

## DISPUTE RESOLUTION SERVICE

DRS 06806

### Decision of Independent Expert

Björn Borg Brands AB (1)  
Björn Borg (2)

and

T'imarco

#### 1. The Parties:

Complainant (1): Björn Borg Brands AB  
Address: Gotgatan 78  
Stockholm  
Postcode 118 30 Stockholm  
Country: Sweden

Complainant (2): Björn Borg  
Address: PO Box 117  
Ingaro  
Postcode 130 35 Ingaro  
Country: Sweden

Respondent: Giorgio Timarco  
Address: Box 5231  
Stockholm  
Postcode: 102 45 Stockholm  
Country: Sweden

#### 2. The Domain Name(s):

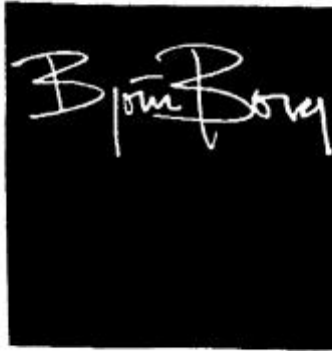
<bjornborg.co.uk> (the "Domain Name")

### **3. Procedural History:**

- 3.1 The Complaint entered Nominet's system on 30 January 2009. The Complaint was validated under Nominet's dispute resolution service policy (the "Policy") and sent to the Respondent on 2 February 2009. Nominet informed the Respondent that it should file any Response by no later than 24 February 2009. The Respondent sent an email to Nominet on 20 February 2009 and Nominet accepted this as the Respondent's Response. On 2 March 2009 the Complainants sent an email to Nominet informing it that they did not intend to file a Reply and requesting that the matter go to mediation. Mediation not being successful and the Complainants having paid the relevant fee, the Complaint was referred to me. I confirmed that I was not aware of any reason why I could not act as an Independent Expert in this case and I was appointed as such on 30 April 2009.

### **4. Factual Background**

- 4.1 There are two Complainants in this case. The Second Complainant is the well known tennis player Björn Borg, who amongst other tournaments was the winner of the Men's singles title at Wimbledon from 1976 to 1980. The First Complainant is Björn Borg Brands AB. It was established in 1997 and since then has dealt in "Björn Borg" branded products that now include clothing, footwear, bags, eyewear and fragrances. In 2007 total reported net sales amounted to approximately £49 million.
- 4.2 "Björn Borg" branded products have been sold in the United Kingdom since September 2006 and are currently sold in over 60 retailers across the country. In 2007 reported sales in the United Kingdom amounted to approximately £1 million.
- 4.3 Björn Borg Brands AB has also since 6 December 2006 been the owner of a number of trade marks and trade mark applications either comprising or incorporating the name "Björn Borg" name including:
- (i) United Kingdom Trade Mark no. 2041908 in class 3, 9, 18, 25 and 28 filed on 19 October 1995 in the following form:



## BJÖRN BORG

- (ii) Community Trade Mark no. 798660 in classes 3, 9, 18, 21, 24, 25 and 28 published on 31 January 2000 for the word “Björn Borg”.
- 4.4 Björn Borg Brands AB also promotes its business products from a website using the domain names <bjornborg.net> and <bjornborg.com>. The second of these two domain names was previously the subject matter of proceedings under the UDRP (the domain name dispute resolution policy that applies to <.com> domain names) in *Björn Borg Brands AB y Björn Borg c. Miguel García* WIPO Case No. D2007-0591.
- 4.5 The Domain Name is registered in the name “T’imarco” and therefore it is not entirely clear who is the Respondent. However, it seems likely that this is either the individual “Georgio Timarco” or possibly Timarco Sweden AB, a company associated with Mr Timarco.
- 4.6 The Domain Name was registered by the Respondent on 8 April 2006. As at the date of the Complaint the Domain Name resolved to a website operating from the domain name <timarco.se>. This website offered for sale clothing (predominantly underwear and sports clothing) of various brands, of which “Björn Borg” branded products was one of many.
- 4.7 More recently the use of the Domain Name appears to have changed. It now resolves to a website operating from the address <http://bjornborgse.timarco.se>, which would appear only to sell “Björn Borg” branded products

## 5. Parties’ Contentions

- 5.1 The Complaint refers to the First Complainant’s various registered trade marks and also the reputation of the Second Complainant as a sports star. Reference is made to the decision of *48 Limited and Wayne Mark Rooney -v- Mr. Huw Marshall* (DRS 03844). This appears to be a claim of “unregistered trade mark” rights under the English law of passing off.

- 5.2 The Complainants contend that the Domain Name is identical to these trade marks. The fact that the Domain Name contains the Latin character “o” instead of the Swedish character “ö” is said to be insignificant given that “the system of registry of non-Latin characters is still in development”.
- 5.3 So far as abusive registration is concerned the Complainants make reference to the Respondent’s use of the Domain Name and they state:
- “While ... the first Complainant were obviously agreeable to the reselling of BJORN BORG branded goods by third parties [it] did not authorise any third parties, including the Respondent, to use the BJORN BORG name or mark in a domain name registration including the Domain Name.”
- 5.4 The registration is said to be contrary to paragraph 3(a)(i)(A) of the Policy i.e. that the:
- “Respondent registered 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, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name”.
- 5.5 In this respect the Complainants claim that when the First Complainant contacted the Respondent:
- “the Respondent refused to effect transfer of the Domain Name. Instead the Respondent offered to negotiate conditional on the first Complainant agreeing to various business arrangements which the Complainant considers to be equivalent of greater than the general out-of-pocket expenses associated with the purchase of the Domain Name”
- 5.6 The Complainants also contend that the Domain Name was registered as a “blocking” registration contrary to paragraph 3(a)(i)(B), as “the Complainants may wish to use the Domain Name as the UK equivalent to the [www.bjornborg.net](http://www.bjornborg.net) website”.
- 5.7 The Complainants further contend that the registration is contrary to paragraph 3(a)(i)(C) in that the Domain Name was registered primarily for the purpose of unfairly disrupting the Complainants’ business, and paragraph 3(a)(ii) in that the “Domain Name would be a natural port of call for a UK or other internet user looking for the UK authorised website”.
- 5.8 Finally, the Complainants make a number of submissions as to why the registration should otherwise be treated as constituting an abusive registration. They claim that the unauthorised use “of the BJÖRN BORG mark in the Domain Name will potentially erode its distinctiveness and decrease its value”. Further reference is made to section 60 of the Trade Marks Act 1994 and the citing of that section by the Nominet Appeal Panel in *Seiko UK Limited v Wanderweb* DRS 00248.
- 5.9 The Respondent has served no substantive Response in these proceedings. Its email of 20 February 2009 read as follows:

“We have had previous talks with the complainant which were never finalized. The registration has not been done in bad faith. We are looking forward to the mediation and we are sure we will find a satisfactory solution as we do not intend to cause any harm to the complainant.  
Rgds Giorgio Timarco”

## 6. Discussions and Findings

### General

6.1 To succeed under the Policy, the Complainants must prove on the balance of probabilities, first, that they have Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainants are required to prove to the Expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

*"Abusive Registration means 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."*

6.3 The failure by the Respondent to file a substantive submission in response to the Complaint does not entitle the Complainants to the equivalent of a default judgment on these issues. The Complainants still have to make out their case on the balance of probabilities under the Policy to obtain the decision they want. However, in the absence of any exceptional circumstances I am entitled to draw such inferences from the Respondent's non-compliance with the Policy or the procedure for the conduct of proceedings under the Policy (the "Procedure") as I consider appropriate (paragraph 15(c) of the Procedure).

### Complainants' Rights

6.4 I accept that the First Complainant owns a number of registered trade marks that incorporate the name "Björn Borg" and that its community trade mark comprises that name alone. I also accept that it is likely that the Second Complainant has unregistered trade mark rights in his name that would also provide rights that are recognised for the purposes of the Policy.

6.5 The Domain Name can only be sensibly understood as the name "Björn Borg" with the character "ö" replaced with the character "o", combined with the "co.uk" second level domain. I also accept that the character "o" is the obvious replacement for "ö" where the domain name in question can only incorporate Latin characters.

- 6.6 In the circumstances, the Domain Name is similar to (if not virtually identical to) at least one trade mark in which the Complainants have rights.

#### Abusive Registration

- 6.7 The facts of this case are relatively straightforward. The Respondent has deliberately registered a domain name that it knows essentially comprises the name of the Second Complainant. It also seems reasonably clear that this registration was made with the First Complainant's uses of the "Björn Borg" name as a trade mark for clothing and other products in mind. This is apparent from the fact that the Domain Name has been used to redirect users to a website that sells products that bear the BJÖRN BORG mark and other competing products.
- 6.8 In *Seiko UK Limited v Wanderweb* DRS 00248 the respondent registered, inter alia, the domain name <seiko-shop.co.uk>, which it used to sell genuine Seiko products. Nevertheless the Appeal Panel in that case held that the registration was abusive. Further, in *Hanna-Barbera Productions, Inc -v- Graeme Hay* DRS 00389 the registration <scoobydoo.co.uk> was held to be abusive where the domain name was registered and used in connection with an unofficial fan website.
- 6.9 These were the first two Appeals under the Nominet system and there are aspects of the reasoning in each of these decisions that have been subject of further discussion and debate (for example, the section 60 analogy in the *Seiko* decision). Nevertheless, in my view the outcome in each of these cases was correct.
- 6.10 In each case the domain name either comprised the entirety of another's mark or that mark with some non-distinguishing addition. Therefore, essentially these were both cases of impersonation. The registrant had sought to take advantage of the reputation of the relevant mark to draw internet users who thought that the domain name was operated by, or otherwise officially associated with, the trade mark owner to the registrant's website. Registration and use of a domain name with the intent of taking advantage of that "initial interest confusion" was sufficient for the registration to be abusive under the Policy even if when the internet user reached the website it became clear that it was operated by some "unauthorised" entity.
- 6.11 I have little doubt that the Respondent registered the Domain Name with the intention of also taking advantage of similar initial interest confusion in this case and accordingly the registration is similarly abusive.
- 6.12 Another factor that points to abuse is the fact that the website to which the Domain Name resolved was also at the time of the Complaint being used to sell products that competed with those of the Complainants. Essentially, the Respondent was using the Complainants mark in order to attract internet users to a website where it sold competing products. There have been recent changes to the website displayed. However, the

Respondent offers no explanation for that change, nor does it seek to argue that its earlier use can or should be discounted.

- 6.13 In the circumstances, the Respondent's registration and use falls within the scope of paragraph 3(a)(ii) of the Policy. This provides that one of a number of factors that can provide evidence that a domain name is an abusive registration is:

“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”

- 6.14 This is sufficient to justify a finding of abusive registration in this case. Therefore, it is unnecessary to consider the Complainants' other submissions under paragraphs 3(a)(i)(A), 3(a)(i)(B), and 3(a)(i)(C) of the Policy.

## **7. Decision**

- 7.1 I find that the Complainants have Rights in a trade 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.
- 7.2 I, therefore, determine that the Domain Name should be transferred to the Complainants. In the absence of any request to the contrary, I determine that the transfer should be to the lead Complainant, Björn Borg Brands AB.

**Signed:** Matthew Harris

**Dated:** 12 May 2009