

## DISPUTE RESOLUTION SERVICE

DRS 7720

Decision of Independent Expert

Zebra Technologies Europe Ltd

and

Eagle Technologies Ltd

### 1. The Parties:

Lead Complainant: Zebra Technologies Europe Ltd  
47 Castle Street  
Reading  
Berkshire  
RG1 7SR

Second Complainant: ZIH Corporation  
3<sup>rd</sup> Floor, HM08  
3 Gorham Road  
Pearman Building  
Hamilton  
Bermuda

Third Complainant: Zebra Technologies Corporation  
Suite 500  
475 Half Day Road  
Lincolnshire  
Illinois  
60069  
United States

Respondent: Eagle Technologies Ltd  
17 The Western Centre  
Western Road  
Bracknell  
Berkshire  
RG12 1RW

## 2. The Domain Names:

zebracardprinter.co.uk  
zebracardprinters.co.uk

## 3. Procedural History:

The complaint dated 10 September 2009 was received by Nominet on the same day. It was supported by material in ten exhibits:

- A UK and European 'ZEBRA' trademarks held by the Second Complainant
- B Waybackmachine search summary for zebra.com
- C Companies' House record for the Lead Complainant
- D Waybackmachine search summary for zebracard.com
- E Waybackmachine search summary for zebracardprinters.co.uk
- F Printout of the webpages at zebracardprinter.co.uk from 9 June 2009
- G Letter dated 19 June 2009 to the Respondent from lawyers acting for the Complainants
- H As at A above, plus print outs from webpages at the domain names
- I Printout of webpages at zebracardprinter.co.uk and zebracardprinters.co.uk from 26 October 2009
- J Printouts from the Respondent's website at the domain name eagletechnologies.co.uk from 26 October 2009

Nominet checked that the complaint complied with the Dispute Resolution Service Policy ('the Policy) and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure') and on 18 September alerted the Respondent. A response dated 14 October was received on 19 October. The Complainants' reply was received on 27 October. Informal mediation came to an unsuccessful conclusion on 15 February 2010. On 2 March Nominet received the fees for an Expert decision.

On 2 March I, Mark de Brunner, agreed to serve as an expert under Nominet's Dispute Resolution Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

## 4. Factual Background

I have visited the webpages at the domain names and followed links through to the Respondent's main website at eagletechnologies.co.uk. I have also visited the Complainants' websites at zebra.com, zebracard.com and zebracard.co.uk. From those visits, the complaint, the response, the reply and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainants are associated companies in a global business supplying printers and printer accessories - including, in particular, equipment that can print onto card (such as for identity cards and passes) and that can produce bar codes.

In the UK, the Complainants have sold their products under the name 'Zebra' since at least 1987.

The Lead Complainant, Zebra Technologies Europe Ltd, was established in 1993 to handle UK business. The Second Complainant has rights, registered in the UK and Europe, to the Zebra name and to a distinctive zebra-head device. In 2008 the Complainants spent more than £1.1 million on promoting Zebra products in Europe, the Middle East and Africa (the so-called EMEA region, within which the UK is the Complainants' largest market).

The Complainants have owned the domain name zebra.com since 1998 and the domain names zebracard.com and zebracard.co.uk since 2004.

The Respondent is represented by Mr Chris Rayner. Through his company, he also sells printers, including card printers, and printer supplies (ribbons, cleaning kits, accessories and spares) as well as complete identity management systems. The domain names at issue were registered on 21 February 2002 and they have been used for webpages since 2006.

There is a disagreement between the parties about timing, but at some point within the past few years the Respondent was an authorised 'reseller' of the Complainants' products. As a result of correspondence between the parties during the course of this dispute, the Respondent removed the authorised reseller references from the web pages at the domain names.

At the time of writing, the domain names point to a landing page headed 'Eagle Technologies Ltd' that promotes Zebra branded merchandise prominently, but which also provides links to non-Zebra products - 'COMPLETE ID SYSTEMS', 'RIBBONS I-SERIES' and 'PLUS CARD ECO'. Following the RIBBONS I-SERIES link, for example, leads to a webpage that the Respondent has established at eagletechnologies.co.uk. Clicking on the 'PLUS-RIBBON' tab, one of many presented there, leads to a page promoting the Respondent's own 'unbranded' printer ribbon which is claimed to be as good as, but significantly cheaper than, the ribbon supplied by the leading brands.

## **5. Parties' Contentions**

### *Complaint*

The Complainants say that they have rights in the name Zebra and that that is similar to the domain names. They argue that the domain names are abusive registrations because they

- unfairly disrupt their business and
- confuse people into believing wrongly that there is a connection between the Complainants and the Respondent.

### *Response*

The Respondent's representative addresses the questions of both disruption and confusion only indirectly, arguing that through his company

- (i) he registered the domain names before the Complainants changed their brand name to match those names
- (ii) his sales of the Complainants' products, and the value he adds to them (with extra support such as extended warranties), is to the Complainants' advantage
- (iii) his website landing pages promote only Zebra products and the links on them are to the pages of his main website that promote only Zebra products. This is not a 'bait and switch' operation, where internet users arrive expecting to find the Complainants' products only to be presented with the products of a competitor

and that

- (iv) the Complainants have known about the domain names for years (and, by implication, should have done something about them earlier if the Respondent's registration or use of them was objectionable)

*Reply*

In reply, the Complainants argue that

- (i) the Respondent's registration of the domain names did not precede a brand name change by the Complainants
- (ii) even if the Respondent is selling genuine Zebra products, that does not allow him to use their trademarks in the way that he is using them
- (iii) the relevant webpages do not promote only Zebra products
- (iv) they discovered the Respondent's use of the domain names only in 2009, but even if they had known about it for longer that would not make any difference to their case now

## 6. Discussions and Findings

To succeed in this complaint, the Complainants must prove, on the balance of probabilities, that

- they have 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

### *Rights*

Through the Second Complainant, the Complainants have registered the name Zebra, together with a distinctive zebra-head device, in the UK and Europe. In the year 2008 they spent a significant sum promoting the Zebra name throughout Europe, the Middle East and Africa – and in particular in the UK. I accept that they have also built up considerable goodwill in the name Zebra as a brand of printer and especially of card printer. The Complainants evidently have both registered and unregistered rights in the name Zebra.

The domain names are made up of the name Zebra and the generic words ‘card’ and ‘printer’ or ‘printers’. Those generic words do not distinguish the domain names from the names in which the Complainants have rights. Given that the words simply describe categories of product to which the Zebra label applies, and that the .co.uk suffixes are conventionally ignored when applying this test, I am satisfied that the Complainants have rights in respect of a name or mark which is identical or similar to the domain name.

### *Abusive registration*

The Policy defines an ‘abusive registration’ as a domain name which either

- was registered...in a manner which, at the time when the registration...took place, took unfair advantage of or was unfairly detrimental to the Complainant’s rights or
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s rights

Where a domain name is identical to a name in which a complainant has rights, the question of unfair advantage or detriment is often easily answered. Most experts on the Nominet panel find it difficult to conceive of circumstances in which it is legitimate for someone to use someone else’s name, without adornment, for a domain name. It looks like impersonation and, as the appeal panel said in an early appeal under the original version of the Policy, ‘impersonation can rarely be fair’ (DRS 00389 – scoobydoo.co.uk). There are circumstances that would make the answer less clear-cut – for example when the registration pre-dates the

complainant's rights and subsequent use has been either unchanged or insignificant (see the appeal decision in DRS 05856 (t-home.co.uk)). But they are the exception. Here the position is less straightforward because the domain names comprise the name in which the Complainants have rights ('Zebra') and two generic descriptors ('printer' and 'card' or 'cards').

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration. The complaint refers directly to two of those factors. They are circumstances indicating that the Respondent

- has registered...the domain names primarily for the purpose of unfairly disrupting the business of the Complainant; or
- is using...the domain names in a way which...is likely to confuse people or businesses into believing that the domain names are...connected with the Complainant

The Policy also contains a non-exhaustive list of factors that may point in the other direction. These factors include where the domain name is generic or descriptive and the Respondent is making fair use of it.

The character of the registrations here seems to me to turn on these three points: the scope for confusion and associated disruption to the Complainants' business in the Respondent's use of the domain names; and whether the generic descriptors that are part of each domain name make any significant difference.

There is an *Overview* document available through the Nominet website which summarises the opinions of experts on the panel in relation to commonly arising issues of DRS policy and procedure. The document touches on precisely these questions:

The 'confusion' referred to in...the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that "the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant"?...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)...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...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 decision in DRS 00248 (seiko-shop.co.uk).

In the seiko-shop.co.uk decision mentioned, Seiko products were being promoted through the website at the domain name. The descriptor 'shop' was perfectly accurate. But the view of the expert, confirmed by the appeal panel, was that the domain name was nevertheless an abusive registration because it looked as

though it could only properly be established by the complainant: use by someone else could only take unfair advantage of the complainant's rights.

There is a strong case that the generic descriptors here have a similar effect – just as in DRS 005818 (hondapetrolgenerators.co.uk). The Respondent is incorporating into his domain names a name in which the Complainants have rights. For that to be legitimate I would expect to see something that puts some distance between the Respondent and the Complainants. Arguably, here, there is no such distance: the Respondent is using for the domain names a name in which the Complainants have rights as though he were free to employ it however he pleases – and in doing so will doubtless get internet traffic that he would not otherwise have received.

With that in mind, I can turn to the Respondent's response and the Complainants' reply (the numbering relates to the numbering under 'Response' and 'Reply' in the summary of the parties' contentions in section 5 above).

- (i) The Respondent has produced no evidence in support of his claim that the Complainants changed their brand to Zebra to match the domain names. Such evidence as I have seen suggests that the claim is without merit: the domain names were registered in 2002 and have been used for a website since 2006 but the Complainants have been using the Zebra name since at least 1987.
- (ii) The Respondent says he is adding value to the Complainants' products because of his promotion of them and the extras he offers around those products. Arguably, though, that does not help him because the additional 'value' is not in the control of the Complainants – who may well take a different view of what adds value to their products.
- (iii) The Respondent says that his website landing pages promote only Zebra products and that the links on them are to the pages of his main website that promote only Zebra products. The Complainants say there is no evidence that what the Respondent is selling as Zebra products are in fact made by them. Given that the Respondent was an authorised reseller of the Complainants' products at some point, it seems to me highly likely that what the Respondent is selling as Zebra products are indeed made by the Complainants – though that itself would not be conclusive in deciding whether the Respondent's use of the domain names takes unfair advantage of the Complainants' rights. But in any event the Complainants also say that, even if the Respondent is selling Zebra products through the website, it is promoting non-Zebra products and services such as printer ribbons and identity management systems. I accept that argument: the links on the landing pages at the domain names take traffic straight to material that is not produced by the Complainants. Whether or not the Respondent is selling Zebra goods, he is using the website at the domain names to promote non-Zebra business too.
- (iv) The Complainants deny that they have known about the domain names for years and I am inclined to accept that denial. In any event, I do not see that it makes a difference here. While I do not rule out the possibility that in certain circumstances delay could be a determinative factor, nothing of that kind is present in this case.

Overall, the scope for confusion and associated disruption to the Complainants' business seems to me to be high and I do not see that the generic descriptors that are part of each domain name make any significant difference. The Respondent registered and is using a name in which, to the Respondent's knowledge, the Complainants have rights. He may be promoting the Complainants' products, but in my judgement he is plainly doing so in a way that takes unfair advantage of their rights. He is also promoting competing products, which – because of the potential disruption to the Complainants' business - can only compound the unfairness.

## **7. Decision**

I find that the Complainants have rights in respect of a name which is identical or similar to the domain names and that the domain names, in the hands of the Respondent, are abusive registrations.

In the light of that, I direct that the domain names be transferred to the Lead Complainant.

**Signed** Mark de Brunner

**Dated** 27 March 2010