

DISPUTE RESOLUTION SERVICE

DRS15070

Decision of Independent Expert

Aldi Stores Limited

and

Wayne Stephenson

1. The Parties:

Lead Complainant: Aldi Stores Limited
Holly Lane
Atherstone
Warwickshire
CV9 2SQ
United Kingdom

Respondent: Wayne Stephenson
49 North End
Osmotherley
Northallerton
North Yorkshire
DL6 3BQ
United Kingdom

2. The Domain Name:

<ilovealdi.co.uk>

3. Procedural History:

The Complaint was filed with Nominet on 18 November 2014. The next day Nominet notified the Respondent by post and by email, and the Response was received the following day. Nominet notified the Complainant that a Reply had to be received on or before 27 November 2014 and the Reply was filed on 21 November 2014. The mediator was appointed on the same day.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 11 December 2014 Nominet informed the Complainant that it had until 29 December 2014 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 24 December 2014 the Complainant paid Nominet the required fee.

On 14 January 2015 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he was independent of each of the parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of a such a nature as to call in to question his independence in the eyes of one or both of the parties.

On 15 January 2015 the Complainant submitted a non-standard submission. On the same day the Expert agreed to view the Complainant's non-standard submission in accordance with paragraph 13(b) of the Procedure.

4. Factual Background

The Complainant is a well-known supermarket in the UK trading under the ALDI mark. The Complainant was incorporated on 25 November 1988. Its official website is available at www.aldi.co.uk.

The Respondent is an individual based in the UK.

The Domain Name was registered on 10 November 2013. It was pointing to a website prominently displaying the ALDI word trade mark and offering for sale a variety of goods, although it appears that it is currently not resolving.

5. Parties' Contentions

The Complaint

The Complainant submits that it and Aldi GmbH & Co. KG ("Aldi GmbH"), a company registered under the laws of Germany (together the "Complainant"), have Rights in the Domain Name for the following reasons:

- The Complainant asserts that Aldi GmbH owns a number of well-known registered trade marks for marks comprising the ALDI name. The Complainant states that details of a number of registrations are submitted with the Complaint. However, the only evidence submitted with the Complaint were screen captures of the website associated with the Domain Name.
- The Complainant states that it is under common control with Aldi GmbH, a licensee under the said trade mark registrations, and a well-known supermarket in the UK that trades under the famous and recognised ALDI name.

- The Complainant further asserts that it was incorporated on 25 November 1988 and that it is the owner of substantial goodwill and reputation in the UK for retailing of groceries, clothing and other household goods. The Complainant further states that its company details are submitted with the Complaint and makes reference to the website at www.aldi.co.uk. However, the Complainant did not submit with its Complaint evidence concerning its company details.

The Complainant claims that the Domain Name is an Abusive Registration for the following reasons:

- the Respondent acquired the Domain Name for the purposes of selling it to the Complainant or to a competitor of the Complainant for valuable consideration in excess of out-of-pocket expenses;
- the Respondent acquired the Domain Name for the purpose of unfairly disrupting the business of the Complainant;
- people are likely to be confused into believing that the Domain Name is registered to, and the website hosted at it is, operated or authorised by or otherwise connected with the Complainant; and / or
- the website presently hosted at the Domain Name takes unfair advantage of and/or is detrimental to the reputation of the Complainant's ALDI trade marks;

In support of its claim, the Complainant submits the following:

- The Complainant asserts that the Complainant's Rights predate the Respondent's registration of the Domain Name;
- The Complainant states that it is concerned that the Domain Name is currently being used in conjunction with the unauthorised marketing, distribution or sale of goods under the ALDI trade mark;
- The Complainant asserts that the Domain Name incorporates the Complainant's registered trade mark ALDI along with the words "I" and "LOVE" and an inference is drawn that any website hosted at the Domain Name will be for online shopping at Aldi. The Complainant asserts that the Domain Name is likely to be taken by most people as a reference to the Complainant's business and that, in consequence, most people navigating to the Domain Name will be expecting to reach a website of the Complainant;
- The Complainant further states that the Domain Name presently hosts a website which purports to be an Aldi online store, offering for sale various grocery and similar goods. In support of its claim, the Complainant has submitted with its Complaint screen captures of the website associated with the Domain Name. The Complainant asserts that the website associated with the Domain Name makes unauthorised use of the ALDI word mark and a version of the ALDI logo mark. The Complainant further submits that it is not clear whether the website is presently operational but that, nevertheless, the Complainant is concerned that consumers who are looking for an online Aldi store, may be misled into thinking that the website associated with the Domain Name is operated or authorised by, or is otherwise connected with the Complainant. In addition, the Complainant asserts that, in view of the poor quality of that website, the Complainant is concerned that it causes detriment to the reputation of the Aldi brand and to the Complainant's registered trade mark rights in the ALDI name;

- The Complainant further submits that the Respondent has no obvious justification for having adopted the ALDI mark in the Domain Name other than to sell the Domain Name to the Complainant or to a competitor of the Complainant, as the name ALDI is extremely well known and valuable;
- The Complainant further argues that the Respondent is threatening to disrupt the business of the Complainant by, inter alia, (i) preventing the Complainant from reflecting the ALDI trade mark in a corresponding domain name and (ii) interfering with the Complainant's activities online via the website at www.aldi.co.uk.

The Response

The Respondent supplied a brief Response, which is reproduced as follows:

"I registered the domain name because I genuinely love shopping at ALDI. It's purpose is to let fellow ALDI lovers make reviews about ALDI products. This is in no way an abusive registration. In fact quite the opposite. I could understand if I had registered www.ihatealdi.co.uk. I am really confused. But I am also scared. I don't want to end up in court because I love ALDI :(".

The Complainant's Reply

The Complainant replied as follows:

- The Complainant submits that it would like to make clear to the Respondent that these are not legal proceedings, and that no court proceedings are threatened or contemplated at this time in respect of the website hosted at the Domain Name, although the Complainant expressly reserves its rights in that regard;
- The Complainant asserts that the Respondent's Response does not address the arguments raised in the Complaint, which are all predicated upon valid grounds for complaint under the Dispute Resolution Policy.
- The Complainant also submits that it notes the Respondent's purported intentions. However, it points out that the absence of malicious intent is not a bar to a finding that, in all the circumstances, a registration is abusive under the DRS Policy and Rules;
- The Complainant further submits that the Respondent's explanation does not explain: a) why the website is dressed as, and purports to be, an online store; b) why there is no part of the website that explains that it is intended to be for the purpose which the Respondent describes; and c) why the website contains statements such as "See our Super 6" (emphasis added), a reference to the Complainant's regular Super 6 offers.

The Complainant's 13(b) non-standard submission

The Complainant submitted that on 13 January 2015 it became aware, via an Expert Decision in another DRS matter, that it accidentally omitted to include details of its trade mark registrations and company details with its Complaint. The Complainant thus provided along with its Explanatory Paragraph evidence consisting of its trade mark registrations and company details.

6. Discussions and Findings

General

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Domain Name the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

- "(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."*

Complainant's Rights

The Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise*".

The Expert is prepared to accept, based on the evidence presented, that the Complainant has Rights in respect of the name ALDI, mainly as a result of the trade marks referred to in the Complainant's non-standard submission.

Furthermore, the Policy provides that the name or mark in which the Complainant has Rights (ALDI) must be identical or similar to the disputed Domain Name (<ilovealdi.co.uk>).

It is accepted practice under the Policy to discount the .CO.UK suffix, and so the only difference between the Complainant's ALDI trade mark and the Domain Name is the addition of the generic terms "i" and "love". The Expert is of the opinion that the addition of this laudatory phrase is insufficient to diminish the similarity between the Complainant's trade mark and the Domain Name.

The Expert thus finds that paragraph 2(a)(i) of the Policy is satisfied and that the Complainant has Rights in respect of a mark which is similar to the Domain Name.

Abusive Registration

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

- "(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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

A complainant must prove one or both of these on the balance of probabilities. In the present case, the Expert finds that the Domain Name was both registered and used in a manner which takes unfair advantage of, or is unfairly detrimental to, the Complainant's Rights.

Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence of Abusive Registration. The Complainant relies on the following:

"i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily

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;

(...)

C. for the purpose of unfairly disrupting the business of the Complainant;

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;"

The Expert is persuaded that, based on the Complainant's renown in the UK, it is clear that the Respondent, who is also based in the UK, would have been aware of the Complainant's Rights at the time of registration of the Domain Name in 2013. The laudatory nature of the Domain Name itself coupled with the use to which the Domain Name has been put leaves no doubt as to this fact. Thus the Expert is convinced that the Respondent *registered* the Domain Name in full knowledge of the Complainant's Rights with the aim of taking unfair advantage of the Complainant's Rights, in accordance with paragraph 1(i) of the Policy (see *Verbatim Ltd v. Michael Toth*, DRS 4331 (*verbatim.co.uk*)).

The Expert is not certain, however, that paragraphs 3(a)(i)(A) and 3(a)(C) of the Policy invoked by the Complainant are applicable in this case because the Policy states that those reasons must be the Respondent's *primary* motivation for registering the Domain Name. In the Expert's opinion those were not the main reasons why the Respondent registered the Domain Name (although it could have resulted in an unfair disruption of the Complainant's business or in an offer to sell the Domain Name to the Complainant or one of its competitors). Rather, it seems more likely that the Respondent's *primary* motivation for registering the Domain Name was simply to profit from the Complainant's Rights for his own financial gain (by setting up a commercial website that offers identical or similar services to those offered by the Complainant – ie. an online supermarket).

The Expert is of the view that paragraph 3(a)(ii) of the Policy invoked by the Complainant perfectly describes the Respondent's behaviour in that he has used the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that it was registered to, operated or authorised by, or otherwise connected with the Complainant. The Expert is of the opinion that the fact that the website associated with the Domain Name prominently displayed the Complainant's trade mark and was being used for an online supermarket, would have most likely misled internet users into thinking that the Respondent's website was operated or authorised by the Complainant. Thus the Expert finds that the Domain Name has been *used* in a manner which has taken unfair advantage of or, has been unfairly detrimental to, the Complainant's Rights, in accordance with paragraph 1(ii) of the Policy.

Finally, paragraph 4 of the Policy sets out a non-exhaustive list of factors which may be evidence of non-abuse, but the Expert is of the opinion that none of them are of any assistance to the Respondent in the present case. The Respondent claims to have

registered the Domain Name because he "genuinely loves shopping at ALDI". However, the evidence submitted by the Complainant showing that the Respondent was using the Domain Name for an online supermarket does not support the Respondent's claim but rather demonstrates that the Respondent was simply seeking to take unfair advantage of the Complainant's Rights.

In summary, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in a name which is similar to the disputed Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The disputed Domain Name should therefore be transferred to the Complainant.

Signed: David Taylor

Dated: 31 January 2015