaceutical companies established in 1957. It owns South Korean trade mark registrations for BEESTOX for dermatological pharmaceutical products dating back to 2010 and predating registration of the Domain Name in 2011. One of its products is a skin cream containing bee venom silk protein prominently branded with the BEESTOX marks.

The Domain Name is highly similar to the Complainant's mark BEESTOX which is a made up word, the only difference being the absence of the letter S which is not enough to distinguish the Domain Name from the Complainant's trade mark.

The Respondent's web site attached to the Domain Name offers a range of beauty products under the name BEETOX. The web site also contains text on the background and science regarding bee venom products. It contained a video, the copyright in which is owned by Chungjin Biotech Company Limited, a South Korean company, in breach of that company's copyright and statements in breach of UK advertising codes. This failure to meet high standards required by the sector is highly damaging to the Complainant.

It is highly unlikely in this regulated market with a small restricted number of entities in the market place, especially given that BEETOX and the distinctive part of the Domain Name are so similar that the Respondent would not have been aware of the Complainant prior to registration of the Domain Name.

The Complainant has no connection with the Respondent and has not consented to registration or use of the Domain Name. The Respondent applied to register 'Beetox' as a trade mark, but the application was withdrawn. The Respondent has no legitimate interest in the Domain Name.

It is likely that customers seeing the Domain Name would be confused into believing there exists a connection between the Respondent, the Domain Name and the Complainant. The Domain Name is like a typo registration omitting only the letter S and many customers may not notice the difference, especially due to the identical nature of the Respondent's products to the Complainant's. The Domain Name, therefore, misrepresents the source of the Respondent's goods. The Respondent is seeking to trade and profit off the Complainant's recognised reputation and goodwill which is unfairly detrimental to the Complainant's rights.

The Respondent's contentions relevant to the DRS procedure can be summarized as follows:

Timothy Hayes and Adam Elabdaly are the founders of Beetox Limited, a UK company with a bee venom skin care range. Timothy was born in Tauranga, New Zealand where he grew up surrounded by the local bee farms of the Kaimai ranges, the home of some of the highest level Manuka honey on the market. The Respondent acknowledges that the Complainant appears to own two South Korean trade mark registrations for BEESTOX and that these are similar to the name Beetox, but denies that the Complainant has established any unregistered rights based on a name similar to Beetox.

Timothy developed the name Beetox over the period from April 2012 through till October 2012 using a combination of two distinct elements relating to the product. The 'Bee' comes from the insect providing the main ingredient for the product whereas the 'tox' derives from the well known detoxifying health benefits that come from the Manuka Flower *Leptospermum* plant. Initially the first proposal and logo related to 'B-tox', but it was decided that the whole word 'Bee' was too important to the marketing and consumer product awareness and 'Bee-tox' was decided on and two domains were registered: bee-tox.com and bee-tox.co.uk. In September of 2012 Timothy was advised by his girlfriend, a fashion

designer, to declutter the logo by taking away the dash line. Timothy agreed and moved forward with 'Beetox'. Beetox.co.uk was owned by Wonka Enterprises, but a transfer of the Domain Name was negotiated in October 2012 and was acquired for genuine business purposes. On 21 November 2012 Beetox Limited was formed.

Timothy Hayes and Adam Elabdaly deny any knowledge of the existence of the Complainant or its BEESTOX brand until receiving a letter dated 9 July 2013 from the latter's legal representatives. There is no evidence that the Complainant traded under BEESTOX at the time the Domain Name was registered and transferred. The Complainant's domain name beestox.co.uk has no web site attached to it and beestox.co.uk, beestox.asia and beestox.kr are still available. There is no turnover, marketing expenditure or dated advertising samples.

The video was placed in error on the Respondent's site by the web development company and removed immediately upon discovery. There is no branding on it. It is not relevant to the Domain Name.

After advice from the ASA and CAP it was found that statements on the Respondent's website do not breach any code and were not inappropriate or unlawful in any way. Again this is irrelevant to the issue of the Domain Name.

The Respondent's trade mark application for Beetox has not been withdrawn, but has been opposed by the Complainant.

The Respondent denies confusion as there is virtually no evidence that the Complainant has ever used the mark BEESTOX in any significant way or in any manner connected with the UK.

The selection of the name Beetox revolved around generic terms relating to the industry and was nothing to do with BEESTOX the Complainant's mark. The Respondent has a genuine trading presence on the UK market.

The Complainant's Reply as far as relevant can be summarised as follows:

The Respondent admits the Complainant's trade mark and the Domain Name are similar. Its comments about the Complainant's unregistered rights are irrelevant.

The Respondent must have known the video was being used on its web site in reckless disregard of intellectual property rights.

The Complainant said the trade mark application of the Respondent was withdrawn as the UK Trade Mark register said it was withdrawn due to non payment of a fee, which must have been subsequently paid.

6. Discussions and Findings

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy). Right is defined as 'rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'.

Complainant's Rights

The Complainant is the proprietor of registered trade marks for BEESTOX in South Korea, rights acknowledged by the Respondent and which qualify for the purposes of the Policy under the definition of Rights as set out above. The Domain Name consists of the name 'Beetox' and the generic suffix .co.uk. 'Beetox' differs only in the omission of one letter 's' which is equivalent to single versus plural, 'bee' versus 'bees'. As such the name 'Beetox' is visually, orally and conceptually similar to the Complainant's BEESTOX mark. Accordingly the Expert finds that the Complainant has Rights in respect of a name or mark, which is similar to the Domain Name. As the Complainant has registered trade marks it is not necessary to consider the issue of any unregistered rights for this limb of the Policy.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an 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 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 3a of the Policy. There being no suggestion that the Respondent has engaged in a pattern of making Abusive Registrations and there being no suggestion that the Respondent has given false contact details, has a relationship with the Complainant or has tried to sell the Domain Name, the only potentially relevant 'factors' in paragraph 3 are to be found in subparagraph i and ii which read as follows:

- i "Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. (intentionally omitted);
 - 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 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 with the Complainant”

This decision is not straightforward given that the Respondent is based in England and the Complainant is based in South Korea and has not produced significant evidence of use of the BEESTOX registered mark and, therefore, secondary meaning other than an example of product packaging and printouts from web sites based in Asia.

Nevertheless, the name BEESTOX is an artificially made up name, searches against it bring up a long list of results referring to Asian web sites which appear to be use as a brand name and not generic English language use referring to bee venom products. Also the expert is persuaded by the representations of the Complainant that this is a small industry where participants are likely to be aware of the products of major players internationally. Mr Hayes of the Respondent appears to have spent his life around the apiary industry; the use by the Respondent began the year after use by the Complainant and the Respondent's web site featured a video showing extraction of bee venom in South Korea. The Domain Name is very similar to the Complainant's BEESTOX mark.

Whilst the mark appears to be an artificial combination of the ordinary word 'bee' which is clearly relevant to the industry concerned and part of relevant ordinary words such as 'toxin' or 'detox', it is not the most intuitive description of bee venom products and the word 'toxin' or 'detox' does not appear in any of the marketing materials for the Respondent's or Complainant's products submitted in English as evidence even in a descriptive sense.

Accordingly the expert finds it likely on the balance of probabilities that the Respondent had the Complainant in mind when the Domain Name was registered which indicates use as a blocking registration or to ride on the Complainant's goodwill, thereby disrupting the Complainant's business and taking undue advantage and causing detriment. The Domain Name has been used by the Respondent for a site selling bee venom products similar to those produced and sold by the Complainant, but which have no connection to the Complainant. In so doing, the Respondent's use of the Domain Name is disruptive to the Complainant's business and in the opinion of the Expert is likely to confuse and to have confused Internet users into thinking that the site connected to the Domain Name is connected to the Complainant.

In the view of the Expert in its registration and use of the Domain Names the Respondent took unfair advantage of and caused detriment to the Complainant's rights.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in respect of a name which is identical to and a mark which is confusingly similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, beetox.co.uk be transferred to the Complainant.

Signed Dawn Osborne

Dated December 26, 2013

