

DISPUTE RESOLUTION SERVICE

D00014291 and D00014103

Decision of Independent Expert

European Polymer Products (Group) Ltd

and

Walkden Group Limited (was Speedliner (Bolton) Ltd)

1. The Parties:

Lead Complainant: European Polymer Products (Group) Ltd
Unit 11, Orleton Road
The Business Park
Ludlow
Shropshire
SY8 1XF
United Kingdom

Complainant: Speedliner Europe Limited
Unit 11, Orleton Road
The Business Park
Ludlow
Shropshire
SY8 1XF
United Kingdom

Respondent: Walkden Group Limited (was Speedliner (Bolton) Ltd)
55 Ashdene Crescent
Harwood
Bolton
Lancashire
BL2 3LW
United Kingdom

2. The Domain Name(s):

speedlinerbolton.co.uk
speedliner.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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

01 June 2014 11:53 Dispute received
03 June 2014 10:32 Complaint validated
03 June 2014 11:11 Notification of complaint sent to parties
20 June 2014 02:30 Response reminder sent
24 June 2014 10:50 Response received
24 June 2014 10:50 Notification of response sent to parties
26 June 2014 12:06 Reply received
01 July 2014 11:20 Notification of reply sent to parties
01 July 2014 11:20 Mediator appointed
10 July 2014 12:23 Mediation started
21 July 2014 12:49 Mediation failed
21 July 2014 12:50 Close of mediation documents sent
28 July 2014 11:03 Expert decision payment received

4. Factual Background

Speedliner Europe Ltd (one of the Complainants) was incorporated in 2004. It imports, markets, sells and distributes specialist polymer spray liner products and other related polymer materials to various sectors. Originally product was sourced by the Complainants from Industrial Polymers, Inc, a US company which sold its products under the 'SPEEDLINER' brand, although the Complainants no longer source their products from that company. The Complainants' products are sold only to independent, authorised dealers/applicators who are trained to use and apply the product and no on-line, trade or retail re-sale by those dealers/applicators is authorised by the Complainants.

The Complainants advertise and market their products both to the trade market with the intention of attracting new dealers/applicators to become authorised, and also to end users, such that those end users will be referred to the authorised dealers/applicators.

Mr Nash, the managing director of Speedliner Europe Ltd, is the registered proprietor of Community Trade Mark number 5842761 for the word 'SPEEDLINER' registered on 21 February 2008 for goods/services in classes 1, 2 and 40. The Complainants use the mark on products, within their business name, within promotional materials and also within the domain names speedlinereuro.com and speedlineruk.com. They have also licensed certain authorised distributors to use the mark in their name, for example Speedliner Germany.

The Respondent and/or persons associated with that company became an authorised dealer of the Complainants in 2003. Some time thereafter the Respondent incorporated a company under the name Speedliner Bolton Ltd and commenced use of the Domain Names. That use was objected to by the Complainants via their accountants in 2005. The Respondent subsequently ceased using that company name and traded as Walkden Group Ltd.

By letter dated 19 December 2012, the Respondent was notified by the Complainants that it was no longer authorised by the Complainants and it was requested to remove all references to the SPEEDLINER trade mark, including on its website. Thereafter the Respondent sold a product supplied by a competitor of the Complainants under a different brand. In fact the Respondent did not cease use of the Complainants' mark on its website and this led to a complaint being made to the Advertising Standards Authority by the Complainants and via its solicitors to the Respondent, which in turn led to the Respondent ceasing use of the mark on its website (save in respect of the Domain Names).

5. Parties' Contentions

a. Complaint

In support of its claim to Rights, the Complainants rely upon Mr Nash being the proprietor of the registered trade mark referred to above, its use of that mark as a trading name, a product name and also its ownership of the domain names referred to above. It asserts that that the Respondent is using a sign the same as the name in which it has Rights.

In support of the claim that the Domain Names are Abusive Registrations the main points made by the Complainants (in summary) are that the Respondent:

- (i) was never authorised to use the mark SPEEDLINER as a company name;
- (ii) if it was ever authorised to use the mark, it ceased to be so authorised on 19 December 2012; and
- (iii) the Respondent's ongoing use of the Domain Names is causing the Respondent's website to appear prominently in search engine results and this is causing confusion for the Complainants' customers or potential customers and disruption to the Complainants' business.

b. Response

The Respondent does not accept that the Complainants have Rights and believes that Industrial Polymers, Inc are the true owner of the SPEEDLINER mark.

In defence of the Complaint the main points made by the Respondent (in summary) are that:

- (i) there are various legal proceedings on foot between the parties (although no evidence is provided);
- (ii) it was historically authorised by the Complainants as a dealer and the Complainants monopoly over the SPEEDLINER mark is not accepted; and
- (iii) the Complainant must prove and quantify the losses that they claim to have suffered.

c. Reply

The Complainants assert the following main points (in summary):

- (i) there are no legal proceedings relating to the Domain Names or the Complainants' trade mark; and
- (ii) the Respondent was never authorised to register the Doman Names.

6. Discussions and Findings

a. General

To succeed in this Complaint, the Complainants must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Names; and
- (ii) the Domain Names in the hands of the Respondent are Abusive Registrations (as defined in paragraph 1 of the Policy).

b. Complainant's Rights

The DRS Policy defines Rights 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".

In my view the Complainants have shown that they have Rights. Whilst it is not expressly asserted that Mr Nash has licensed the Complainants to use the SPEEDLINER mark, given that he has signed the complaint, I think it is reasonable to assume that such a licence exists. It is also apparent that the Complainants have extensively used the mark over a significant period of time. In that regard, the Respondent has failed to make good its assertion that the Complainants do not have Rights by providing evidence that there is a challenge to the Complainants' Rights by itself or any third party.

For the purpose of analysing whether the Domain Names are identical or similar to the name or mark in which rights are claimed, one should ignore the .co.uk suffix. The comparison is therefore between 'SPEEDLINER' on the one hand, and 'SPEEDLINER'/'SPEEDLINERBOLTON' on the other. Given that the word 'BOLTON' will be seen solely as a geographical indication, in my opinion the Complainants have established that they have Rights in a mark identical or similar to the disputed Domain Names.

c. Abusive Registration

I now go on to consider the extent to which the disputed Domain Names are Abusive Registrations.

The Complainants assert that the Domain Names are Abusive Registrations for the reasons identified above.

The Policy defines an Abusive Registration as -

"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"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

In most circumstances where a respondent has registered a domain name that is identical or similar to a name or mark in which the complainant has

rights, the name or mark is well known or distinctive and the complainant and mark were known to the respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration. However the extent to which a party who has or is reselling the goods or services of a complainant, can legitimately use a domain name incorporating the complainant's trade mark or name, has been the subject of much deliberation by Experts and has been dealt with in several appeal decisions. This is in part because of general legal principles regarding the legitimate use of another party's trade mark to denote its goods/services, exhaustion of trade mark rights once goods have been put on the market, and the specific provisions within the Policy concerning a genuine offering of goods (Para 4(a)(i)(A)) or fair use (Para 4(a)(i)(C)).

In the seiko-shop.co.uk appeal decision (DRS00248) the panel said the following:

"The Panel agrees that if there is support in the evidence for the suggestion that the Domain Names make, or are liable to be perceived as making, the latter representation (i.e. that there is something approved or official about their website), this would constitute unfair advantage being taken by Wanderweb or unfair detriment caused to Seiko."

The panel also dealt with an issue arising under paragraph 3(a)(i)(C) of the Policy, which provides that a registration will be abusive if there are -

"i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

C. for the purpose of unfairly disrupting the business of the Complainant".

The issue was how the word "primarily" should be interpreted, and the panel concluded that:

"In our view 'primarily' is not the same as 'only' and although a domain name registrant may start out with the best of intentions, if the effect of his actions is to give rise to confusion and to disrupt a Complainant's business then he has fallen foul of this paragraph in the Policy."

Reseller use was also considered in a case concerning Epson ink cartridges (DRS 03027). The panel confirmed that initial interest confusion was an "admissible species of confusion in DRS cases" and then went on to deal with what the correct approach should be where the respondent was a reseller. It said:

"9.4.9 The question of whether the (misleading) impression of a commercial connection is created is a question of fact in each case. There is, however, a marked difference between selling the genuine products of another party under its registered trade marks in order to identify the goods as being those of the trade mark owner, or making

legitimate comparative uses in accordance with honest commercial practices in such matters, and the Respondent's practice of adopting a multiplicity of web site addresses incorporating the trade mark for general promotional purposes, to divert customers to the Respondent's website, irrespective of whether or not the business includes the sale of such genuine or compatible goods."

Both the Seiko and Epson cases were considered in the toshiba-laptop-battery.co.uk appeal (DRS 07991). Four criteria were identified as being relevant to the determination of whether a reseller's use of a domain name incorporating a complainant's trade mark/name is abusive, as follows:

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.

When addressing whether it would be fair to offer competing goods, the panel said the following:

"The further issue, however, is whether the fact of the offering of competitive products on the Respondent's website is sufficient to render the registration abusive, even in the absence of "initial interest confusion". On this question, the Panel unanimously considers that, if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner's consent, to accord with the principles stated above that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated."

In circumstances where there was an on-going relationship between the Respondent and the Complainants, the above factors would have to be considered carefully before coming to a conclusion. However in the present case there is no current relationship. Furthermore, the Complainants have historically objected to the use of the Domain Names and other uses of the SPEEDLINER mark by the Respondent. The Respondent has seemingly

accepted that use of the Complainants' mark on the Respondent's website should cease and it is therefore curious as to why it has taken the somewhat contradictory view that ongoing use of the Domain Names is permissible.

In my view the Respondent's use prior to the making of the complaint is such that the Domain Names falsely imply a commercial connection with the Complainants and falls within paragraphs 3(a)(ii) of the Policy, namely "*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*". I am not persuaded that the historical relationship between the parties is such that the ongoing use of the Domain Name is legitimate use.

7. Decision

For the reasons set out above, I find that the Complainants do have Rights in respect of a name which is identical or similar to the Domain Names <speedliner.co.uk> and <speedlinerbolton.co.uk> and the Domain Names in the hands of the Respondent are Abusive Registrations. The Complaint therefore succeeds.

Signed: Simon Chapman

Dated: 15 August 2014