

DISPUTE RESOLUTION SERVICE

DRS 06909

Decision of Independent Expert

CLABER SPA

and

Jonathan Bujak

1. The Parties

Complainant: CLABER SPA
Address: Oliviano Spadatto
Via Pontebbana 22
Fiume Veneto
Pordenone
Postcode 33080
Country: Italy

Respondent: Jonathan Bujak
Address: 9 Albion Avenue
Blackpool
Lancashire
Postcode: FY3 8NA
Country: UK

2. The Domain Name

claber.co.uk

3. Procedural History

Nominet received the complaint on 4 March 2009 and checked that it complied with its UK Dispute Resolution Service Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure').

The complaint was supported by material in twelve annexes:

- A company registration abstracts
- B an extract from the Complainant's marketing catalogue for 2009
- C a schedule of annual UK turnover for the years 1998 to 2008
- D a list of authorised UK dealers
- E publicity material and photographs relating to trade exhibitions 2000 to 2008
- F a selection of the Complainant's advertisements in gardening magazines from 2000 to 2008
- G copies of international trade mark registrations
- H copies of trade mark registrations with particular relevance in the UK
- I a schedule of the Complainant's international domain name registrations for 'Claber'
- J the results of searches in UK, European Community and international trademark databases for a link between the Respondent's name and 'Claber'
- K the results of Google and Yahoo searches for a link between the Respondent's name and 'Claber'
- L searches for the domain name at the internet Wayback Machine archive

Nominet notified the Respondent of the complaint on 6 March, informing him that he had 15 working days within which to offer a response. No response was received within that period. Informal mediation not being possible, on 30 March Nominet wrote to both parties to explain that the case would be referred for an expert decision if the appropriate fee was paid no later than 15 April. The fee was received on 7 April.

On 7 April I, Mark de Brunner, agreed to serve as an expert under Nominet's Dispute Resolution Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

4. Factual Background

At the time of writing, the domain name did not resolve to anything but I have visited the Complainant's website at claber.com. From those limited checks, the complaint and the administrative information supplied routinely by Nominet, I accept the following as facts.

The Complainant was established in 1968 and incorporated in 1986. It makes and sells irrigation systems and watering equipment. Based in Italy, it operates in over seventy countries. Annual UK turnover has ranged between £54k and £365k over the ten years to 2008, peaking at £660k in 2001.

The Complainant holds trademark registrations for the name Claber throughout the world. In the UK, it registered the name with the Intellectual Property Office on 29 July 1982. The Complainant operates a website at claber.com and has registered numerous other 'claber' domain names internationally.

The domain name at issue was registered by the Respondent on 14 February 1999. The Wayback Machine archive indicates that the domain name was inactive at 26 February 2009 and that, apart from a webpage at three points during 2007, there is no evidence of the domain name's having been put to use since that registration. The webpage that appeared, briefly, during 2007 describes itself as a free holding page and appears to have been put up by the Respondent's web host. It describes the main services that the host offers. In summary, the domain name is currently inactive and has had no significant use for at least the last few years.

5. Parties' Contentions

Complainant

The Complainant says it has rights in the name Claber.

It accepts that failure to use a domain name is not of itself evidence of an abusive registration, but argues that

- (i) while the Complainant has rights in Claber, the Respondent has no apparent rights in the name: there appears to be no legitimate link between Jonathan Bujak and 'Claber'
- (ii) the domain name is not active and there is no evidence of either use or demonstrable preparations to make use of it in connection with a genuine offering of goods or services; nor is there evidence of non-commercial fair use
- (iii) there is no social or commercial relationship between the Complainant and the Respondent – indeed nothing that could lead to the Respondent's reasonably believing he was authorised to register the domain name
- (iv) 'Claber' is neither generic nor descriptive, nor is it in the English dictionary, so it is not credible that the name was chosen by chance
- (v) the Complainant's rights pre-date the Respondent's
- (vi) the domain name is effectively a 'blocking' registration

On that basis, the Complainant says that this is an abusive registration.

Respondent

There has been no response.

6. Discussions and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it has rights in respect of a name or mark which is identical or similar to the domain name; and
- the domain name, in the hands of the Respondent, is an abusive registration

No response

There has been no response in this case. Paragraph 15 c of the Procedure says that, in the absence of exceptional circumstances, if a party does not comply with any provision in the Policy or Procedure, the expert will draw such inferences from the non-compliance as he or she consider appropriate.

The approach to be taken by experts in this situation is long established. It is for the Complainant to make out at least a prima facie case. Such a case demands an answer and, in the absence of one, the complaint will ordinarily succeed. I am not aware of any exceptional circumstances, so the question becomes whether the Complainant has made out a prima facie case.

Rights

The Complainant has been trading as Claber for many years. It has an established UK and international presence, and recent annual UK turnover that peaked at £660k in 2001. It has invested significantly in publicity over that period, with regular appearances at trade exhibitions. It can also demonstrate registered rights in the name Claber going back over twenty years – both in the trademarks it holds and in its worldwide domain name registrations. The Complainant evidently has both registered and unregistered rights in Claber.

Ignoring the .co.uk suffix as simply a generic feature of the domain name register and capitalisation (because this part of a URL is not case sensitive), the domain name is also Claber.

I conclude that the Complainant has rights in respect of a name that is identical to the domain name.

Abusive registration

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration and a further list of factors that may point in the other direction. The Complainant has clearly had these in mind when formulating the complaint and it makes sense to run through its arguments briefly in the order that they are put forward.

On the evidence before me, I accept that the Respondent does not appear to have any rights in the name Claber. It also seems reasonable to conclude that the domain name has not been used (and is not being prepared for use) in connection with a genuine offering of goods or services. Given that there has been no (or, at any rate, no significant) use of the domain name at all, the question of legitimate non-commercial or fair use does not arise.

I agree that there is nothing before me that could lead the Respondent reasonably to believe he had the Complainant's authority to register the domain name.

I note that the name Claber is neither generic nor descriptive, and that it is not a word that appears in the English dictionary. It does therefore seem to me reasonable to infer that the name was not chosen by chance.

Given that the Complainant can demonstrate registered rights in the name Claber going back over twenty years, on the evidence the Complainant's rights pre-date the Respondent's.

The Complainant's final argument is marginally less straightforward. It says that the domain name is effectively a 'blocking' registration – noted in the Policy as a factor that may be evidence of abuse. As a matter of fact, a current registration will prevent other registrations of the same name. In that sense, all registrations are 'blocking' registrations. But there has long been a consensus among the experts that more is required for this to be a sign that the domain name may be an abusive registration. The question is whether more is present. The difficulty is that the answer turns on a view of the Respondent's intention at the outset and – especially where there is no response – that is difficult to judge directly. It becomes necessary to draw a conclusion on the point from the other evidence.

The Complainant accepts that non-use of a domain name is not of itself evidence of abusive registration. The Policy spells that out explicitly, but here the issue is not non-use on its own, but non-use of a name identical to the Complainant's trading name and in which the Respondent has no apparent rights. That might look less telling if the name was common or generic or at least in the dictionary. But the choice of what appears to be a specially made-up word seems unlikely to have been accidental. In my judgement, that is the key factor: it turns the domain name here from being simply a registration that blocks, as a matter of fact, into precisely the kind of 'blocking' registration envisaged in the Policy. I regard the blocking registration here as evidence of abuse.

I conclude that the Respondent's action here in registering a domain name identical to the Complainant's distinctive, made-up name, was unfairly detrimental to the Complainant's rights. At the very least, the Complainant has made out a prima facie case that the domain name is an abusive registration. It is a case that requires an answer. In the absence of an answer, and of any exceptional circumstances, the claim succeeds.

7. Decision

In summary, I find that the Complainant has rights in respect of a name which is identical to the domain name and that the domain name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the domain name be transferred to the Complainant.

Signed: Mark de Brunner

Dated: 7 May 2009