

DISPUTE RESOLUTION SERVICE

D00023052

Decision of Independent Expert

Compagnie Générale des Etablissements Michelin

and

Nadine Elghool

1. The Parties:

Complainant: Compagnie Générale des Etablissements Michelin
23 Place des Carmes-Déchaux
Clermont-Ferrand
63000
France

Respondent: Nadine Elghool
London
United Kingdom

2. The Domain Names:

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

01 October 2020 16:40	Dispute received
02 October 2020 11:35	Complaint validated
02 October 2020 11:42	Notification of complaint sent to parties

12 October 2020 16:53	Response received
12 October 2020 16:53	Notification of response sent to parties
15 October 2020 02:30	Reply reminder sent
20 October 2020 10:43	No reply received
20 October 2020 10:59	Mediator appointed
20 October 2020 15:39	Mediation started
06 November 2020 15:30	Mediation failed
06 November 2020 15:32	Close of mediation documents sent
18 November 2020 01:30	Complainant full fee reminder sent
19 November 2020 13:17	Expert decision payment received

4. Factual Background

The following summary is taken from the parties' submissions and supporting exhibits.

The Complainant is a global business that has been trading for nearly 200 years. It has traded under the MICHELIN brand for over 130 years and is well-known for using it in relation to vehicle tyres and as the name of a 'fine dining' restaurant guide and its associated 'Michelin star' awards.

The Respondent is a university law student and a commis (assistant) waitress working within the fine dining industry. She registered the Domain Names on 20 June 2020 having previously registered equivalent <.com> and <.net> domain names which she used to resolve to a website at www.michelininsider.com. The website publishes articles and provides information which, according to its front page, "*aims to discuss and educate upon matters within the fine dining industry*".

The Respondent had intended, and if allowed to keep the registration of the Domain Names still does intend to have them resolve to the same website. She has not yet been able to do that as her control over them was temporarily frozen by the effect of this DRS complaint. However, prior to that happening, the Domain Names had each resolved to a parking page which included advertisements relating to vehicle tyres, one featuring advertisements for tyres manufactured by the Complainant and also by its competitors, the other featuring advertisements for tyres manufactured by the Complainant's competitors but not those of the Complainant itself.

5. Parties' Contentions

The Complaint

In summary, in the Complaint, which was supported by various exhibits, the Complainant made the following submissions:

- The Complainant owns several registered trade marks for MICHELIN that are protected worldwide, covering a wide range of goods and services, in particular in relation to tyres and the automobile industry.
- The Complainant operates, among others, the following domain names reflecting its trade mark in order to promote its services:

- <michelin.com> registered on December 1, 1993; and
- <michelin.uk> registered on July 9, 2014;
- The domain name <michelin.com> had been registered more than 20 years before the Domain Names were registered, and the domain name <michelin.uk> had been registered more than 6 years before.
- The Complainant has sales agencies in 171 countries, 117,400 employees, a 14 percent share of the global tyre market and 5,000 tyre distribution and service centres. In 2019, the Reputation Institute, which ranks the world's brands according to their reputation, ranked MICHELIN as the top brand in France and 8th in the world.
- The Complainant also carries out part of its activities in the field of food and tourism guides. The first UK Michelin guide was published in 1911 and contained practical driving information to help motorists on their travels. The current 'Great Britain and Ireland' Michelin Guide is no longer a drivers' handbook but has, since 1974, solely been a restaurant and hotel guide.
- MICHELIN is very well-known in the field of automobile and tyre manufacturing industries and has been considered to be "well-known" by previous panels (NOMINET Case No. D00009108, *Compagnie Générale des Etablissements Michelin v. Mr Neil Harvey*, NOMINET Case No. D00018479, *Compagnie Générale des Etablissements Michelin v. James Powell*). Further, the Michelin Guide relating to restaurants is also very well-known as it is published in a lot of countries, including The United Kingdom.
- The Domain Names reproduce the Complainant's trade mark MICHELIN in its entirety associated with prefix "the" and generic term "insider", which does not prevent any likelihood of confusion. Previous DRS Panels have already considered that the addition of a generic term to a widely known trade mark does not prevent the likelihood of confusion (NOMINET Case n° D00012322, *Pertemps Limited v. Quick Pertemps*, NOMINET Case n° D00010778, *Cosmetic Research Group v. Brainfilled Solutions LLC*).
- Moreover, the full inclusion of the Complainant's trade mark in combination with these generic terms enhances the false impression that the Domain Names are somehow officially related to the Complainant while they are not. Indeed, the Domain Names are likely to confuse Internet users into believing that they will direct them to a website dedicated to the Complainant's services and 'behind the scenes' of the Complainant's business.
- The Respondent's other domain name <michelininsider.com> resolved to a webpage entitled "Michelin Insider" which aims, as stated therein, "*to discuss and educate on issues relating to gastronomy, with emphasis on starred establishments or those deserving of a Michelin star*".
- The country code top-level domain (ccTLD) <.uk> is insufficient to distinguish the Domain Names from the Complainant's trade marks, which are the most prominent part of the Domain Names, as the <.uk> indication is not distinctive. The extension simply denotes the country code and therefore is just descriptive.
- The ccTLD ".co.uk" is a common extension in the United Kingdom. By adding this extension, the Domain Names could easily be mistaken for the Complainant's domain name used for its UK operations. As evidenced by its trade mark registrations, the MICHELIN trade mark has been protected in the UK since 1986, many years before the registration of the Domain Names. The Complainant has also been in business for more than a century and is now world-renowned. The public has learnt to perceive the services

offered under this trade mark as being those of the Complainant and would reasonably assume that the Domain Names are owned by, or affiliated with, the Complainant.

- The Respondent is neither affiliated with the Complainant in any way nor has she been authorized by the Complainant to use and register its trade marks, or to seek registration of any domain name incorporating its trade marks.
- The Respondent cannot claim prior rights or a legitimate interest in such domain names as the MICHELIN trade marks precede the registration of the Domain Names by many years.
- The Respondent is not commonly known by the Domain Names or by the name "MICHELIN".
- The Respondent cannot assert that, before having any notice of this dispute, she was using, or had made demonstrable preparations to use the Domain Names in connection with a genuine offering of goods or services, in accordance with paragraph 8.1.1.1 of the DRS Policy. The Domain Name <themichelininsider.co.uk> directs towards a webpage displaying commercial links related to the Complainant's automotive products and services, while the Domain Name <michelininsider.co.uk> directs towards an inactive page. The Domain Names are so confusingly similar to the Complainant's MICHELIN trade marks and its activities that the Respondent cannot reasonably pretend she was developing a legitimate activity through the Domain Names.
- It is inconceivable that the Respondent was unaware of the Complainant when she registered the Domain Names (as well as the other similar . <.com> and <.net> domain names for which an UDRP procedure has been initiated by the Complainant) and must have had the Complainant's trade marks in mind at the time of registration. It is most likely that the Respondent acquired the Domain Names because of the attractiveness of the MICHELIN trade marks in order to confuse Internet users into believing that they are registered by the Complainant and will direct them to a website relating to the Complainant's services in the United Kingdom.
- It is more likely than not that Respondent's primary motive in registering and using the Domain Names was to capitalize on or otherwise take advantage of the Complainant's trade mark rights, through the creation of initial interest confusion.
- Even a state of inactivity does not mean that the Domain Names are used in good faith. Previous DRS Panels have already considered that passive holding of a domain name can satisfy the requirements of an abusive registration e.g. NOMINET Case No. D00001781, Amazon.com Inc. v Microplace Ltd. (t/a Netknowledge) where it was said *"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"*
- The Respondent also registered the domain names <michelininsider.com>, <themichelininsider.com>, <michelininsider.net> and <themichelininsider.net> which clearly demonstrate that the Respondent was aware of the Complainant when registering the Domain Names.

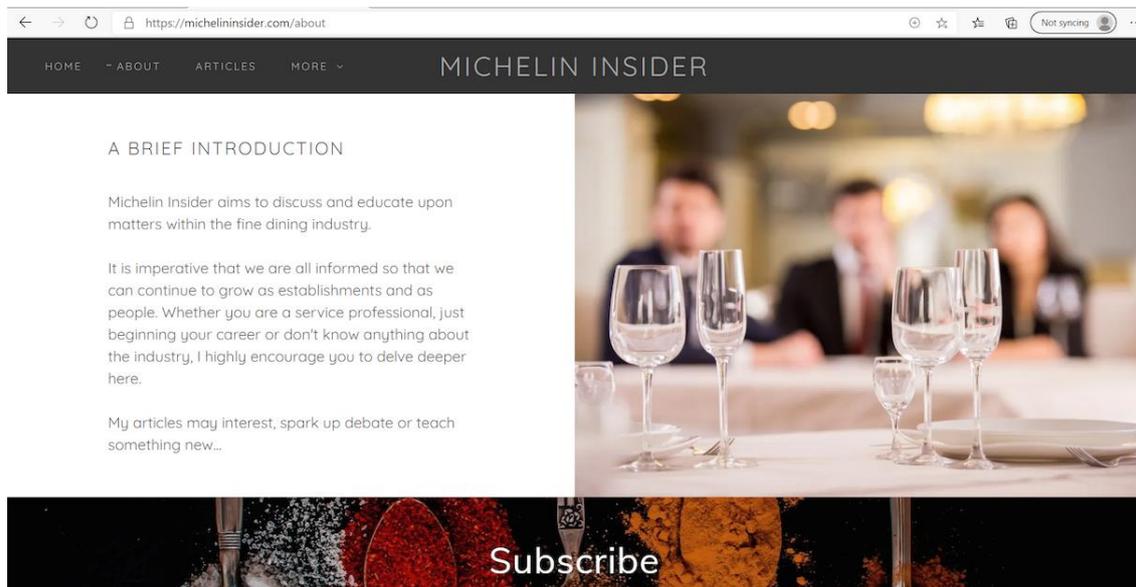
- A legitimate non-commercial or fair use of the Domain Names as per paragraph 8.1.1.3 of the DRS Policy cannot be inferred due to the Respondent's clear intention for commercial gain.
- E-mail servers have been configured on the Domain Names and there might be a risk that the Respondent is engaged in a phishing scheme. The use of an email address with the Domain Names presents a significant risk as the Respondent could aim to steal valuable information, such as credit cards or any financial information, from the Complainant's clients. Indeed, if the Respondent sends emails via the Domain Names, the public are likely to make an assumption based on the Domain Names' similarity to the Complainant's MICHELIN trade marks that the Domain Names are associated with the Complainant and would then be comfortable revealing financial information. Such use of the Domain Names for phishing purposes could cause unfair detriment.

The Response

In summary, in the Response, which was supported by various exhibits, the Respondent made the following submissions:

- The Respondent is a commis waitress and a university law student and has legitimate rights and interests in the Domain Names, which have been explained to the Complainant's representative in correspondence. The Respondent hasn't done anything wrong or illegal.
- The Respondent is not trying to attract users to her website through the "likelihood of confusion". The Respondent asked the Complainant's representative in correspondence if they could send proof of their allegations, which they did not.
- The allegations made by the Complainant about use of the Domain Names to resolve to parking pages are false as such use is not abusive. This was confirmed by NameCheap (a domain name registrar) to the Complainant's representative in email correspondence relating to the Respondent's other domain names, <themichelininsider.com> and <themichelininsider.net>
- Both the Domain Names were bought by the Respondent with the intention of redirecting them to the Respondent's website at www.michelininsider.com. However, before this could be done, the Domain Names were locked due to these DRS proceedings. The Respondent therefore has a legitimate interest and right in the Domain Names.
- Both GoDaddy and NameCheap control the parking pages for the Domain Names. The Respondent has no control over this and does not receive traffic or make money from it. Since the Domain Names are locked, there is no way for the Respondent to change this or redirect them to www.michelininsider.com.
- The Complainant's representative has knowingly presented false information and falsely accused the Respondent of criminal activity, which is itself a crime and proves bad faith and malpractice on their part.
- The Respondent did not refuse to proceed with the transfer of the Domain Names, but merely explained in the correspondence with the Complainant's representative what the Respondent felt were her legitimate rights and interests with regards to the Domain Names and stated that if the Complainant's representative could explain precisely how the Respondent was infringing the Complainant's rights rather than merely ordering the Respondent to give them up, then the Respondent would definitely consider it.

- The Complainant states that the Respondent’s website at www.michelininsider.com aims "to discuss and educate on issues relating to gastronomy, with emphasis on starred establishments or those deserving of a Michelin star", which is false. The Respondent’s website content is shown below, which is quite different. It does not refer to Michelin starred restaurants but discusses employee management relations, communication, and how employees can improve.



- The Complainant said in correspondence that when they type the word ‘Michelin’ in search engines, the Complainant’s websites come up. Thus, no “likelihood of confusion” can occur if the Respondent’s website is not even being displayed within the results. Such a Google search merely shows that the Complainant has done a good job of optimising the search engine results for their brand, in fact, so much so that a simple search on ‘Google’ or any other search engine of the word ‘Michelin’ will not bring up any of the Respondent’s domains, thereby indicating that not only is the Respondent not infringing on the Complainant’s business, she does not present any threat by way of misleading consumers.
- There is no likelihood of confusion due to the site’s description, contents and use of the words “the” and “insider” as part of the name. This determines that the Domain Names are being used for the purposes of information and not for business. Nothing is being sold on the website at all, and the contents of the domains do not at all claim that *MICHELIN TYRES* or *THE MICHELIN GUIDE* has any part in the operation of the website or that the Domain Names are directly run by *MICHELIN TYRES* or *THE MICHELIN GUIDE*, thereby not infringing on the Complainant’s trade mark.
- The Respondent’s website is not creating the perception that it is associated with, licensed, or endorsed by the Complainant. It is clear what the website is about upon viewing it. Therefore, any “likelihood of confusion” is at the discretion of each visitor. If any visitors wrongfully assume that the website or any domain names resolving to it are associated with the *MICHELIN TYRES* or *THE MICHELIN GUIDE* trade mark, the Respondent cannot be held responsible as a result of poor judgement and a lack of information due to the visitor possibly misreading the Domain Names or not reading the contents of the website altogether.

- The Complainant and its representative have no genuine interest in many of the domain name cases they have brought and appear to be filing these many domain name disputes in bad faith. An example is where the Complainant's representative in this case also represented the Complainant in a dispute regarding <michelinma.com> (UDRP Case No. D2013-1418). However, the <michelinma.com> domain name is now available for purchase which indicates bad faith and a waste of both WIPO's and the panellist's time. If the Complainant had a legitimate interest in this domain name, they would have kept it.
- The availability of the <michelinma.com> domain name for sale means somebody else could buy it and another domain dispute case could ensue as a result. This perhaps is the Complainant's representative's way of creating more work for their firm in order to continue charging the Complainant, as they have dealt with many domain dispute cases for the Complainant.
- There are numerous other domain names available for purchase with the word "Michelin" included within it, thus indicating the Complainant's lack of interest in these domains, indicating its bad faith.
- The Respondent does not claim to be the Complainant or be affiliated with the Complainant. "Michelin" is a common name and nowhere in the law does it state that the Respondent must be named by a certain name in order to be able to use it within a domain name. Using a different name in a domain such as <daisyinsider.com> does not indicate identity theft as the Complainant is claiming. Not only is "Daisy" the name of a flower, it is also a name as well and included within the names of many companies and websites. Nobody can claim a monopoly over a name.
- Ownership of a trade mark is not absolute, for instance when the "mark" is used for informational or editorial purposes, and the Respondent's website is informational. The Respondent's articles and website are clearly unrelated to the Complainant's brands.
- The Apple company owns the <apple.com> domain name but there is a website at www.appleinsider.com which has been writing about 'Apple' products and 'Apple news' since 1998, 11 years after the <apple.com> domain name was registered. Apple is not only arguably more famous than the Complainant's brand, they also have a higher net-worth. Therefore, if a bigger brand such as 'Apple' does not see a website that directly speaks about them and their products as creating enough of a "likelihood of confusion" or "infringement on their brand/trademark/rights", the Respondent fails to understand where the Complainant sees a "likelihood of confusion" or "infringement on their brand/trademark/rights" when the Respondent's website is completely unrelated to their brand.
- Many well-known and famous brands cannot hold a monopoly on a particular word that is not original, e.g. 'Sky', 'Michelin' and 'Apple'. Only sites with original/made up names such as <google.com> and <expedia.com> may have a point in bringing such an argument.
- Many celebrities attempted to trade mark their name but were rejected due to other people having the same name. "McDonalds" lost their case against "McCurry" as "federal courts ruled that no person would confuse the two". Further, <sky.com> sued <skykick.com> for trade mark infringement but lost, and <skykick.com> continues to operate.
- The public will not confuse the Respondent's website with the Complainant's brands. The above cases were denied on the grounds that the words/names are public domain

and would not be confused with the name they attempted to gain an unfair monopoly over. This surely should apply to a common name, such as in this case the Italian name 'Michelin', which has many name variations such as Michele, DeMicheli, Megali, Micalini. Additionally, the origin of the name 'Michelin' is believed to come from either the name Michele or Michael.

- The Respondent is in no way tarnishing the Complainant's reputation and has not offered to sell the Domain Names to the Complainant, or any other entity and the Respondent has not designed links to target the Complainant or mislead their consumers, nor are there any plans to do so.
- The Respondent is not commercially gaining from the Complainant's brand as she is not selling tyres or reviewing restaurants and does not intend to do so. The Respondent is offering a bona fide service i.e. articles relating to the topics listed above. The Respondent is not profiting off her website as it is merely informational. The Respondent works within the fine dining industry and has received qualifications relating to the field, thus supporting a genuine interest with regard to the Domain Names.
- The Domain Names were not registered or acquired primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the out-of-pocket costs directly related to the Domain Names. There is no intention of selling, renting or transferring the Domain Names to anyone. They are being used for a specific purpose i.e. to write articles, educate people and share views on various topics. The articles have nothing to do with the Complainant's brand, so the website cannot be tarnishing/negatively affecting the brand.
- The Domain Names were not registered to prevent the Complainant from reflecting their trade mark in a corresponding domain name and the Respondent has not engaged in a pattern of such conduct.
- The Complainant and the Respondent are not competitors and the Domain Names were not registered primarily to disrupt the Complainant's business.
- The Domain Names were not registered in an intentional attempt to attract, for commercial gain, internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or other location or of any product or service on the website or other location. The website is completely different with regards to its contents and its purpose to that of the Complainant's.
- The Respondent believes that the Complainant's representative is attempting to tarnish the Respondent's image with this DRS Complaint by falsely claiming that the Respondent is "opportunistic", "free riding", acting in "bad faith" and engaging in criminal behaviour, i.e. "phishing", "identity theft" and profiting off "parking pages" to "abusively benefit" from the Complainant's reputation. The Complainant's representative continues to mention "prior panels" rather than refute all of the Respondent's points, thus indicating an attempt to harass the Respondent and tarnish her reputation. This seems to be an attempt to sway the panellist in the Complainant's favour.
- Moreover, the Complainant's representative has also attached the Respondent's LinkedIn page within the previous WIPO UDRP case relating to the <themichelininsider.com> and <themichelininsider.net> domain names without a strong reason, which included a photograph of the Respondent. Although the

Respondent says she cannot be certain, as the Respondent is 'Black British', she suggests that perhaps the WIPO complaint was racially motivated in some way. The lack of evidence provided to support the allegation of the Respondent being involved in criminal activity, paired with the lack of relevance of using the Respondent's picture in that case, strongly suggests that the Complainant's case is put forward by its representative on a discriminatory basis. Thus, the Respondent would like further investigation to be carried out and to know how she can proceed with an official case against the Complainant's representative with WIPO as well as any other relevant bodies and authorities.

- The Complainant's statement that the Respondent is "*entirely reproducing the Complainant's trademark*", is false. The Respondent has proved that she is not infringing the Complainant's trade mark.
- The Domain Names and other similar <.com> and <.net> domain names owned by the Respondent do not at all point to a website presenting a "behind the scenes" look at Michelin-starred restaurants.
- The Complainant has made wrongful allegations of criminal activity by the Respondent that e-mail servers have been configured on the Domain Names and there might be a risk that the Respondent is engaged in a phishing scheme and that the use of an email address incorporating the Domain Names presents a significant risk the Respondent could steal valuable information, such as credit cards or any financial information, from the Complainant's clients. By doing this the Complainant's representative is intentionally stating mistruths to paint the Respondent in a negative light, which shows malpractice and underhandedness on the part of the Complainant's representative.

The Reply

The Complainant chose not to file a Reply.

6. Discussions and Findings

In order to succeed, the Complainant must prove, on the balance of probabilities, two matters, namely that:

1. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Names; and
2. the Domain Names, in the hands of the Respondent, are Abusive Registrations.

These terms are defined in the Nominet DRS Policy as follows:

- **Rights** means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.
- **Abusive Registration** means 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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Where, as in this case, there is more than one Domain Name in issue, it is possible for the Complainant to succeed in relation to one Domain Name but fail in relation to the other. However, in this case, there does not appear to be any material difference between the two Domain Names themselves or their previous and intended future uses. As such, they stand or fall together.

Does the Complainant have Rights?

The Complainant's MICHELIN name and trade mark is protected by various trade mark registrations around the world. The Complainant is a long-established global business that has made very extensive use of its MICHELIN name in relation to two principal areas, being vehicle tyres and restaurant guides. The MICHELIN name is very well-known to the extent of being a household name in relation to both areas of the Complainant's business.

As such, the Complainant clearly has Rights in the MICHELIN name for the purposes of the Nominet DRS.

Are those Rights in respect of a name or mark which is identical or similar to the Domain Names?

In assessing whether a domain name is identical or similar to a name or mark, the descriptive ".co.uk" suffix can be ignored, unless perhaps the name or mark concerned itself includes a particular top-level domain suffix, which is not the case here.

Contrary to the Respondent's statement that such a claim is false, both Domain Names do in fact reproduce and incorporate the entirety of the MICHELIN name. They do so along with the suffix "insider" and one of the Domain Names also incorporates "the" as a prefix.

The addition of the word "the" as a prefix adds nothing by way of distinction to what follows. The question is therefore whether or not MICHELIN INSIDER / MICHELININSIDER is similar to MICHELIN. It clearly is.

Are the Domain Names, in the hands of the Respondent, Abusive Registrations?

The Respondent, in her Response and correspondence with the Complainant's representative, has focused on various arguments over whether or not her registration and use of the Domain Names, and other similar domain names she controls, amounts to registered trade mark infringement. In so doing, she seems to be labouring under the misapprehension that there can be no such infringement because her website is just for informational or editorial purposes. If the Respondent intends to carry on with her website, she could be well advised first to seek professional advice from an experienced trade mark lawyer. But in any event, whilst trade mark law has many overlapping principles with Nominet's DRS Policy, they are not one and the same thing. The issue to be decided in these DRS proceedings is whether or not the registration or subsequent use of these Domain Names means they are Abusive Registrations as defined in the DRS Policy.

There can be no real doubt that the Respondent was aware of the Complainant's business and well-known trade mark when she decided to register the Domain Names, with an intention of using them to resolve to a website dedicated to information and articles about the fine dining industry.

The parties have had some discussion over the addition of the word "insider" as a suffix to a well-known brand and what this might denote to Internet users. The Respondent says it infers that the website to which such a domain name resolves is being used for the purposes of providing information and not as a business. The Respondent treats those as being mutually exclusive, but many 'information only' websites are in fact also very lucrative commercial businesses. Examples range from news websites to popular blogs, which generate substantial advertising revenue as a result of their popularity.

To some, the "insider" suffix could denote a website that is dedicated to inside information, exposés and gossip about the relevant brand and the business behind it. But, as contended for by the Complainant, to others it could also indicate an 'official' website controlled or linked to the brand owner that is offering a more detailed 'behind the scenes' look at its business.

The issue has been raised because paragraph 8 of the DRS Policy sets out examples of how the Respondent might demonstrate that the Domain Names are not Abusive Registrations, and paragraph 8.2 states that "*Fair use may include sites operated solely in tribute to or in criticism of a person or business.*"

For a respondent to rely upon paragraph 8.2, the particular prefix or suffix chosen as part of the domain name has to make it very clear by itself that any website to which it resolves is going to be an independent website that is dedicated to the relevant brand and its business, whether in support of it or otherwise. A common example of each would have been <michelinsucks.co.uk> or <michelinismagnificent.co.uk>. But in my view, the addition of "insider" does not of itself make it sufficiently clear one way or the other what the associated website is likely to be.

In any event, in this case the Respondent has stressed that, in fact, her website, to which she intended the Domain Names to resolve, is not about the Complainant or its business at all, but about the fine dining industry in general. As such, she cannot rely on paragraph 8.2 of the DRS Policy regardless of what the 'insider' suffix might denote to Internet users.

In her response the Respondent has also said that, as 'Michelin' is a common Italian name rather than an entirely made up name, the Complainant cannot monopolise it and she is therefore entitled to use it in relation to the Domain Names and her website, even though it is not her own name. She says there is no law requiring her just to use her own name in relation to her domain names and website. That latter point is true, however the Complainant did not allege that there was any such law or requirement. It merely pointed out that the Respondent could not take advantage of paragraph 8.1.1.2 of the DRS Policy, being one of the examples that might show the Domain Names are not Abusive Registrations, and which states as follows:

8.1.1.2 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

As regards the Respondent's point that "Michelin" may be a common Italian name; when one party has been using such a name extensively in relation to a particular area of business and

has registered trade mark rights covering those areas, that does give them rights to object to someone else starting to use it in relation to the same or a similar field, and in some cases even dissimilar fields.

The Respondent seems to think that there can be no issue because the website to which she intends the Domain Names to resolve is not about the Complainant or its business, but the fine dining industry in general, when that must include the Complainant's competitors. But she professes not to understand why the Complainant has complained, even though the website uses the Complainant's name and is about the fine dining industry, the very *raison d'être* of one of the Complainant's two core business areas.

The fact that the Respondent says her intended use of the Domain Names all along was to resolve to a website that is not about the Complainant or its business raises an obvious question that the Respondent has failed to answer i.e. why did she choose to include the well-known MICHELIN name in the Domain Names at all? If she wanted a website devoted to information about the fine dining industry in general, she could have chosen <finedininginsider.co.uk> or something similar. But instead she chose to include the MICHELIN name.

The only conclusion I can reach on the evidence before me is that the Respondent's decision to incorporate the famous MICHELIN name as part of, and in particular at the beginning of the Domain Names, and as the name of her website, was to benefit from its obvious cachet in the hope that her website, to which the Domain Names would be resolving, would be more likely to appear in search engine results of searches relating to the Complainant and the fine dining industry and thereby help drive traffic to her website and make it more popular. In my view, registering the Domain Names for that purpose took unfair advantage of and was unfairly detrimental to the Complainant's Rights.

The Respondent points to the existence of a website at www.appleinsider.com as support for her case and, in particular, that Apple Inc have not stopped it. But no evidence has been put forward as to whether or not Apple Inc has in fact some association with that website or what arrangement, if any, there may be between it and the website's owner. But in any event, one obvious difference is that the website is solely dedicated to information about Apple Inc and its products. The Respondent's website is not solely dedicated to the Complainant and its products. If the www.appleinsider.com website is totally independent of Apple Inc, it may well be that Apple Inc would take a different view of it if the content of the website was about the computing industry in general, including all of its competitors and their products.

The Respondent has also pointed in support of her case to two other well-known businesses who she says took unsuccessful trade mark infringement action against third parties, being McDonalds, who lost their case against "McCurry" as the court ruled that no person would confuse the two, and Sky who took action against <skykick.com> for trade mark infringement but lost.

Each case is decided on its own particular circumstances, but the McDonalds v McCurry case is of no assistance to the Respondent as it is totally different in scope. The only part of the McDonalds name that was replicated by the defendant in that case was the "Mc" part. There would likely have been a different result if the defendant had called its restaurant business 'McDonaldsCurry'. If the Respondent in this case had registered <mi-insider.co.uk> or <mi-insider.com> to resolve to a website called MI INSIDER, which was dedicated to information and articles about the fine dining industry, this DRS complaint and the preceding UDRP

complaints would likely never have been made by the Complainant. But she did not. The Respondent has not just taken and used the first two letters of the Complainant's well-known name, she has taken and used all of it.

The Respondent's reliance upon the Sky v SkyKick case is also misconceived. Contrary to her statement, Sky did not lose the case. Whilst some of its trade mark specification was trimmed down as having been applied for in bad faith, the court found a likelihood of confusion in relation to the remaining core specification and accordingly that SkyKick infringed the SKY trade mark. In July this year, both parties were then given leave to appeal that decision.

Paragraph 5 of the DRS Policy sets out examples which may be evidence that the Domain Names are Abusive Registrations. Paragraph 5.1.2 states:

"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;"

The Complainant raised the issue of 'initial interest confusion' in the Complaint i.e. where someone visits a website believing or assuming it is connected to a complainant because of the similarity of the name. Even though it may immediately be apparent that there is in fact no connection because of the content of the website, the person has been deceived into visiting it because of the use of the name, and then might be faced with a website offering competing goods and services to those of the complainant.

As discussed above, a proportion of Internet users could well see the addition of the "insider" suffix to the MICHELIN name in the Domain Names as an indication that the website to which they resolve will be an 'official' website controlled or linked to the brand owner and which might be offering a more detailed 'behind the scenes' look at its business.

The Respondent says that any likelihood of confusion is at the discretion of each visitor and if any visitors do wrongfully assume that her website or any domain names resolving to it are associated with the MICHELIN TYRES or THE MICHELIN GUIDE brand names, the Respondent cannot be held responsible if this results from poor judgement and a lack of information due to the visitor possibly misreading the Domain Names or not reading the contents of the website. She is wrong about that. She chose the Domain Names and the name for her website and if the names inevitably lead to a risk that a substantial number of Internet users will be so confused, even if the vast majority are not, she is ultimately responsible for having created that risk of confusion.

The DRS Experts' Overview is published on the Nominet website to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet's panel of independent adjudicators, have dealt with those issues to date and identifying any areas where Experts' views differ. I have set out below what it says in section 3.3 of the DRS Experts' Overview relating to paragraph 5.1.2 of the DRS Policy and the application of the concept of 'initial interest confusion':

"Paragraph 5.1.2 concerns confusing use of the domain name. What is meant by confusing use?"

The 'confusion' referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the

site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”?

In the case of BT v One In A Million [1999] 1 WLR 903, the Court of Appeal cited, as one example of how confusion of this kind could occur, the making of a Whois search of the registry/registrar database. The enquirer conducts such a search and because of the similarity of the domain name to the well-known trade mark (the case was concerned solely with well-known trade marks), assumes that the registrant is in some way associated with the trade mark owner. Whether or not this is still (if it ever was) a likely scenario, the English Courts have clearly held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name. The prevailing approach under the DRS is consistent with this.

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant’s web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

In the High Court decision Och-Ziff Management Europe Ltd v Och Capital LLP [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being “a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant’s conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase”. In that case the court held that initial interest confusion is legally actionable under European trade mark legislation.

In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant’s trade mark to sell in addition to the Complainant’s goods, goods competing with the Complainant’s goods.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant’s name or mark, the less likely a finding of Abusive Registration.

Subsequent to the Och-Ziff case (supra) the Court of Appeal in Interflora v Marks and Spencer [2014] EWCA Civ 1403 criticised the use of “initial interest confusion” as a concept relevant to English trade mark law. This case was discussed by the Appeal Panel in DRS 15788 (starwars.co.uk) who concluded that initial interest confusion remained an applicable principle in determining whether or not a domain name registration was abusive.

Another potential for confusion (frequently overlooked) is the use of a domain name for the purposes of email. There are many examples of registrants of domain names receiving email traffic intended for the Complainant. See for example Global Projects Management Ltd v Citigroup Inc. (citigroup.co.uk) [2005] EWHC 2663 Ch., and DRS 00114 (penquin.co.uk). Whether evidence of this occurring will lead to a finding of Abusive Registration will, of course, depend to a large extent on the nature of the domain name and the circumstances of its use. If, at the third level, it is a name which is lawfully in use by a number of people (e.g. a surname), the resultant confusion may just be a hazard which the Complainant will have to accept.”

The Experts’ Overview says that, where the names are identical and cannot sensibly refer to anyone other than the Complainant, there is bound to be a severe risk that a search engine will return the URL for the website connected to the relevant domain name. The Overview does not say that such a situation is the only time there will be a severe risk of initial interest confusion, just that such a risk is bound to happen in that situation. Clearly, there can be situations where the names are merely very similar and there will still be a real risk that when an Internet user searches for the Complainant’s name, the search engine will also return the URL for the website connected to the domain name and that may lead a substantial proportion of such Internet users to become victims of initial interest confusion. That is particularly so as search engines like Google are programmed to pick up common variations to the term being searched and website addresses that comprise the term being searched along with additional descriptive words. In this case, the Domain Names are not identical to the Complainant’s name and mark, but are very similar, merely having the descriptive word “insider” added to the well-known MICHELIN name.

The risk of initial interest confusion is therefore a real one. However, the Respondent points out that her website at www.michelininsider.com is not actually selling any goods or services but merely publishing articles and providing information which do not in any way tarnish the Complainant’s brand, so no harm is being done. Even if that was something the Respondent could rely upon and the Respondent intended for the Domain Names to resolve to that website, that does not take account of the use to which the Domain Names have already actually been put.

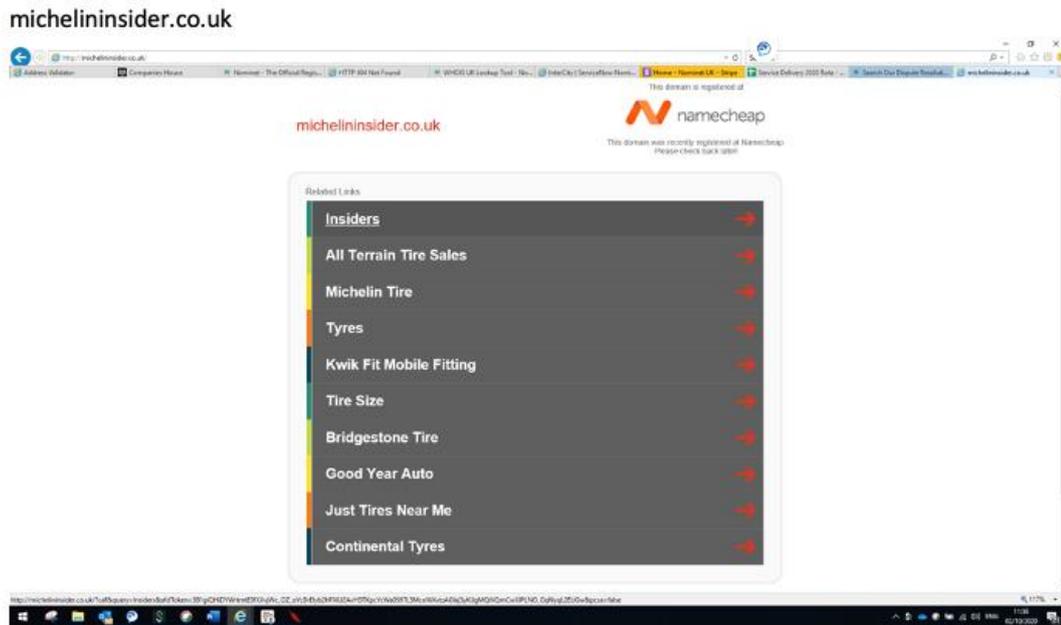
The Complainant said that the Domain Name <themichelininsider.co.uk> directed towards a webpage displaying commercial links related to the Complainant’s automotive products and services, while the Domain Name <michelininsider.co.uk> directed towards an inactive page. The Respondent said that GoDaddy and NameCheap control the parking pages for the Domain Names and she has no control over them, does not receive traffic or make money from them and, since the Domain Names are locked as a result of this DRS complaint, there is no way for the Respondent to change this or redirect them to her own website.

When a DRS complaint is filed, it is Nominet’s practice to take a screen shot of the landing page of any website to which the domain name resolves before locking it and preventing any further use of it pending the outcome of the case. The screen shots of the website parking page to which the Domain Names resolved are shown below.

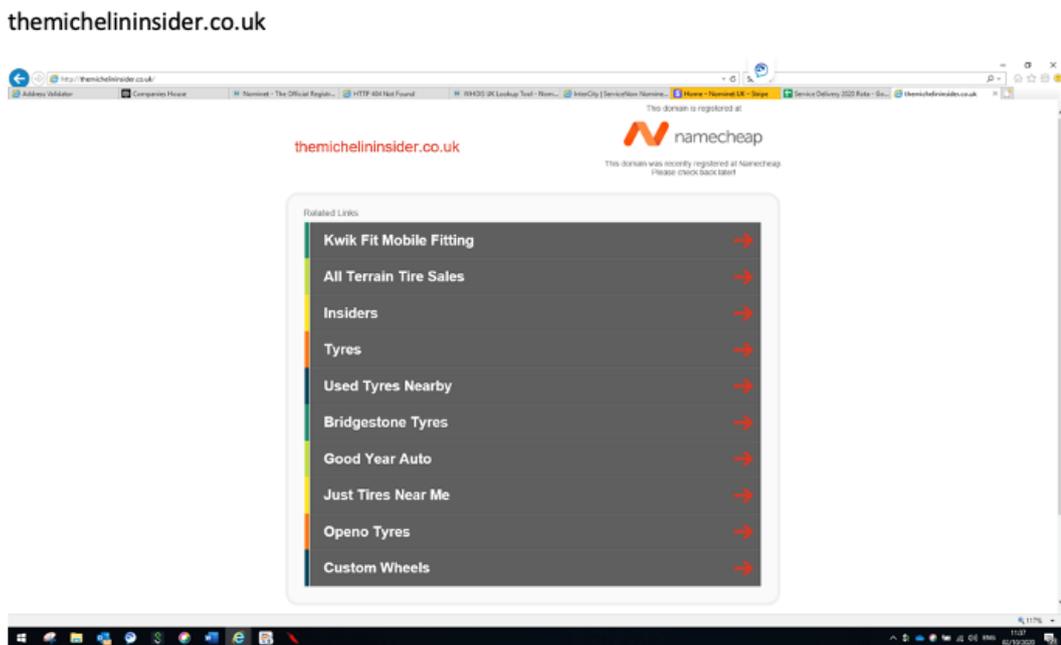
It can be seen that on 2 October 2020 the <michelininsider.co.uk> Domain Name resolved to a parking page displaying advertising links to amongst, other things, ‘Michelin Tire’ (sic) and

also 'Bridgestone Tire' (sic), 'Good Year [sic] Auto' and 'Continental Tyres'. Bridgestone, Goodyear and Continental are three major competitors of the Complainant's vehicle tyre business.

The Domain Name <themichelininsider.co.uk> resolved to a very similar parking page displaying links to, amongst other things, 'Bridgestone Tyres' and 'Good Year [sic] Auto', but not to the Complainant's own tyre business.



Screen shot taken on 02/10/2020 at 11:36



Screen shot taken 02/10/2020 at 11:37

As paragraph 8.5 of the DRS Policy makes clear, connecting a domain name to a parking page and earning 'click-through' revenue from it via links to other websites is not in itself objectionable. But it goes on to confirm that:

“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”

This makes it clear that even if the Respondent has chosen to cede day to day control of the use of the Domain Names to a third party such as Namecheap, she cannot simply wash her hands of any responsibility for what is then done with them, as they still remain her Domain Names.

If an Internet user looking for one of the Complainant’s websites arrived by mistake at the parking page websites to which the Domain Names resolved, the user had then been offered links to websites providing directly competing services. That is a classic 'bait and switch' situation. In my view, such use of the Domain Names took unfair advantage of and was unfairly detrimental to the Complainant's Rights in its MICHELIN name. The Respondent, as registrant of the Domain Names, is ultimately responsible for that use.

I would like to deal with one final point. In the Complaint, the Complainant said there was a 'significant risk' that emails linked to the Domain Names could be used by the Respondent for phishing purposes to steal credit cards or other financial information from the Complainant’s clients. The Respondent took exception to that allegation, which is perhaps understandable. There appears to have been no basis for such an allegation directed at the Respondent, let alone one that there was a “significant” risk of it occurring at the hands of this particular Respondent. Having proved relevant Rights in a name that is similar to the Domain Names, the second limb that the Complainant must prove is that the Domain Names, in the hands of the Respondent, are Abusive Registrations. It is a partially subjective test directed at the particular respondent involved. There should be some material evidential basis before a complainant seeks to make a very serious allegation of potential criminal conduct by a particular respondent. I have seen none to justify it having been made in this case against the Respondent.

It has had the unfortunate effect of 'fanning the flames' of the wider dispute between the parties because, in turn, the Respondent has made an equally serious allegation directed at the Complainant’s representative that this DRS complaint may have been motivated by racial discrimination, an allegation she is seeking to take further. The Respondent seems to base that allegation on the fact that in the UDRP complaint relating to the corresponding <.com> and <.net> domain names, the Complainant exhibited a copy of her LinkedIn page which includes a photograph of the Respondent. She identifies as being 'Black British' and says there was no relevance to her LinkedIn page being exhibited and says that doing so strongly suggests a discriminatory purpose.

The LinkedIn page was not exhibited in support of this DRS Complaint but I am aware that LinkedIn pages generally will include details of a person’s educational and professional experience, including, in the case of the Respondent, her experience as a commis waitress in the fine dining industry. That would help to support a finding that the Respondent will have been aware of the Complainant when registering the relevant domain names, should that have been a potential issue in the previous UDRP case. The result of that case is published

generally and the following is taken from the published decision, where the panellist was setting out the Complainant's contentions:

"In addition, the Respondent's LinkedIn page indicates that she is currently employed at a Michelin starred restaurant and the Respondent's registration of the Second Disputed Domain Names occurred after the Respondent received a cease and desist letter from the Complainant. The Respondent's reproduction of the Trade Mark in the Disputed Domain Names, and its association with the terms "insider" and "the" provides further confirmation that the Respondent was aware of the Complainant and its Trade Mark."

Because of the very serious nature of the allegation made by the Respondent, I would like to make it clear that I have seen no evidence whatsoever to suggest in any way that the Complainant's complaint in this DRS case was motivated by anything other than a reasonable and proper desire to prevent the use of domain names that it considered infringed its Rights and amounted to Abusive Registrations.

7. Decision

For the reasons outlined above, I find that the Complainant has proved, on the balance of probabilities, that it has Rights in respect of a name or mark which is identical or similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are Abusive Registrations.

In the circumstances I order that the Domain Names be transferred to the Complainant.

Signed

Dated 10 December 2020

Chris Tulley