

DISPUTE RESOLUTION SERVICE

D00016340

Decision of Independent Expert

CBA World S.A R.L

and

Ray Munn Ltd

1. The Parties

Complainant: CBA World SARL
25A, Boulevard Royal
Luxembourg
L-2449
Luxembourg

Respondent: Ray Munn Ltd
861-863 Fulham Road
London
Surrey
SW6 5HP
United Kingdom

2. The Domain Name

<protectguard.co.uk>

3. Procedural History

The Expert has confirmed that he is independent of each of the parties and that to the best of his 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 his independence in the eyes of one or both of the parties.

28 July 2015 08:29 Dispute received
28 July 2015 12:47 Complaint validated
28 July 2015 12:55 Notification of complaint sent to parties
14 August 2015 02:30 Response reminder sent
18 August 2015 16:33 Response received
18 August 2015 16:34 Notification of response sent to parties
21 August 2015 02:30 Reply reminder sent
25 August 2015 10:04 Reply received
25 August 2015 10:07 Notification of reply sent to parties
01 September 2015 11:37 Mediator appointed
01 September 2015 13:11 Mediation started
06 November 2015 15:28 Mediation failed
06 November 2015 15:28 Close of mediation documents sent
17 November 2015 13:16 Expert decision payment received

4. Factual Background

The Complainant is the IP holding company of a French registered company, Guard Industrie SAS. Guard Industrie SAS is a specialist supplier of products for the protection, decoration, cleaning, maintenance and preservation of building materials.

The Complainant is the proprietor of trade mark registrations for the mark PROTECTGUARD, including:

- UK trade mark number 3039547 for PROTECTGUARD filed on 27 January 2014 and registered in 02 May 2014 for surface treatment materials in the nature of paints in International Class 02.
- France trade mark number 3442440 for a figurative mark comprising the word PROTECTGUARD in a stylised form surrounded by a border (“the Device Mark”) registered on 25 July 2006 for goods including chemicals for coating, protection and sealing in International Class 01.

The Domain Name was registered on 23 July 2009.

On the basis of evidence submitted by the Complainant, the Respondent has used the Domain Name for the purposes of a website which prominently features the Device Mark and the name Guard Industry and promotes the Complainant’s products.

5. Parties’ Contentions

The Complaint

The Complainant states that its references to the Complainant include Guard Industrie SAS, Guard Industry (UK) Limited and other subsidiary and affiliate companies.

The Complainant relies on the registered trade marks referred to above and on a series of other registrations in various territories (however, the Complainant has only provided evidence of its UK trade mark and the Expert has not readily been able to verify a number of the other marks referred to).

The Complainant states that it supplies a number of product lines under names including the term "...Guard" including in particular "ProtectGuard". It submits that it first supplied ProtectGuard products to DIY shops in 1996 and that its products have since been sold through various distribution channels including those for professional construction projects. It states that in 2014 it celebrated the 25th anniversary of its activities in the UK and produces a catalogue which refers to 1989-2014 (although it is not clear how this reconciles with the 1996 date referred to above). The Complainant exhibits additional promotional materials.

The Complainant states that its turnover under the PROTECTGUARD mark was Eur. 2.7 million in 2013. It states that it invests Eur. 500,000 annually in advertising and promotional activity of which around Eur. 50,000 relates to the UK market. The Complainant claims to have a market share of up to 70 % worldwide and up to 90 % in the UK (although it is not clear how this market share is defined).

In the light of the above, the Complainant submits that the mark PROTECTGUARD is recognized as referring to the Complainant's quality products and that the mark is understood by the purchasing public and the trade as indicating the goods of the Complainant.

The Complainant submits that it has Rights in respect of a name or mark which is identical to the Domain Name. In particular, it states that the Domain Name consists of the term "protectguard" and is therefore identical to the Complainant's trademark.

The Complainant also submits that the Domain Name in the hands of the Respondent is an Abusive Registration.

The Complainant states that it has had a relationship with the Respondent for a number of years as a distributor of the Complainant's products. There was a falling out between the parties in early 2015 at which time the Complainant requested a transfer of the Domain Name. The Complainant subsequently refused to continue to supply the Respondent unless the Domain Name was transferred, but the Respondent declined. The Complainant submits correspondence in this regard.

The Complainant objects that the Respondent's website to which the Domain Name resolves falsely gives the impression that it is the Complainant's official site. The Complainant submits pages from the Respondent's website. The Complainant states that the site includes the Complainant's PROTECTGUARD marks including the Device Mark, numerous images of its products, product information and elements taken from the Complainant's own website blog. The Complainant provides pages from its own website by way of comparison, which use a "Guard Industry" shield design that also appears extensively on the

Respondent's website. The Complainant also points out that the Respondent's "About Us" section refers to the Complainant's products.

The Complainant states that the Respondent is not the Complainant's only UK distributor and is using the website to misrepresent that it is the Complainant's official and exclusive distributor. The Respondent is taking unfair advantage of the Complainant's marks by attempting to attract Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source or endorsement of the Respondent's website.

The Complainant seeks a transfer of the Domain Name.

The Response

The Respondent states that the Complainant's predecessor supplied the Respondent with products, consented to the Respondent registering the Domain Name and to setting up the Respondent's website, and even provided the Respondent with the necessary images and product specifics to enable the website to be built.

The Respondent states that the Domain Name was registered before the Complainant's UK trade mark.

The Respondent states that it is only referred to as a "stockist" on its website and that there is no likelihood of initial or post-sale confusion. The Respondent also submits that since the Complainant no longer supplies the Respondent, no trademark infringement has taken place (this submission is not further explained).

The Respondent exhibits a letter from its solicitors containing the same contentions as above, but does not exhibit any other documentation in support of its submissions. In particular, the Respondent fails to identify to the Complainant's predecessor to which it refers or to provide any evidence in support of its contentions concerning the registration of the Domain Name or the setting up of the website.

The Reply

The Complainant denies that the Domain Name was registered with its consent or that of its predecessor.

The Complainant submits that even if the Domain Name was not registered or acquired in an abusive manner, it is still an Abusive Registration by virtue of its use. The Complainant refers to paragraph 1 of the Nominet DRS Policy ("the Policy") and submits that unfair advantage or detriment can occur at any point during the lifetime of a domain name registration. It is not a requirement of the Policy that both the registration and the use of the Domain Name must be unfair.

The Complainant states that the Respondent's continued use of the Domain Name is unfair given that the commercial relationship between the parties has ended. The Complainant also submits that the Respondent appears to admit trademark infringement.

The Complainant maintains that the Respondent's website is misleading and submits that the Respondent's use of the word "stockist" does nothing to allay the confusing nature of the Respondent's website. By using the Domain Name for the purposes of its website, the Respondent is clearly misrepresenting that it is the Complainant's official website or the Complainant's authorized website for the UK market.

6. Discussions and Findings

The Complaint falls to be determined according to the Policy and the Nominet DRS Procedure. Under paragraph 2 of the Policy:

- "(a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, that:*
- (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
 - (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.*
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."*

Under paragraph 1 of the Policy the term "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."

Also under paragraph 1 of the Policy, the term "Abusive Registration" 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has established that it has registered trade mark rights in the name and mark PROTECTGUARD and in the Device Mark. The Respondent is correct that the registration of the Domain Name pre-dates the registration of the UK trademark, but that is irrelevant to the consideration of whether the Complainant has present Rights in respect of a name or mark which is identical or similar to the Domain Name such as to give it sufficient standing to bring these proceedings.

In the view of the Expert, the Complainant has also established a course of trading under the name and mark PROTECTGUARD for a substantial period of time such as to give it unregistered as well as registered rights in that mark. In other words, the Expert is satisfied that as a result of the Complainant's trading and promotional activities, customers including those based in the UK are likely to associate the name and mark PROTECTGUARD with the Complainant and its products.

Ignoring the formal suffix ".co.uk.", which is typically to be disregarded for the purpose of comparison, the Domain Name is identical to the Complainant's mark PROTECTGUARD. Therefore, the Complainant has established for the purposes of paragraph 2(a)(i) of the Policy that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

The Respondent submits that it was authorized by the Complainant's predecessor to register the Domain Name and actively assisted by that party to set up the Respondent's website. However, the Respondent produces no evidence in support of these contentions, which the Complainant denies.

In the view of the Expert, even if the Complainant's predecessor had licensed the Respondent to use the PROTECTGUARD trademark for the purposes of the Domain Name and the website, it is highly unlikely that any such licence would be perpetual and would not be subject to termination by the Complainant in appropriate circumstances. In the present circumstances, the Complainant has demanded that the Respondent transfer the Domain Name because the Respondent's website is misleading in nature and because it has terminated its commercial relationship with the Respondent. The Respondent denies that the website is misleading or that it has infringed the Complainant's trademark rights.

Having examined the Respondent's website as exhibited by the Complainant, it is quite clear to the Expert that it is misleading in nature and that it purports to be the Complainant's own website or a website authorized by the Complainant. It makes extensive use of the Complainant's trademarks including the Device Mark and the shield design referred to above, refers extensively to the Complainant's products and is clearly designed to give the impression that it is operated by the Complainant. The "About Us" section refers to the Complainant's products and not to the Respondent and it is only in the "Contact Us" section that there appears to be any reference to the Respondent, where the words "Ray Munn Ltd – UK Stockist" appear in small print under the name "ProtectGuard". In the view of the Expert, this serves in no material way to dispel the impression that the website is operated or authorized by the Complainant.

Where a domain name comprises the “unadorned” use of a trade mark owner’s mark, an unauthorised registrant will frequently face a difficulty in establishing that it is not unfairly taking advantage of the mark by impersonating the trade mark owner. Furthermore, in cases where a domain name registrant uses a trade mark to resell the trade mark owner’s goods, the registrant must do so fairly and without misleading the public as to the nature of its relationship with the owner of the mark.

In this case, it appears to the Expert that the Respondent’s use of the Domain Name for the Respondent’s website represents an impersonation of the Complainant and takes unfair advantage of the Complainant’s goodwill in its trade marks. If the use in question was ever authorized by any predecessor of the Complainant, which has not been established, then the Expert is satisfied that the Complainant was entitled to withdraw, and has withdrawn, any such authorization.

In the circumstances, the Expert finds that 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 (paragraph 3(a)(ii) of the Policy). The Domain Name in the hands of the Respondent is therefore an Abusive Registration for the purposes of paragraph 2(a)(ii) of the Policy.

7. Decision

The Expert has concluded that the Complainant 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. The Complaint therefore succeeds and the Expert directs that the Domain Name <protectguard.co.uk> be transferred to the Complainant.

Signed: Steven A. Maier

Dated: 3 December 2015

