

DISPUTE RESOLUTION SERVICE

D00016995

Decision of Independent Expert

Cimpax ApS

and

NJ Dynamic Solutions

1. The Parties:

Lead Complainant: Cimpax ApS
Lille Pilevang 4
Slangerup
DK-3550
Denmark

Respondent: NJ Dynamic Solutions
Cimpax Instruments
67-A Tipu Road Small Industrial Estate
Sialkot
Pakistan

2. The Domain Name(s):

cimpax.co.uk (“the disputed domain”)

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.

25 January 2016 11:28 Dispute received
25 January 2016 12:25 Complaint validated
25 January 2016 13:43 Notification of complaint sent to parties
11 February 2016 01:30 Response reminder sent
15 February 2016 10:46 Response received
15 February 2016 10:50 Notification of response sent to parties
18 February 2016 01:30 Reply reminder sent
22 February 2016 12:57 Reply received
22 February 2016 13:15 Notification of reply sent to parties
22 February 2016 13:16 Mediator appointed
29 February 2016 10:04 Mediation started
10 March 2016 17:18 Mediation failed
10 March 2016 17:24 Mediation failed
16 March 2016 12:26 Close of mediation documents sent
29 March 2016 12:15 Expert decision payment received

4. Factual Background

4.1 The complainant is a Danish company which makes medical devices which it sells in more than 30 countries around the world including the UK, Continental Europe, Australia, New Zealand, South Africa and Hong Kong through a network of approved distributors.

4.2 The complainant was founded in Denmark in November 2008 and has been in business since that date investing substantial resources into building its reputation in the manufacture and supply of high quality medical instruments. The complainant attends trade fairs, including the largest annual medical trade fair, Medica, where it is listed as a manufacturer of medical devices. Since 2010 the complainant has supplied the NHS in the UK with single use medical instruments including needles and laparoscopic equipment. The complainant says that as a result of these activities it has established an extensive and valuable reputation in its name and trade marks.

4.3 The complainant is the owner of international trade mark registration number 0 995 456 for the mark CIMPAX which covers class 10 surgical, medical, dental and veterinary apparatus and instruments, orthopaedic articles; sutures. The mark was applied for on 16 December 2008 and is currently registered and in force in the EU, Denmark, Australia, Switzerland, China and Norway.

4.4 The complainant is also the proprietor of a series of top level domains under various country codes for the domain cimpax including .de, .dk, .ch, .fr, .it, .es, .nl, .at, and .ie.

4.5 Somewhat oddly the complainant has given in the complaint no details of the size of its actual trading business. As the facts set out above do not appear to be disputed by the respondent, however, this does not seem to affect the present decision.

4.6 The respondent is a business operating in Pakistan providing business and web management services to clients including website design, website development, domain registration and website hosting through the domain

njdaynastics.com. The disputed domain was registered by the respondent on 13 February 2012 without the knowledge or consent of the complainant.

4.7 The disputed domain hosts the website of a business called Cimpax Instruments of Defence Road, Sialkot 51310, Pakistan. The complainant says that it understands that Cimpax Instruments instructs the respondent to operate its website having been told this in a telephone conversation with Cimpax Instruments in August 2014. The respondent is credited on the website with the words “*Design By : Nj Dynamic*”. The complainant has brought the complaint against the respondent as the entity in whose name the disputed domain is registered.

4.8 Cimpax Instruments is using the website hosted on the disputed domain to offer for sale surgical, dental, manicure and pedicure instruments. The Cimpax brand name appears on the website although it is not clear from the website whether the name appears on the products themselves and Cimpax Instruments has denied this in correspondence with the complainant.

4.9 On 17 September 2012, RGC Jenkins, patent attorneys, acting for the complainant wrote to Cimpax Instruments complaining of the use of the trade mark CIMPAX and the disputed domain and seeking that the use ceased and the domain be transferred to the complainant. Despite reminders by ordinary post, registered mail and email, there was no response from Cimpax Instruments.

4.10 It seems that nothing then happened for over a year. The next event recorded in the complaint is a telephone call between Mr Michael Busch-Madsen, Vice President International Sales of the complainant, and Mr Asad Ali, who signs correspondence as the President of Cimpax Instruments, on 13 January 2014. This call started a series of email correspondence in which the complainant repeatedly tried to persuade Mr Ali to stop using the Cimpax brand and to hand over the disputed domain. Having spoken to Mr Ali, Mr Busch-Madsen sent him a copy of the original letter from RGC Jenkins and asked for transfer of the disputed domain.

4.11 Mr Ali’s responses are recorded in his emails. His first response (apparently sent later the same day although it is difficult to be sure as it is not clear in which timezone the times of the emails in the chain have been recorded) refused to “clos[e] our domain just for a small reason”. It also explained that Cimpax Instruments was not doing any business in the UK and did not produce packaging with that name on it or put Cimpax branded goods onto the market. However, it then said “we had made a huge investment in it [sc. the Cimpax name] doing business with private labelling”. It then asked about Mr Ali’s investment in website development, hosting and SEO costs if the complainant were to take the disputed domain and suggested rather naively that Mr Ali had no idea how to close down the Cimpax Instruments website. The email finished with an apology.

4.12 Mr Busch-Madsen responded on 15 January 2014 pointing out that Cimpax Instruments’ use of the brand nevertheless violated the complainant’s trade mark and made clear that legal proceedings would be taken if necessary. He declined to make any offers in relation to Cimpax Instruments’ costs, pointing out that these had been incurred without checking whether the name was free for use and that Cimpax Instruments therefore had only itself to blame for the consequences. He

again asked for transfer of the disputed domain, pointing out that this is a very simple procedure.

4.13 Mr Ali responded the following day asking whether the complainant wanted only the domain or closure of the business of Cimpax Instruments. Mr Busch-Madsen responded the same day saying that the complainant wanted Cimpax Instruments to give the undertakings originally sought in the letter from RGC Jenkins in 2012 and advising that Cimpax Instruments choose another name if it wanted to promote its business in Europe or the UK. There was no immediate response to this email and Mr Busch-Madsen sent a chasing email on 24 January 2014. This provoked a response the same day in which Mr Ali said “If you are agree to pay me GBP 18000.00 the we are agree to close this business”.

4.14 There appears to have been another gap in communications for about 6 months as the next event recorded is in August 2014 when the complaint explains that the complainant contacted the respondent by telephone and asked for transfer of the disputed domain name. The respondent said that it would take no action without the consent of Cimpax Instruments. Consequently, Mr Patrick Busch-Madsen, CEO of the complainant, emailed Cimpax Instruments on 6 August 2014. This email repeated the complainant’s complaint that Cimpax Instruments was infringing the complainant’s trade mark rights and sought transfer of the disputed domain.

4.15 Mr Ali responded the same day with an email in the following terms:

“Sorry this not possible... Even u pay us 50000 GBP.... Then agaun [sic] Sorry..”

4.16 When the present complaint was made the respondent did not initially respond. However, on receiving the response reminder Mr Ali sent a response to Nominet in which he queried why the complainant had a problem as his business is in Pakistan and not the UK and that Cimpax Instruments has been registered in Pakistan since 2008 with the NTN number 4117573-5. The complainant’s reply explains that this is a national tax number in Pakistan and has nothing to do with trade mark registrations although the claim that the business is registered under the NTN given appears to be correct. However, the business is not registered as a company and appears to be some form of unincorporated firm.

4.17 The response somewhat inconsistently goes on to explain that the disputed domain has been reserved as a name for a new office/branch in the UK and that Mr Ali has applied for “this company” (presumably this means sought to register a company with the name Cimpax Instruments) in the UK although he had not previously done any business in the UK. Apparently irrelevantly, the response also explains that Mr Ali’s brother is settled in the UK and is trading as Fine & Shine Limited as a beauty tools company.

4.18 The reply says that there has been no registration in the UK of a company with the name Cimpax Instruments. Nor does that name appear in the Companies House register of proposed business names. In any event it doubts the veracity of the claim as the disputed domain was registered in 2012 and that, if it had the claimed purpose, some steps would have been taken by now to put that purpose into effect.

4.19 The complainant also says that it has been unable to find any registration of or reference to Fine & Shine Limited as referred to in the response as well as pointing out that this information is not relevant to the present dispute. It has found two registrations with the name Fine & Shine neither of which appears to be the company referred to in the response. Fine & Shine Limited is a company conducting activities of extraterrestrial organisations. Fine & Shine Cleaning Services Limited, now dissolved, was a company employing domestic personnel.

5. Parties' Contentions

5.1 The complainant argues that the disputed domain is an abusive registration because it has been registered to and is taking unfair advantage of the complainant's rights. It says that the use of a name identical to that of the complainant for products which are the same as those made and sold by the complainant must lead to confusion of the public that there is a connection between the complainant and Cimpax Instruments. This takes unfair advantage of the complainant's rights.

5.2 The complainant says that there have been instances of actual confusion between Cimpax Instruments and the complainant. It gives the example of a nurse in the UK who, in 2014, contacted the complainant by telephone to ask whether she should contact the complainant or "the Pakistani company". Having seen the two websites, she had telephoned the complainant because it was geographically closer and the cost of the telephone call would be less. The complainant says, it would appear correctly, that she had been confused by Cimpax Instruments' website into thinking that it was connected with the complainant.

5.3 The complainant also says that the poor quality of goods from Pakistan is well known and that the association between it and Cimpax Instruments as a Pakistani business will damage its reputation.

5.4 The response from the respondent contains no arguments in response to the complaint or any challenge to the facts asserted by the complainant.

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.

6.7 In the present case there can be no doubt that the complainant has rights. It has a European wide trade mark registration for the mark Cimpax, trade mark registrations in other countries and it claims an unchallenged reputation and goodwill under that name and mark acquired by trading in 30 countries since 2008. Accordingly, the complainant passes the threshold test.

6.8 The next question is whether the respondent registered the disputed domain in order to take advantage of the complainant's trade mark. This gives rise to a slightly unusual question as the respondent is not the person using the disputed domain. However, it is clear that the respondent is and has always been acting as an agent for Cimpax Instruments. Accordingly, it seems to me to be appropriate to treat the acts of the respondent as having been committed on behalf of that business so that it is the knowledge and intention of that business which matters. The complainant says that Cimpax Instruments must have known of the complainant and its reputation when the disputed domain was registered. This has not been challenged in the response filed by Cimpax Instruments. It therefore seems to me that Cimpax Instruments accepts that it knew of the complainant and its mark when the disputed domain was registered. Even without such an admission, it seems unlikely that someone marketing surgical and similar instruments online would not have known of the use of a brand for the same products which was well-established when the disputed domain was registered.

6.9 It seems equally clear that the use by Cimpax instruments of a domain name which is identical to the complainant's trade mark to promote and sell goods identical to those made and sold by the complainant must be likely to cause confusion. The complainant says that there has been actual confusion and gives evidence of a particular instance of it occurring. Again, this has not been challenged by Cimpax Instruments.

6.10 Consequently, it seems clear that the disputed domain is an Abusive Registration within the meaning of the DRS Policy under at least paragraph 3(a)(ii).

6.11 The complainant has not complained that the disputed domain is Abusive under paragraph 3(a)(i)(A) of the Policy as a domain which the respondent intended to sell to the complainant for a profit. It seems to me that Mr Ali's increasing financial demands might well be interpreted as having this underlying intention. However, I do not have to decide this and therefore do not do so.

7. Decision

In the light of the conclusions I have reached above, I determine that the disputed domain, cimpax.co.uk, is an Abusive Registration under the DRS Policy and direct that it be transferred to the complainant.

Signed; Michael Silverleaf

Dated; 13 April 2016

