

DISPUTE RESOLUTION SERVICE

D00016133

Decision of Independent Expert

Raptor Engineering Limited

and

First Discount Ltd

1. The Parties:

Lead Complainant: Raptor Engineering Limited
2 Fox Lane View
Sheffield
South Yorks
S12 4UY
United Kingdom

Respondent: First Discount Ltd
Chelwood, Yarkhill
Hereford
HR1 3SS
United Kingdom

2. The Domain Name:

raptor4x4.co.uk

3. Procedural History:

I can 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 they

might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

23 June 2015 21:36	Dispute received
24 June 2015 10:18	Complaint validated
25 June 2015 09:07	Notification of complaint sent to parties
10 July 2015 11:57	Response received
10 July 2015 11:58	Notification of response sent to parties
13 July 2015 12:00	Reply received
13 July 2015 12:01	Notification of reply sent to parties
13 July 2015 12:01	Mediator appointed
16 July 2015 10:07	Mediation started
27 July 2015 15:31	Mediation failed
27 July 2015 15:32	Close of mediation documents sent
06 August 2015 02:30	Complainant full fee reminder sent
11 August 2015 10:17	Expert decision payment received
11 August 2015 13:25	Sent expert decision pack, expert appointment and conflict check documents

Paragraph 13b submission

On 11 August 2015, a request, by way of an explanatory note under paragraph 13b of Nominet's Dispute Resolution Service (DRS) Procedure was lodged by the Complainant. The Complainant wished to submit additional evidence supporting the contention that RAPTOR 'is our Brand' Being a 'non-standard' submission, it was in the discretion of the Expert to allow such further evidence. The Expert did so allow the further evidence, which is described below, although it has made no material difference to this Decision.

Enquiries by the Expert

In preparing this Decision, the Expert has found it appropriate to conduct a few basic online enquiries or reviews as Experts are permitted to do under paragraph 16a of the DRS Procedure. The precise nature of those enquiries and reviews will be clear from the narrative that follows.

4. Factual Background

The Complainant, Raptor Engineering Limited, was incorporated on 15 May 2009. It has been trading for around 6 years. The Complainant is the family business of a Mr. Phil Proctor and his wife. A search carried out through Nominet's WHOIS tool shows that Mr. Proctor registered the domain name, raptor-engineering.co.uk, on 13 May 2009.

The Complainant designs and manufactures products for the 4x4 market, mainly for Land Rover interiors, such as consoles and glove boxes.

Since incorporation, the Complainant has been taking stands at trade shows.

A UK trade mark application for RAPTOR was filed on behalf of the Complainant on 24 June 2014 in Class 12 for, inter alia, interior fittings and exterior parts and accessories for off-road and 4x4 vehicles.

The Respondent is a multi-channel retailer. It is also a family business, run by a Mr. Andrew Wright and a Mr. Steven Wright (father and son). Both are Directors of the Respondent. The Respondent registered raptor4x4.co.uk, the domain name in dispute (the Domain Name) on 13 January 2015. The Respondent offers a wide range of products in various sectors, including in the automotive field. It has a website at www.firstdiscount.co.uk. A search carried out through Nominet's WHOIS tool by the Expert shows that Andrew Wright registered the domain name www.firstdiscount.co.uk on 13 March 2012.

5. Parties' Contentions

A summary of the Complainant's main contentions are as follows:

- The Complainant has built up a good following and name in the 4x4 market. It is generally known as Raptor, for instance on Land Rover forums, (rather than Raptor Engineering), and internet searches are commonly undertaken using Raptor alone.
- As well as having an online presence and good Google ratings, the Complainant has been active at trade shows. At some such shows the Respondent has had a stand next to that of the Complainant selling homewares, but nothing 4x4 related.
- The Respondent has advised the Complainant that it intends to trade using the Domain Name as it will be importing goods from an Italian company which has registered the domain name, raptor4x4.net.
- The Respondent's use of the Domain Name will cause confusion and take advantage of Internet users searching for the Complainant. Presently, the Complainant receives about one call a month from people seeking the Italian Raptor 4x4 product. This is likely to increase significantly if the Respondent trades using the Domain Name.
- The Complainant is concerned that if the Respondent trades under the name Raptor without knowing much about Land Rovers, and gets a bad name, that will reflect badly on the Complainant's business.
- The Complainant has no objection to the Respondent selling Raptor 4x4 products, but objects to it doing so under the Raptor name.
- The Respondent is using the Complainant's good name and reputation to boost its own ratings. There will be confusion in the market place

and it will be assumed that the Complainant and Respondent are one and the same.

A summary of the Respondent's main contentions are as follows:

- The Respondent has several websites and marketplace listings on Ebay and Amazon. It also makes direct sales at shows and exhibitions at which its business is promoted. 4x4 equipment is exhibited at off-road shows.
- Both Directors of the Respondent are keen off-roaders, own modified 4x4 vehicles and are members of off-road clubs. This experience and knowledge has been used to source a range of 4x4 products.
- The Respondent imports its own branded 4x4 products from the Far East, and also imports 4x4 accessories from Holland.
- The Respondent has been in negotiations with an Italian company, Saglietti S.r.l. in relation to its (Saglietti's) range of off-road products manufactured in Italy and Germany and sold under the Raptor4x4 brand. Saglietti's website is at www.raptor4x4.it. Its Raptor4x4 products are an off road equipment range which enhance and support vehicles in off road situations. The products are functional, not cosmetic.
- Saglietti had been looking for a UK distributor. Terms were agreed between Saglietti and the Respondent, and the Respondent started selling Raptor 4x4 products last year. The market has been tested and an official launch of the full Raptor 4x4 product range is planned. The Respondent has the authority of Saglietti to use the Raptor4x4 brand within the UK and a UK website for the Raptor 4x4 range (at www.raptor4x4.co.uk) will be launched. Expanding the Respondent's range of products and distributing Raptor4x4 products in the UK is part of the Respondent's business growth strategy.
- The term Raptor is widely used in the 4x4 market, for instance, there is a Ford Raptor 4x4 pick up truck and a Yamaha Raptor 4x4 Quad Bike. A Google search for 'Raptor' will return references to Dinosaurs, Birds, etc. Raptor Engineering (the Complainant) appears on page 6.
- A Google search for 'Raptor Off Road' returns the Respondent's supplier (www.raptor4x4.it) on page 1, and the Respondent itself on page 5 (in respect of a Raptor 4x4 product being sold on Ebay). Raptor Engineering do not appear in the first twenty pages of the results. A search for 'Raptor 4x4' achieves a similar result.
- The Respondent sells a range of over 800 specific off-road products for 8 vehicle makes - Isuzu, Kia, Land Rover, Mercedes, Mitsubishi, Nissan, Suzuki and Toyota. These products include roll cages, suspension, rock sliders, wheel spacers, differentials, winch bumpers etc.
- The website of the Complainant shows only 26 products for the Land Rover Defender and Discovery. These are all internal fittings,

- dashboards and boxes for cosmetic use which enhance the internal appearance of the vehicle. The Complainant does not supply products that enhance or support off-road vehicle performance such as bumpers, suspension, differentials, roll cages etc.
- Registration of the Domain Name is not an Abusive Registration.
 - Having researched and tested Raptor 4x4 products since meeting Saglietti in Frankfurt 2014, and becoming their UK distributor, the Respondent has invested heavily in stock, website development, marketing and research.
 - The Domain Name is a direct reflection of the brand Raptor4x4 in which the Respondent has a legitimate interest.
 - The term 'Raptor' is a generic term used for cars, quads, planes (as well as software and dinosaurs).
 - The Respondent is selling Raptor4x4 products in the UK and is therefore making fair use of the Domain Name. It is a legitimate registration.
 - The Respondent does not sell or intend to sell Land Rover dashboards and therefore cannot have any impact on the Complainant. A review of website rankings and traffic supports the view that there will be no impact on the Complainant.
 - The Respondent has known the Complainant for several years and has discussed selling Raptor4x4 products previously. The Respondent has been selling some of the Raptor4x4 range since last year and is therefore surprised at the reaction of the Complainant, it having previously seen the Respondent selling Raptor4x4 products at trade shows.
 - The Complainant contends that the Respondent sells 'nothing 4x4 related', despite it having previously seen the Respondent's product range at trade shows and, moreover, that its range of 4x4 products can be seen on its website at firstdiscount.co.uk, and also on Amazon.co.uk and Ebay.co.uk.

The Complainant replied to the Response of the Respondent. A summary of the main points are as follows:

- Whilst the term Raptor may well be widely used in the 4x4 market, in the UK, the Complainant is the only 'Raptor' selling after-market parts and upgrades for Land Rovers and 4x4 vehicles.
- The Ford Raptor and Yamaha Raptor would never be confused with the Complainant's product.
- If a Google search is carried out for 'Raptor landrover', the entire first page of results refers to the Complainant or its products, many of the results being references to forums where the Complainant is referred to as Raptor.
- Whilst a search for 'Raptor off Road' will return Raptor4x4.it, this is not a .co.uk and the owner of that registration is not in the UK.

- The statement that the Complainant only sells 26 products is incorrect; it manufactures for many of the after-market 4x4 suppliers who also attend trade shows but these products are exclusive to them and do not appear on the Complainant's web site.
- Although the Complainant does not make and sell products to enhance off-road capability for sale on its own web site, it does make such products for others.
- The Complainant's concern is that the market place should not be confused and that there is a clear dividing line between the Respondent's products and the products sold on the Complainant's web site. It is also to protect the 26 products that the Complainant has invented, designed and manufactured, and the associated part of its business. There are new products on the drawing board and they are also self-manufactured interior products.
- It is not necessary to have the name Raptor to sell Raptor products. For instance, the Complainant's agents in Australia and USA sell Raptor product but they are not called Raptor. As the Respondent sells 800 different off-road products, the vast majority of which are not Raptor4x4 products, the Complainant suggests it (the Respondent) does not need the Domain Name, (even if it does need a name other than First Discount that is more in keeping with 4x4 products).
- The Complainant has offered a link on its web site directing customers to the Raptor4x4 product on any website of the Respondent (as well as help generally so that it is known where Raptor4x4 products can be bought).

As earlier mentioned, the Complainant has submitted, and the Expert has allowed, further evidence pursuant to paragraph 13b of the DRS Procedure. Essentially, the evidence is further substantiation of the earlier contentions of the Complainant and comprises and/or illustrates:

- a print out of entries on an online forum in which users have made such comments as *'Ref the new Defender Binnacle from Raptor...'* and *'Got a Raptor Dash...'*
- that the Complainant refers to itself as Raptor on merchandising and sales adverts
- the marketing material used at a trade show by the Respondent – banners and plastic bags – referring to 'Raptor 4 x 4'
- a 'Raptor 4x4' business card on which is printed the website address at www.raptor4x4.co.uk i.e. the Domain Name (and the Complainant contends that the symbol ® which is used on the business card alongside the name Raptor 4x4, should not be so used as the Respondent does not have a registered trade mark in the UK)
- the Complainant's trade mark application for Raptor in Class 12, with a filing date of 24 June 2015
- a letter concerning a trade show said to show confusion between the

- Complainant and Respondent on the part of a promotions company
- evidence of attendance by the Complainant at various trade shows and and also its Companies House Registration certificate
- a letter from the Complainant's trade mark attorneys referring to the Complainant's trade mark application and also that of the Respondent, for Raptor 4x4/Raptor4x4 and what might be done in relation thereto, plus an extract from the same or different letter (but from the same trade mark attorneys) concerning passing off.

The Complainant also says that the name Raptor is a coined term which came from the name of Mr. Proctor's son, Adam Proctor who designed the Complainant's first website, Raptor being an anagram of A Proctor.

6. Discussions and Findings

Under the provisions of the DRS 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 has no registered trade mark rights. Its trade mark application for RAPTOR has not yet been determined and in and of itself will not constitute 'Rights' under the Policy. However, an applicant for a trade mark may have separate parallel unregistered rights in the mark in question which, if sufficiently demonstrated, will constitute Rights for the purposes of the Policy.

These are rights afforded by the law of passing off and are often used to found a complaint. In any action for passing off under English law, a claimant must satisfy three elements – the 'classic trinity': goodwill or reputation associated with the name (or get up) of the products or services offered by the claimant; a misrepresentation by the defendant to the public resulting or with the likely result that the public believes that his goods or services are those of the claimant; and damage to the claimant. It is the first element that Nominet Experts are concerned with, namely goodwill and reputation, for if either can be demonstrated, and the other elements of passing-off satisfied, such goodwill or reputation would ordinarily be protectable.

It should be borne in mind however, that even if goodwill or reputation associated with a name (or get up) of products or services offered by a complainant are demonstrated, that does not mean that passing off is also established. There is

simply no need for an Expert to consider the other elements of passing off – misrepresentation and damage, because Experts under the DRS are not deciding whether there has in fact been passing off, but only that a complainant has standing to bring a complaint. Moreover, whatever analysis might be propounded in terms of intellectual property law, a Complainant must still satisfy the requirements of the Policy.

It has been stated in many DRS decisions that the test for demonstrating Rights is at a relatively low threshold. As paragraph 2.3 of the DRS Expert Overview (Version 2) puts it '*...the first hurdle (i.e. proving the existence of rights in a relevant name or mark) is intended to be a relatively low-level test. Issues relating to confusion are best addressed under the second hurdle. The objective behind the first hurdle is simply to demonstrate a bona fide basis for making the complaint.*'

As low threshold as the test might be however, when dealing with unregistered rights '*...evidence needs to be put before the Expert to demonstrate the existence of the right. This will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results)*' (paragraph 2.2 of the Expert Overview).

Moreover, when dealing with rights in descriptive or generic terms (being more difficult to acquire than rights in distinctive terms, given the lower likelihood that any one person could acquire for themselves the necessary goodwill or reputation in them), one has to be even more circumspect. But, as the definition of Rights (in the Policy) makes clear, where the descriptive term in question has acquired a secondary meaning - in other words, it has become, by its use, associated with the complainant's goods or services in the minds of relevant consumers, it is quite possible for a complainant (relying on a descriptive or generic term) to satisfy this limb of the test.

In the Expert's view, there is evidence to show that the Complainant and its products are referred to as Raptor (as well as, it should be mentioned, Raptor Engineering) and that it produces advertising material referring to Raptor (as opposed to Raptor Engineering). It is clear that Land Rover enthusiasts use the term Raptor to refer to the Complainant and its products and the Expert is satisfied that the Complainant has rights in the name Raptor for the purposes of the Policy. (For the sake of completeness, the Expert should mention the Complainant's 13b submission and the suggestion that the name Raptor is 'an anagram of A Proctor', being Mr. Proctor's son. The word Raptor is not of course

a literal anagram but the Expert assumes that the Claimant means that the word was derived from Mr. Proctor's son's name).

Ignoring the suffix '.co.uk' as Experts are permitted to do when carrying out a comparison, the Expert is also satisfied that the Raptor name, (in which the Complainant has rights for the purposes of the Policy), is similar to the Domain Name - it includes Raptor as the first, and in the Expert's view, dominant element, and the name Raptor is easily recognizable within the Domain Name.

However, the fact that a domain name is similar to or incorporates a trade mark, even if that means that the two are identical, does not of itself mean that there has been an Abusive Registration and accordingly, it is necessary to consider whether the Domain Name, in the hands of the Respondent, is in fact an Abusive Registration.

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;'*

A useful guide as to what might constitute an Abusive Registration is contained in paragraph 3(a) of the Policy. 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.

There is no evidence to suggest that the primary purpose of the Respondent's registration has been to sell the Domain Name or harm the Complainant.

Other factors suggesting an Abusive Registration include a respondent using or threatening to use a 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 example which seems to encapsulate the Complainant's complaint.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This paragraph contains a useful guide as to what does not constitute an Abusive Registration and includes, by way of example, factors such as:

'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;'

Being non-exhaustive lists, neither Complainant nor Respondent need demonstrate that they 'fit' into any particular part of paragraph 3 or 4 respectively, of the Policy.

The Expert is satisfied that there has been some confusion. However, it is perfectly possible for a Respondent to use a domain name that incorporates a Complainant's trade mark and which also causes confusion if there is a legitimate reason to do so. (Moreover, it should perhaps be mentioned that the fact that there has or is likely to be some confusion, does not necessarily mean that there has been a misrepresentation for the purposes of passing off. That is a separate analysis beyond DRS proceedings).

The Complainant expresses a degree of frustration at the Respondent's registration, referring in its Complaint to the Respondent selling 'nothing 4x4 related', that having 'seen how well we have been doing at shows....wants a piece of the action', 'The guy at first discountI am sure is wanting to trade off our back...' and, 'I know the guy at first discount is up to something...'. However, the Complainant does not, in its Reply (or further evidence submitted pursuant to paragraph 13b of the DRS Procedure), challenge what the Respondent says was its motivation in registering the Domain Name i.e. to acquire a domain name that matches the branding of a product range it has been authorised to sell in the UK, and there is no reason why the Expert should not take the Respondent's explanation for registration of the Domain Name at face value.

The website of the Italian company for which the Respondent is now a distributor (Saglietti) is at www.raptor4x4.it. The Respondent now has a website linked to the Domain Name. The Expert has viewed both sites (as well as that of the Complainant at www.raptor-engineering.co.uk). They both use a distinctive Raptor4x4 logo which (save in relation to the switching of the colours yellow and black between text and background), appear to be very similar to, or the same as the logo used by the Respondent at a trade show and on the Raptor 4x4 business card (pictures from/of both having been supplied by the Complainant).

The products on the Respondent's website are described as being Raptor 4x4 products. The Respondent says in its Response that it has been selling some of the Raptor4x4 range since last year. From a review of the Respondent's website at www.firstdiscount.co.uk, it does appear that some Raptor 4x4 products are offered for sale. Whilst it is not apparent when they were added, there is no reason to doubt the assertions of the Respondent.

The English version of Saglietti's www.raaptor4x4.it website, on the 'About' page, states that *'SAGLIETTI s.r.l., owner of RAPTOR 4X4 brand, is a family company which for more than 30 years build accessories for competition cars and off-road parts for the most important companies in the sector.....'*

The production of off road accessories is fully placed in the SAGLIETTI S.r.l. factory (Vado Ligure, Italy) where every step from prototype to packaging of the goods is performed by qualified workers.'

It was not apparent from the review when the Raptor 4x4 brand was first conceived, but a WHOIS search carried out by the Expert suggests that the Raptor4x4.it domain name was first created in 2006.

At the heart of the Policy is unfair behaviour in the sense that for a registration to be considered 'abusive', there should be something morally reprehensible in the Respondent's behavior. In these proceedings, there has been advanced what appears to be a perfectly plausible and legitimate explanation for the Respondent's registration. The brand name Raptor4x4 is that of an Italian company which has granted authority to the Respondent, as UK distributor, to use it. The Respondent has had, before registration, a genuine interest in the 4x4 or off-road market and its Italian supplier appears to have used the Raptor4x4 brand for quite some time. Others have used the term Raptor in a 4x4 context too. The products actually sold by the parties appear different – the Complainant accepts that it does not make and sell products (under the Raptor name) to enhance off-road capability, whereas the Respondent's products are said to do just that. The actions of the Respondent do not appear to have been driven or influenced by the Complainant or the success of its (the Complainant's) Raptor products. Whilst there may be some degree of confusion, that is not in itself the sole determinant of whether there has been an Abusive Registration. In any event, the relevant market is no doubt fairly sophisticated and most 4x4/off-road enthusiasts will probably appreciate that the parties are independent of one another, selling different products lines (broadly, internal/cosmetic on the one hand, external/functional on the other) under different (albeit similar) names.

There is little point in running through the non-exhaustive list of paragraph 4 factors given that they are but examples of the kind of circumstance suggesting that a registration is not abusive. The Complainant bears the burden of proof on a balance of probabilities to demonstrate that the Respondent's registration or use of the Domain Name constitutes an Abusive Registration. The essential

question for an Expert is therefore whether it is more probable than not that the Respondent has taken unfair advantage of the Complainant's rights or acted in a way that has been unfairly detrimental to it.

In all the circumstances, the Expert does not find the Domain Name in the hands of the Respondent to be an Abusive Registration.

7. Decision

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 Expert directs that no action be taken in respect of the Complaint.

Signed Jon Lang

Dated 17 September 2015