

DISPUTE RESOLUTION SERVICE

D00019459

Decision of Independent Expert

Casa Pronat S.L.

and

Star Corp United Kingdom Ltd

1. The Parties:

Complainant: Casa Pronat S.L.
Calle Gregal, 1
Riudarenes
Girona
17421
Spain

Respondent: Star Corp United Kingdom Ltd
54 West View
Chesham
HP5 3BY
United Kingdom

2. The Domain Name(s):

fisiocrem.co.uk (“the Domain Name”)

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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

The procedural history is as follows:

26 October 2017 16:39 Dispute received
30 October 2017 15:08 Complaint validated
30 October 2017 15:14 Notification of complaint sent to parties
16 November 2017 01:30 Response reminder sent
21 November 2017 09:16 No Response Received
21 November 2017 09:16 Notification of no response sent to parties
29 November 2017 13:33 Expert decision payment received

4. Factual Background

The Complainant, incorporated in Spain, has distributed a range of cosmetics products under the brand “Fisiocrem” in Spain since 2003. The Complainant began supplying to the UK on an unspecified date thereafter.

FC Resources Limited, a New Zealand company, owns Australian trade mark no. 1283352 for the “fisiocrem” logo, filed on 4 February 2009 in classes 3 and 5. Paul Clive Ian Jeffrey, a shareholder in FC Resources Limited and the “administrator” of the Complainant, owns EU trade mark no. 012293742 for the “SOLUGEL fisiocrem” logo, filed on 8 November 2013 in classes 3, 5 and 35.

In 2005, the Complainant appointed the Respondent as its exclusive distributor in England.

The Respondent registered the Domain Name on 29 December 2006.

At some point thereafter, the Domain Name resolved to a blog post dated 25 September 2007, which stated as follows:

“Star Corp is no longer a re-seller of Fisiocrem in the United Kingdom.

We are now the exclusive distributor for Rubbeez.

Visit Star Corp’s website www.manukanaturalhealth.com and learn about Rubbeez. Its [sic] the massage cream in “The Blue Tube”. “

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant's "Fisocrem" products are known in the UK and worldwide.

The distribution agreement barred the Respondent from distributing any competing products. The Respondent breached the distribution agreement by unilaterally starting to manufacture "Rubeez", which competed with Fisocrem. The Respondent used the Complainant's client network to do so, falsely telling clients that the Complainant no longer existed.

A 2012 screenshot from a third party website describes Rubeez as "formerly" Fisocrem.

The blog entry shows that the Respondent is continuing to use the Domain Name in a way which confuses and misleads the Complainant's customers. The Respondent continued to order the Complainant's products until the start of 2012.

Response

The Respondent did not file a Response.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has "Rights" (as defined in paragraph 1 of the DRS 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 DRS Policy).

Complainant's Rights

The meaning of "Rights" is defined in the DRS Policy as follows:

"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 established unregistered rights in the mark “Fisiocrem” including on the basis of evidence of a significant volume of UK sales under that brand in 2010.

It is unnecessary to consider whether the Complainant should be entitled to rely on the third party-owned registered trade marks mentioned above.

For the above reasons, I am satisfied that the Complainant has established rights in a name or mark which is identical to the Domain Name, disregarding the domain name suffix.

Abusive Registration

Does the Domain Name constitute an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

The circumstances surrounding the termination of the distribution agreement are not entirely clear, including the exact timings.

However, it is unnecessary to delve into these matters because the blog post on the website is itself compelling evidence that the Respondent has used the Domain Name, which comprises the Complainant’s trade mark without adornment, to divert the Complainant’s customers to the new product offered by the Respondent. Plainly, this amounted to abusive use of the Domain Name, whether or not the distribution agreement had been formally terminated by that point.

Furthermore, the Respondent has not filed a Response to dispute the Complainant’s allegations.

I therefore readily conclude that the Domain Name has been used in manner which took unfair advantage of or was unfairly detrimental to the Complainant’s rights

7. Decision

I find that the Complainant has rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name fisiocrem.co.uk be transferred to the Complainant.

Signed: Adam Taylor

Dated: 22 December 2017