

**DISPUTE RESOLUTION SERVICE**

**D00010734**

**Decision of Independent Expert**

Maxvue Vision Sdn. Bhd.

and

FABU Ltd

**1. The Parties:**

Complainant: Maxvue Vision Sdn. Bhd.  
614-1,  
JLN HARUAN  
4/8 OAKLAND COMMERCIAL CENTRE  
SEREMBAN  
MALAYSIA  
70300  
Malaysia

Respondent: FABU Ltd  
105 Hoe Street  
Walthamstow  
London  
E17 4SA  
United Kingdom

**2. The Domain Name:**

colourvue.co.uk

**3. Procedural History:**

On 10 January 2012 the dispute was received by Nominet, the Complaint was validated and notification of the Complaint sent to both parties by email and Royal Mail special delivery. On 27 January 2012 a Response reminder was sent by Nominet to the Respondent. On 01 February 2012 Nominet noted that no formal Response had been received and a notification of no response was sent to both parties. With no formal Response received mediation was not attempted and Nominet received payment from the Complainant for a full Expert decision on 03 February 2012.

On 10 February 2012 the Expert, Tim Brown, confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an Expert in DRS 10734 and further confirmed that he knew of no matters which ought to be drawn to the

attention of the parties which might call into question his independence and / or impartiality. Nominet accordingly appointed the Expert with effect from 10 February 2012.

#### **4. Factual Background**

The Complainant is a company incorporated and based in Malaysia concerned with the manufacture, distribution and sale of contact lenses and lens care products. The Complainant markets its ColourVUE contact lenses throughout Europe and various parts of Asia and has done so since 2006-2007.

The Complainant maintains Singapore registered trademark number T0807571C for the term COLOURVUE which has been in force since June 2008 and Community Trade Mark numbers 009447947 and 009700923 for figurative marks which include the term COLOURVUE, both of which have been in force since June 2011

In January 2009 the Complainant appointed the Respondent, FABU Limited, as the sole distributor of its products within the United Kingdom and Ireland. With the Complainant's approval, the Respondent registered the Domain Name with the intention of creating an official website to promote the Complainant's ColourVUE products. The Complainant provided the Respondent with the initial content for the web site to allow for its speedy deployment.

The web site was maintained by the Respondent from January 2009 until August 2011 and included information, news and updates about the Complainant's products. Screenshots dated August 2011 have been exhibited showing a live web site displaying the Complainant's branding, ColourVUE marks and information exclusively about the Complainant's products. The Domain Name was also used on flyers, posters and banners to promote the Complainant's products.

At some point between June and August 2011, the Respondent limited company was sold to a competitor of the Complainant called Edit Wholesale Limited. The Complainant was apparently unaware of the sale until informed of it by the Respondent's managing director by email. The relevant email, dated 23 August 2011, notes that all the Respondent's assets - including "the domains" (which are listed as including "ColourVUE") - were transferred to Edit Wholesale as part of the sale.

On or about 01 September 2011, the Domain Name was redirected to a web site apparently operated by Edit Wholesale located at editwholesale.com. Screenshots of editwholesale.com have been exhibited which show a web site promoting Edit Wholesale's products. Edit Wholesale operates in a comparable field to the Complainant and the website displays similar products to those manufactured by the Complainant.

Notwithstanding the apparent sale of its assets to Edit Wholesale the legal registrant of the Domain Name remains the Respondent.

#### **5. Parties' Contentions**

**Complainant**

**Rights**

The Complainant notes that it is the registrant of a Singapore trade mark for the term COLOURVUE which has been in force since June 2008 and two Community Trade Marks for the same term which have been in force since June 2011. Copies of these marks have been exhibited in the Complaint.

The Complainant asserts that it has manufactured and marketed its ColourVUE products throughout Asia and Europe since 2006-2007. Screenshots of the Complainant's original web site have been exhibited to support this contention.

### **Abusive Registration**

The Complainant says that it was content for the Respondent to register the Domain Name in January 2009 and to operate a web site promoting the Complainant's ColourVUE products.

However it contends that the redirection of the Domain Name to Edit Wholesale's web site further to the sale of the Respondent limited company to Edit Wholesale renders the Domain Name abusive, as it is now misused by a former distributor and competitor to sell competing products.

The Complainant contends that the redirection was carried out on or about 01 September 2011, one month ahead of Halloween, to confuse and divert its UK and overseas customers. The Complainant contends that ColourVUE contact lenses sold extremely well through the 2010 Halloween season, which it asserts made Edit Wholesale unhappy about the Complainant's rise in the UK market.

The Complainant contends that the diversion of the Domain Name caused serious damage to its brand and company image both in the UK and globally. Furthermore it says the redirection of the Domain Name caused it a huge loss of sales in 2011. The Complainant claims stockists were uncertain about its brand and refused to order further stock. The Complainant contends that a number of overseas customers have now switched to Edit Wholesale and it believes this was caused by the redirection of the Domain Name.

### **Respondent**

As noted above, the Respondent has failed to respond to the Complaint or take part in this procedure.

## **6. Discussions and Findings**

Paragraph 2 of the Policy requires that for the Complainant to succeed it must prove to the Expert, on the balance of probabilities, that it both has Rights in respect of a name or 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 as defined in Paragraph 1 of the Policy.

### **Complainant's Rights**

Under paragraph 1 of the Policy, 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 exhibited both a Singaporean registered mark and two Community Trade Marks for the term ColourVUE.

As is customary in DRS proceedings the .co.uk suffix is required only for technical reasons and therefore the Expert finds the Complainant's registered rights are identical to the Domain Name.

The Expert therefore finds that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name.

### **Abusive registration**

Although the Respondent has not responded to the Complaint, the Complainant must still establish on the balance of probabilities that the Domain Name is an Abusive Registration.

As the Respondent has chosen not to respond to this procedure or to attempt to rebut the Complainant's contentions, the Expert is prepared to accept the Complainant's version of events. In essence these are that the Domain Name was registered by the Respondent with the Complainant's consent. The website associated with the Domain Name was then used for a number of years to promote the Complainant's products, again with the Complainant's consent.

However the Complainant says that the consequent sale of the Respondent limited company and its assets - including the Domain Name - to a competitor of the Complainant and the consequent use of the Domain Name to redirect users to that competitor's web site rendered the Domain Name abusive.

Paragraph 1.ii of the Policy defines an Abusive Registration as one which "has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights".

The Expert notes that while a Domain Name may start life as a good faith registration, as is the case here, the use to which it is put after registration may render it Abusive. On this point the Expert has drawn guidance from Paragraph 3.2 of the Expert's Overview<sup>1</sup> which asks:

The circumstances set out in paragraphs 3(a)(i) all concern the registrant's motives at time of registration of the domain name. Can a subsequent intention (i.e. formed after registration of the domain name) ... to unfairly disrupt the Complainant's business constitute an abusive use within the meaning of subparagraph ii of the definition of Abusive Registration in paragraph 1 of the Policy?

The consensus view on this point is noted below:

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). Similarly, a threat to unfairly disrupt the Complainant's business by such a means is also likely to constitute an abusive use of the domain name (cf. the wording "is using or threatening to use the domain name ..." in paragraph 3(a)(ii) of the Policy).

While the Complainant has not submitted actual evidence of disruption to its business, it is clear to the Expert that the diversion of a Domain Name - which is identical to the

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<sup>1</sup> The Experts' verview is a document put together by Nominet' panel of Experts which deals with a range of issues that come up in DRS disputes. It is published on Nominet' website at: [www.nic.uk/digitalAssets/53097\\_DRS\\_Expert\\_Overview.pdf](http://www.nic.uk/digitalAssets/53097_DRS_Expert_Overview.pdf).

Complainant's registered marks - to the web site of a competitor will inevitably and inescapably take unfair advantage of and be unfairly detrimental to a Complainant's Rights.

The Expert finds that this is clearly the case, particularly given the Domain Name previously pointed to a web site that promoted the Complainant's authorised products. The Expert finds that the Domain Name, since its change of use to divert users to the web site at editwholesale.com, is being used in a manner which takes unfair advantage and is unfairly detrimental to the Complainant's Rights and is therefore an Abusive Registration in terms of the Policy.

## **7. Decision**

Having concluded that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert determines that the Domain Name should be transferred to the Complainant.

**Signed Tim Brown**

**Dated 02-March-2012**