

Nominet UK Dispute Resolution Service

DRS Number 5337

Bourne Leisure Limited and Bourne Holidays Limited v Sergei P

Decision of Independent Expert

1. Parties

Complainant: Bourne Leisure Limited and Bourne Holidays Limited
Address: No 1 Park Lane
Hemel Hempstead
Hertfordshire
Postcode: HP2 4YL
Country: GB

Respondent: Sergei P
Address: Main Office Tower
Financial Park Complex
Labuan
Postcode: 87000
Country: MY

2. Domain Names

warner-breaks.co.uk ("the Domain Name")

3. Procedural Background

21 December 2007:	Complaint lodged with Nominet electronically
21 December 2007:	Hardcopy complaint received by Nominet
21 December 2007:	Nominet forwarded complaint to Respondent
18 January 2008	No response received by Nominet

On 15 February 2008 I, Adam Taylor, the undersigned, confirmed to Nominet that I knew of no reason why I could not properly accept the invitation to act as expert in this case and further confirmed that I knew of no matters that ought to be drawn to the attention of the parties which might appear to call into question my independence and/or impartiality.

4. Outstanding Formal/Procedural Issues (if any)

None

5. The Facts

The Complainants are Bourne Leisure Limited and its wholly owned subsidiary Bourne Holidays Limited. (I will refer to them collectively as the "Complainant".)

The Complainant offers a wide range of resort/hotel, entertainment, activity, leisure, spa breaks and holiday packages as well as festive and themed breaks under the brand names: "Warner" / "Warner Breaks" / "Warner Leisure Hotels".

The "Warner" brand has been in existence since the 1930s. The Complainant has used the mark "Warner Breaks" and various stylised designs and logos incorporating the words "Warner Breaks" since 2003.

The Complainant's turnover referable to the Warner brand in the company's financial year 2006 was £95,292,000. The Complainant has spent the following on marketing the brand: 2004 - £7,621,000; 2005 - £10,553,000 and 2006 - £11,038,000 (estimated). Advertising and marketing expenditure amounted to 8% of turnover in 2004; 11% in 2005 and 12% in 2006.

The Complainant has operates its own website at www.warnerbreaks.co.uk since 2003.

The Complainant owns a number of registered trade marks related to "WARNER" including UK No. 1286282 for the word "WARNER" dated 1 October 1986 in classes 39, 41 and 42, UK No. 1286285 for the words "WARNER SHORT BREAKS" dated 1 October 1986 in classes 39, 41 and 42 and CTM No. 003701431 for the word / device "warner breaks" dated 2 March 2004 in classes 16, 41, 43, 44.

The Respondent registered the Domain Name on 22 February 2005.

On 10 July 2007 (and on various other dates), there were websites at the Domain Name with directories of affiliate links, most of which led to the websites of the Complainant and its competitors.

6. The Parties' Contentions

Complaint

The Complainant owns registered trade marks for and incorporating "Warner" and "Warner Breaks" and has built up significant goodwill in those names.

The Domain Name is identical to the Complainant's registered and unregistered rights in the brand "Warner Breaks".

Accordingly, the Complainant can demonstrate that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.

The Domain Name in the hands of the Respondent is an Abusive Registration because it was primarily registered or otherwise acquired by the Respondent to stop the Complainant registering it despite the Complainant's rights in the name. Due to the Complainant's significant reputation for providing holidays and short breaks under the "Warner Breaks" brand, and the fact that the Respondent has diverted the domain name to a website containing links relating to services identical or similar to those of the Complainant, it is inconceivable that the Respondent did not know of the Complainant's "Warner Breaks" brand when he registered the Domain Name.

The Respondent does not trade using the mark "Warner" or "Warner Breaks" nor does he appear to use such marks in relation to his business or services. The Respondent has registered the Domain Name as a means of diverting web users searching for information about the well-known services provided under the Complainant's Warner Breaks brand to his own site and has no legitimate interest in the Domain Name.

The Domain Name was registered or otherwise acquired by the Respondent for the purpose of unfairly disrupting the business of the Complainant. The Domain Name resolves to a website of search results, which varies from time to time. The website features links to other

providers of hotel, travel and entertainment services. This is clearly misleading to customers who will expect to access the Complainant's website via the Domain Name. The Respondent clearly acquired the Domain Name primarily for the purpose of diverting traffic from the Complainant and recouping increased sums through the site's sponsored links as a result.

The Domain Name has been used in a way which has confused people or businesses into believing that the name is registered to, authorised by, or otherwise connected with the Complainant. Many users trying to access the Complainant's site will have been directed to the Respondent's site. Those accessing the Respondent's site may have been confused into thinking that the Respondent is connected with the Complainant, or that the Complainant does not have a website.

Response

The Respondent did not file a response.

7. Discussion and Findings:

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Names and, second, that the Domain Names, in the hands of the Respondent, are abusive registrations (as defined in paragraph 1 of the DRS Policy).

Complainant's Rights

The Complainant undoubtedly has common law rights in the mark "WARNER BREAKS" by virtue of its extensive trading activities under that name since 2003. That mark is identical to the Domain Name, disregarding the domain suffix.

The Complainant also owns registered trade marks for the words "WARNER" and "WARNER SHORT BREAKS" as well as for the word / device "warner breaks". Those marks are all similar to the Domain Name.

The Complainant has established rights in a names or marks which are identical and similar to the Domain Name.

Abusive Registration

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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."

I note the following:

1. The Complainant's "WARNER" brand is well-known in the UK.
2. The Domain Name, a combination of the words "WARNER" and "BREAKS", is clearly referable to the Complainant's trade mark.

3. It is difficult to conceive of any genuine purpose for registration of the Domain Name and the Respondent has not come forward to offer any explanation.
4. The Domain Name has been used for websites consisting of directories of affiliate links, most of which led to the websites of the Complainant and its competitors.

I think it reasonable to infer from this that the Respondent registered the Domain Name in order to divert and profit from internet users seeking the Complainant.

I conclude from this that the Domain Name is an abusive registration in that was registered and has been used in a manner which took unfair advantage and/or was unfairly detrimental to the Complainant's rights.

8. Decision

The domain name warner-breaks.co.uk should be transferred to the Complainant.

Adam Taylor

Date