

DISPUTE RESOLUTION SERVICE

D00020598

Decision of Independent Expert

Acer U.K. Limited

and

PC TECH SOLUTIONS Ltd.

1. The Parties:

Lead Complainant: Acer U.K. Limited
Acer House
Heathrow Boulevard 3
282 Bath Road
West Drayton
Middlesex
UB7 0DQ
United Kingdom

Complainant: Acer Incorporated
7F-5, No. 369, Fuxing N. Rd., Songshan Dist.,
Taipei City, 105
Taiwan, Province Of China
Taiwan

(together "the Complainants")

Respondent: PC TECH SOLUTIONS Ltd.
90 Dunster Place
Coventry
London
CV6 4JE
United Kingdom

2. The Domain Name:

acer-support.uk

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.

10 September 2018 11:11 Dispute received
12 September 2018 13:17 Complaint validated
12 September 2018 13:25 Notification of complaint sent to parties
01 October 2018 02:30 Response reminder sent
04 October 2018 10:13 No Response Received
04 October 2018 10:13 Notification of no response sent to parties
16 October 2018 02:30 Summary/full fee reminder sent
17 October 2018 13:09 Expert decision payment received

4. Factual Background

- 4.1 The Complainants are Acer Incorporated and Acer U.K Limited.
- 4.2 Acer Incorporated was founded in 1976 and is incorporated in Taiwan. It manufactures and supplies computers, laptops, notebooks, tablets, gaming devices, servers, storage devices, virtual reality devices, displays, smartphones, computer hardware and consultation, information, advisory, support and maintenance in the advanced electronics technology and information technology sectors. It started life as "Multitech" and was re-named "Acer" in 1987.
- 4.3 Acer U.K Limited (the Lead Complainant) was incorporated on 9 May 1988 under company number 2252821. It has traded in the UK under the ACER trademark since at least 9 May 1988.
- 4.4 Acer Incorporated is the registered proprietor of, *inter alia*, United Kingdom trademarks and European Union trademarks for the mark ACER and acer (stylised). These are set out below.

Mark	Trade Mark Number	Date of Filing	Classification/s
ACER	UK00001304673	20 March 1987	Class 9
ACER	UK00002117054	29 November 1996	Classes 35, 39 and 42
ACER	EU000653691	7 October 1997	Class 9
acer (stylised)	EU001865120	12 September 2000	Classes 9, 35 and 42
acer (stylised)	EU004883377	27 January 2006	Classes 2, 9, 35 and 38

acer	EU009793738	8 March 2011	Class 9
Acer	EU009842311	25 March 2011	Class 9, 35 and 42

- 4.5 The Complainants have made extensive use of the mark ACER worldwide, including in the UK, with regards to 'computer hardware, computers, computer peripherals, apparatus and instruments all for use with computers' and 'consultation, information, advisory, support and maintenance services relating to computer hardware, firmware, peripheral devices, software, computer software systems and programs, and global computer information networks'.
- 4.6 The Respondent is a company incorporated in England and Wales. It registered the Domain Name on 9 January 2017.
- 4.7 The Respondent has used the Domain Name to link to a website which offers "immediate support service" by "certified technical experts" for Acer laptops, although currently the Domain Name does not link to any website.

5. Parties' Contentions

Complainants' Submissions

The Complainants submit as follows:

Rights

- 5.1 They are a long-established and very well-known multinational business active among many other things in the manufacture of computer hardware and in related support and maintenance services.
- 5.2 Their products are marketed globally through an expansive network of authorised dealers located throughout the world, including the United Kingdom, and are extensively promoted under, inter alia, the mark ACER on the internet.
- 5.3 Due to extensive trading, they have built up a significant reputation in relation to the computer related goods and services, worldwide and including the UK.
- 5.4 The Complainants therefore submit that they have Rights in the name ACER for two main reasons:
1. their extensive use of the mark ACER for a significant period;
 2. their registration of a number of trade marks, including the mark ACER.

- 5.5 The Domain Name is similar to the name or mark ACER because it consists of the mark ACER in its entirety followed by the term "support" and the non-distinctive, generic domain name suffix .uk.

Respondent's activities

- 5.6 The Respondent registered the Domain Name on 9 January 2017, long after the Complainants established their Rights in the name or mark ACER. The Respondent uses the Domain Name to point to a commercial website offering exclusive, "Acer Online Technical Support".
- 5.7 This website also prominently uses the Domain Name as a trade name in the upper left hand corner of the site, in the text (such as Acer Online Technical Support, Acer Customer Service and Acer Laptop Support on the home page), and in the Privacy Policy, Refund Policy and Terms and Conditions notices on the website.
- 5.8 The Respondent's website has the following rolling disclaimer at the right-hand side of the home page:

"DISCLAIMER: Acer Support is a Third Party Technical Service provider giving expert solutions for the problems arising in your printer, laptop, browser, email, social networking accounts and antivirus program, etc. With the assistance of our highly trained and experienced team of technical experts we provide round the clock assistance for the technical problems faced by you in using any of these products or services. However, all the brand names, logos, company names, trademarks and other insignias belong to their respective owners and they are being displayed on Acer Laptop Support only for representational purposes. We hold no affiliation to these companies in any manner until and unless it is expressly mentioned anywhere on our website. Acer Support experts provide instant technical support to the customers through phone support or via remote access of the device for all software, firmware and driver related issues."

Abusive Registration

- 5.9 The Complainants submit that the use of the Domain Name by the Respondent is unfairly detrimental to the Complainants' Rights.
- 5.10 The Complainants submit that the Domain Name is an Abusive Registration because it is identical and/or confusingly similar to the name or mark, that the Respondent has no rights or legitimate interests in respect of the Domain Name and that the Respondent has registered and is using the Domain Name in bad faith, because the attachment of the word "support" to the ACER mark suggests that the site is operated by the Complainants or is an authorised representative of the Complainants.

- 5.11 The Complainants contend that the Respondent's unauthorised use of the name or mark ACER, in the form of Acer Online Technical Support, unauthorised use of an image including the Complainants' stylised acer mark, a blog referring to and discussing Acer laptop products, the reference to "Acer Laptop Support", "Acer Customer Issues", "Acer UK Support", "The reasons to choose Acer Support UK" and the "Acer Service" tab are likely to confuse, and may have already confused people into thinking it was controlled by the Complainants.

Respondent

No Response has been filed by the Respondent.

6. Discussion and Findings

- 6.1 Paragraph 2 of Nominet's Dispute Resolution Policy ("DRS Policy") requires that the Complainants must prove, on the balance of probabilities, 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

Rights

- 6.2 As a first step, I must therefore decide whether the Complainants have Rights in respect of a name or mark which is identical or similar to the Domain Name.

- 6.3 The definition of Rights in the DRS Policy is 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.

- 6.4 I have no doubt that the Complainants have Rights in the word or mark, ACER. The Complainants are the registered proprietors of a number of UK and EU trademarks for the mark ACER. It is also clear that the Complainants have been using the name or mark, ACER in relation to its offering of computer products and computer support services for over thirty years. They own the domain name <acer.com> and have amassed an impressive amount of advertising over the last 30 years at least.

- 6.5 The name or mark in which the Complainant has Rights, i.e. ACER, differs only from the Domain Name by the addition of the word "support" in the Domain Name, (ignoring the ".uk" suffix for this purpose). The

addition of “support” does little to distinguish the Domain Name from the mark and is purely descriptive. Put another way, it is the word “Acer” which is the distinctive or trade mark part of the Domain Name. I therefore conclude, on the balance of probabilities, that the Complainants have Rights in a name or mark which is similar to the Domain Name.

Abusive Registration

6.6 Under Paragraph 1 of the DRS Policy, “Abusive Registration” is defined 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.*

6.7 This definition requires me to consider whether the Domain Name is an Abusive Registration either at the time of registration/ acquisition or subsequently through the use that was made of it. Paragraph 5 of the DRS Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 8 of the DRS Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.

6.8 The Policy requires the Complainants to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainants.

6.9 Potentially the most relevant factor in the present case is set out in Paragraph 5.1.2 of the Policy and is as follows:

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.

6.10 In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainants’ Rights. In some cases where the name in which the Complainant(s) Rights are particularly well known, this would be fairly obvious and straightforward while in other cases where the name in which the Complainant(s) has Rights, is less well known and/or

where there are other meanings or uses which can be made of the name, this will require substantial evidence from the complainant.

- 6.11 I have no doubt that the current case falls firmly into the former category, i.e. the name or mark in which the Complainants have rights, i.e. ACER, is very well known and there is no doubt at all that the Respondent knew about those Rights when it registered and used the Domain Name. Indeed, the very nature of the services that the Respondent has been offering from a website linked to the Domain Name, i.e. support services for Acer products, is evidence of that.
- 6.12 Here, however, the question is not one of the Respondent's knowledge of the Complainants' Rights, but more a question of whether visitors to the Respondent's website will be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants, i.e. whether the Domain Name is an Abusive Registration under Paragraph 5.1.2 of the Policy.
- 6.13 This or at least a similar issue, has been the subject of a number of decisions under Nominet's DRS and it is convenient to quote from Nominet's DRS Experts' Overview on this point as follows:

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 an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or 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 the High Court decision *Och-Ziff Management Europe Ltd v Och Capital LLP* [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being "a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant's conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase". In that case the court held that initial interest confusion is legally actionable under European trade mark legislation.*

In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privalege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decisions in DRS 00248 (seiko-shop.co.uk) and DRS 07991 (toshiba-laptop-battery.co.uk).

6.14 It is also convenient to look at the Decision of the DRS Appeal Panel in the Toshiba-Laptop-Battery case where the principles to be followed in this kind of case were neatly summarised as follows:

- 1. It is not automatically unfair for a re-seller 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 re-seller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the Respondent's website.*

6.15 I should say that in this case that there is no suggestion whatsoever that the Respondent has been offering (or indeed referring to in any way) competitive goods (or services) on its website and the website to which the Domain Name is linked refers only to the servicing of the Complainants' products. It is also important to take into account that, as far as I can tell, a disclaimer appears prominently on each page of the website and that disclaimer makes it clear that the Respondent is a "Third Party Technical Service provider".

6.16 These are therefore factors which I must bear in mind when assessing whether or not the Domain Name is an Abusive Registration and specifically in deciding whether the Respondent's use of the Domain Name falsely implies a commercial connection with the Complainants. In other words, would someone visiting the website of the Respondent

believe that it is in some way connected with the business of the Complainants (in the sense of being authorised by the Complainants)? In making this assessment it is open to me to consider both initial interest confusion (as discussed above in the Expert's Overview) and the content of the website.

6.17 A relevant factor here is the nature of the Domain Name. It includes the name or mark in which the Complainants have Rights together with the single word, "support". "Support" is a descriptive word which could be readily used to describe the kind of services that the Complainants' provide in relation to their goods. In my view, and very much on the balance of probabilities, when taken as a whole, this is the kind of domain name which the public are likely to see as being something official and connected to (authorised by) the Complainants. In other words, an internet user is likely to look at the Domain Name and believe it is owned by or connected to the Complainants. It feels to me like the kind of Domain Name that a business such as the Complainants would naturally have and I think that an internet user would come to the same conclusion. By contrast, if the Domain Name had been something like "we-provide-ACER-support.co.uk" or even "unofficial-ACER-support" then it would have been much less likely to be taken as an official site of the Complainants.

6.18 I find therefore, on the balance of probabilities, that the nature of the Domain Name is such that it is likely to be either typed into a browser by an Internet user guessing what the Complainants' official support site may be or, alternatively, an Internet user may arrive at the site having typed words such as "Acer" and "support" into a search engine. In each case, "initial interest confusion" would occur.

6.19 Having found that initial interest confusion has occurred, I do not find it necessary to go onto look at the content of the site to decide whether or not the user would continue to be confused, indeed, as the DRS Appeal Panel said in *Rayden Engineering Limited v Diane Charlton* DRS 06284, "*....by the time the user reads the disclaimer, or realises from the content of the website that it is not what he was looking for, the damage is done and the advantage sought by the respondent is achieved*".

7. Decision

I find that the Complainants have Rights in a name or mark which is identical or similar to the Domain Name. I also find that, on the balance of probabilities, the Complainants have established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Lead Complainant.

Signed

Dated