

DISPUTE RESOLUTION SERVICE

D00015762

Decision of Independent Expert

Erreà Sport S.p.A.

and

Logoxpres Ltd

1. The Parties:

Lead Complainant: Erreà Sport S.p.A.
Via di Vittorio 2/1
San Paolo di Torrile
Parma
43056
Italy

Respondent: Logoxpres Ltd
4 Kings Court
Glentye Road
Stirling
FK7 7LH
United Kingdom

2. The Domain Name:

<erreakit.co.uk>

3. Procedural History:

The Complaint was filed with Nominet on 7 April 2015. The next day Nominet notified the Respondent by post and by email, stating that the Response had to be received on or before 29 April 2015. The Response was filed on 24 April 2015. Nominet notified the Complainant that a Reply had to be received on or before 1 May 2015 and the Reply was filed on 30 April 2015. The mediator was appointed on the same day.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 18 May 2015 Nominet informed the Complainant that it had until 2 June 2015 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 29 May 2015 the Complainant paid Nominet the required fee.

On 12 June 2015, the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he was independent of each of the parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of a such a nature as to call in to question his independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant is an Italian company specialised in technical athletic apparel, founded in Torrile, Parma in 1988.

The Complainant is the owner of several trade marks around the world in the term ERREA in connection with sport technical equipment and related products, including clothing for sports. Such trade mark registrations include but are not limited to the following:

- Community Trade mark No. 812891, for "ERREA" (figurative), filed on 28 April 1998 (for goods and services in class 25);
- Community Trade mark No. 1671759, for "ERREA" (figurative), filed on 24 May 2000 (for goods and services in classes 18 and 28);
- Community Trade mark No. 7008477, for "ERREA" (figurative), filed on 23 June 2008 (for goods and services in, *inter alia*, classes 18, 25 and 28);
- Community Trade mark No. 009284191, for "ERREA" (word), filed on 30 July 2010 (for goods and services in, *inter alia*, classes 18, 25 and 28);
- International Trade mark No. 621285, for "ERREA" (figurative), filed on 18 April 1994 (registered on 16 June 1994) (for goods and services in class 25); and
- International Trade mark No. 759602, for "ERREA" (figurative), filed on 22 December 2001 (registered on 23 January 2001) (for goods and services in, *inter alia*, classes 18, 25 and 28).

The Complainant's official website is available at www.errea.it (the domain name <errea.it> was registered in 1996). The Complainant is also the owner of a number of domain names consisting of or containing the term ERREA, including but not limited to <errea.com>, <errea.uk>, <errea.co.uk>, and <erreakits.co.uk>, amongst many others.

On the Complainant's official website at www.errea.it, the Complainant offers its products for sale and also provides a search tool that allows customers to find a reseller of ERREA products in approximately 70 countries around the world, including Great Britain.

The Respondent is one of the Complainant's resellers in the United Kingdom.

The Respondent registered the Domain Name on 11 January 2007.

The Domain Name resolves to a website prominently displaying the Complainant's ERREA trade mark and offering the Complainant's sports products for sale.

5. Parties' Contentions

The Complaint

The Complainant asserts that its "ERREA" trade marks are extremely well known in Italy and all over the world, including the United Kingdom, in connection with sports products. The Complainant further asserts that the "ERREA" brand has become well known as a result of its considerable sponsorship action throughout the years for some of the most important sports clubs in Italy and around the world, including the United Kingdom. To support its claim, the Complainant has submitted numerous press articles from various football magazines and has made reference to the "Sponsor" section of its official website available at www.errea.it.

The Complainant asserts that the Respondent is a legitimate reseller of the Complainant, and that the Respondent appears as such on the Complainant's official website www.errea.it. However, the Complainant contends that it never authorised the Respondent to use the trade mark "ERREA" in a domain name.

The Complainant's lawyers sent three cease and desist letters to the Respondent: on 11 November 2011 by email to the address on the website associated with the Domain Name; and on 12 January 2012 and on 7 January 2015 by registered post. The Complainant contends that the Respondent did not formally reply to any of these letters. The Complainant further asserts that it made several other attempts to contact the Respondent in order to reach an amicable agreement to no avail.

The Complainant asserts that as of the date of filing of this Complaint, the Respondent continues to use the Domain Name to point to an active website which prominently displays the ERREA trade mark and offers ERREA products for sale.

The Complainant refers to its various trade marks and contends that the Domain Name is identical or similar to its ERREA trade mark. The Complainant asserts that the Domain Name consists of the term ERREA with the addition of the generic term "kit" which is insufficient to avoid a risk of confusion in the mind of internet users. The Complainant further asserts that the Top Level Domain ".CO.UK" does not have any impact on the overall impression of the Domain Name and is therefore irrelevant to assess whether the Complainant's trade mark and the Domain Name are similar.

The Complainant further contends that the Domain Name is an Abusive Registration. In this regard, the Complainant stresses that it has valid trade mark rights in the term ERREA in the United Kingdom and that it never authorised the Respondent to register the Domain Name.

The Complainant acknowledges that the Respondent is a reseller of the Complainant. However, the Complainant underlines that the Respondent is merely one reseller amongst approximately 40 resellers of the Complainant's products in Great Britain and does not enjoy

any special status over the others. For this reason, the Complainant argues that the registration of the Domain Name by the Respondent disrupts the Complainant's business, in accordance with paragraph 3(a)(i)(C) of the DRS Policy. In this regard, the Complainant relies on the decisions DRS 11479 (<solidedge.co.uk>), DRS 10143 (<frontlinekillsfleas.co.uk> and <frontlinespotonkillsfleas.co.uk>) and DRS 12643 (<cokpairsystem.co.uk>).

The Complainant further contends that there is no indication on the website to which the Domain Name is pointing that the Respondent is merely one of the Complainant's resellers. It underlines that only the Complainant's trade mark appears on the website and that on the "About us" section of the website, the Respondent is describing itself as the Complainant itself and that there is no reference to the Complainant or its official website. As a result, the Complainant argues that the Respondent is misleading internet users into thinking that it is the Complainant and not a reseller who is behind the Domain Name.

The Complainant further contends that the Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant, in accordance with paragraph 3(a)(ii) of the DRS Policy.

The Complainant further submits that the Respondent is using the Domain Name in order to take unfair advantage of the Complainant's rights and this in turn causes unfair detriment to the Complainant's trade mark and name. In this regard, the Complainant relies on DRS 11828 (<rbsspclaimsuk.co.uk>) and DRS 9828 <lbarclays.co.uk>).

Finally, the Complainant argues that its delay in bringing its Complaint does not prevent it from succeeding in its claim. In this regard, the Complainant argues that it first contacted the Respondent in 2011 and that since then it has made numerous attempts to settle the dispute amicably with the Respondent to no avail. In addition, the Complainant asserts that "*the generally held view amongst Nominet experts (and UDRP panelists) is that delay alone is not a ground on which a Complaint may be denied.*" (Appeal Panel, Emirates v. Michael Toth, DRS 8634).

Response

The Respondent asserts that it was appointed as a UK distributor of ERREA sports products in 2002 and that both the Respondent and the Complainant's companies have and continue to have a successful business relationship. It claims to be one of the Complainant's first appointments and the longest established distributor in the UK.

The Respondent explains that in 2007 it asked to have a website to promote its ERREA activities and improve communication with its customers. The Respondent claims that this was discussed with the Complainant's representatives.

The Respondent claims that the website at the Domain Name was a collaborative project between the Complainant and the Respondent. In particular, the Respondent claims that the website's layout and images were all prepared by the Complainant's marketing department and that the Respondent provided the website content. In this regard, the Respondent has submitted copies of its correspondence with two representatives of the Complainant in Italy which in the Respondent's view show that the website "*was set up with the full cooperation and agreement of ERREA*". For instance, on 22 March 2007 the Complainant sent an email to the Respondent with the subject heading "Ereakit.co.uk website" stating as follows:

*"Hello,
this is a layout of the homepage with a menu lined up almost like your facsimile, also
will find links to our English catalogue and to our customizable section.
Hope You can use it and arrange contents following this basic layout.
best regards
Flavio"*

The Respondent further contends that the website is used to wholly and exclusively promote the ERREA brand only. The Respondent further asserts that the URL is promoted on the Respondent's signage, marketing materials and on all of its kit bags that customers receive.

The Respondent further asserts that the Complainant's action *"has alarmed [him]"* and further claims that it has not received a *"full and proper explanation as to why this is being challenged 8 years after the event"*. The Respondent argues that this would have an impact on how it promotes its ERREA activity and that the removal of the website will be detrimental to both companies.

The Respondent further underlines that it has only recently received notice of the dispute by its internet provider as all official correspondence from the Complainant was sent to the address 62 Stirling Enterprise Park Stirling (the address appearing on the WHOIS record of the Domain Name) and not to him.

Reply

The Complainant asserts that the Respondent's claim that the Domain Name is *"used to wholly and exclusively promote the Errea brand only"* is not completely true. The Complainant asserts that the Respondent is selling old products belonging to the Complainant's 2006/2009 collection. Thus the Complainant argues that the website is completely obsolete as it has not been updated for several years and that this is damaging the Complainant's image. The Complainant further argues that the Respondent's intention is to "occupy" the Domain Name in bad faith and that the Respondent has no real interest in using it.

The Complainant further contends that the Respondent's contention that he is *"alarmed"* by the Complainant's action as he has never received a *"full and proper explanation why this is being challenged 8 years after the event"* is false and misleading. In this regard, the Complainant has submitted a copy of an email from the Respondent to the Complainant sent on the same day it received the Complainant's lawyers' cease and desist letter of 11 November 2011, in which the Respondent stated as follows:

"Fabrizio

*Obviously our site was developed in conjunction with yourself and the marketing team.
I am assuming this organization are not aware of this. Can you please communicate
with these people on our behalf.*

*Kind regards
Stephen"*

In response to the Respondent's email above, on the same day the Complainant's representative replied as follows:

"Stephen,

This matter is treated directly by the ownership of Errea.

The ownership have decided that all domain with the word "errea" in it, should be property of Errea.

Once the property is back to Errea, the use and continuation of the internet site will be probably be handed back to yourself, but the running of the site is not related to the ownership of the site.

Our Icelandic, Finnish and Belgium importer that had a similar issue have already agree to hand over the property of the domain and run the site as they are doing know (sic).

Regards

Fabrizio"

Thus the Complainant argues that the Respondent had knowledge of the Complainant's intention since 2011. The Complainant further asserts that no reply was received by the Complainant in response to the above.

Furthermore, the Complainant has submitted an additional email to the Respondent dated 15 April 2013, in which the Complainant stated as follows:

"Frances,

if you remember we discuss some while ago about the deed of assignment for erreakit site, you have been contacted by the firm Bugnon that is acting on our behalf.

In the attached document is written what you have to do, if something is unclear please give me a call

Regards

Fabrizio"

The Complainant submits that the above demonstrates the Complainant's intention to settle the dispute amicably two years after the cease and desist letter was sent and suggests that the Respondent's failure to respond demonstrates the Respondent's unwillingness to cooperate.

6. Discussions and Findings

General

Under paragraph 2(a) of the DRS Policy, for the Expert to order a transfer of the Domain Name the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"(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."*

Complainant's Rights

The Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise*".

Based on the trade mark registrations submitted by the Complainant, the Expert finds that the Complainant has Rights in respect of the name ERREA.

Furthermore, the Policy provides that the name or mark in which the Complainant has Rights must be identical or similar to the disputed Domain Name. It is accepted practice under the Policy to discount the .CO.UK suffix, and so the only difference between the Complainant's ERREA (word) trade mark and the Domain Name is the addition of the generic term "kit". The Expert is of the opinion that the addition of the term "kit" in the Domain Name does not materially diminish the similarity with the Complainant's trade mark and so the Expert finds that the Domain Name and the Complainant's trade mark are similar.

The Expert thus finds that paragraph 2(a)(i) of the Policy is satisfied and that the Complainant has Rights in respect of a mark which is similar to the Domain Name.

Abusive Registration

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

- "(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."*

A complainant must prove one or both of these on the balance of probabilities.

Paragraph 3(a) of the Policy sets out a non-exhaustive list of circumstances which may be evidence of Abusive Registration, including:

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

(...)

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".

Paragraph 4 of the Policy provides a similar non-exhaustive list of circumstances which may be evidence that the Domain Name is not an Abusive Registration, including where a respondent has used the Domain Name in connection with a genuine offering of goods or services (paragraph 4(a)(i)(A)), has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name (paragraph 4(a)(i)(B)) and where a respondent has made legitimate non-commercial or fair use of the Domain Name (paragraph 4(a)(i)(C)).

In the present case, the Parties agree that the Respondent is an authorised reseller of the Complainant's products and the Respondent appears as such on the Complainant's official website available at www.errea.it. The issue in this case is therefore whether use of a domain name incorporating a trade mark by an authorised reseller constitutes an Abusive Registration.

The key decision under the DRS Policy concerning whether a resellers' use of a domain name that contains a trade marked term constitutes an Abusive Registration is the Appeal's panel decision *Toshiba Corporation v Power Battery Inc.*, DRS 7991 (<toshiba-laptop-battery.co.uk>), which is based on principles set out in two previous Appeal panel decisions, namely *Seiko UK Ltd v. Wanderweb* DRS 00248(<seiko-shop.co.uk>) and *Epson Europe BV v. Cybercorp Enterprises* DRS 03027 (<epson-inkjet-cartridge.co.uk> et al), as well as the decision under the Uniform Domain Name Dispute Resolution Policy (UDRP), *Oki Data America v. ASD*, WIPO Case No. D2001-0903 (although the Appeal panel advised that care must be taken because the tests under the UDRP are different from those under the DRS Policy).

In the *Toshiba* case, the Appeal panel referred to the criteria set out in the *Oki Data* decision regarding a reseller or distributor of goods or services' use of a domain name incorporating a trade mark, namely:

- "a) the respondent must actually be offering the goods or services at issue;*
- b) the respondent must use the site only to sell the trade marked goods, otherwise it could be using the trade mark to "bait" customers and then offer them other goods;*
- c) the site must accurately disclose the respondent's relationship with the trade mark owner (i.e. must not falsely claim to be an official site);*
- d) the respondent must not try to corner the market in relevant domain names, thus depriving the trade mark owner of the opportunity of reflecting its own mark in a domain name".*

The Appeal panel in the *Toshiba* case stated that the aforementioned criteria are consistent with the principles of the two aforementioned DRS appeal decisions, which can be summarised as follows:

- "1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.*
- 2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.*

3. Such an implication may be the result of “initial interest confusion” and is not dictated only by the content of the website.

4. Whether or not a commercial connection is implied, there may be other reasons why the reseller’s incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent’s website.”

Based on the foregoing, the fact that a reseller of trade marked goods has registered a domain name incorporating a trade marked term does not constitute in itself Abusive Registration but rather depends on the particular circumstances of each case. The particular circumstances of this case are examined as follows:

The Complainant contends that although the Respondent is one of the Complainant’s authorised resellers, it never authorised the Respondent to use the trade mark “ERREA” in the Domain Name and that by doing so, the Respondent is unfairly exploiting the goodwill of the Complainant’s trade mark. The Respondent in turn argues that the website to which the Domain Name is pointing was a collaborative project with the Complainant in which the Complainant provided the basic layout of the website and the Respondent its content.

The Expert has considered the arguments and evidence put forward by the Parties and, while there is no evidence that the Complainant expressly authorised the Respondent to register the Domain Name, the Expert does not consider that there was anything untoward about the Respondent’s registration of the Domain Name, which consists of the Complainant’s trade mark and the generic term ‘kit’. In this regard, the Expert notes that, in its Response, the Respondent has asserted and has put forward evidence showing that the Complainant and the Respondent closely collaborated to develop the website associated with the Domain Name and the Complainant did not dispute this in its Reply. Based on the foregoing, the Expert is of the view that the Complainant at the very least implicitly authorised the Respondent to register the Domain Name to enable the Respondent to promote the Complainant’s products on the associated website. Thus the Expert does not consider that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant, in accordance with paragraph 3(a)(i)(C) of the DRS Policy, as contended by the Complainant, but rather as part of its legitimate commercial relationship with the Complainant.

The Expert is of the view that in the particular circumstances of this case the main relevant question is whether the Respondent’s subsequent use of the Domain Name can be considered Abusive Registration, namely whether the Respondent fairly and adequately represented its status as a reseller to internet users searching for the Complainant’s products or, on the contrary, the Respondent misrepresented itself as the Complainant itself or the Complainant’s exclusive reseller in the UK. Prior panels deciding under the DRS Policy have held that there are limits to how the Respondent may represent its reseller status to internet users searching for the Complainant’s products at a domain name incorporating a complainant’s trade mark, as an unfair representation may likely result in taking unfair advantage of the trade mark holder’s rights. See *Siemens Product Lifecycle Management Software Inc. v. Cutting Edge Solutions Limited*, DRS 11479 (<solidedge.co.uk>) (“If the use of the Domain Name by the Respondent falsely implies that the Respondent actually is the Complainant itself or alternatively at minimum is the sole UK reseller of the Complainant’s product, then in the Expert’s opinion such use is unlikely to be fair”).

In the instant case, the Expert is of the view that, on the balance of probabilities, the Respondent's use of the Domain Name constitutes an Abusive Registration mainly because the Respondent is unfairly representing itself as the Complainant. Whilst the website layout may contribute to give the false impression that the website belongs to or is controlled by the Complainant, in the particular circumstances of this case, this circumstance cannot constitute a relevant factor in the Expert's determination for the simple reason that the Complainant was responsible for creating the basic layout of the website, as asserted by the Respondent and not denied by the Complainant. However, the Respondent remained responsible for the content of the website itself and so taking the content of the website into consideration the Expert notes the following:

First, the absence of a disclaimer or other statement accurately and prominently disclosing the Respondent's relationship with the Complainant. Secondly, as pointed out by the Complainant, the fact that the Respondent is clearly misrepresenting itself as the Complainant itself in the "About Us" section of the website. In this regard, the Respondent misleadingly refers to itself as "Erreà Sport", "a vibrant and growing manufacturer of innovative and quality sportswear across Europe". In addition, on the same page, the Respondent's address refers to "Erreakit" as the addressee. There is simply no mention of the Respondent's true identity on the "About Us" section of the website or anywhere else on the website.

Incidentally, the Expert notes that the Respondent's LOGOXPRES logo is displayed at the bottom of the website's main page. However, the Expert is of the view that the presence of the Respondent's LOGOXPRES logo is insufficient to indicate to internet users that the website is controlled by the Respondent and not by the Complainant, particularly not only due to its size and placement (at the bottom of the page) but also it is one of many logos appearing at the bottom of the website's main page.

The Respondent had an opportunity to offer an explanation in its Response in this regard but chose not to do so. In the absence of an explanation, the Expert is of the view that based on the absence of a disclaimer coupled with the information on the "About Us" section of the website, internet users are likely to believe that the website belongs to or is controlled by the Complainant and that it is likely that the Respondent did so deliberately with the intention of taking unfair advantage of the Complainant's rights.

The Expert therefore finds 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", in accordance with paragraph 3(a)(ii) of the DRS Policy. As a result, the Expert is of the view that the Respondent's use of the Domain Name to misrepresent itself as the Complainant results not only in taking an unfair advantage of the Complainant's rights, it is also unfairly detrimental to the Complainant and its system of resellers in the UK.

In summary, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Domain Name is therefore an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

Delay

Finally, the issue of delay was addressed in *Emirates v. Michael Toth*, DRS 8634 (<emirates.co.uk>), where the Appeal panel stated that "*The generally held view amongst*

Nominet experts (and UDRP panellists) is that delay alone is not a ground on which a Complaint may be denied”, unless the delay was such as to prejudice the proper consideration of the issues. The Expert is of the view that in the present case the Complainant's delay has not prejudiced the proper consideration of the issues and so it does not prevent the Complainant from succeeding as it has established its case on the merits.

7. Decision

The Expert finds that the Complainant has Rights in a name which is similar to the disputed Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The disputed Domain Name should therefore be transferred to the Complainant.

Signed: David Taylor

Dated: 6 July 2015