

**Note inserted by Nominet – September 2006:**

In July 2006 the Respondent, Michael Toth, made a formal complaint regarding the handling of certain aspects of this case. Mr Toth felt that these shortcomings unintentionally restricted his ability to put in a fully evidenced Response to the allegations.

As a result of an investigation, Nominet has upheld a key element of the customer complaint relating to the quality of customer service, which Nominet accepts fell short of the level that Nominet would usually provide. Nominet has therefore apologised to Mr Toth. Nominet has also instigated a full internal investigation into the handling of this case by our employees.

It is only fair to Mr Toth to point out that the Experts did not have the opportunity (for whatever reason) of seeing evidence in a Response from him - either on the topic of whether the domain name was generic or descriptive; or on his reasons for registration and later use. Those wishing to rely on these decisions in future are reminded that their value may therefore be limited.

At the request of Mr Toth, Nominet has agreed to write to all Dispute Resolution Service (DRS) experts and notify them of the existence of the above statement.

The matter has now been resolved to the satisfaction of both Mr Toth and Nominet.

## **Nominet UK Dispute Resolution Service**

**DRS 03316**

**The Procter & Gamble Company -v- Michael Toth**

### **Decision of Independent Expert**

**a. Parties**

Complainant: The Procter & Gamble Company  
Address: One Procter & Gamble Plaza  
Cincinnati  
Ohio  
Postcode: 45202  
Country: US

Respondent: Michael Toth  
Address: PO Box 773, TC-437  
Providenciales  
Turks & Caicos Islands  
Postcode:  
Country: TC

## **b. Domain Name**

bounce.co.uk (the “Domain Name”)

## **c. Procedural Background**

The Complaint was lodged with Nominet on 24 January 2006 and Nominet notified the Respondent of the validated Complaint on 25 January 2006. The Respondent did not respond to the Complaint and Nominet so informed the Complainant on 21 February 2006. Informal mediation not being possible in these circumstances, the Complainant paid Nominet the appropriate fee on 1 March 2006 for a decision of an Expert, pursuant to §7 of the Nominet UK Dispute Resolution Service Policy (the “Policy”).

Steve Ormand, the undersigned, (the “Expert”) confirmed to Nominet on 2 March 2006, that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties that might appear to call into question his independence and/or impartiality.

## **d. Procedural Issues**

There is no evidence before the Expert to indicate the presence of exceptional circumstances that prevented the Respondent from submitting a response to Nominet within the required time period; accordingly, the Expert will now proceed to a Decision on the Complaint in accordance with §15b of the Nominet UK Dispute Resolution Procedure (the “Procedure”).

## **e. The Facts**

### **Complainant**

The Complainant is a large multi-national company that operates in a number of markets worldwide including detergents and fabric care products. One such product is sold in the UK under the brand name BOUNCE.

The Complainant has held a European Community trade mark registration for BOUNCE since 1998 and the Complainant’s UK subsidiary, Procter & Gamble Limited, holds UK trade marks for BOUNCE dating back to 1961.

### **Respondent**

The Respondent registered the Domain Name on 31 October 2001.

## **f. The Parties’ Contentions**

### **Complainant**

*The Complaint*

The Complainant’s assertions are:

1. That the Domain Name is identical to the mark, BOUNCE in which the Complainant has Rights (as defined in §1 of the Policy) because:
  - a. The Complainant is (by their subsidiary Procter & Gamble Limited) the proprietor of the trade mark BOUNCE which is used in the UK and in the USA in respect of a range of fabric care products.
  - b. The Complainant registered BOUNCE as a trade mark before the UK Trade Marks Registry, the Community Trade Marks Office and other countries around the world, including the USA (evidence is provided of the Complainant's UK and Community Trade Mark registrations). Although one of the BOUNCE trade marks contains a device element, the word BOUNCE appears prominently in each of the three trade marks. The earliest of these marks dates back to 1961 (UK registration no. 824136).
  - c. The Complainant has built up a very substantial goodwill and reputation in the BOUNCE name, as a result of the use it has made of this trade mark in the UK since 1982 (evidence is provided of the BOUNCE range of products which are available in the UK and the USA).
  - d. The Complainant has spent substantial sums on advertising BOUNCE products in the UK, including television, radio and print advertisements. According to the MMS public tracking service (AC Nielsen Media Monitoring Services), the media spend for BOUNCE is recorded at £9,799 for the fiscal year 03/04 and £23,542 for the fiscal year 04/05.
  - e. In previous years, BOUNCE has been advertised during 10 second indents sponsoring the weather reports on GMTV for 6 months of each year. Weather Sponsorship cost £300m in fiscal year 04/05, £287m in 03/04, £270m in 02/03, and £560m in 01/02.
  - f. Sales of the Complainant's BOUNCE products have been extremely successful. These products are widely available throughout the UK in supermarkets, convenience stores and general stores. There is between 60 and 70 per cent distribution across all supermarkets, hypermarkets and cash and carry's. BOUNCE represents about 3-4 per cent of the market share of the total fabric conditioner market (i.e. both liquids and sheet conditioners) and is the market leader of the sheets market. The total sheets market is about 6-7 per cent of the total fabric conditioners, so BOUNCE represents about 50-60 per cent of the market share of sheet conditioners.
2. That the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in §1 of the Policy) because:
  - a. There is to the Complainant's knowledge no prior relationship between the Respondent and Complainant or its subsidiary, Procter & Gamble Limited.
  - b. The Complainant wrote to the Respondent on 27 September 2005 (copy provided) to the address then provided on Nominet's WHOIS information asking for the voluntary transfer of the Domain Name to the Complainant. The letter confirmed that the Complainant would be prepared to compensate the Respondent for registration and maintenance of the Domain Name up to this date. The letter was returned marked "address unknown". The Complainant discovered the Respondent's email address and re-sent this letter by email on 28 October 2005. The Complainant received no response.

- c. It is clear that the Complainant and its subsidiary Procter & Gamble Limited have established substantial goodwill and reputation by over 20 years use of the BOUNCE brand in the UK. The Complainant has pertinent trade mark registrations and has made substantial sales of BOUNCE products in the UK.
- d. Considering the extent of these sales and considerable advertisements of the BOUNCE products, it is believed that the Respondent must have been aware that the name BOUNCE denoted the Complainant's products and trade mark. Thus, the Domain Name was registered primarily to stop the Complainant registering the Domain Name to reflect its trade mark rights and legitimate business interests.
- e. The Domain Name presently redirects to the website [unitedkingdom.co.uk](http://unitedkingdom.co.uk) and is classified as an online shopping web directory. This site gives no reason as to why the name BOUNCE should have been chosen as the Domain Name (screen dumps of the website provided).
- f. It is believed that the Respondent has engaged in a pattern of such behaviour, evidenced by the fact that the Respondent presently holds 2793 .co.uk domains, many of which appear to correspond to the trade mark rights of third parties. Examples include [dylanthomas.co.uk](http://dylanthomas.co.uk), [backstreetboys.co.uk](http://backstreetboys.co.uk), [starlightexpress.co.uk](http://starlightexpress.co.uk), [wimpy.co.uk](http://wimpy.co.uk), [georgebest.co.uk](http://georgebest.co.uk), [garfield.co.uk](http://garfield.co.uk), [astonmartins.co.uk](http://astonmartins.co.uk), [rangerovers.co.uk](http://rangerovers.co.uk), [lotussportscars.co.uk](http://lotussportscars.co.uk), [alfaromeos.co.uk](http://alfaromeos.co.uk), [lamborghinis.co.uk](http://lamborghinis.co.uk), [volvos.co.uk](http://volvos.co.uk), [vauxhalls.co.uk](http://vauxhalls.co.uk), [stanstedairport.co.uk](http://stanstedairport.co.uk), [hondas.co.uk](http://hondas.co.uk) and [agassi.co.uk](http://agassi.co.uk) (evidence is provided of these domain names, and others, being registered to a Michael Toth).
- g. A previous decision was made against the Respondent in 2003, ordering the transfer of the website [universityoflondon.co.uk](http://universityoflondon.co.uk) to the lawful owner of that name (DRS 1740).
- h. The Respondent has established no legitimate interest under the Domain Name and appears to have engaged in a passing off of registering domain names that correspond to the trade mark rights of third parties. This evidences Abusive Registration. The Complainant believes that registration of the Domain Name is detrimental to it by preventing it from establishing legitimate websites under the Domain Name reflecting its established business activities in the BOUNCE name in the UK.

## **Respondent**

The Respondent has not submitted a Response.

## **g. Discussion and Findings**

### **General**

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

1. it has Rights in respect of a name or mark identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

## **Complainant's Rights**

The wholly generic domain suffix “.co.uk” is discounted for the purposes of establishing whether the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

Rights is defined in §1 of the Policy as including, but not limited to, rights enforceable under English law, but a Complainant may not rely on rights in a name or term that is wholly descriptive of the Complainant's business.

The Complainant relies on its evidenced European Community trade mark and UK trade marks, the latter held by its UK subsidiary Procter & Gamble Ltd, and goodwill in the name BOUNCE. The UK trade marks are registered to a legal entity that is not a party to the Complaint, but in this case it is not fatal to the Complainant because of the other evidence presented. The Complainant's attention is drawn to §3b of the Procedure for future reference.

Although the name is a verb or noun in common use, the name is not wholly descriptive of the Complainant's business, and the Complainant has clearly established substantial goodwill in the name BOUNCE in the detergents and fabric care products markets in the UK. It is noted that there are registrants of the name in other classes in the UK and the European Community.

The Expert finds that the Complainant has, for the purposes of the first limb of the test pursuant to §2 of the Policy, established rights in the name BOUNCE which is identical to the Domain Name.

## **Abusive Registration**

The Complainant's assertion of no prior relationship with the Respondent and the fact that the Respondent has not responded to its letters asking to transfer the Domain Name do not evidence Abusive Registration per se.

The Complainant asserts that the Respondent must have been aware that the name BOUNCE denoted the Complainant's products and trade mark and the Domain Name was thus registered primarily as a blocking registration, which is evidence of Abusive Registration under §3a i B of the Policy. The Complainant has a difficulty here in that there is no evidence of the Respondent's awareness of the Complainant's mark and products or his purpose in registering the Domain Name. The test developed in DRS 00292 (chivasbrothers.co.uk) does not help. The test states that where a respondent registers a domain name:

1. which is identical to a name in respect of which the complainant has rights; and
2. where that name is exclusively referable to the complainant; and
3. where there is no obvious justification for the respondent having adopted that name for the domain name; and
4. where the respondent has come forward with no explanation for having selected the domain name

it will ordinarily be reasonable for an expert to infer first that the respondent registered the domain name for a purpose and secondly that that purpose was abusive.

1 and 4 are satisfied, but there is difficulty with 2 in that the name is not exclusively referable to the Complainant given the registration of the same name in other classes by other persons and its use for other products outside of the detergents and fabric conditioner market. Further, in respect of 3, whilst justification for the Respondent having adopted the name for the

Domain Name is perhaps not obvious, it is possible, nevertheless, given its everyday use as a verb or noun, that the Respondent did register the Domain Name with a legitimate use in mind.

The Complainant also asserts that the Respondent has engaged in a pattern of behaviour contrary to §3 a iii of the Policy as the registrant of domain names which correspond to well known names or trade marks in which he has no apparent rights, and the Domain Name is part of that pattern. The Complainant cites several examples and provides evidence of registration by a Michael Toth. These are:

1. dylanthomas.co.uk
2. backstreetboys.co.uk
3. starlightexpress.co.uk
4. wimpy.co.uk
5. georgebest.co.uk
6. conservative-party.co.uk
7. garfield.co.uk
8. astonmartins.co.uk
9. rangerovers.co.uk
10. lotussportscars.co.uk
11. alfaromeos.co.uk
12. lamborghinis.co.uk
13. volvos.co.uk
14. vauxhalls.co.uk
15. stansteadairport.co.uk
16. hondas.co.uk
17. derbycountyfc.co.uk
18. englandfc.co.uk
19. agassi.co.uk

The evidence does not provide an address for the registrant and is not conclusive that it is the same person as the Respondent in this Complaint. Further investigation of these domain names reveals that all are registered to Michael Toth and the registrant's agent is Mr Michael Toth t/a Gooseberry Internet [Tag = GOOSEBERRY]. The Domain Name and all the above domain names, except stansteadairport.co.uk and englandfc.co.uk, resolve to unitedkingdom.co.uk, which is also registered to Michael Toth and the registrant's agent is Mr Michael Toth t/a Gooseberry Internet [Tag = GOOSEBERRY]. Finally, the Domain Name is registered to Michael Toth and the registrant's agent is Mr Michael Toth t/a Gooseberry Internet [Tag = GOOSEBERRY].

Given the registration evidence, and the lack of a response from the Respondent, the Expert considers that it is probable that the same Michael Toth has registered the Domain Name, the domain names listed above and operates or has some connection with the unitedkingdom.co.uk website. Thus, the Complainant has demonstrated that the Respondent is engaged in a pattern of registrations of domain names which correspond to well known marks (or marks that save for the addition of a plural 's' are so similar to well known marks that the first limb of the test for Rights in a name would be satisfied) in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

The Complainant has also referenced the decision in DRS 01740, which was made against the Respondent. Although a different address is quoted in that decision it corresponds with an address given for Michael Toth as the administration contact in this Complaint. However, there is no evidence of the Respondent having been found to have made the requisite 3 or more Abusive Registrations in the last 2 years prior to the Complaint to establish the presumption of Abusive Registration in this Complaint under §3 c of the Policy.

*Conclusion*

The Expert finds on the balance of probabilities that the Respondent has registered the Domain Name for purposes which take unfair advantage of and are unfairly detrimental to the Complainant's Rights, which is an Abusive Registration in contravention of the Policy.

**h. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in respect of a name which is identical to the Domain Name and the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, bounce.co.uk, be transferred to the Complainant.

**Signed:** \_\_\_\_\_

**Steve Ormand**

**Date:** 20 March 2006