

DISPUTE RESOLUTION SERVICE

D00009264

Decision of Independent Expert

Thule Sweden AB

and

Mr John Cooper

1. The Parties:

Complainant: Thule Sweden AB
PO Box 69
Borggatan 2
SE-330 33 Hillerstorp
Hillerstorp
Sweden
SE-33033
Sweden

Respondent: Mr John Cooper
Grange Lane North
Scunthorpe
North Lincolnshire
DN16 1RG
United Kingdom

2. The Domain Name(s):

thuletowbars.co.uk

3. Procedural History:

09 November 2010 13:13 Dispute received
10 November 2010 10:34 Complaint validated
10 November 2010 10:35 Notification of complaint sent to parties
12 November 2010 10:22 Response received
12 November 2010 10:22 Notification of response sent to parties
22 November 2010 10:22 No reply received
22 November 2010 10:22 Mediator appointed
26 November 2010 14:34 Mediation started
24 February 2011 14:53 Mediation failed
24 February 2011 14:54 Close of mediation documents sent
15 March 2011 09:58 Expert decision payment received

4. Factual Background

The Complainant was incorporated in Sweden in 1961. The Complainant's group of companies manufactures towbars, roof racks and other vehicle-related goods under the name "Thule". The group employs approximately 3,000 people worldwide.

The Complainant owns a number of registered trade marks for the word THULE including Community Trade no. 001337534 filed 7 October 1999 in classes 12, 18 and 22.

Since 2006, the Complainant has also owned the "Brink" brand, which is also used for vehicle-related products.

The disputed domain name was registered on 16 May 2007.

As of 26 October 2006, the disputed domain name resolved to a website headed "Towing Services UK Ltd" which offered a "Brinkmatic Advance towbar" system for sale. The site included prominent use of "Thule" and "Brink" logos.

At a later (unspecified) date the disputed domain name was redirected to an "under construction" page at www.brinktowbars.co.uk.

5. Parties' Contentions

Complaint

The domain name is confusingly similar to Complainant's trade mark THULE. The additional term "towbars" is a common term of no significant value in distinguishing the trade mark from the disputed domain name.

The mark is well-known within its field of business.

The disputed domain name is visually, phonetically and conceptually confusingly similar to the Complainant's trade mark. As the domain name incorporates the mark followed by the descriptive term "towbars", the public will assume that the website at the disputed domain name is related to the Complainant.

The disputed domain name is abusive based on the Complainant's continuous and long prior use of its mark. The use of the domain name by the Respondent has confused people into thinking that its website was/is controlled by the Complainant. The Complainant has not licensed or otherwise permitted the Respondent to use its trade mark. The Respondent is well aware of the Complainant's mark as the Respondent is a dealer in the Complainant's products in the UK.

The website to which the disputed domain name was initially directed gave the impression to customers that it was authorized by the Complainant, including by means of use of the Complainant's logo. The Complainant does not allow dealers to use its trade marks without permission.

The Respondent has since redirected the domain name to the webpage www.brinktowbars.co.uk, which currently is under construction. Even this action misleads customers into believing that the Respondent is authorised by the Complainant.

The Complainant acquired the "Brink" brand in 2006.

The continued use by the Respondent of the domain name takes unfair advantage of, and is unfairly detrimental to, the Complainant's rights. The Respondent's primary purpose in registering the domain name was to target actual and potential customers of the Complainant and unfairly draw them away from the Complainant's sites.

The domain name should be considered an abusive registration in accordance with paragraphs 3a(i) (blocking registration) and 3a(ii) (confusing use) of the DRS Policy.

Response

"john cooper's" is a long established towbar company which has been selling Brink towbars for over 15 years. The Respondent operated a website in the past called "brinktowbars". The Complainant was well aware that the Respondent has traded online using this name and that it has owned the domain name for over ten years. The Respondent has not used this domain name for passing off because the Respondent is selling the Complainant's own towbars and there is no hint of the sale of any other products. As a dealer for the Complainant, the Respondent does have permission to use the Complainant's "Brink" logo. The Respondent displays this logo on the outside wall of its premises.

The Complainant purchased brinktowbars.com in 1998 but not brinktowbars.co.uk. The Complainant purchased brink-towbars.com and brink-towbars.co.uk after 1998 but before the Respondent purchased brinktowbars.co.uk in March 2000. The

Complainant did not seem bothered about brink-towbars.co.uk and brink-towbars.com as it let both domain names lapse, following which the Respondent registered brink-towbars.com.

The disputed domain name was registered some time ago to sell Thule towbars, which is what the Respondent has done for 10 years. The Respondent does not use the website abusively. The Respondent uses the name "Towing Services UK Limited" on the website and promotes this as its business name, not Thule. The Respondent is a dealer in both the towbars and roof rack systems and as a dealer it is allowed to promote the products and to use the logos for sales purposes.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the disputed domain name and, second, that the disputed domain name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of "rights" is clarified and defined in the Policy in the following terms:

"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"

It is not in dispute that the Complainant has both registered and unregistered rights in the name "Thule". The addition of the generic term "toolbars" is insufficient to distinguish between domain name and trade mark.

The Complainant has therefore established rights in respect of a name or mark which is similar to the disputed domain name

Abusive registration – introduction

Is the disputed domain name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS Policy defines "abusive registration" 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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

Paragraph 3a(ii) of the Policy

The Complainant relies, amongst other things, on paragraph 3a(ii) of the Policy (one of the non-exhaustive factors which may be evidence that a domain name is an abusive registration):

“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”

The gist of the Respondent’s case is that it registered the disputed domain name to sell Thule towbars, which it has done for some 10 years. The Respondent says that it uses the name “Towing Services UK Limited” on its website and that it promotes this as its business name, not Thule. By this, the Respondent presumably infers that there is little or no likelihood of confusion.

Entities connected with the Respondent

I should mention at this point that, while the Respondent is John Cooper, the Response makes reference to “john coopers” (described as a “long established towbar company”) and also to “Towing Services UK Limited”, the name which appears at the top of the website at the disputed domain name. Although the Respondent does not clearly identify these various entities, or explain his relationship with them, it seems likely that the Respondent controls whatever separate limited companies are involved. In any case I see no reason to distinguish between the Respondent and these various other entities and so I will treat them all as “the Respondent” for the purpose of this decision.

Respondent’s use of the domain name

The Complainant has produced a 2006 version of the website at the disputed domain name, where the Respondent offered for sale the “Brinkmatic Advance towbar” system. The home page was prominently branded with the words “Towing Services UK” in large font and the word “Ltd” in small font next to it. The page also included prominent “Thule” and “Brink” logos.

It is not in dispute that the Respondent has used the disputed domain name to resell the Complainant’s products and there is no suggestion that the Respondent has ever used it to offer any competing products. (While the Complainant’s printout shows use of the site for Brink, not Thule, products, the Complainant has not raised any point about this, for example by suggesting that this usage occurred before the Complainant acquired the Brink brand or that it was otherwise inappropriate to use the site to sell Brink -as opposed to Thule - products.)

The Respondent later redirected the website to an “under construction” page at www.brinktowbars.co.uk, owned by the Complainant. The Respondent has not explained why it made this change but, in any case, the key issue is whether the Respondent’s former use of the domain name to resell the Complainant’s products was abusive.

What is meant by confusing use under paragraph 3a(ii)?

Paragraph 3.3 of the the “DRS Experts’ Overview” on Nominet’s website explains what is meant confusing use in the following terms:

“The ‘confusion’ referred to in this paragraph of 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”?

... the English Courts have clearly held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name. The prevailing approach under the DRS is consistent with this.

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.

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 decision in DRS 00248 (seiko-shop.co.uk).”

In that last case (DRS 00248, seiko-shop.co.uk), the respondent used the domain name to resell (only) the complainant’s products – as here. The appeal panel said this:

“Essentially Seiko’s complaint is that Wanderweb’s registration of the Domain Names has gone beyond making the representation “we are a shop selling Seiko / Spoon watches” and is instead making the representation(s)

“we are The Seiko/Spoon watch Shop” or “we are the official UK Seiko/Spoon watch shop”. The latter form of representation is what we understand the ECJ to be referring to when, in the ECJ case C-63/97 BMW v. Deenik, it speaks of creating “the impression that there is a commercial connection between the other undertaking and the trade mark proprietor”...

The Panel agrees that if there is support in the evidence for the suggestion that the Domain Names make, or are liable to be perceived as making, the latter representation (i.e. that there is something approved or official about their website), this would constitute unfair advantage being taken by Wanderweb or unfair detriment caused to Seiko.”

Application of principles

In my view, applying those principles, the disputed domain name is making the representation “we are Thule” and not “we are selling Thule products”. While the domain name does not consist of the Complainant’s unadorned trade mark, the additional word “towbars” could hardly be more appropriate to the Complainant’s field of activity – exactly the scenario described in the DRS Experts’ Overview as likely to be condemned as abusive.

It is doubtful, in my opinion, that use of the name “Towing Services UK Limited” in the header of the website would have been sufficient to dispel any confusion of on the part of users arriving at the site, as the Respondent infers. It seems to me that the impact (if any) of this branding was likely to have been outweighed by the prominent display of the Complainant’s logos.

In any case, as explained in the above extract from the DRS Experts’ Overview, use of a domain name will be abusive where, as here, the visitor has been “sucked in / deceived” by the domain name - even if it were to become immediately apparent to that person on reaching the site that it was not in any way connected with the Complainant. This is known as “initial interest confusion”.

Consent / acquiescence

The Respondent also argues that, as a dealer in the Complainant’s towbars and roof rack systems, it is allowed to promote the Complainant’s products and to use the Complainant’s logos for sales purposes.

It is not clear if, by this, the Respondent means that the Complainant specifically authorised the Respondent’s registration and use of the disputed domain name. If so, the claim must fail as the Respondent has produced no evidence of such consent and the Complainant denies it.

If the Respondent is merely saying that it was permitted to register and use the disputed domain name in the way that it has done simply because it is a dealer in the Complainant’s products, then I disagree for the reasons given above.

Finally, the Respondent makes a number of assertions relating to Brink-related domain names.

The Respondent claims to have owned and used the domain “brinktowbars” to sell the Complainant’s products for over ten years and that the Complainant was well aware of this. However, the Respondent has produced no evidence of such alleged knowledge / acquiescence. Even if it had done so, and even if this were properly attributable to the Complainant (which only acquired Brink in 2006), the Respondent would still need to demonstrate that that the knowledge / acquiescence also encompassed the Thule trade mark. In any event, the point is academic as there is no evidence of relevant knowledge / acquiescence in relation to either Brink or Thule.

The Respondent also says that the Complainant (or its predecessors) failed to register certain Brink-related domains and let others lapse. In my view these matters are irrelevant to the question of whether or not the disputed (Thule-related) domain name is an abusive registration.

Conclusion

In the circumstances outlined above, I conclude that the disputed domain name is an abusive registration in that it has been registered and/or used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s rights.

7. Decision

The domain name thuletowbars.co.uk should be transferred to the Complainant.

Signed: Adam Taylor

Dated: 4 April 2011