

DISPUTE RESOLUTION SERVICE

D00019166

Decision of Independent Expert

MERIAL

and

Pepi Mikov

1. The Parties:

Complainant: **MERIAL**
Address: 29 Avenue Garnier
Lyon
France

Respondent: **Pepi Mikov**
Address: ul. Shipka 5
s. Popica
3382
Bulgaria

2. The Domain Name:

frontlineproducts.co.uk (the “Domain Name”)

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.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 4, October 2016 (the “Policy”) unless the context or use indicates otherwise.

26 July 2017

Dispute received

27 July 2017	Complaint validated and notification of complaint sent to parties
15 August 2017	Response reminder sent
18 August 2017	No response received and notification of no response sent to parties
31 August 2017	Summary/full fee reminder sent
4 September 2017	Expert decision payment received

4. Factual Background

The Complainant has marketed and sold FRONTLINE-branded preparations for treating fleas in household pets, particularly cats and dogs, since 1994.

The Respondent did not reply to the Complaint and so there are no facts before me setting out the Respondent's business or otherwise.

The Respondent registered the Domain Name on 26 March 2017.

5. Parties' Contentions

The Complaint

Complainant's Rights

The Complainant's assertions of rights in the name FRONTLINE are:

1. The Complainant has filed five previous DRS complaints in relation to domain names that include the name FRONTLINE (DRS9667, DRS10143, DRS10146, DRS18854 and DRS18855). Each of these complaints was successful.
2. This complaint relates to the allegation of the sale of counterfeit products through the corresponding website at the Domain Name.
3. The Complainant is the proprietor of the following registered trade marks in Class 5 dating from as early as 1996:
 - a. UK trade mark registration No. 1557026 FRONTLINE;
 - b. UK trade mark registration No. 3090065 FRONTLINE PLUS;
 - c. EU trade mark registration No. 1966787 FRONTLINE;
 - d. International registration (UK) No. 771092 FRONTLINE COMBO.
4. The Complainant's FRONTLINE products have become the UK's leading brand of anti-parasitic preparations for cats and dogs and is sold under three main formulations:
 - a. FRONTLINE Spot On sold in veterinary surgeries, pharmacists, pet shops, via the internet and elsewhere;
 - b. FRONTLINE Plus; an insecticide and acaricide;
 - c. FRONTLINE Combo sold only on a veterinary prescription for regulatory reasons.

5. The Complainant says that it sells vast quantities of Frontline products in the UK each year, as the exhibited sales figures show.
6. The Complainant says that it has invested considerable resources over many years in educating the public about the causes and consequences of pet fleas and methods for treating them, and in educating pharmacists, veterinarians and others about the appropriate FRONTLINE products that may be used for treating dogs and cats. The Complainant exhibits extracts from publications such as Pet Health magazine (14th July 2010).
7. The Complainant exhibits several documents to illustrate the way in which the FRONTLINE name is used in the UK on product packaging and promotional material including:
 - a. advertising material published in 2013;
 - b. a 2006 covering letter to veterinary practices to accompany educational waiting room posters and flea and tick fact sheets;
 - c. a 2008 FRONTLINE Combo Calendar;
 - d. 2003 marketing material;
 - e. 2002, 2004 and 2005 advertisements;
 - f. 2006 design drawings for FRONTLINE Combo pack for cats and for dogs;
 - g. 2008 information pack for stockists of the FRONTLINE Combo product.
8. The FRONTLINE products have been advertised on national television and in both specialist and popular press. The Complainant exhibits advertisements in Chemist + Druggist magazine dated 5 April 2008 which discusses the FRONTLINE TV advertising campaign due to run from April – October 2008, along with printed advertising in the Radio Times and OK! Magazine.
9. The Complainant says that the effectiveness and popularity of the its FRONTLINE product has been recognised by winning the Best Cat Flea Pet Product 2009/10 and Best Dog Flea Pet Product 2009/10 in the Your Cat Magazine and Your Dog Magazine Product Awards.
10. The Complainant operates a website at www.uk.frontline.com.
11. As a consequence of the substantial investment in education, marketing and the resulting sales of the Complainant's FRONTLINE products, the Complainant has established substantial goodwill and reputation in its FRONTLINE brand throughout the United Kingdom. The FRONTLINE brand has become a household name for flea treatment products for cats and dogs.

Abusive Registration

The Complainant's assertions of Abusive Registration are:

1. The Domain Name was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, was unfairly detrimental to the Complainant's Rights and it has been used in a manner which has been unfairly detrimental to the Complainant's Rights. In particular:

- a. it has been used to sell counterfeit FRONTLINE products;
 - b. it amounts to a blocking registration against a name or mark in which the Complainant has Rights;
 - c. it has been registered for the purpose of unfairly disrupting the business of the Complainant;
 - d. 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.
2. The Domain Name has been used to sell fake FRONTLINE products. On 11th April 2017 a private investigator placed an order for Frontline Spot on Cat, Spot on Solution 6 pipettes of 0.5ml from www.frontlineproducts.co.uk. The product was delivered on 18th April 2017. The Complainant exhibits a copy of the investigator's report and details of the purchase.
3. An analysis of the packaging of the products sold via the Respondent's website clearly shows that the products are not genuine and that there are numerous discrepancies between the genuine Spot on Solution produced by the Complainant and the Spot on Solution which was purchased from www.frontlineproducts.co.uk.
4. The Domain Name is used to sell fake veterinary preparations bearing the Complainant's trade mark. This is clear trade mark infringement and poses a clear risk of damage to the Complainant's business, both to the profits of the business and to the reputation and goodwill of the FRONTLINE brand.
5. The Domain Name was clearly registered with a view to hosting a website that would sell FRONTLINE branded products. The Domain Name implies, and customers would infer, that any website hosted at the Domain Name is an official website of the Complainant or is officially authorised by the Complainant. Even in the highly unlikely event that the Respondent was unaware that the goods offered for sale on its website were counterfeit, the Respondent is not associated or affiliated with the Complainant and the Complainant has not authorised the Respondent to register or use the Domain Name.
6. Although the Complainant's products are sold to the public via intermediaries, those not aware of this would reasonably assume that the products sold or advertised by www.frontlineproducts.co.uk were genuine. Without control of the Domain Name and the business conducted through the website, the Complainant is unable to check and control the products sold by the Respondent. This is evident from the fact that the Domain Name has been used to sell low-quality, counterfeit FRONTLINE branded products.
7. The Complainant is unable to control the quality, accuracy and appropriateness of the content of the website. Not all visitors will purchase products from the website, but incorrect, poor quality or inappropriate material displayed on the website is still likely to lead to damage to the reputation of the FRONTLINE trade mark, and consequently to impair sales of the Complainant's FRONTLINE product.
8. The registration of the Domain Name in the hands of the Respondent is further abusive because the Domain Name itself, regardless of the use to which it is put, amounts to an infringement of the Complainant's rights in its registered trade marks and to passing off. The definition of "abusive registration" under the Nominet DRS

must include a domain name whose registration amounts to an infringement of a registered trade mark, and passing off.

9. The Complainant quotes sections 9 and 10 of the Trade Marks Act 1994 and concludes that the Respondent has infringed the rights of the Complainant by using in the course of trade a sign identical with or similar to the Complainant's earlier trade mark by, amongst other things, offering or exposing fake FRONTLINE branded products through the website at www.frontlineproducts.co.uk.
10. The Complainant quotes from the judgment in the case of *British Telecommunications plc and Others v One in a Million and Others*, [1998] EWCA Civ 1272, in which the Court of Appeal held that registration of the domain name <marksandspencer.com> by the respondent, which was unconnected with Marks & Spencer plc, amounted both to passing off and registered trade mark infringement.
11. The Complainant does not sell its FRONTLINE products to the public directly but supplies wholesalers and retailers. The Complainant's reliance on its wholesale and retail distribution network, and the need to maintain fair and equal terms for all of the sellers of its FRONTLINE products, means that the Complainant cannot allow a minority of sellers to register domain names that include the FRONTLINE name which could result in those particular retailers deriving an unfair advantage over other sellers of the same product.
12. The Complainant says quotes from the terms and conditions of sale of its UK subsidiary (MERIAL Animal Health Limited) with its direct wholesale customers which prohibits the customer from affixing, applying or using any mark, name or symbol or device upon or in relation to the products unless specifically authorised.
13. The Complainant says that allowing a "free for all" in the registration and use of domain names that incorporate its FRONTLINE name would require the Complainant to expend considerable resources in monitoring and policing all websites containing this name. For this reason, amongst others, the Complainant has a policy of not consenting to the registration of any domain name containing the FRONTLINE name by any seller of its products. Accordingly, the registration of the Domain Name unfairly disrupts the business of the Complainant in breach of 5.1.1.3 of the DRS Policy.
14. The Complainant again refers to DRS9667, DRS10146, DRS18854 and DRS18855 (dealing with <thefrontlineshop.co.uk>, <buyfrontline.co.uk>, <frontlinecats.co.uk> and <getfrontlinecat.co.uk>) and quotes from the relevant expert's decision.
15. Following action by the Complainant (which the Complainant does not elaborate on), the website at www.frontlineproducts.co.uk is no longer operational.

The Response

The Respondent did not reply to the Complaint.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2.1 and 2.2 of the Policy, both limbs of the test 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.*

Complainant's Rights

Rights is defined in §1 of the Policy as “*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 wholly generic suffix “.co.uk” may be discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has evidenced registered and unregistered rights in the name FRONTLINE.

The Domain Name comprises the name FRONTLINE with the everyday dictionary word “products”. The addition of the word “products” adds a descriptive element to the name FRONTLINE to inform the internet user of the purpose of the website at www.frontlineproducts.co.uk, namely to sell, possibly amongst other items, FRONTLINE products. The word “products” in this instance does not detract in any degree from the similarity of the Domain Name to the name FRONTLINE or from the Respondent’s use of the name but, due to its informative nature, rather reinforces the use of the name in the Domain Name.

Accordingly, for the purposes of the first limb of the test in §2.1.1 of the Policy, I find that the Complainant has Rights in the name FRONTLINE which is similar the Domain Name.

Abusive Registration

Abusive Registration is defined in §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.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §5.1 of the Policy:

- 5.1.1 *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
- 5.1.1.1 *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*
 - 5.1.1.2 *as a blocking registration against a name or mark in which the Complainant has Rights; or*
 - 5.1.1.3 *for the purpose of unfairly disrupting the business of the Complainant;*
- 5.1.2 *Circumstances indicating that the Respondent is 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;*
- 5.1.3 *The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*
- 5.1.4 *It is independently verified that the Respondent has given false contact details to us;*
- 5.1.5 *The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:*
- 5.1.5.1 *has been using the Domain Name registration exclusively; and*
 - 5.1.5.2 *paid for the registration and/or renewal of the Domain Name registration;*
- 5.1.6 *The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.*

The main thrust of the Complainant's complaint is the sale of counterfeit FRONTLINE products at the Respondent's website at www.frontlineproducts.co.uk. The Complainant employed a private investigator to purchase products and to analyse the packaging and product. The investigator purchased Frontline Spot on Cat spot on solution for £31.80 via PayPal using guaranteed special delivery. The investigator's report and analysis of the purchased product packaging, various inserts, and the product pipettes/packaging appears to evidence discrepancies and falsified bar codes indicating that the purchased product is counterfeit.

In following the link to the Respondent's website, as provided by Nominet in the Expert papers, I find that it now results in a message from Google that "This site cannot be reached". The taking down of the Respondent's website does not excuse the Respondent's previous use of the Domain Name as evidenced in the papers before me.

One of the DRS complaints exhibited by the Complainant, DRS 18854 (<frontlinecats.co.uk>), was also a case where the domain name was used to sell apparent counterfeit products. The expert in that case concluded that:

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.

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.

I concur with the expert's findings in DRS 18854. On the papers before me, I accept the Complainant's assertion that the purchased product is counterfeit and I conclude that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant by trading on the name FRONTLINE to sell counterfeit products.

I also find that the Respondent's use of the Domain Name has almost certainly caused initial interest confusion and/or actual confusion as to the operation of the website at www.frontlineproducts.co.uk, and led users to believe that it was operated by or otherwise connected with the Complainant.

Accordingly, I find that the Respondent's use of the Domain Name has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights, and is therefore an Abusive Registration.

There is one matter raised in the Complaint that I now address. The Nominet DRS is a forum for deciding whether the registration and/or use of a domain name is abusive by reference to the Policy. Such registration or use may also be a trade mark infringement under the Trade Marks Act 1994 but the Nominet DRS is not a forum for deciding such matters nor can the Expert consider them as such.

Accordingly I make no findings in relation to the Complainant's assertions of trade mark infringement and I have not taken it into account in reaching my decision.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Name, and that the Domain Name, in the hands of the Respondent,

is an Abusive Registration, I direct that the Domain Name be transferred to the Complainant.

Signed

Dated: 25 September 2017

Steve Ormand