

DISPUTE RESOLUTION SERVICE

D00009097

Decision of Independent Expert

Ameron International Corporation

and

Mr Mark Bullock

1. The Parties:

Complainant: Ameron International Corporation
245 South Los Robles
Pasadena
California
91101-2894
United States

Respondent: Mr Mark Bullock
Rectory Lodge
Upton Cressett
Bridgnorth
Shropshire
WV16 6UH
United Kingdom

2. The Domain Name(s):

amerondirect.co.uk ("the Disputed Domain Name")

3. Procedural History

The Complaint was filed with Nominet on 24 September 2010. Nominet validated the Complaint on 27 September 2010 and notified the Respondent. The

Respondent filed a Response on 12 October 2010. Nominet notified the Complainant that a Response had been filed, and the Complainant filed a Reply on 19 October 2010.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 18 January 2011 the Complainant paid the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy").

On 26 January 2011 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an Expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question his independence and/or impartiality.

4. Factual Background

The Complainant is a manufacturer of various products aimed at the chemical, industrial, energy, transportation and infrastructure markets, including lines of industrial paints.

The Complainant holds two UK trade marks, filed in 1983, in the term AMERON.

The Respondent is a private person who registered the Disputed Domain Name on 16 August 2007. The Respondent appears to be the owner of a business which trades as Andrews Coatings Limited.

The Disputed Domain Name currently points towards a website, www.amerondirect.co.uk, operated by the company Andrews Coatings Limited, where painting products are offered for sale online. The website is headed "AMERCOAT DIRECT", followed by a phone number and the following email address sales@amerondirect.co.uk.

The Complainant sent a cease and desist letter to the Respondent on 1 July 2010 requesting the transfer of the Disputed Domain Name and the Respondent replied on 14 July 2010. In his response to this letter, the Respondent refused to transfer the Disputed Domain Name and referred to correspondence with a third party company referred to as PPG Industries Netherlands BV. The Respondent's company appears to be a distributor of PPG Industries Netherlands BV.

The Complainant and a company named PPG Industries, Inc. ("**PPG**") entered into a trade mark license agreement on 1 August 2006 in relation to the AMERON trade marks whereby PPG was granted a licence to use the AMERON trade marks in several jurisdictions, including in the United Kingdom. This licence was granted for a term of 30 months, thus until 1 January 2009.

The Complainant and PPG Industries, Inc. also entered into an asset purchase agreement on 28 June 2006 whereby the Complainant sold to PPG the assets of a

company named Ameron's Performance Coating & Finishes Group. As part of this agreement, PPG acquired the trade mark AMERCOAT.

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant asserts that it has two UK trade marks in the term AMERON since the 1980s and that the trade marks AMERON are used in relation to paint.

Abusive Registration

The Complainant says that the Disputed Domain Name incorporates the registered trade mark AMERON in which the Complainant has held rights in the UK since the 1980s.

The Complainant asserts that, as a customer of the Complainant, it is inconceivable that the Respondent would not have been aware of the Complainant's rights in the Ameron name. In the Complainant's view the Respondent's use of the Disputed Domain Name is disruptive to the Complainant's business by misdirecting or misleading the Complainant's customers and potential customers.

In addition, the Complainant asserts that the Respondent's registration of the Disputed Domain Name indicates the intention on the part of the Respondent to trade off of the goodwill and reputation of the Complainant in its registered trade mark AMERON.

According to the Complainant, the use of the Disputed Domain Name by the Respondent will and does confuse people into thinking that the Disputed Domain Name is under the control of the Complainant because of the use in the Disputed Domain Name of the Complainant's trade mark and the use of the Complainant's trade mark on the Respondent's website.

The Complainant therefore requests the Disputed Domain to be transferred.

Response

The Respondent asserts that it has continuously used the Disputed Domain Name in *bona fide* business practices in order to sell the Complainant's products. The Respondent is a distributor of PPG in the UK and, since registration of the Disputed Domain Name, has used the Disputed Domain Name to sell only Ameron / PPG products.

The Respondent argues that, due to the Respondent's *bona fide* and legitimate use of the Disputed Domain Name, which has become central to the Respondent's business of selling the Complainant's legitimate products, the Disputed Domain

Name is important to the Respondent's business. The Respondent points out that it is aware of the fact that the products branded AMERON, as marketed in the UK, can no longer be supplied due to an agreement between Ameron and PPG in the United States. However, the Respondent is also aware of the fact that the paint brand Ameron has a significant following in the UK and thus, without the use of the website at the Disputed Domain Name, customers would not be aware of the link between Ameron, Amercoat and PPG and significant sales would be jeopardised.

The Respondent asserts that it had no control over the agreement made between the Complainant and PPG and that, without this agreement, the Complaint would not be justified. The Respondent argues that the Complainant has not proven that the Respondent acquired the Disputed Domain Name in order to block the registration of the Disputed Domain Name or for the purpose of unfairly disrupting the business of the Complainant.

As far as the Complainant's statement about the likelihood of confusion is concerned, the Respondent states that the website at the Disputed Domain Name clearly indicates that the operator of the website is a distributor of the Complainant's products in the UK and provides the contact details of the company Andrews Coatings Limited.

The Respondent states that it is clearly not pretending to be the Complainant or taking advantage of the Complainant's goodwill and reputation. The Respondent further states that the markings on the web pages are clear enough to a potential customer that it cannot be said that the customers would be confused, misled or misdirected into thinking that the Disputed Domain Name is under the control of the Complainant.

The Respondent thus states that it is of the opinion that it cannot be said that the Respondent is using, has used or is threatening to use the Disputed Domain name in a manner which has confused or is likely to confuse people or businesses into believing that the Disputed Domain Name is registered to, operated, authorised by, or otherwise connected with the Complainant.

Reply

In the Complainant's opinion, the Respondent's Response to the Complaint raises certain matters which require further comment by the Complainant. Those matters are as follows:

(i) The Respondent claims to be using the Disputed Domain Name to sell the Complainant's products

The Complainant asserts that the Respondent is not using the Disputed Domain Name to sell the Complainant's products since the Disputed Domain Name is aimed at a website titled Amercoat Direct. That website is not selling products bearing any trade marks owned by the Complainant but appears to be selling products bearing the trade marks owned by PPG.

(ii) The agreement entered into between the Complainant and PPG

According to the Complainant, the agreement entered into between the Complainant and PPG in 2006 temporarily granted to PPG rights in the trade mark AMERON in the UK. That agreement expired in January 2009.

PPG had also previously acquired certain trade marks related to the Complainant's business in protective marine coatings by PPG, including the trade mark AMERCOAT, which is used in the heading of the website at the Disputed Domain Name. The trade mark AMERCOAT is thus owned by PPG, not by the Complainant.

The Respondent is a distributor of PPG's products. However, the Complainant does not currently have a business relationship with PPG and PPG is not a party to this action. Therefore, in the Complainant's opinion the relationship between the Complainant and PPG is not relevant to these proceedings. In any event, PPG has no, and has never had any licence to use the trade mark AMERON, even at the time the agreement between the Complainant and PPG was effective, so it cannot confer any rights to use it.

Finally, the Complainant points out that PPG succeeded in a Nominet action against the Respondent for the transfer of the domain names <amercoatdirect.co.uk> and <amercoat.co.uk>.

(iii) The content of the website at the Disputed Domain Name

In the Complainant's opinion the registration of the Disputed Domain Name is abusive irrespective of the content of the website at the Disputed Domain Name, in particular because the Respondent has registered and put to use a domain name consisting principally of a registered trade mark in which he has no rights. The Complainant asserts that the response makes it clear that the Respondent is aware that AMERON is a registered trade mark since he asserts that he is making no use of the Complainant's trade mark on his web site.

6. Discussions and Findings

General

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Disputed Domain Name the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

- "(i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Disputed Domain Name; and
- (ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration."

Complainant's Rights

The Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise*".

By far the easiest way to demonstrate Rights under the Policy is the provision of a registered trade mark. In this regard the Complainant has supplied evidence that it owns registered UK trade marks numbers 1207756 and 1207757 in the term AMERON by supplying relevant printouts. The Expert is therefore satisfied that the Complainant has Rights in this term under the Policy.

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights (AMERON) must be identical or similar to the Disputed Domain Name (<amerondirect.co.uk>). It is accepted practice under the Policy to discount the .co.uk suffix, and so the only difference between the Disputed Domain Name and the Complainant's trade mark is the additional word "DIRECT" placed after the trade mark.

The Expert is of the opinion that this difference is not significant for the purposes of making a finding under the Policy, especially because DIRECT is a descriptive term.

The Complainant's marks and the Disputed Domain Name are thus similar to one another.

As a result the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and that the Complainant has Rights in respect of a mark which is similar to the Disputed Domain Name.

Abusive Registration

Moving on to paragraph 2(a)(ii) of the Policy, Abusive Registration is defined in paragraph 1 of the Policy to mean a domain name which:

"(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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Paragraph 3(a) of the Policy sets out a non-exhaustive list of five factors which may be evidence of Abusive Registration. The Complainant seems to be basing its case mainly on paragraphs 3(a)(i)(C) and 3(a)(ii), which read as follows:

"(i) Circumstances indicating that the Respondent has registered or otherwise acquired the Disputed Domain Name primarily:

(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"

As far as paragraph 3(a)(i)(C) is concerned, the Respondent's response, and in particular the fact that it asserts that he used the Disputed Domain Name to sell the Complainant's products, shows that the Respondent was obviously aware of the Complainant when he registered the Disputed Domain Name. It is therefore difficult to think of a plausible explanation as to why the Respondent would have chosen to register a domain name so similar to the Complainant's trade mark if it was not in order to take unfair advantage of the Complainant's goodwill and reputation, and the Expert is satisfied that this is indeed the case. The Expert therefore finds that the Disputed Domain Name has been registered in a manner which took unfair advantage of the Complainant's Rights, in accordance with limb (i) of the definition of Abusive Registration.

It is worth noting that, unlike paragraph 3(a)(i)(C), paragraph 3(a)(ii) does not depend upon the Respondent's intent and sets out a more objective test. As far as actual confusion is concerned, the Expert feels that it is not possible to make a finding on this based on the evidence presented.

Turning to the likelihood of confusion, certain customers may well have been misled by the Respondent's use of the Disputed Domain Name into thinking that the Complainant and the Respondent were somehow connected with each other. This is mainly because of the use of the trade mark AMERON in the Disputed Domain Name and because both the Complainant and the Respondent are involved in the selling of paint. This is further reinforced by the fact that the name and contact details of the company Andrews Coatings Limited are simply indicated in small characters at the very bottom of the web pages which make up the website found at the Disputed Domain Name.

The panel in the Nominet case *Metabolic Balance GmbH v Ms Pema Petra Gericke* (DRS decision number 07493) underlined that, searching for the complainant, an internet user could be presented with the domain name of the respondent. While the internet user may realise on reaching the website that it is not the one of the complainant, the "initial interest confusion" is sufficient to demonstrate confusion for the purposes of paragraph 3(a)(ii) of the DRS Policy.

In the present case, whether confused or not, once on the Respondent's website, certain customers may then have decided to do business with the Respondent anyway, thus resulting in the Respondent's unfair enrichment as a result of the use of the Disputed Domain Name, and potentially the Complainant's unfair detriment, had the customer been planning to buy from the Complainant in the first place.

The Expert reviewed the DRS decision number 7880, issued on 12 January 2010, referred to in the Complainant's Reply which involved the Respondent and notes that the complainants in that case, PPG Industries, Inc., PPG Coatings Nederlands B.V. and PPG Industries Ohio, Inc. tried to recover the Disputed Domain Name when filing their complaint. The Expert ordered the transfer of five of the disputed domain names, namely <amercoatdirect.co.uk>, <ppgcoatings.co.uk>, <amercoat.co.uk>, <sigmacoatingsdirect.co.uk> and <sigmapaints.co.uk> but denied transfer of the Disputed Domain Name because it found that the complainants did not have rights in the term AMERON at the time they filed their complaint, namely on 2 November 2009.

Concerning the domain names <amercoatdirect.co.uk> and <sigmacoatingsdirect.co.uk>, the Expert in that case referred to the DRS decision regarding <bio-oil-direct.co.uk> and noted that *"there will normally be an associated implication from the use of the word "direct", which will suggest a saving for the user (cutting out intermediate links in the supply chain), and imply a close commercial connection between the Respondent and the Complainant, unless the ways in which the Domain Names are actually used demonstrate clearly that there is some other intention behind the use of that wording. There is no obvious explanation here for the use of the suffix "direct" other than to suggest such a close connection, and none is suggested by the Respondent"*.

The Expert concurs with the view of the Expert in DRS decision number 7880 and also finds that the adjunction of the term DIRECT to the Complainant's trade mark can only imply a commercial relationship between the Respondent and the Complainant and that this is clearly misleading.

Even though the Expert in DRS decision number 7880 denied the transfer of the Disputed Domain Name, it referred to the registration of this domain name to further establish the Respondent's abusive conduct and stated the following:

"Also, the Expert notes that, despite having been told by the Complainants that there was no continuing authority to use the AMERON trade mark, given the termination of the licence from [Ameron International Corporation] on 31 January 2009, the Respondent has nevertheless continued to use that mark in one of the Domain Names, and as the principal email contact for the AMERCOAT DIRECT website to which the majority of the Domain Names resolve. This suggests to the Expert a degree of disregard by the Respondent for others' trade mark rights".

The Expert in the present case is of the same opinion as the Expert in DRS decision number 7880 and would add that the fact that the Respondent was ordered in DRS decision number 7880, on 12 January 2010, to transfer domain names incorporating trade marks of others which redirected to the current website at the Disputed Domain Name should have prompted him to transfer the Disputed Domain Name to the Complainant upon receipt of the Complainant's letter on 1 July 2010. However, the Respondent refused to do so and this is, in the Expert's opinion, a further element showing that the Respondent has not acted in good faith.

The Expert therefore finds that, on balance of probabilities, limb (ii) of the definition of Abusive Registration is satisfied and that the Disputed Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

For the sake of completeness, the Expert would point out that paragraph 4(a) of the Policy contains a non-exhaustive list of factors which may be evidence that the Disputed Domain Name is not an Abusive Registration and which the Respondent could have attempted to rely on. On the face of it, paragraph 4(a)(i)(A) could appear to be potentially relevant, and it reads 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 (...).*

The Respondent relies on an email of 11 April 2008 from Mr Scott Fretwell, PPG's Area Sales Manager to assert that Ameron / PPG were willing to cooperate with him. However, this email does not refer to any clear permission for the Respondent to use the AMERON trade mark. In the Expert's view an offering of goods and services cannot be said to be genuine if it takes unfair advantage of another company's reputation. The Expert notes that even if such clear permission had been granted to the Respondent, the Disputed Domain Name was, in any event, registered before the email in question was sent and could thus not be relied upon.

In the Expert's opinion, paragraph 4(a) (i)(A) of the Policy does not offer any assistance to the Respondent.

In conclusion, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Disputed Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

7. Decision

In light of the above findings, namely that the Complainant has Rights in a mark which is similar to the Disputed Domain Name, and that the Disputed Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Disputed Domain Name be transferred to the Complainant.

Signed: David Taylor

Dated 21 February 2011