

DISPUTE RESOLUTION SERVICE

D00021924

Decision of Independent Expert

Yodeyma Parfums SL

and

Graham Snowden

1. The Parties:

Complainant: Yodeyma Parfums SL
Camino de Noblejas S/N
Dosbarrios
Toledo
45311
Spain

Respondent: Graham Snowden
19d The Browse
Malton
YO17 6AX
United Kingdom

2. The Domain Name:

yodeyma.co.uk

3. Procedural History:

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

03 October 2019 14:57 Dispute received
03 October 2019 15:09 Complaint validated
03 October 2019 15:12 Notification of complaint sent to parties
22 October 2019 02:30 Response reminder sent
24 October 2019 16:38 Response received
24 October 2019 16:38 Notification of response sent to parties
25 October 2019 14:47 Reply received
25 October 2019 14:47 Notification of reply sent to parties
25 October 2019 14:53 Mediator appointed
30 October 2019 17:31 Mediation started
26 November 2019 17:41 Mediation failed
26 November 2019 17:41 Close of mediation documents sent
28 November 2019 16:14 Expert decision payment received

4. Factual Background

The Complainant is the owner of the mark YODEYMA registered, inter alia, as a European Union trade mark since 2014 as a word mark and since 2005 in a stylized form for perfumes and cosmetics. It registered yodeyma.com in 2002 which is used as an active web site.

The Domain Name registered in 2017 purports to offer the Complainant's product, but uses the Complainant's trade mark in the Domain Name as a masthead and does not make it clear that the site is not the genuine site of the Complainant.

5. Parties' Contentions

The Complainant's contentions in the Complaint can be summarised as follows:

The Complainant is the owner of the mark YODEYMA registered, inter alia, as a European Union trade mark since 2014 as a word mark and 2005 in a stylized form for perfumes and cosmetics. It registered yodeyma.com in 2002 which is used as an active web site.

The Domain Name registered in 2017 contains the Complainant's trade mark and is designed to confuse Internet Users into believing that the web site attached to the Domain Name is an official web site as the Respondent is posing as the Complainant.

The Respondent made the following comments by way of a Response:

"We purchased the domain Yodeyma.co.uk almost 2 years ago with the purpose of retailing Yodeyma fragrances. I am surprised this action has been taken now as we have become one of yodeyma.com largest clients and they were obviously aware of our existence. We wish to continue retailing under the yodeyma.co.uk banner and would be happy to discuss the possibility with Yodeyma. It is our intention not to renew the yodeyma.co.uk name which is due shortly"

By way of Reply the Complainant invited the Respondent to transfer the Domain Name to the former.

6. Discussions and Findings

Under Paragraph 2 of the Policy

“2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

Identical or Similar

The Complainant owns the YODEYMA mark which is registered as a trade mark, inter alia, in the UK for perfume and has been registered as a wordmark since 2014 and in a stylized form since 2005.

The Domain Name consists of the Complainant’s YODEYMA trade mark and the ccTLD .co.uk. The suffix .co.uk in the Domain Name does not serve to prevent it being identical to the Complainant’s YODEYMA mark as .co.uk has a generic meaning and is a functional part of a domain name, not a part of any trade mark involved in these proceedings.

The Domain Name is therefore identical to a mark in which the Complainant has Rights under the Policy.

Abusive Registration

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

“a Domain Name which either:

i. was registered or otherwise acquired in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR

ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 5 of the Policy. There being no suggestion that the Respondent has offered to sell the Domain Name, given false contact details, has a pattern of registrations or has a relationship with the Complainant other than as a customer, the only potentially relevant ‘factors’ in paragraph 5 are to be found in subparagraph 5.1.1, 5.1.2 and 5.1.6 which read as follows:

“5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;”

“5.1.2 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;” and

“5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant’s mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.”

It seems from the assertions of the Respondent that it was only concerned with its own commercial activities and it would not have appeared to have intended to block the Complainant from registering the Domain Name or disrupt the Complainant’s business although, in fact, it perhaps has done both. The Domain Name is an exact match for the name in which the Complainant has rights and a reputation. The Respondent has put forward no justification for its registration other than it wanted to sell the Complainant’s genuine products. There is no dispute that it is permitted to sell the Complainant’s genuine products (although there is no evidence whether the products for sale by the Respondent are in fact genuine products of the Complainant). Nevertheless it is not clear from the web site attached to the Domain Name that it is not an official site of the Complainant and the Expert believes that the use made of the Domain Name was more likely than not to confuse people into believing that the Domain Name was registered by or otherwise connected with the Complainant.

Accordingly the Expert is of the opinion on consideration of all the evidence that the Complainant has shown on the balance of probabilities that the Domain Name has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights and that the Domain Name is an Abusive Registration in that there are circumstances indicating that the Respondent is using the Domain Name in a way which 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.

7. Decision

The Expert determines that the Domain Name shall be transferred to the Complainant.

Signed Dawn Osborne

Dated 29 December 2019