

DISPUTE RESOLUTION SERVICE

D00022261

Decision of Independent Expert

Bürstner GmbH

and

United British Caravans Ltd

1. The Parties

Complainant: Bürstner GmbH
Weststr. 33
Kehl
Baden-Württemberg 77694
Germany

Respondent: United British Caravans Ltd
Sandy Lane
Wideopen
Newcastle upon Tyne
NE3 5HE
United Kingdom

2. The Domain Name

<buerstner.co.uk>

3. Procedural History

The Complaint was filed with Nominet on 24 January 2020. Nominet validated the Complaint and notified the Respondent of the Complaint by post and by email on 24 January 2020, informing the Respondent that the due date for submission of a Response was 14 February 2020.

The Response was filed on 13 February 2020. Nominet informed the Complainant that the due date for submission of a Reply was 20 February 2020. The Complainant filed a Reply on 19 February 2020.

The mediator was appointed on 21 February 2020. The informal mediation procedure started on 24 February 2020 but failed to produce an acceptable solution for the Parties and so on 13 March 2020 Nominet informed the Complainant that it had until 27 March 2020 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Policy (the "Policy"). On 20 March 2020, the Complainant paid Nominet the required fee.

On 28 March 2020 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she was independent of each of the Parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed which might be of such a nature as to call in to question her independence in the eyes of one or both of the Parties.

4. Factual Background

The Complainant is a German-based manufacturer of mobile homes and motorhomes, and has been active in the United Kingdom market since 1979. For use in connection with the manufacture and sale of its mobile home and motorhomes, the Complainant has registered, *inter alia*, the following trade marks:

- International Registration No. 1343140, BÜRSTNER, registered on 8 February 2017, designating China, the European Union, Japan, Norway, New Zealand and Switzerland;
- International Registration No. 1431514,  , registered on 9 August 2018, designating the European Union, France, Norway, New Zealand, the Republic of Korea, Switzerland and the United Kingdom; and
- European Union Trade Mark No. 003969144,  , registered on 22 November 2005.

The Complainant is also the owner of the domain name <buerstner.com>, which resolves to the Complainant's main customer-facing website.

The Respondent is a company based in the North-East of England, engaged in the sale of new and used caravans and motorhomes on the United Kingdom market. The Respondent operates a commercial website at "www.unitedbritishcaravans.co.uk" advertising its caravans and motorhomes for sale (the "Respondent's website").

The Domain Name was first registered on 29 October 2007. At the time of filing the Complaint, the Domain Name redirected to the Respondent's website showing listings of the Complainant's mobile homes and motor homes for sale. At the time of this decision, the Domain Name no longer resolves to an active website.

5. Parties' Contentions

5.1. The Complaint

The Complainant asserts registered rights in the BÜRSTNER trade mark. The Complainant notes that the German letter "ü" is written as "ue" in English, and argues that the Domain Name is simply an anglicised form of the Complainant's name and trade mark.

The Complainant submits that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complainant asserts that the Respondent has not been granted any permission or exclusivity by the Complainant in relation to any of the Complainant's BÜRSTNER trade marks. The Complainant states that the Respondent company was briefly an official dealer of the Complainant's products, in approximately 2001, and asserts that the Respondent was therefore aware of the Complainant's company name and trade mark when it registered the Domain Name on 29 October 2007.

The Complainant states that its registration of the domain name <buerstner.uk> was refused on the basis that the Domain Name (<buerstner.co.uk>) was registered in the name of the Respondent. The Complainant submits that the Domain Name is an Abusive Registration as it blocks the legitimate registration of the Domain Name corresponding to the Complainant's trade mark.

The Complainant notes that the Domain Name redirects Internet users to the Respondent's website where the Respondent sells caravans from other suppliers. The Complainant asserts that the Domain Name is being used to syphon off the goodwill generated by the Complainant through the use of its trade mark. The Complainant further argues that the Domain Name is being used to disrupt trade in goods under the Complainant's mark by seeking an unfair advantage and by attracting an unfair proportion of the trade in such goods, to the detriment of the Complainant's other legitimate resellers.

The Complainant further asserts that the Respondent has not used the Domain Name in connection with any genuine offering of goods or services; that the Respondent is not commonly known by the Domain Name; and that the Respondent has not made any legitimate non-commercial or fair use of the Domain Name. The Complainant submits that the Domain Name is not generic or descriptive. The Complainant also asserts that there is no agreement between the Parties providing for the Respondent to hold the Domain Name.

5.2. The Response

The Respondent claims that it acquired the Domain Name "a few years ago". The Respondent explains that it sells caravans and motorhomes, including used Bürstner models, and claims that it acquired the Domain Name for that reason. It states that it holds many domain names for use in the future. The Respondent claims that United British Caravans Ltd did not register the Domain Name, and that the Respondent company was formed in 2006.

The Respondent submits that at no point in time has there been, or at any time in the future will there be, any abuse, infringements of trade marks, or any similar problems. The Respondent asserts that it has never pretended to be the Complainant. Rather,

the search functionality of the Respondent's website allows people who are looking for a Bürstner caravan to find them on the Respondent's website, if it has any.

The Respondent states that it will never try to infringe upon the intellectual property rights of the Complainant, but it does not agree that it should transfer the Domain Name, as it was acquired for a legal purpose.

The Respondent questions why this issue is being raised now, rather than in 2007 when the Domain Name was registered.

The Respondent claims that it has no intentions to make use of the Domain Name to make it seem like it is the Complainant, and asserts that the Domain Name will be used "in the correct manner" to assist the Respondent in its sales of Bürstner caravans and motorhomes in the future. The Respondent contends that it holds the Domain Name so that it can use it – not so that the Complainant cannot. The Respondent argues that the Domain Name will not disrupt the Complainant's business, as the Complainant already has a website for the United Kingdom at "www.buerstner.com/uk/home/".

5.3. The Reply

The Complainant asserts that it is clear from the Response that the Respondent knows of the Complainant and of the Complainant's trade mark rights. The Complainant submits that the Respondent admits to not having used the Domain Name, despite having owned it for more than 12 years. The Complainant further argues that the Domain Name is serving to block the legitimate registration of a domain name corresponding to the Complainant's trade mark.

The Complainant refutes the Respondent's assertion that United British Caravans Ltd was never a Bürstner dealer and that it was not formed until 2006, referring to the Respondent's website which states that the Respondent has been in existence since 1938. The Complainant notes that the Respondent company was incorporated in 2006, which it claims is consistent with the Complainant's claim that United British Caravans was, briefly, an official dealer of the Complainant in approximately 2001.

The Complainant submits that the Respondent has failed to provide any legitimate reason for its ownership of the Domain Name, and that the Respondent has not made any use of the Domain Name in 12 years.

The Complainant further submits that if the Domain Name redirects Internet users to the Respondent's website, this has the effect of syphoning off purchasers seeking the Complainant's website and products to the Respondent's website, which sells other brands of caravans.

6. Discussions and Findings

Under paragraph 2.1 of the Policy, for the Expert to order transfer of the Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

- "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."

Paragraph 18.1 of the Policy provides:

"The Expert will decide a complaint on the basis of the Parties' submissions and this Policy. It is the Parties' responsibility to explain all the relevant background facts and other circumstances applicable to the dispute in their submissions, and to support those submissions with appropriate evidence. In the ordinary course an Expert will not perform any research into a dispute or check the parties' assertions, however an Expert may (in their entire discretion) check any material which is generally available in the public domain."

6.1. The Complainant's Rights

The Expert finds that the Complainant has established "Rights" in the trade mark BÜRSTNER in light of its registration and international use, the details of which are provided in the factual-background section above. The Complainant's trade marks afford the Complainant protection internationally, including in the United Kingdom.

The Domain Name incorporates the Complainant's BÜRSTNER trade mark in its entirety, altered only by replacing the letter "ü" with the letters "ue", under the ".co.uk" suffix. The Expert notes that the letter "ü" with an umlaut diacritic is often replaced with the two-letter combination "ue" in languages that do not have that letter as part of its regular alphabet. This is also common practice in non-internationalised domain names, which make use of a limited ASCII character set that does not include the letter "ü" (as is the case for the Complainant's official domain name <buerstner.com>). The resulting impression is one of close visual and phonetic similarity between the Domain Name and the Complainant's trade mark.

The Expert finds the Domain Name to be similar to the Complainant's trade mark. Accordingly, the Complainant has satisfied the requirements of paragraph 2.1.1 of the Policy.

6.2. Abusive Registration

An "Abusive Registration" is defined in the Policy 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

The Expert notes that neither the Complainant nor the Respondent has submitted clear or comprehensive evidence in support of its use or non-use of the Domain Name. The Expert has therefore undertaken limited review of publicly-available historic screen captures of the website associated with the Domain Name in accordance with the discretionary powers afforded to the Expert under paragraph 18.1 of the Policy.

The Expert notes that as recently as 28 February 2020, the Domain Name was configured in such a way that Internet users seeking to access the Domain Name would be redirected to the Respondent's website which would return the search results for the term "burstner", presumably in order to show which Bürstner-branded items in the Respondent's inventory were offered for sale at that time.

The Expert notes that the Respondent's predecessor-in-interest appears to have been, for a brief time several years before the registration of the Domain Name, a reseller of the Complainant's products; however, there is no suggestion from either Party that such an arrangement presently exists.

Prior experts issuing decisions under the Policy have recognised that resellers, including unauthorised resellers, may have a legitimate interest in a domain name comprising a third-party trade mark, provided that certain conditions are met. See *Toshiba Corporation v. Power Battery Inc* (Appeal Decision DRS 07991) <toshiba-laptop-battery.co.uk>:

- "1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of 'initial interest confusion' and is not dictated only by the content of the website.
4. 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."

As noted above, the Domain Name comprises an anglicised version of the Complainant's trade mark. In terms of the Domain Name itself, there are no other additional elements in the Domain Name that may otherwise indicate to Internet users that the Domain Name is not affiliated with the Complainant. As a result, the Expert considers that Internet users are likely to believe that the Domain Name is operated or otherwise affiliated with the Complainant. Such a risk of confusion is affirmed by the Complainant hosting its official website at the domain name <buerstner.com>, whose second level "buerstner" corresponds identically to the third level of the Domain Name. The Expert is of the view that the Domain Name itself creates initial interest confusion with the Complainant's trade mark.

The Expert further notes that the Domain Name has been used to redirect Internet users to the Respondent's website where new and used caravans and mobile homes are offered for sale. The redirection of Internet users in such a manner creates a misleading impression that the Respondent is an authorised dealer or reseller of the Complainant's products. The Expert does not accept the Respondent's assertion that "there is no disruption or syphoning off of any goodwill" or that the Respondent has "never and will never pretend to be Bürstner", as such redirection has the precise effect of rerouting customers searching for the Complainant as a result of confusion as to the source of the goods offered on, and the affiliation of, the Respondent's website. Furthermore, the Respondent's website also offers caravans from the

Complainant's competitors, which may have the effect of diverting customers away from the Complainant's products.

Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. The Expert finds that the circumstances of the present case indicate that the Respondent has used the Domain Name in a way that has confused or is likely to confuse Internet users into believing that the Domain Name is registered, operated or authorised by, or otherwise connected with the Complainant, as contemplated by paragraph 5.1.2 of the Policy.

Noting that there is no time limit for bringing a proceeding under the Policy, the Expert does not consider the delay between the date of registration and the filing of the Complainant to have any substantive impact on the Expert's findings above.

For reasons set out above, the Expert finds that the Domain Name in the hands of the Respondent is an Abusive Registration, as it has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. The Complainant has satisfied the requirements of paragraph 2.1.2 of the Policy.

7. Decision

The Complainant has Rights in a name or mark which is identical or similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name should therefore be transferred to the Complainant.

Jane Seager
22 April 2020