

## **DISPUTE RESOLUTION SERVICE**

**D00022979**

### **Decision of Independent Expert**

**B.S.A.**

and

**Zhao Ke**

#### **1. The Parties**

Complainant: B.S.A.

33 Avenue du Maine Tour Maine Montparnasse  
75015 Paris  
France

Respondent: Zhao Ke

Shanghai  
China

#### **2. The Domain Name**

presidentcheese.co.uk (“the Domain Name”)

### **3. Procedural History**

Nominet checked that the complaint received on 7 September 2020 complied with its UK Dispute Resolution Service (“DRS”) Policy (“the Policy”), before notifying the Respondent and inviting a response. No response had been received by 30 September, so Nominet told both parties that mediation would not be possible and that the Complainant had the option of paying a fee to appoint an independent expert to decide the dispute. Nominet received that fee on 12 October.

On the same day I, Mark de Brunner, agreed to serve as an expert under the Policy. I 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 such a nature as to call into question my independence in the eyes of one or both of the parties.

### **4. Factual Background**

I have viewed the web page to which the Domain Name currently resolves and carried out a Whois lookup. From that limited research, the complaint and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant, part of the Lactalis Group, is a French company, created in 1933, that makes and sells dairy products. It is the world's largest dairy company, with 266 production sites in 51 countries, more than 85,000 employees and a turnover of 20 billion euros.

It has been marketing its dairy products under the PRESIDENT name since at least 1968 and products bearing the name are available in more than 150 countries. It holds numerous UK and international trade mark registrations for the word PRESIDENT with applications dating back to at least 1976. It also has a large number of domain names made up of or including the word PRESIDENT.

There is little information available to me about the Respondent. The Domain Name was registered in April 2016. It resolves to a page of web links which appear to change but which at the time of checking mostly contained references to cheese and opportunities to buy cheese online.

### **5. Parties’ Contentions**

#### *Complaint*

The Complainant says it has rights in a name that is similar to the Domain Name.

It argues that the Domain Name is an abusive registration because:

1. the Respondent has no rights or legitimate interest in the name reflected in the Domain Name. In particular, the Respondent does not appear to be commonly associated with the word PRESIDENT and the Complainant has not authorised use of the Domain Name by the Respondent. The Domain Name is not used in connection with a bona fide offering of goods or services and there is no evidence of legitimate non-commercial fair use.
2. the disputed domain name disrupts the Complainant's business and causes harm to the Complainant's brand image.
3. the Domain Name is potentially confusing for internet users. Mail servers have been configured to operate with the Domain Name, creating a risk that the Respondent may be aiming to deceive internet users and make them believe they are dealing with the Complainant.
4. the Domain Name has been registered and is being used in bad faith. The Complainant's own trade marks and domain names were filed before the registration of the Domain Name, so the Respondent must have known of the Complainant and had the Complainant in mind when registering the Domain Name. In addition, the domain name has been put up for sale by its owner, proving this to be a case of cybersquatting.

*Response*

There has been no response.

## 6. Discussion and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it has rights in respect of a name or mark which is identical or similar to the Domain Name; and that
- the Domain Name, in the hands of the Respondent, is an abusive registration.

### *Rights*

Alongside its trade mark registrations, the Complainant has clearly built up significant goodwill in PRESIDENT. It has therefore established both unregistered and registered rights in the name.

The Domain Name consists of the word in which the Complainant has rights plus the word CHEESE. Taken together, that combines the Complainant's trade mark with one of the main products it sells under that mark. Ignoring the generic country code top-level domain <co.uk> for this purpose, I accept that the Complainant has rights in respect of a name or mark which is similar to the Domain Name.

### *Registration*

As defined by the Policy, an abusive registration is a domain name which:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.

The Complainant's case is essentially that the Respondent has no legitimate reason for registering the Domain Name, that its use of the Domain Name is potentially disruptive and confusing and that the registration has been made in bad faith. I can take those arguments in turn.

### No legitimate interest in the name

There is certainly no evidence before me of the Respondent's interest in the name PRESIDENT, beyond its use as a hook to attract interest in online links associated

with cheese. Of course the nature of that use has a bearing on the character of the registration that I am invited to assess, and I draw conclusions about that use below.

### Potential disruption and confusion

I agree that there is very significant potential, from both registration and use of the Domain Name, for disruption to the Complainant's business, including that caused by confusion. The *Experts' Overview* (paragraph 3.3) says (*my emphasis*):

“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose. In such cases, 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.*

“Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)...The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. *However...generally condemned [are the activities of] those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity.*

*“Another potential for confusion...is the use of a domain name for the purposes of email.”*

This seems to me to reflect the position here precisely. The Respondent is using goodwill in the brand that the Complainant has built up in order to attract interest and turn it to its own commercial advantage.

It is worth acknowledging that the Policy (paragraph 8.5) says

sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:

- the nature of the Domain Name;
- the nature of the advertising links on any parking page associated with the Domain Name; and
- that the use of the Domain Name is ultimately the Respondent's responsibility.

Here most of links on the parking page appear to lead to opportunities to buy cheese and presumably at least some of them will involve competitors of the Complainant, adding weight to the claim that use of the Domain Name is potentially disruptive to the Complainant's business.

#### Bad faith and cybersquatting

Under the DRS Policy, there is no requirement to establish bad faith when attempting to show that a domain name is an abusive registration: a registration can be abusive without bad faith. On the other hand, the Policy makes clear (paragraph 8.4) that

Trading in domain names for profit...[is of itself a] lawful activit[y]. The Expert will review each case on its merits.

So the mere fact that the Domain Name is offered for sale is not conclusive of the character of the registration. But that character already seems to me to be clear. The Respondent decided on the Domain Name with the Complainant and its brand in mind, looking to take advantage of the reputation that the Complainant has built up in that brand, in a way that can only be unfair.

My answer to the key underlying question is therefore that, in both registration and use of the Domain Name, the Respondent took or is taking unfair advantage of the Complainant's rights.

## **7. Decision**

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an abusive registration.

I therefore direct that the Domain Name be transferred to the Complainant.

**Mark de Brunner**

**20 October 2020**