

ADMINISTRATIVE PANEL DECISION

Imperative Training Ltd. T/A defibshop.co.uk v. Adam Walton,
Pura Technologies Limited
Case No. D2023-4201

1. The Parties

The Complainant is Imperative Training Ltd. T/A defibshop.co.uk, United Kingdom, represented by MLP Law Ltd, United Kingdom.

The Respondent is Adam Walton, Pura Technologies Limited, United Kingdom, represented by Barker Brettell LLP, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <defibshop.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (VIVEST) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on October 20, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2023. Following an extension of time granted to the Respondent, the Response was filed with the Center on November 18, 2023.

The Center appointed Steven A. Maier as the sole panelist in this matter on December 5, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a private limited company located in Manchester, United Kingdom. It is a supplier of defibrillators and related products and services.

The Complainant is the owner of United Kingdom trademark registration number 908306656 for the mark DEFIBSHOP.CO.UK, registered on March 29, 2010 in International Classes 10 and 35. The mark comprises the term “DEFIBSHOP” in stylized lower case text, coloured red, with the term “.CO.UK” included in significantly smaller text and superimposed upon a “heart” logo to the right of the main text.

The Complainant operates a website at “www.defibshop.co.uk”, which prominently features the trademark referred to above. The Panel notes that “www.archive.org” includes archived captures of the website at “www.defibshop.co.uk” displaying the Complainant’s DEFIBSHOP.CO.UK logo since 2006.

The disputed domain name was created on June 16, 2021. Based on the Panel’s own review via “www.archive.org” it appears that an almost identical domain name was operated by an entity trading from the URL “www.defibshop.com.au” until at least August 24, 2019. The Respondent describes this entity as a third party.

The disputed domain name has resolved to a website at “vivist-aed.co.uk” which promotes a range of defibrillators branded “Vivest”. The website provides a street address in Derbyshire, United Kingdom, but it does not appear to identify the relevant trading entity.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain name is identical or confusingly similar to its trademark DEFIBSHOP.CO.UK.

The Complainant states that it has used its trademark DEFIBSHOP.CO.UK since 2014 and has established goodwill relating to that trademark. It exhibits in this regard what appear to be brief customer reviews and a “Certificate” provided by a website named “eKomi – The Feedback Company”.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It contends in particular that the Respondent has not been commonly known by, nor acquired any trademark rights in respect of, the disputed domain name.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith. It contends that the disputed domain name was registered primarily for the purpose of disrupting the business of the Complainant, and/or that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent submits that the Complainant's trademark relates primarily to a figurative device trademark but concedes that both the trademark and the disputed domain name include the term "defibshop".

The Respondent challenges the reputation of the Complainant's trademark and questions the status of the "eKomi" website.

The Respondent contends that, under United Kingdom trademark law, the Complainant could not have registered a trademark for the term "defibshop" alone. It states that any such mark would be devoid of distinctive character, as combining the descriptive terms "defib" and "shop". The Respondent provides evidence that its own application for a United Kingdom trademark for the mark DEFIBSHOP.COM, (filed on October 23, 2023) was refused on this basis and as constituting a description of services as opposed to a badge of origin.

The Respondent submits, in the circumstances, that the Complainant is not entitled to prevent third parties, including the Respondent, from using the term "defibshop" as an accurate term for a shop that sells defibrillator products. It refers to the "www.defibshop.com.au" business as an example of another trader legitimately using the term in that manner.

The Respondent denies that the disputed domain name was registered or is being used in bad faith. It states that the Complainant has made serious allegations in this regard without providing any evidence in support.

The Respondent states that registering the disputed domain name "... had nothing to do with the Complainant".

The Respondent contends that it has used the disputed domain name as a descriptive term for the products which it has continuously offered. It states that it is a United Kingdom distributor for a defibrillator company named Cardia International and exhibits a letter from that company stating that it is the manufacturer of "CardiAid Automated Exchange Defibrillators" and that the Respondent has been its exclusive United Kingdom distributor for those products since 2017.

The Respondent adds that the owner of the business branded as "Vivest" is a company named Invictus Global Limited. The Respondent states that a Mr. Mark Roberts is a director of both the Respondent and that company and that the entities are therefore inter-related.

The Respondent denies that there is any likelihood of confusion between the "Vivest" website and the Complainant's business. It contends that even if the disputed domain name gave rise to a likelihood of confusion, which it denies, any such confusion would immediately be dispelled upon reaching the "Vivest" website.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of registered trademark rights for the mark DEFIBSHOP.CO.UK. While the trademark is figurative in nature, the Panel finds that the textual term “defibshop” constitutes the dominant element of the trademark. The disputed domain name wholly incorporates that term, and the Panel finds in the circumstances that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent submits that it has rights or legitimate interests in the disputed domain name by virtue of using it in a wholly descriptive manner for the supply of defibrillator products. It also contends that, as a matter of United Kingdom trademark law, the Complainant cannot prevent another party from using the non-distinctive term “defibshop”.

The Panel’s first observation in this regard is that proceedings under the UDRP are determined under the terms of the Policy and not by reference to any national trademark laws. In particular, as discussed in paragraph 2.10 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)):

“Does a respondent have rights or legitimate interests in a domain name comprised of a dictionary word/phrase or acronym?[...]”

Panels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent; panels have held that mere arguments that a domain name corresponds to a dictionary term/phrase will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights.”

The question for the Panel, therefore, is whether the Respondent registered the disputed domain name for legitimate business purposes, or alternatively, in order to take unfair advantage of the Complainant’s goodwill in its trademark.

Concerning the Respondent’s use of the disputed domain name, it submits that it is the exclusive United Kingdom distributor for “CardiAid” defibrillator products and provides evidence to that effect. However, the website to which the disputed domain name resolves neither offers, nor makes reference, to any “CardiAid” products and is concerned exclusively with “Vivest” branded goods. Moreover, based on the Panel’s own limited research, the official website for “CardiAid” products in the United Kingdom is located at “cardiaid-aed.co.uk”. It is therefore unclear to the Panel what relevance the “CardiAid” products may have to this proceeding. Furthermore, the disputed domain name reproduces in its entirety the term “defibshop”, which is different to the terms “CardiAid” or “Vivest”.

So far as the “Vivest” website is concerned, the Panel notes first that this is operated not by the Respondent, but by another legal entity with which the Respondent claims to be associated. Leaving this issue to one side, the disputed domain name is used entirely for the purpose of redirection to the website at “www.vivest-aed.co.uk”, and the Panel has seen no evidence of the use of the term “defibshop” to identify this business as a trading name or style, or otherwise in connection with it.

In addition, the Panel notes that both Parties seem to be located, or at least with an address, in the United Kingdom, and that both Parties are operating within the same business field.

In the circumstances, the Panel infers on balance that the Respondent is likely to have registered the disputed domain name opportunistically to take unfair advantage of the Complainant’s trademark, rather than primarily for purpose of a business operating by reference to the disputed domain name. Under the terms

and application of the Policy, the fact that the disputed domain name may (arguably) be comprised of two “dictionary” terms does not invest the Respondent with rights or legitimate interests in circumstances where it has sought to target the Complainant’s trademark.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

In order to establish registration of the disputed domain name in bad faith, the Complainant must establish that the Respondent was aware of the Complainant’s trademark at the time the disputed domain name was registered or otherwise acquired. In this regard, the Respondent challenges the reputation of the Complainant’s trademark and states that the registration of the disputed domain name “... had nothing to do with the Complainant”. However, this does not amount to a denial that the Respondent was aware of the Complainant’s trademark and indeed, given that both the Complainant and the Respondent operate in a specialist field of business within a similar geographical region, the Panel would find it remarkable if the Respondent had not been aware of the Complainant and its trademark.

The Panel’s remaining considerations on the issue of bad faith are largely aligned with its findings in respect of rights or legitimate interests above. The Respondent provides no compelling reason why it chose and has used the disputed domain name for the sole purpose of redirecting to the “Vivest” website, particularly in circumstances where that website makes no use of, or reference to, the disputed domain name. The Panel infers in the circumstances that the Respondent is likely to have found the disputed domain name to be available, and decided to register and use it competitively with the Complainant’s trademark and business name; in other words, to target the Complainant’s trademark. It does not avail the Respondent in these circumstances that the term “defibshop” may be comprised of dictionary terms and/or may not be registrable on its own as a United Kingdom trademark.

The Panel therefore accepts the Complainant’s submissions that the Respondent is likely to have registered the disputed domain name to disrupt the business of the Complainant and/or to attract Internet users to the “Vivest” website by creating a likelihood of confusion with the Complainant’s trademark (paragraphs 4(b)(iii) and 4(b)(iv) of the Policy respectively). In the latter case, the Respondent will already have gained an unfair commercial advantage when Internet users arrive at the “Vivest” website, and it is not therefore material (as the Respondent argues) that such users may realise, at that time, that it is in fact unconnected with the Complainant.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <defibshop.com>, be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: December 19, 2023