

DISPUTE RESOLUTION SERVICE

D00012942

Decision of Independent Expert

Clampco (UK) Ltd

and

Mr Paul Cliff

1. The Parties:

Complainant: Clampco (UK) Ltd
Units 1-3 Hammond Avenue
Whitehill Industrial Estate
Stockport
Cheshire
SK4 1PQ
United Kingdom

Respondent: Mr Paul Cliff
87 Milton Avenue
Liverpool
L14 6TF
United Kingdom

1. The Domain Name:

<clampco.co.uk>

2. Procedural History:

On 14 June 2013 the Dispute was received, the complaint was validated and notification of complaint was sent to both parties. On 26 June a response was received and notifications were sent to both parties; a reply was received on the same day and notifications were sent to both parties and a mediator was appointed by Nominet.

On 01 July mediation started but failed on 09 July and the close of mediation documents were sent to both parties. On 10 July an Expert decision payment was received, with the Expert - Tim Brown - being appointed on 17 July.

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call into question my independence in the eyes of one or both of the parties.

3. **Factual Background**

The "Clampco" brand has existed since the 1990s when it was a trading name of a limited company that went into administration. This limited company is not named in either party's submissions and therefore for simplicity I will refer to it as the "First Clampco" in my decision.

The Complainant was incorporated in the United Kingdom in November 2001 as Clampco (UK) Limited. The Complainant is concerned with the sale of a range of automotive products which are primarily sold through its e-commerce web site at <clampcouk.co.uk>.

The Respondent is an individual based in the United Kingdom.

In the screenshot provided by Nominet the Domain Name resolves to a website associated with the domain name <amazonparts.co.uk>.

The Complainant has previously taken action through Nominet's Dispute Resolution Service against the Respondent's registration of the disputed Domain Name and another domain name, namely <clampcouk.co.uk>. The circumstances of this previous dispute are not made entirely clear in the submissions before me. However, Nominet have noted in their correspondence to the parties that the case was not the subject of an Expert decision and instead 'timed-out' when the Complainant chose not to pay for an adjudication. Both parties agree that at this time the Complainant bought the domain name <clampcouk.co.uk> from the Respondent but chose not to buy the disputed Domain Name.

4. **Parties' Contentions**

Complainant

The Complainant's contentions are as follows:

Complainant's Rights

The Complainant has exhibited a registered United Kingdom trade mark, number 2515999, which has a filing date of 9th May 2009 and a date of entry in the register of 21 August 2009. The mark consists of the word "Clampco" in larger blue letters and "Automotive Workshop Supplies" in smaller black letters to the upper right of the mark.

The Complainant notes it uses the domain name <clampcouk.co.uk> to showcase and sell the thousands of auto-related products it offers.

The Complainant avers that it has traded under the name Clampco since the 1990's and that this was a trading name of a company that went into administration (the "First Clampco"). The Complainant clearly considers that any goodwill and rights that existed in the First Clampco were transferred to it - but precisely how this was carried out is not made clear in the submissions before me. The Complainant says that the business became a limited company in its own right in November 2001 called Clampco UK Limited. Various documents from Companies House have been exhibited to support these averments.

The Complainant contends that it is widely known through the automotive industry as simply "Clampco" and that it uses the term "Clampco" on its many own brand products.

Abusive registration

The Complainant narrates how it previously took action under Nominet's Dispute Resolution Service against the disputed Domain Name and the domain name <clampcouk.co.uk>. The Complainant notes that at the time the Domain Name was determined not to be classified as an abusive registration as the "registration of the websites took place before Clampco UK Ltd was actually incorporated in 2001".

The Complainant notes that after mediation it "begrudgedly" agreed to buy the domain name <clampcouk.co.uk> from the Respondent and the transfer was duly arranged. The Complainant notes that the Respondent was unwilling to transfer the disputed Domain Name and that it didn't have the "time or the funds to pursue the matter further..."

The Complainant avers that since purchasing the domain name <clampcouk.co.uk> from the Respondent it has developed an e-commerce offering at the domain name, a screenshot of which has been provided. The Complainant contends that this has helped it to grow and be found by more customers. The Complainant says that it spent thousands of pounds on a new e-commerce platform which was launched in August 2012 and has been a huge success. The launch of the Complainant's new platform was supported through marketing and trade exhibitions and a related flyer has been exhibited.

The Complainant says that within recent months customers have been reporting that they have been visiting what they apparently thought to be its website, complaining that it was of poor quality and that they were not able to place orders. Furthermore the Complainant avers that it received complaints from customers who said they had sent the Complainant emails but had not received replies.

The Complainant contends that it investigated these complaints and noted that it appeared customers were typing the disputed Domain Name rather than the Complainant's similar domain name into their browsers. The Complainant avers that customers who typed the Domain Name were being diverted to a website called "Amazon Parts" - a screenshot showing the diversion has been exhibited. The Complainant notes that Amazon Parts is a direct competitor of the Complainant, selling similar products.

The Complainant says that the Respondent is associated with an individual called Matthew Cliff who - according to documents exhibited by the Complainant - is a director of AmazonParts Limited.

The Complainant avers that it sent a number of test emails to a number of addresses at the Domain Name. It notes that while two test emails bounced back, emails sent to sales@clampco.co.uk did not. The Complainant contends that it seems the Respondent is capturing emails intended for the Complainant.

The Complainant says the configuration of the Domain Name to divert users to a competitor is taking unfair advantage of its rights and that this is having a detrimental effect on its business. The Complainant contends that the Domain Name is confusing Internet users and its potential customers and that this is disrupting its business.

Respondent

The Respondent's contentions are as follows:

Procedural issues

The Respondent avers that the Domain Name has been subject to proceedings under the DRS before and that the said proceedings were dismissed by Nominet. The Respondent appears to maintain that the current dispute should be considered a re-filing and therefore dismissed.

Complainant's Rights

The Respondent contends that he was a director of the First Clampco. When the First Clampco went into receivership the Respondent avers that he bought the stock and name from the receiver. The Respondent notes that the Complainant is trading as Clampcouk Limited not Clampco Limited.

The Respondent avers that the Complainant does not have copyright on the name "Clampco" as he owned it prior to the Complainant's incorporation in 2001.

The Respondent notes that he is prepared to "go legal" with the complaint and take action against Nominet and the Complainant. The Respondent further notes that he has spent a large sum defending his rights to <amazonparts.co.uk> from the on-line retailer Amazon.

Abusive registration

The Respondent has not directly addressed the question of whether or not his registration of the Domain Name is Abusive as he clearly considers the Complainant does not have rights as required by the Policy and therefore the Complaint should fail at the first hurdle.

Complainant's reply

The Complainant's reply to the Response is as follows:

Complainant's Rights

The Complainant avers that the Respondent has not presented any evidence of any involvement or interest in any company called "Clampco". The Complainant

notes it has searched Companies House and has not found a company called "Clampco Limited" of which the Respondent claims he was a director.

The Complainant contends it bought the rights to Clampco in October 2008.

Abusive registration

The Complainant avers that the Respondent is using the Domain Name to divert traffic to the website of a company with which he is associated and that this use is fraudulent. The Complainant says that the Domain Name is of no use to the Respondent other than to prevent the Complainant from using it.

5. Discussions and Findings

Procedural issues

The first matter which must be considered is whether this is a re-filing of a previous dispute - as claimed by the Respondent. I have referred to Paragraph 10.e. of the Policy which says:

If a complaint has reached the Decision stage on a previous occasion it will not be reconsidered (but it may be appealed, see paragraph 10(a) and Procedure paragraph 18) by an Expert. If the Expert finds that the complaint is a resubmission of an earlier complaint he or she shall reject the complaint without examining it.

Nominet's mediation period - which chronologically precedes Expert decisions - is a useful service designed to resolve issues between parties. However, any conclusions reached during this process regarding the merits of a dispute are not formally binding. In theory, a party may bring a complaint and withdraw from the procedure during the mediation period as many times as it wishes.

It is clear from the correspondence between Nominet and both parties that this matter has not previously reached the decision stage. Therefore the Complainant is within its rights to bring this complaint and proceed this time to an Expert decision.

In conclusion, I reject the Respondent's assertion that this is a re-filing and will proceed with my decision on the facts before me.

Rights

There is some dispute between the parties as to which purchased the goodwill in the Clampco name after the First Clampco ceased trading. Little evidence has been presented by either party to back up their claims and it is certainly not clear from the submissions precisely how and to whom the First Clampco's assets were sold. However, I take the view that it is not necessary under the first test of the Policy to consider how a party came about their rights or whether those rights pre-date the disputed domain name's registration. An Expert only has to decide whether the Complainant has Rights at all. Issues such as whether rights pre-date the registration of a domain name are considered under the second test - Abusive Registration.

According to Paragraph 2.a.i of the Policy, the Complainant must have Rights in respect of a name or mark which is identical or similar to the Domain Name. These rights are rights enforceable by the Complainant, whether under English law or otherwise.

The Complainant has exhibited a registered trade mark; as noted above the mark consists of the word "Clampco" in larger blue letters and "Automotive Workshop Supplies" in smaller black letters to the upper right of the mark. The mark is clearly not identical to the disputed Domain Name but is it similar?

As is customary in DRS proceedings the .co.uk suffix is only required for technical reasons and, along with any whitespace, can be ignored for the purposes of comparison between a mark and a Domain Name.

In my view the mark is similar to the Domain Name. The word "Clampco" is the most dominant element of the mark with the additional words "Automotive Workshop Supplies" being less dominant and descriptive of the Complainant's business activities. I have taken this view in the context of the exhibited screenshots of the Complainant's website and flyer which consistently refer to the Complainant as "Clampco" rather than "Clampco Automotive Workshop Supplies".

Therefore I find that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

Abusive Registration

Paragraph 1 of the Policy defines an Abusive Registration as a domain name which:

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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

The Policy lays out a non-exhaustive list of factors which may be viewed as evidence that a domain name may be an Abusive Registration.

In essence the Complainant relies on Policy Paragraph 3a.ii, namely that there are 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.

In its submissions the Complainant says, and the Respondent does not deny, that the Domain Name has been configured to forward web users to a competitor of the Complainant, namely "AmazonParts". The Complainant says the Respondent is connected with AmazonParts and the Respondent himself notes that he has spent a large sum defending his rights to <amazonparts.co.uk> from the on-line retailer Amazon. It is highly unlikely that someone would (or indeed could) defend an action if they were not associated with it. Therefore I take the view that the Respondent is connected with the competing web site to which the Domain Name directs users.

The Complainant has submitted that the configuration of the Domain Name to divert users to a competitor and to capture emails intended for the Complainant is taking unfair advantage of its rights and that this is having a detrimental effect on its business.

In considering this point I have referred to Paragraph 3.3 of the Expert's overview: "Paragraph 3(a)(ii) concerns confusing use of the domain name. What is meant by confusing use?" The Overview says:

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 ... 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 my view when web users type the Domain Name into a browser or find it through a search engine they will expect to find the Complainant's web site, not that of AmazonParts. That the Domain Name is similar to the Complainant's mark will inevitably result in the species of "initial interest" confusion described above.

If these were the only facts in this matter, I would have little hesitation in awarding the Domain Name to the Complainant. However, the facts are further complicated as both the Complainant and Respondent claim to have bought the rights to the Clampco name from the First Clampco when it ceased trading. In essence, the Complainant's case is as set out above while the Respondent says the Domain Name is his and he can do with it as he pleases.

I have very little firm evidence before me from either party as to who bought the goodwill and how and when it was purchased. However, it seems to me to be more likely on the balance of probabilities that the Complainant was the successor to the First Clampco rather than the Respondent.

The evidence before me shows that the Complainant has operated under the trading style "Clampco" for a number of years; it is an incorporated company

called "Clampco UK Limited"; it operates a web site at <clampcouk.co.uk>; it has attended trade shows and exhibited a flyer which uses the term "Clampco".

To counter this the Respondent makes an assertion, unsupported by evidence, that it is the owner of the "Clampco" brand. The Respondent has shown no evidence that he has traded as "Clampco" or used the name since his apparent purchase of the goodwill from the First Clampco. Indeed the Domain Name itself has been configured to direct users to a website operated by the business AmazonParts, with which the Respondent appears to be associated.

On balance, I find it very unlikely that an entity would buy the goodwill in a brand with no intention of trading under it, instead choosing to operate under an entirely different name. Perhaps there may be circumstances in which a brand is purchased and kept dormant, but in the absence of any averments or evidence to this effect the Respondent has not shown to my satisfaction that he acquired the goodwill from the First Clampco. Even if the Respondent had bought the brand he has not produced any evidence to show the goodwill in said term has been maintained through any active use during the years since his averred purchase.

For completeness, it is worth noting that a registration can be Abusive under Paragraph 1.ii if it "**has been used** in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights" [Expert's emphasis]. In certain circumstances, while a domain name's registration may pre-date the creation of any rights, the use to which it has been put may render it Abusive (for extensive discussion on this point see *The Game Group plc v. Garth Associates Multimedia Entertainment* [DRS2166]). In the absence of any submissions from the Respondent explaining why he has configured the Domain Name to divert users to a competitor of the Complainant, I take the view that the Domain Name has been used in manner which takes unfair advantage of the Complainant's Rights.

In the absence of any evidence, I do not give any particular weight to the Respondent's claims and take the view that the Respondent's use of the Domain Name to divert web users to a competitor of the Complainant is Abusive in terms of the Policy.

6. **Decision**

Having concluded that the Complainant has Rights in respect of names or marks which are similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I determine that the Domain Name should be transferred to the Complainant.

Signed Tim Brown

Dated 25-July-2013