

DISPUTE RESOLUTION SERVICE

D00014116

Decision of Independent Expert

Global Garden Products Italy S.p.A. and GGP UK Limited

and

Ing. Tomas

1. The Parties:

Lead Complainant: Global Garden Products Italy S.p.A.
Via del Lavoro, 6
CASTELFRANCO VENETO
TV
31033
Italy

Complainant: GGP UK Limited
Unit 8 Bluewater Estate
Bell Close
Plympton
Plymouth
PL7 4JH
United Kingdom

Respondent: Ing. Tomas
Podbabska 81/17
Praha 6
16 624
Czech Republic

2. The Domain Name(s):

atcomowers.co.uk (“the Domain Name”)

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.

Here is the formal procedural history of this case:

24 April 2014 11:19 Dispute received
24 April 2014 11:44 Complaint validated
24 April 2014 13:34 Notification of complaint sent to parties
14 May 2014 02:30 Response reminder sent
19 May 2014 10:56 No Response Received
19 May 2014 10:56 Notification of no response sent to parties
28 May 2014 11:37 Expert decision payment received

4. Factual Background

The Complainants are part of the GGP Group, an international group of companies which produces and sells lawn mowers and gardening equipment. (The Complainants are collectively referred to below as “the Complainant”.)

The Complainant, and its predecessors, have traded under the name “Atco” for almost 100 years.

Since at least 1996, the Complainant and its predecessors have operated their own website at www.atco.co.uk.

The Complainant owns a range of registered trade marks for “ATCO” including UK trade mark no. 410604 dated 14 December 1920 in classes 7, 8, 12 and 20.

The Domain Name was registered on 7 July 2011.

The Respondent has used the Domain Name for an “ATCO”-branded website offering lawn mowers for sale. Beneath a large photo of some lawn mowers, there is a portion of text headed “ATCOMowers.co.uk”, which starts: ***“Welcome to our e-shop, which is focused on on-line sales of traditional English lawnmowers ALLETT (ATCO).”***

5. Parties’ Contentions

Complaint

The following is a summary of the Complainant's submissions.

The Complainant's trade marks are very similar to the Domain Name as both are dominated by the word "ATCO" and the additional word "mowers" in the Domain Name is simply a description of the goods offered for sale by the Respondent.

The Domain Name was created well after the Complainant's trade marks were registered.

The Complainant has found no evidence of any relevant trade mark owned by the Respondent.

The Complainant has not authorised the Respondent to register or use the Domain Name.

The Domain Name has been used in a way which is likely to cause confusion with the Complainant. Not only is the Domain Name similar to the Complainant's trade mark, the Respondent's website is very similar to that of the Complainant. Both sites are dominated by the colour green. The "ATCO" logo appears in an identical font at the top of the respective home pages. Both sites include multiple pictures of green lawn mowers.

The products offered on the Respondent's website are counterfeit. There is no relationship between the Complainant and the Respondent, which falsely claims on its website to be "in contact with ATCO manufacturer in England".

Customers are misled into thinking that the Respondent's website is operated by a subsidiary or authorised dealer of the Complainant.

Response

The Respondent did not file a Response.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of "rights" is clarified and defined in the DRS Policy in the following terms:

"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"

The Complainant has rights in the term "ATCO" based on its registered and unregistered trade marks.

The Complainant's trade mark is undoubtedly similar to the Domain Name as it differs only by addition of the descriptive word "mowers".

The Complainant has therefore established rights in a name or mark which is similar to the Domain Name.

Abusive registration

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS Policy defines "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."***

The Respondent's site states that it offers the Complainant's products for sale.

Section 4.8 of the DRS Expert Overview ("the Overview") on Nominet's website sets out the applicable principles derived from DRS cases, as reviewed by the appeal panel in Toshiba Corporation v Power Battery Inc (DRS 07991) <toshiba-laptop-battery.co.uk>. These are:

"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."

The Complainant claims that the products offered by the Respondent are in fact counterfeit but it offers no detailed proof of this. However, it makes no difference whether or not the products are counterfeit. Even if the Respondent is simply re-selling genuine Complainant products, it is abusive to do so in the following manner whereby the Respondent's use of the Domain Name falsely implies a commercial connection with the Complainant.

First, in my view, the Domain Name is likely to result in initial interest confusion. The Domain Name consists of the Complainant's distinctive trade mark plus an appended descriptive term which could hardly be more appropriate to the Complainant's field of activity. See section 3.3 (penultimate paragraph) of the Overview.

Second, the Respondent is using a website which users are likely consider to be connected with the Complainant, in particular due to the prominent branding of the Respondent's site with an "ATCO" logo in exactly the same font as the Complainant's own logo.

Furthermore, the Respondent has not seen fit to file a Response to explain or justify its activities.

For the reasons stated above I find that the Domain Name is an abusive registration in that it has been registered and/or used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights.

7. Decision

I find that the Complainant has rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name, atcomowers.co.uk, be transferred to the First Complainant.

Signed Adam Taylor

Dated 17 June 2014