

**nominet****DISPUTE RESOLUTION SERVICE****DRS 00006639****Decision of Independent Expert****Stapla Ultraschall-Technik GmbH****and****Stuart Carroll****1. The Parties:**

**Complainant:** Stapla Ultraschall-Technik GmbH  
**Address:** 30, Buchenrodestraße,  
Frankfurt  
**Postcode** 60528  
**Country:** Germany

**Respondent:** Stuart Carroll  
**Address:** 16 Wrenbury Drive  
Rochdale  
Lancashire  
**Postcode:** OL16 4PJ  
**Country:** United Kingdom

**2. The Domain Name(s):**

stapla.co.uk

**3. Procedural History:**

On 10 December 2008 the Complaint was received by Nominet UK.

On 12 December 2008 Nominet UK notified the Respondent that the Complaint had been received and further notified the Respondent that the response was due on or before 07 January 2009.

No Response was received by Nominet UK.

On 8 January 2009 Nominet UK notified the Complainant and the Respondent that no Response had been received from the Respondent.

On 13 January 2009 James Bridgeman was appointed as Expert following a conflicts check.

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

The Complainant is a member of a group of companies under its parent company Schunk-Dienstleistungsgesellschaft mbh engaged in the sale of welding technology.

The Complainant is the owner of the figurative trademark, STAPLA, International trademark registration No. 0648988 dated 8 March 2005, designating the European Union, and has further provided evidence of an established goodwill in the use of the mark STAPLA in connection with welding technology.

In the absence of a Response, there is no information about the Respondent except that provided in the Complaint. The domain name resolves to a website purporting to be owned and controlled by a third party, Cable Speed Limited, and the third party has informed the Complainant that it has no association with the Respondent.

According to the Nominet UK WHOIS database the domain name in dispute was registered on 15 November 2002.

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

The Complainant alleges that the registration of domain name <stapla.co.uk> by the Respondent amounts, amongst others, to passing off and infringement of a registered trade mark and requests that the domain name be transferred to the Complainant.

The Complainant's parent company, Schunk-Dienstleistungsgesellschaft MbH, and its subsidiaries have been dealing with goods under the brand STAPLA since about 1990 and supply these goods to the UK market. The Complainant submits that STAPLA is a well known brand for welding technology manufactured by the Complainant's group of companies.

Furthermore the Complainant submits that STAPLA is a registered WIPO trademark (*sic*), no. 0648988, registered on 9 June 2005 in the name of Stapla Ultraschall-Technik GmbH.

The Complainant submits that the Respondent is (*sic*) a director of Plus Sonix Limited, a company which was appointed UK distributor by Stapla Ultraschall Technik GmbH for its products, including the STAPLA brand.

The distribution agreement was terminated on 31 March 2004 when a court order for the winding up of Plus Sonix Limited was made.

It appears that the Respondent registered the domain during the distribution agreement but, unknown to the Complainant, it was not registered in their names but in the name of Stuart Carroll.

The Complainants have had no further dealings with the Respondent or his companies since March 2004. The Respondent has no authority to deal with STAPLA products or to use the STAPLA brand and trademark.

In about May 2008 it came to the Complainants' attention that the domain name <stapla.co.uk> was being used as the address of an active website on which a company called Cable Speed Limited advertised the Complainants' products without their authority.

Cable Speed Limited ignored the first letter of complaint from the Complainant dated 5 May 2008. In response to a further letter from the Complainant's representative dated 1 July 2008 Cable Speed Limited replied that they have no further association or contact with the registrant and are therefore unable to procure a change of content or de-activation of the site or a transfer of the domain name.

By letter dated 8 July 2008 the Complainant's solicitor wrote to the registrant requesting a transfer of the domain but did not receive a reply.

The domain name <stapla.co.uk> continues to advertise Cable Speed Limited's business.

## **6. Discussions and Findings**

The Complainant is required to prove that 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.

The Complainant has provided evidence that it is the owner of the figurative trademark, STAPLA, International trademark registration No. 0648988 dated 8

March 2005, designating the European Union and has further provided evidence of an established goodwill in the use of the mark STAPLA in connection with welding technology.

It follows that the domain name in dispute is identical to the trademark STAPLA as used by the Complainant and is similar to the Complainant's figurative registered trademark.

The Complainant has made out a *prima facie* case that the domain name is an Abusive Registration in the hands of the Respondent.

The Complainant has stated that the Respondent was a director of a company that was a former distributor of the Complainant's products. The distributorship was terminated on the winding up of the distributor. In the absence of any denial by the Respondent, this Expert accepts these statements as being correct.

The Respondent registered the domain name during the period of the distributorship. Subsequent to the termination of the distributorship, the Respondent caused the domain name to resolve to the website of a third party, namely Cable Speed Limited.

Cable Speed Limited has no connection with the Complainant and has advised the Complainant that it no longer has any association or contact with the Respondent.

The Respondent is misleadingly using the domain name that is identical to the Complainant's STAPLA trademark as the address of a website purporting to be controlled by a third party, Cable Speed Limited, in circumstances where the third party has stated that it has no association with the Respondent and is unable to procure any change of content or de-activation of the site

In the view of this Expert such misleading use of a domain name amounts to an Abusive Registration for the purposes of the Policy.

## 7. Decision

This Expert directs that because the Complainant has established both elements of the test set out in paragraph 2(a) of the Nominet UK DRS Policy in respect of the domain name <stapla.co.uk> the Complainant should succeed in its application.

This Expert directs that the domain name the domain name <stapla.co.uk> be transferred to the Complainant.

Signed

James Bridgeman

Dated 11 February 2009