

DISPUTE RESOLUTION SERVICE

DRS 08179

Decision of Independent Expert

Republic Technologies (UK) Limited

and

Michael Swan

1. The Parties:

Complainant: Republic Technologies (UK) Limited
Address: Sword House
Totteridge Road
High Wycombe
Bucks

Postcode: HP13 6DG
Country: UK

Respondent: Michael Swan
Address: 50 Windmill Street Brill
Ayelsbury
Bucks

Postcode: HP18 9TG
Country: UK

2. The Domain Name(s):

swan.co.uk

3. Procedural History

The Complaint was validated by Nominet on 26 January 2010, and was sent to the Respondent on 29 January 2010.

A Response was filed on 17 February 2010 and the Complainant was notified on the same day that it was entitled to file a Reply. No Reply was filed, and the dispute proceeded to mediation. Mediation was not successful, and on 2 March 2010, the Complainant paid the requisite fee for an Expert Decision.

I was thereafter contacted by Nominet and asked to confirm that I was able to provide an Expert Decision. I responded to Nominet confirming that I had no conflict preventing me from providing a decision.

The matter was thereafter duly referred to me, Simon Chapman, ("the Expert") for an Expert Decision.

4. Factual Background

The Complainant recently acquired the rights to the "SWAN" trade mark, which is most closely associated with Swan Vesta Matches, which have been sold for over 126 years. The Complainant sells cigarette papers, filters, lighters, matches and other accessories under the "SWAN" trade mark. The Complainant is the owner (beneficially at least) of the Community Trade Mark registration for the word mark "SWAN".

The Respondent is an individual. His surname is "SWAN", which has been evidenced by production of his birth certificate. He registered the Domain Name in or about January 1995. The website to which the Domain Name is pointed has included family photos, and references to the Respondent's company, Cygnos Ltd, under which he operates as an IT consultant. In addition, multiple copies of a logo (the "Swan Logo"), previously used by the Complainant's predecessor in title, have appeared as a banner on the top of the home page of the website which is owned by the Complainant. The website has also included a statement to the effect that the proprietor of the site is not the manufacturer of domestic appliances.

5. Parties' Contentions

Complainant

The Complainant asserts that the Domain Name is identical to its trade mark and that the Domain Name in the hands of the Respondent is an abusive registration.

In support of its claim to Rights, the Complainant relies upon the extent of the use and investment in the "SWAN" trade mark by it and its predecessor in title, and its Community Trade Mark registration.

In support of the claim that the Domain Name is an Abusive Registration the Complainant says (in summary) that -

- (i) The Domain Name is a blocking registration. The website to which it is pointed is a website for personal business yet has no contact details or up to date information.
- (ii) The Respondent is using an old Swan Logo, without consent and not in keeping with the current design.
- (iii) The Respondent's website relays incorrect information on the ownership of the Swan brand.
- (iv) The Respondent's use has confused customers into thinking that the website is run by the owners of the Swan brand, by reference to a disclaimer on his site relating to domestic appliances.

The Complainant requests that the Domain Name be transferred.

Respondent

The Respondent does not challenge the existence of the Complainant's Rights, nor does he seemingly challenge the Complainant's assertion that the Domain Name is similar to a mark in which it has rights.

In defence of the allegation that the Domain Name is an Abusive Registration, the Respondent says (in summary) that –

- (v) He has the right to register and use the Domain Name because his surname is "SWAN", and he is the beneficiary of the "first-come-first-served system of domain name registration".
- (vi) He had no intention to block the Complainant's registration of the Domain Name. He has not offered the Domain Name for sale to the Complainant or anyone else.
- (vii) The website to which the Domain Name has been pointed, has very little content. It has been legitimately used variously for family content, and references to the Respondent's IT Consultancy business. The Domain Name was primarily registered to be used for email.
- (viii) It is irrelevant that the website to which the Domain Name was pointed had no contact details or up to date contact information.
- (ix) The Respondent was unaware that the Swan Logo used by him was used or owned by the Complainant. He had used the Swan Logo having located it on a website unconnected to the Complainant. Had the Complainant communicated its objection to the Respondent, the Respondent would have ceased any use of the Swan Logo, which he has now done. In any event the use of the Swan Logo should only be significant if it were to affect the essential function of the trade mark, which the website does not.
- (x) The notice on the Respondent's website relating to household appliances was put on to the website following an email to the Respondent in which he was asked whether he could provide

information about a toaster. "SWAN" being a brand name used by the manufacturer of household appliances

- (xi) The Respondent has not received any emails from persons who were under the impression that he was connected to the Complainant. He does not believe that any visitors to his site would believe that he was connected to the Complainant, and the Complainant has not produced any evidence to that effect.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the DRS Policy ("the Policy), prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Disputed Domain Name; and
- (ii) the Disputed Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

The Policy defines Rights as follows -

"Rights includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business."

There would appear to be no argument between the parties that the Complainant does qualify as having the necessary Rights.

The Policy requires such Rights to be in a name or mark identical or similar to the Disputed Domain Name. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which Rights are claimed, one must ignore the .co.uk suffix. The comparison is therefore between 'SWAN' on the one hand, and 'SWAN' on the other. In my opinion the Complainant has established that it has Rights in a mark identical to the disputed Domain Name.

Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above.

The Policy defines an Abusive Registration as follows :-

"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"

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration as follows –

"3. Evidence of Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

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

A. 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;

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

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. 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;

iii. 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 trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

iv. It is independently verified that the Respondent has given false contact details to us; or

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

A. has been using the Domain Name registration exclusively; and

B. paid for the registration and/or renewal of the Domain Name registration.

b. Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

c. There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the Complaint was filed. This presumption can be rebutted (see paragraphs 4(a)(iv) and 4 (c)).”

The Policy also identifies a list of grounds that a Respondent may use to demonstrate that the Domain Name is not an Abusive Registration as follows:-

“4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

C. made legitimate non-commercial or fair use of the Domain Name; or

ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it;

iii. In relation to paragraph 3(a)(v); that the Respondent's holding of the Domain Name is consistent with an express term of a written agreement entered into by the Parties; or

iv. In relation to paragraphs 3(a)(iii) and/or 3(c); that the Domain Name is not part of a wider pattern or series of registrations because the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent.

b. Fair use may include sites operated solely in tribute to or in criticism of a person or business.

c. If paragraph 3(c) applies, to succeed the Respondent must rebut the presumption by proving in the Response that the registration of the Domain Name is not an Abusive Registration.

d. Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.

e. Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:

i. the nature of the Domain Name;

ii. the nature of the advertising links on any parking page associated with the Domain Name; and

iii. that the use of the Domain Name is ultimately the Respondent's responsibility."

In the present dispute, it is clear that "Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has been commonly known by the name which is identical or similar to the Domain Name" (Para 4(a)(i)(B) Policy. I should therefore have little difficulty in finding that the Domain Name is not an Abusive Registration. However, paragraph 4 is not an absolute answer to a Complaint because it has to be considered in the overall context of the Respondent's conduct.

If the Respondent had merely registered the Domain Name and was using it for his personal business unconnected to the Complainant, in my view I would not need to consider his use further. However, on his website he has used the Swan Logo previously used by the Complainant and/or its predecessor in title. Is this use such as to indicate an ulterior motive on the part of the Respondent to take unfair advantage of the Complainant's rights?

I have considered the submissions made by the Respondent as to his knowledge and intent. He says that he was unaware of the Complainant's use of the logo, and is not a smoker. I also note that he ceased use of the logo as soon as the Complainant complained about his use.

In my opinion the Complainant has not shown, on the balance of probabilities, that the use of the Swan Logo was intended by the Respondent to take unfair advantage of the Complainant's Rights. I am prepared to accept, in the context of the Respondent's overall submission, that the use of the Swan Logo was inadvertent.

As for the other grounds of complaint advanced by the Complainant, I do not consider that a lack of contact details or up to date information on the Respondent's website is evidence of any abusive intent, and I do not consider its evidence regarding the Respondent's notice about household appliances to be relevant.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name and mark which is identical and/or similar to the Domain Names <swan.co.uk>, and that the Domain Name in the hands of the Respondent is not an Abusive Registration. The Complaint therefore fails.

Signed: Simon Chapman

Dated: 23 March 2010