

**DISPUTE RESOLUTION SERVICE**

**D00015514**

**Decision of Independent Expert**

**MBE Engineering sp. z o.o.**

and

**Paul Dixon**

**1. The Parties:**

Lead Complainant: MBE Engineering sp. z o.o.  
ul. Promyka 92  
Pruszków  
05-800  
Poland

Second Complainant: LUCKYLOCKS Sole-owner Ltd  
2, EKZARH YOSIF STR.  
Sofia  
Bulgaria

Respondent: Paul Dixon  
Tower 42 25 Old Broad Street  
London  
London (City of)  
EC2N 1HN  
United Kingdom

**2. The Domain Name:**

turbodecoder.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 February 2015 15:33 Dispute received  
17 February 2015 10:03 Complaint validated  
17 February 2015 10:16 Notification of complaint sent to parties  
06 March 2015 01:30 Response reminder sent  
11 March 2015 09:45 No Response Received  
11 March 2015 09:45 Notification of no response sent to parties  
23 March 2015 01:30 Summary/full fee reminder sent  
25 March 2015 12:34 Expert decision payment received  
26 March 2015 Michael Silverleaf appointed as expert  
09 April 2015 Expert asks for complete complaint under Rule 13a  
10 April 2015 Request for complete complaint sent to parties  
28 April 2015 Complete complaint received from complainant  
14 May 2015 No response from respondent

### **4. Factual Background**

4.1 This is an unusual complaint in that the complainants seek a full decision despite the fact that no response has been filed to the complaint. The complaint was sent by post to the respondent at his registered address to which it was delivered and signed for on 19 February and to Shop-Turbodecoder UK, 8 Euro House, Birch Lane, Aldridge, West Midlands WS9 0NF from which it was returned as "addressee unknown". The complaint was also sent by e-mail to the registered e-mail address but no response has been received to this.

4.2 The complaint is more unusual because in its original form the complaint was incomplete (it ended after two paragraphs in mid-sentence) and provided no basis for a finding in the complainants' favour. On 10 April 2015, Nominet, at my request, sent a request to the complainants, copied to the respondent seeking a full version of the complaint.. The complainants sent a full complaint on 28 April. Nominet sought a response from the respondent but none has been received. I have accordingly to decide the dispute solely on the basis of the facts set out by the complainants in the complaint, drawing such inferences as I consider appropriate from the lack of a response pursuant to paragraph 15c of the DRS Procedure.

4.3 The lead complainant is the proprietor of the domain turbodecoder.pl and the second complainant of the domain turbodecoder.com. The second complainant is also the proprietor of Community Trade Mark 013491352 for the mark TURBODECODER registered in classes 6, 8 and 45 for goods and services covering locks, locksmith tools and locksmith services. The registration was applied for on 24 November 2014 and was registered on 28 April 2015 without opposition.

4.4 The complainants are in the business of supplying locksmith tools, primarily for unlocking motor vehicles under the name Turbodecoder. They have websites on the domains mentioned above through which their products may be purchased.

4.5 The respondent registered the domain turbodecoder.co.uk ('the disputed domain') on 14 November 2014. The complainants have submitted a screenshot of the website hosted on this domain from February 2015. This shows what appear to be some of the complainants' goods being offered through turbodecoder.co.uk said to be "Number One UK Supplier Of Turbo Decoder".

## **5. Parties' Contentions**

5.1 The complainants say that the respondent is using the disputed domain for the same goods as made and sold by the complainants. That appears to be correct. Indeed, from the screenshot supplied, they are the complainants' own goods.

5.2 The complainants also say that consequently consumers, even those who are most prudent and well-informed, are exposed to a high risk of confusion. I infer from this submission that the respondent is not associated with the complainants and is not an authorised reseller of their goods. The complaint is that the respondent's website makes it appear that this is the case.

5.3 Consequently, the complainants complain that the respondent's use of the disputed domain takes unfair advantage of and is detrimental to their rights because the respondent's activities infringe those rights.

## **6. Discussions and Findings**

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008. Paragraph 1 of that policy defines an 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights"

6.2 Paragraph 1 of the DRS Policy defines "Rights" for the purposes of this procedure 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."

6.3 Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and

(b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.4 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The relevant factors for the purposes of the present case are

“(a)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;

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;

...

The remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.5 Paragraph 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. These include the following which are relevant to the present case:

“(a)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 commercially known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

...

6.6 The first question in any DRS complaint is whether the complainant has Rights. As the DRS Policy definition makes clear Rights are limited to rights which are enforceable by the complainant whether under English law or not: see also paragraph 1.10 of the Expert Overview. Equally, as has been said in many cases, the requirement to establish Rights sets a low threshold test.

6.6 There can be no dispute that the complainants have Rights in this case. The second complainant is the registered proprietor of the Community Trade Mark TURBODECODER. In addition both parties have turbocoder domains on which they operate websites under that name offering locksmith tools for sale.

6.7 The respondent is using a name identical to the complainants’ registered trade mark in relation to goods for which it is registered. If those are not the

complainants' goods, then it is plain that the complainants' trade mark rights are being infringed by this activity. Even if they are the complainants' goods, then it appears from the screenshot submitted by the complainant that the respondent is offering them in such a way as to lead visitors to his website to infer that he is an authorised reseller of those goods. That, at least prima facie, is an infringement of the class 45 registration for locksmith services.

6.8 In either event, it is clear that there is a likelihood that members of the public will be deceived into believing that the goods and services offered by the respondent are associated with the complainants and that the respondent is an authorised reseller of those goods. Such activities are prima facie an infringement of the complainants' trade mark rights and a breach of paragraph 3(a)(ii) of the DRS Policy. In the absence of any explanation from the respondent of a justification for his activities, I can reach no other conclusion.

6.9 On this basis I am satisfied on the balance of probabilities that the respondent's use of the disputed domain falls within the example of abusive registration given in paragraph 3(a)(ii) of the DRS Policy.

6.10 Consequently, I conclude that the disputed domain is an Abusive Registration as defined by the DRS Policy.

## **7. Decision**

7.1 I direct that the domain turbodecoder.co.uk be transferred to the complainants.

**Signed** Michael Silverleaf

**Dated** 21 May 2015