

DISPUTE RESOLUTION SERVICE

D00017259

Decision of Independent Expert

GT Global Trademarks AG

and

Mr Mark Graves

1. The Parties:

Complainant:

GT Global Trademarks AG
Sihlbruggstrasse 105 6340
Baar
Switzerland

Respondent:

Mr Mark Graves
Wharfside Mews
Carre Street
Sleaford
Lincs
NG34 7TW
United Kingdom

2. The Domain Name(s):

dunlopillowpillows.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, which need be disclosed as might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

24 March 2016 Dispute received
29 March 2016 Complaint validated
29 March 2016 Notification of complaint sent to parties
15 April 2016 Response reminder sent
20 April 2016 Response received
20 April 2016 Notification of response sent to parties
25 April 2016 Reply reminder sent
28 April 2016 Reply received
28 April 2016 Notification of reply sent to parties
28 April 2016 Mediator appointed
04 May 2016 Mediation started
12 July 2016 Mediation failed
12 July 2016 Close of mediation documents sent
14 July 2016 Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 5 May 2008.

Based on the parties' submissions (see section 5 below) and a review of the materials annexed to the Complaint and Response, I set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant is the owner of UK trade mark registrations for DUNLOPILLO, dating back to 1972.
- b. Substantial use of the DUNLOPILLO name has been made in the UK, including for pillows, for over 50 years. Such use has been by the Complainant, its predecessors in title, and licensees of both, with the goodwill and consequent rights arising from such use belonging to the Complainant.
- c. The Respondent is one of the Complainant's authorised distributors in the UK.
- d. The Respondent carries on business under the trading name of The Sleep Shop.
- e. The Domain Name re-directs to the Respondent's website at www.thesleepshop.co.uk. More specifically it re-directs to a landing page on that website which depicts a range of (genuine) Dunlopillo pillows.

- f. The same landing page lists other brands of bedding products, including pillows, which can also be purchased on The Sleep Shop's website.
- g. The Respondent claims to have had written permission from the Complainant's predecessor in business to use the Domain Name, but has failed to corroborate such claim.

5. Parties' Contentions

Complaint

The Complainant's submissions are set out below:

The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:

- (1) The Complainant has rights in the name 'Dunlopillo' (the 'Dunlopillo Mark') as a result of its ownership of the historic Dunlopillo brand and associated trade marks, as well as enforceable common law rights.
- (2) The Complainant is a Swiss company which is associated with the Steinhoff Group of companies (the "Steinhoff Group"). The Steinhoff Group is a multinational group that manufactures, sources and sells furniture, household goods and general merchandise. In the UK, its business includes the manufacture and sale, through wholesaling and retail, of beds, furniture and pillows and other products including 'Dunlopillo' branded pillows and products. Its business in the UK also includes the Myers, Slumberland, Staples Pritex and Relyon manufacturing brands.
- (3) The Complainant is not a trading entity. Instead, as is common practice in large multinationals operating across multiple jurisdictions, it is an intellectual property holding company which owns a number of UK and EU trade mark registrations relating to the brands the Steinhoff Group operates. The marks associated with such brands are licensed to the Steinhoff Group. In the UK, the right to use the Dunlopillo Mark in the distribution and sale of the products, including pillows, covered by the Registered Marks (described below) is licensed to Steinhoff UK Beds Limited under a trade mark licence. Under this licence all goodwill in relation to the marks accrues to the Complainant. Therefore the Complainant is bringing this complaint in relation to its registered rights and as owner of the goodwill generated by the Steinhoff Group and historically in the UK in respect of the use of the Dunlopillo Mark.
- (4) The Steinhoff Group acquired the business of Dunlopillo and its related trade marks and goodwill when Steinhoff UK Beds Limited (a UK company within the Steinhoff Group) purchased certain assets of Hilding Anders PLC ("Hilding Anders") in March 2013. At the time Hilding Anders PLC was in administration.

- (5) As part of that transaction, the trade marks relating to the business of Dunlopillo (amongst other assets) were assigned by Hilding Anders Switzerland AG (a subsidiary of Hilding Anders PLC) to the Complainant under a trade mark assignment dated 26th March 2013, together with the goodwill of the business associated with such marks.
- (6) As a result the Complainant is the proprietor of the following UK trade marks (details of which are annexed to the Complaint) (the “Registered Marks”): trade mark numbers 995361, 2328241 and 1152934, all registered for ‘Pillows’ in Class 20, amongst other things.
- (7) The Dunlopillo Mark is distinctive and is not descriptive. Its distinctiveness has been enhanced by virtue of its lengthy and extensive use.
- (8) The invented word ‘Dunlopillo’ was first coined and used by the Dunlop Rubber Company in 1929 in relation to a latex foam product. The Dunlopillo brand was used from the 1920s to the 1970s in connection with a range of upholstery for vehicles, beds and other rubber goods (see Annex of Complaint for further examples of historic use of the Dunlopillo Mark). The Dunlopillo brand has also been used in relation to pillows for many years, see (for instance) the advertisement from Punch magazine from 1956. In recent years the Dunlopillo Mark has been used exclusively in relation to beds, mattresses and pillows. Dunlopillo is an established premium brand in the upper price segment of the bed, mattress and pillow retail markets.
- (9) Upon the purchase of Dunlopillo by Hilding Anders in 2002, it was reported that Dunlopillo had annual sales of £14m and engaged 90 employees (see Annex). More recently, the turnover of the bedroom goods sold under the Dunlopillo Mark (including the Registered Marks) in the UK in the calendar years immediately prior to and including the assignment to the Complainant was:
- 2011: £4,643,862;
2012: £4,060,232; and
2013: £3,069,221.
- (10) Bedroom Products, including pillows, sold under the Dunlopillo Mark in the UK are sold through the retail stores within the Steinhoff Group including Bensons for Beds which has approximately 250 retail outlets in the UK.
- (11) Products, including pillows, sold under the Dunlopillo Mark in the UK are also sold through third party distributors within their retail stores, including John Lewis, Furniture Village and other reputable retailers.
- (12) Products, including pillows, sold under the Dunlopillo Mark have been and continue to be stocked and sold online by a significant number of retailers including (merely taking a sample of retailers with an online presence):

John Lewis: <https://protect-eu.mimecast.com/s/wNI5BfKJQrohk>
Land of Beds: <https://protect-eu.mimecast.com/s/akKmBiAdq3YTv>
Beds Are Uzzz: <https://protect-eu.mimecast.com/s/2eQOBsYZvG8Ia>
Roomes: <https://protect-eu.mimecast.com/s/619rBh7oma8hr>
Furniture Village: <https://protect-eu.mimecast.com/s/NI45BhYKRXqIK>

- (13) The Complainant takes reasonable steps to protect its brand and does not allow distributors to register DUNLOPILLO as a trade mark or domain name. This has involved writing to infringers and requiring them to enter into undertakings (containing confidentiality provisions) to cease their infringing activities.
- (14) The Complainant also owns a number of domain name registrations relating to the Dunlopillo Mark including Dunlopillo.co.uk (which is registered to Homestyle Operations Limited which is part of the Steinhoff Group).
- (15) Therefore, the Dunlopillo Mark is recognised by the purchasing public as indicating the goods of the Steinhoff Group which it uses under licence from the Complainant.
- (16) The sale of pillows and other products under the Dunlopillo Mark through so many retailers and the significant level of turnover demonstrate that there is substantial goodwill in the business denoted by the name “Dunlopillo”. As a result the Complainant has enforceable common law rights, sufficient to give the Complainant the right to bring an action for passing off in respect of the Dunlopillo Mark in the UK.
- (17) The domain name *dunlopillopillows.co.uk* (the “Domain Name”) is owned and controlled by Mark Graves (trading as FGS Furnishings Limited). The Dunlopillo Mark enjoyed a reputation in the United Kingdom at the date of the registration of the Domain Name.
- (18) The Domain Name contains the Dunlopillo Mark with the addition of the word ‘pillow’. This addition is merely descriptive of one of the main products sold under the Dunlopillo Mark rather than adding anything new or distinctive. As described above, a number of the Registered Marks include ‘pillows’ in their specification. Therefore, the word “pillow” does not distinguish the Domain Name from the Dunlopillo Mark.
- (19) Therefore the Complainant has rights in the Domain Name, given the Complainant’s rights in the Dunlopillo Mark.

The Domain Name, in the hands of the Respondent, is an abusive registration:

- (1) There is evidence that the Domain Name is an Abusive Registration under Paragraph 3(a)(ii) of Nominet’s DRS Policy because there are “circumstances indicating that the Respondent is using... 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”.

- (2) In DRS 3027 (*Epson-compatible-ink-cartridges.co.uk* and ors., paragraph 9.5.6) the Expert noted that “The Respondent is using the attractive force of the EPSON registered trade mark... to draw visitors to its website both to sell competing products and to imply a commercial connection with the owner of the mark”. In Epson, compatible ink cartridges were sold alongside Epson’s genuine products. The same is happening in this case: the Respondent is using the attractive force of the long established Dunlopillo brand, which forms the main part of the Domain Name, to draw customers to its own website, where it sells competing products alongside Dunlopillo products. The use of the Domain Name in this way confuses the relationship between the Complainant and Respondent and confuses the public.
- (3) The Respondent is Mr Mark Graves who is the registrant of the Domain Name. The Whois record for the Domain Name records Mr Graves as the ‘Registrant’ but indicates that Mark Graves is “trading as” FGS Furnishings Limited.
- (4) Upon visiting the Domain Name, a visitor is automatically redirected to http://www.thesleepshop.co.uk/acatalog/Dunlopillo_Pillows.html (the “Landing Page”). The *thesleepshop.co.uk* domain name is held by FGS Furnishings Limited as the registrant. The terms of services of the website on *thesleepshop.co.uk* refer to the website being operated by the Sleep Shop Ltd. On Companies House Mr Graves is identified as a director and company secretary of FGS Furnishings Limited (company number 04569731) and the Sleep Shop Ltd (company number 04569731).
- (5) There is evidence of an Abusive Registration as the registration of the Domain Name will cause confusion as to who is operating the Domain Name. Such confusion takes unfair advantage of the Complainant’s rights in the Dunlopillo Mark and, the Complainant suspects, is being used to optimise the Respondent’s own search engine results by linking to the Landing Page.
- (6) Confusion will occur because the Domain Name and the Dunlopillo Mark are identical (or very similar) and this will inevitably lead to confusion (or at least initial interest confusion) and/or give the impression of a link or connection between the Domain Name and the Complainant/Dunlopillo Mark which does not exist.
- (7) Internet users visit websites by way of search engines or by guessing the relevant URL. There is a risk that a search engine being asked for the Dunlopillo Mark will produce on results for the URL for the Domain Name. There is a risk that internet users will attempt to guess the URL for sites operated by the Complainant or the Steinhoff Group in this way. The natural assumption of any person seeing the Domain Name would be that it was operated or controlled (or otherwise endorsed) by the Steinhoff Group.

(8) Such confusion is likely because:

- (a) the use of such a short and unadorned Domain Name (i.e. containing only the Dunlopillo Mark and a key product sold under the Dunlopillo Mark) suggests that the Domain Name is operated by the Complainant or another company in the Steinhoff Group or that the use of the Domain Name in an unadorned manner creates the false impression of a link or an endorsement between the Respondent (or FGS Furnishings and/or the Sleep Shop Ltd because of the immediate redirect) and the Complainant. It suggests that the Complainant approves of the use of the Domain Name in this way or that some sort of permission or association with the Complainant and its group exists which permits this activity;
- (b) the immediate redirect to the Landing Page from the Domain Name gives no opportunity to explain or expand upon the relationship between the Domain Name, the Complainant or the Respondent. This use makes the ownership of the Domain Name essentially unknowable without a 'whois' search which most consumers are unlikely to undertake. It encourages the notion that either:
 - (i) the Complainant and the Respondent are one and the same,
 - or
 - (ii) there is some sort of endorsement or special relationship between those parties entitling this kind of redirect. In DRS248 (Seiko-shop.co.uk) the panel noted that "the use of a trade mark for a domain name without the consent of the trade mark owner for selling genuine products could make the false representation that there was something official or approved about the website". As in Seiko, as the use of a Domain Name, even to direct consumers from the Landing Page for the sale of genuine Dunlopillo products (although sold alongside competitors' products), gives the false impression of endorsement by the Steinhoff Group of the use of the Domain Name and the Respondent's website;
- (c) there is no indication on the Landing Page relating to the relationship between the Complainant and the Respondent which would disabuse any visitor redirected from the Domain Name that there was some kind of relationship or endorsement; and
- (d) the Steinhoff Group's other distributors do not, and would not be permitted to, use the Dunlopillo Mark in such a way without any qualification, or indeed without a licence. Therefore there is an implication of a special relationship or endorsement by the Complainant and the Steinhoff Group which differentiates the Respondent from other distributors. Therefore using the Domain Name in this way gives the Respondent an unfair advantage. As with Seiko in Seiko-shop.co.uk, Dunlopillo has not set up a franchise in which all retailers are able to represent themselves as being 'Dunlopillo' retailers. The Respondent is free to promote and sell Dunlopillo pillows and other

products, but does not have the right to usurp the rights of the Steinhoff Group in the Dunlopillo Mark.

- (9) Even if visitors are not confused, in the alternative, a visitor to the Domain Name (redirected immediately to the Landing Page) would suffer from initial interest confusion for the reasons set out above. It was noted in DRS 3027 (Epson-compatible-ink-cartridges.co.uk and ors. citing the BMW v Deenik case C-63/97 [1999]) that confusion may arise irrespective of website content and that ‘initial interest confusion is an admissible species of confusion in DRS cases’. This is because the Domain Name would be visited in the hope and expectation that it is operated or authorised or otherwise connected with the Complainant or the Steinhoff Group – but the visitor will be redirected to the Landing Page which is not. At Paragraph 3.3 of the Nominet Expert Overview it is noted that: “the speculative visitor to the registrant’s web site will be visiting it in the hope and expectation that the web site is a web site operated or authorised by, or otherwise connected with the Complainant. This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with ... a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.”
- (10) The Complainant submits that whilst initial interest confusion might exist in respect of the Landing Page and the Respondent’s website, such confusion is not dispelled between when a visitor clicks on the Domain Name and when they are redirected to the Landing Page.
- (11) The Respondent’s use also goes against the principles set out in the UDRP decision D2001-0903 (Oki Data America v ASD – and as summarised for the purposes of the DRS by the appeal panel in DRS7993 (Toshiba-laptop-battery.co.uk) that “a registration will be abusive if the effect of the domain name is falsely to imply a commercial connection with the Complainant” whether through actual confusion or initial interest confusion.
- (12) The Respondent is using the Domain Name with the intention of taking unfair advantage of the Dunlopillo Mark to “bait” (to use the word from the Oki Data America v ASD [WIPO] D2001-0903 UDRP decision) customers to the Respondent’s own website.
- (13) A customer, when presented with the option of visiting the Domain Name (as a result of a search result or as a link), would do so on the basis of their perception of the Dunlopillo Mark. There are no other meaningful indicia forming part of the Domain Name except the Dunlopillo Mark. Therefore all persons clicking on the Domain Name would do so on the basis of the reputation of the Dunlopillo Mark, rather than that of the Respondent or his connected businesses.

- (14) This gives an unfair advantage to the Respondent and its website and is misleading for visitors to the Domain Name. In the UDRP decision *Oki Data America v ASD* (WIPO[D2001-0903 it was made clear that the “respondent must use the site only to sell the trade marked goods, otherwise it could be using the trade mark to “bait” customers and then offer them other goods”. The use of the Domain Name to redirect visitors to the Landing Page performs the same function of ‘baiting’ in this case.
- (15) The Complainant has no issue with the Respondent’s site selling Dunlopillo branded products with competing products, but the Complainant cannot accept the use of the Domain Name containing the Dunlopillo Mark to ‘bait’ customers a website presenting Dunlopillo products in this way.
- (16) The Respondent is using the Domain Name to take unfair advantage and cause unfair detriment to the Complainant’s rights by immediately redirecting all visitors to the Domain Name to the Landing Page.
- (17) The Landing Page offers a number of the Complainant’s products for sale. The Respondent is a distributor of products carrying the Dunlopillo Mark and there is no dispute as to whether or not the Respondent is entitled to display and sell the Complainant’s products in an online environment. However, the Landing Page also lists a number of brands which compete directly with the Complainant (please note that the Slumberland and Relyon brands are owned by the Steinhoff Group).
- (18) These brands are listed in three places on the Landing Page (see Annex):
- (i) as logos in a banner at the top of the Landing Page including: Sealy (a registered trade mark of Sealy Technology LLC), Silentnight and Rest Assured (registered trade marks of Silent Night Group Limited), Original Bedstead, Sleepzee (a registered trade mark of Sleepzee Limited), Kaymed (a registered trade mark of Kayfoam Woolfson), and Rauch (a registered trade mark of Rauch Möbelwerke GmbH).
 - (ii) at the foot of the page in a longer list including the brands in the banner above but also more brands including Hypnos, Buoyant, Friendship Mill, Original Bedstead Company (OBC), Simmons, Kaymed Sleep Spa, Swanglen, Crowther, Metal Bed Company, Bentley, Gleneagle, Birlea and the Respondent’s own brand, the Sleep Shop.
 - (iii) In the backing border of the page the logos of Sealy, Silent Night and Rest Assured, Original Bedstead, Sleepzee, Kaymed and Rauch are visible.

- (19) For all of the brands listed, whether in the banner or the list at the bottom, their name or logo contains a link from the Landing Page to other parts of the Respondent's website where these competing brands are sold. None of the companies described above is in any way part of the Steinhoff Group.
- (20) Whilst Dunlopillo branded goods are sold on the Landing Page, the use of the Domain Name will inevitably drive traffic to the Complainant's competitors as prominent links to competing products are also displayed on the Landing Page. In DRS7991 (Toshiba-laptop-battery.co.uk) it was noted by the Appeal Panel that "if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner's consent, to accord with the principles ... that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do otherwise is likely to take unfair advantage of the Complainant's rights by riding on its coat-tails for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated". In the summary of UDRP decision Oki Data in Toshiba-laptop-battery.co.uk it was concluded that "whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website".
- (21) The Complainant submits that, as with Toshiba and Oki Data, the sale of competing products on an automatic redirect from the Domain Name is detrimental to the Complainant's rights as it promotes competitors' brands. Such use is taking unfair advantage of the Complainant's rights by driving traffic to the Respondent's website selling competing products.
- (22) Furthermore, a scenario very similar to what has occurred in the current matter was considered in DRS15763 (seachem.co.uk) when the Expert noted "if the Respondent was using the Disputed Domain Name to point to a website selling the products of other manufacturers, as well as SEACHEM products (commonly known as "bait and switch"), then in the Expert's opinion this would clearly be against the Policy". The Complainant agrees with the Expert's conclusion that such a type of registration (as has occurred in the current case) is against the Policy and is an Abusive Registration.
- (23) As noted in DRS 7991 (Toshiba-laptop-battery.co.uk) "this element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated". Therefore, even if the Expert does not consider there to be unfair detriment (and the Complainant submits that there is unfair detriment given, amongst other things, the sale of competing products) unfair advantage still remains and the finding of unfair detriment is not a requirement for an abusive registration to be found.

(24) Paragraph 3 of the DRS Policy does not constitute an exhaustive list of evidence that use of a registration is abusive. Other factors which cause unfair detriment or unfair advantage should also be considered. In light of this, the Complainant submits that it suffers unfair detriment to its rights as visitors to the Domain Name shall have their opinion of the Dunlopillo Mark lowered due to the way in which it is used by the Respondent. The Dunlopillo Mark is long established as a premium brand for pillows, beds and mattresses and it is important to the Complainant to maintain the reputation of the Dunlopillo Mark as one for a premium product. The use of a redirect from the Domain Name to the Landing Page is detrimental to the Dunlopillo Mark as it gives a sense of 'cheapness' as it is evocative of redirection via spam links within emails or redirection to less credible websites from adverts. The user journey from the Domain Name to Landing Page is a messy one – which the Complainant does not want to be associated with the Dunlopillo Mark. The use of the Domain Name in this way is unfairly detrimental to the Complainant's rights.

(25) The Respondent has maintained throughout its correspondence with the Complainant that it has permission to undertake its activities with the Domain Name through an agreement with Hilding Anders – entered into before the Steinhoff Group acquired the Dunlopillo business. It is the Complainant's position that to the extent there ever was such an agreement (and the Complainant has never seen any evidence of being in place) any such permission is now at an end and thus the activities in relation to the Domain Name are being undertaken without its consent and thus are abusive. Below the Complainant sets out its correspondence with the Respondent in relation to this matter:

(a) The Complainant, having learned of the Respondent's use of the Domain Name, first wrote to the Respondent on 15th July 2015 to make clear that the usage by the Respondent was not acceptable and requesting that the Respondent cease such usage and transfer the Domain Name to the Complainant.

(b) The Respondent, Mr Graves, telephoned the Complainant shortly after receiving the Complainant's letter and said there was a written "domain name agreement" which had been put in place between the Respondent and Hilding Anders which entitled him to such usage of the Domain Name (the 'Alleged Arrangement').

(c) The Complainant's David Wescomb emailed the Respondent on 20th August 2015 requesting that the Respondent provide a copy of the Alleged Arrangement – as the Complainant was not aware of the existence of such an agreement nor of any other correspondence in relation to such an agreement.

(d) The Respondent did not respond to this request and so the Complainant instructed Hansel Henson solicitors to write to the Respondent. On 9th October 2015, Hansel Henson wrote to the Respondent requesting a copy of the Alleged Arrangement and

making it clear that the Complainant had not been aware of any such agreement. The letter made clear that to the extent 'such a licence, permission or agreement ever existed and has not previously been terminated... that the licence permission or agreement is hereby terminated with immediate effect'. The letter offered to cover the Respondent's out of pocket expenses and requested that the Domain Name be transferred as soon as practicable.

(26) The Respondent called Hansel Henson's Mr Hansel on 9th October 2015 upon receipt of the letter asserting that he had previously sent information to the Complainant (the Complainant has not received any such information). The Respondent said he would provide a copy of the Alleged Arrangement (see Hansel Henson's email reporting this attendance to the Complainant- copy in Annex).

(27) The Respondent did not follow up on his assertion that he would provide a copy of the Alleged Arrangement and so Hansel Henson wrote to the Respondent again on 23rd October 2015 (see page 45 of the Annex) repeating the request for a copy of the Alleged Arrangement. The Respondent telephoned Hansel Henson's Mr Henson on 23rd October, upon receipt of the letter, and said he was retrieving a copy of the Alleged Arrangement from archive. The Respondent said he was taking advice from Nominet on the strength of his case for arguing the Domain Name should not be transferred to the Complainant. Mr Henson noted that it was unlikely that Nominet would provide such guidance.

(28) The Respondent did not contact Hansel Henson to provide a copy of the Alleged Arrangement, so on 7th December 2015 Hansel Henson wrote to the Respondent making a final offer to meet his out of pocket expenses in respect of the transfer of the Domain Name. Hansel Henson noted that to the extent that there was any licence in place with Hilding Anders, neither Hansel Henson nor the Complainant has seen any evidence of such an Alleged Arrangement and that in any event such a licence was terminated under Hansel Henson's letter dated 9th October 2015. Hansel Henson noted that if the domain name was not transferred to the Complainant before 14th December 2015, Hansel Henson was instructed to undertake DRS proceedings.

(29) The Respondent spoke by telephone with Hansel Henson's Mr Hansel on 14th December 2015. The Respondent asserted that he is only selling the Complainant's products at the Domain Name. Mr Hansel noted that competitive products are clearly advertised for sale. The Respondent asserted that the Respondent had permission to do this, Mr Hansel asserted that no evidence of such a right had been provided nor had the Respondent, when invited to do so, provided such evidence. Mr Hansel noted that the Complainant had offered to pay the out of pocket expenses of the Respondent. Mr Graves asserted the Domain Name is worth more than that.

(30) It can also be deduced from the Respondent's correspondence that the Respondent was aware that it required some form of permission in

writing from the Complainant or its predecessor in title in order to use the Domain Name in this way.

- (31) In summary, there is no arrangement between the Complainant and the Respondent. To the extent an arrangement existed between the Complainant and Hilding Anders (and the Complainant has no knowledge of one existing) it has been terminated by the Complainant. The Respondent is aware that it needs to have a licence to use the Domain Name in the way in which it is doing so.
- (32) The principle of a brand owner retaining control of its brand and the quality and nature of the products sold under its brand, is paramount and a key reason why the Complainant has taken this action. The Complainant submits that the Respondent is deliberately taking unfair advantage of the reputation of the Dunlopillo Mark and causing unfair detriment to the Dunlopillo Mark through the use of the Domain Name and that this makes the registration abusive.

Response

The Respondent's submissions are set out below:

- (1) FGS Furnishings is a family owned company which was established in 1947 as upholsterers and manufacturers of upholstery. FGS has since diversified into furniture retail in 1978. Expansion later took place to move to online sales in 2006. This journey allowed the company to grow and work with many well-known brands giving them the opportunity to offer an extensive and high quality product range.
- (2) The Sleep Shop is owned and operated by FGS Furnishings and this is where the majority of FGS' online sales originate.
- (3) FGS Furnishings has five retail outlets in total and also operates several websites which sell a range of furniture products including the following: mattresses, divan sets, bedsteads, adjustable beds, guest beds, children's beds, bunk beds, headboards, sofa beds, pillows, futons, bedroom furniture, upholstery and dining and living furniture.
- (4) In Lincolnshire and particularly Sleaford, FGS Furnishings are very successful due to their high street presence and the fact that they have products from so many manufacturers including Dunlopillo on display in store for consumers to view. The target market of FGS is people wishing to purchase quality furniture products at the best prices possible. FGS are able to do this due to developing professional relationships with manufacturers over a number of years.
- (5) The Sleep Shop's online presence is something FGS have seen grow rapidly since 2006 and due to this have seen an increase in sales. Sales figures are as follows:

Jan 2013 – Dec 2013 Number of items sold: 4565 Value: £178567

Jan 2014 – Dec 2014 Number of items sold: 5223 Value: £198411

Jan 2015 – Dec 2015 Number of items sold: 5369 Value: £202345

- (6) In 2007 FGS Furnishings became stockists of both the Slumberland and Dunlopillo brands, which were at the time owned by Hilding Anders UK PLC and were administered from Salmon Fields, Royton, Oldham. Trading accounts were opened with Mr Tony Bryant who at the time was the Area Sales Manager and is now the Sales Director- Independents for Steinhoff UK Beds.
- (7) Steinhoff UK do not sell their products directly to the consumer. Sales are through authorised stockists. We have been an authorised stockist of Dunlopillo products since 2007 and continue to be listed on Dunlopillo's own website as such.
- (8) The Sleep Shop's homepage and in particular the landing page for Dunlopillo product has been specifically designed in order that it is clear to the consumer that they are buying Dunlopillo products from The Sleep Shop and not direct from the Complainant, Dunlopillo or Steinhoff UK
- (9) In late 2007 Hilding Anders acquired the Myers and Staples brands operating from Huntingdon. In January 2008 production and administration of the Slumberland and Dunlopillo brands was transferred to this site. This was achieved by Horatio and Myer Co Ltd purchasing the Slumberland and Dunlopillo brands. All brands were then traded under the Horatio Myer and Co with separate accounts for each brand.
- (10) Turnover with Horatio Myer and Co increased and therefore FGS Furnishings required them to sign 'key supplier trading terms and conditions' this was completed on the 31st October 2008. At that time this covered all brands including Dunlopillo.
- (11) FGS Furnishings had further correspondence with Hilding Anders in 2012. Following their re organisation they confirmed that they acknowledged the trading agreement dated 31st October 2008 and Paul Francis on behalf of Hilding Anders confirmed that they were happy for FGS Furnishings to continue to use the domain provided that it was for the promotion of the Dunlopillo products.
- (12) FGS initially registered the domain name in 2008 and this was due to Dunlopillo being one of the most well-known brands that they had a relationship with. FGS Furnishings were having a number of enquiries about the Dunlopillo products both in store and online via phone calls; therefore the domain was chosen so that consumers were aware FGS stocked the Dunlopillo products at a reasonable price. The use of the domain has only ever been in connection with genuinely offering Dunlopillo products for sale. This has been done through retail stores and online in for in excess of 7 years preceding the Complaint. The domain is descriptive and we believe we have at all times made fair use of it.

- (13) From 2008 onwards at any and every opportunity employees of the former owner of the trademark Dunlopillo and the Complainant were made aware of FGS' ownership of the domain name and its use. This was discussed and agreed with Hilding Anders employees Paul Francis, Tony Bryant and Sarah Harris, then furthermore Sarah Chapple and Chris Francis were aware of our ownership of the domain. Two of these employees are now employed by the Complainant. David Westcomb although employed by Steinhoff prior to their purchase of the assets of Hilding Anders was also aware of FGS' ownership of the domain.
- (14) Apart from the recent correspondence received from the Complainant at no point in the 8 years prior to this has FGS Furnishings received any communication to indicate that either Hiding Anders or the Complainant were unhappy with the domain name or in the manner in which it was used.
- (15) As the Complainant confirms whenever we have received correspondence from Steinhoff of UK or Hansel Henson limited we have responded the same day. The reference to Nominet was a suggestion to amicably resolve matters. FGS do work in partnership with all of their suppliers and the Respondent believes it has at all times made fair use of the domain name.
- (16) The ownership of the trademark Dunlopillo by the Complainant in the UK is not disputed but the word pillow has never formed part of the trade mark.
- (17) One letter on behalf of the Complainant states "we are keen to ensure we own or control ownership of all the domain names which contain the word Dunlopillo". However, the following domains containing the word Dunlopillo are available but have not been registered by the Complainant: Dunpillomattresses.co.uk; Dunpillobedding.co.uk; Dunpillofurniture.co.uk; Dunpillohedboards.co.uk; Dunpillomattressbases.co.uk; Dunpillodivans.co.uk; Dunpillobolstersandcushions.co.uk. With the exception of "pillows" (owned by FGS) the only registered domain name containing product from categories within class 20 is "beds".
- (18) On researching Dunpillobeds.co.uk this has been in the ownership of Sunny Pea since January 2013. As far as the Respondent is aware, the owner has no connection with the Complainant, and there has never previously been a complaint made against the use of this domain name.
- (19) The Respondent therefore fundamentally takes issue with the reason for initiating this Complaint, namely that the Complainant is keen to "ensure we own or control ownership of all the domain names which contain the word Dunlopillo".
- (20) As regards the connection to the Epson case, there was no Response in that case and the registered domain names were related to specific

model numbers, whereas this Domain Name simply describes a 'product group' rather than a specific model.

- (21) The Complainant has stated that the Respondent is using the attractive force of the long established Dunlopillo brand which forms the main part of the Domain Name to draw customers to its own website where it sells competing products. FGS use the domain name to allow consumers to purchase Dunlopillo products from their site at a reasonable price. The following products are displayed on the landing page: Dunlopillo Jacquard Cotton pillow; Dunlopillo 3D Airflow Mesh pillow; Dunlopillo Anti Allergy pillow; Dunlopillo Celleste pillow; Dunlopillo Double Comfort pillow; Dunlopillo Latex Wrap pillow; Dunlopillo Serenity Deluxe pillow; Dunlopillo Super Comfort pillow.
- (22) The landing page of the domain has a scrolling banner at the top of the page which displays a number of manufacturers including Dunlopillo. The Complainant has mentioned that some of the brands listed in the scrolling banner, at the foot of the page and also in the backing border of the page "compete directly" with the Steinhoff Group's brand. However, for the Dunlopillo products listed above there is no brand logo which offers competitive products e.g. Hypnos or Healthbeds pillows which are both manufacturers on The Sleep Shop's website. It is understood that Hypnos are displayed in the list at the foot of the landing page however none of the links take the user to an alternative latex pillow.
- (23) The use of the Domain Name has not changed over time and this has been consistent since its registration. It has not been used in any publications or advertising by FGS Furnishings or The Sleep Shop.
- (24) FGS Furnishings have enjoyed a professional relationship with Dunlopillo since 2007. Mark has met with representatives from the company on a regular basis and has also come into contact with Dunlopillo at various furniture and bed shows over a period of time. This relationship has allowed FGS Furnishings to offer products at a reasonable price to the target market, and since they have built on their existing online presence Dunlopillo products rank highly on FGS Furnishings "best sellers" reports.
- (25) As previously stated Dunlopillo products rank highly in the sales reports that FGS Furnishings produce. It is not believed that the Domain Name has caused any damage to the Dunlopillo brand or the Steinhoff Group's business. All pages contain tracking which allows the monitoring of referral traffic. This can be proved with the analytics shown in the appendix which demonstrate the fact that the Domain Names has not produced any referral business from 2009 to date. There is therefore no evidence to support that FGS has gained any unfair advantage.
- (26) If FGS Furnishings has registered a domain name containing a brand name it is ensured that it is done with the knowledge and co-operation of the brand name owner. Although FGS Furnishings own several

domain names, it does not have a history of registration complaints and to date this remains the only one that has been received.

- (27) The owner of the brand at the time the Domain Name was registered was Hilding Anders UK. They were made aware of the registration and were content with its proposed use. The Domain Name was only ever intended to promote and sell Dunlopillo products there has never been any attempt to sell the Domain Name to either Hilding Anders or the Complainant.
- (28) Searches made for Dunlopillo when using relevant search engines do not display the Domain Name in the first 300 results, however dunlopillo.co.uk is the first URL displayed. This proves that FGS Furnishings are not gaining an unfair advantage from the use of the Domain Name nor the use of the Steinhoff name or mark.
- (29) FGS Furnishings or any of The Sleep Shop products are visibly different from both the Dunlopillo name and their online branding, as well as other brands which the Steinhoff group own. Although The Sleep Shop sell beds, mattresses and pillows, it does not sell any latex pillow under its own brand.
- (30) The Respondent's use of the Domain Name has been fair at all times and we have maintained a positive working relationship with Hilding Anders, the previous owners, and with the current owners, the Complainant.
- (31) Upon visiting the website dunlopillopillows.co.uk, each visitor is directed to the landing page of Dunlopillo products within The Sleep Shop website as shown in the annex to the Complaint. The landing page is therefore consistent with the descriptive nature of the Domain Name.
- (32) The Complaint states that the Domain Name has been used in a manner which has taken unfair advantage of the Complainants rights. However, this has not happened because the Domain Name simply shows the Dunlopillo pillows which The Sleep Shop sell. It promotes the Dunlopillo products and does not imply an advantageous relationship with the Complainant. The main reason the Complainant believes that the Domain Name takes unfair advantage of them is because they believe there will be confusion as to who is operating the Domain Name. The Respondent believes that this confusion does not exist.
- (33) The Dunlopillo trade mark is not owned worldwide by either Steinhoff or GT Global Trade marks. The trade Mark is only registered in the UK. Dunlopillo products available in the UK use foam that is no longer manufactured in the UK. The product is assembled using components sourced from America and Europe. The companies producing the foam are not in the ownership of either the Complainant or Steinhoff. The brand is a worldwide brand that is owned by several different entities worldwide.
- (34) The future plans for the Domain Name are for it to continue to promote Dunlopillo products both in store and online.

- (35) Further to recent meetings in January 2016 with David Westcomb and Tony Bryant and a follow-up meeting with the area sales manager for Dunlopillo, FGS Furnishings have plans to further increase the in-store presence of Dunlopillo products. FGS Furnishings is pursuing a policy of making products available both in-store and online to its customers, as it strongly believes that these two media complement each other as opposed to compete.
- (36) The Domain Name cannot be construed as an abusive registration. It was registered before the Complainant acquired the rights to the Dunlopillo trade mark.
- (37) FGS Furnishings has traded and continues to sell Dunlopillo products prior to the Complainant's ownership and remains a stockist of Dunlopillo products with the consent of a Complainant. At no time since 2008 can it be demonstrated that the ownership of this domain name has given FGS Furnishings any unfair advantage or been detrimental to the Complainants rights to the trade mark Dunlopillo.

Reply

The Complainant's submissions in reply are set out below:

- (1) The Complainant has no issue with the Respondent's Sleep Shop website nor the sale on that website of a range of pillows, including those supplied by the Complainant and its competitors. The Complainant takes issue with the use of the Disputed Domain Name, incorporating the Dunlopillo Mark, to direct traffic to that website. This will inevitably lead to sales of competitive products (causing unfair detriment), takes unfair advantage of the Dunlopillo Brand to attract visitors to the Claimant's website and causes confusion among visitors and customers as to the ownership of the Domain Name and relationship between the Complainant and the Respondent.
- (2) The Complainant does not dispute that the Respondent's company is a stockist of the Complainant nor that he was previously a stockist of Hilding Anders for a number of years.
- (3) The Respondent alleges that Sleep Shop's home page and the Landing Page have been 'specifically designed in order that it is clear to the consumer they are buying Dunlopillo products from the Sleep Shop...'. The Respondent does not identify any design elements on the home page or the Landing Page which do this.
- (4) The Respondent repeatedly referred in correspondence to a licence which he had in place with Hilding Anders in relation to its registration and use of the Domain Name. It was clear from this correspondence the Respondent knew that he required a licence to use the Domain Name. Because it never existed, no such licence has been provided by the Respondent, despite

repeated opportunities to provide it (including as part of the Response). To the extent any licence ever existed, such permission to use the Dunlopillo Mark in this way has been terminated.

- (5) The Respondent provides no evidence in support of the contention that the registration of the Domain Name was known or was reported to Hilding Anders or Horatio Myer & Co Ltd ('HMCL'), or later to the Complainant. The Respondent alludes to conversations with Hilding Anders in relation to such a permission but there is nothing substantive to support this. The Complainant has checked with David Wescomb (an individual the Respondent claims was aware of this the Respondent/FGS's ownership and use of the Domain Name) as to whether he was aware of the Respondent's use of the Dunlopillo Mark. Mr Wescomb has said he "was not aware of FGS's claimed ownership of the Dunlopillo Pillow brand until it was raised in autumn 2015 at which point we began discussions with Mark Graves". Furthermore it seems illogical that either Hilding Anders/HMCL or the Complainant would not deal in writing with such valuable and historic intellectual property rights. Equally, had the Respondent believed he had such rights in a domain name incorporating such a well-known trade mark it is strange that he did not secure such rights in writing.
- (6) The Respondent has provided the 'Supplier Terms' of FGS Furnishings signed by HMCL:
 - (a) These terms do not apply to the relationship between the Respondent and the Complainant or the Steinhoff Group. Hilding Anders/HMCL sold certain assets of the Dunlopillo business to the Steinhoff Group in 2013 but this did not include the transfer of agreements with stockists which were expressly excluded from the transfer.
 - (b) These terms have never been provided to the Steinhoff Group and do not apply to their relationship. The Steinhoff Group and the Respondent's companies do business on different terms; and
 - (c) Even if clause 8(A) is in force (and it is denied that it is) such a permission was solely for the 'purpose of promotion of any goods supplied'. The registration and use of Disputed Domain Name by the Complainant goes far beyond any permission Hilding Anders granted and does not extend to the promotion of the Sleep Shop website or the personal use and registration by the Respondent of the Disputed Domain Name. In any event, such a permission would now be terminated.
- (7) The Respondent alleges the Disputed Domain Name is 'descriptive'. The word 'pillows' describes one of the main products sold under the Dunlopillo Mark but the Dunlopillo Mark is distinctive. The Respondent even acknowledges that Dunlopillo is 'one of the most well-known brands that [FGS] have a relationship with' – it is a well-known trade mark. The Respondent expressly acknowledges the Disputed Domain Name was selected to attract customers searching for Dunlopillo products and to use the Dunlopillo Mark to attract further customers.

- (8) The Respondent alleges he has made ‘fair use’ of the Domain Name. The Complainant disagrees as fair use means that such use does not interfere with a rights holder's enjoyment of its rights and certainly does not entail it being used to market competing products. The Complainant has made it clear that it does not want the Respondent to use the Dunlopillo Mark as part of the Domain Name and believes it is entitled to control the commercial use of the Dunlopillo Mark.
- (9) The Respondent flags the Complainant's comment in relation to ownership and control of the Dunlopillo Mark. This is an entirely reasonable aspiration for a rights holder, but the Complainant is under no obligation to register all of the domain names potentially available to it – this would be both extremely expensive and impractical (given the limitless variations of product and brand names available). The Respondent's assertion that the Complainant should have done so (and identification of a number of unregistered domains) is nonsensical and has no bearing on whether the registration is abusive. The Complainant has taken action against other infringers (as flagged in the Complaint) and prioritises those which constitute the greater commercial risk. For example, dunlopillobeds.co.uk is currently not being used by its registrant and is not being used to push traffic to a commercial website marketing competing products as is the case with the Domain Name.
- (10) The Respondent's comment on DRS 3027 (Epson-compatible-ink-cartridges.co.uk) misunderstands the decision (the use of the model numbers in the domain names was not a decisive factor) and does not address the Complainant's point about the decision, being that in Epson the Complainant's mark was used to draw visitors to the Respondent's website (implying a commercial connection beyond what existed) and to sell competing products – as is the case here.
- (11) The Respondent states that FGS uses the Domain Name “to allow customers to purchase Dunlopillo products from their site...” and later that there is no confusion as “the domain name simply shows the Dunlopillo pillows that The Sleep Shop Sells”. This is not true. The Disputed Domain Name is used to direct visitors to the Respondent's website – the Respondent repeatedly mixes up the Domain Name and the website. As stated above, the Complainant has no issue with Respondent's website nor how it sells or presents Dunlopillo or other products – but the Complainant takes issue with the use of the Domain Name, containing the Dunlopillo Mark, to drive traffic to this website. The reason third party products are an issue in respect of the Domain Name is that the Dunlopillo Mark is used to attract consumers to a site where directly competitive products are sold. The automatic redirect makes this similar to having the website content displayed on the Domain Name – which makes the Complaint analogous with the Epson decision.
- (12) The Respondent does not believe the Domain Name has caused any damage to the Complainant. No evidence or explanation is provided for

this belief other than the provision of analytics data. This assertion is problematic because:

- (a) no meaningful explanation of the analytics data is provided, so it is unclear what is being shown. There is a reference to 'referrals' but this is not defined. We assume that this means sales generated within a browsing session - but this is not a reflection of the value derived from the Domain Name as it does not set out the traffic generated by the Domain Name (which is of commercial value in itself), whether goods purchased in subsequent sessions are tracked (and whether they are Dunlopillo products or those of its competitors) or the positive impact on the Respondent's companies by use and association with the Dunlopillo Mark;
 - (b) the clear inference from the Respondent's registration, continued use and response to this Complaint is that the registration of the Domain Name is of commercial value. The Complainant believes this is the case as it enables the Complainant to ride on the coat tails of the Dunlopillo Mark in an unfair way; and
 - (c) damage is not the test as to whether the registration and use of a domain name is abusive. The Complainant believes it meets both of the tests set out in paragraph 2.4 of the Expert Overview on what constitutes unfair advantage and unfair detriment as the Respondent's actions are both 'something morally reprehensible' (the Respondent has acted contrary to the express wishes of the rights holder) and in a way that is similar to trade mark infringement that either 'a gain or a detriment' is required – the Complainant has obtained commercial advantage and confused and misled potential customers as to its identity (as set out in the Complaint).
- (13) The Respondent refers to the page ranking of the Domain Name and quotes a 'Google Approved Partner' as evidence that the Domain Name is hard to find and so there is no confusion. The Respondent has not provided its analytics as to the traffic of the Domain Name, but the Complainant would not expect the traffic generated by the Domain Name to be significant, either through direct entry of the domain into a search engine or natural search. However, it is the Complainant's position that every single visitor to the Sleep Shop website via the Domain Name will have attempted to access the Domain Name on the basis of the Dunlopillo Mark before being redirected. The traffic (and therefore value) generated for the Respondent is reliant upon the confusion (or initial interest confusion) of such visitors. The Respondent's defence of the Complaint demonstrates that the Disputed Domain Name generates sufficient traffic for the investment of time and effort in doing so.
- (14) The Respondent says the Domain Name does not imply an advantageous relationship with the Complainant. The Complainant disagrees as any visitor to the Domain Name will do so on the basis of the 'attractive force' of the Dunlopillo Mark. Use of the Dunlopillo Mark in the

Domain Name implies authorisation by the Complainant which goes beyond that of a mere stockist. The Complainant's many other stockists do not have this advantage and it is clearly of value to the Respondent. It cannot be the case that a rights holder is not able to control the use of its brand by one of its stockists.

- (15) In conclusion the Respondent asserts that the Domain Name is not an abusive registration and that 'it was registered before the Complainant acquired the rights to the Dunlopillo trade mark'. This is plain wrong - the Complainant's rights were purchased from Hilding Anders and substantially pre-date registration of the Domain Name. The Respondent has previously asserted that he had a licence entitling him to register and use the Domain Name – no evidence of such a licence has ever been provided and to the extent there ever was a licence it has been terminated.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

The Complainant is the owner of UK trade mark registrations for DUNLOPILLO, which date back to 1972.

It is also clear that substantial use of the DUNLOPILLO name has been made in the UK, including for pillows, for over 50 years. Such use has been by the Complainant, its predecessors in title, and licensees of both, with the goodwill and consequent rights arising from such use belonging to the Complainant.

Accordingly the Complainant owns legal rights in the DUNLOPILLO name.

Disregarding the generic .co.uk suffix, the Domain Name is very similar to the name in which the Complainant has Rights, the only difference being the addition of the descriptive "pillows" at the end.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The factor under paragraph 3a on which the Complainant relies in this case is as follows:

- "ii. 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 DUNLOPILLO brand is a long-established name in the market of bedding products, including pillows. It seems clear that it is a well-known brand in that market and the Respondent does not dispute this.

It is common ground between the parties that the Respondent's business is an authorised seller of the Complainant's products in the UK.

The Respondent's business, which uses the trading name of The Sleep Shop, also sells bedding products of competitors of the Complainant.

The Domain Name is used by the Respondent in such a way that it automatically re-directs to the Respondent's website at www.thesleepshop.co.uk. More specifically it re-directs to a landing page on that website which depicts a range of (genuine) Dunlopillo pillows. The same landing page lists several other brands of bedding products, including pillows, which can also be purchased on The Sleep Shop's website. Those other brands are competitors of the Complainant.

The key issue in this case is essentially whether or not it is fair for the Respondent to use a domain name to link directly to a website where it sells not only the Complainant's products but also those of the Complainant's competitors, when that domain name consists primarily of the Complainant's mark DUNLOPILLO.

It is important at this point also to note that the only element added to Dunlopillo in the Domain Name is the word "pillows", which is a descriptive term referring to one of the bedding products sold by the Complainant. There is therefore nothing in the Domain Name which serves to indicate that it belongs to, and is being used by a business which is not the Complainant itself. An often cited example would be something along the lines of "weselldunlopillopillows.co.uk".

The Complainant does not object to the Respondent also selling products of its competitors. However, it does object to the Respondent using its DUNLOPILLO

mark as the predominant element of the Domain Name when that domain name automatically takes a user to the Respondent's website where competitors' products are also offered for sale.

In a previous Nominet decision, DRS7991 (toshiba-laptop-battery.co.uk) which had materially similar facts to this case, the Appeal Panel stated as follows:

“if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner’s consent, to accord with the principles ... that fairness is likely to be dependent upon the retailer only selling the trade mark owner’s genuine products. To do otherwise is likely to take unfair advantage of the Complainant’s rights by riding on its coat-tails for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated”.

In the Toshiba case, the respondent had no business relationship with the complainant. In that respect, the facts were different from this case since here the Respondent is an authorised seller of the Complainant's products. However, in my opinion the same reasoning still applies, namely that the Respondent's use of the Domain Name- to direct to a website which also sells competitive products- takes unfair advantage of the Complainant's rights.

This finding of unfair advantage means that the Domain Name is an Abusive Registration as defined in paragraph 1 of the Policy. As such, it does not matter whether or not the Domain Name has been used 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", as set out in paragraph 3a(ii) of the Policy. It is not a requirement that any of the factors in paragraph 3 of the Policy be proved. Paragraph 3 simply sets out factors which may be evidence that a Domain Name is an Abusive Registration. The determining factor is whether the Domain Name is an Abusive Registration, and I have found that it is.

Nevertheless, I should add that, because of the content of the Domain Name, it is reasonable to conclude that at least some people are likely to be confused into believing that the Domain Name is operated by the Complainant. In my opinion, it is likely that at least some people using the Domain Name will do so expecting to reach a website which is operated by the Complainant, when this is not the case. Even if, on reaching the Respondent's website, such people quickly realise that it is not operated by the Complainant, they will have arrived there on the basis of what is known as "initial interest confusion". Having reached the Respondent's website, some such users may remain on the site and some may purchase products which are not those of the Complainant. This means that the Domain Name will have been used to cause an outcome which is often called "bait and switch". That outcome is unfairly detrimental to the rights of the Complainant.

7. Decision

Having found that the Complainant has Rights in respect of a name which is similar to the Domain Name, and that the Domain Name is an Abusive

Registration, the Expert directs that the Domain Name *dunloppillows.co.uk* be transferred to the Complainant.

Signed: Jason Rawkins

Dated: 1 August 2016