

DISPUTE RESOLUTION SERVICE

D00011470

Decision of Independent Expert

Norcros Group (Holdings) Ltd trading as Johnson Tiles

and

Mr P O Connor

1. The Parties:

Lead Complainant: Norcros Group (Holdings) Ltd trading as Johnson Tiles
Harewood Street
Tunstall
Stoke on Trent
Staffordshire
ST6 5JZ
United Kingdom

Respondent: Mr P O Connor
3 Standhouse Lawns
Kildare
Ireland

2. The Domain Name:

prismatics.co.uk

3. Procedural History:

14 June 2012	Dispute received
15 June 2012	Complainant invited to clarify Complaint under Rule 13b
19 June 2012	Complaint validated
19 June 2012	Notification of Complaint sent to parties prior to receipt of Complaint clarification
06 July 2012	No Response having been received, Response reminder sent

11 July 2012	No Response received
11 July 2012	Notification of no Response sent to parties
20 July 2012	Complainant's explanatory paragraph under Rule 13b received
28 July 2012	Complainant's additional submission received
4 August 2012	Expert appointed, having made Declaration of impartiality and independence
23 August 2012	Respondent provided with Complainant's additional submission and invited to respond by 28 August 2012
28 August 2012	No Response received

4. Factual Background (undisputed facts)

The Complainant manufactures and supplies in many countries ceramic wall and floor tiles under the trademark PRISMATICS, first registered in the UK on October 15, 1996 under No. 2112744 in the name of an affiliated company, H & R Johnson Tiles Limited and currently licensed to the Complainant.

The Domain Name was registered on October 6, 2011. When the Complainant became aware of it in February, 2012, the Domain Name resolved to a website headed "prismatics.co.uk" which offered the Complainant's tiles and also stated "To View our whole range visit www.TileSupply.co.uk". The name Tile Supply Ltd appeared in a copyright notice in fine print at the foot of that webpage. The Tile Supply Ltd website offered a wide range of tiles including ceramic, wall and floor tiles and listed numerous tile manufacturers including the Complainant. It described the prismatics.co.uk website as "our new sister website" for coloured tiles.

5. Parties' Contentions

The Complainant says Tile Supply does not stock Prismatics tiles. It arranges for the Johnson Tiles factory outlet to deliver direct to their customer or to their company address.

A letter was sent to Tile Supply advising that the use of "Prismatics" was a potential infringement of the registered trademark and seeking transfer of the Domain Name. No reply was received although the site was taken down. A subsequent letter noted that the website was not being used and again sought transfer of the Domain Name. No reply has been received. Both letters were sent by recorded delivery.

Prismatics is one of Johnson Tiles major product brands with an established recognition amongst the trade in particular. The product is widely used in both the public and private sectors and has gained a reputation for quality, longevity and colour consistency. The registration of the Domain Name by the Registrant represents to the trade and public that the sales of Prismatics tiles are authorised by Johnson Tiles and/or the use of the Domain Name is with the consent of Johnson Tiles. Through the use of the trademark Prismatics, Johnson Tiles have

goodwill in the trademark which is liable to be damaged by the Registrant's actions.

6. Discussions and Findings

Under the Nominet Dispute Resolution Policy ("the Policy"), to succeed in a claim for transfer of the Domain Name, the Complainant is required to prove, on the balance of probabilities, that it has Rights in respect of 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.e. that it is 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.

Under section 3 of the Policy, a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration includes:

- 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.

The Complainant has shown that, as licensee of its affiliated company, it has rights in the UK registered trademark PRISMATICS. The Domain Name comprises that trademark, with the addition of the inconsequential generic domain suffix ".co.uk". Accordingly the Complainant has established that it has rights in a mark which is identical to the Domain Name.

Although the connection between the Respondent and Tile Supply Ltd is not clear, the conclusion is inescapable, especially in the absence of any Response, that the Domain Name has been used by Tile Supply Ltd, with the consent of the Respondent, to promote both the Complainant's products and the competing products of other tile manufacturers. Prior to the site being taken down following the initial letter from the Complainant to Tile Supply Ltd, Internet users seeing the Domain Name or the site to which it was connected were likely to believe that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The failure to respond to the Complainant's letters leads to the conclusion that, if transfer were not ordered in this proceeding, it is likely the previous use will be resumed. Accordingly the Expert concludes 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.

It follows that the Complainant has established that, in the hands of the Respondent, the Domain Name is an Abusive Registration.

7. Decision

I find that the Complainant has proved, on the balance of probabilities, that it has rights as licensee in the UK registered trademark PRISMATICS which is identical to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. I therefore direct that the Domain Name be transferred to the Complainant.

Signed Alan Limbury

Dated September 7, 2012.