



DISPUTE RESOLUTION SERVICE

D00022897

Decision of Independent Expert

Compagnie Générale des Etablissements Michelin

and

Domain Privacy Protector Ltd

1. The Parties:

Complainant: Compagnie Générale des Etablissements Michelin
23 PLACE DES CARMES-DÉCHAUX
CLERMONT-FERRAND
FRANCE
63000
France

Respondent: Domain Privacy Protector Ltd
Office 404, 4th Floor
Albany House, 324/326 Regent Street
London
W1B 3HH
United Kingdom

2. The Domain Name:

michelintyre.uk

3. Procedural History:

- 3.1. 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, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

19 March 2020 12:27 Data release request
19 March 2020 13:01 Data release
14 August 2020 16:10 Dispute received
17 August 2020 13:23 Complaint validated
17 August 2020 14:14 Notification of complaint sent to parties
04 September 2020 02:30 Response reminder sent
09 September 2020 08:47 No Response Received from Respondent
09 September 2020 08:59 Notification of no response sent to parties
21 September 2020 02:30 Summary/full fee reminder sent
21 September 2020 09:15 Expert decision payment received

- 3.2. This Decision is determined in accordance with Nominet's Dispute Resolution Service Policy Version 4 dated October 2016 (the "**DRS Policy**").

4. Factual Background

- 4.1. The chronology of the complaint is set out above.
- 4.2. The following facts and matters are taken from the Complaint and attached documents, which are substantially unchallenged. Where claims are made by the parties these are stated as such.
- 4.3. The Complainant is a tyre manufacturer located in France, but which has operations in 171 countries around the world and is the owner of the following UK trade marks:
 - UK trade mark No. 691700 for MICHELIN, filed on and registered since 23/8/50 in class 12 for "Tyres and inner tubes, all for vehicles, patching materials for tyres and internal protectors for pneumatic tyres."
 - UK trade mark No. 1286122, for MICHELIN, filed on 1/10/86 and registered since 16/8/91, covering services of particular relevance in class 37: - Tyre repair services; tyre fitting services; tyre retreading services; tyre regrooving services; wheel repair services; wheel balancing services; all for others; all included in Class 37.
- 4.4. The Complainant is also the owner of a number of registered trade marks in a number of other jurisdictions, including the European Union for these and other goods and services under the sign MICHELIN.
- 4.5. The Domain Name was registered on 6/2/20 and the named registrant was LCN.com, a business which provides domains and registrant privacy services in relation to those domains. The identity of the actual registrant was therefore hidden. Prior to making the Complaint the Complainant's Representatives made

a data release request and were provided with the details held by Nominet in relation to the registration; the registrant was listed as “Private User” with the address given above and an email address.

- 4.6. The Complainant’s representative entered into pre-complaint correspondence with the Respondent named above. It received a response to its initial letter of complaint dated 31/3/20 from Mr Simon Webb on 1/4/20.
- 4.7. In that response Mr Webb claimed to be representing a garage which distributed sold and fitted Michelin branded tyres. He stated that his intention was “*to build a website further enhancing the Michelin brand within [his] local community*”.
- 4.8. He claimed that there was no intention to misuse the name and that he intended to seek the Complainant’s approval for the website before it went public.
- 4.9. Further correspondence ensued in which the Complainant sought the transfer of the Domain Name. After initial responses, Mr Webb ceased responding to the communications.
- 4.10. There was no response by the Respondent named above or Mr Webb to the Complaint.

5. Parties’ Contentions

The Complaint

- 5.1. The Complainant claims longstanding rights in the trade mark MICHELIN in connection with tyres and tyre services, and to have captured 14% of the global tyre market. The Complainant claims to have acquired considerable reputation and goodwill in the MICHELIN brand and asserts that it was rated as America’s Best Large Employer in 2018. It has 117,400 employees worldwide. In 2019, it was rated as the top brand in France and 8th in the world by the Reputation Institute. The Complainant states that MICHELIN is very well known in the field of automobile and tyre manufacturing industries and has been found to be well known in previous Nominet DRS decisions D00009108 and D00018479.
- 5.2. The Complainant also relies on its operation of domain names michelin.com (from 1/12/93) and michelin.uk (from 9/7/14). The former being operated for more than 20 years and the latter more than 4 years before the registration of the Domain Name.
- 5.3. The Complainant states that the Domain Name was registered anonymously and was directed to the default page of the listed registrar and has an email server configured on the domain name, so that there may be a risk of phishing. After the Complainant obtained the registrant details (set out above as the Respondent) it sent a cease and desist letter through the registered email address on 31/3/20.
- 5.4. Mr Webb responded to this correspondence providing the information set out in paragraph 4.7 above. The Complainant refers in its Complaint to Mr Webb as the Respondent. The Complainant states that Mr Webb refused to transfer the Domain Name, and accused the Complainant of being a bully. The Complainant complains that Mr Webb also stated that if the Complainant refused to make an offer to buy the domain name from him, he would register other domain names

incorporating the Complainant's MICHELIN trade mark and would spread negative advertising about the Complainant, and stated that he had already contacted television channels in the United Kingdom and in Russia.

5.5. The Complainant sent a few more e-mails to Mr Webb, trying to solve this matter amicably, but there was no response.

5.6. The Complainant asserts as follows:

- The Domain Name reproduces the Complainant's trade mark MICHELIN in its entirety;
- In the Domain Name the MICHELIN trade mark is associated with the generic term "tyre" which enhances the impression that it is officially related to the Complainant, and is likely to confuse Internet users into believing that the Domain Name will direct them to a website dedicated to the Complainant's tyre services.
- The .uk extension should not be taken into consideration.
- Previous Nominet DRS decisions have considered that the addition of a generic term to a widely known trade mark does not prevent the likelihood of confusion (D00012322, D00010778).
- The Respondent was not known by the name MICHELIN, had not made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services, in accordance with paragraph 8.1.1.1 of the DRS Policy, and the confusing similarity of the Domain Name was such that the Respondent could not reasonably pretend he was developing a legitimate activity through the Domain Name.
- The Respondent's assertion about building a website is inconsistent with the period of more than a year and a half during which the Domain Name continued to resolve towards the registrar's default page.
- It was implausible that the Respondent was unaware of the Complainant when registering the domain, as demonstrated by (1) the addition of "tyre" to the Complainant's MICHELIN trade marks in the Domain Name, (2) the time by which those trade marks predated the application for the Domain Name and (3) the Respondent's correspondence shows he was aware of the Complainant's MICHELIN trade marks, which he pretends to seek to promote on a website.
- It was most likely that the Respondent acquired the Domain Name because of the attractiveness of the MICHELIN trade marks and to confuse Internet users into believing that the Domain Name is registered by the Complainant and will direct them to a website relating to the Complainant's tyre services in the United Kingdom.
- The inactivity of the page to which the Domain Name resolves does not mean that it is used in good faith, relying on Nominet Decision D00001781.
- A legitimate non-commercial or fair use of the Domain Name under §8.1.1.3 of the DRS Policy cannot be inferred due to Respondent's clear intent to use it for commercial gain. The only reason the Respondent

registered the Domain Name is for the purpose of selling it to the Complainant for valuable consideration in excess of documented out-of-pocket costs directly related to the Domain Name.

- The Respondent's aggressive attitude and threats towards the Complainant, as well as his subsequent lack of response, clearly demonstrates the Respondent's bad faith.
- The fact that an email server had been configured on the Domain Name indicated that there might be a risk that the Respondent is engaged in a phishing scheme and the Respondent could intend to steal valuable information, such as credit card or other financial information, from the Complainant's clients. The sending of emails via the domain name is likely to cause the public to assume that the disputed domain name is associated with the Complainant, who would then be comfortable revealing financial information. Such use of the Domain Name for phishing purposes would be unfairly detrimental to the Complainant.
- It is not possible to conceive a plausible circumstance in which the Respondent could legitimately use the Domain Name, as it would invariably result in misleading diversion and taking unfair advantage of the Complainant's rights.

The Response

5.7. There was no Response to the Complaint from Mr Webb or the Respondent named above, and accordingly no Reply.

6. Discussion and Findings

6.1. To succeed under the DRS Policy the Complainant is required to demonstrate, on the balance of probabilities, that (1) it has Rights in respect of a name or mark which is identical or similar to the Domain Name (§2.1.1 of the DRS Policy), and (2) the Domain Name, in the hands of the Respondent, is an Abusive Registration (§2.1.2 of the DRS Policy).

Identity of the "true" Respondent

6.2. The definition of the "Respondent" to the Complaint in the DRS Policy is "*the person (including a legal person) in whose name or on whose behalf a Domain Name is registered*".

6.3. The Respondent named above is a company which provides registrant privacy services for domains. Nothing has been heard from the Respondent named above. However, given that Mr Webb responded very promptly to the initial cease and desist letter and taking into account the content of the pre-complaint correspondence, which the Complainant relies upon, it is appropriate, in all the circumstances, to treat Mr Webb as the true Respondent. As a result he will be bound by this Decision, as will the Respondent named above, which is merely the company behind which Mr Webb has concealed his identity.

Does the Complainant have relevant Rights?

- 6.4. The Complainant has longstanding registered UK trade mark rights for the mark MICHELIN, which is the first part of the Domain Name. It is used in the Domain Name with the generic term “tyres”, for which goods I find that the Complainant has demonstrated a longstanding reputation when used with the mark MICHELIN. I note that the Complainant’s reputation for the use of this mark in relation to tyres was also previously found in Nominet DRS Decision D00018479, in 2017.
- 6.5. I conclude that the Complainant has Rights in respect of the mark MICHELIN which is entirely contained in and forms the first part of the Domain Name, the remainder of which comprises the generic term, tyres. In addition, the Complainant is well known for the supply of tyres, so that the mark “MICHELIN TYRES”, which is effectively identical to the Domain Name, is a mark in which the Complainant has a substantial and longstanding reputation.

Abusive Registration?

- 6.6. An Abusive Registration means a Domain Name which either:
- 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
 - is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;
- 6.7. The DRS Policy provides a non-exhaustive list of factors which may indicate that a Domain Name is an Abusive Registration.
- 6.8. These include the registration or acquisition of a Domain Name for the purpose of selling to the Complainant or a competitor of the Complainant for valuable consideration in excess of the Respondent’s expenses (§5.1.1.1 of the DRS Policy).
- 6.9. A second factor is the use or threatened use by the Respondent of 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.
- 6.10. Another such factor is where the Domain Name is an exact match for the marks in which the Complainant has Rights, where the Complainant’s mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name (§5.1.6 of the DRS Policy).
- 6.11. In the absence of any Response, there is no substantive challenge by the Respondent to the Complaint and no positive case is put forward. However, the Complainant has the burden of proving that the Domain Name is an Abusive Registration to the requisite standard. The Complainant has included the pre-complaint correspondence as part of the Complaint, and seeks to rely upon it. Although this material is not contained in a formal Response, in these

circumstances I find that it is appropriate to take this material into account even though no formal Response was provided.

- 6.12. I accept the Complainant's argument that Mr Webb was not known by the name MICHELIN and had not made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services. The Domain Name resolves to the registrar's holding page and there is no evidence that Mr Webb has made legitimate non-commercial or fair use of the Domain Name.
- 6.13. Mr Webb asserted that he intended to set up a website to promote the Claimant's MICHELIN trade mark in his area. There is nothing in the material before me which demonstrates that this was not Mr Webb's intention in registering the Domain Name. However, there is no suggestion from Mr Webb that he sought the permission of the Complainant at any point prior to registering the domain.
- 6.14. I accept that Mr Webb was fully aware of the Complainant's trade mark before registering the Domain Name, as a result of his expressed intention to publicise the MICHELIN mark. This intention has to be viewed in the context of the tyre services he claims to provide in his garage and his recognition that permission would need to be provided by the Complainant before the website could be used.
- 6.15. I do not accept the Complainant's argument that the delay in setting up the website since the registration of the Domain Name is material. This was not a period of 18 months, as asserted by the Complainant; the Domain Name was registered on 6/2/20 and the cease and desist letter was sent on 31/3/20. In any event, this is not a long period and given that some of that period was covered by the start of the lockdown in the UK caused by the COVID19 pandemic, there may well be explanations why the website had not been set up in this much shorter period. After the correspondence had started and it became clear that consent would not be provided by the Complainant, there would be no point in Mr Webb progressing the plans for the website.
- 6.16. I note that subsequently Mr Webb did invite an offer to purchase the Domain Name and other similar domains he claimed to own from the Complainant as part of an agreement that he would not purchase any others. No specific fee was mentioned. This was made in the context of an email in which he claimed to have been bullied.
- 6.17. I find that the Complainant has not demonstrated that Mr Webb primarily registered the Domain Name to sell it for a sum in excess of the costs directly associated with acquiring or using the Domain Name or for the purpose of unfairly disrupting the business of the Complainant. This may have occurred to him subsequently, but there is no material from which I can conclude that he had this intent at the time of registration.
- 6.18. I consider the Complainant's argument that the Domain Name could be used for phishing to be speculative. There is no indication of any intention to use the Domain Name for such purposes or any evidence that it has been used for such purposes.
- 6.19. I note however, that Mr Webb did threaten to purchase similar names, if there was no "amicable solution", and did threaten to publicise the dispute and his opinions about the dispute on websites in jurisdictions which the Complainant

would be unable to prevent. The clear implication being that the commentary would be unfavourable to the Complainant to the degree that the Complainant would have a justifiable legal complaint which it could not enforce. He did not make these threats in relation to the Domain Name itself. Thereafter, it seems that Mr Webb did not engage with the Complainant in relation to the transfer of the Domain Name, so that the Complainant had to resort to the Nominet DRS process.

- 6.20. I consider that the close similarity of the Domain Name to the Complainant's trade mark MICHELIN together with the word "tyres", for which mark the Complainant has a longstanding reputation, when used in the context of the provision of services by a garage, is highly likely to give rise to confusion on the part of the public, so that the public would associate use of that Domain Name and any person using this Domain Name, in such circumstances, with the Complainant or assume that that Domain Name was authorised by or associated with the Complainant, when this was not true.
- 6.21. Although the registered trade mark relied upon is MICHELIN, the use of "michelin tyres" in the form of the Domain Name, is an exact match for the name used by the Complainant in relation to the goods for which the mark is registered, and for which the Complainant has a substantial and longstanding reputation.
- 6.22. I do not consider that the correspondence from Mr Webb contains a reasonable justification for the use of the Domain Name. Mr Webb had the opportunity to put forward his justification in a Response but did not do so.
- 6.23. I do not consider that the use of the Domain Name for the promotion of the Complainant's goods in the context of Mr Webb's garage services, put forward in correspondence, is a reasonable justification, when he was aware of the Complainant's trade marks, had not sought prior consent for such use and did not obtain consent. He did state that the use would be submitted for approval by the Claimant, which indicates that he considered that such consent would be required, but ultimately, did not submit any such proposal.
- 6.24. I also take into account that Mr Webb claims to have made multiple similar registrations, he did not seek the Complainant's permission before registering the Domain Name or these other registrations and, when challenged, resorted to threatening to publicise damaging and probably unjustified statements about the Complainant which he intended could not be prevented. Although Mr Webb did not indicate he would use the Domain Name itself for such purposes, it is apparent that he would not use the Domain Name for the originally expressed purpose at the same time as carrying out such activities aimed at damaging the Complainant.
- 6.25. For these reasons, I consider that the Domain Name is an Abusive Registration.

7. Decision

- 7.1. Accordingly, I find that the Complainant has Rights in respect of marks which are identical or similar to the Domain Name and that the Domain Name in the

hands of the Respondent named above and/or under the control of Mr Webb is an Abusive Registration.

7.2. I direct that the Domain Name be transferred to the Complainant.

Signed Jacqueline Reid Dated 08/10/2020