

DISPUTE RESOLUTION SERVICE

D00017913

Decision of Independent Expert

HP Hewlett Packard Group LLC

and

Simon Hancock

1. The Parties

Complainant: HP Hewlett Packard Group LLC
11445 Compaq Center Drive West
Houston
Texas
77070
United States

Respondent: Simon Hancock
Cheshire
United Kingdom

2. The Domain Names

hp3dprint.co.uk
hp3dprinter.co.uk
hp3dprinters.co.uk
hp3dprinting.co.uk

(‘the Domain Names’)

3. Procedural History

For disputes filed on or after 1 October 2016, Version 4 of Nominet's UK Dispute Resolution Service ('DRS') Policy ('the Policy') applies and there is no longer a separate Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). But for disputes filed up to 30 September 2016 the Policy (Version 3) and the Procedure both apply.

Accordingly, Nominet checked that the complaint received on 31 August 2016 complied with the Policy and the Procedure. It then notified the Respondent and invited him to file a response. That response was received on 19 September. On 27 September, the Complainant replied to that response.

Mediation was attempted but ended unsuccessfully and, on 7 November, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 21 November.

On 21 November I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. 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 they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

4. Factual Background

I have visited the websites to which the Domain Names resolve, as well as the Complainant's website at <hp.com>. From that limited research, the complaint, the response, the reply and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant is in the business of developing and selling IT hardware, such as personal computers and printers, as well as software and computer games. It employs more than 50,000 employees. In 2015, global sales gave it market share of just over 18%, ranking it second.

The Complainant and its licensee HP Inc have used the mark 'HP' in their business, in both word and various device formats, since their founding in the 1930s. The material supporting the complaint includes a large number of trade mark registrations by the Complainant, for the name 'HP' and a related logo, the earliest of which dates from 1958. All of the registrations were effective before the Respondent registered the Domain Names.

The Complainant or its licensee owns a portfolio of .uk domain names including <hp.co.uk>. The Complainant has also registered <hp.com>, <hp.org>, <hp.net>, <hprinters.com> and <hprint.com>.

The Respondent was a 'business partner' of the Complainant. In 2010, the Complainant entered the 3D printer market with a rebranded version of a 3D printer that the Respondent was already selling. Drawing on his experience with that printer, the Respondent became an 'Official HP Designjet 3D Reseller'. He remained a business partner, selling the Complainant's products, for six years. The relationship has since been terminated.

The Domain Names were registered on the following dates:

- hp3dprinter.co.uk – 1 March 2010
- hp3dprinters.co.uk – 6 March 2010
- hp3dprint.co.uk – 6 March 2010
- hp3dprinting.co.uk – 1 March 2010

They all currently resolve to <s2e.co.uk>, the website of Solutions 2 Enterprise, based in Warrington. The text on the home page includes the following text:

Solutions 2 Enterprise provide professional 3D printing solutions to commercial and educational organisations across the UK. Our experience combined with the range of Stratasys 3D printers bring benefits to organisations like never before.

The web pages contain 3D printer hardware, printing materials and consumables for sale, as well as case studies and other resources. Printer models listed are Mojo, Uprint, Objet and Fortus – all of which appear to be made or supplied by Stratasys. The web pages refer to the Complainant at the bottom of a short list of consumables available for various printers.

The Complainant recently approached the Respondent anonymously to try and buy the Domain Names, but he took the view that the price was too low and declined to sell.

5. Parties' Contentions

Complaint

The Complainant says that the main element of the Domain Names is identical to the name and marks in which it has rights and that the other elements of the Domain Names are just a combination of the word 3D and generic wording relating to one of the Complainant's key business areas (print, printer, printers or printing). In its view, therefore, the Domain Names are similar to a name in which it has rights.

It says that these are abusive registrations for the following reasons.

1. They are effectively 'blocking' registrations. (Policy 3 a i B)
2. The website to which they resolve is unconnected with the Complainant and contains details of 3D printers, related products and printing services

provided by the Complainant's competitors. The effect of this is unfairly to disrupt the Complainant's business. (3 a i C)

3. The descriptive elements in the Domain Names do nothing to distinguish the Domain Names from the names in which the Complainant has rights, and the Respondent is using the Domain Names in a way which is likely to confuse people or businesses into believing wrongly that the Domain Names are connected with the Complainant. (3 a ii)
4. The Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to names in which the Respondent has no apparent rights, and the Domain Names are part of that pattern. (3 a iii)
5. The Respondent's holding of the Domain Names does not reflect any agreement with the Complainant. (3 a v)
6. The Respondent is not operating a website in tribute to or criticism of the Complainant. (4 b)
7. There is (and could be) no evidence that the Respondent has been commonly known by a name or mark which is identical with or similar to the Domain Names. (4 a i B)
8. The Respondent has made no legitimate non-commercial or fair use of the Domain Names. (4 a i C)

Response

1. The Respondent says that, as an authorised reseller of the Complainant's products, contributing to the marketing of those products, he registered the Domain Names and used them for a website dedicated to the (then) new HP 3D printer. He says the Complainant was aware of and supported his efforts.
2. He notes that the Complainant's products still feature on the website to which the Domain Names resolve.
3. He says he is open to selling the Domain Names to the Complainant, but only for a price that reflects the profits he has made for the Complainant and his efforts over the years to promote the Complainant's printing products.

Reply

1. The Complainant says that it did not encourage the Respondent to register domain names incorporating its trade mark and believes it did not give him permission to do so.
2. It did try to buy the Domain Names but only as a low cost alternative to legal action to secure the transfer of domain names that incorporate its trade mark without its consent.

6. Discussion and Findings

To succeed in this complaint, the Complainant must 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 Names; and that
- the Domain Names, in the hands of the Respondent, are abusive registrations.

Rights

The Complainant has been using the name 'HP' for decades to sell computer hardware and software. In addition to the goodwill it will have built up in this way, it also has long-established registered rights in the name.

The Domain Names include the name 'HP' and add two generic terms – '3D' and either 'print', 'printing', 'printer' or 'printers'. Those generic additions do not seem to me to affect the primary focus of the Domain Names, which is on the name 'HP'. As is usual for the purposes of applying this test, I am ignoring the .co.uk suffix as merely a generic feature of the domain name register.

I conclude that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Names.

Registration

As defined by the Policy, an abusive registration is a domain name which:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is or is not an abusive registration and the complaint runs in some detail through that list. I will return to that but this is in fact a relatively straightforward 'reseller' case, where a buyer and seller-on of branded goods uses the brand in a domain name. The approach to be taken within the DRS is set out in the *Experts' Overview* (section 4.8):

The generally accepted principles to be derived from the cases, as reviewed by the appeal panel in *Toshiba Corporation v Power Battery Inc* (DRS 07991) <toshiba-laptop-battery.co.uk> are:

1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of 'initial interest confusion' and is not dictated only by the content of the website.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name (*sic: the appeal panel here clearly meant the incorporation in the domain name of the name in which the complainant has rights*) is unfair. One such reason is the offering of competitive goods on the respondent's website.

This last point envisages a finding of Abusive Registration in circumstances where there may be no likelihood of any confusion. The use of the domain name or the sale of competing goods was the basis for the finding of Abusive Registration in the Toshiba case, even though a majority of the panel found no likelihood of any confusion ("initial interest confusion" or otherwise).

So the key question is whether the Domain Names here falsely imply a commercial connection with the Complainant. From the decided cases there emerges a view that, to the extent that rights holders register domain names that are similar rather than identical to their trade marks, they tend to keep any extra wording or lettering to a minimum. But this view is qualified. The *Overview* (section 3.3) says:

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)...The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, [generally condemned are] the activities of typosquatters [and] those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity.

The additions, in the Domain Names, of '3D' and either 'print', 'printing', 'printer' or 'printers', look exactly like appendages to the Complainant's mark that is appropriate to the Complainant's field of activity. Furthermore, the Complainant's own domain name registrations include <hpprinters.com> and <hpprint.com>, so arguably there is increased scope for 'initial interest' confusion because the Domain Names are similar to the kinds of name the Complainant itself uses.

Even more significantly, the Domain Names are less than a fair description of the goods on offer at the web pages to which they resolve. The home page appears exclusively devoted to services provided by the Respondent and to products manufactured by the Complainant's competitors. There are two sets of the Complainant's consumable products on offer, but they are among a longer list of products from the Complainant's competitors which is itself tucked away some distance from the home page.

It seems to me clear that the Domain Names are being used falsely to imply a commercial connection with the Complainant, in order to attract web traffic on the back of the Complainant's reputation and try and sell, in the main, goods and services from the Complainant's competitors.

There is some dispute about the extent to which the Complainant may have encouraged the Respondent in his attempt to help promote the Complainant's 3D printers. But even if the Respondent's original registration of the Domain Names was reasonable as part of that effort, the subsequent use of those Domain Names clearly takes unfair advantage of the Complainant's rights.

I do not regard as evidence of abuse the fact that the Respondent would like to sell the Domain Names to the Complainant for a price that reflects his efforts over the years to market the Complainant's products. But the reality is that any increase in the value of the Domain Names is ultimately to do with the Complainant's goodwill and reputation and, however much the Respondent feels he has contributed to that, it is not his to exploit.

For completeness I can now run through the arguments presented in the complaint, response and reply:

- I understand that these are effectively 'blocking' registrations but in practice there needs to be some evidence of motive if this is to be taken as evidence of abusive registration.
- I agree that the effect of the website at the Domain Names, with the barest of references to the Complainant and a far greater emphasis on the sale of products and services by the Complainant's competitors, is unfairly to disrupt the Complainant's business, and that the potential for confusion is high.
- I am not convinced that the registration of these four domain names itself constitutes evidence of a relevant pattern of registrations corresponding to names in which the Respondent has no apparent rights.

- I note that there is a dispute about the extent to which the Respondent was encouraged in his marketing efforts by the Complainant but in any event I have seen no evidence that the Respondent's holding of the Domain Names reflects any agreement with the Complainant – and, even if there were such evidence, there is compelling evidence already introduced about the use to which the Domain Names have since been put.
- I agree that the Respondent is not operating a website in tribute to or criticism of the Complainant and that there is no evidence that the Respondent has been commonly known by a name or mark which is identical with or similar to the Domain Names.
- I agree that the Respondent has made no non-commercial use of the Domain Names but the question of whether use has been 'fair' is for me to decide here.
- I draw no inference from the Complainant's attempts to buy the Domain Names, or from the Respondent's desire to sell them for the best price, but I have already noted that any increase in value reflecting the Complainant's goodwill and reputation is not the Respondent's to exploit.

7. Decision

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are abusive registrations.

In the light of that, I direct that the Domain Names be transferred to the Complainant.

Mark de Brunner

8 December 2016