

DISPUTE RESOLUTION SERVICE

D00020183

Decision of Independent Expert

HIMOINSA, S.L.

and

Identity Protect Limited

1. The Parties:

Complainant: HIMOINSA, S.L.
Crtra Murcia San Javier Km 23.6
San Javier
Murcia
30730
Spain

Respondent: Identity Protect Limited
PO Box 786
Hayes
Middlesex
UB3 9TR
United Kingdom

2. The Domain Name:

<himoinsa.co.uk>

3. Procedural History:

I 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 such a nature as to call into question my independence in the eyes of one or both of the parties.

9 May 2018 11:43	Dispute received
9 May 2018 14:53	Complaint validated
9 May 2018 15:00	Notification of complaint sent to parties
29 May 2018 02:30	Response reminder sent
4 June 2018 11:23	No Response Received
4 June 2018 11:23	Notification of no response sent to parties
14 June 2018 02:30	Summary/full fee reminder sent
15 June 2018 12:22	Expert decision payment received

4. Factual Background

The Complainant is part of the Yanmar Group, and manufactures power generators, lighting and associated equipment. The scale of the Complainant is that it employs about 1,000 people worldwide.

The Complainant holds trademarks for HIMOINSA, of which the following are representative for the purposes of this proceeding:

HIMOINSA, figurative, European Union trademark number 001787001, registered on 24 November 2004 in class 7;

HIMOINSA, figurative, International trademark number 1225687, registered on 22 May 2014 in classes 7 and 9;

HIMOINSA, figurative, United States trademark number 4953367, registered on 10 May 2016 in classes 7 and 9.

The Respondent is a privacy service and the Expert has not been formally notified of the identity of the underlying registrant of the disputed Domain Name, which was registered on 3 March 2011. However, after the No Response Received Notice was served, the Respondent forwarded an email to Nominet from which it appears that the underlying registrant is "T Stiff". At the time of filing of the Complaint, the Domain Name resolved to a parking page of the Registrar hosting service with a promotion for a website building application.

5. Parties' Contentions

Complainant

Complainant's Rights

The Complainant says that it, and no other entity, has rights in the trademark HIMOINSA, and has produced copies of online registration documents in its name in respect of the trademarks listed in section 4 above. It says that International trademark number 1225687 is designated in 40 international jurisdictions.

The Complainant says the Domain Name is identical to its trademark, which is incorporated in its entirety, resulting in a likelihood of confusion that may be misleading to Internet users.

Abusive Registration

The Complainant says it is not in any way associated with or related to the Respondent, and has not permitted the Respondent to use its trademark or to apply for any domain name incorporating it. The Domain Name is not in any legitimate use. The website to which it resolves has no content but redirects to a domain trading website.

The Complainant asserts that it has therefore stated a *prima facie* case to the effect that the Respondent has no rights or legitimate interests in the Domain Name.

The Complainant sets out its points of claim of Abusive Registration in abbreviated form. The Complainant says that its trademark is well known internationally, therefore the Respondent knew about it and registered the Domain Name in bad faith. The fact that the Domain Name is in effect passively held does not prevent a finding of bad faith, because the Respondent clearly intends to do something profitable and not legitimate with it, to cause Internet users to confuse it with the name of the Complainant, and to prevent the Complainant from using the same Domain Name.

The Complainant requests the transfer to itself of the Domain Name.

Respondent

The Respondent has not provided any formal Response to the Complaint.

In an email of 5 June 2018, evidently forwarded by the privacy service after delivery of the No Response Received notice to the privacy service, a person speaking as the underlying registrant through the Respondent said informally (re-punctuated):

“Hi. Thanks for the email. As mentioned before, I legally acquired the mentioned name from 123 reg, I am not using it in anyway shape or form. It is sitting dormant, which is perfectly legal. As I have previously stated, I would be willing to listen to sensible offers for the mentioned name that I am the LEGAL owner of. Many thanks. T Stiff”.

6. Discussions and Findings

Under paragraph 2.1 of the Policy the Complainant must prove, on the balance of probabilities, 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.”

Complainant’s Rights

In paragraph 1 of the Policy rights are defined 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”.

The Complainant has produced evidence satisfactory to the Expert of its rights in the trademark HIMOINSA, including a European Union trademark registration dating back to 2004, more than six years before registration of the Domain Name. The Complainant also holds an International trademark registration designated in a number of countries including Great Britain, being the registered address of the Respondent, and Spain, being the registered address of the Complainant.

The Domain Name extension “.co.uk” may be disregarded in the determination of similarity to the Complainant’s trademark. The Domain Name then reads “himoinsa”, which is identical to the Complainant’s trademark. Accordingly the Expert finds for the Complainant under paragraph 2.1.1 of the Policy.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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. is being used or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.”

Paragraph 5 of the Policy states as follows:

“5.1 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;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 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;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.4 It is independently verified that the Respondent has given false contact details to us;

5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively;
and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) 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 having registered the Domain Name.

5.2 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.

5.3 There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the complaint was filed. This presumption can be rebutted (see paragraphs 8.1.4 and 8.3)".

The Complainant is expected to prove its Complaint, on the balance of probabilities, under the applicable paragraphs of the Policy. The Complaint has not been formally contested by the Respondent. The Respondent was not obliged to respond, but "if the Complainant has satisfied the Expert that the Respondent has a case to answer, the Expert will be looking for an answer" (Dispute Resolution Service Experts' Overview, version 3, paragraph 4.1).

The Complainant's main supporting evidence is the three trademark registration documents, including the re-registration of a European trademark at the USPTO. On the other hand, the statements made by the Complainant are over a certification by the Complainant that "the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument".

The Complainant's statement to the effect that the Domain Name does not have any content but redirects visitors to "a general website of domain trading" is a reasonable interpretation of the screen capture taken by Nominet at the time of filing of the Complaint, which shows a website that promotes website building facilities, provided by 123 Reg, being the registrar, hosting service and source from which the Respondent acquired the Domain Name. In other words, the Domain Name is parked and not in any discernible use for a website or email address. That, in and of itself, is not determinative of whether there is or is not an Abusive Registration (paragraph 5.2 of the Policy).

Considering paragraph 5.1.6 of the Policy, it is clear, first, that the Domain Name exactly matches the Complainant's name and trademark.

The next question under paragraph 5.1.6 of the Policy is whether the Complainant's name or trademark has a reputation. Paragraph 5.1.6 of the Policy does not define any extent of reputation in space and time beyond "has a reputation". The Complainant's European Union trademark 001787001, registered on 24 November 2004, was filed as early as 1 August 2000, some 18 years ago and more than 10 years before the Domain Name was first registered. Although not expressly stated anywhere, it is reasonable to infer that the trademark HIMOINSA also represented the Complainant's name at that time. The Complainant asserts its scale and international recognition by stating that it has 11 subsidiaries worldwide, eight production centres and 1,000 employees who work closely with more than 130 distributors around the world. The Complainant's established business in building, among other things, diesel and gas electricity generators, lighting towers and solar power systems, would project considerable substance and investment. In the absence of further details of the Complainant's industrial activities, the Expert notes the Complainant's long-standing European Union trademark as supporting evidence that it has a reputation, a matter not challenged by the Respondent.

The final question under paragraph 5.1.6 of the Policy is whether the Respondent is without reasonable justification for having registered the Domain Name. The name and trademark HIMOINSA appears to be a distinctive acronym or non-dictionary word and not generic or descriptive. The issue is whether the Domain Name could be interpreted as likely targeting the Complainant, or whether the word "himoinsa" is in wider usage.

Generally, Experts rely solely on the material and documents presented in the Complaint and Response. Paragraph 5.10 of the Experts' Overview, however, cites the decision in the case of *Chivas Brothers Limited v. David William Plenderleith* (DRS Case No. DRS 00658). Previous cases do not have the status of precedent. Nevertheless the present Expert notes the following passage from that decision: "(...) should the Expert conduct an online check at the Trade Marks Registry to verify whether or not there had been an Assignment, a check which need take no more than a couple of minutes of the Expert's time?" That Expert decided to do so, in part because he was "(...) conscious that in all probability the Complainant possessed the rights claimed for it in the [Complaint]".

In the present case the Expert decided, exceptionally, to spend a "couple of minutes" checking the Global Brand Database of the World Intellectual Property Organization. In the relevant words of the Experts' Overview, to do so would be "expedient" and "proportionate" versus the peremptory alternative. The Expert was also conscious of the principles of natural justice since the wording of the Complaint indicated the Complainant may have been under some possible disadvantage in presenting the Complaint in English.

The online check immediately returned 20 results for "himoinsa", every one of them registered to the Complainant, or an entity clearly related to the Complainant using the same distinctive trademark in logo form. One result also incidentally revealed the apparent origin of the acronym HIMOINSA as Hispano-Italiana De Motores Industriales, S.A. The Respondent has offered no justification for having registered the Domain Name comprising the Complainant's distinctive and apparently unique name and trademark, except to await "sensible offers", and the Expert can envisage no legitimate justification.

On the preponderance of the evidence, the Expert finds it more probable than not that the grounds exemplified under paragraph 5.1.6 of the Policy are fulfilled and therefore the Expert finds Abusive Registration of the Domain Name under paragraphs 1(i) and 2.1.2 of the Policy.

Furthermore, whereas there has been no formal Response, the email quoted in the Respondent's Contentions above at least projects the Respondent's frame of mind. The email confirms unequivocally the reasonable inference that the Respondent expected to sell the Domain Name for a profit. If there has been no direct approach to the Complainant from the Respondent with an offer to sell, that would be unsurprising since any such approach is recognised as being potentially prejudicial in the terms of paragraph 5.1.1.1 of the Policy, and sellers now usually wait for an approach from a buyer.

There is no assumption that the present Respondent is a trader in domain names, but that is of no consequence. Trading in domain names is common, and may generally be legitimate (paragraph 8.4 of the Policy). However, there are exceptions. Whilst it is legitimate to sell benign domain names, those comprising strings of alphanumeric characters, generic or descriptive words and the like, or in some circumstances words dissipated among the trademarks or names of multiple users, it ceases to be legitimate if a particular trademark or name is targeted. On balance, the Expert finds it considerably more probable that the distinctive and possibly unique word or trademark HIMOINSA was incorporated in the Domain Name through prior awareness, than that it was coined afresh for the purpose. As the Respondent has stated informally, "It is sitting dormant (...) I would be willing to listen to sensible offers (...)". Realistically, the Complainant (or a competitor) was the ultimate sales target.

On the balance of probabilities, the Expert finds the use of the Domain Name to fall within the contemplation of paragraph 5.1.1.1 of the Policy and accordingly Abusive Registration is found additionally under paragraphs 1(ii) and 2.1.2 of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in respect of a name or mark identical to the Domain Name <himoina.co.uk> and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Domain Name <himoina.co.uk> is ordered to be transferred to the Complainant.

Signed Clive Trotman

Dated 26 June 2018