

DISPUTE RESOLUTION SERVICE

D00018547

Decision of Independent Expert

Premier Plc

and

Mr Denys Ostashko

1. The Parties:

Complainant: Premier Plc
Premier House, Braintree Road
South Ruislip
Middlesex
HA4 0EJ
United Kingdom

Respondent: Mr Denys Ostashko
Apt 433, Chynoweth House
Trevisson Park
Truro
TR4 8UN
United Kingdom

2. The Domain Name:

premier.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

15 February 2017 16:27 Dispute received
17 February 2017 14:12 Complaint validated
17 February 2017 14:19 Notification of complaint sent to parties
08 March 2017 10:32 Response received

08 March 2017 10:33 Notification of response sent to parties
13 March 2017 01:30 Reply reminder sent
14 March 2017 17:48 Reply received
14 March 2017 17:48 Notification of reply sent to parties
23 March 2017 13:00 Mediator appointed
23 March 2017 14:27 Mediation started
30 March 2017 16:22 Mediation failed
30 March 2017 16:23 Close of mediation documents sent
12 April 2017 11:21 Expert decision payment received
12 April 2017 13:31 Sent expert decision pack, expert appointment and conflict check documents

4. Factual Background

The Complainant is a homeware retailer and the owner of the registered trade mark PREMIER in the UK for, inter alia, Christmas decorations, filed in 1999 and registered in 2001.

The Domain Name, registered in 2006, has been offered for sale generally and to the Complainant for 38,500 British Pounds (on a holding page run by the Respondent at <http://buydomainnames.co.uk/domain/premier.co.uk>, without any commercial links) and does not appear to have been used otherwise.

5. Parties' Contentions

The Complainant's contentions can be summarized as follows:

The Complainant is a well known retailer of homeware and is the owner of UK trade mark registration PREMIER which has been used for nearly 30 years.

The Domain Name was registered for the purposes of sale at a price in excess of out of pocket costs and the Respondent is engaged in a pattern of registrations which correspond to well known marks or names in which the Respondent has no apparent rights.

The Complainant was approached by a domain name broker on October 3, 2016 offering to sell the Domain Name to the Complainant for 38,500 UK pounds. A cease and desist letter was sent to the Respondent which received no answer. In a follow up the Complainant offered to purchase the Domain Name for a reasonable sum and subsequently offered 4,500 UK pounds. This offer was turned down by the Respondent who claimed he had a 25,000 UK pounds offer to purchase it anytime.

The Respondent was involved in three past DRS disputes where the registrations in question were found to be Abusive Registrations (over two years ago so no presumption of Abusive Registration in the present case but still relevant). In DRS 4620 the Complainant identified the Respondent had registered 231 names and of those at least 12 consisted of registered trade marks of third parties such as kinder.co.uk, bbcradio.co.uk, aolsearch.co.uk and fcukonline.co.uk. In that decision it was found that this constituted a pattern of registering well known marks or trade marks in which the Respondent had no apparent rights. The Respondent owns Gstar.co.uk, jager.co.uk, lemmings.co.uk and kimball.co.uk which correspond to well known registered marks.

The registration of the Domain Name and offer for sale for 38,500 UK pounds is part of that pattern of registrations and the Domain Name was registered because of the status of PREMIER as a well known name and mark with the purpose of selling or transferring it to a party with an interest in the mark.

The Respondent's contentions can be summarised as follows:

The Complainant has no right to the Domain Name.

The Complainant's PREMIER trade mark registration covers Christmas decorations and similar goods. The Complainant is not known as 'Premier' but is using Premier Decorations Ltd as reflected in the company's logo and trading name. A number of other trade marks for PREMIER held by the Complainant have expired or are listed as dead. UK trade mark searches return over 107 trademarks for exact match 'PREMIER'. All of those peacefully coexist with each other as they cover different business classes. None of those rights holders would automatically be able to extend their rights to more generic use cases and/or obtain a pervasive right to the Domain Name.

The Domain Name was registered as a generic dictionary word without the Complainant in mind. The Complainant is a niche wholesale business and will not be recognised in the mind of a general consumer as 'Premier',; such a consumer will not expect to see the Complainant at premier.co.uk. The latest company press release for the Complainant is February 2015 and many of its trade marks have expired so it seems to be slowing down. The Domain Name is being used without being abusive or detrimental to anyone. Offering domain names for sale is not per se abusive nor is holding domain names for profit. The Respondent was never aware of Complainant's existence and there are hundreds of suitors to sell this domain name to and the Respondent has received many strong offers in the past without even marketing the Domain Name. The Complainant was never the subject of any clearly directed or focused sale efforts coming from Respondent or representatives of the Respondent. The for sale e mail offer was sent to many other potential suitors.

A domain broker contacted the Respondent who agreed to let him market some of the Respondent's generic domains. The broker confirmed he did not single out the Complainant but sent the offer to at least thirteen businesses using 'premier'. Both the Respondent and the broker acted in good faith and never knew about the Complainant before including him in the circular e mail. The Complaint is filed in bad faith and constitutes an attempt of reverse domain name hijacking.

The Complainant was never interested in the Domain Name and never contacted the Respondent expressing any purchase interest during 11 years that the Domain Name has been owned by the Respondent. Domain Broker only informed the Complainant the Domain Name was available for sale for 38,500 UK pounds, the amount already displayed on the web site attached to the Domain Name for several years, so this was not singling out the Complainant in any way.

The Complainant's offer of a relatively substantial offer of 4,500 UK pounds clearly indicates the Complainant does not believe the registration is abusive.

The Complainant has taken a list of domain names from a 2007 case and suggests the Domain Name is part of a pattern when clearly it is not. None of the mentioned domain names belong to the Respondent and all assumptions from past DRS cases should have expired long ago. Gstar is an astronomy term, Jager and Kimball are surnames and lemmings are small rodents.

In any case the Domain Name can never form part of any pattern due to its generic meaning. Anyone who tries to bring a case purely on sale of a generic domain name is a reverse domain name hijacker.

The DRS cases cited against the Respondent date back 10 years. No cases older than 3 years can be reviewed to create any bias towards deciding current cases.

The Complainant's Reply can be summarized as follows:

The Complainant denies Domain Name Hijacking.

The Complainant offered 4,500 British pounds which does not indicate that the Complainant did not regard the registration as abusive, but merely that it made the offer with a view of saving the costs of a Nominet Complaint.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy). Rights is defined as 'rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'.

Complainant's Rights

The Complainant is the Owner of a UK trade mark registration for PREMIER for, inter alia, Christmas Decorations.

.co.uk is not taken into account for the purposes of a comparison between the Complainant's mark and the Domain Name under the Policy.

Accordingly the Expert finds that Complainant has Rights in respect of the PREMIER mark which is similar to the Domain Name for the purposes of the Policy. As such, the Complainant has satisfied the first limb of the Policy.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "Abusive Registration" as:-

"a Domain Name which either:

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. 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. The Complainant does not assert that the Respondent has registered the Domain Name to block or disrupt the Complainant, that the Respondent has given false contact details or has registered the Domain Name on behalf of the Complainant or is threatening to or has caused confusion on the Internet.

The Complainant alleges that the Domain Name is an abusive registration because:

- i) It was primarily registered for the purposes of selling, renting or otherwise transferring it to the Complainant or one of its competitors for valuable consideration in excess of the Registrant's documented out of pocket costs of registration; and
- ii) The Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (whether under .UK or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights and the Domain Name is part of that pattern.

The new Section 5.1.6 states that a Domain Name can be an Abusive Registration if it is 'an exact match for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.'

The Respondent is in the business of selling Domain Names. However, Paragraph 8.4 of the Policy states that 'Trading in domain names for profit and holding a large portfolio of domain names are of themselves lawful activities.' After a review of all the evidence, the Complainant has not persuaded the Expert that eleven years ago, when the Domain Name was registered, it was primarily registered for sale to the Complainant or one of its competitors for a profit. The Expert agrees with the Respondent that 'Premier' is a common descriptive term and that the Complainant's reputation for Christmas decorations is not so huge in the UK that on the balance of probabilities anyone registering the Domain Name would believe that the Complainant would be the main party interested in operating under that name. The Respondent says that a domain name broker whose services it retained offered the Domain Name in 2016, ten years after it was registered, to at least thirteen businesses with 'Premier' in the names and to the Complainant. It appears the domain name broker offered the Domain Name to the most likely businesses interested in the name, but this does not show that when the name was registered the Respondent had the Complainant or its competitors in mind. The Expert believes the Respondent when it says that when it registered the name it was not specifically targeting the Complainant or its competitors and there is no evidence to the contrary.

The Complainant has produced some evidence that the Respondent has engaged in a pattern of registrations in the past that correspond to well known trade marks and that the Respondent has some DRS decisions against it some time ago, however it has not brought sufficient evidence on the balance of probabilities that premier.co.uk (with its general

meaning that would be valuable to many businesses) is part of that pattern. The Respondent also owns many generic meaning domain names. Trading for profit in a generic meaning domain name without specifically targeting a trade mark owner, in particular where many people might be legitimately interested in use of a particular domain name and that domain name or the circumstances of its use would not call to mind any one business or business group in the minds of consumers, is not in the opinion of the expert an Abusive Registration. In such circumstances there would be a reasonable justification for the holding of such a generic meaning domain name even if it were for trade and such a domain name could be offered for sale generally without fear of falling foul of the Policy until such time as evidence arose that it was being used in a manner which was unfair or detrimental to a Complainant. The Policy makes it clear that a mere offer for sale of a generic meaning domain name where no abusive use is being made of it is permissible.

Accordingly, the Expert is of the opinion that the Respondent has not taken unfair advantage of or caused detriment to the Complainant's Rights under the Policy. Accordingly, the Expert finds that the Domain Name is not an Abusive Registration within the definition of that term in paragraph 1 of the Policy.

However, the Complainant would not have known that the Domain Name was being offered widely to businesses using 'premier' and, as such, may have reasonably believed it was being targeted specifically, when it was not. As such the Expert declines to make a finding of Reverse Domain Name Hijacking.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in respect of a registered mark which is similar to the Domain Name, but that the Domain Name, in the hands of the Respondent, is not an Abusive Registration, the Expert directs that the Domain Name, premier.co.uk remain with the Respondent.

Signed Dawn Osborne

Dated 8 May 2017