

DISPUTE RESOLUTION SERVICE

D00009108

Decision of Independent Expert

Compagnie Générale des Etablissements Michelin

and

Mr Neil Harvey

1. The Parties:

Lead Complainant: Compagnie Générale des Etablissements Michelin
12 Cours Sablon
Clermont-Ferrand
63000
France

Respondent: Mr Neil Harvey
Unit 8, Drake Building
Tamar Science Park
Plymouth
Devon
PL6 8BX
United Kingdom

2. The Domain Name(s):

michelinstar.co.uk

3. Procedural History:

A copy of the Complaint was lodged with Nominet on 27 September 2010. Nominet validated the Complaint and notified the Respondent. A Response was submitted in time on 19 October 2010. No Reply was lodged. The dispute not having been resolved in mediation, the Complainant paid Nominet the appropriate fee for a decision of an expert pursuant to paragraph 7 of the Nominet Dispute Resolution Policy (the Policy).

Sallie Spilsbury, the undersigned expert (the Expert) has confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as Expert in this dispute and further confirmed that she knew of no matters which ought to be drawn to the attention of the Parties which might appear to call into question her independence and impartiality.

There are no outstanding procedural issues in this matter.

4. Factual Background

The Complainant has an established reputation in the field of tyre manufacturing for cars, trucks, motorcycles and planes. It is also well known for publishing road maps, restaurant, hotel and travel guides. One of these guides is *The Michelin Guide* which covers hotels and restaurants around the world. *The Michelin Guide* adopts the Michelin star rating system for assessing hotels and restaurants which was first used in 1926. The three-star rating (denoting exceptional cuisine) is awarded to the best restaurants across the world. *The Michelin Guide* is available in numerous languages. It was first published in the United Kingdom over 35 years ago in 1974 where it has become well established with editions dedicated to Great Britain and Ireland being regularly updated (the most recent edition being published in 2010). Each year the Complainant sells approximately 800,000 copies of *The Michelin Guide* across the world.

The Respondent is the sole director of Juice Media Design Limited which is described as “a growing web, graphic and mobile business”. He purchased the Domain Name on 21 March 2010 after having the idea of developing a restaurant booking system/website that would allow the public to book Michelin star rated restaurants in the United Kingdom. The Domain Name appears not to have been used for this purpose. The Complainant attaches to the Complaint a printout of the address to which the Domain Name resolved as at 19 July 2010. It shows that the Domain Name was directed to an “Apache 2 Test Page”. A search carried out by the Expert on 14 December 2010 showed the same result.

The Respondent contacted the Complainant by telephone and by a follow-up email dated 27 April 2010 with a view to working jointly with the Complainant on the restaurant booking project. In this email the Respondent agreed to suspend all promotional activity surrounding the Domain Name with a view to establishing a working relationship with the Complainant. In June 2010 the Complainant wrote to the Respondent informing him that only the Complainant and authorised third parties had the right to register and use domain names consisting of the MICHELIN mark and that the Respondent was not so authorised. A transfer of the Domain Name was requested. By reply dated 30 June 2010 the Respondent indicated that his registration of the Domain Name was not abusive and that the only settlement he would consider was “amicably buying the domain off me”.

In September 2010 the Respondent sought to revive his relationship with the Complainant via the Complainant’s marketing department. Towards the end of September he was told that the Complainant was not willing to consider the project.

5. Parties' Contentions

Rights

Complainant

The Complainant asserts that it has Rights to and a legitimate interest in the MICHELIN mark and that these predate the registration of the Domain Name. It relies on a portfolio of MICHELIN trademarks registered in more than 90 countries. It particularly cites;

(i) Community Trade Mark 004836359 for the word MICHELIN registered on 13 March 2008 and covering goods and services which include printed publications, and

(ii) UK Trade Mark 1015388 for the word MICHELIN registered on 3 August 1973 and covering goods in class 16, again including printed publications.

It relies on the worldwide use of the MICHELIN mark for over more than a century to support an assertion that its trade mark is well known.

The Complainant also relies on its length and extent of use of the MICHELIN mark to assert unregistered Rights through the goodwill that has been generated by the use of the mark.

Finally, the Complainant refers to a number of domain name registrations that it owns that feature the MICHELIN mark- including Michelin.co.uk.

The Complainant states that these Rights are in a mark that is identical or similar to the Domain Name. While there are no trade mark registrations in the MICHELIN STAR mark the Complainant asserts that it has unregistered rights in the MICHELIN STAR mark. It also classifies the word "star" as generic and states that such a generic term is insufficient to confer any independent distinctiveness to the Domain Name such as to distinguish the Domain Name from the Complainant's well known MICHELIN mark. The Complainant relies on the Nominet Dispute Resolution Service decision in Compaq Trademark BV v Balata.com LLC (DRS 02455) in support of this submission and a WIPO panel decision involving the Complainant in which it was held that "the mere adjunction of the generic term "star" is not sufficient to consider that MICHELIN has lost its distinctive and attractive character" (Compagnie Générale des Etablissements Michelin-Michelin & Cie v Mr Kristian Marjin van Wezel, WIPO case D2001-0598).

Respondent

The Respondent accepts that the Complainant has a number of trade marks that protect the MICHELIN mark and that, while there are no trade mark registrations for the MICHELIN STAR mark, "it could legally be considered a passing off issue".

Abusive Registration

Motivation in Registering the Domain Name

Complainant

The Complainant makes two submissions in relation to the registration of the Domain Name. Firstly, it points out that the Respondent had no legitimate interest in the MICHELIN mark and that it is probable that the Respondent acquired the Domain Name in order to benefit from the Complainant's goodwill and attract internet users searching for the Complainant's website. This, it submits, takes advantage of Internet users' "initial interest" confusion as well as taking unfair advantage of the Complainant's Rights.

Secondly, the acquisition of the Domain Name was abusive because it was for the purpose of financial gain, that is for sale to the Complainant for a sum in excess of the Respondent's documented out of pocket costs (contrary to clause 3(a)(i) of the Policy). This is evidenced by the Respondent's email of 30 June 2010 in which he stated that the only settlement he would consider was an offer to buy the Domain Name from him.

Respondent

The Respondent does not accept that his acquisition of the Domain Name was in bad faith. He submits that the Domain Name was acquired after having the idea of developing a restaurant booking website which he sought to develop in collaboration with the Complainant.

Use

Complainant

The Complainant submits that the Respondent is threatening to use the Domain Name in a manner which is likely to confuse customers into believing that the Domain Name is connected to the Complainant contrary to clause 3(a)(iii) of the Policy. The Complainant reviews restaurants in its *Michelin Guide* using the star rating system. The Respondent's proposed use of the Domain Name would be in connection with restaurants that have been rated by the Complainant. It is likely that Internet users will be confused into believing that the Domain Name has a connection with the Complainant.

Respondent

The Respondent submits that he believed his idea would add value to the Complainant. He kept the Complainant in the loop at every stage and agreed that he would not engage in promotional activity or start developing his restaurant booking website without the Complainant's permission. In the Response he states that, "this I feel concludes the fact that I should keep the rights to the domain name as on the balance of probability I haven't been abusive in registering the

domain and only intended to work with the complainant to develop an added value website which won't devalue their registered trade mark."

The Respondent also points out that there are a number of online restaurant booking websites which include and promote Michelin star restaurants. Although these do not use the domain name "Michelin" they do use the mark to instigate restaurant bookings.

6. Discussions and Findings

Under clause 2 of the Policy a Complainant must establish on the balance of probabilities that:

- i) The Complainant 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.

Considering each of these requirements in turn:

Rights

Rights are defined in clause 1 of the Policy as including, but not limited to, "rights enforceable by the Complainant whether under English law or otherwise".

Registered Rights

The Complainant has established that it has registered trade mark rights in the UK and elsewhere in the MICHELIN mark. The mark is clearly not identical to the michelinstar domain name because of the addition of the word "star". The question therefore arises whether the registered trade marks in the MICHELIN brand confer Rights in a mark which is similar to the Domain Name for the purposes of the Policy?

The Expert finds that they do confer such Rights. She agrees with the Complainant's submissions that the addition of the word "star" to the well known MICHELIN mark does nothing to detract from the distinctiveness of the Complainant's MICHELIN mark. The Complainant's trade mark registrations therefore provide a bona fide basis for the Complaint.

Unregistered Rights

In addition to its registered Rights the Expert finds that the Complainant has unregistered Rights in both the MICHELIN and the MICHELIN STAR marks. Unregistered Rights protect the Complainant's goodwill arising from the length of and extent of use of the marks by the Complainant in the United Kingdom. The Complainant has used the MICHELIN STAR rating system in the UK since at least 1974 (i.e. for over 35 years) in connection with its *Michelin Guide*. This length of

use and the success of the guidebooks establish that the MICHELIN STAR rating system has acquired a significance that is associated with the Complainant and/or products. It should therefore be noted that, unlike the trade mark registrations, the unregistered Rights provide protection for a mark that is identical to the Domain Name (it being customary to disregard the .co.uk suffix).

The Complainant also relies on its domain name registrations featuring the MICHELIN mark. This submission is rejected. Domain name registrations do not in themselves confer Rights under the Policy because they do not involve any confirmation of ownership of the underlying marks.

In summary, the Complainant has established that it has Rights in a mark that is identical or similar to the Domain Name. The trade mark registrations confer Rights in a mark that is similar to the Domain Name. The unregistered Rights extend further to a mark that is identical to the Domain Name. The first element of the Policy has accordingly been satisfied.

Abusive Registration

Abusive Registration is defined in clause 1 of the Policy as follows:

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 or was unfairly detrimental to the Complainant's Rights.

The Complainant seeks to establish that the Domain Name is an Abusive Registration on both of these grounds.

Clause 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Of relevance to this matter are the following factors:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. 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;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant;

- ii. 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 by or authorised by, or otherwise connected with the Complainant.

Registration of the Domain Name

The Complainant asserts that the Respondent registered the Domain Name primarily for sale at a profit or alternatively it implies that it did so in order to disrupt the Complainant's business. The Expert finds that the Complainant has not established either of these matters on the balance of probabilities.

The allegation of sale for a profit is based on a reference in an email from the Respondent to the Complainant dated 30 June 2010 in which the Respondent raised the possibility of amicably resolving what amounted to an impasse between the parties by a sale of the Domain Name. No figure for the transfer was put forward by the Respondent nor was the Complainant explicitly invited to make an offer. In subsequent correspondence in September 2010 the Respondent did not repeat the offer to transfer the Domain Name. His major concern seeming to be to establish a business relationship with the Complainant. It follows that the 30 June email falls far short of evidence that the Respondent's dominant motive in securing the Domain Name was to sell it for a profit.

There is also no evidence to suggest that the Respondent wished to cause disruption to the Complainant's business by acquiring the Domain Name. The Complainant asserts that he had no legitimate interest in the MICHELIN STAR name. This may be so, but the Respondent has explained to the satisfaction of the Expert that he wished to work with the Complainant to add value to the Complaint's business. His willingness to defer active use of the Domain Name at the Complainant's behest is an indication of his good faith in this regard.

It follows that the Complainant has not established that the registration of the Domain Name in itself amounted to an Abusive Registration under the Policy.

Use of the Domain Name

The Respondent has not made active use of the Domain Name in connection with a website or email address. He has also indicated in the Response that he will not do so without the Complainant's permission. There is however nothing before the Expert that indicates that this is a legally binding agreement by the Respondent. It is therefore possible that he could reactivate his project in the future without the Complainant's permission.

It should be noted that the definition of Abusive Registration in the Policy is not restricted to actual use of a domain name. It may also include threatened future use, such as the Respondent's plans for the Domain Name (clause 3(ii) of the Policy).

The question is therefore whether the Respondent's project would take unfair advantage of the Complainant's Rights or cause unfair detriment. It is the view of

the Expert that it would take unfair advantage of the goodwill and brand recognition generated by the Complainant's MICHELIN and/or its MICHELIN STAR marks. The Domain Name is similar/identical to the Complainant's household name marks. If the projected use of the Domain Name were to be instigated, a member of the public is likely to make an assumption based on the Domain Name's similarity to the Complainant's marks that the Domain Name is associated with the Complainant and/or its range of products. Depending on the content of the Respondent's website such initial confusion may well remain with the enquirer being under the impression that the Complainant endorses the restaurant booking service offered. This would take advantage of the Complainant's marks. If done without the Complainant's permission it would be an unfair advantage. If the quality of the Respondent's service were to be poor, the perceived association with the Complainant would also cause unfair detriment to the Complainant's marks. The operation of the booking service under the Domain Name could also prevent the Complainant from using its marks to expand its services into this area of business should it wish to do so in the future. Any such restriction would also be detrimental to the Complainant's Rights.

For the avoidance of doubt, the Expert disregards the Respondent's submission that other restaurant booking operators make use of the MICHELIN STAR mark as part of their service. The submission is irrelevant since, as the Respondent points out, those operators are using domain names which distinguish their business from that of the Complainant.

The Expert therefore finds that the threatened use of the Domain Name by the Respondent amounts to an Abusive Registration under the Policy. This is not to suggest bad faith on the part of the Respondent. The finding is however something of an inevitability given his choice of domain name.

7. Decision

The Expert finds that the Complainant has proved on the balance of probabilities that it owns Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration.

Accordingly the Expert finds in favour of the Complainant and directs that the Domain Name be transferred to the Complainant

Signed: Sallie Spilsbury.

Dated: 17 December 2010