

# **DISPUTE RESOLUTION SERVICE**

**D00017796**

## **Decision of Independent Expert**

Multi-Lab Ltd

and

**CERAMIC SUBSTRATES & COMPONENTS LIMITED**

### **1. The Parties:**

Complainant: Multi-Lab Ltd  
Unit 1, Westway Industrial Park, Throckley,  
Newcastle upon Tyne  
Newcastle upon Tyne  
NE15 9HW  
United Kingdom

Respondent: Ceramic Substrates & Components Limited  
Lukely Works, 180 Carisbrooke Road  
Newport  
Isle of Wight  
PO30 1DH  
United Kingdom

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

multilab.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.

29 July 2016 14:16 Dispute received  
02 August 2016 12:04 Complaint validated  
02 August 2016 12:11 Notification of complaint sent to parties  
09 August 2016 09:57 Response received  
12 August 2016 14:13 Notification of response sent to parties  
16 August 2016 11:33 Reply received  
16 August 2016 11:33 Notification of reply sent to parties  
24 August 2016 12:07 Mediator appointed  
24 August 2016 12:07 Mediation started  
12 September 2016 16:16 Mediation failed  
12 September 2016 16:17 Close of mediation documents sent  
13 September 2016 17:25 Expert decision payment received

### **4. Factual Background**

The Complainant was formed in 1984. It trades under the name Multi-Lab and has done so for some time. It has a website at the URL multi-lab.co.uk. The website states that the Complainant manufactures and distributes technical ceramic materials.

A Nominet WHOIS search shows that the Domain Name was registered on 3 September 2009. The registrant is an individual who shares the same address as the Respondent Company. The Respondent is operating a website using the Domain Name.

The Respondent trades in products and services which to some extent overlap with the Complainant's business. The Respondent is a customer of, and a supplier to, the Complainant.

In February 2010, the Complainant made a Complaint under the Nominet Dispute Resolution Service Policy (the Policy) against the Respondent in respect of the Domain Name (DRS 8269). That Complaint did not proceed to an Expert decision after mediation was closed.

The current Complaint was begun when the Complainant embarked on a new Search Engine Optimization process. The Complainant was advised that the use of the Domain Name by the Respondent was, and would continue to be, harmful to the Complainant's business.

## 5. Parties' Contentions

### The Complaint

The Complainant asserts Rights in the MULTI-LAB mark. It relies on its longstanding use of the mark. Its reputation has been built on word of mouth around universities and research institutes and this is a fundamental part of its success.

The Domain Name is to all intents and purposes identical to the MULTI-LAB mark. The lack of the hyphen in the Domain Name makes no significant difference.

The registration and use of the Domain Name is an attempt by the Respondent to divert business inquiries from the Complainant. The Respondent's choice of the Domain Name was not a mistake or oversight. It was familiar with the Complainant because it is a longstanding customer and supplier. The Respondent's own corporate and trading name is a contrast to Multi-Lab and Multi-Lab is not the name of a product or material. There was therefore no legitimate reason for the Respondent to use the Domain Name.

It also follows that anyone using MULTI-LAB or MULTILAB as a search term would be looking for a company called Multi-lab (i.e. the Complainant) and not a product.

### The Response

The Respondent has produced and relies on the submissions it made in response to the Complaint about the Domain Name in 2010. It makes no further submissions or updates to the information provided in 2010, which was:

1. The Respondent is not a direct competitor of the Complainant, although the Parties do overlap in certain areas. The Parties' respective websites advertise different products.
2. The Respondent's website at the Domain Name looks different to that of the Complainant. The Respondent's website uses its own logo which is clearly visible on the landing page together with the Respondent's name and address. The Respondent is not trying to cause confusion.
3. The Respondent owns and uses more than one domain name to promote its products such as [www.macor.info](http://www.macor.info), [www.machinableceramic.com](http://www.machinableceramic.com) and [www.co.uk](http://www.co.uk) and [www.Anvil.com](http://www.Anvil.com).
4. The name multilab.co.uk is generic. There are other companies with the Multilab name who own other Multilab domain names with and without the hyphen e.g.(i) multilab.com is owned by Multi-Lab Inc. in the USA offering printed circuit boards and (ii) multilab.biz is a business which exports, supplies and manufactures laboratory instruments and equipment. There is also a range of laboratory furniture called Multilab.

5. The domain name multi-lab.com was for sale but the Complainant had not purchased it.

### The Reply

The Complainant disputes that the Parties are not in direct competition. It submits that they overlap in most if not all ceramic areas and materials.

## **6. Discussions and Findings**

Under Paragraph 2 of the Policy in order for the Complainant to succeed it must establish on the balance of probabilities, both:

that it has 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 as defined in Paragraph 1 of the Policy.

### Rights

Rights are defined in Paragraph 1 of the Policy 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."

The Complainant asserts rights in the MULTI-LAB mark. It does not rely on any trademark registrations. Its case is based on its length and extent of use of the MULTI-LAB mark in the course of trade. There is no specific evidence about how long or in what way the Complainant has used its mark, other than the fact that the use is longstanding and that it has generated a word of mouth trading reputation for the Complainant. The aborted 2010 complaint about the same domain name shows that the Complainant was using the MULTI-LAB mark at that time, which places the length of use of the mark as being at least 6 years. The Respondent has not disputed that the Complainant has Rights.

On balance, the Expert finds that the Complainant has established that it owns unregistered Rights in the MULT-LAB mark through its use of the mark in the course of trade.

The next issue to determine is whether the Domain Name is similar or identical to the Complainant's MULTI-LAB mark. The Expert agrees with the Complainant that the

Domain Name is at least similar to the Domain Name. Phonetically the two are the same. The impact of the Domain Name comes from the distinctive components “multi” and “lab”. The lack of the hyphen makes no difference to the overall impact of the Domain Name.

The Expert therefore finds that the Complainant has established on the balance of probabilities that it owns Rights in a name or mark which is similar to the Domain Name.

### Abusive Registration

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

"Abusive Registration means 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".

In this matter registration and use of the Domain Name fall to be considered together.

The Domain Name was registered in 2009. The Complainant’s case is that the Respondent was motivated to register the Domain Name to divert business inquiries from the Complainant and that its use of the Domain Name has had this effect. The Respondent disputes this for the reasons set out in paragraph 5 above, which will be considered below. The Respondent does not suggest that it was unaware of the Complainant at the time that it registered the Domain Name. In fact, its submission to the 2010 complaint makes it clear that it traded with the Complainant at that time. This gives rise to an inference that the Respondent was aware of the Complainant at the time of registration.

In relation to the Respondent’s submissions:

The Expert is not in a position to carry out a detailed analysis of the extent to which the Parties are in direct competition. But both Parties acknowledge a degree of overlap in their trading activities and it seems to the Expert that they operate in the same broad field. This fact increases the likelihood that business is being diverted from the Complainant to the Respondent.

The Respondent may have differentiated its website from the Complainant but what the Respondent does not counter in its submissions is the fact that the Domain Name attracts traffic intended for the Complainant. An internet user who types “multilab” into their search engine is directed to the Respondent’s website.

The Respondent's marketing strategy of using a range of domain names makes no difference to this position.

The Respondent's submission that the MULTI-LAB mark is generic is not accepted. The mark is not a dictionary word and has no commonly understood meaning. The fact that other businesses in different sectors and jurisdictions use the mark does not mean that it is not associated with the Complainant and its products in its own field of activity. The Expert has already found that the Complainant has Rights in the MULTI-LAB mark.

The fact that the Complainant has not registered all variants of domain names featuring the MULTI-LAB mark is also irrelevant to the issues that are raised in this matter.

The Respondent's submissions are therefore rejected. On the other hand, the Complainant's submission that the Respondent had no legitimate reason for registering and using the Domain Name is compelling. The Respondent must have realised that internet traffic intended for the Complainant would be diverted to its website at the time it registered the Domain Name. Although it is possible- or even likely- that visitors to the Respondent's website would realise that they had not reached the Complainant's website, they are nevertheless exposed to the Respondent's goods and services. As the Complainant states, the business inquiry has been diverted and possibly any resulting custom. This situation causes unfair detriment to the Complainant which has built up the goodwill associated with the MULTI-LAB mark over time. It also takes unfair advantage of that goodwill by exploiting the reputation and brand recognition to attract internet traffic and business.

Although there is no evidence of actual confusion or loss of trade before the Expert, this is not necessary for the Complainant to establish its case. The facts lead to a strong inference that the public are being misled. This is sufficient to allow the Complainant to establish its case on the balance of probabilities.

The Complainant has therefore established that the Respondent's registration and /or use of the Domain Name is an Abusive Registration under the Policy.

## **7. Decision**

The Expert finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert orders that the Domain Name be transferred to the Complainant.

**Signed** .....

**Dated** 7 October 2016