

Dispute Resolution Service

DRS10279

Decision of Independent Expert

Mobotix AG

and

Mr. Nick Palmer

1. Parties

Complainant : Mobotix AG
Luxemburger Str. 6
Kaiserlautern
67657
Germany

Respondent : Mr. Nick Palmer
3 Decimus Park
Kingstanding Way
Tunbridge Wells
Kent
TN2 3GP
United Kingdom

2. Domain Name

mobotix.co.uk (the "Domain Name")

3. Procedural Background

On 13th September 2011 the Complaint was lodged with Nominet UK Limited (“Nominet”) and was validated. On 13th September 2011 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising him to log into his account to view the details of the Complaint and giving him 15 working days within which to lodge a Response on or before 4th October 2011.

The Respondent responded on 4th October 2011. On 4th October 2011 Nominet informed the Complainant that the Response was available to be viewed via the Complainant’s online services account and inviting it to Reply to the Response on or before 11th October 2011. On 11th October 2011 Nominet informed the Respondent that the Reply was available to be viewed via the Respondent’s online services account. Mediation documents were generated for the Complaint and mediation commenced on 18th October 2011. Mediation was unsuccessful and concluded on 29th November 2011.

On 5th December 2011 the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 8th December 2011 Mr. Niall Lawless (“the Expert”) was selected and on 13th December 2011 was formally appointed to act as Expert in this dispute, having confirmed that he knew of no reason why he could not properly accept the appointment and knew of no matters which ought to be drawn to the attention of the parties which might appear to call in to question his impartiality and -/- or independence. He is required to give his Decision by 6th January 2011.

4. Outstanding Formal -/- Procedural Issues

There are no outstanding formal or procedural issues.

5. Factual background

The Complainant Mobotix AG, a German company, is a provider of high resolution network camera technology. The Respondent Mr. Nick Palmer, is a Director of Vitech Security Systems Ltd (“Vitech”) which is a systems integrator specialising in the installation, maintenance and support of access control, CCTV and door entry systems.

The Complainant is the owner of the European Community Trade Mark number E1494129 for "MOBOTIX" registered since 3rd July 2001 in classes 07, 09, 21, 35, 38, 41 and 42.

On 10th to 12th March 2004 Mr. Palmer successfully completed the Mobotix AG Network Technical Seminar of Mobotix CCTV Systems, run by an official UK distributor for the Complainant, BATT Networks. Having completed the training, Vitech decided to market and sell Mobotix cameras and associated installation services.

On 22nd March 2004 the Respondent registered the Domain Name.

The Complainant seeks transfer of the Domain Name.

6. The Parties' contentions

The Complainant

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under Nominet's Dispute Resolution Service Policy (the "Policy") because:-

- the Domain Name is being used in a way which creates a likelihood of confusion with the Complainant's trade mark.
- the Respondent has not sought to obtain appropriate approvals or relevant licences to sell the Complainant's products and is doing so illegally.
- the Domain Name was primarily registered to unfairly disrupt the Complainant's business and to take advantage of the Complainant's established reputation.
- the Domain Name has been used in a way that has confused (or is likely to confuse) people into thinking that it is affiliated, endorsed or controlled by the Complainant.

The Respondent

The Respondent says that the Domain Name controlled by him is not an Abusive Registration under Nominet's DRS Policy because :-

- the Respondent is not selling the Complainant's products illegally as Vitech purchases cameras from a number of distributors, is accredited to install Mobotix cameras and became a Mobotix/BATT partner in 2004, shortly before registering the Domain Name.
- the Complainant does not deal direct in the UK, only through distributors.

- the Domain Name is used solely to promote the supply and installation of the Complainant's products as an approved dealer.
- the Domain Name does not cause confusion when they are redirected to the Respondent's website as it clearly states that the Respondent is an "installer of Mobotix cameras".

7. Discussions and Findings

7.1 General

The Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities that:-

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

The Complainant is required to prove to the Expert that the Complainant has Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

7.2 Complainant's Rights

The Complainant's company name is MOBOTIX AG, it has obtained European trade mark protection for the term MOBOTIX and since 1998 it has used the domain name "mobotix.com" to promote the sale of its products and services. Because of that I decide that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name.

7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy, but it does not state under which part of the Policy. Under Paragraph 3 - Evidence of Abusive Registration - guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

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

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(A). 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;

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainant has Rights; or

3(a)(i)(C). for the purpose of unfairly disrupting the business of the Complainant;

3(a)(ii). 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 ...”

DRS 3882

The Respondent says that he is responding to the complaint in the same way as he did in 2005 under DRS 03882 and accompanies his Response with documentation provided at that time. The Complainant says that the prior complaint (which it also refers to as DRS 03714) is irrelevant as it did not raise the same assertions as in this complaint case number DRS 10279. The Complainant also says that the prior complaint was declared inadmissible as the complaint form incorrectly referred to the Registrant of the Domain Name as “Vitech Security Systems Ltd” and not Mr. Nick Palmer.

Nominet's Dispute Resolution Service Policy Paragraph 10(e) provides that if a complaint has reached the Decision stage on a previous occasion it will not be reconsidered by an Expert. Paragraph 10(e) also provides that if the Expert finds that the complaint is a resubmission of an earlier complaint he or she shall reject the complaint without examining it. One of the factors in determining whether a complaint is a resubmission of an earlier complaint, or contains a material difference that justifies a re-hearing is whether the Complainant, the Respondent and the domain name in issue are the same as in the earlier case.

I have used Nominet's Dispute Resolution Service (DRS) Decisions Search facility (which scans across the full decision database to find details about cases and their outcomes) looking for Expert Decisions under case numbers 03714 and 03882 and also using the text "robotix". In all three searches the DRS Decisions Search facility answered my query that "*sorry, no results were found for your search*". It therefore appears that no decision was issued.

Because of this I decide that there is no impediment to me providing a Full Expert Decision in the dispute between the Complainant (Robotix AG) and the Respondent (Mr. Nick Palmer) over the Domain Name (robotix.co.uk).

Confusion with the Complainant's trade mark

The Complainant says that the Domain Name is being used in a way which creates a likelihood of confusion with the Complainant's trade mark and that the use of the Complainant's trade mark in the Domain Name without the Complainant's authorisation or consent is an infringement of the Complainant's registered Community trade mark in relation to goods and services which are identical with those for which the Community trade mark is registered.

As a Nominet Expert I am not under duty to consider whether or not the Respondent's activities amount to a violation of the Complainant's trade mark. Expert Decisions are to be determined by reference to Nominet's DRS Policy and not the law in respect of trade mark infringement, for example as decided in Deutsche Telekom AG v Lammtara Multiserve Limited Appeal Decision (DRS 05856).

If passing off (or trade mark infringement) is a pressing concern the Complainant has the option of pursuing the matter in an English Court which it has not done. It is not the role of Nominet's DRS to act as a potential substitute for litigation in relation to all domain name disputes, only those falling within the narrow confines of the Policy.

Selling the Complainant's products illegally

The Complainant says that the Respondent has not sought to obtain appropriate approvals or relevant licences to sell the Complainant's products and is doing so illegally.

From the certificate copy provided it is clear that Mr. Palmer of Vitech successfully completed the Complainant's Network Technical Seminar for Mobotix CCTV Systems in Kent in March 2004. And although nothing hangs on it in terms of making this decision I accept the Respondent's assertion that Vitech is accredited to install Mobotix cameras and that it is not selling the Complainant's products illegally as it purchases cameras from three different distributors.

On the other hand, I also accept the Complainant's assertion that the award of an accreditation certificate to install Mobotix cameras does not give the Respondent the right to say that Vitech is the Complainant's affiliate or partner.

Unfairly disrupting the Complainant's business

The Complainant says that the Domain Name was primarily registered to unfairly disrupt the Complainant's business and to take advantage of the Complainant's established reputation. It says that the Domain Name is used to direct internet users to the Respondent's own website which sells identical and/or similar products to the Complainant's for commercial gain.

The Respondent says that the Complainant does not deal directly in the UK, only through distributors and that the Domain Name is used solely to promote the supply and installation of the of the Complainant's products as an approved dealer.

The Respondent says that in March 2004, when he registered the Domain Name, the Complainant had no plans to trade directly in the UK and that he is not willing to sell the Domain Name as Vitech is providing a service linked directly to the Domain Name.

I do not accept the Complainant's assertion that the Domain Name was primarily registered to unfairly disrupt the Complainant's business.

However, the Nominet Experts Overview says that *"unfair disruption of the Complainant's business by way of a domain name is very likely to constitute an abusive use of the domain name (DRS 02223 itunes.co.uk)"*.

It is enough for the Complainant to show that the 'abuse' occurred at any time during the 'life' of the Domain Name - so it may be that :-

- there was an 'unfair' motive when it was registered;
- there was an 'unfair' use after registration but it has now stopped;
- there was an 'unfair' motive at transfer;
- there is something 'unfair' going on now;
- the domain name is inherently 'unfair' (similar to the concept of an "instrument of fraud" in the Court of Appeal case [One In a Million](#)); or
- any combination of these.

Nominet operates a "first-come, first-served" system of domain name registration and there is no requirement for the Respondent to show that he has Rights in the name (unlike the Complainants who must prove that in order to obtain a transfer of the domain name).

In terms of the Complainant's rights it is irrelevant that the Domain Name was registered on 22nd March 2004 and Mobotix Ltd was subsequently incorporated in the UK on 19th April 2004 OR that at that time the Complainant had no plans to trade directly in the UK.

It is clear that in 2004 the Respondent was well aware of the Complainant's established reputation in the manufacture and supply of high resolution network camera technology. That is the reason why the Respondent attended the Complainant's Network Technical Seminar for Mobotix CCTV Systems in Kent in March 2004. In 2004 when Vitech decided to supply and install Mobotix cameras the Respondent registered the Domain Name.

The Domain Name is being used to automatically direct users to www.vitechsecurity.co.uk. Through this website, Vitech sells CCTV products from a range of companies such as Bewator, Pelco, Sony and Vista, in addition to those of the Complainant. The Respondent is therefore using the Domain Name to facilitate sales of a range of the Complainant's competitors' products as well as Mobotix products. This clearly takes advantage of the Complainant's established reputation and I accept that this is an unfair use of the Domain Name.

I decide that the Domain Name has been used in a way which has been unfairly detrimental to the Complainant's Rights. I decide that in the control of the Respondent the Domain Name is an Abusive Registration.

Confusion that the Domain Name is affiliated, endorsed or controlled by the Complainant

The Complainant says that the Domain Name has confused (or is likely to confuse) people into thinking that it is affiliated, endorsed or controlled by it.

The Respondent says that Domain Name does not cause internet users confusion when they are redirected to Vitech's website as the website clearly states that Vitech is an "installer of Mobotix cameras" and that the Domain Name is used solely to promote the supply and installation of the Complainant's products as an approved dealer.

When internet users use the Domain Name typing it into a web browser they are automatically directed to www.vitechsecurity.co.uk/mobotix/. This webpage has an image of a Mobotix camera and the associated text is "*Mobotix...The Future of Surveillance Cameras. For information please contact us: T: 01892 509948 F: 01892 509941 E: sales@mobotix.co.uk*"

The use of the Domain Name linking to the use of the enquiry e-mail address "sales@mobotix.co.uk" is likely to confuse people into thinking that the Domain Name is affiliated, endorsed or controlled by the Complainant. I decide under the test in Nominet's DRS Policy 3(a)(ii) that in the control of the Respondent the Domain Name is an Abusive Registration.

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name identical or similar to the Domain Name and that the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

8. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name be transferred to the Complainant.

Niall Lawless, Nominet Expert

30th December 2011