

DISPUTE RESOLUTION SERVICE

D00018385

Decision of Independent Expert

VKR Holding A/S

and

Mr Steve Barrett

1. The Parties:

Lead Complainant: VKR Holding A/S
Breeltevej 18
2970 Horsholm
Denmark

Respondent: Mr Steve Barrett
62 The Ridgeway
Croydon
Surrey
CR0 4AE
United Kingdom

2. The Domain Name(s):

veluxrooflight.uk

3. Procedural History:

12 January 2017 16:08 Dispute received
16 January 2017 13:07 Complaint validated
16 January 2017 13:12 Notification of complaint sent to parties
02 February 2017 01:30 Response reminder sent
03 February 2017 16:00 Response received
03 February 2017 16:01 Notification of response sent to parties
06 February 2017 14:11 Reply received
06 February 2017 14:12 Notification of reply sent to parties

09 February 2017 09:22 Mediator appointed
 13 February 2017 12:31 Mediation started
 20 February 2017 15:26 Mediation failed
 20 February 2017 15:26 Close of mediation documents sent
 01 March 2017 13:02 Expert decision payment received

The Expert has confirmed to Nominet that he is independent of each of the parties and that there are no circumstances that would give rise to justifiable doubt as to his impartiality or independence.

As the Complaint was filed after 1 October 2016 it falls to be determined under Version 4 of the Dispute Resolution Service Policy (“the Policy”).

4. Factual Background

The Complainant is a company incorporated under the laws of Denmark and is a worldwide manufacturer of roof windows and accessories. The Complainant owns a portfolio of registered trademarks for the mark VELUX and claims common law rights in that mark through use of the mark over an extended period of time.

The Domain Name was registered by the Respondent on 10 October 2015. The Domain Name has been used as a parking page and contains a number of sponsored links to various web sites.


5. Parties’ Contentions

Complaint

The Complainant seeks to rely upon both registered and unregistered rights in the mark VELUX, which it says is similar to the Domain Name.

Registered rights

The Complainant relies upon its worldwide portfolio of 450 registered trademarks that include or incorporate the word VELUX, some of which are said to be enforceable under English law. In particular, it refers to the following trademarks:

Trademark text/image	Type/number	Classes	Registered since
VELUX	UK 691115	6, 19	28 July 1950
VELUX	EU TM 955609	6, 7, 9, 11	31 March 2000
VELUX	EU TM 651869	6, 9, 16, 19, 20, 22, 24, 37, 41, 42	16 July 2004
	EU TM 5260229	19, 20, 24, 37	12 June 2007

Unregistered rights

The Complainant claims to have acquired an extensive and valuable reputation and goodwill in the mark VELUX. The Complainant says that, as a result of the scale and extent of the advertising that it has carried out, the Complainant's mark VELUX has become a household name. It claims that the mark VELUX is recognised by a substantial proportion of the population of the United Kingdom as indicating the Complainant's companies or goods and services.

The Complaint contains the following assertions in support of the claim to common law rights in the mark VELUX:

- The Complainant's business has grown consistently and substantially since 1941 to become a well-known brand worldwide.
- The Complainant has a presence in 40 countries throughout the world and sells its products in approximately 90 countries.
- The Complainant's products have been advertised and sold in the United Kingdom since 1954 on an increasingly extensive scale.
- The Complainant spends approximately €8 million in marketing each year.
- The VELUX Group spent over €4 million in 2016 on the purchase of AdWords on the Google search engine.
- The Complainant's domain name <velux.co.uk> attracted an average of 2,800 hits per day in 2016. Its domain name <velux.com> attracted an average of 1,000 hits per day in the same year.
- The Complainant promotes its name and reputation through sponsorship of events, including being the title sponsor of the premium club handball tournament in Europe, the VELUX EHF Champions League.
- The Complainant also promotes its name and reputation through sponsorship of the VELUX 5 Oceans Race, a single-handed yacht race around the world.
- The Complainant operates the national VELUX Certified Installer scheme, whereby businesses or individual traders may carry out various roofing services under and by reference to the Complainant's trademarks.
- The Complainant is the owner of various domain names which incorporate the VELUX trademark.

The resulting reputation and goodwill is said to extend beyond the range of goods and services in which the Complainant has used or permitted the use of its mark and encompasses any goods and/or services which might reasonably be expected to be produced or supplied by the Complainant or its authorised users.

Similarity

The Complainant says that the mark VELUX and the Domain Name are similar because the mark VELUX is the first and dominant element of the Domain Name and the second element “rooflight” is a generic term.

Abusive Registration

Knowledge of the Complainant

The Complainant says that the Domain Name was registered by the Respondent on 10 October 2015 without the knowledge or consent of the Complainant. The Complainant points out that the Respondent is not authorised by or in any way connected to the Complainant.

The Complainant states that it is highly likely that the Respondent was aware of the Complainant’s rights at the time the Domain Name was registered. The Complainant later expresses its case on the basis that it is inconceivable that the Respondent did not have prior knowledge of the Complainant’s marks.

The Complainant seeks to draw an inference of prior knowledge on the grounds that:

- the word VELUX is a made up word invented by the Complainant and is therefore highly distinctive; and
- the Complainant has acquired a worldwide reputation in respect of its business under the VELUX name.

Sale of traffic

The Complainant says that the Domain Name is being used by the Respondent as a holding page to display sponsored links to a range of online businesses, including that of the Complainant, third parties offering the Complainant’s products, and third parties offering competing products.

The Complainant has provided the following examples of links to web sites that it says offer competing products:

- The Domain Name displays links to the web site of Ultraframe (UK) Limited, which manufactures and supplies roof windows.
- The Domain Name displays a link to the web site at <sterlingbuild.co.uk> which offers the Complainant’s goods for sale alongside third party brands such as FAKRO, FENSTRO and RoofLITE.

The Complainant refers to paragraph 8.5 of the Policy which states:

“Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:

8.5.1 the nature of the Domain Name;

8.5.2 the nature of the advertising links on any parking page associated with the Domain Name; and

8.5.3 that the use of the Domain Name is ultimately the Respondent's responsibility."

The Complainant contends that the Respondent is taking unfair advantage of the Complainant's rights by gaining click-through revenue from the Domain Name. In addition, the Complainant contends that by using its trademark in this way the Respondent is seeking to capture a proportion of Internet traffic which otherwise would have reached the Complainant's own web sites. It is said that this will cause the Complainant to lose revenue and, as such, is unfairly detrimental to its rights.

Likelihood of confusion

The Complainant claims that the Domain Name amounts to an Abusive Registration as people or businesses are likely to be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant cites paragraph 5.1.2 of the Policy in this regard.

The Complainant argues that such confusion is likely; firstly, because of the choice of words that make up the Domain Name itself and, secondly, because of the use of the Domain Name.

The Complainant points out that its trademark is positioned as the first element in the Domain Name and that the second element "rooflight" is generic and does not distinguish the Respondent from the Complainant. The Complainant says that the word "rooflight" is common in the market in which the Complainant operates, and is purely descriptive.

The Complainant also argues that the existence of a link to the Complainant's own web site, together with the use of the Complainant's trademark within the Domain Name itself, is likely to cause people or businesses to wrongly believe that the Domain Name is connected with the Complainant.

The Complainant points out that there is nothing to confirm that the Domain Name is operated by the Respondent and is not operated by, authorised by, or otherwise connected to the Complainant.

Disclaimer

The Complainant does note that the web pages displayed at the Domain Name contain the following message in small font at the bottom of each page:

"The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain owner maintain any relationship

with the advertisers. In case of trademark issues please contact the domain owner directly (contact information can be found in whois).”

The Complainant argues that this is not an effective disclaimer in that it does not work to eliminate any risk of confusion regarding the links displayed on the parking page at the Domain Name.

The Complainant also refers to paragraph 8.5.3 of the Policy which states that the use of the Domain Name is the responsibility of the Respondent and such responsibility cannot be avoided simply by including a brief disclaimer.

Correspondence with the Respondent

The Complainant says that it was made aware in January 2016 that the Respondent had registered and was using the domain name <veluxrooflight.com>, which also pointed to a parking page. The Complainant says it contacted the Respondent and sought removal of the parking page and transfer of that particular domain name. The Complainant says that the Respondent removed the parking page visible at that domain name.

The Complainant says that it became aware of the Domain Name in October 2016. It was also registered to the Respondent and pointing to a parking page. The Complainant says that it attempted to contact the Respondent but received no response.

Remedy sought

The Complainant seeks a transfer of the Domain Name.

Response

The Respondent lodged a short Response in the following terms:

“Hi there.
I did respond on 16th Jan.
I explained that I do not use the domain and never intend to. I also don't know how take down a domain which is not in use?
Please explain how I refrain from using something I'm not using???
Regards,
Steve Barrett”

Reply

The Complainant says that it is not aware of any response submitted by the Respondent on 16 January 2017. It says it did not receive any notification from Nominet regarding such a response and it also checked the Nominet online services page and there is no such response.

The Complainant does not accept that the Respondent is not using the Domain Name and repeats the assertion, in the Complaint, that the Domain Name is being used by

the Respondent to derive click-through revenue, which amounts to an Abusive Registration.

The Complainant rejects the Respondent's assertion that he does not know how to "take down" the Domain Name. The Complainant has produced an email exchange in relation to the domain name <veluxrooflight.com> in which the Respondent confirmed that he had left instructions with his hosting company "to remove it."

6. Discussions and Findings

Under paragraph 2 of the Policy a Respondent must submit to proceedings under the DRS if a Complainant proves to the Expert that the following two elements are present on the balance of probabilities:

"The Complainant 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."

Under paragraph 1 of the Policy the term 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."

Under paragraph 1 of the Policy the term Abusive Registration means a Domain Name which either:

"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

is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 5 of the Policy. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is set out paragraph 8 of the Policy. The factors listed in paragraphs 5 and 8 are however only a guide and the only limiting factor is the definition of Abusive Registration in paragraph 1 of the Policy.

Rights

The Complainant has produced compelling evidence that it has enforceable rights in the mark VELUX by reason of:

- its extensive worldwide portfolio of trademark registrations; and

- the goodwill and reputation it has acquired through extensive use of the mark in connection with the sale of roof windows and accessories, over a period of 70 years.

The Complainant has produced in evidence a list of its registered trademarks which reveals that its portfolio extends to 461 separate trademark registrations. The portfolio includes the UK trademark 691115 which was registered as of 28 July 1950 and the EU trademark 651869 which was registered as of 16 July 2004. Evidence of both of those trademarks has been produced by the Complainant.

In relation to its claim to have the benefit of unregistered rights in the mark VELUX, the Complainant has produced evidence that demonstrates the existence of such rights. The evidence shows that the Complainant has made extensive use of that mark and that the mark is recognised by the purchasing trade and public as indicating the goods of the Complainant. The evidence includes screen shots from its web sites as well as details of its advertising spend and sponsorship activities.

There is no doubt on the evidence that the Complainant has enforceable rights in the mark VELUX on the basis that the mark has become highly distinctive of the Complainant's roof window products and accessories.

Disregarding the .uk suffix, the only difference between the Complainant's mark and the Domain Name is the addition of the appendage "rooflight" in the Domain Name.

Under the Policy, there is no need for the Complainant to establish that the Domain Name is confusingly similar to the trademark. It just needs to establish that it is similar. As the Experts' Overview points out:

"The wording of the Policy is broader and less restrictive [than under the UDRP], which matches the reality that the first hurdle (i.e. proving the existence of rights in a relevant name or mark) is intended to be a relatively low-level test. Issues relating to confusion are best addressed under the second hurdle. The objective behind the first hurdle is simply to demonstrate a bona fide basis for making the complaint."

The addition of the descriptive word "rooflight", which is relevant to the Complainant's field of activity, does not detract from the obvious similarity with the Complainant's trademark VELUX. The Complainant has satisfied the Rights test in relation to the Domain Name.

Abusive Registration

A Domain Name may be found to be abusive based on the motivation of the Respondent at the date of registration and/or the use to which the Domain Name has been put.

Motivation for registration of the Domain Name

There is no direct evidence that the Respondent was aware of the Complainant's VELUX mark when he registered the Domain Name on 10 October 2015. The Complainant argues that it is highly likely that the Respondent had prior knowledge of the Complainant's mark. Indeed, later in the Complaint, the Complainant puts this point in more forthright terms by asserting that it is inconceivable that the Respondent did not have the Complainant in mind when he chose to register the word VELUX in the Domain Name.

Having considered the evidence, the Expert accepts the inference that that the Respondent had prior knowledge of the Complainant when he registered the Domain Name. The Expert makes a finding that the Respondent had the Complainant firmly in mind when he registered the Domain Name. The Expert has taken into account the following factors in arriving at this finding:

- VELUX is a made-up word. It is therefore a word of very high inherent distinctiveness. It cannot sensible refer to anyone other than the Complainant as it has no other meaning.
- The mark VELUX has been used by the Complainant extensively in connection with the promotion and sale of its roof window products for over 70 years.
- The presence of the additional word "rooflight" in the Domain Name lends support to the view that the Respondent had the Complainant in mind given that the Complainant's primary product range is roof windows.
- The Respondent registered another domain name <veluxrooflight.com> which incorporates the mark VELUX.
- In the Response, the Respondent has not challenged the Complainant's claim to rights in the mark VELUX.
- The Respondent has also not challenged the Complainant's assertion that the Respondent had prior knowledge of the Complainant at the time that he registered the Domain Name.

All of the available material in this case supports the inference that the Respondent had the Complainant in mind when he registered the Domain Name. There is no case advanced by the Respondent, or that emerges from the evidence, that the Respondent came up with the Domain Name for reasons that are unconnected to the Complainant's mark.

Use of the Domain Name

There is a dispute about whether the Domain Name has been used. The Respondent's case is that the Domain Name has not been used. The Complainant's case is that the Domain Name is being used as a holding page to display sponsored links to a range of

online businesses, including that of the Complainant, third parties offering the Complainant's products, and third parties offering competing products.

The Complainant cites two specific examples of links to web sites offering competing products:

- The Domain Name displays links to the website of Ultraframe (UK) Limited, which manufactures and supplies roof windows.
- The Domain Name displays links to the web site at <sterlingbuild.co.uk>, which offers the Complainant's products for sale alongside third party brands such as FAKRO, FENSTRO and RoofLITE.

The Complainant has produced evidence, in the form of screen shots, which shows that the Domain Name links to a parking page. The parking page contains a number of sponsored links which take the form of phrases such as "Velux Roof", "Flat Roof Skylight" and "Velux Window Blinds." Most of the phrases which form the links are relevant to the Complainant's field of activity. The Complainant has produced further screen shots which support its case that the links connect to web sites that promote the products of the Complainant as well as competing products.

The Expert has used the link to the Domain Name provided by Nominet on its online service. By clicking on the sponsored links on the parking page the Expert was taken to various web sites offering the Complainant's products and those of other companies. The evidence is consistent with the Complainant's case and wholly inconsistent with the Respondent's case on use. The Expert finds that the sponsored links connect to web sites that offer competing products to those offered by the Complainant. The Expert also finds that the Respondent's motivation was to derive click-through revenue through the use of sponsored links.

Likelihood of confusion

The Complainant contends that the use of the Domain Name falls within paragraph 5.1.2 of the Policy, which reads as follows:

"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 Complainant points to the following factors which it says create a likelihood of confusion:

- the Domain Name contains the highly distinctive word VELUX, in which it has acquired rights, together with a descriptive word "rooflight;" and
- there is a link on the parking page to the Complainant's own web site.

The Complainant also points out that some of the links on the parking page connect to web sites offering competing products. The Complainant argues that the consequence

of such confusion is that Internet users looking for the Complainant's products may be diverted to the web sites of third parties, and obtain products from those businesses rather than from the Complainant.

The Experts' Overview considers what is meant by confusing use and includes the following passages:

“The ‘confusion’ referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”?”

“Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privilege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decisions in DRS 00248 (seiko-shop.co.uk) and DRS 07991 (toshiba-laptop-battery.co.uk).”

“In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.”

In this case, the appendage added by the Respondent to the Complainant's trademark is the word “rooflight.” This appendage is a word of low inherent distinctiveness and it is appropriate to the Complainant's field of activity. It therefore does very little, if anything, to dispel any potential confusion with the Complainant.

The Expert accepts that an Internet user is likely to be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. This finding is based both on the fact that:

- the choice of words used in the Domain Name itself gives rise to a likelihood of confusion; and
- the Domain Name has been used, in part, to link to the Complainant's web site.

The presence of the disclaimer, details of which are at pages 5 and 6 above, is not enough to avoid a finding of potential confusion under paragraph 5.1.2 of the Policy. Even if it is apparent to the Internet visitor to the web site, having read that

disclaimer, that the site is not connected with the Complainant, the visitor has still been deceived.

The fact that the Respondent has used the Domain Name for a parking page which consists of sponsored links to web sites which offer, in addition to the Complainant's products, products competing with the Complainant's products is also indicative of abusive intent.

The Respondent's case

The Complainant has made out a strong prima facie case of abuse. The Expert needs to consider whether the Respondent has provided an answer to that case which would support a finding that this is not, in fact, an Abusive Registration. For the reasons set out below, the Expert has concluded that the Response - as an answer to a strong case of abuse - is wholly inadequate.

The Respondent says that he responded on 16 January and, in that response, he explained that he does not use the Domain Name and he does not know how to "take down" a domain name that is not in use. The Respondent has not produced a copy of the 16 January response and the Complainant says that it did not receive it.

The Expert has already addressed and rejected the Respondent's case that the Domain Name has not been used at all. The Domain Name has been used as a parking page to display a number of sponsored listings with links to various web sites offering the Complainant's products as well competing products.

The Respondent has attempted to distance himself from the use of the Domain Name by stating that he has not used the Domain Name. This is not an effective answer to a case of abusive use. The Respondent is the registrant and, as paragraph 8.5.3 of the Policy establishes, the use of the Domain Name is ultimately the Respondent's responsibility.

Conclusion

Taking the evidence in the round, the Expert makes a finding that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert has arrived at that conclusion having regard to the following findings:

- The Respondent was aware of the Complainant, and had it firmly in mind, when he registered the Domain Name – see the finding at page 9 above.
- The Domain Name has been used as a parking page to derive click-through revenue – see the finding at page 10 above.
- The parking page at the Domain Name contains links to web sites offering products that compete with the Complainant's products – see the finding at page 10 above.
- There is a likelihood of confusion and the disclaimer is not effective to dispel any such confusion – see the finding at page 11 above.

- The Respondent's answer to the case of abuse is wholly inadequate. He has failed to make out any of the factors in paragraph 8 of the Policy. He has suggested that he bears no responsibility for the use of the Domain Name. However, as registrant he bears ultimate responsibility for that use.

The clear picture that emerges is that the Respondent deliberately sought to misuse the goodwill attaching to the Complainant's mark in order to derive a financial benefit for himself. That takes unfair advantage of the Complainant's rights and amounts to an Abusive Registration.

7. Decision

The Complainant has established that it has rights in respect of a mark which is similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that the Domain Name be transferred to the Complainant.

Signed
Andrew Clinton

Dated 19 April 2017