

DISPUTE RESOLUTION SERVICE

D00022816

Decision of Independent Expert

Peli Products (UK) Ltd

and

Stenning Limited

1. The Parties:

Lead Complainant: Peli Products (UK) Ltd
Peli House
Peakdale Rd
Brookfield Industrial Estate
Glossop
Derbyshire
SK136LQ
United Kingdom

Respondent: Stenning Limited
Apt 3164, Chynoweth House
Trevisson Park
Truro
Cornwall
TR4 8UN
United Kingdom

2. The Domain Name(s):

pe.li.co.uk (the "Domain Name")

3. Procedural History:

- 3.1 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.
- 3.2 13 July 2020 12:16 Dispute received
13 July 2020 16:11 Complaint validated
13 July 2020 16:14 Notification of complaint sent to parties
28 July 2020 11:28 Response received
28 July 2020 11:51 Notification of response sent to parties
31 July 2020 02:30 Reply reminder sent
05 August 2020 11:26 No reply received
06 August 2020 13:24 Mediator appointed
13 August 2020 09:27 Dispute closed
24 September 2020 14:58 Dispute opened
24 September 2020 14:59 Mediation started
28 September 2020 13:52 Mediation started
28 September 2020 13:56 Mediation failed
28 September 2020 14:43 Close of mediation documents sent
28 September 2020 14:49 No expert decision payment received
08 October 2020 02:30 Respondent full fee reminder sent
09 October 2020 13:45 Expert decision payment received

4. Factual Background

- 4.1 The Complainant, Peli Products Ltd, is a registered company in the United Kingdom and is a distributor for the "Peli" range of cases and torches. It was established in 1992.
- 4.2 The Respondent is, a registered company in the United Kingdom which describes its business as buying, selling, and monetising generic and common domain names.
- 4.3 The Domain Name was registered on 1 September 1999 and resolves to a page which advertises that the Domain Name is potentially for sale or lease, and provides a contact form and an alternative email address to establish contact with the Domain Name holder.

5. Parties' Contentions

5.1 The Complainant's main contentions are that;

- they are the "sole authorised distributor" of the "Peli" range of products within the United Kingdom;
- they hold 20 Domain Names registered with the name "Peli" included;
- the word "Peli" is a brand and has a registered trademark In Europe, which is not held by the Respondent, and cannot be used in the public domain without the consent of the Complainant;
- the Domain Name is an Abusive Registration as set out in the DRS Policy as the Respondent is in the business of buying domains with the intent of selling them for a fee that is substantially greater than the current average cost for a domain;
- the Respondent has been subject to complaints to Nominet in the past, specifically D18624;
- the Domain Name was previously in the possession of the Complainant but as soon as the Complainant's registration expired, the Respondent purchased it for the purpose of financial gain from the buying and selling of domain names; and
- the Respondent does not have a legitimate claim to the name "Peli".

5.2 On this basis the Complainant requests that the Domain Name be transferred to them.

5.3 The Respondent submits that;

- the Complainant has not provided sufficient proof that it holds a registered trademark in the name "Peli", or that it has a license to use such a trademark if registered from the trademark holder;
- the Complainant has not provided sufficient proof that they have been trading for a significant period of time or to a significant degree using the name "Peli";
- the Complainant has not provided sufficient proof that the name "Peli" is associated to any degree with goods sold by the Complainant;
- the Respondent has obtained the Domain Name as part of a wider business consideration to purchase four-letter, generic, acronym-style domain names which are likely to be of interest to a number of entities;
- the Respondent purchased the Domain Name in order to sell it to any party who had an interest in using the Domain Name, for whatever purpose as they saw fit;
- the Respondent was unaware of the existence of the Complainant or their Rights in the Domain Name;

- the name “Peli” is utilised across a number of other entities within the United Kingdom and beyond;
- the prior complaint about the Respondent made to Nominet, referenced by the Complainant, refers to a case in which the decision was made in favour of the Respondent;
- the Respondent has made no approach or solicitation towards the Complainant regarding the sale of the Domain Name;
- the Domain Name has never been used by the Respondent in any way with reference to the Complainant’s industry;
- the Domain Name was owned by Giraffe.co.uk since at least 2013, indicating that the Domain Name has not been in the Complainant’s ownership for at least seven years. The Respondent has therefore held it for at least four years after the Complainant relinquished it;
- the Complainant has sought to mislead the Expert through referencing a complaint that was decided in favour of the Respondent in support of their complaint. The Respondent has referenced DRS decision 21075 where they state a similar deliberately false assertion by the Complainant significantly contributed to a finding of Reverse Domain Name Hijacking;
- the Complainant has further sought to mislead the Expert through seeking to give the false impression that the Respondent had deliberately acquired the Domain Name immediately upon the expiration of the Complainant’s registration of the Domain Name;
- the Complainant has made no serious effort to establish either Rights or Abusive Registration as set out in the DRS Policy; and
- the Complainant has largely confined itself to attacking the concept of domain name trading.

5.4 On this basis the Respondent requests that it retains the Domain Name, and that a finding of Reverse Domain Name Hijacking is made against the Complainant.

6. Discussions and Findings

6.1 It is convenient to say at the outset that the Complaint in this case appears to have been prepared without a careful consideration of the detail of the DRS Policy and without apparently taking note of the guidance in the “Experts Overview version 3” (the “Overview”) which is guidance published by Nominet and available on its website. This has led to a complaint which is unsatisfactory in a number of important respects – see below.

Rights

6.2 Under paragraph 2 of the DRS Policy, a Complainant must prove to the satisfaction of the relevant expert that they have Rights in respect of a name

or mark that is identical or similar to the Domain Name, before then showing that the registration itself is an Abusive Registration.

- 6.3 Rights, as defined by the DRS Policy, “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”.
- 6.4 As set out under paragraph 2.2 of the DRS Policy “The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities”.
- 6.5 In this case, the Complainant has stated that it is the “sole distributor for the Peli range of products within the United Kingdom”, that is has a further 20 domain names registered that include the name “Peli”, and that the word “Peli” is a registered trademark in Europe which the Respondent does not hold and therefore is not able to utilise this name without the consent of the Complainant.
- 6.6 In support of these assertions, the Complainant has provided a screenshot of the Companies House webpage regarding their business, showing that the Complainant is a Private Limited Company with the name “Peli Products (UK) Limited”.
- 6.7 In addition the Complainant has provided a photograph of their UK head office, which clearly displays the name “Peli”, a copy of a page containing the company letterhead, which again clearly displays the name “Peli”, and a hyperlink to a site which provides a list of names trademarked by “Peli Products, S.L.U., its parent, subsidiaries and/or affiliates”.
- 6.8 This evidence does not in itself establish Rights as set out in the Overview section 1.1. In this case the assertions made by the Complainant and the evidence they have provided me do not lead me to the conclusion that Rights in the name “Peli” exist. The Overview, under paragraph 2.2, sets out the evidence that would be required to satisfy the expert as to the existence of Rights, and this evidence is not provided as part of the Complaint.
- 6.9 Likewise I am not led to the conclusion that any such Rights (if they do exist) are held by the Complainant. The Complaint simply does not provide enough information about the Complainant’s Rights for me to be satisfied in this respect.
- 6.10 Whilst it is not the role of the Expert to perform independent research to make good deficiencies in either parties case, I have nevertheless made some basic enquiries of matters of public record and it seems to me there is a case that the Complainant could have advanced had it prepared its case more thoroughly. Had this been the only matter in issue I would have considered whether it was appropriate for me to issue a procedural order seeking

further information. It seems likely to me that the Complainant is the authorised distributor of “Peli” branded cases which are made by a US company called Peli Products Inc. (or its European subsidiary). That company owns various registered trademarks for the word “Peli”. It may be that the Complainant is licensed by the trademark owner to use the “Peli” trademark. If so, this would likely provide a basis for a finding of Rights. It may also be that the Complainant’s trading history would provide a basis for claiming unregistered rights in the term “Peli” in the United Kingdom, assuming that appropriate evidence could be provided. None of this has been set out in the Complaint. Whether it would be appropriate to allow the Complainant to correct the deficiencies in its case in this manner is an issue I would need to consider were I minded to proceed in this way. I do not however consider it either necessary or appropriate to proceed in this manner given my further findings as to Abusive Registration as set out below.

Abusive Registration

6.11 The Complainant has asserted that the Domain Name is an Abusive Registration as set out in the DRS Policy as the Respondent is in the business of buying domains with the intent of selling them for a fee that is substantially greater than the current average cost for a domain.

6.12 I consider that here the Complainant is making reference to the DRS Policy Paragraph 5.1, where it states:

“A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

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

5.1.1.1 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”

6.13 Critically for this paragraph of the DRS Policy for an Abusive Registration to be found, the Complainant will need to show on the balance of probabilities that the Respondent acquired the Domain Name **primarily** for the purposes of selling, renting or otherwise transferring the Domain Name **to the Complainant or to a competitor of the Complainant.**

6.14 Trading in domain names per se is not enough to establish a case under paragraph 5.1 – something more is required. This is made quite clear by paragraph 8.4 of the DRS Policy: “Trading in domain names for profit, and

holding a large portfolio of domain names, are of themselves lawful activities”.

- 6.15 The Respondent has asserted that it has a legitimate business in the buying, selling, and monetising of four-letter, generic, acronym-style domain names. To this end the Respondent has provided an extensive list of four-letter, generic, acronym-style domain names which it has acquired for sale. It says it acquired the Domain Name in 2017 “...because it was a short, simple, acronym-style domain name, likely to be of interest to a number of entities and because it was in line with the many other .uk four-letter domain names owned by the Respondent dating back to 1994”.
- 6.16 Further to this, the Respondent has asserted that its intention at the time of registration was to sell it to any party that had an interest in the Domain Name, for whatever reason. To this end the Respondent has provided screenshots of six websites where the name “Peli” is utilised as part of a product or a service provided.
- 6.17 I see no reason to doubt the Respondent’s case in this regard. The Complainant has not provided any evidence to show that the name “Peli”, and its use of it, is so well known that there must be an overwhelming inference that the Respondent would have had the Complainant in mind when it acquired the Domain Name. There is no evidence that suggests the Respondent’s case, that it was unaware of the Complainant when it acquired the Domain Name, must be untrue.
- 6.18 See also the Appeal decision in case D00022003 (OVS S.p.A. and Nokta Internet Teknolojileri Sanayi ve Ticaret A.S) <ovs.co.uk> discussing the applicable principles when a short domain name is registered by a trader in domain names. The same principles apply in the present case.
- 6.19 The Complainant is also incorrect to suggest that its trade mark rights (assuming it has some) prevent anyone else using the term “Peli” - any such rights may prevent others from using the same term in the same field of activity but will not generally prevent use in another field not covered by the trademark in question.
- 6.20 On the balance of probabilities and in light of this evidence provided, I do not accept that the Respondent purchased the Domain Name with the primary intention to sell it to the Complainant or a competitor of the Complainant. I accept it purchased it as a generic four-letter domain name that might be of value to any number of persons.
- 6.21 On this basis, I do not consider there is an Abusive Registration, and hence the Complaint fails.

Reverse Domain Name Hijacking.

- 6.22 The Respondent has requested a finding of Reverse Domain Name Hijacking. This is defined in the DRS Policy in section 1 as “using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name”.
- 6.23 Where I might consider the allegation of Abusive Registration on its own in this case was an innocent misunderstanding of DRS Policy, there are two other unsubstantiated assertions made by the Complainant, which have been refuted by the Respondent, which need consideration.
- 6.24 Firstly, the Complainant said about the Respondent that “It is also clear that no description of business has been provided and with a quick google search they have been subject to complaints to Nominet in the past”. This was accompanied by a link to a report of DRS decision D18624. No further explanation was provided. However if that case is reviewed it is readily apparent that the Respondent succeeded, on facts remarkably similar to the present case - in that the Respondent had acquired another four letter domain name (scor.co.uk) for its generic value rather than by way of targeting the complainant in that case. The Complainant presented this case as part of its evidence presumably with the intention that the Expert here should view it as evidence of wrongdoing on the part of the Respondent. In fact, it is precisely the opposite and should have alerted the Complainant to the difficulties with its own case.
- 6.25 It strikes me that this might have been done having not taken the time to read through the case and understand that the mere existence of a complaint against the Respondent did nothing whatsoever to further their argument. However, in considering whether this amounts to “bad faith” I am not minded to distinguish between this potential mistake on the one hand, and a more overt attempt to deceive the Expert on the other. Submitting evidence to the DRS without properly understanding what is held within that evidence, let alone how it relates specifically to the complaint at hand or the DRS Policy underpinning the decision-making process, is not acceptable. Considering that the result of this action might be the removal of legitimately obtained property from the Respondent, it would not be right for me to excuse this act, even if it were simply a mistake.
- 6.26 Secondly, the Complainant has stated that “The domain was originally registered to us and expired and as soon as it did Stenning registered it for the purpose of financial gain from buying and selling domains, and does not have a legitimate claim to the name”.
- 6.27 Evidence filed by the Respondent shows this is factually inaccurate. It is not clear when (if at all) the Complainant was the registrant of the Domain Name or when it allowed it to lapse (no detail has been provided in the Complaint about this issue), but in any case evidence provided by the Respondent

shows that as of 2013 the Domain Name was in the possession of a third party which traded via a website linked to giraffe.co.uk. The Respondent acquired the Domain Name from that business in an arms length transaction in 2019. It accordingly follows that the Complainant's case that the Respondent snapped up the Domain Name as soon as the Complainant allowed it to lapse (which might be evidence supporting a finding of bad faith) is incorrect.

- 6.28 Once again, even if this was done negligently rather than maliciously, I consider it unacceptable for the reasons set out above.
- 6.29 Taken as a whole I reach the conclusion that the Complaint is materially inaccurate in important respects. I have had regard to the fact the Complaint has been prepared in house by the Complainant without legal representation. I do not know whether the inaccuracies in the Complaint arose deliberately or as a result of carelessness. I do however consider that they go beyond minor mistakes and would (if they had been accepted) have materially misled me.
- 6.30 As a result, I consider this at the very least to be an attempt by the Complainant to weaken the Respondent's case in the eyes of the Expert by presenting inaccurate unchecked evidence, and so obtain the Domain Name from the Respondent. This in my view leads to a finding the Complainant is using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name.
- 6.31 Accordingly I find that this complaint was an attempt at Reverse Domain Name Hijacking by the Complainant.

7. Decision

- 7.1 I find that the Complainant has failed to adequately demonstrate that they have Rights in the Domain Name in question, or that they have license to such Rights. Therefore the Domain Name should remain in the hands of the Respondent.
- 7.2 Further to this finding, I consider that the complaint constitutes an attempt at Reverse Domain Name Hijacking.

Signed Nial Vivian

Dated

8 November 2020