

DISPUTE RESOLUTION SERVICE

D00018854

Decision of Independent Expert

MERIAL

and

Krasimir Tzvetkov

1. The Parties:

Complainant: MERIAL
29 Avenue Tony Garnier
LYON
69007
France

Respondent: Krasimir Tzvetkov
21-vi vek 13
Sofia
Sofia
1000
Bulgaria

2. The Domain Name(s):

frontlinecats.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 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.

03 May 2017 18:59 Dispute received

04 May 2017 08:49 Complaint validated

04 May 2017 08:52 Notification of complaint sent to parties

23 May 2017 02:30 Response reminder sent
26 May 2017 11:23 No Response Received
26 May 2017 11:23 Notification of no response sent to parties
08 June 2017 02:30 Summary/full fee reminder sent
08 June 2017 11:31 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is a company incorporated in France which manufactures veterinary pharmaceutical products.
- 4.2 One of the Complainant's major brands is FRONTLINE.
- 4.3 The Complainant has, *inter alia*, a United Kingdom registered trade mark and a European Union registered trade mark for the mark FRONTLINE. These were registered as of 16 August 1996 and 21 January 2002 respectively.
- 4.4 The Complainant has used the FRONTLINE brand in the UK with regards to dogs and cats since 1994.
- 4.5 The Respondent is an individual whose address is in Sofia.
- 4.6 The Domain Name was registered on 3 February 2017.
- 4.7 The Domain Name does not currently link to an active website. However, in the recent past it has been used to sell counterfeit products under the FRONTLINE trade mark without the consent of the Complainant.
- 4.8 No Response has been filed by the Respondent.

5. Parties' Contentions

Complainants' Submissions

Rights

- 5.1 The Complainant submits that it has Rights in the name FRONTLINECATS for two main reasons. First, because of the Complainant's use of the mark FRONTLINE for anti-parasitic preparations for cats and dogs and, secondly, because of the Complainant's UK and European Trade Mark Registrations for FRONTLINE which were registered as of 16 August 1996 and 21 January 2002 respectively.
- 5.2 In relation to its use of FRONTLINE, the Complainant submits that it has established substantial goodwill in the mark FRONTLINE because of its widespread commercial use of the brand in respect of veterinary products –

especially for combating fleas in cats and dogs. In 2014-2016, the Complainant sold over €90,000,000 worth of products under the FRONTLINE mark.

5.3 The Complainant submits that its FRONTLINE brand has been used in the UK since 1994 and is still in use by the Complainant today. This is backed up by the fact that the Complainant applied for its UK trade mark on 18 December 1993. It has also provided an article from 2006 which states that it has been using the mark since 1994. Additionally it has provided advertisements and other use of the mark from 2002, 2003, 2004, 2005, 2006, 2008, 2009/10 and 2013 and sales figures from 2014-2016.

5.4 The Complainant claims to have established substantial goodwill in its FRONTLINE brand throughout the United Kingdom as a consequence of its substantial investment in education, marketing and resulting sales of FRONTLINE products.

Abusive Registration

5.5 The Complainant submits that the Domain Name is an Abusive Registration because it was registered or otherwise acquired and then subsequently used in a manner which was unfairly detrimental to the Complainant's Rights.

5.6 The Complainant submits that the use of the Domain Name by the Respondent is unfairly detrimental to the Complainant's Rights because:

- 5.6.1 it has been used to sell counterfeit FRONTLINE products;
- 5.6.2 it amounts to a blocking registration against a name or mark in which the Complainant has Rights;
- 5.6.3 it has been registered for the purposes of unfairly disrupting the business of the Complainant; and
- 5.6.4 the Respondent is using the Domain Name in a way likely to cause confusion on behalf of potential customers (which for the Complainant are wholesalers and retailers), causing them to believe that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

5.7 The Complainant has provided evidence that the Domain Name was being used to sell counterfeit FRONTLINE products by hiring a private investigator to purchase such products and then provide a report. The products which the private investigator purchased were sold under the FRONTLINE mark but did not have the correct active ingredient and as such could have been dangerous for cats. The Claimant submits that this poses a clear risk of damage to the goodwill of the FRONTLINE brand and also to the profits of the business as a whole.

5.8 The Complainant submits that the Respondent's use of the Domain Name amounts to infringement of its trade marks and passing off.

5.9 The Complaint also makes reference to a number of similar cases under the Nominet DRS where it has been successful in the past albeit that none of these involves the Respondent or relates to allegations of counterfeiting.

Respondent's Submissions

5.10 The Respondent has not filed a Response.

6. Discussions and Findings

6.1 Paragraph 2 of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

6.2 The definition of Rights in the Policy is 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.

6.3 I have no doubt that the Complainant has Rights in the word or mark FRONTLINE. The Complainant is the registered proprietor of a UK and EU trade mark for the mark FRONTLINE. It is also clear that the Complainant has been using the mark FRONTLINE in relation to its offering of anti-parasitic veterinary products for cats and dogs for many years. It owns the Domain Name uk.frontline.com and has amassed an impressive amount of advertising over the last 15 years at least.

6.4 As the name or mark in which the Complainant has Rights differs only from the Domain Name by the addition of the word "cats" in the Domain Name, ignoring the ".co.uk" suffix for this purpose. The addition of "cats" does little to distinguish the Domain Name from the mark, as the mark is used both by the Complainant and the Respondent to sell products to do with cats and therefore 'cats' in this case is merely descriptive. I therefore conclude that the Complainant has Rights in a name or mark which is similar to the Domain Name.

Abusive Registration

6.5 Abusive Registration is defined in Paragraph 1 of the Policy as 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

- 6.6 This definition requires me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.
- 6.7 Paragraph 5 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 8 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.
- 6.8 The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.
- 6.9 In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's Rights. In some cases where the name in which the Complainant has Rights is particularly well known this will be fairly obvious and straightforward while in other cases where the name in which the Complainant has Rights is less well known and/or where there are other meanings or uses which can be made of the name this will require substantial evidence from the Complainant.
- 6.10 The approach that I intend to take in this case is to look at the overall question of whether the Respondent's registration or use of the Domain Names constitutes an Abusive Registration. Bound up with that, and indeed central to it, will necessarily be the question of the Respondent's knowledge of the Complainant's Rights.
- 6.11 In making this overall assessment the nature of the name or mark in which the Complainant has Rights is also clearly a factor here. The more descriptive or generic that name or mark is then the more likely it is that the Respondent simply happened upon the Domain Name as a "good domain name" without necessarily having any knowledge of the Complainant's Rights. Obviously the more well-known and unique that name or mark is then the less likely it is that the Respondent did not register the Domain Name with the Complainant's Rights in mind.
- 6.12 In this case, the Domain Name contains the word or mark FRONTLINE. There is no suggestion that it is descriptive or that it would be the kind of word or mark that one would naturally wish to adopt in relation to anti-parasitical veterinary products.
- 6.13 Since the Respondent appears to have used the Domain Name to sell counterfeit copies of the Complainant's products this leads to an irresistible inference that the Respondent knew about the Complainant's Rights when it registered and used the Domain Name.
- 6.14 Further, it is difficult to conceive that the use of the Domain Name to sell counterfeit copies of the Complainant's products can be anything other than an

Abusive Registration and very clearly takes unfair advantage of the name or mark in which the Complainant has Rights and is also unfairly detrimental to the Complainant's Rights.

6.15 The Respondent has not put in a Response and indeed it is difficult to think of a credible explanation for the Respondent's conduct. I therefore have no hesitation in finding that on the balance of probabilities the Domain Name is an Abusive Registration.

7. Decision

I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. I also find that, on the balance of probabilities, the Complainant has established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

Signed Nick Phillips

Dated