

DISPUTE RESOLUTION SERVICE**D00018316****D00018320****Decision of Independent Expert**

FANUC UK Limited

and

Pennine Automation Spares Limited

and

Neil Ginley

1. The Parties:

Lead Complainant: FANUC UK Limited
Address: Seven Stars Industrial Estate
Quinn Close Off Wheler Road
Coventry
Warwickshire
CV3 4LB
United Kingdom

Complainant: FANUC Corporation
Address: Oshino-mura
Yamanashi Prefecture 401-0597
Japan

DRS18316
Respondent: Pennine Automation Spares Limited
Address: Brookwoods Industrial Estate
Burrwood Way
Holywell Green
Halifax
West Yorkshire
HX4 9BH
United Kingdom

DRS18320

Respondent: Neil Ginley
Address: Brookwoods Industrial Estate
Burwood Way
Hollywell Green
Halifax
HX4 9BH
United Kingdom

2. The Domain Name:

DRS18316 fanuc-parts.co.uk
DRS18320 fanuc-spares.co.uk (together the "Domain Names")

3. Procedural History:

I 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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 4, October 2016 (the "Policy") unless the context or use indicates otherwise.

DRS18316 and DRS 18320

This complaint was originally filed as one complaint in relation to both Domain Names. However, as the first Domain Name is registered to Pennine Automation Spares Limited and the second Domain Name is registered to Neil Ginley, the sole director of Pennine Automation Spares Limited, Nominet attributed the original complaint (DRS18316) to fanuc-parts.co.uk and the Complainant submitted an identical complaint (DRS 18320) in relation to fanuc-spares.co.uk.

The Respondent requested that both complaints be treated separately in the mediation stage and although the same mediator was appointed Nominet agreed to this.

Mediation having failed the Complainant requested consolidation of DRS18316 and DRS18320 into one referral to an expert for determination on the basis that the same company, Pennine Automation Spares Limited, appears within the Registrant Type field for both Domain Names and therefore the two Domain Names are clearly under common control, even if technically the registrants are regarded as different. Nominet agreed to consolidation and appointed the Expert to deal with both Domain Names together.

DRS18316

15 December 2016 Dispute received
15 December 2016 Complaint validated and notification of
complaint sent to parties
6 January 2017 Response reminder sent
9 January 2017 Response received and notification of
response sent to parties
12 January 2017 Reply reminder sent
12 January 2017 Reply received
17 January 2017 Notification of reply sent to parties
17 January 2017 Mediator appointed
20 January 2017 Mediation started
16 February 2017 Mediation failed and close of mediation
documents sent
22 February 2017 Expert decision payment received

DRS18320

16 December 2016 Dispute received
20 December 2016 Complaint validated and notification of
complaint sent to parties
11 January 2017 Response reminder sent
13 January 2017 Response received and notification of
response sent to parties
18 January 2017 Reply reminder sent
19 January 2017 Reply received and notification of reply
sent to parties
19 January 2017 Mediator appointed
20 January 2017 Mediation started
16 February 2017 Mediation failed and close of mediation
documents sent
22 February 2017 Expert decision payment received

4. Factual Background

The Complainants are part of the FANUC international group of companies which provides automation products and services such as robotics and computer numerical control systems. The group is a manufacturer of industrial robots for customers including manufacturers of cars and electronics.

The Lead Complainant has traded in the UK under the names "FANUC"/ "FANUC Robotics" since 1982. It is currently the main group trading company in the UK. The turnover of this company was approximately £16.5 million in 2014 and £49 million in 2015. The Lead Complainant offers servicing, repairs and spare parts for its systems.

The second Complainant, FANUC Corporation, is a Japanese company incorporated in 1972 and since then it, and its group companies, have supplied automation systems in Japan and worldwide under the name "FANUC" and related names.

For simplicity I refer to:

1. the Complainants jointly as the Complainant; and
 2. the DRS18316 Respondent and the DRS 18320 Respondent jointly as the Respondent,
- unless stated otherwise.

The Complainant exhibited financial results from the early 1970s to 2015. The group's consolidated financial results indicate net sales for the group of around 729,000 million yen (approximately £5,500 million) in 2014 and 623,000 million yen (approximately £4,712 million) in 2015.

The Respondent supplies parts for a variety of products including Fanuc parts for the Complainant's machines. The Respondent uses the Domain Names for websites offering spares and repairs for the Complainant's FANUC products.

The Respondent registered the first Domain Name on 16 January 2002 and the second Domain Name on 5 July 2001.

5. Parties' Contentions

The Complaint

Complainant's Rights

The Complainant's assertions of rights in the name FANUC are:

1. The name FANUC is a coined term derived from "Factory automation numerical control".
2. The Complainant owns a portfolio of trade marks for FANUC including the following:
 - a. UK trade mark number 910676 dated 13 June 1967 - word mark for FANUC in class 9;
 - b. UK trade mark number 1182663 dated 1 October 1982 - word mark for FANUC in class 7;
 - c. UK trade mark 2337783 dated 15 July 2003 - word mark for FANUC in classes 7 and 9; and

- d. International trade mark no. 948323 designating the EU dated 11 June 2007 - word mark for FANUC in classes 7, 9, 37 and 4.
3. The Complainant's main websites are at:
 - a. www.fanuc.eu/uk/en/robots - the site includes the Complainant's distinctive red "FANUC" logo on a yellow bar comprising the header of the page;
 - b. www.fanuc.co.jp, to which www.fanuc.com redirects.
4. Both Domain Names are similar to the Complainant's FANUC trade mark, disregarding the domain suffix. The Domain Names wholly incorporate the trade mark and differ only by addition of the generic word "parts" with a hyphen in between the words "Fanuc" and "parts" and by addition of the generic word "spares" with a hyphen in between the words "Fanuc" and "spares".
5. The Complainant says that the terms "parts" and "spares" in each case fail to dispel the connection between the relevant Domain Name and the trade mark; indeed it reinforces the link as the word "parts" and "spares" are each apt to denote an aspect of the Complainant's services. The Complainant's trade mark remains the dominant feature of each Domain Name.
6. The Complainant also asserts common law rights by virtue of its trading and marketing activities which, it says, have acquired substantial reputation and goodwill in the name FANUC such that it is recognised by the public as distinctive of the Complainant's business of providing automation products and services such as robotics and cnc systems.

Abusive Registration

The Complainant's assertions of Abusive Registration are:

1. The Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its trade marks.

The website at www.fanuc-spares.co.uk

2. As of 4 August 2016, there was a website available at www.fanuc-spares.co.uk offering spare parts and repairs for the Complainant's systems as well as those of the Complainant's competitors. This includes links and references to Mitsubishi, "Okuma", "Indramat" and "Gettys". These companies are all competitors of the Complainant.

3. The home page of the website at www.fanuc-spares.co.uk also includes a prominent link to "CNC Related Links". This includes a long list of CNC-related goods and services including those supplied by competitors of the Complainant or relating to competitor products.
4. Apart from the homepage the Complainant notes that all the above-mentioned pages on the site are based on the Complainant's distinctive yellow and red branding and exhibits a comparison with the Complainant's own website.
5. Appearing prominently in the centre of the home page is a yellow bar on which the words "CLICK HERE TO REQUEST QUOTE" appear in a red typeface, which the Complainant says is based on the Complainant's distinctive yellow and red branding.
6. The home page includes a disclaimer part way down the page: "*We are an Independent Company. We are not affiliated to Fanuc Ltd*". The Complainant suspects that this disclaimer has been moved up the page in response to correspondence from the Complainant since the archive version of the homepage dated 29 January 2014 has the disclaimer appearing near the bottom of the page.

The website at www.fanuc-parts.co.uk

7. As at 25 August 2016 there was a website available at www.fanuc-parts.co.uk offering spare parts and repairs for the Complainant's systems as well as those of its competitors. This includes links and/or references to "Siemens", "Indramat", "Bosch", and "GE 2000". These companies are all competitors of the Complainant.
8. Appearing prominently in the centre of the home page is a yellow bar on which the words "CLICK HERE TO REQUEST QUOTE" appear in a red typeface, which the Complainant says is based on the Complainant's distinctive yellow and red branding.
9. A previous version of the homepage dated 24 July 2013 has no disclaimer on the home page, just a link in the footer to "Disclamer" on a separate page.

Disruption

10. The Respondent registered the Domain Names for the purpose of unfairly disrupting the business of the Complainant by using its name to attract traffic to its websites at which it offers services relating to products competing with those of the Complainant. The Respondent was aware of the Complainant and its business when it registered the Domain Names.

Confusion

11. Paragraph 4.8 of the DRS Experts' Overview sets out the principles applicable in "reseller" cases as summarised by the appeal panel in toshiba-laptop-battery.co.uk (DRS 07991):
 - a. 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.
 - b. 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.
 - c. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.
 - d. 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.
12. In this case the Respondent has set out to falsely imply a commercial connection with the Complainant by:
 - a. copying and using the Complainant's red/yellow colour scheme and typeface on both sites (as explained above) to try and give the impression that it is, or is officially connected with, the Complainant; and
 - b. initial interest confusion and, in particular use, of the Complainant's trade mark plus an appendage which is highly appropriate to the Complainant's field of activity (as set out in paragraph 3.3 of the DRS Experts' Overview).
13. In the case of initial interest confusion, the confusion has already arisen by the time that the users arrive at the site and the disclaimers are therefore irrelevant. In any case, as demonstrated above, there were earlier versions of both websites in which the disclaimers were either at the bottom of the page or on a different page entirely and therefore unlikely to have been seen by most users.
14. Furthermore, the Respondent is using the Domain Names to offer repairs and spares for competitor products. This is of itself unfair irrespective of any implied commercial connection, as indicated in toshiba-laptop-battery.co.uk decision. The toshiba-laptop-battery.co.uk approach is based partly on the UDRP Oki

Data principles in the UDRP as to which a UDRP panel stated in Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052 regarding the domain names <controltechniques-repairs.com> and <controltechniques-spares.com>:

"It is clear, therefore, that the Respondent cannot bring itself within the Oki Data principles, for it is trading on the Complainant's trademark to promote its own services and to enhance the products of business rivals of the Complainant by offering to service their competing products and sell their competing spare parts."

15. The Complainant contends that such behaviour is equally unfair, and abusive, under the DRS - in line with toshiba-laptop-battery.co.uk.

Other factors

16. On 13 February 2014, the Complainant's solicitors sent a cease and desist communication relating to the Domain Names and four other FANUC-related domains owned or controlled by the Respondent: fanuc-parts.co.uk [sic], fanucspares.com, fanuc-spares.com and fanuc.li. The Respondent replied the same day. Without attempting to offer any defence or explanation, he stated that he would not be prepared to transfer the Domain Names to the Complainant, although he would be willing to transfer the other domains because he said he did not use them. However, when the Complainant's solicitors asked for the transfer of those other domains to be effected the Respondent replied that it would be necessary to come to some agreement about the Domain Names before he would agree to the transfer.

17. The Complainant also relies on the fact that the Respondent has not denied abusive registration in its communication of 13 February 2014 let alone attempted to justify its registration and use of the Domain Names.

18. The Complainant refers to the above as evidence that the Respondent has also engaged in a pattern of similar abusive behaviour.

Previous DRS and WIPO decisions

19. The Complainant refers to the previous DRS decision in gefanuc.co.uk (DRS 77 - 10 January 2002) in which a predecessor of the Complainant (during a period when the Complainant's group was merged with GE) filed a successful DRS complaint against Pennine Automation Limited, of which the Respondent was a director. In this case the expert concluded that:

- a. The domain name gefanuc.co.uk, which was being used to offer spares for the complainant's own products only, was abusive on grounds of initial interest confusion and that the respondent had set out to take advantage of the complainant's goodwill in an unfair manner. The expert also noted that the respondent also operated a site at www.fanuc-spares.co.uk and could have used that domain if it merely wished to associate its site with the complainant's products, noting that that domain did not specifically denote "GE Fanuc" which was the name relied upon in that case. The Complainant submits that that obiter comment is of no assistance to the Respondents in this case, given their use of fanuc-spares.co.uk in a plainly abusive manner.
 - b. The domain name had been registered abusively under 3(a) (i) (A) of the Policy in that the respondent admitted that onward sale of the domain name was within its contemplation on registration and that it sought £60,000 in communications with the complainant. The expert dismissed the claim that the offer constituted Mr. Ginley's personal views rather than the official position of the respondent, of which he was a director.
 - c. The domain name gefanuceur.net had been registered to "raise the stakes" in the communications with the complainant and that this was a further factor pointing towards abusive registration. The expert dismissed the respondent's claim that it did not own gefanuceur.net, given that Mr. Ginley was the registrant.
 - d. The Respondent registered and used gefanuc.co.uk abusively both to create initial interest confusion and to sell to the Complainant for some £60,000.
20. The Respondent has been found to have registered and/or used three other Fanuc- related domains in bad faith in proceedings brought by the Complainant: see WIPO Case No. D2015-1387 relating to the domains fanuc-repairs.repair, fanuc-spares.com and fanucspares.com. The Respondent was found to have registered and used these domains in bad faith in circumstances very similar to those arising here including use for services relating to products of the Complainant's competitors.

Delay

21. Finally, the Complainant raised the issue of delay in raising this Complaint.

22. The Complainant acknowledges that it has taken some years for the Complainant to file this case. It says that the reason is simply that the Complainant lost focus on the domains through various corporate restructurings and personnel changes and it is only relatively recently that the Complainant has systematically addressed infringements such as this (including the other infringements by the Respondent referred to above).
23. The Complainant notes that the Appeal Panel considered the question of delay in starwars.co.uk DRS 15788 and concluded that, where the use complained of was ongoing, then delay alone should not automatically preclude a complaint being brought but, nonetheless, delay in a particular case might mean that an otherwise abusive registration was acceptable, in particular if the respondent had been unfairly prejudiced. The Panel considered various cases relating to laches, emphasizing the need for circumstances rendering it unconscionable for a complainant to act now, rather than mere delay or acquiescence.
24. The Complainant contends that there are no such circumstances here. The Respondent has not been prejudiced in any way. As in starwars.co.uk, the Domain Names are amongst multiple satellite domains operated by the Respondent in order to capitalise on the Complainant's name. The Respondent's main site is at www.pennineuk.com, through which it operates exactly the same business as it is carrying on (illicitly) at the Domain Names and via which it can readily continue to carry on its trade.
25. The Complainant says it has not done anything which renders it unconscionable for it to pursue the case now. The Complainant has not encouraged the Respondent in any way, or given the Respondent any reason to think that it would not take action. On the contrary, it was clear to the Respondent from the gefanuc.co.uk case back in 2002 that the Complainant in no way condoned misuse of its name.

The Response

The Respondent's responses to the two complaints can be summarised as follows:

Fanuc-spares.co.uk response

1. The Respondent says it is accused of copying and using a red/yellow colour scheme and typeface on the Domain

Name. It submits a screenshot to show that the background yellow is not intended to be a Fanuc yellow but is just a duck egg colour. Also, there is no typeface similar to Fanuc on the page and the Respondent has used a "P" logo for Pennine followed by the website address. Furthermore, there are no Fanuc logos on the website. Finally, the Respondent notes that its company name and address is on every page of the web site. The Respondent provides a screenshot of the www.gefanuc.com website from around the same time as its website was built to illustrate the difference between the fonts/typeface and colour scheme.

2. The Respondent says that the following paragraph has always been displayed high on the index page and notes that it uses the word "source" which indicates the Respondent can find the parts, not that it is the suppliers of the original parts:

"Welcome to the best place to source GE Fanuc, Fanuc Parts, Fanuc Amplifier Modules, Fanuc Exchange & Second User Fanuc Boards, Fanuc Alpha, Fanuc Encoders, New and Used Fanuc Motors, Drives and Control Cards + other CNC Spare Parts. Many Surplus Items Stocked Are On Long Deliveries From the OEM - Please browse our lists of machine tool replacement Parts Including: Indramat, Okuma electronics, Mitsubishi Spares Which Change Daily - if we don't stock the parts what you need then please ask"

3. It is not illegal to sell Fanuc spare parts.
4. The Complainant says that the Respondent's website has links relating to the Complainant's competitors. The Respondent says that if it was pretending to be Fanuc it would not have not included these; these are part of our business as a CNC parts supplier who is using this website to advertise its Fanuc parts for sale.
5. The Respondent says if the Complainant was keen to take action why has it waited 15 years to pursue an old website?
6. The Respondent says that the website www.fanuc-spares.co.uk was chosen as it best describes what it does as an independent spares company.

Fanuc-parts.co.uk response

1. The Respondent says that Pennine Automation were approved Fanuc retrofit partners and were one of the biggest Fanuc retrofitters in Europe from the late 1980s to 2005 and fitted more Fanuc CNC controls than any

other company in the uk. and were listed on Fanuc's web site with its contact details as approved Fanuc retrofit partners.

2. The website at the Domain Names have the same design now as they did 16 January 2002 and the Respondent has been using them in the same way for the last 15 years.
3. The Complainant's sales revenue is not relevant.
4. The yellow on the background of the website is not the same as the yellow on the Complainant's website(s).
5. The Complainant's solicitor sits on the Nominet DRS panel.
6. The Respondent replies to a paragraph in the Complaint that deals specifically with fanuc-spares.co.uk:

The Complainant said:

"The home page of the website at www.fanuc-spares.co.uk also includes a prominent link to "CNC Related Links" which leads to the page. This includes a long list of CNC-related goods and services including those supplied by competitors of the Complainant or relating to competitor products."

The Respondent replied:

"The links on this page are mostly companies that we have traded links with for the purpose of SEO and are not competitors."

7. The Complainant said in respect of fanuc-parts.co.uk:

"Again, appearing prominently in the centre of the home page is a yellow bar on which the words "CLICK HERE TO REQUEST QUOTE" appear in a red typeface, clearly based on the Complainant's distinctive yellow and red branding."

The Respondent replied that it is only meant to stand out and the website looks nothing like the Complainant's; it is blue and white and does not use the Complainant's logos.

The Reply

The Complainant replied to the responses as follows:

Fanuc-spares.co.uk reply

1. While the yellow background found on the Respondent's website at fanuc-spares.co.uk is a lighter shade of yellow than that of the Complainant's site, the Respondent's prominent use of red, together with the

yellow background, shows that it was out to ape the Complainant's site.

2. It is not claimed that the Respondent has used the exact FANUC logo on the Website. However, the Respondent's use of red on yellow includes a dark red bold font which is identical, or at least very similar, to the font used for "FANUC" in the Complainant's logo, such as the sentence starting "Fanuc cables...". The Complainant says that this was clearly designed to evoke the Complainant's branding.
3. The evidence submitted by the Respondent in fact supports the Complainant as it demonstrates that the blue and white colour scheme, and indeed layout, of the homepage of the website at fanuc-spares.co.uk was based on the website of GE FANUC, the Complainant's predecessor. There are striking similarities between both sites. The Respondent has used a very similar colour palette to the Complainant's site. The Complainant notes also the splash of red / yellow on each site (FANUC logo v FANUC quotation request bar).
4. The Complainant says that the Respondent's uses the subtle word "source" on the website at fanuc-spares.co.uk does not negate the overall impression that the site is officially connected with the Complainant created by the aping of the Complainant's colour schemes etc. Furthermore, the Complainant has also relied on initial interest confusion in which case the confusion has already arisen by the time that users arrive at the site. In any case, as set out in the Complaint, the Respondent has acted unfairly, irrespective of any implied commercial connection, in that it offers spare parts and repairs for competitor products.
5. The Complainant does not say that it is illegal for the Respondent to sell Fanuc spare parts. It is the way that the Respondent has used the domain names to do so that is the issue, including use of the website at fanuc-spares.co.uk to offer repairs and spares for competitor products.
6. The Respondent has accepted that it supplies parts for competitors of the Complainant's products, as well as for the Complainant's systems. As such it is not the case that the Domain Name fanuc-spares.co.uk "best describes what we do as an independent spares company", as submitted by the Respondent. Furthermore, the Complainant says that the inclusion of the name "Fanuc" in the domain name as well as the nature of the Respondent's website imply that the Respondent is not independent, but rather that it is associated with the Complainant.

Fanuc-parts.co.uk reply

1. Although Nominet have treated this Complaint as applying only to fanuc-parts.co.uk, the Complainant expected it to be consolidated with DRS 18320 and as the Respondent mentioned both Domain Names in its response, the Complainant deals with both in the reply.
2. The Complainant has never had a contractual relationship with the Respondent.
3. Having carried out enquiries, the Complainant has established that the Respondent was a customer of a FANUC group company GE Fanuc Automation CNC UK Ltd. However, the Complainant has not been able to verify the Respondent's claim that it was an "approved retrofit partner". The Respondent has provided no evidence in support of this, or indeed of any of its other claims including as regards the extent of its alleged dealings in the Complainant's products.
4. In any case, the Complainant says that this is not relevant. The Respondent has not suggested, let alone supplied evidence, that the Complainant, or any companies in its group, have ever authorised the Respondent's activities at the Domain Names.
5. The Respondent has provided no evidence in support of its claim that the design of the websites has remained unchanged since 2002. On the contrary, the Complainant provides evidence that the design of www.fanuc-spares.co.uk has changed in, the Complainant says, a material way in that the disclaimer was moved from the bottom of the page in 2014 to its current position part way down the homepage. The position is similar on www.fanuc-parts.co.uk where there is a disclaimer on the current homepage website but, in 2013, it was on a different page as exhibited.
6. Information relating to the Complainant's financial position was included in connection with establishment of the Complainant's rights.
7. The yellow background on the Respondent's websites is a lighter shade of yellow than that of the Complainant's website, but the Respondent's prominent use of red shows that it was out to ape the Complainant's website. In addition, as admitted by the Respondent, it principally uses the colours blue and white on its homepages, so accordingly there is no reason to switch to a completely different yellow / red colour scheme on other pages other than to connect them in the minds of consumers with the Complainant.

8. The complainant says that it is clear that the yellow / red "CLICK HERE TO REQUEST QUOTE" bar was designed to evoke the Complainant's branding. There are multiple ways that the Respondent could have highlighted this information without adopting the Complainant's colours and typeface.
9. Even if it is the case that the companies listed on the "CNC Related links" page are mostly not competitors of the Complainant, the Respondent has not disputed the numerous other links to competitors of the Complainant including on the homepages of both websites.
10. Finally, the Complainant notes that the Respondent has not contested most of the points raised in the Complainant in relation to abusive registration including as to the unfairness of its use of the Domain Names for competitor products, its previous pattern of misconduct vis-à-vis the Complainant and delay.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2.1 and 2.2 of the Policy, both limbs of the test that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

Rights is defined in §1 of the Policy as "*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 wholly generic suffixes ".co.uk" and ".uk" may be discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has evidenced registered and unregistered rights in the name FANUC.

Each Domain Name comprises the name FANUC with the everyday dictionary word "parts" or "spares" respectively, and in each

case linked by a hyphen. I accept the Complainant's assertion that the word "parts" and "spares" fails to dispel the connection between the relevant Domain Name and the trade mark FANUC and reinforces the link in that the word "parts" or "spares" denotes an aspect of the Complainant's services. I note also that Respondent has not denied the Complainant's assertions.

For the purposes of the first limb of the test in §2.1.1 of the Policy, I find that the Complainant has Rights in the name FANUC which is similar to each of the Domain Names.

Abusive Registration

Abusive Registration is defined in §1 of the Policy 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §5.1 of the Policy:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 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;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.4 It is independently verified that the Respondent has given false contact details to us;

5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively; and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.

Before considering with Abusive Registration, I will deal with three issues:

The Complainant's solicitor sits on the Nominet DRS panel

I fail to see the relevance of the Respondent's reference to this fact unless he is implying that the Expert in this Complaint will favour the Complainant? If this is the Respondent's point then I refer him to the Nominet DRS website at www.nominet.uk/domains/resolving-uk-domain-disputes-and-complaints/ and the reference to the appointment of an Expert, namely:

*"... the Complainant has the option of paying a fee to appoint an **independent** adjudicator, called the Expert to make a binding decision about what should happen to the domain name."* [emphasis added]

The Expert is not employed by Nominet and has no relationship with the other independent experts appointed to the DRS panel of Experts. Furthermore, the Expert makes a declaration to the parties to a dispute under the DRS that he or she is independent of the parties, and thereafter makes a decision in the dispute solely on the basis of the papers before him or her in accordance with the Policy.

Delay

Unlike the Star Wars dispute, the Respondent has not raised an argument as to the issue of delay save for a question as to why the Complainant waited 15 years, in one response, and an oblique reference to it in its assertion in the other response that the website at the fanuc-parts.co.uk has the same design now as it did on 16 January 2002, and that the Respondent has been using it in the same way for the last 15 years. In its Reply, the Complainant notes one instance where the Respondent's latter statement is incorrect.

Given the opportunity to do so on two occasions (in DRS18316 and in DRS18320), the Respondent failed to respond to the Complainant's explanation for delay and its application of the Star Wars appeal panel decision.

The Complainant's explanation (that it lost focus on the Domain Names through various corporate restructurings and personnel changes and it is only relatively recently that the Complainant has systematically addressed infringements such as this) is plausible. But I still find it surprising that the Complainant was aware of the Respondent having fanuc-spares.co.uk in 2002, as it was registered the previous year and it was referred to in DRS 77 in January 2002. However, I note that in DRS 77 the reference to fanuc-spares.co.uk was to the Respondent's statement that the website at the domain name in that dispute (gefanuc.co.uk) "*will change soon to www.fanuc-spares.co.uk*" suggesting that it was not in operation at the time of DRS 77.

I have considered the findings of the appeal panel in the Stars Wars appeal (DRS 15788), in particular where the panel said that where the use complained of was ongoing, then delay alone should not automatically preclude a complaint being brought but, nonetheless, delay in a particular case might mean that an otherwise abusive registration was acceptable, in particular if the respondent had been unfairly prejudiced. I also considered the Panel's emphasis of the need for circumstances rendering it unconscionable for a complainant to act now, rather than mere delay or acquiescence. I find no such circumstances in the papers before me nor do I find any unfair prejudice to the Respondent.

Accordingly, I accept the Complainant's explanation and I conclude that the Respondent has not been prejudiced in any way by the delay.

UDRP disputes

In the Expert's Overview guidance document participants to a DRS dispute are warned:

"Finally, it should be stressed for the benefit of those who have had experience of domain name disputes under the Uniform Domain Name Dispute Resolution Policy ("UDRP"), that the DRS Policy and the UDRP are different systems. In some places they share very similar wording, but there are significant differences and the citation of UDRP decisions in a dispute under the DRS Policy is rarely likely to be helpful."

Ordinarily, the quoting of UDRP cases is irrelevant to a dispute under the DRS Policy. In this case, however, the Complainant has made out its case without relying on the objectionable use of extensive quoting of UDRP cases. The use of such references in this Complaint is to evidence the Respondent's use of the name FANUC in other domain names that were the subject of dispute resolution under the UDRP. Accordingly, I accept their inclusion as background evidence of the Respondent's propensity to use the name FANUC in its domain names without relying on the decisions reached in such cases.

Abusive Registration

Turning now to consideration of the submissions in respect of Abusive Registration, I am rather surprised that having been given two opportunities to respond to the relatively detailed Complaint, the Respondent does not deal with the majority of the Complainant's assertions.

In particular, the Respondent makes little or no reply to the appeal panel's findings in *toshiba-laptop-battery.co.uk* (DRS 07991). The Respondent's focus on background colours and fonts, its un-convincing argument around "sourcing" as opposed to being the supplier of the parts, and its bizarre argument that if the Respondent was trying to appear to be connected to or authorised by to be the Complainant then it would not have included links to the Complaint's competitors, offer little to counter the Complainant's reliance on the Toshiba batteries case.

I find the appeal panel's findings in the Toshiba batteries case compelling in this dispute. On the papers before me, and the Respondent's failure, in the main, to dispute or counter the evidence submitted by the Complainant, I conclude that the Respondent's use of the Domain Names was and is predominantly to falsely imply a commercial connection with the Complainant which is the result of initial interest confusion, the content of each website at the Domain Names, and the offering of goods of the Complainant's competitors. I accept the unchallenged basis of Abusive Registration made out by the Complainant by way of reference to the Toshiba batteries case.

I also accept the Complainant's point that the colours and fonts used at the websites do in fact appear similar to the gefanuc.co.uk website. I note that the Respondent registered the Domain Name fanuc-parts.co.uk six days after the decision in DRS77 in which the expert ordered the transfer of gefanuc.co.uk from the Respondent to the Complainant's predecessor and I do consider that on the balance of probabilities the two are linked, supported by the Respondent's unchallenged history of use of the Complainant's mark FANUC in domain names which paints a compelling background picture in support of this Complaint.

Accordingly, I find that the Respondent's registration and use of the Domain Names have taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights, and each is therefore an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Names, and that both Domain Names, in the hands of the Respondent, are Abusive Registrations, I direct that both Domain Names be transferred to the Complainant.

Signed

Dated: 27th March 2017

Steve Ormand