

DISPUTE RESOLUTION SERVICE

DRS 8843

Decision of Independent Expert

Armon Limited

and

Mrs Aleks Higgins

1. The Parties:

Lead Complainant: Armon Limited
17, Rue Du Cendrier
PO BOX 1699
Geneva
CH-1211
Switzerland

Complainant: Armon Limited
United Kingdom

Respondent: Mrs Aleks Higgins
45 Oldway Drive
Solihull
West Midlands
B91 3HP
United Kingdom

2. The Domain Name(s):

maclarentechnoxlr.co.uk

3. Procedural History:

The Complaint was received by Nominet on 16 July 2010 and validated on 19 July. The Parties were notified of the Complaint on the same date. On 9 August a Response was received and notified to the Complainant, who issued a Reply, received by Nominet and notified to the Respondent on 25 August. After the failure of Mediation, the Complainant requested a full Expert Decision, payment for which was received by Nominet on 3 November 2010.

On 4 November 2010, the undersigned, Peter Davies, agreed to provide a full Expert Decision, certifying that he was independent of the Parties and knew of no facts which might call his impartiality into question. The Expert's appointment was confirmed on 9 November.

4. Factual Background

The Complainant manufactures and sells goods under the brand name Maclaren. The brand is used in relation to baby buggies, carriages and related accessories.

The Respondent registered the Domain Name in January 2010 and uses it to host a website which provides information about Maclaren products and links to vendors.

5. Parties' Contentions

5.1 The Complainant

5.1.1 The Complainant declares that it is the owner of registered and unregistered rights in the name Maclaren and its associated logo, and submits evidence of Community and UK trademark registrations. The Complainant also claims registered and unregistered rights in other territories and declares that it is the registered owner of the domain names www.maclaren.co.uk and www.maclarenbaby.com.

5.1.2 The Complaint alleges that the Domain Name website seeks to appear to be linked to the Complainant and its products, thus infringing the Complainant's intellectual property rights.

5.1.3 The Complainant argues that the Respondent is causing damage to its goodwill by passing off or misrepresenting goods as goods of the Complainant. The website offers products with different specifications/colours than the Complainant's.

5.1.4 The Complainant accuses the Respondent of intending to confuse users into a belief that they are related to the Complainant.

5.2 The Respondent

- 5.2.1 In reply to the Complainant's statement that the website is "misrepresenting goods as those of our company" and that "The website offers products with different specifications/ colours than our company's", the Respondent states that all of the specifications shown on the website have been sourced either directly from www.maclarenbaby.com (UK site) or from well known UK suppliers of genuine branded Maclaren products. All of the colours shown available in the UK are also drawn directly from the official Maclaren site.
- 5.2.2 In reply to the Complainant's allegation that "They clearly intend to confuse the users that they are related to our company" the Respondent answers that the website is a price comparison website. It details the product - in this instance the Maclaren Techno XLR buggy - and promotes it on behalf of the Complainant. The website itself does not directly sell any Maclaren branded or unbranded products but does indicate to its users where legitimate Maclaren products can be sourced in the UK. Suppliers shown on the site include well-known high street retailers such as John Lewis Partnership, Babies R Us, and Mothercare.
- 5.2.3 The Respondent declares that the website has offered a service to consumers wishing to purchase Maclaren branded product from approved suppliers since January 2010. Consumers are given the product specification and are then shown which are the most cost effective suppliers to purchase from in the UK. It is clear to users of the site that they are being directed to other sites to purchase a buggy and that the purchase is not directed to Maclaren.
- 5.2.4 The Respondent avers that the registration and use of the Domain Name were not intended to be misleading or detrimental to Maclaren and the Respondent does not believe that this is the case. The site was intended to be a fair representation of the product and a means of offering users an easy way to determine the most cost effective way of purchasing genuine Maclaren product.

5.3 Complainant's Reply

The Complainant exercised its right to submit a reply to the Response provided by the Respondent. The reply in its entirety states:

"Irrespective of all the given facts which we consider irrelevant, the fact that our client's brand is being infringed and exposed to passing off is key here. We do not wish for any third party to use our client's registered and unregistered rights to benefit from them. It is our client's right to determine what happens to his brand and how it is used. Clearly, no license or other agreement has been given to the opposite party here to benefit from our client's rights."

We would like to draw you [sic] attention to the above major point and the attached list of recent website decisions.”

The “list of recent website decisions” referred to, contained references to DRS cases which, in the Complainant’s view, support its argument that the alleged infringement of its trademarks is of paramount importance in determining that the Registration is Abusive. No discussion of the cases is offered, although the Complainant places particular emphasis on DRS 248 (seiko-shop.co.uk). The list of cases is divided into categories, headed “Distributor”, “Selling products by other manufacturers”, “Tribute/Criticism” and “Unconnected third Party”.

6. Discussions and Findings

6.1 General

In order to succeed in these proceedings, paragraph 2.b of the Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that:

- i. the Complainant has Rights in respect of names or marks which are identical or similar to the Domain Name; and*
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.*

6.2 Complainant’s Rights

The Complainant submits proof of ownership of several registered trademarks relating both to the brand name which forms a part of the Domain Name and to other brand and product names. The Complainant also asserts certain unregistered rights relating to the name and reputation of its branded products and the goodwill attached thereto. There is no trademark registration in respect of the precise formulation which constitutes the Domain Name, (discounting the .co.uk suffix in accordance with the Policy) and no evidence is submitted of the Complainant’s trading history or reputation. However the Domain Name combines the Complainant’s registered trading name with that of one of its products in a manner which puts the Complainant’s Rights beyond doubt. The Respondent offers no argument in this regard, and indeed makes it clear that she chose the name precisely because it denoted a product of the Complainant. It is therefore appropriate to proceed on the basis that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6.3 Abusive registration

6.3.1 The Policy requires the Complainant to show that the Domain Name is an 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, at the time 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

6.3.2 The Complainant focuses overwhelmingly upon the alleged infringement of trademark and other rights by the Respondent. Whereas the existence or otherwise of legally or contractually enforceable rights is of the essence so far as establishing Rights under the DRS Policy is concerned, the question of infringement of such rights lies outside the operation of the Policy. The Complainant specifically draws my attention to the Appeal decision of the seiko-shop.co.uk case, but in their Decision, the Appeal Panel offers the following advice:

"..parties and Experts should not be overly concerned with whether or not an allegedly abusive registration also constitutes an infringement of registered trade mark. The question of trade mark infringement is, as both parties (and the Expert) agree, one for the courts to decide. The question of abusiveness is for the Expert to decide.

I do not propose to comment further upon this aspect of the Complainant's case.

6.3.3 The Complaint does however include allegations against the Respondent which fall properly within the scope of the Policy. These relate to the confusion which arises, the Complainant argues, from the Respondent's use of its brand name in the Domain Name. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3.a of the Policy. These include, at paragraph 3.a.ii:

"Circumstances indicating 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"

6.3.4 It is open to the Respondent to demonstrate that the Domain Name is not an Abusive Registration, by providing evidence to that effect. A non-exhaustive list of factors upon which a respondent might rely is set out in Paragraph 4 of the Policy. Those relevant to the Respondent's case would seem to be Paragraph 4.a.i.A, which states

*i.before being aware of the Complainant's cause for complaint (not necessarily "the complaint" under the DRS) the Respondent has:
A. used or made demonstrable preparations to use the Domain Name in connection with a genuine offer of goods or services;*

And Paragraph 4.a.i.C which covers circumstances where the Respondent has

C. made legitimate non-commercial or fair use of the Domain Name;

The Respondent is not, in my view, aided by Paragraph 4.a.i.A. It is self-evident that the Respondent knew of the Complainant, its brand names and product ranges at the time of the registration of the Domain Name. The Complainant is entitled to see the unauthorized use of its brand name as a cause for complaint. Paragraph 4.a.i.C might have assisted the Respondent, but no evidence is offered to support an argument that what she is doing amounts to “legitimate non-commercial or fair use” of the Domain Name.

6.3.5 The factors in Paragraph 4 of the Policy address the question of the Respondent’s good faith, or its absence. The Complainant argues a lack of good faith on the part of the Respondent by alleging that the Respondent is (a) attempting to pass herself off as authorised by or connected to the Complainant, (b) offering McLaren branded goods for sale on the Domain Name website and, (c) offering goods that are not the authorised, branded goods of the Complainant.

6.3.6 As to the first of these, the Complainant offers no evidence of an intention on the part of the Respondent to suggest a legal or business connection with the Complainant, and no comment is offered upon the disclaimer which appears on the site. The Respondent also does not trouble to refer to this disclaimer, which states that there is no such connection. However, it is there and, although these things are subjective to a degree, I take the view that it is unambiguous and sufficiently prominent at least to support an argument that the Respondent has acted in good faith in this regard.

6.3.7 As to the second allegation, an examination of the website does not reveal evidence that the Respondent herself is offering goods for sale. The site appears to be what the Respondent says it is: a price comparison site.

6.3.8 The third allegation once again takes the Complaint beyond the scope of the DRS Procedure. The Complainant accuses the Respondent of

“causing damage to [its] goodwill by passing off / misrepresenting goods as those of [the Complainant]”.

The Complainant goes on to allege that

“the website offers products with different specifications/ colours than our company’s. They clearly intend to confuse the users that they are related to our company.”

This too is a matter for the courts. Without evidence that the Complainant's business is unfairly disrupted by the appearance of goods on the website which are in some way inauthentic, this submission is of no help to the Complainant.

6.3.9 I return to the second allegation, that the Respondent is using the site to sell the Complainant's goods, (or imitations of these goods – the Complaint seems to allege both). The Respondent says that she registered the Domain Name to provide a price comparison service to consumers wanting to know about the Complainant's products and where and for how much they can be bought. If this dispute turned simply upon the question of whether or not the Respondent was selling goods on the site, the Complaint would fail for want of evidence to support the Complainant's argument. However, even if I accept that the site is what the Respondent says it is, and that the price comparison features of the site are unexceptionable in themselves, the possibility of confusion on the part of visitors to the site must be taken into account. Although not binding upon Expert Decisions in DRS cases, it is appropriate to consider the words of the Court of Appeal in *British Telecommunications plc and Others v. One in a Million Ltd and Others* [1999] ETMR 61, where the Court stated:

"The placing on a register of a distinctive name [...] makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name."

Applied to this Complaint, I consider this reasoning sound. It is plausible that users seeking information about Maclaren products could arrive at the website in the mistaken belief that it is operated by or connected with the Complainant. Having arrived at the site, there are features which make it clear to visitors that goods are not offered for sale on it and that the Respondent disclaims any connection with the Complainant. By not addressing these facts, the Complainant weakens its argument that its business is disrupted. No evidence is offered that the Respondent has deliberately confused the public, or acted in bad faith by selling goods which she has no license to sell, or by selling counterfeit goods, or by pretending to be connected legally or commercially with the Complainant.

6.3.10 Nevertheless, it is in the Respondent's interests to maximise traffic to her site and thus optimise the use of links to the third party suppliers provided on it. Notwithstanding the shortcomings in the Complainant's case, and allowing for the *prima facie* evidence in support of the Respondent's good faith, I must conclude that use of the Complainant's brand name, and the possibility of confusion about who is operating the site, will contribute to the number of visitors attracted to the site. A benefit to the Respondent is obtained on the back of her unauthorised use of a name in which the Complainant has Rights. This constitutes an unfair advantage, in terms of paragraph 1(ii) of the Policy. The

registration of the Domain Name thus falls within the scope of Paragraph 3.a.ii of the Policy and is an Abusive Registration in the hands of the Respondent.

7. Decision

For the reasons set out above, I find that the Complainant has Rights in a name identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Domain Name should be transferred to the Complainant.

Signed: Peter Davies

Dated: 29 November 2010