

DISPUTE RESOLUTION SERVICE

D00013496

Decision of Independent Expert

C. & E. FEIN GmbH

and

Mr John Sisk

1. The Parties:

Lead Complainant: C. & E. FEIN GmbH
Hans-Fein-Strasse 81
Schwäbisch Gmünd
Baden-Württemberg
70794
Germany

Respondent: Mr John Sisk

2. The Domain Name(s):

fein.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.

07 November 2013 11:53 Dispute received
07 November 2013 12:15 Complaint validated
07 November 2013 13:00 Notification of complaint sent to parties
18 November 2013 11:30 Response received
21 November 2013 10:01 Notification of response sent to parties
26 November 2013 01:30 Reply reminder sent
29 November 2013 09:37 No reply received
29 November 2013 09:38 Mediator appointed
05 December 2013 15:25 Mediation started
06 January 2014 11:24 Mediation failed
06 January 2014 11:24 Close of mediation documents sent
13 January 2014 12:48 Expert decision payment received
20 January 2014 Keith Gymer appointed as Expert wef 23 January 2014

4. Factual Background

The Complainant, C. & E. Fein GmbH, is a German-based business, dating from the 19th century, specialising in industrial power tools particularly for metal work and automotive uses. It has international subsidiaries in many countries around the world, including in the UK. It has various websites using domain names including fein.com, fein.de, fein.fr, fein.it and fein-uk.co.uk.

It has various trade mark registrations for its “Fein” stylised logo (e.g. IR 449364 dating from 1979; CTM 1139898 dating from 2000) and for FEIN in plain text (e.g. IR 889485 dating from 2005).

The Respondent, John Sisk, is a UK individual.

According to the current Nominet WHOIS record, the Respondent is also said to be a “non-trading individual” who has opted to have their address omitted from the WHOIS service, and who is recorded as having registered the Domain Name on 18 September 2013.

There is no active website resolvable at www.fein.co.uk.

5. Parties' Contentions

Complainant

The Complainant asserts that the Domain Name was originally registered from 1997 to 2013 in the name of Kimpton Brothers Limited, but that it was not used during this period. The Complainant says that it sought to obtain the Domain Name registration itself, through registrar United Domains, at the time it was due to expire (18 June 2013).

Unfortunately for the Complainant, when the Domain Name was eventually released by Nominet following expiry, it was evidently picked up by the Respondent before United Domains could register it for the Complainant.

The Complainant claims that it needs the Domain Name for use by its UK subsidiary, FEIN Industrial Power Tools UK Limited, which is presently inconvenienced by having to use the alternative domain fein-uk.co.uk.

It points out that it owns various trade mark registrations for the FEIN marks [as identified at 4 above].

The Complainant asserts that the Respondent may be a "domain grabber" and states that it has filed the Complaint to prevent the Domain Name being sold to another party without rights in FEIN or to a competitor.

It claims that the Domain Name is an Abusive Registration as it is not used for a website or email; no nameservers are listed for the Domain Name; it unfairly disrupts the Complainant's business (which has to use fein-uk.co.uk); research using Netcomber reportedly reveals that the Respondent has similarly registered many other domains which are unused.

The Complainant asks that the Domain Name be transferred to it.

Respondent

The Respondent accepts that the Complainant has "Rights" in the term FEIN for the purposes of the DRS, based on the Complainant's registered trade marks.

The Respondent goes on to deny that the Complainant could have any unregistered rights, noting that the Complainant has provided no evidence of use.

With respect to the question of Abusive Registration, the Respondent denies this and refers to the Decision in DRS 4331 (verbatim.co.uk), which addressed the question of a respondent's knowledge of a Complainant's brand. The Respondent claims not to have been aware of the Complainant in the present dispute before receipt of the Complaint.

The Respondent points out that the Complainant has not provided any evidence of the nature and extent of its business or reputation in the UK.

Consequently, the Respondent submits that he could not have acquired the Domain Name for prospective sale to the Complainant, nor could there have been any intent to disrupt the Complainant's business.

The Respondent expressly admits that he "buys and sells generic domain names", and observes that the DRS Policy at Paragraph 4d expressly acknowledges that "[t]rading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities".

He provides evidence that "Fein" is a Germanic surname, and that a "Julius George Stephen Fein" was in fact a director of Kimpton Brothers Limited, which previously held the Domain Name.

The Respondent himself claims to have "had in mind ultimately to sell the disputed domain name to an individual with the surname "Fein" or possibly to use it as a brand for a web-development business...".

The Respondent dismisses as irrelevant the fact that the Domain Name had not been used in the short period between registration and the filing of the Complainant, and that other domains owned by the Respondent have similarly not been used.

He calls the Complainant's argument, that the Domain Name should be considered as an Abusive Registration because the Domain Name at issue would be more convenient and useful to the Complainant than its present fein-uk.co.uk domain, a "flawed belief", and concludes by reiterating that the Domain Name is not an Abusive Registration.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant has demonstrated earlier registered trade mark rights in FEIN, and the Respondent has acknowledged those rights. There is therefore no issue between the parties on this aspect of the Policy.

The Expert concurs. The FEIN name and mark is manifestly identical to the distinctive element of the Domain Name, fein.co.uk, so that the requirement of Paragraph 2a.i. of the Policy is met.

Abusive Registration

The Complainant also has to show that a disputed Domain Name is 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 a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant's submissions, the following examples appear to be potentially applicable in this case:

- 3a.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; 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;
- ...

As the Respondent has also pointed out, Paragraph 3b. of the Policy has the proviso:

- 3b. Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

Paragraph 4 of the Policy additionally provides observations on "How the Respondent may demonstrate in its response that the Domain Name is not an

Abusive Registration”, of which the following may be considered pertinent to the present Complaint:

4a.i.C. [The Respondent has] made legitimate non-commercial or fair use of the Domain Name.

4a.ii The Domain Name is generic or descriptive and the Respondent is making fair use of it.

4d. Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.

The factors listed in Paragraphs 3 and 4 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In accordance with the Policy Paragraph 2b, it is for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

The Complaint was filed less than two months after the Respondent acquired the Domain Name. The evidence is clearly that the Domain Name has not been used, for any purpose, by the Respondent. Consequently, only the conditions of Paragraph 1(i) might directly be argued to apply if the Domain Name is to be considered as an Abusive Registration.

In the Expert's opinion, however, there is simply no evidence to support the Complainant's contentions in this case.

The function of the DRS is not to re-allocate a domain name from one party to another, just because one might appear to have a more convenient use for it than the other. The function of the DRS is to deal with Abusive Registrations, where there is evidence of manifest unfairness, not merely some inconvenience.

Various operators offer drop-catching services to try to pick up expiring domain name registrations, when released by Nominet at a random time after cancellation. Where there is more than one potentially interested party competing to pick up a particular domain on release, no-one can guarantee who will be first to do so. There is no evidence that the Respondent had any unfair advantage over the Complainant in the race to re-register the Domain Name, when released by Nominet. It appears that he simply beat them to it.

“Fein” is an ordinary German word and, in the Expert's view, quite likely to be recognised as such by a significant proportion of English speakers for its similarity and correspondence to the English “fine”. As the Respondent has noted, the Complainant has presented no evidence of the extent of its own use or reputation, which might conceivably have supported a claim that the word is so strongly, and uniquely associated with the Complainant as to constitute an ‘instrument of deception’, unusable by anyone else without confusion.

The Complainant might query whether any professional domain broker would not have researched the potential users for a domain name he was buying. However, although in his Response the Respondent expressly identified the Complainant's failure to provide any proof of the nature and extent of its business or reputation in the UK, the Complainant did not take the opportunity to submit any Reply.

In the absence of any evidence of the extent of publicity and general recognition of the Complainant's mark, there is really no reason to doubt the Respondent's assertion that he was not aware of the Complainant when he acquired the Domain Name.

The Complainant evidently put up with the Domain Name being owned by another party – and also apparently being unused - for the 16 years from 1997-2013, without complaint. The Respondent's evidence reasonably suggests that the Domain Name might have first been registered because that party had a director whose name was "Fein". In this context, the Respondent's contention that he could sell the Domain Name to another individual with the name "Fein" would also appear to be just as reasonable.

The Complainant might fear that the Respondent could sell the Domain Name to someone with no rights in Fein or to a competitor, but again there is no evidence to justify such a fear. There is no evidence of any prior complaint or any history of abusive conduct by the Respondent in relation to this or any other of his domain names. The mere fact that the Respondent may own numerous domain names is not significant on its own, and the Expert considers the Complainant's reference to Netcomber searches to be of no value whatever.

The worst that may be said, in the Expert's view, is that, as the Respondent expressly admits that he "buys and sells generic domain names" and that he "had in mind ... to sell the disputed domain name ... or to use it ... for a web development business", it is plainly misleading to claim to be "a non-trading individual" in the WHOIS record. However, that does not make the Domain Name an Abusive Registration itself and is of no assistance to the Complainant's case.

Of course, if the Respondent were suddenly to start using the Domain Name in a deceptive or unfair manner, however unlikely that may be, the Complainant might have grounds to make another complaint in future. As it stands, however, the claim that the Domain Name should be considered as an Abusive Registration presently is wholly unsubstantiated. The Complainant may be frustrated at having lost the race to re-register the Domain Name and may feel it is inconvenient to have to continue to use the alternative fein-uk.co.uk but, on the evidence, the Respondent's acquisition of the Domain Name cannot be said to have taken unfair advantage of, or to have been unfairly detrimental to, the Complainant's Rights. It is not an Abusive Registration.

Consequently, the Complaint must fail on this basis.

7. Decision

Having found that the Complainant has Rights, but that Domain Name, fein.co.uk, is not an Abusive Registration in the hands of the Respondent, the Expert orders that no action be taken in relation to the Domain Name.

Signed
Keith Gymer

Dated 4 February 2014