

# **DISPUTE RESOLUTION SERVICE**

**D00020385**

## **Decision of Independent Expert**

Compagnie Générale des Etablissements Michelin

and

Orlando Antoine

### **1. The Parties:**

Complainant:

Compagnie Générale des Etablissements Michelin  
12 Cours Sablon  
Clermont-Ferrand  
Puy-de-Dôme  
63000  
France

Respondent:

Orlando Antoine  
6 Roberts Court  
Maple Road  
London  
SE20 8JJ  
UK

### **2. The Domain Name(s):**

*michelincook.co.uk*

### **3. Procedural History:**

I can 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, which need be disclosed as might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

6 July 2018 Dispute received  
9 July 2018 Complaint validated  
12 July 2018 Notification of complaint sent to parties  
31 July 2018 Response reminder sent  
3 August 2018 No Response Received  
3 August 2018 Notification of no response sent to parties  
10 August 2018 Expert decision payment received

### **4. Factual Background**

The Nominet records show that the Domain Name was registered on 20 February 2018.

Based on the Complainant's submissions (see section 5 below), which are unchallenged by the Respondent, I set out below the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant owns several trade mark registrations for MICHELIN.
- b. The Complainant has made extensive use of the MICHELIN name for many years, including in relation to the Michelin restaurant guides and the star ratings which it awards to top-rated restaurants. The Complainant has thereby established substantial goodwill in the MICHELIN name, which is well-known in the UK and elsewhere.
- c. The Respondent is not affiliated in any way with the Complainant, nor has it been authorised by the Complainant to use the Domain Name.

### **5. Parties' Contentions**

#### Complaint

The Complainant's contentions are as follows:

**The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:**

- (1) The Complainant and its MICHELIN trade mark enjoy a worldwide reputation.

- (2) Michelin, the leading tyre company, is dedicated to enhancing its clients' mobility, sustainably; designing and distributing the most suitable tyres, services and solutions for its clients' needs; providing digital services, maps and guides to help enrich trips and travels and make them unique experiences; and developing high-technology materials that serve the mobility industry.
- (3) Headquartered in Clermont-Ferrand, France, Michelin is present in 170 countries, has 111,700 employees and operates 68 production facilities in 17 countries which together produced 187 million tyres in 2016.
- (4) For the third consecutive year, the Reputation Institute, which ranks the world's brands according to their reputation, has put Michelin at the head of the French rankings and 13th worldwide. Michelin is also the French brand with the best reputation in many countries: United States, China, Germany, the United Kingdom and Italy. Other reputation surveys rank Michelin as the leading company in its business sector.
- (5) In the UK, the Michelin Tyre Company Ltd was incorporated on 11 May 1905 and is now, more than one hundred years later, involved in many activities not just tyre making, from tyre industry training to economic development and publishing.
- (6) Michelin has an extensive sales force supporting the thousands of tyre distributors in the UK and the Republic of Ireland, from car tyre to truck, agricultural as well as specialist industrial and earthmover. This is backed by a comprehensive sales and technical support.
- (7) Michelin's UK head office and commercial headquarters is in Stoke-on-Trent with tyre factories in Ballymena (bus and truck tyres) and Dundee (car tyres) as well as a truck tyre retreading factory in Stoke-on-Trent. The Maps and Guides division, publishers of the famous Michelin Guide, is located in Watford.
- (8) The Complainant owns numerous MICHELIN trade mark registrations around the world, notably the following:
  - European trade mark MICHELIN No. 009914731, filed on 21 April 2011 and registered on 27 September 2011, covering goods and services in classes 9, 35, 37, 38, 39, 41, 42 and 43
  - International trade mark MICHELIN No. 348615, registered on 24 July 1968 (duly renewed), covering goods in classes 1, 6, 7, 8, 9, 12, 16, 17 and 20
  - International trade mark MICHELIN No. 816915 registered on 27 August 2003 (duly renewed), designating United Kingdom and covering services in classes 35, 37, 39 and 42

- United Kingdom trade mark “MICHELIN” No. 1286122, filed on 1 October 1986 registered on 16 August 1991 (duly renewed), covering goods and services in classes 35, 37, 41 and 42.

- (9) The Complainant operates many domain names reflecting its trade mark through which Internet users can easily and quickly find information on the products and services commercialised under the MICHELIN trade mark, including:

<michelin.com> registered on 1 December 1993;

<michelin.co.uk> registered on 22 April 1997.

- (10) The above-mentioned domain names have been registered more than 20 years before the domain name in dispute.
- (11) The domain name <michelincook.co.uk> reproduces entirely the Complainant’s trade mark MICHELIN and associates it with the generic term “cook”.

**The Domain Name, in the hands of the Respondent, is an abusive registration:**

- (1) The disputed domain name <michelincook.co.uk> incorporates the Complainant’s trade mark MICHELIN, which is very well-known and has also been considered to be “well-known” by previous panels (Nominet Case No. D00009108, *Compagnie Générale des Etablissements Michelin v. Mr Neil Harvey*; and Nominet Case No. D00018479, *Compagnie Générale des Etablissements Michelin v. James Powell*).
- (2) The term MICHELIN does not have any meaning in English, except in relation to the Complainant. Consequently, this sign has a high degree of distinctiveness. It is therefore necessarily related to the Complainant’s trade mark and company name.
- (3) Previous Nominet experts have already considered that the addition of a generic term to such a widely known trade mark does not prevent the likelihood of confusion (Nominet Case No. D00012322, *Pertemps Limited v. Quick Pertemps*; Nominet Case No. D00010778, *Cosmetic Research Group v. Brainfilled Solutions LLC*).
- (4) The inclusion of the word “cook” as part of the disputed domain name is likely to cause further confusion since this term may refer to the numerous restaurants which have been starred by The Complainant inasmuch as there are 10,195 such restaurants in the United Kingdom. A press release illustrated the following article: “Michelin is pleased to unveil the new selection of the Michelin Guide Great Britain & Ireland, which highlights a total of 2,067 restaurants and 1,155 hotels and guesthouses. In this selection, London continues to build on its reputation as a world-class destination for rich, varied eating experiences. But the offer across Great Britain and Ireland as a whole is developing, often based around exceptional regional ingredients”. Thus, it is likely that this domain name could mislead Internet users into thinking that it

is, in some way, associated with the Complainant and thus may heighten the risk of confusion.

- (5) Before submitting the present Complaint, on 7 May 2018 the Complainant sent a cease-and-desist letter to the Respondent via registered letter and e-mail on the basis of its trade mark rights concerning the domain name <michelincook.co.uk>. The cease-and-desist letter requested the Respondent to transfer the said domain name to the Complainant, followed by several reminders.
- (6) On 29 May 2018, the Respondent replied to the Complainant's cease-and-desist letter stating that he declined the proposal of transferring the disputed domain name to the Complainant free of charge inasmuch as the domain name is currently not in use.
- (7) In view of the seriousness of the infringement, the Complainant has no other choice but to directly initiate a Nominet procedure against the Respondent in order to obtain the transfer of the disputed domain name <michelincook.co.uk>.
- (8) All of the following grounds establish that the domain name in dispute has been registered and is being used in bad faith.
- (9) The Respondent is not known under the name "Michelin" or any similar term. The Whois database identifies the Respondent as "Orlando Antoine".
- (10) Hence, the Respondent is not affiliated with the Complainant in any way nor has the Respondent been authorized by the Complainant to use and register its trade mark or trade name, or to seek registration of any domain name incorporating said mark or trade name.
- (11) Previous Nominet panels have held that, in the absence of any licence or permission from the Complainant, no legitimate use of a domain name may reasonably be claimed (Nominet Case No. DRS00006995, Normalu S.A. v. Stretch Ceilings).
- (12) The Respondent has no prior rights or legitimate interest in the domain name. The registration of the MICHELIN trade marks preceded by many years the registration of the disputed domain name.
- (13) In addition, to the best of the Complainant's knowledge, the Respondent has so far neither used nor made any demonstrable preparation to use the domain name in connection with a bona fide offering of goods or services. The domain name resolves to a website under construction, which can be considered as an inactive page. Consequently, the Respondent fails to show any intention of non-commercial or fair use of the disputed domain name. It is most likely that the Respondent has no legitimate interests or rights in the domain name.
- (14) Considering the reputation of the Complainant's trade mark and its long history, it is implausible that the Respondent was unaware of the Complainant

when he registered the disputed domain name. Indeed, the Complainant is well-known throughout the world, including in the United Kingdom, where the Respondent is located. Also, several Nominet decisions have previously mentioned the Complainant's worldwide reputation, making it unlikely that the Respondent was not aware of the Complainant's proprietary rights in the MICHELIN trade mark. This is therefore additional proof that the Respondent was aware of the Complainant's existence and activities at the time of the registration of the disputed domain name.

- (15) Additionally, a simple search via Google or any other search engine using the keyword "MICHELIN" demonstrates that all first results relate to the Complainant's products or news.
- (16) Knowledge of a corresponding trade mark at the time of a domain name's registration suggests bad faith. In this day and age of the Internet and advancement in information technology, the reputation of brands and trade marks transcends national borders. Taking into account the worldwide reputation of the Complainant and its trade marks, as well as the high level of notoriety of the Complainant, it is hard to believe that the Respondent was unaware of the existence of the Complainant and its trade marks at the time of registration of the disputed domain name.
- (17) The disputed domain name is so similar to the Complainant's trade mark that the Respondent could not reasonably pretend to develop a legitimate activity through said domain name. The Respondent has no reason to choose a domain name which incorporates the trade mark "MICHELIN" in its entirety, other than to benefit from the reputation of the Complainant (see Nominet Case No. D00006524, Expedia, Inc. v. Bluestone Ventures Pty Ltd).
- (18) The disputed domain name is so obviously connected with the Complainant's well-known trade mark that its very use by the Respondent, who has no connection to the trade mark MICHELIN, suggests opportunistic bad faith.
- (19) It seems that the only reason why the Respondent has registered the disputed domain name is probably for the purpose of selling it to the Complainant or using it later, taking advantage of the notoriety of the Complainant. As such, the Respondent is acting in bad faith by retaining the disputed domain name despite having been requested to transfer it to the Complainant.
- (20) Previous Nominet cases have considered that passive holding of a disputed domain name can satisfy the requirements of abusive registration: "So, when presented with what seems to be an inactive site, potential purchasers will assume that the Complainant's UK website is inactive, or is temporarily out of operation. As a result, such users may indeed, as the Complainant suggests, go to other internet sites operated by the Complainant's competitors in order to purchase their goods. Thus, not only does the existence of the disputed domain name have the potential for disrupting the Complainant's business, there is no doubt that its continued existence is likely to confuse users into believing that the disputed domain name is connected with the Complainant when it is not" (Nominet Case No. DRS 01781 Amazon.com Inc. v Microplace Ltd).

- (21) Finally, it can be deduced that the Respondent registered the domain name to prevent the Complainant from using its trade mark in the disputed domain name.
- (22) For the reasons stated above, it is, therefore clear that the disputed domain name, in the hands of the Respondent, is an abusive registration.

### Response

The Respondent has not filed a Response.

## **6. Discussions and Findings**

### General

#### The Complaint

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

### Complainant's Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the name Michelin.

Disregarding the generic .co.uk suffix, the only difference between the Domain Name and the Michelin name is the addition of the suffix "cook". Since "cook" is a descriptive term, this does not prevent the Domain Name being very similar to the name in which the Complainant has Rights.

I therefore find that paragraph 2.1.1 of the Policy is satisfied.

### Abusive Registration

Paragraph 1 of the Policy defines an "Abusive Registration" 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."

Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The key relevant factors under paragraph 5 on which the Complainant expressly or implicitly relies are as follows:

*"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 purposes 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"*

By way of preliminary comment, although the Respondent has not filed a Response, it is still necessary for the Complainant to prove its case. It is nevertheless relevant that the Respondent has not sought to provide any explanation for why it chose to register the Domain Name.

There is no doubt that MICHELIN is a famous trade mark, which is very well-known worldwide. Accordingly it is not credible that the Respondent could have chosen the Domain Name without being aware of the MICHELIN name. The Respondent must have been aware of it. This conclusion is reinforced by the Respondent adding "cook" to the end of the Domain Name, a term which is obviously associated with the MICHELIN brand because of the Complainant's well-known restaurant guides.

When a distinctive brand name is completely reproduced in a domain name, with the only addition being a descriptive and therefore non-distinctive term- especially one which has a connection with the brand name, as is the case here with "cook"- the normal presumption is that there is no bona fide reason for the registration of that domain name. I find that this presumption applies in this case.

As already noted, the Respondent has chosen not to file a Response and has thereby failed to offer any explanation for the choice of the Domain Name. The Respondent has therefore failed to rebut the presumption which applies.



It is clear to me that any use which the Respondent could make of the Domain Name is likely to cause people to be confused into believing that the Domain Name belongs to the Complainant or is connected with, or authorised by, the Complainant in some way. Even if the Respondent were to use the Domain Name for a website, the content of which makes clear that it is not in fact connected with the Complainant, the nature of the Domain Name would still be likely to give rise to what is known as "initial interest confusion". This is the type of confusion whereby people believe that they are accessing a website belonging to someone else, i.e. the Complainant, and are only disabused of that confusion after spending time reviewing the website.

"Initial interest confusion" has been found in several DRS decisions to be a relevant type of confusion for the purposes of the DRS Policy. The factor under paragraph 5.1.2 of the Policy therefore applies.

In the correspondence between the parties prior to the Complainant filing its Complaint, the Respondent stated in one communication that it was not willing to transfer the Domain Name free of charge but was "open to offers". Also taking into account the nature of the Domain Name, the Respondent having made no use of it to date, and the lack of any Response being filed, I find on the balance of probabilities that the Respondent registered the Domain Name primarily for the purpose of selling it to the Complainant for a profit. In other words, the factor under paragraph 5.1.1.1 of the Policy also applies.

Having found that the Respondent intended to sell the Domain Name to the Complainant for a profit, I conclude that the registration of the Domain Name therefore took unfair advantage of and was unfairly detrimental to the Complainant's Rights. There is nothing in this case which could lead to a conclusion that such purpose could be anything other than unfair.

In addition, the fact that any use which the Respondent could make of the Domain Name would be likely to give rise to at least initial interest confusion also means that the Domain Name takes unfair advantage of, and/or is unfairly detrimental to, the Complainant's Rights. It takes unfair advantage because, whatever the content of a website using the Domain Name, the Complainant would thereby unfairly attract visitors to its website who would not otherwise have accessed it. It is unfairly detrimental because the content of any such website would be outside the control of the Complainant.

As a result, I find that the Domain Name takes unfair advantage of, and/or is unfairly detrimental to, the Complainant's Rights whether or not the Respondent's intention when registering the Domain Name was to sell it to the Complainant for a profit. The above means that the Domain Name is an Abusive Registration under paragraph 1 of the Policy.

## **7. Decision**

Having found that the Complainant has Rights in respect of a name which is similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an

Abusive Registration, the Expert directs that the Domain Name *MichelinCook.co.uk* be transferred to the Complainant.

**Signed .....**  
**Jason Rawkins**

**Dated: 6 September 2018**