

## DISPUTE RESOLUTION SERVICE

D00010458

### Decision of Independent Expert

Xerox Corporation

and

Mr Simon Day

#### 1. The Parties:

Lead Complainant: Xerox Corporation  
45 Glover Avenue  
P.O. Box 4505  
Norwalk  
Connecticut  
06856-4505  
United States

Respondent: Mr Simon Day  
4 Nutley Close  
Yateley  
Hampshire  
GU46 6JE  
United Kingdom

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

xeroxparts.co.uk

#### 3. Procedural History:

31 October 2011 22:37 Dispute received  
01 November 2011 10:38 Complaint validated  
01 November 2011 12:22 Notification of complaint sent to parties

02 November 2011 15:30 Response received  
02 November 2011 15:31 Notification of response sent to parties  
07 November 2011 01:30 Reply reminder sent  
08 November 2011 11:27 Reply received  
08 November 2011 11:28 Notification of reply sent to parties  
08 November 2011 11:29 Mediator appointed  
09 November 2011 16:28 Mediation started  
03 February 2012 12:57 Dispute resolved during mediation  
03 April 2012 13:38 Dispute opened  
03 April 2012 13:40 Mediation failed  
03 April 2012 13:51 Close of mediation documents sent  
17 April 2012 02:30 Complainant full fee reminder sent  
20 April 2012 10:14 No expert decision payment received  
20 April 2012 15:13 Expert decision payment received  
26 April 2012 the Expert was appointed  
09 May 2012 the Expert filed his declaration of impartiality and independence

#### **4. Factual Background**

The Complainant carries on a global business in document management products and services and is the owner of the XEROX trademark. The Complainant has furnished evidence of its ownership of the following UK and Community Trade Marks registrations:

UK trademark XEROX registration number 710961, registered on 29 September 1952 for goods in class 1.

UK trademark XEROX registration number 865679 registered on 16 June 1964 XEROX for goods in class 01

UK trademark XEROX registration number 2204483 registered on 30 July 1999 for goods and services in classes 02, 03, 09, 16, and 42.

CTM number 000207035 XEROX filed on 1 April 1996 and registered on 23 November 2000 for goods and services in classes 1, 2, 7, 9, 16, 35, 36, 37, and 42

CTM number 004072591 XEROX filed on October 13, 2004 and registered on 16 November 2005 in classes: 35 and 40.

CTM number 006589535 XEROX (Logo), filed on 17 January 2008 and registered on 30 January 2009 for goods and services in classes: 2, 9, 16, 35, 37, 40, and 42 (CTM) January 30, 2009.

The Respondent is an unauthorised re-seller of the Complainant's products and maintains a website to which the disputed domain name resolves. The disputed domain name was registered by the Respondent on 16 July 2010.

## 5. Parties' Contentions

### The Complainant's Submissions

The Complainant claims rights in the XEROX trade mark through its ownership of the above trade mark registrations and the goodwill acquired by its extensive use of the XEROX mark in its documents management business for many years throughout the world.

The Complainant submits that it was the world's first commercial producer of document copiers based on work by American inventor Chester Carlson and has grown to be a global leader providing goods and services relating to its document-management business with worldwide revenues of US\$17.6 Billion. The Complainant submits that it employs 130,000 people and provides goods and services under the XEROX trademark in 160 countries. Its stock is publicly traded on the New York Stock Exchange under ticker symbol XRX and it was ranked at number 147 on the 2009 Fortune 500 list of companies. It was also named as No. 1 in Fortune Magazine's 2008-09 World's Most Admired Companies. The Complainant extensively promotes its XEROX Marks through print, radio, television and internet advertising as well as sponsorship of sporting events and appearances at trade shows around the world. The Complainant also promotes its products on its various websites.

The Complainant submits that as a result of its use and promotion of the Xerox mark, the mark has acquired a reputation and goodwill and has come to identify and indicate the source of the Complainant's goods and services to the consuming public, and to distinguish its goods and services from those of others.

The Complainant submits that the disputed domain name is similar to the XEROX trade mark arguing that the use of the word "parts" in proximity to the unique and world-famous XEROX trade mark does not avoid, but rather, enhances similarity between the disputed domain name and the Complainant's mark since the Complainant, itself manufactures and sells replacement parts for its various products. In support of this submission the Complainant cites the decision of the expert in *Scania CV AB v. Abdul Mayat*, DRS Complaint No. 04196 (2006) in which the expert decided that the domain name at issue was similar to the complainant's SCANIA trademark as used in relation to heavy trucks and busses and stated that "[i]n my opinion the addition of the word 'PARTS' in the Domain Name make little difference to the overall impression or impact of it. I therefore determine that the Complainant has established that it has Rights in a name or mark similar to the disputed Domain Name."

The Complainant further argues that the fame of a trademark will influence the analysis of whether a given domain name is similar. In *Hennes & Mauritz AB v. Zaibatsu, Inc.*, DRS Complaint No. D00010145 (2011), the expert found that, "owing to its trade mark rights and the well known nature of its name and

mark, it is entitled to extensive protection for the mark H&M, including the right to object to the [] Domain Name.”

The Complainant submits that the word XEROX is a unique, arbitrary, coined term and has no generic meaning in any language known to the Complainant. The Complainant has continually used the XEROX mark in commerce since 1948 and makes extensive use of the mark such that it has become famous in the United Kingdom and throughout the world. The Complainant argues that the worldwide fame of the XEROX trademark counsels towards a broad scope of protection. Further, given the fact that the Complainant sells replacement parts for its products, it would be natural for Internet users to add the word “parts” to the XEROX mark when typing in a domain name seeking the genuine branded parts and the official website of the Complainant.

The Complainant submits that the disputed domain name is an Abusive Registration and is unfairly detrimental to the Complainant's rights.

The Complainant alleges that the disputed domain name is likely to confuse people or businesses into believing that the domain name is registered to, operated by, authorised by, or otherwise connected with the Complainant. The Complainant argues that because of the similarity of the disputed domain name and the Complainant's trade mark, the disputed domain name is likely to confuse people into believing there is a connection between the Respondent and the Complainant when none, in fact, exists. The Complainant argues that the use of the word “parts” in the disputed domain name enhances the likelihood of confusion as the Complainant's customers would fully expect to see this word in relation to an authorized website hosted by the Complainant. In this regard, the Complainant cites the decision of the expert in *Barclays PLC v. Realm Solutions, Inc.*, DRS Case No. D00009988 (2011) in which the Expert stated that “[i]t is not difficult to see how a person looking for a job at Barclays would type the words ‘Barclays’ and ‘jobs’ into a search engine”.

Furthermore, the Complainant argues that, a strong likelihood of confusion exists given the overall appearance of the Respondent's website, its prominent use of the XEROX logo, and, the Respondent's failure to adequately disclose its lack of any relationship with Complainant on the website to which the disputed domain name resolves.

The Complainant submits that even, assuming, *arguendo*, that a sustained likelihood of confusion is not found here, Internet users who type the disputed domain name into their browsers will be expecting to reach an official website of the Complainant and, even if they ultimately realize that the Respondent is not an official distributor for the Complainant, will have suffered from initial interest confusion. The expert in *Hennes & Mauritz AB v. Zaibatsu, Inc, supra*, held that, “even if the respondent's website is clearly unconnected with the complainant, the visitor will only have been taken there in the first place in the expectation of finding the complainant's authorised site.”

Even more compelling is the expert's statement in *Barclays PLC v. Realm*

*Solutions, Inc., supra*: “That the Respondent uses neither the Complainant’s logo nor the ‘look and feel’ of the Complainant’s web sites is unlikely to have been sufficient to disabuse those visitors to the web site who viewed its contents, having been led to it as a result of their false belief that it was connected to the Complainant (i.e. by their initial interest confusion).”

The Complainant submits that in the present case, the website to which the disputed domain name resolves does, in fact, use the Complainant’s logo and shows many images of its products which can only enhance the likelihood of confusion or, at a minimum, prolong the initial interest confusion, perhaps to the point where a visitor actually makes a purchase from the Respondent.

The Complainant argues that the Respondent is not legitimately connected with the Complainant’s XEROX mark, that the Respondent is not making fair use of the Complainant’s XEROX mark and while the Respondent may claim that it’s use of the XEROX mark is fair as it appears to be selling XEROX branded parts on its website the inquiry must go deeper than this.

In the seminal case of *Toshiba Corporation v. Power Battery Inc.*, DRS Appeal No. 07991 (2010) the panel was presented with facts, not unlike those of the present situation, where a reseller of supposedly genuine parts was using the TOSHIBA trademark in its domain name and was using the complainant’s logo on its website. In considering the relevant factors to determine whether this use was fair, the Panel cited the UDRP case of *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, in which the reseller’s domain name was ordered transferred. Stating that the *Okidata* criteria are consistent with the DRS, the Panel set out four factors for determining whether a reseller’s domain is fair or abusive:

1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent’s use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of “initial interest confusion” and is not dictated only by the content of the website.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller’s incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent’s website.

In *Toshiba Corporation v. Power Battery Inc.*, *supra*, ultimately, the appeal panel held that the domain name in issue in that case was Abusive, primarily on the fourth ground - that the respondent was offering other products for sale on its site in addition to those of the complainant.

The Complainant submits that therefore in the present case the disputed

domain name registration clearly satisfies the *Toshiba* criteria and is an Abusive Registration. The Complainant argues that the domain name falsely implies a commercial connection with the Complainant by its use of the very obvious word “parts”, by the website’s prominent use of the XEROX logo, and by the fact that the site does not “accurately disclose the respondent’s relationship with the trademark owner.” To the contrary, the website to which the disputed domain name resolves prominently displays images of copiers and printers and touts the following statement “XEROX PARTS, XEROX COPIER REPAIR, XEROX SERVICE & MAINTENANCE. XEROX TONER AND CONSUMABLES ALWAYS IN STOCK.”

The Complainant submits that it is only mentioned once, and in much smaller print, that the Respondent is a reseller. Many retail visitors will not even know what it means to be a “reseller” and will assume that the Respondent is authorized by, or affiliated with Complainant. The lack of any relationship with the Complainant is thus not clearly or adequately disclosed and is not mentioned anywhere else on the Respondent’s website.

The Complainant submits that finally and most persuasively the Respondent offers the goods and services of others, unrelated to the Complainant, on the website to which the disputed domain name resolves. As may be clearly seen on the home page and other pages of this site, there are advertisements and links styled as “Empty ink cartridges, earn CASH? Try this!” and “Print Shops news ideas! Make These!” The “Empty ink cartridges” links lead visitors to the website of a cartridge-filling business offer that has no relationship to the Complainant. The “Print Shops” link leads visitors to an offer of children’s custom-printed books. Next, the reference, on the website to “Trusted Partner moneybookers” leads visitors to yet another unrelated commercial offer, this time for online payment solutions.

The Complainant argues that whether these third-party commercial offers are all technically “competitive goods” within a strict reading of the fourth *Toshiba* factor is not critical to this inquiry. This factor is open-ended and an “other reason” for finding abuse is the fact that Respondent is, without dispute, using the XEROX marks to promote and profit from the referral of visitors to these commercial offers much in the way the owner of a classic pay-per-click website profits from the improper use of a trademark. See, e.g., *Maplin Electronics Limited v. Colours Limited*, DRS09824 (2011).

### **The Respondent’s Submissions**

The Respondent submits that he purchased the disputed domain name in 2010 when he decided to sell his digital print business.

The Respondent states that he has used Xerox equipment since 2001 and does everything possible to promote its quality and resilience.

Due to the increasing cost of the contract with the Complainant he commenced maintaining his Xerox presses himself and made significant

savings. However it took him many months to find suppliers and Xerox dealers who were able to offer him parts, toners, consumables. For the next three years he worked in this manner until his digital print business was sold on.

In early 2010 the Respondent decided to set up a parts distribution, servicing and consumable supply business. As he sold parts for the Complainant's products he decided to register the disputed domain name which to his surprise was available for registration.

When contacted by the Complainant and requested to cease use of the disputed domain name, the Respondent replied he services and maintains Xerox copiers, that he provides 100% genuine Xerox products worldwide and has even be contacted by an employee of the Complainant in the UK asking him if he could supply the Complainant and its engineers if they do not have the supply.

The Respondent asked at that time if he could be made a distributor of the Complainant's products so that he could get better local supply in the UK instead of importing in from the USA but the Complainant did not respond to his request.

The Respondent submits that he runs a legitimate business selling stocked genuine XEROX branded items to the market for anyone who is not on a contract with the Complainant. He submits that he does this because the Complainant shuns these customers and leaves them in the lurch, just as they left the Respondent when he told them that their contract rates were too expensive.

The Respondent submits that this re-sale market existed before the Respondent became involved and in the last two years it has grown bigger and bigger due to Complainant's failure to adapt to customer requirements. He argues that he is fulfilling those requirements through the knowledge and expertise he has acquired working with and on the Complainant's copiers. The Respondent submits that he only supplies genuine boxed and branded XEROX supplies which he legitimately buys through companies which he believes are partners of the Complainant. He does not condone, or sell, fakes, compatibles of any type and he has supporting documentation for all purchases he has ever made.

He argues that it is appropriate for him to display the Complainant's products on his website because he is selling the Complainant's products.

The Respondent submits that he sells to distributors worldwide because they cannot get supplies from the Complainant and on one occasion when the Complainant ran out of DC700 toner for its contract customers the Respondent had 50 sets.

As a copier engineer the Respondent claims to be entitled to work on any type of copier including the Complainant's machines and he is entitled to offer

those services freely without the Complainant's say so. The Respondent submits that he can list at least five firms turning over in excess of £500k per annum, doing the same as him and asks why has the Complainant not contacted one of them?

The Respondent submits that he has turned over approx £175k in sales since he started this business. He works on a 55% profit margin, he made it clear to an employee of the Complainant that he would be interested in releasing the disputed domain name and closing down the shop and his business if a reasonable compensation package was proposed. The Respondent argues that this is not a "money grab situation", he has a family who relies on his business for a livelihood. In order for Respondent to set up a different business and move away from the now "congested" XEROX parts and supplies business he would need to be compensated. This is the only time he has mentioned any form of compensation or monetary buyout.

The Respondent submits that he has spent a lot of money with Google adwords promoting his website, it has taken twelve months to get excellent recognition. He has approximately 3000 hits per month and his average orders are £1000.

In the 48 hours prior to submitting the Response, the Respondent made a number of amendments to his website and where he has seen fit, he has put a note on front page of his website stating clearly that he is not the Complainant.

He argues that he uses Moneybookers as a payment processor and as he has a merchant account with that organisation he is quite within his rights to promote them on his website as a backlink.

The Respondent also submits that he has removed "unrelated Xerox items and wording" from his site.

Finally Respondent cites the case Volvo against Volvoparts and submits that he has abided with all of the following criteria: \_

- The dealer is actually offering the goods or services at issue;
- The dealer is using the site to sell only the trade marked goods;
- The site discloses the dealer's relationship with the trade mark owner; and
- The dealer has not tried to corner the market in all domain names.

## **Complainant's Further Submissions**

In further submissions, the Complainant re-asserts that the website to which the disputed domain name resolves does not adequately disclose the lack of any relationship between the Respondent and the Complainant and that the site features advertisements of third parties offering such services as empty



ink cartridge filling businesses, custom-printed children's books and online payment solutions.

Since receiving the Complaint, the Respondent has also added, to its website, the notation "PLEASE NOTE: We are a distributor of Genuine Xerox parts & consumables...We are NOT Xerox itself." While this may indicate that the Respondent and the Complainant are separate entities, it does nothing to dissuade the impression that the Respondent is an official and authorized distributor for the Complainant and so the overall effect is still "falsely to imply a commercial connection with the complainant." *Toshiba Corporation, supra*.

The Complainant further responds that post-complaint changes may not be used to cure all the ills of a domain name and then to allow a respondent to self-servingly claim that its domain name is not an abusive registration. See, e.g., *WST Charters Ltd v. Ligang Sup*, DRS Complaint No. 2631 (2005) (Changes in accused domain's web content made after Complaint filed held by Expert to be self-serving of respondent's arguments and not curing abusive nature of registration.). Also, *F-Secure Corporation (PLC) v Global Publications Ltd*, DRS Complaint No. 7578 (2009) (Expert ordered transfer of domain where "[t]he Complainant also alleges that the Respondent has changed the website since having notice of the complaint in an attempt to prevent a finding of bad faith."); *Jacques Vert Plc v Balata.com LLC*, DRS Complaint No. 03470 (2006) (Ordering a transfer after noting that "[i]t appears that since being notified of the Complaint, the Respondent has changed the website so that it now provides links to websites advertising plants and gardening-related items...."). Such changes only indicate that the Respondent realizes that his abuse has been recognized and do not provide any reassurance that the offending website elements won't be restored to the site in the future.

The Complainant refers to the fact that the Respondent makes reference to the UDRP case of *Volvo Trademark Holding AB v. Auto Shivuk*, WIPO Case No. D2005-0447 in which the complaint against was denied. The Complainant submits that this case is distinguishable from the present situation in that the panelist there noted that "[t]he Respondent does not use the Logo of Complainant...." The Complainant concludes that given the prominent use of the XEROX logo by the website, up until the Response was filed, it is clear that the Volvo Trademark Holding case is not on-point here and that the factors of the Toshiba Corporation case remain the controlling authority.

## **6. Discussions and Findings**

Paragraph 2 a of the Policy provides that

" A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Procedure, 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.”

The Complainant has furnished evidence of its rights in the XEROX trade mark through its ownership of the above trade mark registrations and the extensive goodwill it has acquired through the use and promotion of the XEROX trade mark in connection with its global business of document management machinery and related services.

This Expert agrees with the Complainant’s submissions that the disputed domain name is similar to the Complainant’s XEROX trade mark. The disputed domain name consists of the Complainant’s distinctive trade mark which is a coined word with no other meaning in combination with the descriptive term “parts”.

This Expert also agrees with the Complainant’s submissions that the disputed domain name is an Abusive Registration.

On his own admission the Respondent chose and registered the disputed domain name in order to refer to the Complainant’s mark and products. He claims to be entitled to register and use the Complainant’s trademark in the disputed domain name because he is a re-seller of the Complainant’s products.

As the Complainant has cited, the appeal panel in *Toshiba Corporation v. Power Battery Inc.*, DRS Appeal No. 07991 (2010), when presented with a similar case, adopted the approach of the administrative panel in the UDRP case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 which is set out above in the Complainant’s submissions.

The Respondent admits that he has allowed content advertising home bound books and a financial transaction service to be posted on the website to which the disputed domain name resolves.

Of more significance, on the evidence before this Expert, the print-out of the website to which the disputed domain name resolves, submitted by the Complainant offers a manual on how to set up an ink refilling business and includes what appears to be a “pop-up” or similar notice which states: “Free Report 20 reasons why now is the time for you to start a (sic) ink Cartridge Refilling Business Get this special report FREE Find out why this business is perfect for almost any lifestyle in any location in the world!” The pop-up has two text-boxes inviting visitors to the website to enter their email address and surprisingly their first name and a “submit” button. In the view of this Expert this content puts the Respondent outside of the criteria set by the appeal panel in *Toshiba* and the Complainant is entitled to succeed in the Complaint.

The Respondent refers to “the case of Volvo against Volvoparts “ which presumably is *Volvo Trademark Holding AB v. Auto Shivuk*, WIPO Case No. D2005-0447 June 8, 2005 where the panel refused to transfer the domain name <volvo-auto-body-parts-online.com> to which the Complainant refers.

In that case the panel adopted the *OKI Data* principles and stated as follows: “This Panel follows the majority view put forward in the Oki Data case that a reseller or other sales agent can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name if the use fits the above identified requirements. The Panel also holds the view that the Oki Data criteria are appropriate to be applied in cases, as the present case, where the complainant has not authorized the respondent to act as its distributor or and there is no contractual relationship between the complainant and the respondent.”

The panel in that case went on to find as a fact that the respondent met all the OKI Data *criteria*. In the present case however, for reasons given above the Respondent specifically fails to meet the fourth element of the OKI Data/Toshiba test by offering third party and competitive goods on the website to which the disputed domain name resolves.

Finally this Expert furthermore agrees with the Complainant’s submission that the changes made by the Respondent following the initiation of the procedures under the DRS Policy, came too late in the day and merely serve to indicate the Respondent’s awareness that the website content gave the impression that there was a connection between the Complainant and the Respondent.

## **7. Decision**

For the above reasons, this Expert directs that the disputed domain name xeroxparts.co.uk be transferred to the Complainant.

**Signed .....**

**Dated 10 May 2012**