

DISPUTE RESOLUTION SERVICE

D00010146

Decision of Independent Expert

MERIAL (société par actions simplifiée)

and

Cayton Veterinary Surgery

1. The Parties:

Lead Complainant: MERIAL (société par actions simplifiée)
29, avenue Tony Garnier
Lyon
F-69007
France

Respondent: Cayton Veterinary Surgery
Ansells End Farm
Kimpton
Hitchin
Herts
SG4 8HD
United Kingdom

2. The Domain Name(s):

<buyfrontline.co.uk>

3. Procedural History:

28 July 2011 14:34 Dispute received
29 July 2011 12:15 Complaint validated

29 July 2011 12:22 Notification of complaint sent to parties
17 August 2011 08:51 Response received
17 August 2011 08:52 Notification of response sent to parties
22 August 2011 02:30 Reply reminder sent
24 August 2011 15:32 Reply received
24 August 2011 15:33 Notification of reply sent to parties
24 August 2011 15:33 Mediator appointed
09 September 2011 12:34 Mediation started
09 September 2011 12:35 Mediation failed
09 September 2011 12:35 Close of mediation documents sent
12 September 2011 13:26 Expert decision payment received

4. Factual Background

The Complainant is the manufacturer of veterinary pharmaceutical products and has provided evidence of its ownership of the following trade mark registrations:

UK trade mark registration No. 1557026 FRONTLINE covering “insecticides and anti-parasitic agents, all being veterinary preparations” in Class 5.

Community Trade Mark registration No. 1966787 FRONTLINE for “insecticides and antiparasitic preparations for veterinary purposes” in Class 5.

International trademark registration (UK) No. 771092 FRONTLINE COMBO for “veterinary products, namely insecticides and antiparasitic products” in Class 5.

The Complainant first marketed and sold FRONTLINE-branded preparations for treating fleas in household pets, particularly cats and dogs.

Cayton Veterinary Surgery appears to be the name under which Mr. John Cousins carries on a veterinary pharmaceutical retail business. The disputed domain name was registered on 9 April 2006. The Respondent has established a website to which the disputed domain name resolves on which there are links to another web site established by the Respondent to sell the Complainant’s goods and competing goods.

5. Parties’ Contentions

Complaint

The Complainant submits that it is the owner of and has rights in the FRONTLINE trademark and the abovementioned trademark registrations.

The Complainant submits that it first marketed and sold FRONTLINE-branded preparations for treating fleas in household pets, particularly cats and dogs, in 1994 and has provided evidence to support this claim in an annex to the Complaint. The Complainant submits that since then its FRONTLINE products have become the UK's leading brand of anti-parasitic preparation for cats and dogs.

The Complainant states that its FRONTLINE brand of products is sold under two main formulations viz. FRONTLINE Spot On and FRONTLINE Combo.

The Complainant submits that it invests considerable resources in educating the public about the causes and consequences of pet fleas and methods for treating them, and in educating pharmacists, veterinarians and others about the appropriate FRONTLINE products that may be used for treating the dogs and cats of their clients and customers. Some of this investment is alluded to in the extract from Pet Health magazine dated 14th July 2010, attached at Annex 4.

The Complainant has submitted the following documents annexed to this Complaint to illustrate the way in which the FRONTLINE name is used in the UK on its product packaging and promotional material:-

- design drawings for FRONTLINE Combo pack for cats and for dogs – produced September 2006;
- an information pack for stockists of FRONTLINE Combo product entitled “How to create your flea life cycle display” – produced 2008;
- a covering letter to veterinary practices to accompany information and sales support material comprising educational waiting room posters and flea and tick fact sheets with a dispenser. Produced in 2006.
- A FRONTLINE Combo Calendar for the year 2008;
- marketing material dated 2003 with the headline wording “You can't stop them going out, but you can protect them from fleas, ticks and lice”;
- an advertisement published in 2004 headed “Give your pets a flea-free winter”;
- an advertisement published in 2005 headed “FLEA INFESTATIONS? NOT IN THIS HOME!”;
- an advertisement published in 2002 entitled “Where do fleas go in winter? Sadly, they stay at home, with you and your pets”.

The Complainant has submitted copies of two illustrative invoices from 26 October 2007 and 5 November 2007 to customers in Torbay and Stoke on Trent and details of orders amounting to £204,073.10 and £425,879.26 respectively and submits that its annual sales of the FRONTLINE Spot On in the United Kingdom for the last 10 years were between £16.7m and £ 20.8m.

The Complainant further submits that its annual sales in the United Kingdom for the FRONTLINE Combo product are nearly comparable to sales of FRONTLINE Spot On.

The Complainant submits that in addition to marketing material aimed specially at vets and pharmacists, the FRONTLINE products have been advertised on national television and in both specialist and popular press and the Complainant has submitted details of an advertisement dated 5 April 2008 which discusses the FRONTLINE TV advertising campaign due to run from April – October 2008, along with printed advertising in the Radio Times and OK! Magazine.

The Complainant further submits that by way of recognition of the effectiveness and popularity of the Complainant's FRONTLINE product, it was the winner of the Best Cat Flea Pet Product 2009/10 in the Your Cat Magazine and Your Dog Magazine Product Awards and has submitted a copy of the attesting certificate as an annex to the Complaint.

The Complainant submits that between 2008 and 2009 the Complainant spent the Sterling equivalent of STG£2,913,750 and STG£2,265,000 respectively and STG£1,881,875 in the year 2010 (up until October).

In the United Kingdom, the Complainant operates a website at <http://uk.merial.com/>. As part of this website there is a dedicated section for the FRONTLINE product at <http://frontline.uk.merial.com/> which provide more information on the Complainant's UK business and its FRONTLINE products. The Complainant has submitted a copy of this website in an annex to the complaint.

The Complainant argues that as a consequence of the substantial investment in education, marketing and consequent sales of the Complainant's FRONTLINE product, the FRONTLINE brand has established substantial goodwill and reputation throughout the United Kingdom. It has become a genuinely household name for flea treatment products for cats and dogs.

The Complainant submits that the disputed domain name buyfrontline.co.uk is abusive for the following reasons:-

- i. it 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; and
- ii. It has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

The Complainant argues that in particular the disputed domain name:-

- a) amounts to a blocking registration against a name or mark in which the Complainant has Rights, and
- b) has been registered for the purpose of unfairly disrupting the business of the Complainant

and that

c) the Respondent is using 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 Complainant argues that the disputed domain name <buyfrontline.co.uk> is highly similar to the Complainant's FRONTLINE trade mark because the dominant and distinctive element of the subject domain name is the word FRONTLINE which, in relation to flea treatment products, is uniquely distinctive of the Complainant's products.

The Complainant further argues that the disputed domain name <buyfrontline.co.uk> implies, and customers would infer, that any website hosted at the subject domain name is an official website of the Complainant or is officially authorised by the Complainant. The Complainant asserts that the Respondent is not associated or affiliated with the Complainant and the Complainant has not authorised the Respondent to register or use the disputed domain name.

The Complainant argues that since it is unable to control the quality, accuracy and appropriateness of the content of the website any incorrect, poor quality or inappropriate material displayed on the website, whether now or in the future, is likely to lead to damage to the reputation of the FRONTLINE trade mark, and consequently to impair sales of the Complainant's FRONTLINE product.

The Complainant submits that although the Complainant's products are sold to the public *via* intermediaries rather than by the Complainant or its UK subsidiaries directly, those not aware of this would reasonably assume that the only products sold or advertised via a website at www.buyfrontline.co.uk are the Complainant's products and that those products are genuine. Without control of the domain name and the business conducted through the website, the Complainant is unable to check and control the products sold by the Respondent.

The Complainant argues that by using the Complainant's well known trade marks in its domain name, the Respondent has the potential to take advantage of that reputation and goodwill by attracting customers to its website. The Complainant refers to content posted on the Respondent's website at www.buyfrontline.co.uk which shows that on the left-hand side of the front page, the Respondent has created a long list of names of other veterinary products which originate from a number of different companies. Towards the top of the list is an entry for ADVOCATE, which is a rival anti-flea product produced by Bayer. The entry for ADVOCATE re-directs users to a website at www.buyadvocate.co.uk. The Complainant has furnished a print-out from the website at www.buyadvocate.co.uk, along with details of Bayer's UK trade mark registration of ADVOCATE as an annex to the Complaint. The Complainant is not connected with Bayer in any way and is not responsible for the ADVOCATE product. By using the Complainant's registered trade mark in the www.buyfrontline.co.uk website to market products of a competitor

company, the Respondent is in effect (whether intentionally or not) misappropriating the Complainant's goodwill and taking unfair advantage of the reputation established by the Complainant, with the consequent risk of damage to the Complainant.

The Respondent uses the website at <www.buyfrontline.co.uk> to direct potential customers to a related website at <www.viovet.co.uk> at which a range of veterinary products such as FIPROSPOT and ADVOCATE may be bought.

The Complainant submits that the Respondent is shown to be using the Complainant's trade mark to attract internet users to its website, but which instead then informs, advertises and promotes third party products such as ADVOCATE and FIPROSPOT and directs Internet users to the purchasing website at which third party rival products are promoted and sold. This amounts to bad faith and abusive behaviour on the part of the Respondent which is damaging to the Complainant's business.

The Complainant argues furthermore, that in 2010 the website hosted at www.buyfrontline.co.uk contained an article on FRONTLINE flea treatments. A copy of a page from the Respondent's website dated 7 June 2010 is annexed to the Complaint. At the top of that article there was a link that took the internet user to a third party web site where the purchaser was also able to browse, select and purchase flea treatments made by competitors of the Complainant. This is no different in principle than if the Respondent had simply set up its website business in such a way that competing products were sold directly through the www.buyfrontline.co.uk website. This practice clearly takes unfair use of the Complainant's trade mark for the Respondent's own commercial ends which are not the same as, and in many cases diverge completely from the Complainant's commercial interests. There are parallels between this conduct and the conduct referred to in the Toshiba case DRS 7991. However, whether or not the Respondent's website only promotes and sells genuine FRONTLINE products, the Complainant does not authorise unrelated third parties to register and use domain names that incorporate its trade marks for any commercial purposes.

The Complainant (via its UK trade mark attorneys) contacted the Respondent about its conduct as long ago as May 2010 to request that it cease using the subject domain name. The Complainant informed the Respondent of the Complainant's rights and its intention to resort to Nominet UK DRS proceedings if it did not comply with the Complainant's request, but the Respondent refused to do so.

The Complainant submits that the registration of the domain name in the hands of the Respondent is further abusive because it amounts to an infringement of the Complainant's rights in its registered trade marks and to passing off. The definition of "abusive registration" under the Nominet UK DRS must include a domain name whose registration amounts to an infringement of a registered trade mark, and passing off.

The Complainant argues that the Respondent has infringed the rights of the Complainant by using in the course of trade a sign identical with or similar to the Complainant's earlier trade mark by, amongst other things, offering or exposing competing branded goods for sale through a website that is directly linked and connected with the Complainant's www.buyfrontline.co.uk website.

The Complainant submits that in addition, in the case of *British Telecommunications plc and Others v One in a Million and Others*, [1998] EWCA Civ 1272, the Court of Appeal held that registration of the domain name marksandspencer.com by the Respondent which was unconnected with Marks & Spencer plc amounted to both passing off and registered trade mark infringement.

The Complainant submits that In relation to trade mark infringement, it was held in the *One in a Million* case that the use of the trade marks within registered domain names was infringing on the basis that 'the domain names were registered to take advantage of the distinctive character and reputation of the marks. That is unfair and detrimental'. In light of the judgement of the Court of Appeal in the *One in a Million* case, the registration and the use of the subject domain name by the Respondent in the present case amounts to an infringement of the rights of the Complainant in its registered trade marks, as well as passing off.

The Complainant does not sell its FRONTLINE products to the public directly; rather, it supplies wholesalers who in turn supply retailers. Because of the Complainant's reliance on its wholesale and retail distribution network, and the need to maintain fair and equal terms for all of the purchasers and sellers of its FRONTLINE products, the Complainant cannot allow a small minority of sellers to register domain names that include the FRONTLINE name which could result in those particular sellers deriving an unfair advantage over other sellers of the product. It is for this reason, amongst others, that the Terms and Conditions of Sale of the Complainant's UK subsidiary Merial Animal Health Limited with its direct wholesale customers which are attached as an annex to the Complaint state as follows:- "8. Information Trademarks etc. The customer shall not: 8.1 Affix, apply or use any mark, name or symbol or device upon or in relation to the products unless specifically authorised by the Company."

The Complainant submits that if there were to be a "free for all" in the registration and use of domain names that incorporate the FRONTLINE name, it would require the Complainant to expend considerable resources in monitoring/policing all websites containing this name. For this reason, amongst others, the Complainant has a policy of not consenting to the registration of any domain name containing the FRONTLINE name by any seller of its products.

Accordingly, the registration of the subject domain name unfairly disrupts the business of the Complainant in breach of paragraph 3 a. i.(c) of the Nominet UK DRS Policy.

In *MERIAL (société par actions simplifiée) v. Mr Graham Parlane* Nominet UK DRS 09667, a previous complaint brought by the present Complainant in relation to the domain name <thefrontlineshop.co.uk>, the expert accepted that the Respondent's registration of that domain name was objectionable in light of the above considerations and stated:-

"67. Even if the misrepresentation did enhance sales of the products (as to which there is no evidence), this fact itself is beside the point. Any increase in trade is likely to have been at the expense of MRV's competitors, and for the reasons given in paragraph 66 above that would constitute the taking of an unfair advantage of Merial's trade marks."

In conclusion the Complaint cites a number of complaints brought under Nominet UK's DRS Policy which the Complainant submits are relevant to the case at hand:-

- *MERIAL (société par actions simplifiée) v. Mr Graham Parlane* Nominet UK DRS 09667 was a complaint brought by the present Complainant regarding a substantially similar domain name to that in question in the present case. The expert upheld the complaint on several grounds applicable to the present Complaint, namely that it was abusive to:- (i) advertise and sell products of an unrelated company using the website at www.thefrontlineshop.co.uk and (ii) to take unfair advantage of the Complainant's trade mark by incorporating it in a domain name which would give the Respondent an unjust advantage over the Complainant's other resellers and thus disrupt the Complainant's business relationship with those other resellers.
- *Epson Europe BV v Mr J Armitage* Nominet UK DRS 07228 (buy-epson-uk.co.uk) being a summary decision and as such in the view of this Expert is of little value as a basis for argument in the present proceedings.
- *Schering-Plough Corporation Schering Corporation Schering-Plough Limited affiliates and subsidiaries v B D Healthcare Ltd* Nominet UK DRS 07186 (clarityn.co.uk) where the registrant used the website associated with the domain name to promote and sell genuine products bearing the Clarityn mark. The expert concluded as follows:- "...the Respondent registered the Domain Name in a manner which at the time took unfair advantage of the Complainants' Rights and that the Domain Name has been used in a manner which has taken unfair advantage of those Rights, which is an Abusive Registration". The Complainant submits that the Clarityn case has parallels with the present case in that the products in question were both pharmaceutical preparations whose name was incorporated into a domain name registered by a seller of those preparations who was unconnected with the trade mark owner.

- The decision of the appeal panel in *Toshiba Corporation (trading as Kabushiki Kaisha Toshiba D / B / A Toshiba Corporation) v. Power Battery Inc.* Nominet UK DRS 07991 (toshiba-laptop-battery.co.uk) the complaint was brought by Toshiba Corporation against Power Battery Inc. The website at www.toshiba-battery-laptop.co.uk allowed customers to purchase both Toshiba batteries and batteries produced by companies other than Toshiba. The inclusion of the Toshiba name was held to lead to “initial interest confusion”, meaning that people seeing the website following an internet search might be directed there under the impression that it was connected with the trade mark owner. On appeal, the Nominet Panel ordered the subject domain name to be transferred to Toshiba.
- The decision of the appeal panel in *Seiko UK Limited v. Designer Time/Wanderweb* Nominet UK DRS 002480 (seiko-shop.co.uk) which held that Designer Time/Wanderweb illegitimately registered and used the subject domain name, even though it was allegedly used only for promoting and selling genuine Seiko watches. Seiko successfully argued that the registration by one retailer of the subject domain name that included the SEIKO registered trade mark gave it an unfair advantage over other Seiko retailers, and took unfair advantage of the Complainant’s mark to set itself above the others.

The Complainant argues that the seiko-shop.co.uk case has analogies with the present case in that both domain names include the Complainant’s registered trade mark, and the words “shop” and “buy” are semantically closely connected words. The Complainant in both cases had justifiable and legitimate concerns about the negative effect that the registration and use of such a domain name would have on the other retailers of its products, and hence on its own business. The addition of what is in the context of the Complainant’s business a neutral or purely descriptive word, namely “buy”, does not displace the overall impact of the word FRONTLINE in the domain name.

In light of all the above, the Complainant requests that the Panel determine that the domain name buyfrontline.co.uk in the hands of the Respondent is an abusive registration and should be transferred to the Complainant.

Response

In a detailed Response, the Respondent accepts that the disputed domain name is similar to the Complainant’s FRONTLINE trade mark and that the Respondent is not associated or affiliated with the Complainant and the Complainant has not authorised the Respondent to register or use the subject domain name.

The Respondent submits that the disputed domain name was registered to sell FRONTLINE products by a small family business and argues that it does not take unfair advantage of, and is not unfairly detrimental to, the Complainant's Rights, nor has it been used in such a manner. The associated website has the very obviously

look and feel of a small, personalised, veterinary, commercial website. It consists of a single page, which ends stating that it contains the personal opinions of the Respondent. The Respondent's website has immediately apparent links to other sites including a very obvious one where FRONTLINE products can be purchased. Nothing can be bought directly from <buyfrontline.co.uk>. No reasonable person could think it is an official website of the Complainant. The purpose of <buyfrontline.co.uk> is purely and simply as an advert to sell FRONTLINE. Branded products are usually named in adverts. That is what happens here.

The Respondent argues that he is using the disputed domain name as an advertisement and knows of no reason why he should not do so.

The Respondent denies that the disputed domain name amount to a blocking registration and submits that it certainly was not registered for the purpose of unfairly disrupting the business of the Complainant.

The Respondent argues that the disputed domain name does not create any initial interest confusion. The immediate impression is that the domain leads to an online facility where customers are able to buy FRONTLINE. If potential customers visit the associated website, they can go on to find FRONTLINE products offered for sale. There is no confusion, nor is there any reason for people or businesses to believe that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Respondent accepts that the disputed domain name <buyfrontline.co.uk> is indeed deliberately similar to the Complainant's FRONTLINE trade mark. This is so that customers are able to know what they are buying. When an item is offered for sale, it is useful to call it by name. The Respondent offers FRONTLINE product for sale using the registered name. All sellers of FRONTLINE product use the name to identify the product they are selling. The fact it is in a domain name does not alter that. Putting the word "buy" with the trademark word makes it instantly obvious what visitors can do – buy FRONTLINE.

The Respondent also accepts that it is true that the Respondent is not associated or affiliated with the Complainant and the Complainant has not authorised the Respondent to register or use the subject domain name. The Respondent argues however that the Respondent makes no such claims and there is no reason for anyone to think otherwise. The Complainant suggests that people will automatically assume some such association but offers no evidence for this suggestion.

The Respondent argues that the inclusion of a trade mark within a domain name is not automatically disallowed. An extremely brief search of the internet yielded a number of unofficial web sites with addresses that incorporated the names of well known brands. The Respondent argues that these are all unofficial sites using major brand names much bigger than FRONTLINE. This is the world as it is. People are familiar with it, and understand this situation. It is very straightforward. The very

idea that a domain name containing a brand name automatically implies direct authorisation by the brand owner is outdated and completely false.

The Respondent argues that brand names are used within domain names all the time. The Respondent uses over 50 of them. All are intended to advertise that brand for sale. There is nothing underhand, dishonest or deceitful about them. All these brands are sold on <www.viovet.co.uk>, along with FRONTLINE products. None of the other trademark owners appears to have an issue with it. The Complainant stands alone in its attitude.

The initial impression created by the use of the <buyfrontline.co.uk> domain name is that it is somewhere one can buy FRONTLINE. Why ever would any reasonable person think differently? The Complainant offers no evidence that people could reasonably be confused in the way they suggest, so the Respondent would like to ask for proof that this confusion exists, beyond their unsupported claim. The Respondent suggests in fact that the opposite is true. It is obviously a place to buy FRONTLINE. Nothing beyond that is a reasonable assumption.

The Complainant's next suggestion is that poor quality or inappropriate material displayed on the website could damage the reputation of the FRONTLINE trade mark. That could only happen upon entering the website. The analogy would be a person going into (say) a veterinary surgery and being told something similar. The Complainant supplies display media for use in veterinary surgeries. It is clearly identified with their trade mark. A vet, nurse or receptionist within the building could then say something which the Complainant would disapprove of. Such is life. Once a person visits a shop, whether it be online or on the High Street, they have left the realm of what the Complainant can control. If the Complainant does not agree with anything on the website relating to FRONTLINE, they can approach the Respondent directly about it. The very good name of FRONTLINE is if anything supported by the way it is used on the websites in fact.

The Respondent denies the Complainant's suggestion that people would assume that only FRONTLINE products are offered for sale at <buyfrontline.co.uk>. The Respondent suggests not. Very few places sell just one range of products. Very many places advertise individual products, but for these advertised products to be the only ones sold by that seller is not often the case. The Respondent is not aware of any websites which sell just FRONTLINE. One only has to follow online adverts to websites to see how many of them sell many different products. <viovet.co.uk> is typical in this. The assertion from the Complainant of implied exclusivity is not reasonable. The Complainant is indeed unable to check and control the products sold by the Respondent but the right to do so does not exist. Wholesalers sell vast quantities of FRONTLINE to myriads of veterinary surgeries, pharmacist stores, agricultural merchants, pet stores and online suppliers. The assurance of quality and the genuine product comes from the packaging which the purchaser receives. That applies to all the outlets just the same. The Complainant can come and inspect the Respondent's facilities at any time, they only need to ask. Only genuine FRONTLINE is sold as FRONTLINE.

Advertising a well known brand, but then having other brands for sale in addition, is not unusual. Most websites sell more than one product, as do most high street shops. The Respondent does not sell anything on <buyfrontline.co.uk> and customers have to go to <viovet.co.uk> to purchase anything. The Complainant contends that potential customers would assume that only FRONTLINE products would be available for sale. What is their evidence for that suggestion? The Respondent thinks it is unusual to go to a website to find only one type or range of products for sale. If products are for sale at all, very usually there are different products there. There is no suggestion that only FRONTLINE products are for sale. Indeed as the Complainant points out, it is immediately apparent that other products are available. The genuine purpose of using the domain name <buyfrontline.co.uk> is to sell FRONTLINE.

The Complainant takes issue with ADVOCATE being offered for sale to people who have arrived through being attracted to the FRONTLINE name. ADVOCATE is not a comparable product. It does treat fleas amongst many other parasites, but it can only be bought with a prescription from the customer's vet. The purchaser must send the written prescription to the seller. There is no prospect of selling ADVOCATE to people who were attracted to the name FRONTLINE. People who buy ADVOCATE were attracted to that name. The links are present on the same page to help Google rankings, which are crucial to online businesses.

The Respondent accepts that it is of course abusive to offer a branded product for sale with the intention of selling another. It might be abusive even if this is a reasonable, but unintended, prospect. The Respondent accepts that he is clearly trying to sell FRONTLINE through the disputed domain name, which the Respondent feels is not abusive.

If people navigate around the website at <viovet.co.uk> they will indeed find competitor products advertised against some FRONTLINE product and some products such as worming tablets that are different from the Complainant's FRONTLINE product. This is very much analogous to going into a supermarket to buy an advertised, branded product, but then finding another product there for sale. This sort of choice is part and parcel of most shopping experiences. The important point is that customers have to travel away from the pages where they are directed by the buyfrontline.co.uk. If they follow the obvious, expected route they will find that it is very easy to buy FRONTLINE, and significantly less obvious how to buy anything else. If the Complainant wishes to consider having exclusivity on the whole <viovet.co.uk> website that is a commercial discussion and agreement which could be made. However it goes beyond the scope of their legitimate rights regarding <buyfrontline.co.uk>. The Respondent states that <viovet.co.uk> is a large website with over 12,000 product lines offered for sale - one would expect rival products to be offered for sale there.

The Respondent argues that ADVOCATE is not a comparable product for the reasons already stated. EFFIPRO and FIPROSPOT is available in other parts of the "store".

The Respondent has replied twice to direct communications from the Claimant in the past. Copies of those replies are attached as an annex to the Complaint. The Respondent also offered face to face discussion, but no response to this was received.

The terms and conditions imposed by the Complainant on its wholesalers or retailers are not a concern of Nominet's DRS. If The Complainant consider the Respondent is not complying with any of their requirements, then they should make direct contact about that particular matter. This they have not done so far. There is nothing unfair about the Respondent's registration of <buyfrontline.co.uk> as all other competitors could have registered it if they had wished. There are in fact many other names which still could be registered. For example, any of the following are available, plus innumerable others for those who would like to register them: <frontlineforsale.co.uk>, <genuinediscountfrontline.co.uk>, <purchasefrontline.co.uk>, <frontlinefordogsandcats.co.uk>, <frontlineseller.co.uk>, <frontlineonline.co.uk>. <wesellfrontline.co.uk> .

Reply

The Complainant filed a Reply in rejoinder in which the Complainant submits that while the Respondent presents itself as operating a small family veterinary business which has innocently and with justification registered and used the domain name buyfrontline.co.uk by its own admission the Respondent's on-line business at <www.viovet.co.uk> sells over 12,000 product lines and uses upwards of 50 websites incorporating third party brands to increase the rankings of that website on Google. Accordingly, the Respondent's business appears to be a substantial and sophisticated concern.

The Complainant further submits that the Respondent has admitted in its numbered paragraph 1 to the accuracy of the first of the two ingredients for a successful complaint, namely that the Complainant has rights in respect of a name or mark which is identical with or similar to the disputed domain name. It has further confirmed that the Respondent is not associated or affiliated with the Complainant and that the Complainant has not authorised the Respondent to register or use the subject domain name.

The Respondent alleges that the inclusion of a trade mark within a domain name is not automatically disallowed, and attempts to support this allegation by reference to other subsisting registered domain names that include brands such as MERCEDEZ-BENZ, BMW, IPHONE AND NOKIA. However, the Respondent has clearly confused the fact that it is technically possible for third parties to register such domain names with the question of the legality of such registrations. For example, Nominet UK has previously adjudicated on five complaints brought by Nokia Corporation against the registration by various Respondents of the domain names <1-nokia-ring-tones.co.uk>, <my Nokias stuff.co.uk>, <nokia.me.uk>, <nokiaringtones.co.uk> and <nokiagsm.co.uk>. Each of Nokia's five complaints was successful and the expert ordered the subject domain names to be transferred to Nokia in each case.

Similarly, companies within the Mercedes-Benz group have brought at least four complaints before Nominet UK relating to the registration of domain names incorporating the term MERCEDEZ. These domains are <mercedees.co.uk>, <mercedesbenzdirect.co.uk>, <mercedescar.co.uk> and <mercedescars.co.uk>. In each case, the expert ordered the subject domain names to be transferred to the Complainant on the basis that the registrations in the hands of the Respondent were abusive.

Whilst the Complainant's case does not hang solely or exclusively on the proposition that a domain name containing a brand name automatically implies direct authorisation by the brand owner, that is part of its case, and at the very least there is a very real possibility that there may be some "initial interest confusion", leading the internet user to click onto the Respondent's website in the belief that it may be clicking onto an authorised website.

The Complainant asks this Expert to note that the Respondent admits to using over 50 brand names (belonging to third parties) as a way of promoting its own business. The Complainant refers to the provisions of s3 a. iii. of the Nominet UK DRS Policy which states that one of the non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration includes:-

"The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern".

The Respondent claims that "none of the other trademark owners appears to have an issue with [this]". However, the Respondent has provided no evidence that these other trade mark owners know of this practice or have consented to it, or would consent to it if they knew about it.

The Respondent disputes the assertion that the public would only assume that FRONTLINE products are offered for sale at <buyfrontline.co.uk> on the basis that "very few places sell just one range of products". However, this is not the case. An official Apple store only sells Apple-branded products; it does not for example sell Microsoft or Dell products

Whilst the Respondent's registration of the buyfrontline.co.uk domain name would be an Abusive Registration, even if it linked to an e-commerce website that only sold FRONTLINE products, it is certainly abusive for the Respondent to use the Complainant's trade mark to link to and promote a website that also offers products that are directly competing with the Complainant's products.

The Respondent complains that "exclusivity" (i.e. for it to only sell FRONTLINE products) is not reasonable. No-one is forcing the Respondent to sell only FRONTLINE products through <www.viovet.co.uk>, however one significant aspect of

the Complaint is that the Respondent is not entitled to use the Complainant's FRONTLINE trade mark to link to another website through which the Respondent also sells competitors' products.

The Respondent states that "it would be theoretically possible for a potential customer to be attracted to the FRONTLINE name, visit the Respondent's website at <viovet.co.uk>, then buy something other than FRONTLINE. The Complainant submits that it is not just theoretically possible for a potential customer to act in this way, but is possible in practice. Indeed, the steps from selecting a FRONTLINE product to being faced with the option of purchasing a FIPROSPOT product are very small in number.

At the time of filing this reply, anyone putting a FRONTLINE product into the on-line "basket" is then taken to a screen which contains a very prominent button giving the internet user the option of buying DRONTAL wormers (produced by another company, Bayer). If the internet user clicks on this link, and then selects a DRONTAL product,(s)he is taken to a webpage containing a very large advertisement for FIPROSPOT. In the text of the advertisement, the Respondent has added the words "VioVet's number one recommended flea treatment". Thus, it is at this point, before the FRONTLINE order has been completed, that the potential consumer is faced with a very strong message in favour of a competing product. A neutral observer would conclude that the Respondent has not made it very hard for someone directed to the VioVet website from the www.buyfrontline.co.uk website to find him/herself with the clear option (indeed, recommendation) of purchasing a competing product. Accordingly, the Respondent's assertion in its concluding paragraphs that there is absolutely no attempt made on the websites to change the customer's minds if they started their journey by following the name FRONTLINE is untrue.

The Respondent lists other domain names that could be registered that incorporate the name FRONTLINE. That is clearly irrelevant and their registration by unauthorised third parties would almost certainly also constitute Abusive Registrations.

The Complainant's terms of business and its desire not to allow retailers to register and use domain names that incorporate FRONTLINE, in order to ensure a level playing field and avoid retailer disputes and the ensuing additional administrative burden on the Complainant are entirely pertinent matters for the Expert to take into account, and are entirely justifiable reasons for the Complainant's policy toward the adoption of the subject domain name by the Respondent.

Finally, the Respondent claims that "Buyfontline.co.uk is used exactly like an advert in a shop window, it is the precise internet equivalent. It invites potential customers to come into the shop and buy Frontline". However, the incorporation of a brand owner's trade mark into a domain name and corresponding webpage(s) is not a "precise equivalent" to placing an advertisement in a shop window. Rather, it is the equivalent of placing that name over the front of the shop. Any supermarket with Tesco in its name, or any computer store with Apple in its name, implies or is likely

to be perceived by the consumer, at least initially, that it is a genuine Tesco or genuine Apple store. If on later inspection the consumer, having entered the store, discovers that it is not, the operator of that shop has still taken unfair advantage of the well-known brand name and misled the customer and used the well known name to the potential disadvantage of other legitimate retailers who operate under their own name.

6. Discussions and Findings

This Expert accepts and the Respondent has admitted and acknowledged that the disputed domain name is similar to the Complainant's FRONTLINE trademark. The word FRONTLINE is the dominant feature of both. The ccTLD extension ".co.uk" may be ignored for the purposes of the comparison and the additional element "buy" does not detract from the similarity in any degree.

The Respondent has admitted that he uses the Complainant's trade mark to attract Internet users to his website, but which in turn advertises and promotes not only the Complainant's FRONTLINE product but competing third party products such as ADVOCATE and FIPROSPOT and provides links directing Internet users to another website owned by the Respondent at which third party rival products are promoted and sold.

Obviously the DRS Policy is different from the UDRP however it is worth noting that in answer to the question at paragraph 2.3: "Can a reseller/distributor of trademarked goods or services have rights or legitimate interests in a domain name which contains such trademark?" the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") states that the consensus view of UDRP panelists is to apply the principles established in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No.D2001-0903, <okidataparts.com>.

In the very recent decision involving the present Complainant, *Merial (société par actions simplifiée) v. Med&Vet uk ltd* DRS 10143 of 30 September 2011 the expert pointed out that the OKI Data principles applied in the UDRP and the related Toshiba/Seiko principles that have evolved in the DRS decisions, should be reviewed in the light of developing trademark caselaw in the European Union and in particular *Google France SARL v Louis Vuitton Malletier SA* C-236/08 to C-238/08 and *Portakabin v Primakabin*, Case C-558/08 concerning the use of trademarks as keywords to advertise competing products. She nonetheless accepted that the complainant was entitled to succeed and could rely on the current majority view of experts and this Expert agrees with that approach.

Paragraph 4.6 of the Nominet UK DRS – Experts' Overview refers to the appeal decision in *Seiko UK Limited v. Designer Time/Wanderweb* Nominet UK DRS 002480 (seiko-shop.co.uk - paragraph 8.1) and states that the real issue in a case such as this is whether the use in question, has "taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".

Applying that principle to the facts in the present case, this Expert is satisfied that the Respondent is putting the disputed domain name to a predatory use as distinct from an informative use necessary to guarantee the right of resale. This is not a case of balancing the Respondent's interest in informing its customers that it has FRONTLINE product for sale on the one hand and the Complainant's interest in restricting and controlling the use of its trademark.

In the abovementioned recent case *MERIAL (société par actions simplifiée) v. Med&Vet uk ltd Nominet* UK DRS No 10143 similar issues were addressed by the expert in the following terms:

“The Complainant says Oki Data (above) should be distinguished as a UDRP rule. However, in *Toshiba Corp. v. Power Battery Inc.* DRS 07991 the Appeal Panel said the Oki Data principles were broadly consistent with the Nominet Policy on resellers —but that its own summary of the position would be as follows:

- ‘1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of “initial interest confusion” and is not dictated only by the content of the website.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.’

These factors were derived from *Seiko UK Ltd -v- Wanderweb* DRS 00248 and *Epson Europe BV -v- Cybercorp Enterprises* DRS 03027 —and considered in detail by the Appeal Panel in *Toshiba* (above).”

Applying the four *Toshiba/Seiko* factors to the present case, the disputed domain name clearly incorporates the FRONTLINE mark. In the view of this Expert the use of the Complainant's trademark will create an initial interest confusion and there is nothing in the disputed domain name to prevent such confusion. In taking this view this Expert is applying Nominet UK DRS Policy and not trademark law principles.

The Respondent is using the Complainant's trademark as bait to attract customers and the manner in which he is using the disputed domain name encourages Internet users to switch to his other website where he sells competing products. In the view

of this Expert that is an Abusive Use of the Complainant's trade mark and the disputed domain name.

In the view of this Expert the Respondent's activity amounts to a bad faith and abusive use of the Complainant's FRONTLINE trademark and the disputed domain name. The Respondent is taking predatory bad faith advantage of the Complainant's trade mark and is damaging to the Complainant's business.

This Expert does not accept the Respondent's analogy that his activity is similar to placing an advertisement for the Complainant's goods in a shop to attract customers. It would be a better analogy to suggest that the Respondent is putting the Complainant's name over his shop to give the impression that the Complainant is the proprietor of the business.

In the circumstances this Expert finds that the disputed domain name is an Abusive Registration in the hands of the Respondent and the Complainant is entitled to succeed in its Complaint.

7. Decision

For the foregoing reasons, this Expert decides that the disputed domain name <buyfrontline.co.uk> be transferred to the Complainant.

Signed: James Bridgeman

Dated: 14 October 2011