

DISPUTE RESOLUTION SERVICE

D00010786

Decision of Independent Expert

Microsoft Corporation

and

Microsoft Slate Ltd

1. The Parties:

Complainant: Microsoft Corporation
One Microsoft Way
Redmond
WA
98052
United States

Respondent: Microsoft Slate Ltd
1 Stanton Cottages
Middle Road
Stanton St John
Oxford
OX33 1EY
United Kingdom

2. The Domain Name(s):

<windows8slate.co.uk>

3. Procedural History:

19 January 2012 19:57	Dispute received
20 January 2012 10:57	Complaint validated
20 January 2012 11:30	Notification of complaint sent to parties
13 February 2012 09:23	No Response Received
13 February 2012 09:24	Notification of no response sent to parties
22 February 2012 12:34	Expert decision payment received

28 February 2012	Complainant's application to adduce further evidence pursuant to paragraph 13(b) of the DRS Procedure
29 February 2012	Expert's decision to receive further evidence pursuant to paragraph 13(b) of the DRS Procedure

4. Factual Background

The Complainant is a corporation founded in April 1975 and which is engaged in the computing business. It is well known for its PC operating system under the name "Windows", much other software, hardware and related products and services.

The Respondent has registered the Domain Name on 20 August 2011 according to a Nominet WHOIS search. The website to which the Domain Name resolves is a holding page containing a number of links none of which appears to have anything directly to do with the Complainant or its business.

5. Parties' Contentions

Complainant's contentions

The Complainant states that it is a business established since April 1975 engaged in the computing business, including development, manufacture, licensing and support of a wide range of products and services. The Complainant says that it is a globally significant business, which has for the last 10 years been either the second or third most valuable global brand according to one assessment provided at Annex 1 to the Complaint. The Complaint points to its website at www.microsoft.com, which is itself a portal for consumers of the Complainant's products and services; the Complainant says that this is aimed at use in the home, at work, for IT professionals and for developers.

The Complainant says that it is currently involved in developing a "slate" device, which is a tablet computer to be built by Samsung but which will use the Complainant's Windows operating system. The Complainant expects that it will start sales of the device in 2012. The Complainant comments that there has been much public and press speculation about the forthcoming device, such as reviews of demo models, and the Complainant points to evidence of this included at Annex 2 of the Complaint.

The Complainant points to the Respondent's name as clearly showing the connection which the public will make between the Complainant and the forthcoming slate product as it has combined the Complainant's product's name with the word, "slate".

The Complainant asserts rights in the Domain Name as it is identical with or similar to a mark in which the Complainant has rights. The Complainant says that the Domain Name consists of the word, "WINDOWS", the number "8" and the word "SLATE". The Complainant says that it has both registered and unregistered rights in the word, "WINDOWS". The Complainant says that

connection of “SLATE” with “WINDOWS” strongly evokes the Complainant’s business as it has described it.

The Complainant points to various registered trade marks both in the UK and in Europe, including,

- UK 1512097: “WINDOWS” in class 9 dated 1 September 1992
- UK 1512098: “WINDOWS” in class 16 dated 1 September 1992
- UK 1529974: “WINDOWS” in class 41 dated 18 March 1993
- CTM 79681: “WINDOWS” in class 9 dated 1 April 1996
- CTM 1691963: “WINDOWS” in classes 35, 41 and 42 dated 6 June 2000

The Complainant provides details of these in Annex 3 to the Complaint and observes that the trade marks pre-date the Domain Name’s registration date by some years and, in two cases, by over 18 years.

The Complainant says that it was formed in April 1975 and has become one of the world’s largest and best-known companies. The Complainant states that it announced its Windows operating system in November 1985 and that it now has an estimated 82% of the market for client operating systems. The Complainant states that it is currently developing Windows 8.

The Complainant moreover asserts other protectable rights and in support of this points to its use of the WINDOWS mark, extensive worldwide press and TV coverage, as well as pointing out the reputation of the goods and service offered under the mark. The Complainant further asserts that it has established a highly recognisable, distinctive and enforceable reputation in its mark as well as registered rights.

The Complainant states that it has also registered domain names incorporating the trade mark “WINDOWS”, all of which it says are registered to the Complainant:

- windows.microsoft.com
- windows.co.uk
- windows.me
- windows.asia
- windows.com
- windows.net
- windows.biz
- windows.info
- windows.us
- windows.mx

The Complainant refers to Annex 4 to the Complaint which is a selection of articles referring to its Windows 8 operating system and showing the wide recognition of the term and its connection with the Complainant.

The Complainant says that the Domain Name was registered by the Respondent on 27 August 2011 and provides at Annex 5 to the Complainant a copy of the Nominet WHOIS search. The Complainant says that the Domain Name currently resolves to a holding page, which it attaches as Annex 6 to the Complaint.

On discovering the Domain Name, the Complainant says that it has sought to resolve the dispute. The Complainant says that its representatives, Olswang, wrote to the Respondents on 29 November 2011, alleging trade mark infringement and passing off, but offering to settle against a transfer of the Domain Name (among other things). The Complainant says that no reply was received. The Complainant says that Olswang wrote a second time on 14 December 2011 to which the Respondent replied by email that day to the effect that it was acting for a third party and would seek clarification and revert. The Complainant says that, since then, there has been no further communication.

The Complainant says that there is no evidence that the Respondent is using the Domain Name *bona fide* to offer goods or services but the Complainant claims that the Respondent actively wants to confuse the public into thinking that there is a connection between its website and the Complainant. The Complainant in support of this claim points to a conversation between the Respondent's representative and sole director, Russell Warner, and investigators, Farncombe International, whose report is attached as Annex 7 to the Complaint, when he stated that the Respondent has the "backing and accreditation" of the Complainant, which is not in fact the case according to the Complainant.

The Complainant says that the Respondent has no legitimate purpose for registering the Domain Name and that it would be inconceivable for the Respondent not to have actual knowledge of the Complainant's rights when registering the Domain Name. The Complainant says that there is no reason for the Respondent to have chosen the Domain Name other than to take advantage of the Complainant's reputation, as shown by the Respondent's stated intention to use the Domain Name for a website which will sell the slate tablet computer, and by the Respondent's incorrect assertion that its business has the Complainant's backing and accreditation, which the Complainant says it does not in fact have.

The Complainant says it is clear that the Respondent intends to use the Domain Name to divert customer traffic from the Complainant's website by using a domain name which incorporates the Complainant's well known trade mark, "WINDOWS"; "8", which is the number of the forthcoming version of Windows and the word, "SLATE", which is a product which will run the Complainant's software.

The Complainant observes that the Respondent cannot be commonly known by the Domain Name and it is not identified on the holding page to which the Domain Name resolves as offering any goods or services. The Complainant

asserts that the Respondent therefore has no trade mark rights in the Domain Name.

The Complainant claims that the Respondent has made no legitimate, non-commercial or fair use of the Domain Name and so it has no rights or legitimate reason for registering it and it cannot show that its registering of the Domain Name is not abusive.

The Complainant says that it has not consented to the use of the Domain Name by the Respondent.

The Complainant says that the Domain Name is an Abusive Registration under paragraphs 3(a)(i), (ii) and (iii) of the DRS Policy and relies on the following information.

As to paragraph 3(a) (i)(C), the Complainant says that the Respondent is unfairly disrupting its business, as it is using the Domain Name in which the Complainant has rights and is not doing so in connection with a *bona fide* offering of goods or services. The Complainant states that legitimate customers of the Complainant visiting in error a website to which the Domain Name resolves may, if or when the Respondent sets up a website instead of a holding page, choose to go to a competitor's website instead of to the Complainant's.

As to paragraph 3(a)(ii), the Complainant says that the Respondent has already indicated its intention to sell slates, and has stated that it has the Complainant's backing and accreditation, and so it is clear that the Respondent is intending to use the Domain Name in a way that is intended to and will confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to the Complainant. The Complainant says this will cause direct damage to the Complainant.

As to paragraph 3(a)(iii), the Complainant says that the Respondent's representative has also registered the domain name <microsoftslate.org>, another name in which the Complainant asserts rights, and in which neither the Respondent nor its representative has rights. Furthermore, the Complainant says that the Respondent has registered a company called Microsoft Slate Limited on 22 August 2011, 5 days before the registration of the Domain Name, which the Complainant says is intended to and will create further likelihood of confusion between the Respondent and it.

The Complainant concludes by saying that that, taking account of all the evidence and its submissions, it is not possible to conceive of any plausible actual or contemplated use of the Domain Name by the Respondent which would not be illegitimate.

Pursuant to paragraph 13(b) of the DRS Procedure, the Complainant has, with my consent, adduced further evidence relating to the Complaint.

The Complainant explained that, following the Respondent's receipt of the Complaint, the Respondent sent an email to the Complainant to say that the registration of the Domain Name was done on behalf of a client, First Metropolitan UG.

The Complainant says that Olswang, informing the Respondent that it would do so, thereupon contacted First Metropolitan so that it could explain the position and in that connection refers to Annex 3 of its paragraph 13(b) submission. The Complainant states that the reply of First Metropolitan UG, provided in Annex 3 to the paragraph 13(b) submission, was that it had not asked for, or agreed to, the registration of any domain names containing "WINDOWS".

The Complainant says that Olswang then wrote again to the Respondent enclosing Olswang's correspondence with First Metropolitan, which it has attached as Annex 4 to the paragraph 13(b) submissions. The Respondent's reply, attached as Annexes 5 and 6 to the paragraph 13(b) submissions, was to the effect that First Metropolitan was being investigated by the German courts and that it owed the Respondent money. The Complainant believes these emails have no relevance to the Complaint.

The Complainant says that Olswang received a letter from the Respondent, attached as Annex 7 to the paragraph 13(b) submissions. In this letter, which is from Liquid Finance Limited trading as Morfactor, it is said that the registration of the Domain Name was done on behalf of one Michael McGhee, and that all further correspondence should be directed to that individual.

The Complainant says that the correspondence included in the paragraph 13(b) submissions strongly indicates that the Respondent's registration of the Domain Name was abusive, and that the Respondent has acted in bad faith throughout. The Complainant asserts that the Respondent's representative has sought to pass blame to third parties and to discredit First Metropolitan so as to make his own story more credible.

Respondent's contentions

The Respondent has not made any submissions or provided any evidence in respect of this Complaint.

6. Discussions and Findings

Preliminary observations

While the Respondent has not made any submissions or provided any evidence, there is no "default" procedure in the DRS Policy and I have examined all the evidence so as to verify whether the Complainant has made out a valid case according to all the criteria of the DRS Policy.

Upon the Complainant's request, I agreed to permit it to submit further evidence pursuant to paragraph 13(b) of the DRS Procedure. As the Respondent had not made any submissions or provided any evidence in the

context of the Complaint, it seemed reasonable to me to receive further evidence of the communications between the parties which would provide me with as much evidence as possible upon which to base this decision.

There is one point of correction to make at the outset: the Complainant says that the Domain Name was registered on 27 August 2011, whereas the WHOIS information included as Annex 5 to the Complaint states that the date was 20 August 2011. This also means that the Complainant's assertion that the Respondent was registered on 22 August 2011 and therefore 5 days prior to the registration of the Domain Name cannot be correct. It is not clear how the registrant of the Domain Name was a company which did not technically exist until 2 days later. However, it is clear that the WHOIS inquiry shows, and I accept, that the registrant and current owner of the Domain Name is indeed the Respondent in this Complaint.

To make out an Abusive Registration, it is necessary for the Complainant to show that it has Rights as defined by the DRS Policy in respect of a name or mark which is identical or similar to the Domain Name and also that the Domain Name in the hands of the Respondent is an Abusive Registration. I shall look at these matters in order.

Rights

The Complainant has submitted evidence to show its rights in "WINDOWS". To this effect, it has adduced various trade mark registrations effective in the UK and the Community. It has also adduced evidence concerning the reputation of the Complainant in various sectors of the computing industry. I accept all this evidence. It is apparent from other decisions that the concept of "Rights" under the DRS Policy is a fairly low threshold, and I conclude that the Complainant's evidence shows that it has indeed "Rights" both registered and unregistered in "WINDOWS".

However, there is a further hurdle for the Complainant to cross, and that is set out in paragraph 2(a)(i) of the DRS Policy i.e. that the Rights must be "in respect of a name or mark which is identical or similar to the Domain Name". In other words, having established that it has Rights in "WINDOWS", is that mark identical or similar to the Domain Name (leaving out the generic suffix)?

The first point is that "WINDOWS" is of course identical with the first element of the Domain Name. However, it is not of course identical with the Domain Name as a whole, so the question is whether it is similar to the Domain Name taken as a whole.

I take account of the fact that the Complainant has registered trade marks in respect of "WINDOWS" and I also take account of the evidence produced by the Complainant as to the considerable marketing and reputation of its Windows product as giving it rights wider than just registered rights. When looking at the Domain Name, it seems to me to be clear that it is using the word "WINDOWS" not in its ordinary dictionary sense but in relation to the specific use of the word in relation to the Complainant's software product. I say this because of the materials produced by the Complainant in connection

with its forthcoming product, a tablet computer running Windows 8 i.e. the eighth version of the Windows operating system. The materials produced by the Complainant in Annex 2 to the Complaint often refer to the product under development as a “slate”, which I accept is another word for a tablet computer.

When looking at the Domain Name, apart from the opening element “WINDOWS”, the remainder of the Domain Name can therefore be seen as a sort of qualification of “WINDOWS”, making the reference more specific. It seeks to narrow down the reference to “WINDOWS” to a particular version of Windows running on a particular platform.

Taking account of all these matters, I therefore find that the Complainant has Rights as defined by the DRS Policy in respect of a mark which is similar to the Domain Name.

Abusive Registration

This is also a term defined by the DRS Policy, and it means a Domain Name which either

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

The DRS Policy goes on to give a non-exhaustive list of evidence of what can amount to Abusive Registration. This is set out in paragraph 3. The Complainant complains of Abusive Registration under a number of these paragraphs. However, there is set out in paragraph 4 a non-exhaustive list of matters which may be evidence that the Domain Name is not an Abusive Registration. I shall look at these in order.

Paragraph 3 of the DRS Policy

The Complainant has chosen some specific provisions from this paragraph and I will look at them in order.

Paragraph 3(a)(i)(C)

Under this sub-paragraph, I am concerned with “[c]ircumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily ... (C) for the purpose of unfairly disrupting the business of the Complainant”.

The Complainant points to the fact that there is no *bona fide* offering of goods or services. The Complainant also points to the fact that its customers might be confused when they visited any website to which the Domain Name resolves.

Of course, there is no webpage to which the Domain Name resolves at the moment, only a holding page, as the Complainant concedes; however, I am looking for “circumstances” which point to a primary purpose of unfairly disrupting the Complainant’s business, not actual disruption of the Complainant’s business at this point in time.

I take into account the report prepared by Farncombe International dated 16 November 2011, which indicates that the Respondent is likely to misrepresent to consumers its actual status in relation to the Complainant. More specifically, the Respondent has sought to assert that it has “the backing and accreditation of [the Complainant]”. The Respondent also claimed in that report to be “selling to OEM distribution channels, major corporates”. I also note the claims recorded as made by the Respondent in that report to being, in effect, a substantial entity with offices internationally as well as nationally when the Respondent is in fact a newly created entity; moreover, the Respondent provides confirmation that the product in question was a tablet computer to be developed by the Complainant.

It has already been seen in experts’ decisions under the DRS Policy that claims to accreditation or of being in some way approved by a complainant can lead to a finding of Abusive Registration. An example of this is to be found in DRS00248 <seiko-shop.co.uk>.

On the balance of probabilities, based on the evidence I have discussed above, I find that the Respondent’s primary intention when registering the Domain Name was to take advantage of the Complainant’s Rights by including them in the Domain Name and thereby unfairly disrupting the Complainant’s business by falsely claiming to be in some way approved by the Complainant, when it is not. I am not saying that the Respondent did this deliberately in order to harm the Complainant, but the evidence shows, on the balance of probabilities that he intended acts which would hold out to the public some sort of connection with the Complainant which did not exist. This might be by “initial interest confusion” or by a more thorough-going misrepresentation as to the relationship between the parties, but I find that the evidence shows that the grounds of Abusive Registration under paragraph 3(a)(i)(C) are made out

Paragraph 3(a)(ii)

Under this sub-paragraph, there is an Abusive Registration where there are “[c]ircumstances indicating that the Respondent is ... threatening to use the Domain Name in a way which ... 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 same evidence is relevant here as under the discussion of paragraph 3(a)(i)(C) above. With just a holding page at the moment, there is little risk of actual confusion, but the evidence I referred to above shows that the Respondent is holding itself out as being “accredited” by the Complainant.

On the balance of probabilities, the grounds of Abusive Registration under paragraph 3(a)(ii) are also made out.

Paragraph 3(a)(iii)

This sub-paragraph requires that 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 marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern”.

The Complainant points to the registration of <microsoftslate.org> and also the incorporation of the Respondent itself (“Microsoft Slate Limited”).

I do not think that two instances can form a pattern as such. I think more is called for in terms of domain names being registered over a period of time. I am not asked by the DRS Policy to take into account company names (for which a separate remedy is now available using different procedures).

That all being so, I do not accept that the Complainant has demonstrated the grounds for making out an Abusive Registration under paragraph 3(a)(iii).

Paragraph 4 of the DRS Policy

Paragraph 4 provides a further non-exhaustive list of factors, but this time aimed at showing that the Domain Name is not an Abusive Registration. The Respondent in this case has not provided any submissions or evidence in this Complaint, but I am still concerned to verify whether or not any of the factors in paragraph 4 are made out before coming to a conclusion on Abusive Registration.

The only grounds which seem to me to be potentially relevant here are paragraphs 4(ii) taken together with paragraph 4(b).

It would of course be possible for the Respondent to show that the Domain Name was intended to be used in connection with some sort of tribute site, or a site providing information about the Complainant’s tablet products such as reviews, where to buy, technical support and so on. Such uses might fall within the description of “fair use” – I say “might” because it is not an automatic conclusion and every decision must be based on its own facts.

In this case, the evidence provided by the Complainant, especially the report prepared by Farncombe International referred to above, does not point to any such fair use. I do not accept that the Respondent has in mind some sort of tribute or information site, but it has in mind something entirely different: a site which is intended to represent some sort of connection with or approval by the Complainant.

Conclusion

For the reasons set out above, my conclusion is that the Domain Name is an Abusive Registration.

7. Decision

I direct that the Domain Name should be transferred to the Complainant.

Signed Richard Stephens

Dated 14 March 2012