

# DISPUTE RESOLUTION SERVICE

**D00021703**

## Decision of Independent Expert

A. Gezang & Co BV

and

Robert Laycock

### **1. The Parties:**

Complainant: A. Gezang & Co BV  
Westvlietweg 65 unit P, 2495 AA  
Den Haag  
Zuid-Holland  
2495AA  
Netherlands

Respondent: Robert Laycock  
5 Broadway Furlong  
Anstey  
Leicester  
Leics  
LE7 7TL  
United Kingdom

### **2. The Domain Names:**

cona.co.uk  
cona.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 being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

#### *Timeline*

02 August 2019	Dispute received
06 August 2019	Complaint validated
09 August 2019	Notification of Complaint sent to parties
14 August 2019	Response received
14 August 2019	Notification of Response sent to parties
19 August 2019	Reply reminder sent
21 August 2019	Reply received
21 August 2019	Notification of Reply sent to parties
21 August 2019	Mediator appointed
28 August 2019	Mediation started
10 September 2019	Mediation failed
10 September 2019	Close of mediation documents sent
19 September 2019	Expert decision payment received

## **4. Factual Background**

The Complainant is the registered proprietor of a UK series mark for the word CONA/Cona (Registration No: 3386753) with a filing date of 26 March 2019 and a registration date of 14 June 2019, and also a UK figurative series mark, with the same filing and registration dates.

The Complainant acquired the rights to manufacture and sell Cona coffee makers from Cona Ltd in May 2017, leading to a joint public statement in July 2017, headed:

*“Dutch/Belgian importer on July 1st 2017 has become the manufacturer within Euro-zone. Cona Ltd transfers its Cona activity to A. Gezang & Co BV”*

By way of further background, the joint public statement goes on to explain:

*For many decades 'Cona Ltd' has been the world's leading manufacturer of luxury vacuum coffee brewers, commonly referred to as the CONA COFFEE MAKER by coffee devotees.*

*For as many years the import division of 'A. Gezang & Co BV' has distributed Cona Coffeemakers within Holland and Belgium with great success.*

*The famous industrial design by Abram Games, known as the 8-cup 'table model Size D' has been manufactured since 1962 continuously at the Cona Ltd Works near London in England.*

*CONA COFFEE MAKERS continue to be solely made at the facility of Gezang & Co BV in the Netherlands. It combines manufacturing, central warehouse and sales-office.*

*Cona Ltd shall no longer make or distribute it, but says 'thank you' for your support in the past, and trusts you shall be happy to work together with Gezang in the future.*

*Tighter control over cost price levels in Euros, enables Gezang to offer steady consumer prices for quality 'Made in Europe' and a steady reseller-discount as a percentage thereof.*

*For any future enquiries and orders please contact the sales office of A. Gezang & Co per email: [info@gezang.nl](mailto:info@gezang.nl)*

*At [www.cona.be](http://www.cona.be) you can get a pre-view of a new development, aimed at baristas. It enables them to stir. For the domestic user the traditional 'Size D All-Glass' remains the pragmatic choice.*

*The site provides you online with our contact details. Some of the pictures are interactive. Click on them to read more.*

The website of the Complainant's factory (in the Netherlands) is at [www.cona.be](http://www.cona.be).

The Respondent, trading as Classicona, acquired the domain name [cona.co.uk](http://cona.co.uk) and associated website from Cona Ltd, in January 2018.

A letter from Cona Ltd dated 16 July 2019, states that:

*To: Whom it may concern*

*Re: CONA WEBSITE ([cona.co.uk](http://cona.co.uk))*

*Dear Sirs*

*I hereby confirm that Cona Limited sold their website ([cona.co.uk](http://cona.co.uk)) to Robert Laycock trading as Classicona.com on 5th January 2018 as per invoice No:SI326639. This invoice was paid in full on 8th January 2018."*

The Respondent purchased [cona.uk](http://cona.uk) on the 16th February 2018.

This dispute arises because Cona Ltd sold the rights to continue certain of its Cona related activities to the Complainant in 2017, but sold its website and associated "[cona.co.uk](http://cona.co.uk)" domain name to the Respondent in 2018.

## **5. Parties' Contentions**

The following is a brief summary of the key contentions of the parties.

### **Complaint**

Cona Ltd was the previous manufacturer of Cona coffee makers to mid 2017, when it sold its entire Cona activity to the Complainant, who continued production and sale without disruption. Reference is made by the Complainant to invoice P170504 dated 4 May 2017, relating to the sale of "*the rights to the manufacture and sale of Cona Coffee Machines, including the rights to the tooling to manufacture of ... parts ... of said coffee makers*". The

Complainant owns the present day Cona factory in the Netherlands. The transaction did not allow the digital infrastructure of the factory website, domain and email-addresses to be transferred to the Respondent for the purposes of violating and abusing the rights of the Complainant acquired from Cona Ltd.

Cona Ltd was the owner of a CONA word mark between 1911 and 2015 and a figurative mark between 1972 and 2015, but as a result of non-payment of renewal fees, these trade mark registrations expired (although Cona Ltd and the Respondent have maintained the facade of Cona Ltd continuing to be the owner of the marks).

Since December 2017, the Respondent has sought to attract Internet users to the website at cona.co.uk, and once there cause them to believe that the Cona factory no longer exists so as to present itself as the last remaining source from which to buy new Cona Coffee makers and replacement parts, or entice them into buying a competing brand of coffee maker.

The Respondent, after receiving the joint public statement in July 2017, congratulated the Complainant but noted that the Complainant was not keen to allow him to continue to sell Cona products worldwide and at discount prices. The Respondent first uploaded abusive content onto the website to which the cona.co.uk domain name resolved in December 2017, as a look-a-like of Cona Ltd's website, and acquired the domain name a little while later. The Respondent had, sometime earlier, been given or taken control of the email-address info@cona.co.uk, once Cona Ltd's primary email-address.

The Complainant has exhibited a number of screen shots from the Respondent's website and makes a number of observations, some examples of which are as follows:

It is suggested that Cona *is* Classicona and that the Internet user is on the factory website;

It is suggested that the CONA trade mark and other trade marks are held by Cona Ltd and/or Classicona;

It is suggested that Cona Ltd is still registered as an active company at Companies House;

It is suggested that the Cona factory of the Complainant in the Netherlands (and authorized dealers worldwide) does not exist;

A photo shows a phased-out Cona model manufactured between 1962 and 2009, as if it is the newest and last model, and thus attempts to mislead the Internet user into believing he is looking at the latest models;

Use of an Outdated logo of Cona Ltd violates the Complainant's figurative mark;

The statement that *“Cona ...and their respective logos are trade marks property of Cona Ltd.”* is untrue;

A link on the website leads to the website at [www.classicona.com](http://www.classicona.com) which entices Internet users to buy coffee makers manufactured by competitors of the Complainant;

Internet users are deceived into thinking that manufacture of Cona coffee makers ceased in 2017.

### Response

The [cona.co.uk](http://cona.co.uk) domain name has been used for many years prior to the recent registration of the trade mark, with a Cona website being active since at least 2001, and a registered domain name predating this.

The Cona activity transferred to the Complainant was for manufacturing the Cona vacuum coffee maker and did not include other Cona products manufactured by Cona Ltd for instance, earlier Cona coffee makers, modern and vintage filter coffee makers and tea machines. Such products carry the name of Cona as the manufacturer, and Classicona sells many of the spares for these products, with many originally purchased from Cona Ltd. Cona Ltd arranged for the sale of the domain name, [cona.co.uk](http://cona.co.uk) and website to Classicona so that Classicona could retail spares for these items. Classicona also deals in spares for other products.

The recently registered mark would not cover all products that Cona Ltd has manufactured prior to the transfer of the brand.

Cona Ltd explained to the Complainant that the website and domain name, [cona.co.uk](http://cona.co.uk) was not included in the agreement made between them and that Classicona would retain the domain name [cona.co.uk](http://cona.co.uk) and use the website to continue selling parts for catering products that were not included in the agreement between Cona Ltd and the Complainant (and which are not covered by the recent CONA trade mark).

Classicona does not retail or claim to retail the Complainant’s products and does not use its trade mark because Classicona do not sell products made by the Complainant. The only use of the name Cona is for Cona branded products made by Cona Ltd before the recent trade mark registration.

It has not been suggested that Cona Ltd presently owns any brand or trade mark; the [cona.co.uk](http://cona.co.uk) website simply explains that Cona Ltd has ceased trading.

A PDF document submitted by the Respondent lists some of the spare parts that Classicona supplies, and the Respondent explains that some were originally supplied by Cona Ltd but in

some cases they are sourced from other distributors. It is said that these spare parts are for machines other than vacuum coffee makers.

### Reply

The list referred to by the Respondent falsely attributes importance to catering product groups (i.e. products other than luxury coffee makers for domestic use for which the Complainant's Cona brand is famous) which, by 2014, had already been discontinued.

The lack of success of catering products meant that the contribution to annual worldwide turnover of Cona Ltd in the last two decades was marginal. It also explains the comment in one screen shot attached to the Complaint (taken from the Respondent's website), that *"In 2014 Cona moved to Cranleigh to concentrate on domestic coffee makers"*.

The Complainant refers to results generated by a Google search using the following combination of words: "Robert Laycock Guildford Classicona". Out of 64 pictures of relevant products, at least 60 show the Complainant's domestic Cona coffee makers or spare parts for them, or past Cona or Cona-competitor products for domestic use (and spare parts). Only 3 show a catering spare part found on the list relied on by the Respondent (which contains 91 items for nearly every commonly available bolt, nut or washer for discontinued equipment).

As to Cona Ltd's letter of 16 July 2019, (stating that *"...that Cona Limited sold their website (cona.co.uk) to Robert Laycock trading as Classicona.com on 5th January 2018..."*), the Complainant refers to a paragraph from its email to Cona Ltd of 23rd of December 2016 which, it is asserted, demonstrates that the website at cona.co.uk and associated email-infrastructure was intended to be part of the 2017 agreement between the parties. It is also asserted that no exclusion was mentioned in the invoice dated 4 May 2017, in relation to the acquisition by the Complainant from Cona Ltd.

It is said that neither the Respondent nor Cona Ltd can provide evidence of any agreement between Cona Ltd and the Complainant that the website and email-infrastructure would be excluded from the 2017 acquisition.

There was no mention by Cona Ltd of, or invitation to make a bid on the sale of the website prior to its "alleged" sale to the Respondent on 5 January 2018, which strengthens the Complainant's opinion that this later transaction was intended to disable the Complainant after it had committed itself to the acquisition. The disruption caused to the Complainant has cost it in excess of £100,000.

The Respondent bought the website from Cona Ltd with the primary purpose of infringing the rights acquired by the Complainant from Cona Ltd, rights which cannot be ignored given the Complainant's registered trade marks.

## 6. Discussions and Findings

### Preliminary comments

The Dispute Resolution Service of Nominet (DRS) offers an efficient and transparent method of resolving disputes concerning .uk domain name registrations. Disputes under the DRS are decided by reference to a set of binding rules called the DRS Policy (the Policy) which are binding on any registrant of .uk. domain name.

Paragraph 2 of the Policy provides:

*“A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:*

*2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

*2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration*

*2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities”*

An Expert appointed under the DRS must decide a Complaint in accordance with the Policy rather than the general law. Thus, for instance, whilst intellectual property law may be of some assistance in relation to the question of enforceable 'Rights' (as to which see below), the fact that a domain name registration, or its use, may constitute trade mark infringement, does not necessarily lead to a finding against the registrant of that domain name under the Policy. By the same token, the fact that use of a domain name would not constitute trade mark infringement, does not necessarily mean that it would also not constitute an Abusive Registration. Whatever analysis might be propounded in terms of intellectual property or other law, a Complainant must satisfy the requirements of the Policy.

### The Policy

Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, on a balance of probabilities, those matters set out in paragraphs 2.1.1 and 2.1.2 of the Policy i.e. that it has Rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

### *Complainant's Rights*

The meaning of 'Rights' is defined in the Policy as follows: *'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in*

*descriptive terms which have acquired a secondary meaning’.*

By virtue of the Complainant’s registered word marks, it clearly has rights in the mark CONA. The precise scope of the Complainant’s registration or, for that matter, geographical location, matters not for the purposes of establishing Rights under the Policy. Moreover, the acquisition from Cona Ltd in 2017, whatever its precise terms, is very likely to have transferred to or conferred on the Complainant (impliedly or otherwise) unregistered trade mark and/or contractual rights in or to the Cona name, if not already vested in the Complainant pursuant to its long term relationship prior to the 2017 acquisition as described in the joint public statement.

### *Similarity*

The cona.co.uk and cona.uk domain names (together the Domain Names) clearly encapsulate the Complainant’s CONA trade mark in its entirety. Apart from the suffixes ‘.co.uk’ and ‘.uk’, which may be disregarded for comparison purposes, it is their only element.

Accordingly, the Expert is satisfied that the Complainant has Rights in a mark which is identical to the Domain Names for the purposes of the Policy.

The Expert must now therefore consider whether the Domain Names are Abusive Registrations in the hands of the Respondent.

### *Abusive Registration*

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *‘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 which *‘is being or has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant’s Rights;’*.

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 5 of the Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name *primarily* as a blocking registration against a name or mark in which the Complainant has rights (para 5.1.1.2), or for the purpose of unfairly disrupting the business of the Complainant (para 5.1.1.3).

Other such factors suggesting an Abusive Registration include the Respondent 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 (para 5.1.2).

If the domain name is an exact match for the name or mark in which the complainant has rights, the complainant's mark has a reputation and the respondent has no reasonable justification for the registration, that too may evidence an Abusive Registration (para 5.1.6).

A non-exhaustive list of countervailing factors is set out in paragraph 8 of the Policy i.e. factors which may indicate that the Domain Name is not an Abusive Registration. Included are circumstances suggesting that before being aware of the complainant's cause for complaint, the respondent has used or made demonstrable preparations to use the domain name in connection with a genuine offering of goods or services (para 8.1.1.1). A respondent being commonly known by a name or legitimately connected with a mark which is identical or similar to the domain name (para 8.1.1.2), or having made legitimate non-commercial or fair use of the domain name (para 8.1.1.3), will also be indicative of a registration that is not abusive. If the domain name is generic or descriptive and the respondent is making fair use of it, that too may indicate that it is not an Abusive Registration (para 8.1.2).

### Discussion on Abusive Registration

It can be seen that, at the heart of the Policy, is the requirement to prove unfairness: for a registration to be considered 'abusive' there should be something unfair in the object or effect of the respondent's behaviour. Such behaviour may or may not be captured in one or more of the non-exhaustive examples mentioned in paragraph 5 of the Policy.

There can be little doubt that a domain name which incorporates a trade mark in its entirety, particularly if it *only* contains that trade mark, may well cause confusion as to the identity of the entity behind the domain name. However, it does not follow, whatever analysis might be propounded in terms of intellectual property or other law, that in these circumstances a finding of Abusive Registration must always be made. There are several examples of trade mark owners failing to secure transfers of domain names incorporating their marks. The Complainant must satisfy the requirements of the Policy and it is the Complainant that bears the burden of proof, on the balance of probabilities, in this regard.

Although the Expert has only limited background information, a brief summary is as follows:

In May 2017, Cona Ltd transferred to the Complainant certain rights which included the right to manufacture and sell Cona coffee makers. The precise scope of the agreement is unclear and may well be disputed, in particular whether such agreement included in some way, or excluded the cona.co.uk Domain Name and associated website. The Complainant relies on *its* email to Cona Ltd, dated 23 December 2016, to support its contention that the website at cona.co.uk (and email-infrastructure) was intended to be part of the 2017 agreement. It also makes reference to an invoice said to evidence the 2017 agreement dated 4 May 2017 (which has not been produced) which refers, it is said without exclusion of the website at cona.co.uk and domain name, to "*the rights of manufacture and sale of Cona Coffee Machines*".

The Respondent relies on a letter from Cona Ltd confirming that it (Cona Ltd) sold their website (cona.co.uk) to Robert Laycock trading as Classicona.com on 5th January 2018. The Respondent explains that Cona Ltd sold the domain name cona.co.uk and website to Classicona (the trading name of his business) so that Classicona could retail spares for Cona products not covered by the agreement between the Complainant and Cona Ltd.

The Complainant's CONA trademarks have a filing date of 26 March 2019 and a registration date 14 June 2019.

The Respondent purchased cona.uk on the 16th February 2018 having already acquired cona.co.uk from Cona Ltd.

### Findings

The fact that the Complainant's trade marks were filed and registered after the Respondent acquired the cona.co.uk Domain Name provides no answer to the Complaint. For reasons already explained, the Complainant is very likely to have had rights "*in respect of a name or mark*" prior to the Respondent acquiring either of the Domain Names, with such rights later being supplemented by the Complainant's trade mark registrations. The Respondent clearly knew of the Complainant's interest in the CONA brand, at the latest, in July 2017 as a result of the joint public statement.

A determination of whether or not the cona.co.uk Domain Name was or should have been included in the May 2017 transaction (between the Complainant and Cona Ltd) or the January 2018 transaction (between the Respondent and Cona Ltd), is beyond the scope of this DRS proceeding. In any event, any finding on that issue would not necessarily be determinative one way or the other. It is possible of course that the 2017 agreement between Cona Ltd and the Complainant, specifically excluded any rights to exploit the cona.co.uk Domain Name (or other .uk registration), which could be a matter of significance. However, the letter from Cona Ltd dated 16 July 2019, referred to earlier, does not say this and whilst there is a clear dispute between the Complainant and Respondent on the point, the Expert is of the view, given the nature of the agreement between Cona Ltd and the Complainant, that it is inherently improbable that there was any such express exclusion. Thus, in the Expert's view, this is not a case where the background circumstances, being of such complexity, should result in the complaint being rejected as inappropriate for adjudication under the Policy as was case in the Appeal Panel's view in DRS 16584 (polo.co.uk). Enough is known or can safely be assumed so as to make a determination.

It is perfectly possible for a registrant to have acquired a domain name legitimately and without any contractual restriction on use, but to then use it in a way that falls foul of the Policy. Thus, just as the Complainant's trade mark rights do not render the Complaint unanswerable, the Respondent's agreement of 5<sup>th</sup> January 2018, does not afford it an unanswerable defence. The Expert must look at the behaviour of the Respondent and whether it takes or has taken unfair

advantage of, or is or was unfairly detrimental to the Complainant's Rights. To that end, the Expert's focus must be on the Respondent's use of the Domain Names, in particular the website to which they resolve.

Clearly the Respondent supplies Cona (and other competitor) products. It is unclear whether it only supplies Cona products not covered by the 2017 agreement, but again that in itself would not be determinative one way or the other. What the Expert does find to be of particular relevance is the impression given by the Respondent's website that it, the Respondent, since the cessation of trading by Cona Ltd, is the only port of call for Cona products.

The Complainant has annexed to its Complaint a number of screenshots of the Respondent's website, some or all of which give the impression that since closure of Cona Ltd ("*Cona Ltd. ceased trading in 2018*"), the Respondent has filled the vacuum left as best he can. Whilst it might be said that the Respondent's website refers to *specific* Cona products or product lines (not covered by the 2017 agreement), and to it having (*only*) taken over "*this official website*" from Cona Ltd, comments such as "*Our mission is to try and keep as many CONA coffee makers in operation around the world as possible*", may well give the impression that new Cona products are no longer manufactured.

Despite the references to Cona Ltd having ceased trading, there are references to Cona Ltd owning trade marks. There is also the heading on one screenshot of the Respondent's website "*Current Cona Ltd. Product Pages*", under which appears the description "*Glass Retro Coffee Makers*", a product said by the Complainant to have been included in its 2017 agreement with Cona Ltd.

The heading "*1960's to Today*" on another screenshot, describing the history of Cona, does not mention the 2017 transaction involving the Complainant, or the fact that new Cona products continue to be manufactured in the Netherlands.

Under Paragraph 18.1 of the Policy, an Expert may, in their discretion, look at material which is generally available in the public domain. The Expert has looked at the Respondent's website as it currently stands and can see that the "Trademarks" link on the landing page (and what is assumed was the associated page entitled "Trademarks", being another of the screenshots annexed to the Complaint), has been removed. The fact that the Respondent has made changes to its website, whether in an attempt to avoid an adverse finding in this DRS proceeding or otherwise, cannot exclude the prior use from consideration.

The link to the "Classicona online store" transports Internet users to the Respondent's website at [www.classicona.com](http://www.classicona.com) which lists several Cona products but also products of other coffee maker manufacturers i.e. competitor products.

Given these findings and in all the circumstances, in the Expert's opinion, the Respondent's website is unfairly detrimental to the Complainant's Rights. The Respondent's website to which the Domain Names resolve, provides an incomplete and misleading history of Cona Ltd from

which it is far from obvious that new Cona products are still manufactured. An Internet user could therefore quite readily assume that new Cona products are no longer manufactured and that, in the Expert's opinion, is unfairly detrimental to the Complainant's Rights. Moreover, competitor products i.e. alternatives to the Complainant's products, are sold by the Respondent on a website linked to the website to which the Domain Names resolve.

## **7. Decision**

The Expert finds that the Complainant has Rights in a name or mark that is identical to the Domain Names which in the hands of the Respondent constitute Abusive Registrations. Accordingly, the Expert directs that the Domain Names <cona.co.uk> and <cona.uk> be transferred to the Complainant.

**Signed .....**  
**Jon Lang**

**Dated: 15 October 2019**