

DISPUTE RESOLUTION SERVICE

D00013009

Decision of Independent Expert

ADP Dealer Services UK Limited

and

Network Needs Limited

1. The Parties:

Complainant: ADP Dealer Services UK Limited
Cygnet Way
Charnham Park
Hungerford
Berkshire
RG17 0YL
United Kingdom

Respondent: Network Needs Limited
2nd Floor The Platinum Building
St John's Innovation Park Cowley Road
Cambridge
CB4 0DS
United Kingdom

2. The Domain Name:

kerridgetraining.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

27 June 2013	Dispute received
27 June 2013	Complaint validated
27 June 2013	Notification of complaint sent to parties
16 July 2013	Response reminder sent
18 July 2013	Response received
18 July 2013	Notification of response sent to parties
23 July 2013	Reply reminder sent
25 July 2013	Reply received
25 July 2013	Notification of reply sent to parties
25 July 2013	Mediator appointed
30 July 2013	Mediation started
27 August 2013	Mediation failed
27 August 2013	Close of mediation documents sent
06 September 2013	Complainant full fee reminder sent
09 September 2013	Expert decision payment received

4. Factual Background

The Complainant

The Complainant is said to be the market leader in the UK market for Dealer Management Systems (DMS) with its Autoline series of products. A DMS is a category of enterprise resource planning software that is specifically tailored to the needs of automotive dealers. A DMS requires significant training for end users.

In addition to licensing its Autoline DMS, the Complainant provides hosting, consultancy, training and other services in relation to the DMS and the IT needs of automotive dealers generally. The

Complainant's training offering involves a range of options, including both traditional classroom-based training sessions and e-learning solutions.

Prior to its acquisition by the Automatic Data Processing group in 2006, the Complainant was privately held and known by its registered company name, Kerridge Computer Company Limited. A Certificate of Incorporation on Change of Name dated 30 June 2006 evidences the change of name.

The Complainant is the owner of United Kingdom trade mark number 2537463 for the word mark, KERRIDGE, registered on 30 April 2010 for goods and services in Classes 9, 35 and 42. The specification includes, 'computer programs to transfer data between dealers, motor manufacturers, importers and other third party concerning parts, warranty service, vehicles and finance', (Class 9), 'advertising, promotion, marketing and communication consultancy and assistance in the retail motor industry and associated trades' (Class 35) and 'Computer services, consultancy, design, testing, research and technical support in the field of computing, more particularly in the retail motor industry and associated trades' (Class 42).

The Respondent

The Respondent's (main) website at www.networkneeds.co.uk (referred to in the Complainant's Reply) describes its offering as follows '*professional IT business solutions and support... Our consultants have extensive experience in providing training and solutions for Dealer Management Software, server hosting and data storage*'. It is also said, under a heading '*Kerridge Autoline Consultants*' that '*If you need assistance installing a Kerridge Autoline system, we can help. But our services don't stop there. We can also provide you with full training and will continue to manage the Kerridge Autoline Dealer Management Software on your behalf*'. It goes on to mention specific Kerridge products and other services it provides.

The domain name in dispute (the Domain Name) was registered by the Respondent on 26 November 2008. It points to a webpage of

the Respondent which is headed 'Kerridge Training Solutions' and which describes various services under the heading 'NN Training'. It is said that '*APD support and Keridge training is provided by Network Needs, providing full level support and many other benefits.*' and that '*Network Needs are able to provide Autoline Kerridge server hosting, remote backup routines....*'.

At the bottom of the web page, it is said that '*We are not registered to, operated by or otherwise connected to ADP...The word KERRIDGE is only used to show the intended purpose or our training services and we are 'Honest' with the services we provide.*'

The parties' relationship

It seems that there is no current dispute as to the content of the Respondent's main site at www.networkneeds.co.uk or indeed the content of the webpage to which the Domain Name points. In fact, the parties appear to be in regular communication in relation to customers needs. Evidence of such communication has been provided by the Respondent from as far back as 2008, up to just before the date of the Complaint. The most recent communications (in June 2013) shows the Complainant corresponding with a customer on an issue, subsequently copying-in a member of the Respondent's staff and later providing his contact details. The e-mail address of the Respondent's member of staff is '@networkneeds.co.uk. Whilst the Complainant notes (in its Reply) that some of the e-mails the Respondent refers to appear to come from a customer account, the Complainant does not appear to object to the Respondent carrying on its business in the way that it is, including using the Complainant's trade marks to describe the services that it offers. It does however object to its use of the Domain Name.

Past dispute

In April 2009, solicitors for the Complainant wrote to the Respondent, alleging infringement of a number of its intellectual property rights, including, at that time, its rights in the unregistered mark, 'KERRIDGE'. The letter also listed a number of domain names, including kerridgetraining.co.uk and alleged that they were

abusive registrations. The letter sought undertakings, including the transfer of domain names. The Respondent instructed solicitors who wrote to the Complainant's solicitors on two occasions in May 2009, but received no reply. They wrote again on 17 June 2009, saying that they were surprised not to have received a reply to their earlier correspondence but that their clients took the Complainant's allegations seriously, that they had taken various steps in connection therewith (including the transfer of a number of 'websites') and regarded the matter as closed. The 'websites' that the Respondent's solicitors said they had arranged to transfer did not include the Domain Name. It appears that the correspondence ended with that letter of 17 June 2009. No response was received from the Complainant's solicitors.

5. Parties' Contentions

The Complaint

- Although the Complainant's DMS product is now sold under its registered product name, Autoline, it is still widely referred to in the UK automotive community by the former name of the Complainant, 'Kerridge', in which there is still significant goodwill.
- The fact that the Respondent chose to use the Domain Name incorporating the word 'Kerridge' in order to promote its services in relation to the Autoline software is evidence of the goodwill in the Kerridge name.
- The Domain Name and the website to which it points are aimed at automotive customers who constitute the Complainant's target market and the Complainant submits that the purpose of the registration and use of the Domain Name is to divert Internet users that are searching for information about:
 - (a) Kerridge software, programs and systems in the automotive sector; or
 - (b) training services provided by the Complainant in

respect of their Kerridge systems.

Such Internet users are being targeted by the Respondent for the purposes of diverting them to its own website, specifically for the purposes of creating interest in its services. This both takes unfair advantage of, and is unfairly detrimental to, the Complainant's rights in its KERRIDGE trade mark.

- The Respondent's use of the Domain Name may mislead customers into believing that the services it provides in respect of Kerridge software and associated programs are authorised, licensed or endorsed by the Complainant. This is because "kerridge" is the dominant, significant and distinctive part of the Domain Name. No other name or word has been incorporated within the Domain Name which would make it clear that the Respondent is independent of the Complainant. The addition of the word 'training' within the Domain Name is entirely descriptive and fails to identify the Respondent as a commercial undertaking that is wholly separate from the Complainant.
- The Respondent has used 'Kerridge' on its website in such a way as to reinforce the misleading impression of some form of formal association with the Complainant or that the Respondent is the owner of the KERRIDGE brand e.g. the heading 'Kerridge Training Solutions' and the comment that *'APD [sic] support and Keridge [sic] training is provided by Network Needs, providing full level support and many other benefits'*.
- An Internet user is likely to believe on entering the Respondent's site that its business is affiliated to the Complainant in some way or that there is a special relationship between them concerning Kerridge.
- In so far as the 'disclaimer' referred to earlier is concerned (at the bottom of the web page to which the Domain Name points), the Complainant says that such statements are insufficient to avoid the misleading impression already

created by use of the Domain Name, not least because the Internet user would not see the disclaimer until he had already looked at the (preceding) content of the site. Moreover, that the Respondent has seen fit to include such statements is itself evidence that the Domain Name being used in the way that it is, and the content of the site to which it points, would otherwise suggest a misleading affiliation with the Complainant.

The Response

- The Respondent disputes the Complaint
- The Complainant has been aware of the Respondent's use of the Domain Name since at least April 2009 and of the provision by the Respondent of training services in connection with the Kerridge software product since 2008.
- The Complainant has actively condoned the Respondent's use of the Domain Name and the provision by the Respondent of training services in connection with the Kerridge software product, and the Respondent has actively co-operated with, and assisted the Complainant, since at least May 2008.
- The European Court case of *The Gillette Company & Gillette Group Finland Oy v LA-Laboratories Ltd Oy [Case C-228/03]* establishes that use of another party's registered trade mark is legitimate and permissible where such use is necessary to describe the product or services to which the complaint relates and where such use is in accordance with honest business practices.
- The Respondent's use of the mark 'Kerridge' within the Domain Name is merely descriptive of the nature of the services provided by the Respondent and its services could not adequately be described (without unduly complex or technical language) or promoted without such use. As such, the Respondent's use of the Domain Name is, and has

always been in accordance with honest practices in industrial and commercial matters, and not abusive.

- In 2009, the Complainant unilaterally abandoned a legal complaint in connection with the Domain Name in circumstances where the Respondent had made it clear that it intended to continue to use the Domain Name. Since that time, and in reliance upon the Complainant's abandonment of its complaint, the Respondent has invested significantly in the use and promotion of the Domain Name.
- The Respondent relies generally on the communications between the parties (or their legal representatives).
- The Respondent's registration of the Domain Name (26 November 2008) pre-dates the registration of the Kerridge trade mark (30 April 2010) by some 17 months.
- The Respondent submits that it was obvious to the Complainant in June 2009 that:
 - a) the Respondent intended to continue to use the Domain Name, and
 - b) that, by failing to raise further complaint, the Complainant implicitly accepted and condoned the Respondent's continued use of the Domain Name.
- The Respondent's website to which the Domain Name points includes an express statement which disclaims any connection or endorsement by the Complainant.
- The Respondent, in an attempt to amicably resolve the dispute, is willing to amend its website to which the Domain Name points by inserting a page prior to the site itself which would state that the Respondent is neither affiliated nor connected in any way with the Complainant and that it is not the owner or operator of the KERRIDGE brand. This would ensure that all users of the site were fully informed prior to it being accessed.

The Reply

- The Complainant does not dispute that the Respondent is engaged in the business of providing consultancy services in relation to the software and systems that it provides to mutual customers, or claim to be unaware that the Respondent is engaged in that business (to which it does not object).
- The Complainant has not '*actively condoned the Respondent's use of the Domain*' and there is nothing in the evidence submitted to support this.
- As to the passage of time since the correspondence between solicitors in 2009, and the suggestion that the Respondent has '*significantly financially invested in the use and promotion of the Domain.*', the Complainant again denies it has condoned the use of the Domain Name and says of the delay that it is due to '*naturally competing priorities in protecting a large portfolio of intellectual property*'. It also says that there is no evidence of the alleged financial investment by the Respondent, commenting that the site to which the Domain Name points has little content and contains errors. For these reasons the Complainant finds the Respondent's assertions implausible, particularly as the Respondent's main site at www.networkneeds.co.uk contains much more detailed and apparently recent content than the site to which the Domain Name points.
- As for the registration of the Domain Name pre-dating registration of the Kerridge mark, the Complainant says that the Kerridge name is and was for many years before the registration of the Domain Name, well known in the UK automotive market and was understood to refer to the Complainant's products. Accordingly, the Complainant owned significant goodwill in the unregistered trade mark before its registration in April 2010. The Complainant goes on to say that, like most brand owners, it keeps its portfolio of intellectual property under regular review and from time to

time will take the decision to invest in the registration of marks that had previously been unregistered, and that registration of the KERRIDGE mark in 2010 does not in any way suggest that there was no goodwill in the mark prior to registration. The Complainant also notes that its application for registration was published by the UK IPO in 2010, and that the Respondent had the opportunity to object to registration at that time (which it did not do).

- The Complainant does not dispute the principles espoused in *The Gillette Company & Gillette Group Finland Oy v LA-Laboratories Ltd Oy*, just their relevance to this dispute. That is because, as the Complainant states, '*The subject of this complaint is not the content of the Respondent's website - which contains many references to ADP's trade marks as do other websites maintained by the Respondent - but the use of ADP's registered mark within the Domain itself.*' The Complainant goes on to say that use of the trade mark within the Domain Name is not necessary for the Respondent to describe its services as those services are perfectly adequately described within the site to which the Domain Name points, including by reference to the Complainant's registered trade marks. This is also the case on the Respondent's other sites, including its main site at www.networkneeds.co.uk.
- The Complainant does not consider the Respondent's proposal to insert a further disclaimer as being an adequate remedy - the damage will already have been suffered if potential customers have been led to the Respondent's site by its misleading Domain Name.
- The Complainant makes clear that it does not wish to prevent the Respondent from carrying on any legitimate business, and acknowledges that the Respondent is entitled to refer to its registered trade marks in describing the services that it offers. The Respondent can and does do exactly that on the site it maintains under the domain name www.networkneeds.co.uk. It does not need to use the Domain Name for that purpose.

6. Discussions and Findings

Under the provisions of Nominet's Dispute Resolution Service Policy (the Policy), for a Complaint to succeed, a 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 in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's 'Rights'

The meaning of 'Rights' is defined in the Policy as follows:

'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'.

The Complainant enjoys registered rights in the mark KERRIDGE. The Panel is also satisfied that the Complainant enjoys unregistered rights in the mark as a result of longstanding use in relation to the sale of its products and services over many years.

The Domain Name encapsulates the Complainant's mark KERRIDGE in its entirety. It is the first and dominant word of the Domain Name, being followed by the descriptive word 'training'. The Complainant's mark and Domain Name are similar.

Accordingly, the Expert is satisfied that the Complainant has Rights in a name or mark that is similar to the Domain Name.

The Expert must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'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 which 'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights;'

Paragraph 3(a) of the Policy provides a guide as to what might constitute an Abusive Registration. It contains a non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant (or a competitor) for valuable consideration in excess of the Respondent's out-of-pocket costs, as a blocking registration against a name or mark in which a Complainant has rights, or for the purpose of unfairly disrupting the business of a Complainant.

Other factors suggesting an Abusive Registration include the Respondent 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.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This paragraph contains a guide as to what does not constitute an Abusive Registration and is dealt with further below.

Discussion

The Domain Name incorporates the Complainant's mark and is very much its dominant element, being a mark of some note in the automotive sector in which it is used. It is then followed by the descriptive term, 'training' which does nothing to lessen the potential for confusion given that it is probably the case that Internet users looking for a 'Kerridge' product, will probably be aware of the need or desirability for, or at least the availability of training on that product. In fact, the use of the word 'training' may even compound the potential for confusion.

Accordingly, there is a possibility that Internet users may be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

On the face of it therefore, absent any persuasive countervailing factors, there could be grounds for a finding of Abusive Registration on the basis that 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. It is this ground on which the Complainant appears to rely.

Given the above, the Expert must now examine, the Complainant having established that the Respondent has a case to answer, whether the Respondent has an answer to the case.

Such an examination invariably involves a review of Paragraph 4 of the Policy for it is that paragraph, as mentioned earlier, which sets out matters which, if established to the satisfaction of the Expert, are likely to be regarded as a satisfactory answer to the Complainant's case. However, the matters set out in Paragraph 4 are not exhaustive and the Panel is entitled to examine any suggested countervailing factors raised by the Respondent. Nevertheless, Paragraph 4 is a good starting point.

Paragraph 4(a) of the Policy provides:

“A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

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 or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

- C. made legitimate non-commercial or fair use of the Domain Name; or*
- ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it*
- iii.....”*

As Paragraph 2 (and indeed the examples of countervailing factors in Paragraph 4) of the Policy makes clear, an Expert must consider the question of Abusive Registration by examining the ‘...*Domain Name, in the hands of the Respondent...*’. Thus one must examine the actual Respondent in the case and the actual use or otherwise made by that Respondent, not a hypothetical Respondent or hypothetical uses by the actual Respondent. It should be unsurprising that a domain name could be an Abusive Registration in the hands of one Respondent, but not another.

The Respondent says that the Complainant has been aware of (and condoned) the use of the Domain Name since at least April 2009 and of the provision by the Respondent of training services in connection with the Kerridge software product since 2008. It is also said that there has been cooperation between the parties since at least May 2008. As to the circumstances surrounding the solicitors’ correspondence in 2009, the Respondent maintains that the Complainant ‘*implicitly accepted and condoned the Respondent’s continued use of the Domain*’.

The use made of the Domain Name in either May 2008 or April 2009 (or between those dates) is not entirely clear but by April 2009, the Complainant saw fit to complain. Whilst it may well be the case that the Complainant had justified cause for complaint at that point, the analysis cannot be left there. The last letter in connection with the 2009 complaint is from the solicitor’s for the Respondent and it lists the domain names it is giving up. Importantly, the list did not include the Domain Name (included as a source of complaint in the Complainant’s solicitors’ letter). The Respondent heard nothing further about the complaint (until the Complaint herein) for over 4 years, during which time the parties have clearly communicated with one another on other matters.

In these circumstances, the Panel takes the view that the Respondent was entitled to regard the complaint in relation to the Domain Name as at an end in June 2009, (or at least at an end by a sensible period thereafter), was justified in believing that the Complainant no longer took issue with its use and was thus entitled to continue its use. Accordingly, the Panel is of the view that the Respondent has an answer to the Complaint.

The Panel should add that no real explanation has been forthcoming as to why the Complainant has only now, four years after it originally complained, resurrected the matter apart from it saying that the delay is due to *'naturally competing priorities in protecting a large portfolio of intellectual property'*. Given that the process under Nominet's DRS Policy is relatively inexpensive, the Panel does not consider that a particularly convincing explanation. It certainly does nothing to suggest that the Complainant, (whatever the position pre-June 2009) now believes that there is real detriment (or a fear thereof) in the Respondent's continued use of the Domain Name.

Moreover, the Panel is mindful of the specialist nature of the market in which the Kerridge name has prominence (the Complainant talks of the *'UK automotive community'*), and the likelihood of market knowledge and sophistication on the part of those looking for Kerridge related services lessening or extinguishing the possibility of any confusion and/or detriment.

7. Decision

In all the circumstances, the Expert finds that the Complainant has rights in a name or mark that is similar to the Domain Name but is not satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Panel directs that no action be taken on the Complaint.

Signed: Jon Lang

Dated: 4 October 2013