

DISPUTE RESOLUTION SERVICE

D00019567

Decision of Appeal Panel

Illinois Tool Works Inc.

and

Successful Internet Limited

1. The Parties

Complainant/Appellant:

Illinois Tool Works Inc., 155 Harlem Avenue, Glenview, Illinois 60025, United States

Respondent:

Successful Internet Limited, Suite 36, 88090 Hatton Garden, London EC1N 8PN,
United Kingdom and rue de Montchoisy 17, Geneva 1207, Switzerland

2. The Domain Names

The domain names the subject of this appeal are:

forte.co.uk
forte.uk

These are referred to as the “Domain Names” in this decision.

3. Appeal Panel Declaration

Nick Gardner, Ian Lowe and Claire Milne (the "Appeal Panel") have each made a statement in the following terms:

"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. The Policy

This appeal is governed by version 4 of Nominet's Dispute Resolution System ("DRS") Policy that applies to disputes filed on or after 1 October 2016 (the "Policy"). This document is available for inspection on the Nominet website (<https://www.nominet.uk/resources/policy/policies-rules/#drspolicy>). The Policy sets out how cases under Nominet's DRS will be determined. Capitalised terms used in this decision shall have the meaning set out in the Policy unless otherwise stated.

5. Procedural History

This is an appeal by the Complainant/Appellant against a decision of James Bridgeman (the "Expert") dated 23 March 2018. The Expert found that the Complainant had Rights in a trade mark and that the Domain Names were identical to that trade mark but that the Respondent's registrations of the Domain Names were not Abusive Registrations. He did so primarily on the basis that the Complainant had not established that the Respondent would have had knowledge of the Complainant and/or its trade mark when registering the Domain Names, having regard to the fact that "forte" is an ordinary dictionary word. He also concluded that the Respondent's subsequent actions in offering the Domain Names for sale did not mean that the Domain Names were Abusive Registrations. Further details of the Expert's reasoning can be found in his decision which is available on Nominet's website.

On 6 April 2018 the Complainant gave notice of intent to appeal against the Expert's decision. On 9 April 2018 the appeal decision deposit and Appeal Notice were received. On 12 April 2018, having received the balance of the appeal payment, Nominet notified the Respondent of the proceedings, and an Appeal Response was filed on 23 April 2018.

On 27 April 2018 Nick Gardner was appointed as chair of the Appeal Panel with Claire Milne and Ian Lowe as co-panellists.

6. The Nature of This Appeal

Paragraph 20.8 of the Policy provides that: “The appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters”. This appeal relates to substantive rather than procedural matters and will therefore proceed as a re-determination on the merits.

For convenience the Panel will continue to refer to the parties as the “Complainant” and “Respondent”.

7. Factual Background

The Complainant is Illinois Tool Works Inc. which is a United States corporation. It is a conglomerate operating in many different sectors and many countries across the world, employing some 55,000 people in total. The entity which carries out activities under the name “forte” appears to be a division or unit within the Complainant which is based in the United Kingdom. It originated as a UK company called Forte Lubricants Limited that was acquired by the Complainant in 2008. It appears that following its acquisition by the Complainant this company has ceased to exist as a legal entity, but now operates as a distinct part of the Complainant’s business. It is this part of the Complainant’s business and its activities which need to be considered with regard to the Complaint. It and its predecessor Forte Lubricants Limited will be referred to in this decision as “Forte Lubricants”.

Forte Lubricants manufactures and sells a range of lubricants, cleaners and fuel additives for use primarily in motor vehicles. Examples include a “DPF [diesel particulate filter] Cleaner and Regenerator”, an “Advanced Diesel Fuel Conditioner” and a “Petrol Specialist Injector Cleaner”.

The most recent financial information the Complainant has provided as to the activities of Forte Lubricants relates to the period to November 2007, before the acquisition and dissolution of the UK company. These accounts show a business with a turnover of some £11 million and an operating profit of over £2 million. In the absence of any more recent information the Appeal Panel assumes that Forte Lubricants’ business has been maintained at a broadly similar level since that date.

In July 2000 Forte Lubricants registered <forteuk.co.uk> and since then has promoted its business via a website linked to that domain name. That website indicates that Forte Lubricants sells its products to some 9,000 garages in the UK and states prominently (on the home page) “Forte products are for trade only and not for retail sale”.

Forte Lubricants also carries out business internationally, with the filed evidence indicating activities carried out in the Netherlands and Belgium and sales being made elsewhere in the world via one or more independent distributors. Given that the

Domain Names are both in the “.uk” top level domain and that the discussion relates to businesses carried on in the UK, there is nothing in the submissions provided which suggest a need to go into further detail here as to these international activities.

The Complainant owns various registered trade marks in many different jurisdictions which are for, or which incorporate, the word “Forte”. Whilst some of these (Denmark and Malaysia marks have been identified) are word marks, most of the registrations are for a figurative or stylised form of the word “forte”, with an accented “e”, often in combination with a four stripe logo, as illustrated below.



This image is copied from United Kingdom registration No. 1345551 applied for on 26 May 1988 and registered on 17 January 1997¹, covering “lubricants, oils and greases; additives for fuels and oils; all for motor vehicles; rust penetrating and lubricating preparations; all included in [International] Class 4”, which appears to the Panel to be a typical example.

The Respondent is a reseller of domain names, that registered <forte.co.uk> on 21 September 2004 and <forte.uk> on 3 April 2017. The Domain Names have since registration been “parked” and offered for sale. They are each linked to a webpage which provides “Indirect Links” to other webpages which then provide “pay per click” links to third party websites.

On 8 March 2017, the Complainant sent to the Respondent a “cease and desist” letter complaining about the <forte.co.uk> domain name. The Complainant contacted the Respondent on 17 May 2017 and offered to purchase the <forte.co.uk> domain name for £1,000 (which was the starting price advertised through the website to which the domain name resolved). The Respondent replied indicating it would sell for £15-20,000. Matters did not proceed further, the Complainant subsequently filed the Complaint in this case, and on receipt of an unfavourable Decision followed up with this Appeal.

¹ This seems an unusually long time between application and registration but the Appeal Panel does not know what the reason was.

8. Parties' Contentions

The Complaint

The essential points the Complainant makes are as follows.

The Complainant says it has Rights in the FORTE trade mark and relies upon the trade mark registrations described above. It also says it has acquired Rights at common law through substantial, continuous, and extensive use and promotion of the FORTE trade mark in the course of business since 1979.

It says that the Domain Names are identical to the Complainant's FORTE trade mark because they each incorporate this trade mark in its entirety, adding only the ccTLDs ".co.uk" or ".uk."

The Complainant submits that both of the Domain Names are Abusive Registrations in the hands of the Respondent. The Complainant alleges that the Respondent must have been aware of the Complainant's FORTE trade mark when it registered <forte.co.uk>. The Complainant says that the Respondent has used the Domain Names to divert Internet users away from its genuine FORTE website, to the Respondent's advertising-related site and onwards to advertised links, for its own commercial advantage. The Complainant makes a number of points about the links displayed on the parking pages, which are described and discussed in detail below.

The Complainant also submits that the fact that the Respondent registered <forte.uk> when it knew of the Complainant and its objection to the registration of <forte.co.uk> was taking further improper advantage of its position. The Complainant alleges further that the Domain Names were registered intentionally to block the Complainant's registration and to disrupt the Complainant's business, inferring the Respondent's intent from the timing of registration of <forte.uk> (shortly after the Complainant contacted the Respondent) and also from the price of £15,000 to £20,000 demanded for <forte.co.uk>.

The Complainant states that the Domain Names have, since their creation, been offered for sale for more than the Respondent's out-of-pocket costs associated with acquiring the Domain Names. The Complainant also says that although the relevant parking pages linked to pages which suggested the Domain Names were for sale at £1,000 the Respondent in fact demanded a much higher sum (£15,000-£20,000) for the sale of <forte.co.uk>.

The Complainant further alleges that the Domain Names are Abusive Registrations because they are part of the Respondent's pattern of registering domain names that correspond to well-known names or trade marks. In this regard it identifies the following domain names in the Respondent's portfolio: <halliburton.co.uk>, <bently.co.uk>, <macafee.co.uk>, <energiser.co.uk> and <rollingstone.co.uk>.

The Complainant has relied upon a large number of previous DRS decisions as supporting its case and/or the points it makes on particular issues. Where relevant the Appeal Panel discusses these further below.

The Response

The Respondent says that it is a company of good standing and reputation in the UK domain name community that has been a member of Nominet for 15 years, carrying on a family business engaged in the sale of premium domain names with a current portfolio of 5,322 registrations. The Respondent submits that its portfolio comprises primarily generic, dictionary word, three-character, first name and surname domain names and that the Domain Names are examples of generic dictionary words.

The Respondent denies any knowledge of the Complainant or Forte Lubricants, or its products or trade marks, prior to the Complainant's communication of 8 March 2017.

The Respondent denies that the word "forte" is automatically and immediately associated by the general public with Forte Lubricants. The Respondent says that while the Complainant is a large international enterprise, Forte Lubricants is a small business with a single production facility in a business park in Coventry with 20 employees in total and is just one small business amongst 812 mostly larger businesses owned by the Complainant internationally.

The Respondent says that Forte Lubricants produces a range of specialist automotive cleaning and additive fluids for use exclusively in professional garages and which are neither marketed to nor offered for sale to the general public. The 9,000 garages supplied by Forte Lubricants represent only a fraction of the total number of commercial garages in the UK. There is no evidence to support the claimed widespread marketing campaigns, promotion and online advertisements. Furthermore, the Respondent says that any marketing efforts that may have been carried out will have been restricted to the professional garage sector.

The Respondent in effect admits the Complainant has Rights in the trade mark FORTE and concedes the Domain Names are identical to that trade mark. It notes that most of the registrations relied upon are for stylised forms of the word FORTE. It says this is not surprising as "forte" itself is a dictionary word with a generic meaning and unlikely to be capable of registration as a word mark on its own. It also notes that many of the FORTE trade marks the Complainant relies upon were applied for after it had registered <forte.co.uk>.

In support of its claimed lack of knowledge of the Complainant and its FORTE trade mark the Respondent makes a large number of detailed points, including the following.

The Respondent says that "forte" is a generic and descriptive dictionary word meaning "a strength, strong point, speciality, talent or skill" which is widely used by

many parties as a brand, or mark, or domain name or company name. The Respondent says that there are 293 trade marks equalling or containing the word “forte” registered in the UK and EU, in addition to any held by the Complainant; there are 42 exact trade mark matches for “forte” and no fewer than 86 trade marks in the same trade mark classes as the Complainant holds; another “forte” trade mark for Class 3 was just recently published; and there are 660 limited companies with the word “forte” in their name in the UK, with hundreds more internationally including several other “Forte Lubricants” named companies around the world, (with no relation to the Complainant)², in Canada, South Africa and India for example.

The Respondent also says that there are at least 254 other “.uk” domain names currently registered beginning with “forte” in addition to the two held by the Complainant, with a further 212 “.uk” domains ending in “forte”. Internationally there are around 1,280 relevant gTLD domain names starting with the word “forte”. The word “forte” is also registered as a domain name in 68 other common ccTLDs and gTLDs, with a further 67 domains registered in the new gTLDs. It says none of these domain names belongs to the Complainant or related companies.

The Respondent says that when a Google.co.uk search was performed on “forte” it produced 376 million entries for the word. The results contained many different “forte” companies, goods and services.

The Respondent states that on receipt of the Complainant’s letter on 8 March 2017, the Respondent responded in good faith the same day to co-operatively address the Complainant’s apparent concerns over the advertising content on the web page to which the <forte.co.uk> domain name resolved, offering to remove parking from the domain name until any potential advertising issues could be ruled out. The Respondent states that this was done even though the Respondent could not replicate the claimed content on its web page to which the Complainant had objected.

Having initially acted with immediate effect, the Respondent later restored the parking page for <forte.co.uk> in August 2017 with advertising which had been edited to try and prevent references to the Complainant’s business or products being shown under all circumstances. The Respondent had assumed that the Complainant had been satisfied with this response and actions until receipt of this DRS Complaint.

Addressing the Complainant’s assertion that <forte.co.uk> is an Abusive Registration because it is advertised for sale, the Respondent refers to the Policy paragraph 8.4 which states that “[t]rading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities”.

² This seems a surprising coincidence and the Appeal Panel wonders if it is correct. One possibility is these companies had some historic connection with Forte Lubricants Limited. The Complainant has not as far as the Appeal Panel can see challenged this evidence but the Appeal Panel does not propose to rely on it in its reasoning.

The Respondent asserts that it has made no attempt to contact Forte Lubricants at any stage over the 13-year registration period to offer for sale the <forte.co.uk> domain name and only provided pricing information on this in response to the Complainant's offer made in May 2017. The Respondent says it uses the same simple "For Sale" page for all its domain names and all pages contain the same "Starting Offer" price, currently £1,000. It says it is very clear from the description on these pages that this amount represents a minimum starting offer only. When the Complainant unilaterally made an offer on the <forte.co.uk> domain name of £1,000, the Respondent's reply was not any kind of demand, but simply to inform the Complainant of the asking price for the domain name. The Respondent says this domain name is one that received a lot of interest and the Respondent has received many enquiries from many different individuals and businesses wishing to purchase it. The Respondent says it provided the standard quotation to the Complainant at this stage without any real expectation of appropriate further interest from them given the nature of its earlier correspondence and apparently firm lower offer.

The Respondent submits that in practical terms the premeditation that the Complainant alleges would be impossible in the context of the manner in which the Respondent registers its domain names. The domain name <forte.co.uk> was registered in 2004 in an automated fashion, often now called 'drop catching'. It was registered simply because it became available and matched a word from the Respondent's dictionary word list which contained 68,000 entries. It was not known in advance which domain name would become available at any given time. The chances of acquiring any given domain name when it is released are relatively small and it is not possible in practice to secure the registration of any given premium domain name with any degree of certainty.

The Respondent acknowledges that it uses pay-per-click (PPC) advertising on its placeholder domain name pages but denies that it is "[a]n online [pay-per-click] business" as alleged, asserting that its domain registration costs for its ".uk" domain names alone amount to approximately £20,000 per annum presently (£3.75 x 5322 domains) while its annual pay-per-click revenues from all ".uk" domain names together are under £2,700 (and were \$0.02 for <forte.uk> in 2017). It says that if this was the Respondent's business it would not represent a very effective model.

The Respondent acknowledges that under the Policy paragraph 8.5 "the use of the Domain Name is ultimately the Respondent's responsibility". It says it uses the reputable parking provider ParkingCrew (www.parkingcrew.com) for this and hosts its domain names with them. They operate best practice for these services and use auto-optimised adverts on the page which are provided by Google and presented using templates. The adverts displayed are auto-optimized for the visitor based on a number of factors including contextual advertising.

The Respondent says it does not specifically set up and target the adverts for any particular domain names, as it would not be worth its while in terms of the time taken and the small returns generated; the auto-optimization setting is simply the most effective way and usually automatically avoids trade mark issues. The

Respondent says it has never targeted any adverts on any domain name, including <forte.co.uk>.

The Respondent notes that the Complainant with its 8 March 2017 letter attaches a screenshot that purports to show the <forte.co.uk> parking page containing what seems to be a specific reference to a Forte Lubricants product area - 'Forte Diesel Additive'. In another one of the 10 text adverts shown it also includes the related generic term 'fuel additive', along with other listings for unrelated things like drain cleaning. The Respondent questions how this page was created and says it was not able to replicate a page that looked like this one. It suggests there are two possible explanations. Firstly, it could be the result of contextual advertising. That is, the Google adverts on the pages which use this feature have based the displayed PPC ads based on the past searches and visits stored as cookies by the user in question. Alternatively, it could be the result of what it terms a "manipulated" use of the parking page³. It goes into considerable technical detail as to what it means in this regard.

The Respondent denies that it is engaged in a pattern of Abusive Registrations and submits that of its 5,322 domain name registrations the Complainant can only point to the following to support this allegation: <halliburton.co.uk>, <bently.co.uk> and <macafee.co.uk> which it says are family names; <energiser.co.uk> which it says is a dictionary word in its own right, used as the name for several UK businesses; and <rollingstone.co.uk> which is part of the Respondent's "phrase or saying domain name category". The Respondent adds that none of these domain names has ever been subject to a DRS or any other complaint and they all produce only negligible advertising revenue.

The Respondent states that the Complainant makes much of the Respondent's taking up the right to register <forte.uk> on 3 April 2017 suggesting this somehow forms evidence of Abusive Registration. It says this happened because the Respondent availed itself of the opportunity to take up rights of registration on the ".uk" domain for its existing ".co.uk" domain name, which Nominet was offering free of charge. This is something that the Respondent has done with respect to all of its pre-10 June 2014 registered ".co.uk" domain names.

The Complainant's Reply

In Reply the Complainant submits that the Respondent's arguments do not alter three fundamental facts: that the Complainant owns numerous, worldwide FORTE registrations dating back to the 1980s and 1990s, including for word marks; that the Respondent's <forte.co.uk> website displayed pay-per-click links related to products and services offered under the Complainant's marks; and that the Respondent registered the <forte.uk> domain name less than a month after the Complainant contacted the Respondent regarding infringement at <forte.co.uk>.

³ The Expert decided that this suggestion was an inappropriate allegation which he declined to deal with. This issue is addressed further in the Panel's discussions below.

The Complainant repeats its assertion that it has demonstrated that its marks have acquired substantial commercial strength through decades of worldwide use.

The Complainant also suggests that even if the Respondent's arguments were accepted, the expert's decision in *Road Runner Motor Trade Ltd v. Mr. D Ostashko*, Case No. D00004620 (Nominet 7 July 2007) is instructive. In that case, the respondent similarly argued that the complainant's ROAD RUNNER mark would not automatically be associated with the complainant due to dozens of other "road runner" companies and websites, and due to the fact that the complainant was low on the list of Google searches. The respondent also argued that the complainant described itself as a specialist for "sole traders & small independents" and that "anyone outside the scope of this business and consumer target group would have no idea about this small company which had after-tax profits of only £15,460 in 2006 and £17,877 in 2005." The expert, however, found the complainant's long-standing use more probative, stating that the complainant's "turnover figures are not huge, but that is not relevant. Usage over some 13 years should have accumulated substantial common law rights in the name."

The Complainant refers to the Respondent's denial that it had knowledge of the Complainant's FORTE brand prior to the Complainant's letter of 8 March 2017 and argues that given the long-standing, worldwide presence of Complainant's FORTE mark, this assertion is difficult to credit.

The Respondent's argument that the <forte.co.uk> domain was registered as part of an automatic "drop-catch" process is therefore unavailing. In this regard the Complainant refers to paragraph 2.4 of the "Experts Overview" (version 3) published by Nominet (the "Overview") and available on its website ("Where domain names are acquired as part of an automated or bulk transfer of a bundle of domain names, a Respondent will not escape the effect of the *Verbatim* decision on the basis that he was in fact unaware at the time of the transfer that one of the domains was similar to a well-known trade mark.").

The Complainant further argues that even if the Respondent's assertion is true, that would be relevant only to the question of whether the Respondent registered the <forte.co.uk> domain name in bad faith in 2004. It says the Policy paragraph 1 is written in the disjunctive, defining an "abusive registration" as one that has either been registered or "is being or has been used in a manner which has taken unfair advantage of...Complainant's rights." Thus, even if the Respondent registered the domain name in good faith in 2004, its later bad-faith use constitutes an abusive registration.

It says that the Respondent admits it knew of the Complainant and its FORTE marks as of 8 March 2017. The Respondent also admits that, though it took the infringing pay-per-click site down by May 2017, it put it back up in August 2017. The Complainant filed its DRS Complaint on 21 November 2017, attaching screenshots gathered in late 2017 of the <forte.co.uk> website displaying links directly related to

the Complainant's business. Thus, even though the Respondent claims to have disabled the <forte.co.uk> website in good faith, it knowingly restored it to its previously infringing status. Nor is the Respondent shielded by the fact that it has now once again revised the <forte.co.uk> website content. The Complainant cites *Sportingbet Plc v. Murphy*, Case No. D00009552 (Nominet 18 July 2011) ("The use appears now to have ceased... But the fact that the link to the parking page has apparently stopped does not however neutralise the previous abusive use of the Domain Name.").

The Complainant both denies, and takes offence at, the assertion that in order to create its screenshots, it somehow manipulated the Respondent's webpage. The Respondent claims to have been unable to reproduce the <forte.co.uk> screenshots provided by the Complainant in its letter of 8 March 2017 or the DRS Complaint, and that the Complainant's screenshots "would not have happened automatically in the circumstances." There is evidence from independent sources to support its claims regarding recent advertisement content on <forte.co.uk>, showing historical screenshots of the <forte.co.uk> website taken from DomainTools (<domaintools.com>), dated 6 May 2016, 17 October 2015, 11 February 2015, 21 August 2013, and 13 October 2010, which has been provided as an exhibit to the Reply.

The Complainant also argues that the Respondent's claims that its website's content is generated automatically by a third party, and that the Respondent has no relationships with the advertisers, are irrelevant. The DRS Policy is clear that "the use of the Domain Name is ultimately the Respondent's responsibility".

The Complainant submits that the Respondent cannot deny it knew of the Complainant's FORTE marks when it registered the <forte.uk> domain in April 2017. Further, the Respondent admits that it did not register it as part of its allegedly standard drop-catch process, but rather intentionally to "tak[e] up rights of registration on an existing ".co.uk" domain name". The Complainant submits that the Respondent's claim to have done this for all its ".co.uk" names is irrelevant.

Finally, the Complainant repeats its allegation that the Respondent is engaged in a pattern of Abusive Registrations. It refers to *Zehnder Verkaufs-Und Verwatungs AG v. 4Names Limited*, Case No. DRS 04513 (Nominet 20 May 2007) ("Even if the Respondent is correct that 'Faral' is a surname, that is irrelevant to the case at hand because...it is deliberately drawing traffic to the site by including a primary reference to the goods and interests of the Complainant.").

The Appeal Notice

The Appeal Notice criticises the Expert's decision on a number of grounds and in effect repeats the Complainant's case as outlined above. The Appeal Panel does not think it necessary to set out any more detail as to its contents.

The Appeal Response

The Appeal Response restates the Respondent's position, particularly with regard to the detail of the links that appear on the parking pages for the Domain Names, and includes a categorical denial that the Respondent has ever deliberately targeted the Complainant or Forte Lubricants or its products. The Appeal Panel does not think it necessary to set out any more detail as to its contents.

9. Discussion and Findings

Rights

Whilst the Respondent has drawn attention to the fact that the trade marks in question are (in the main) device marks, and that some of the trade marks were registered subsequent to the registration of <forte.co.uk>, there is ultimately no dispute that the Complainant has Rights in the trade mark FORTE for the purpose of the Policy. The Appeal Panel has accordingly not found it necessary to analyse this issue in any more detail. The Appeal Panel is satisfied that the Complainant has Rights in a name or mark that is identical to the Domain Names.

Abusive Registration – generally

In order to establish that the Domain Names in the hands of the Respondent are Abusive Registrations, the Complainant must show that the Domain Names were either:

- i) registered or otherwise acquired in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii) are being or have been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Establishing either one of these requirements (or both of them) will mean there is an Abusive Registration. In the following sections the Appeal Panel addresses these requirements for the two Domain Names separately, first for <forte.co.uk> and then for <forte.uk>.

Abusive Registration – the registration of <forte.co.uk>

In order to show that a domain name amounts to an Abusive Registration under i) above, a Complainant generally needs to show on the balance of probabilities that the Respondent was, or should have been, aware of the Complainant and/or its rights in a name or mark identical or similar to the domain name at the time it was

registered. Here, the Complainant suggests that the Respondent “undoubtedly knew” of the Complainant’s rights in the FORTE mark at the time it registered <forte.co.uk>. The Complainant relies on its own and its predecessors’ long-standing use of the mark in the UK, as well as the manner in which the Respondent used the Domain Name after registration.

The Complainant also contends that the Respondent registered the Domain Names for the purpose of selling them to the Complainant or a competitor of the Complainant for a sum in excess of the Respondent’s out of pocket costs associated with acquiring the Domain Names; or as blocking registrations. It argues that the offer to sell the <forte.co.uk> domain name for a very substantial sum (£15,000 to £20,000) is evidence that the Respondent had such a sale in mind when it registered the Domain Names.

It is important to bear in mind that the system of registration of domain names is a “first come first served system”. As a general rule any person is entitled to register any available domain name⁴. The question is: under what circumstances does such a registration become an Abusive Registration when there are one or more pre-existing identical or similar trade marks?

This issue is addressed in paragraph 2.4 of the Overview as follows:-

“The body of expert decisions under the Policy is developing and certain principles are emerging. The section of the Appeal decision in DRS 04331 (verbatim.co.uk) dealing with ‘knowledge’ and ‘intent’ sets out one panel’s views on that topic. However, new domainer practices (e.g. automated bulk transfers of domain names) are becoming commonplace and to the extent that the Verbatim decision suggests that for a finding of Abusive Registration, the Respondent must have had knowledge of the Complainant and/or its Rights at the relevant time, it is now thought by some Experts that that might overstate the position.

Where domain names are acquired as part of an automated or bulk transfer of a bundle of domain names, a Respondent will not escape the effect of the Verbatim decision on the basis that he was in fact unaware at the time of the transfer that one of the domain names was similar to a well-known trade mark. He will normally be taken to be aware (either actually or constructively) of the nature of his acquisition and the nature of the use that is being made of it.”

The Appeal Panel agrees with this approach and would add that the practice of automatically registering domain names which a previous registrant has allowed to lapse (“drop catching”) seems to the Panel to be subject to the same approach as automated or bulk transfers referred to in the Overview. The critical question of how well-known a trade mark has to be in order for a given registration to be impugned is a question of fact to be answered on the basis of the evidence in a given case.

⁴ There are exceptions to this general rule. The only one that is relevant for present purposes is the restricted availability (for 5 years from 10 June 2014) of “name.uk” domain names to registrants of corresponding “name.co.uk” domain names. This is discussed in section 10 below.

In the present case the Complainant's Forte Lubricants business sells only to the motor trade. Apart from details of its website no evidence has been provided even as to how it promotes its products to the motor trade. There is no evidence of its promoting its products to any wider audience and there is nothing before the Appeal Panel to suggest that the general public would have any knowledge of Forte Lubricants, or its products, or its FORTE trade mark.

Against that background the Appeal Panel regards the Respondent's denial of any knowledge of the Complainant or Forte Lubricants or its FORTE trade mark (until it received a letter from the Complainant's legal advisers in March 2017) as entirely credible and sees no reason to doubt it.

In the absence of actual knowledge by the Respondent can the Complainant's FORTE trade mark be regarded as a well-known trade mark so as to fall within the test in the Overview as described above and thus give the Respondent constructive knowledge of it? The Panel does not consider it does. As just stated, there is no evidence before the Panel that anyone outside the motor trade would have any knowledge of it. If Forte Lubricants' annual turnover is in the order of £11 million and it sells its products to some 9,000 garages (see above), its sales are on average in the order of £1,200 per garage per annum, a relatively modest amount. In these circumstances the Appeal Panel concludes the Complainant has failed to establish that its Forte trade mark is well-known for the purposes of applying the principles described above.

In the absence of any actual (or constructive) knowledge the Respondent cannot have registered <forte.co.uk> for the purposes of selling it to the Complainant or a competitor of the Complainant or to block the Complainant from effecting its own registration.

The Complainant has also raised the argument that the Respondent is engaged in a pattern of registrations which correspond to well-known names or trade marks in which the Respondent has no apparent rights and that the Domain Names are part of that pattern. The Complainant points to five of the Respondent's portfolio of over 5,300 domain names, namely <halliburton.co.uk>, <bently.co.uk>, <macafee.co.uk>, <energiser.co.uk> and <rollingstone.co.uk>. In response the Respondent claims that these comprise either family surnames (halliburton, bently and macafee); or a dictionary term (energiser); or part of a well-known phrase or saying (rollingstone).

The Appeal Panel agrees with the Respondent that the five domain names cited can all be understood in the ways it suggests, even if they or names similar to them have also been used as well-known trade marks. They are names which the Appeal Panel considers are at least potentially of legitimate interest or value to persons other than the owners of the various trade marks the Complainant has identified, and as such seem to the Appeal Panel to be properly within a large portfolio held by a trader in domain names. These types of name are in the Appeal Panel's opinion significantly different from domain names which can have no sensible meaning other than in

relation to the trade mark owner concerned. Thus for example in the <roadrunner.co.uk> case (DRS 4620) cited by the Complainant the respondent had also registered <generalgeorge.co.uk>, <kinder.co.uk>, <bbcradio.co.uk>, <mortgageexpress.co.uk>, <nokiaringtones.co.uk>, <channel4racing.co.uk>, <scotlandtoday.co.uk>, <axahealthcare.co.uk>, <ntl broadband.co.uk>, <aolsearch.co.uk>, <eastendersbbc.co.uk>, and <fcukonline.co.uk>. Most of these domain names seem to the Appeal Panel to be names which no one other than the trade mark owner concerned was likely to have a legitimate interest in acquiring.

Accordingly, in the absence of other examples of domain names held by the Respondent corresponding to well-known names or trade marks, the Panel does not consider that the registration of the five domain names identified in the present case could be said to be evidence of a pattern of abusive registrations on the part of the Respondent.

The Appeal Panel also does not consider that the price the Respondent sought for the <forte.co.uk> domain name supports an inference that the Respondent knew of the Complainant when it registered the domain name. As a general rule a seller of a domain name which is legitimately held can seek whatever price it likes for it. It does not seem surprising to the Appeal Panel that a name which is a five-letter dictionary word, which is easily memorable and which has a positive meaning, should be offered for sale at a significant price. The Appeal Panel also agrees with the Respondent that the pages suggesting that the Domain Name could be bought made it clear that £1,000 was a starting level for offers, rather than a firm price.

The Appeal Panel therefore declines to find that the <forte.co.uk> domain name was registered or otherwise acquired in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Abusive Registration – the subsequent use made of <forte.co.uk>

The next issue to consider is the question of the use made by the Respondent of <forte.co.uk>. This raises the need to consider the use of parking pages containing (i) pay-per-click advertising links which when clicked lead directly to a third party website; or (ii) "Indirect Links" which lead to further pages which in turn contain such "pay per click" links.

Such pages are in the Appeal Panel's experience widely used in particular by traders in domain names. The relevant pages are typically automatically created and some revenue will be generated if visitors to the page click through via the links to another site, although the amounts concerned are typically very small. The Respondent's evidence in the present case is that it earns £2,700 per annum from its entire portfolio of largely ".uk" domains. The advantage of this arrangement is that it provides a mechanism for making the domain name available for sale whilst potentially earning some revenue to defray the cost of maintaining the domain name registration.

The manner in which the content of such pages is automatically created is not straightforward to understand. In cases where parties wish to rely upon the detail of such pages as an important feature of a case they would be well advised to provide appropriate technical evidence explaining precisely what is happening. In the present case the evidence is not satisfactory and has led to significant dispute.

The Appeal Panel's understanding is as follows. The algorithms used often take into account the words contained within the domain name itself. They may also draw on other sources of data, such as Google or other search engines. They may well also take into account data relating to the particular visitor to the webpage. This could include the geographical association of the visitor's IP address and also cookies or other data stored on the visitor's system indicating for example other searches carried out or websites visited. Some or all of these factors are used to generate automatically a page of links, which may well be generated "on the fly" for a particular visitor and change dynamically in response to what the visitor clicks on.

The Appeal Panel does not know in what circumstances Indirect Links are generated rather than direct links, or what exactly causes any given link to be generated. However, it is clear that the content of the parking page may vary depending upon when it is visited and by whom. It also seems that the operator of the parking site (who may or may not be the domain name owner) has the ability to modify how the page content is generated and can ultimately remove the page altogether, either replacing it with another type of page (for example a simple "this domain is for sale" page) or leaving the domain name dangling so it no longer resolves at all.

The Appeal Panel considers that linking portfolios of domain names to parking pages in this manner is unobjectionable in itself. However the links generated on the parking page may be objectionable; whether they are objectionable is a question of fact depending on all the circumstances of the case. It will be necessary to consider the detail of the links in question and assess to what extent such links are causing or are likely to cause the complainant harm. In circumstances where it seems on the evidence that harm is being caused or is likely to be caused then a respondent may come under an obligation to change the nature or behaviour of the page or risk the domain name being found to have been used in a manner which has been unfairly detrimental to the complainant's Rights. Similar remarks apply to the respondent deriving unfair advantage from the links because of the complainant's Rights.

Returning to the facts of the present case, the essence of the Complainant's contentions is that the links on the webpages to which <forte.co.uk> has resolved were such as to take unfair advantage of, or be unfairly detrimental to, the Complainant's Rights. In the circumstances, the Appeal Panel will consider first the evidence adduced by the Complainant as to such links. This evidence comprises screenshots (or print-outs of web pages) taken either from current webpages or from historical webpages captured by archiving tools.

The screenshot of the <forte.co.uk> webpage provided as Exhibit 11 to the Complaint, and referred to in the Complaint in the present tense, is undated (apart from a line near its foot saying “2017 Copyright. All Rights Reserved.”). It lists 10 links – <Auto Spares>, <Small Cars>, <Hotels>, <Hospitality>, <Software>, <Music>, <DPF Diesel Particulate Filter>, <DPF Filter Removal>, <Diesel Exhaust Fuel> and <Exhaust Particulate Filter>. These all appear to be Indirect Links and there is no evidence before the Panel as to what happened if any link was clicked upon. The latter four entries seem to be the closest to the Complainant’s Forte Lubricants business, but they are not direct references to any type of product the Complainant advertises on its Forte Lubricants website - the Complainant does not appear to sell filters or fuel. It is therefore not apparent to the Panel that any of these links are likely to lead via further webpages to products which compete with those of the Complainant.

The Appeal Panel cannot realistically see how this parking page can have caused the Complainant harm or benefitted the Respondent in a way that could be said to take unfair advantage of the Complainant’s Rights. Even if the Panel were to assume that an actual or potential trade customer of the Complainant arrived at this page by mistake (for example by incorrectly guessing the Complainant’s web address) the Appeal Panel considers it would immediately realise its error and adopt another approach, particularly given that there is no evidence that any of the links in question lead to products that compete with those of the Complainant. The Appeal panel does not consider in this case that “initial interest confusion” could lead to a finding of Abusive Registration (see the Overview paragraph 3.3) given the very limited customer base to which the Complainant sells its products and the evidence, discussed in more detail below, of very low visitor numbers.

The Appeal Panel adds that this conclusion depends on the facts of this case and the nature of the Complainant’s business. A different analysis would apply for a business that marketed its products or services to the general public, and where visitors to a parking page were presented with links that took them to competing products (see for example the discussion below of DRS 4513 <faral.co.uk>).

Matters do not however depend only on this page. The Complaint also exhibits historical copies of the <forte.co.uk> webpage. The earliest is from 8 September 2005 and contains links all of which are hotel related. The Panel imagines this is because of the then existing Forte hotel business (which is an illustration of how more than one party may have interests in the same word as a trade mark). A later page from 14 December 2007 is also exhibited. This contains links to a wider range of products including lighting, skin care and Rocco Forte hotels. None of them have any relevance to the Complainant or its Forte trade mark. Neither of these pages assists the Complainant.

The Complaint also exhibits its legal advisers’ letter of 8 March 2017. This has annexed to it a further example of a webpage at <forte.co.uk>, dated 14 December 2016, which contains a significantly different set of links: <Forte Diesel Additive>, <Forte>, <DPF Cleaning>, <Diesel Exhaust Fuel>, <Fuel Additive>, <DPF Diesel Particulate Filter>, <DPF Filter Removal>, <Water Removal>, <DPF Cleaning> and

<Drain Cleaning>. Again, these all appear to be Indirect Links and the Appeal Panel does not know what happens when any link is clicked on. Whilst these links seem to be closer to the Complainant's Forte Lubricants business the Appeal Panel still does not know whether any of them will lead eventually to any product that competes with those of the Complainant.

This parking page has led to a heated debate between the parties. The Respondent says that it has been unable to reproduce this page and accuses the Complainant of having "manipulated" this page. The Complainant's legal advisers have taken the word "manipulated" as an allegation that they have improperly fabricated evidence. The relevant allegation is certainly made in rather heated terms (see below) but the thrust of the Respondent's argument, as the Appeal Panel understands it, is that the Complainant - through its lawyers - probably by repeated visits to the same page has caused a specific webpage to be displayed. Whether this was done intentionally (which the Complainant vehemently denies) or was an unintended consequence of the steps taken in visiting the page does not matter for the purposes of assessing the significance of the evidence. It is this webpage which the Respondent says it has been unable to replicate. The Respondent in its evidence goes into considerable detail, citing statistics it has obtained on traffic to the webpage in question at around the relevant time, which it says support its case:

"After a more detailed investigation I have found evidence that the complainant's representative did very likely in fact carry out such a manipulation to obtain the screenshot in question. The date at the bottom of the captured page when it was taken of 2016 (E13) pointed us to examine this year. We then found a suspicious time period 8th-14th December 2016, this time from the data available shows a spike in page visits, advert clicks and especially click through rate which spiked up to 400% on 13/12/16 (A31i). This is an increase from a monthly average of 7.79% for the preceding 12 months (A31ii), with inflated rates also seen on the adjoining days of up to 200%.

Examination of forte.co.uk related server log files showed a large number of visits by IP address 193.240.51.66 to the forte.co.uk for sale page on 8th-14th December 2016. (A32i). The same IP address also visited the Successful.co.uk home page during the same period and made multiple searches for "forte" and related terms (A32ii). This IP address traces to a company at the location of the complainant's representative's London office (A32iii)."

These seem to the Appeal Panel to be proper points to make in seeking to challenge the Complainant's evidence and do not depend upon the Complainant having deliberately intended to produce a misleading result. However, whether or not the Respondent's arguments are correct is not something the Appeal Panel can resolve. The Complainant for its part in its Reply denies completely that its legal advisers' proper visiting of the website was a deliberate attempt to manipulate the page in question or that it will have caused this behaviour. It places in evidence earlier screenshots derived from archive websites which it says show exactly the same behaviour. Thus, for example, it exhibits what is said to be an archived copy of the

forte.co.uk webpage dated 21 August 2013 which contains Indirect Links to <Fuel Additive>, <Diesel Emissions>, <Diesel Oil>, <Additive Diesel Fuel> as well other Indirect Links to unrelated products.

The Appeal Panel is reluctant to draw inferences from such archived screenshots without the benefit of proper expert advice on how their content is derived. In any case, although these pages show Indirect Links which could be related to the Complainant's Forte Lubricants business, it has already been stressed that there is no evidence as to what pages they led to, nor, in particular, any indication that a visitor to them could be directed to a competitor of Forte Lubricants. The Appeal Panel has still seen no evidence that the Complainant suffered harm as a result of any instance of the parking page. All that is provided is unsupported assertion - for example in the Reply: *"Further, even if the links provided on Respondent's website do not correspond perfectly to Complainant's product line, they are close enough to cause consumer confusion"*. The Appeal Panel has not been furnished with any actual evidence of such confusion. In some cases an Expert or Appeal Panel can readily infer confusion as a matter of common sense and such evidence is not necessary. This is not such a case, given the specialised nature of the Complainant's products and the limited trade market to which it sells those products.

In addition, there is evidence (contained in appendix 30 to the Response) that the level of visitor traffic attracted to the forte.co.uk parking page is very low: in the period January to October 2017 there were a total of 162 unique visitors to the parking page and these visits resulted in only 12 click throughs which actually earned any revenue. The Appeal Panel considers that the evidence as to the revenue that the Respondent is deriving (appendix 30 to the Response, showing earnings in the period January to November 2017 from the <forte.co.uk> parking page of (in total) \$3.57) indicates that it is unlikely that the Respondent deliberately targeted the Complainant. The Appeal Panel agrees with the Respondent when it says: "if this was our business it certainly would not represent a very effective model".

The sparse evidence of potentially detrimental links contrasts with the findings of the cited case which the Complainant relies upon, DRS 4513, <faral.co.uk>. In that case the complainant sold radiators under the trade mark Faral. The relevant parking page included the following text:

*"For Faral and Radiators try these sponsored results:
Central Heating Radiator Price Match Guarantee? Find Cheaper We'll Match It. Free UK Delivery. www.HeatAndPlumb.com
Designer Radiators Vast Range At Low Prices? See our special offers.
www.radiatorfactory.co.uk*

...

*Central Heating Radiators designer radiators, bathroom radiators discounted, free delivery www.warmrooms.co.uk
Radiators & Towel Rails Top Quality. Great Online Prices Electric Models. Free Fast Delivery www.uk-radiators.com*

Oil Filled Radiators Cheap Oil Filled Radiators Top UK Suppliers - Fast Delivery! Oil-Filled-Radiators. Top-UK.co.uk
Designer Radiators 15% Discount On all Contemporary And Classic Radiators, Buy Online! www.diy.com
The Radiator Centre Massive range of designer radiators all styles and models available www.wpah.co.uk."

This parking page is replete with references to products the same as those of the complainant and the Expert in that case concluded that it was likely to be causing the Complainant harm.

The Appeal Panel has also considered the earlier decisions by Nominet experts under the Policy which the Complainant has cited. The Appeal Panel is reluctant to undertake a forensic analysis of these decisions because, as the Overview points out, "there is no system of precedent under the DRS Policy". However, in addition to the <faral.co.uk> case (above) the five further cases relied on by the Complainant related to domain names that suggest clear distinctions from the present case because they were not dictionary words, and were on the face of it, most likely to have been intended to take advantage of the respective complainant's Rights in a relevant name. They were "myfortic", a trade mark of Novartis; "aldityres", that Aldi Stores complained of; "backwell logs", that clearly related to a product of the complainant Backwell Wood Estate; "moneycorpbank", where TTT Moneycorp objected; and "jemca", one of Toyota's trade marks.

In contrast, we are concerned here with a dictionary word that is also a well-known surname; that was first registered as a domain name more than 12 years before complaint was made; where the Appeal Panel does not consider that the Respondent either is likely to have known or should have known of the Complainant or its Rights at the time he registered the <forte.co.uk> domain name; and where the Respondent has done nothing directly to take advantage of the Complainant's Rights.

As paragraphs 8.4 and 8.5 of the Policy provide:

8.4 Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.

8.5 Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:

8.5.1 the nature of the Domain Name;

8.5.2 the nature of the advertising links on any parking page associated with the Domain Name; and

8.5.3 that the use of the Domain Name is ultimately the Respondent's responsibility.

In conclusion, the Appeal Panel does not find it credible that the Complainant has lost any sales as a result of the Respondent's activities or that, for example, it has unfairly had to pay (indirectly) for pay-per-click visits to its website. At the same time, the Panel finds persuasive the Respondent's argument (with supporting evidence) that its business model in general rests rather on the sale of attractive domain names than on click-through revenue derived from parking pages, and that this holds strongly in this specific case. Thus, the Respondent has not unfairly benefited from the coincidental match between <forte.co.uk> and the Complainant's Rights in its FORTE trade mark.

Abusive Registration – the registration of <forte.uk>

The Respondent registered <forte.uk> on 3 April 2017 which was after it had become aware of the Complainant and its claim to have Rights in the FORTE mark, as some four weeks earlier it had received the Complainant's letter requesting transfer of <forte.co.uk>.

It has only been possible to register domain names directly under the ".uk" ccTLD since 10 June 2014. When this new option was established by Nominet, it provided for registrants of ".co.uk" domain names who had registered the domain name on or before 28 October 2013, and who still held the domain name on 10 June 2014, to have the reserved right to register the equivalent ".uk" domain name until 10 June 2019. Since the Respondent has held <forte.co.uk> since September 2004, he was so entitled and exercised that right on 3 April 2017. The Respondent argues that as a holder of a portfolio of domain names he naturally takes advantage of this right for all his ".co.uk" domain names and states that a substantial number of such ".uk" domain names were taken up by him in 2017 because of a two year free registration promotion being run by Nominet at that time.

In view of the timing, the Appeal Panel considers it most likely that the decision to register <forte.uk> under the reserved right was prompted by the Complainant's cease and desist letter, whilst noting that it would not then have been possible for the Complainant to have registered the domain name because it was reserved to the Respondent for as long as he continued to hold <forte.co.uk> up until 10 June 2019.

The Respondent's reserved right to obtain <forte.uk> depended on its existing registration of <forte.co.uk>. At the time of registration, the Respondent knew of the Respondent and its Rights. It also knew that "forte" was a dictionary word and a surname and likely to be of value generally to persons other than the Complainant. The Respondent is a trader in domain names and has a legitimate interest in seeking to exploit its portfolio as effectively as possible. It seems natural to the Panel this will include obtaining ".uk" domain names corresponding to ".co.uk" domain names especially where there is a reserved right and the ".uk" domain name is available free of charge. It is therefore understandable that the Respondent has now done so

