

## **Nominet UK Dispute Resolution Service**

**DRS 25169**

**S.J. Electro Systems, Inc. v Alton Pumps**

### **Decision of Independent Expert**

#### **1. Parties**

Complainant:

S.J. Electro Systems, Inc.  
22650 County Highway 6  
Detroit Lakes  
Minnesota 56501  
United States

Respondent:

Alton Pumps  
4A Blacknest Industrial Estate  
Blacknest Ind Est  
ALTON  
Hampshire  
GU34 4PX  
United Kingdom

#### **2. Domain Name:**

<sjerhombus.co.uk>

#### **3. Procedural Background:**

A Complaint regarding <sjerhombus.co.uk> (the "Domain Name") under Nominet UK's Dispute Resolution Service Policy ("the Policy") was received from the Complainant and forwarded to the Respondent by Nominet on 26 October 2022. A Response was received from the Respondent the same day. The Complainant lodged a Reply on 2 November 2022.

The dispute was not resolved by mediation and was referred for a decision by an Independent Expert following payment by the Complainant of the required fee on 29 November 2022. I was invited to act as Independent Expert. I was appointed as Independent Expert as of 1 December 2022 and confirmed to Nominet I was independent of the parties and knew of no facts or circumstances that might call into question my independence in the eyes of the parties.

#### **4. The Facts**

The Claimant is a global leader in the water and wastewater industry. Since at least 1975, it has been creating products for a range of uses, including pump control panels, alarm systems, level monitoring solutions, float switches, among others.

The Complainant owns US trade mark registration no. 3068029 for the words SJE RHOMBUS registered as of 14 March 2006, as well as numerous UK registrations and applications for trademarks comprising the words SJE RHOMBUS including trade mark number UK00003187984 SJE-RHOMBUS registered as of 06 January 2017, trade mark number UK00003187998 SJE RHOMBUS registered as of 06 January 2017, and trade mark number UK00917496852 SJE RHOMBUS and device registered as of 01 March 2018, among others. Its various SJE RHOMBUS marks have been used around the world since 1975. The Complainant registered the domain name <sjerhombus.com> on 18 September 1997.

The Respondent, the UK and Caribbean division of HCP Pump Manufacturing Co., Ltd., holds itself out as the UK's leading water pump provider and one of the leading pump service suppliers and manufacturers in the UK, supplying many other leading manufacturers' products throughout the UK, Europe, the former eastern bloc and the Caribbean. According to the Whois database of Nominet UK, the Domain Name was registered on 18 October 2017. The registrar is Fasthosts Internet Ltd., and the registrant has elected to have their address omitted from the Whois database.

#### **5. The Parties' Contentions**

##### Complainant

The submissions by the Complainant are:

- The Domain Name was registered on 18 October 2017. From 10 August 2018 until 28 September 2022, the Respondent hosted a website at the Domain Name, offering identical and competitive goods and services to those of the Complainant, such as water pumps and drainage equipment. The website displayed the Complainant's logo and registered trade mark, without the Complainant's permission.
- On 28 September 2022, the Complainant's lawyers contacted the Respondent identifying its rights in the registered marks and logos, with a request to voluntarily transfer the Domain Name and cease further conflicting use. The Respondent replied, refusing to transfer the Domain Name and offering to sell the Domain Name to the Claimant.
- By email reply on 28 September 2022, the Respondent's Managing Director, Jason Horn, asserted that the Respondent worked with the Complainant for eight to nine years until recently and has advertised the Complainant's products and portrayed the Complainant's trade mark on its website for many years. The Respondent stated that it would not hand over the Domain Name for free but only for a price.
- It is clear from the correspondence that the Respondent was aware of the Complainant. The Respondent's representation it "worked with" the Complainant is misleading. The Respondent may have purchased products from the Respondent, but it is not an authorised partner or seller.
- The Respondent's use of the Domain Name piggy-backs on the Complainant's Rights and benefits from the goodwill. It dilutes the strength of the Complainant's brand and reduces the value of the Complainant's legitimate authorised representative scheme.

This means the Complainant loses income as trade is potentially diverted from the Complainant to the Respondent.

- The Domain Name is identical to one of the Complainant's trade marks. Confusion is likely to occur as the Complainant and the Respondent operate in the same field of business and potential customers will naturally (but erroneously) assume a direct connection with the Complainant and the Respondent.
- The Domain Name is similar to the Complainant's Rights; the Domain Name was, at the time of registration, an Abusive Registration, and the Domain Name is being used in a manner that makes it an Abusive Registration.

### Respondent

The Respondent's brief Response can be summarised:

- It has used the Domain Name since 2017.
- The Domain Name was used to sell the Complainant's products available on the Respondent's website.
- The redirect to the Respondent's website has now been removed.
- The Respondent wants to sell the Domain Name to the Complainant.

### Complainant's Reply

In reply, the Complainant made these submissions:

- The Complainant never worked with or authorised the Respondent to use or sell products under the Complainant's Rights.
- The Respondent is in the same commercial field as the Complainant and used the website hosted on the Domain Name to sell competitor products.

## **6. Discussion and Findings**

### General

The Complainant is required under clause 2b of the Policy to prove to the Expert on the balance of probabilities that:

- i the Complainant has Rights regarding a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### Complainant's Rights

"Rights" are defined in the Policy and in the Procedure. Rights "includes, but is not limited to, rights enforceable under English law".

The Complainant has adduced uncontroverted evidence of registrations of UK trade marks regarding SJE RHOMBUS and of its use of the mark SJE RHOMBUS with the marketing and sales of its water and wastewater pumps and related equipment in the UK since mid-2016.

Ignoring the suffix “.co.uk” the Domain Name is identical to SJE RHOMBUS. I am satisfied that the Complainant does have Rights regarding a name or mark which is identical or similar to the Domain Name.

#### 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, 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.

Paragraph 5.1 of the Policy provides a non-exhaustive list of factors which may evidence that a Domain Name is an Abusive Registration. Those listed under Paragraph 5.1.1 include where the Domain Name was registered or acquired 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.

Paragraph 5.1.2 provides that an Abusive Registration may be found where circumstances indicate 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.

The evidence adduced supports the Complainant’s allegations that the Respondent hosted a website offering identical and competitive goods and services, including water pumps and drainage equipment, to those of the Complainant and that the website displayed the Complainant’s logo and registered trade mark without the Complainant’s permission.

It further appears that the Respondent registered the Domain Name, which fully incorporates the Complainant’s SJE RHOMBUS marks in which the Complainant had pre-existing registered trade mark rights, to confuse and misdirect Internet users seeking the Complainant’s products and services to its own website, which purported to offer for sale not only the Complainant’s products and services, but also those of its competitors, including the Respondent.

The Respondent engaged in this conduct with full knowledge of the Complainant’s prior Rights in the distinctive SJE RHOMBUS marks. I find the Respondent registered the Domain Name as a blocking registration against the Complainant’s registered mark, or acquired the Domain Name to disrupt the Complainant’s business, or both, and that the Respondent used 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 that the Domain Name is an Abusive Registration in the hands of the Respondent.

The Respondent’s admission that it ceased re-directing the Domain Name to its website offering competing goods and services only after the institution of the present proceedings, while continuing to demand a pay-off from the Complainant in exchange for transferring the Domain Name, underscores the correctness of the finding of an Abusive Registration under these facts.

**7. Decision**

Accordingly, I find that the Complainant has Rights regarding 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. I therefore determine that the Domain Name be transferred to the Complainant S.J. Electro Systems, Inc.

A handwritten signature in blue ink, appearing to read 'David Kreider', with a long horizontal stroke extending to the right.

David Kreider  
11 December 2022