

DISPUTE RESOLUTION SERVICE

DRS 14438

Decision of Independent Expert

Bata Brands Sarl

Complainant

and

Garth Piesse

Respondent

1 The Parties

Complainant:	Bata Brands Sarl
Address:	123 avenue du X Septembre L-2551 Luxembourg

Respondent:	Garth Piesse
Address:	PO Box 181 Palmerston North Manawatu 4440 New Zealand

2 The Domain Name

bata.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.

08 July 2014:	Dispute received
09 July 2014:	Complaint validated
09 July 2014:	Notification of complaint sent to parties
28 July 2014:	Response reminder sent
28 July 2014:	Response received
28 July 2014:	Notification of response sent to parties
31 July 2014:	Reply reminder sent
05 August 2014:	No reply received
05 August 2014:	Mediator appointed
08 August 2014:	Mediation started
10 September 2014:	Mediation failed
10 September 2014:	Close of mediation documents sent
22 September 2014:	Complainant full fee reminder sent
25 September 2014:	No expert decision payment received
26 September 2014:	No expert decision payment received
26 September 2014:	Expert decision payment received

4 Factual Background

- 4.1 The Domain Name was registered by the Respondent on 26 December 2008.
- 4.2 The Respondent is in the business of buying, selling and monetising domain names.
- 4.3 The Complainant owns multiple trade marks in the BATA name. Bata is in the business of manufacturing, importing, retailing and distributing shoes.

5 Parties' Contentions

Complaint

- 5.1 The Complaint is relatively brief. The Complainant explains that it owns trade marks for the "Bata Shoe Organization" in connection with the manufacture and sale of footwear, the first such registration dating back to April 1928. The Complainant asserts that the BATA mark is "world-famous, iconic and synonymous with identifying primarily footwear products and shoe stores associated with the Bata family of international companies". It also asserts that it is a registrant of approximately 275 TLDs and ccLDs incorporating the word BATA, including *bata.com* and *bata.shoes*.
- 5.2 It asserts that the Respondent "has no relationship with Bata Brands and is not authorised by Bata Brands to use the "bata" trademark [sic] in any country of the world or for any purpose".
- 5.3 It explains that "the Bata organization" was founded by Thomas Bata in 1894 in what is now the Czech Republic and that his grandson is currently chairman of Bata. Reference is made to a book named *Bata: Shoemaker to the World*. The Complainant says that Bata operates over 5,000 stores in 60 countries worldwide selling approximately one million pairs of shoes every day.
- 5.4 The Complainant says that the Respondent has no right to use the BATA name or mark, and that he is not in the business of manufacturing or importing, retailing or distributing shoes.
- 5.5 It asserts that the Domain Name was registered by him "with the primary purpose of selling or renting it to the complainant (or a competitor) for more than the Registrant paid for it". The

Complainant relies in this regard on a link from the webpage at *www.bata.co.uk* to an invitation to "get a free price quote for bata.co.uk." and on an assertion that the Respondent offered to sell the Domain Name to "an agent of Bata Brands" for approximately €4,000. No evidence is provided in support of the latter assertion.

- 5.6 Further, the Complainant asserts that it has been prevented from using the Domain Name for its UK businesses and, in addition, that use of the Domain Name by the Respondent is likely to disrupt the Complainant's business and direct traffic to the website of the Respondent rather than that of the Complainant.
- 5.7 The Complainant also asserts that the Respondent's use of the Domain Name is likely to confuse internet users. It says that the Respondent is not using the Domain Name in connection with any active commercial business other than intended sale of the Domain Name to a third party.
- 5.8 The Complainant asserts, in addition, that the Respondent is in breach of the terms and conditions governing his registration of the Domain Name because he has infringed the Complainant's intellectual property rights (contrary to Clause 7.4), he was not entitled to register the Domain Name (contrary to Clause 7.5) and he has used and continues to use the Domain Name for an unlawful purpose (contrary to Clause 7.7).
- 5.9 For all these reasons (i.e. as summarised at paragraphs 5.4 to 5.8 above), the Complainant submits that the Domain Name is, in the hands of the Respondent, an abusive registration.

Response

- 5.10 The Respondent denies that the Complainant has established unregistered rights because it has failed to adduce any evidence in support of its assertions as to the extent of its trading goodwill. However, he accepts that, for the purposes of the DRS Policy (the "Policy"), the Complainant has the requisite Rights (as defined in the Policy) in the BATA name or mark, on the basis of its registered trade marks, and that the BATA mark is identical to the Domain Name.
- 5.11 As to Abusive Registration (as defined), the Respondent denies that, at the time that he registered the Domain Name, he was aware of the existence of the Complainant or its brand.
- 5.12 The Respondent says that he is in the business of buying, selling and monetising "generic domain names". He explains that he registered the Domain Name after becoming aware that it was on a list of domain names which were about to "drop" (i.e. their registration was about to expire and the names would therefore become available for registration by another party) and he therefore assumed that the previous owner no longer wanted it. He says that he regarded it as a "short four-letter acronym-type domain" and says that he owns approximately 400 similar generic four letter acronym domain names. A list of those four letter domain names is exhibited to the Response, together with their respective dates of registration, but no evidence is provided to demonstrate that they are in fact registered to the Respondent.
- 5.13 The Respondent accepts that his purpose was ultimately to sell the Domain Name to a third party, "most likely for use as an acronym", and in the meantime to profit from automated advertising links from the webpage at *www.bata.co.uk*. He points out that none of those links related to shoes.
- 5.14 The Respondent, who lives in New Zealand, says he was not aware of the Complainant when he registered the Domain Name and that there was no reason why he should have been. He says that the Complainant only came to his attention when it made its complaint in these

proceedings. He also asserts that the Complainant has not suggested any reason why he should have heard of it apart from "a very general, vague and entirely unsupported claim" that its trade mark is world famous and iconic. Indeed, the Respondent points out that the Complainant has provided no evidence at all of its reputation, let alone in 2008 when the Domain Name was registered.

- 5.15 The Respondent asserts that the acronym BATA is used by many organisations in the UK and elsewhere and provides a list of some of them. They vary from the well known British Air Transport Association to the less well known Bulgarian Association of Travel Agents. Various screenshots are exhibited of the websites of various users of the BATA acronym which are unrelated to the Complainant. He also points out that in Australasia the BAT Australia cigarette business has websites at *www.bata.com.au* and *www.bata.co.nz*.
- 5.16 The Complainant therefore asserts that, having regard to the DRS Appeal Panel decision in *verbatim.co.uk* (DRS 4331), the Complainant has failed to get to first base because it has not demonstrated that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name.
- 5.17 Notwithstanding its primary case in that regard, the Respondent goes on to answer the other arguments advanced by the Complainant.
- 5.18 The Respondent points out that intent is a necessary ingredient for all the circumstances indicating Abusive Registration set out at paragraph 3(a)(i) of the Policy. Since he was unaware of the Complainant when he registered the Domain Name, it therefore follows that he could not have registered it for the purpose of selling it to the Complainant or a competitor of the Complainant.
- 5.19 He says that the notice inviting offers for the Domain Name "simply shows that the Respondent was open to sale of the Domain Name to the world at large".
- 5.20 Further, the Respondent says that the Complainant's version of events in the Complaint is misleading because it gives the false impression that the Respondent unilaterally approached the Complainant with a view to selling it the Domain Name.
- 5.21 The Respondent says that in fact there were communications with only one party relating to the sale of the Domain Name. On 10 June 2014, the Respondent received a message from "Martin" asking if the Domain Name was for sale and, if so, for how much. In response, the Respondent says that he generated a standard email inviting "Martin" to make an offer. On 20 June, the link was used by "Martin Rennie", giving a personal Hotmail address, to make an offer of US\$2,000. The Respondent counter-offered US\$5,000, but nothing further was heard. That correspondence is exhibited to the Response.
- 5.22 The Respondent points out (a) that he did not make an unsolicited offer to the Complainant (or anyone else), but rather was seeking to negotiate a price in response to an approach made to him by a potential buyer, and (b) that he was not aware that the buyer was an agent of the Complainant.
- 5.23 The Respondent relies on paragraph 4(d) of the Policy which provides that there is nothing objectionable, in and of itself, in trading in domain names for profit, and refers in this regard to the Appeal Panel decisions in *parmaham.co.uk* (DRS359) and *ghd.co.uk* (DRS3078).
- 5.24 The Respondent denies that he registered the Domain Name primarily for the purpose of blocking registration of the Domain Name or of disrupting the Complainant's business, again because the requisite intent was not present.

- 5.25 As to the suggestion that the Domain Name is likely to confuse internet users, the Respondent says that he has never used the Domain Name in a manner relevant to the Complainant's business and relies in this regard on the Appeal Panel decisions in *myspace.co.uk* (DRS4962) and *oasis.co.uk* (DRS6365). He says that, given that he registered the Domain Name unaware of the Complainant's existence and rights, the situation is akin to that where a domain name is registered prior to a complainant acquiring the requisite rights.
- 5.26 As regards the Complainant's case on non-use, the Respondent relies on paragraph 3(b) of the Policy which provides that: "*Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration*".
- 5.27 The Respondent submits that the Complainant appears to base its case on trade mark infringement and asserts that trade mark infringement does not equate to Abusive Registration for the purposes of the Policy, and, in any event, that the Complainant has not made out any claim in trade mark infringement.
- 5.28 Finally, the Respondent requests a finding of attempted reverse domain name hijacking on the basis of the Complainant's version of events as regards the alleged attempt to sell the Domain Name to the Complainant. The Respondent submits that Complainants should not be allowed to "misuse the DRS in this manner".

Reply

- 5.29 Notwithstanding the detailed and carefully reasoned Response filed by the Respondent, the Complainant has chosen not to file a Reply.

6 Discussions and Findings

General

- 6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that he has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:
- "Abusive Registration means 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."*

Complainant's rights

- 6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "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".

- 6.4 The Complainant asserts that it owns a number of trade marks. It has exhibited a list of such trade marks. However, it has provided no evidence that it is the registered proprietor of those trade marks.
- 6.5 In those circumstances, and given that it has also failed to provide any evidence whatsoever of unregistered rights in the BATA name, an Expert might ordinarily be slow to find that the Complainant had proved that it had Rights in a name or mark identical or similar to the Domain Name.
- 6.6 The Complainant has, however, been rescued by the Respondent expressly accepting that the Complainant has rights in the BATA name and that this is identical to the Domain Name.
- 6.7 Accordingly, the Expert is prepared to proceed on the footing that the Complainant has Rights (as defined) under the Policy in respect of a name or mark that it is identical or similar to the Domain Name.

Abusive registration

- 6.8 The Complainant asserts that the Respondent "has no lawful right to use the name or trademark" BATA. That bare assertion does not hold water, either as a principle of trade mark law or, more particularly for present purposes, by reference to the test for Abusive Registration under the Policy. As the Respondent points out, even if, which the Complainant falls a long way short of demonstrating, the Respondent were liable for trade mark infringement, that does not necessarily equate to Abusive Registration under the Policy.
- 6.9 The Complainant relies also on the fact that the Respondent is not in the footwear business. However, it is not explained how this goes to the question of Abusive Registration (or alleged trade mark infringement). Indeed, on one view, this serves to exculpate the Respondent rather than the opposite.
- 6.10 The Complainant's principal ground of Abusive Registration therefore appears to be under paragraph 3(a)(i)(A) of the Policy, namely that there are circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose 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.
- 6.11 However, the Complainant has not contended, let alone proved, that this was the primary purpose for which the Domain Name was registered. Moreover the Respondent has explained that, at the time of registration, he was not aware of the Complainant. This seems plausible, particularly given that the Respondent lives in New Zealand, a long way from the Complainant's Central European heartland and where, according to its website, it does not appear to have a retail presence. We are not talking Jimmy Choo or Christian Louboutin, let alone Coca Cola or IBM. Further, this explanation has not been contradicted, let alone disproved, by the Complainant, as it had every opportunity to do in a Reply, had it chosen to file one.
- 6.12 Accordingly, the Expert accepts the Respondent's submission that this case falls within the principle enunciated in *verbatim.co.uk* (DRS359) which held as follows:

- "8.14 ... For this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name.
- ...
- 9.12. *Even if the Respondent did register the Domain Names for the purpose of sale, it did not do so primarily to sell the Domain Names to the Complainant – it did so to make them available for sale to the world at large.*
- 9.13 *The Panel is satisfied that on the evidence before it and on the balance of probabilities the Respondent at the time of registration genuinely and reasonably believed the Domain Names were generic or descriptive terms. It appears that the Respondent was not aware of the existence of the Complainant, nor is there any reason to suppose that a lay person, unfamiliar with the precise nature of the regulation of the production of parma ham in Italy, would be likely to apprehend such a body would exist.*
- 9.14. *As mentioned above, there is no evidence before the Panel as to the extent and nature of recognition by the public of the terms "Parma" or "Parma ham" or "prosciutto di Parma" and so the Panel is not prepared to infer that the Respondent knew or could reasonably have been expected to know of the Complainant's existence and rights at the time of registration."*
- 6.13 The Complainant has not discharged that burden of proof. Indeed, it has not even attempted to answer the Respondent's case in this regard, as it could have done had it chosen to file a Reply.
- 6.14 Further, the Expert accepts the Respondent's submission that the Complainant's statement that "the Registrant has offered to sell it to an agent of Bata Brands for approximately €4,000" was misleading, in light of the exchange of correspondence exhibited to the Response which provides the complete communications between the Complainant's representative and the Respondent, as set out in paragraphs 5.21 and 5.22 above.
- 6.15 Given that the true position is that the approach was made by the Complainant rather than the Respondent, the facts do not go very far, if anywhere, in demonstrating that the Respondent registered the Domain Name for the primary purpose of selling it to the Complainant.
- 6.16 Accordingly, the Complainant's case under paragraph 3(a)(i)(A) fails.
- 6.17 It is also said by the Complainant that the Respondent is preventing it from using the Domain Name for its UK business. However, again it is incumbent on the Complainant to demonstrate not just that the Domain Name is, in the hands of the Respondent, a blocking registration against a name or mark in which the Complainant has Rights (pursuant to paragraph 3(a)(i)(B) of the Policy), but that it was registered by the Respondent primarily for that purpose. However, there is no evidence that the Respondent was even aware of the Complainant's existence at the time of registration, nor evidence from which such knowledge or intent can reasonably be inferred. Accordingly, the complaint fails under that head also.
- 6.18 The Complainant asserts that the Respondent's use of the Domain Name is likely to disrupt its business by directing traffic to the Respondent's website instead of its own. Again, under paragraph 3(a)(i)(C), the Complainant must demonstrate not only that the Domain Name is being used for the purpose of unfairly disrupting the business of the Complainant (emphasis

added), but also that it was registered by the Respondent primarily for that purpose. Again, for the reasons set out in paragraphs 6.11 to 6.13 above, that contention must fail.

- 6.19 Paragraph 3(a)(ii) of the Policy provides that 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 can constitute evidence of abusive registration. The Complainant asserts that the Domain Name, in the hands of the Respondent, is "likely to confuse Internet users". No explanation is given as to how that confusion is likely to arise. Moreover, it is the uncontradicted evidence of the Respondent that BATA is a four letter acronym for a substantial number of organisations, so on balance it does not look like an initial interest confusion case, even had the Complainant advanced such an argument (which it did not). Accordingly, the complaint fails under this head.
- 6.20 The Complainant relies on the fact that the Respondent is not using the Domain Name "in connection with any active commercial business other than the intended sale of that domain to a third party". As the Respondent has correctly observed, the Policy specifically provides (paragraph 3(b)) that : "*Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration*". Accordingly, that bare assertion, does not get the Complainant home, particularly in light of the further provision in paragraph 4(d) of the Policy to the effect that there is nothing *per se* objectionable about trading in domain names for profit.
- 6.21 Finally, the Complainant relies upon alleged breaches of the agreement between the Respondent and Nominet. In the first place, it is questionable whether any such alleged breaches would constitute evidence of Abusive Registration. Secondly, and more pertinently, those alleged breaches are in any event parasitic on the Complainant succeeding in proving trade mark infringement and/or Abusive Registration under the Policy.
- 6.22 Accordingly for the reasons given above, the Complainant has failed to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration in the hands of the Respondent.

Reverse domain name hijacking

- 6.23 Finally, there is the Respondent's request for a finding against the Complainant of attempted reverse domain name hijacking. Under Paragraph 16(d) of the DRS Procedure it is open to an Expert to make a finding that a complaint was brought in bad faith "*for example in an attempt at Reverse Domain Name Hijacking*". Reverse domain name hijacking is defined in the Procedure as "*using the Policy in bad faith in an attempt to deprive a registered domain name holder of a domain name*".
- 6.24 The Expert accepts, on the evidence before him, that the Complainant's version of events concerning the purported offer to sell the Domain Name to the Complainant was incomplete and therefore misleading. Such conduct, if deliberate, is to be seriously deprecated.
- 6.25 Paragraph 16 (d) appears to be directed at what would in litigation be termed abuse of process, e.g. where a Complainant has set out to misuse the DRS knowing it did not have a tenable claim but perhaps hoping that no response would be filed. In this case, there is insufficient evidence before the Expert to reach such a conclusion. While the Complainant plainly failed properly to explain or evidence its (or its agent's) dealings with the Respondent, the remainder of the Complaint is equally sketchy and unsubstantiated. Whether the Complainant was acting in bad faith or was simply incompetent, it is difficult to say.

6.26 Accordingly, in the circumstances, the Expert declines to make a finding of attempted reverse domain name hijacking against the Complainant.

7 Decision

7.1 The Expert therefore finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name, but that the Domain Name, in the hands of the Respondent, is not an Abusive Registration.

7.2 It is therefore determined that there be no transfer of the Domain Name to the Complainant.

Signed David Engel

Dated 14 November 2014