

## **DISPUTE RESOLUTION SERVICE**

**D00009667**

### **Decision of Independent Expert**

MERIAL (société par actions simplifiée)

and

Mr Graham Parlane

### **The Parties**

Lead Complainant: MERIAL (société par actions simplifiée)

MERIAL

29, avenue Tony Garnier

Lyon

F-69007

France

Respondent: Mr Graham Parlane

Grove Farm

Bradley  
Stafford  
Staffs  
ST18 9EE  
United Kingdom

## **The Domain Name**

thefrontlineshop.co.uk (“the Domain Name”)

## **Procedural History**

1. The procedural history is as follows, -

- 09 March 2011 Complaint validated and notice of complaint sent to parties.
- 30 March 2011 Response received.
- 30 March 2011 Notification of response sent to parties.
- 31 March 2011 Reply received.
- 31 March 2011 Notification of reply sent to parties.
- 31 March 2011 Mediator appointed.
- 05 April 2011 Mediation started.
- 12 April 2011 Mediation failed.
- 18 April 2011 Expert decision payment received.

## **Factual Background**

2. The Complainant is Merial SAS (‘Merial’). It is the owner of UK and EC registered trade marks in the word FRONTLINE for specified veterinary products and has since 1994 carried on business in the UK in the development, manufacture and sale of those products for cats and dogs. Merial operates a website at <http://uk.merial.com/> on which there is a dedicated section for its FRONTLINE products.

3. The Domain Name was first registered by the Respondent ('Mr Parlane') on 28 September 2008. Mr Parlane was a director of MR V Ltd ('MRV'). In November 2008 Merial complained to him about his ownership of the Domain Name and the content of a web-site operated by MRV and hosted at the URL address of the Domain Name. By early January 2009, the web-site was no longer hosted at that address, which resolved to a URL address named [www.mrpets.co.uk](http://www.mrpets.co.uk), which where there was a new web-site. Within a couple of months or so afterwards, all use of the Domain Name to re-direct visitors to [www.mrpets.co.uk](http://www.mrpets.co.uk) ceased. Mr Pets Ltd ('MPL') is a company incorporated under the laws of Guernsey and Mr Parlane, who continues to be the registered owner of the Domain Name, says that MPL bought the Domain Name from MRV on 15 December 2010. Both MPL and MRV have purchased and re-sold genuine FRONTLINE products and MPL has continued to do so.

## **Parties' Contentions**

### The Complaint

4. Merial is the proprietor of the following registered trade marks:-
  - 4.1 UK trade mark registration No. 1557026 FRONTLINE for insecticides and anti-parasitic agents, all being veterinary preparations in Class 5.
  - 4.2 EC trade mark registration No. 1966787 FRONTLINE for insecticides and antiparasitic preparations for veterinary purposes in Class 5.
  - 4.3 International registration (UK) No. 771092 FRONTLINE COMBO for veterinary products, namely insecticides and antiparastic products in Class 5.

Merial first marketed and sold FRONTLINE-branded preparations for treating fleas in household pets, particularly cats and dogs, in 1994. Since then, its

FRONTLINE products have become the UK's leading brand of anti-parasitic preparation for cats and dogs.

5. The brand of products is sold under two main formulations First, FRONTLINE Spot On, the active ingredient of which is fipronil (an insecticide and acaricide), sold in veterinary surgeries, pharmacists, pet shops, via the internet and elsewhere. Second, FRONTLINE Combo, containing both fipronil and methoprene (which inhibits the development of immature stages of insects such as fleas.) For regulatory reasons, this is sold only on a veterinary prescription. Merial invests considerable resources in educating the public about the causes and consequences of pet fleas and on methods for treating them, and in educating pharmacists, veterinarians and others about the appropriate FRONTLINE products that may be used for treating the dogs and cats of their clients and customers.
6. Annual UK sales of the FRONTLINE Spot On for the last 10 years have ranged between about £16.7M and £26.1M and sales for FRONTLINE Combo product over that period have been similar. In addition to marketing material aimed specially at vets and pharmacists, the FRONTLINE products have been advertised on national television and in both the specialist and popular press. Merial was also the winner of the Best Cat Flea Pet Product 2009/10 in the Your Cat Magazine and Your Dog Magazine Product Awards. Between 2008 and October 2010, Merial spent in excess of £7.5M (converted from US dollars at 1.6) on advertising its FRONTLINE products in the UK.
7. Merial operates a website at <http://uk.merial.com/>, which deals with UK sales. As part of this website there is a dedicated section for FRONTLINE products at <http://frontline.uk.merial.com/>. As a consequence of the substantial investment in education, marketing and consequent sales of Merial's FRONTLINE product, the FRONTLINE brand has established substantial goodwill and reputation throughout the UK.
8. The registration is abusive for the following reasons:-

- 8.1 the Domain Name 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 Merial's Rights; and
- 8.2 it has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to Merial's Rights.

In particular, it amounts to a blocking registration against a name or mark in which Merial has Rights, and has also been registered for the purpose of unfairly disrupting Merial's business, for the following reasons.

9. Merial's FRONTLINE trade mark is highly similar to the Domain Name thefrontlineshop.co.uk, as the dominant and distinctive element of the Domain Name is the word FRONTLINE which, in relation to flea treatment products, is distinctive of Merial's products.
10. The Domain Name implies, and customers would infer, that any web-site hosted on it is an official web site of Merial or is officially authorised by it. Mr Parlane is not associated or affiliated with Merial and Merial has not authorised him to register or use the Domain Name. Consequently, Merial is unable to control the quality, accuracy and appropriateness of the content of the web site. Incorrect, poor quality or inappropriate material displayed on the web-site is likely to lead to damage to the reputation of the FRONTLINE trade mark, and consequently to impair sales of Merial's FRONTLINE products.
11. Although Merial's products are sold to the public via intermediaries rather than by it or its UK subsidiaries directly, those not aware of this would reasonably assume that the only products sold via a web-site at [www.thefrontlineshop.co.uk](http://www.thefrontlineshop.co.uk) were FRONTLINE products and that those products were genuine. Without control of the domain name and the business conducted through the web-site, Merial would be unable to check and control the products sold by Mr Parlane.

12. By using Merial's well-known trade marks in the Domain Name, Mr Parlane has the potential to take advantage of that reputation and goodwill by attracting customers to its web-site. In October 2008 he was selling DRONTAL worming tablets on that web site. DRONTAL tablets are produced by Bayer, a competitor of Merial. Merial produces its own worming tablets sold under the EQVALAN trade mark. By using Merial's registered trade mark to market products of a competitor, Mr Parlane has sought to misappropriate its goodwill and to take unfair advantage of Merial's reputation, with the consequent risk of damage to Merial.
13. The Domain Name came to Merial's attention towards the end of 2008. Carpmaels & Ransford, Trade Mark Attorneys acting on behalf of Merial, wrote to Mr Parlane on 12 November 2008 demanding that the web-site be taken down and that the Domain Name be transferred. By 6 January 2009, Mr Parlane had removed the web-site at [www.thefrontlineshop.co.uk](http://www.thefrontlineshop.co.uk) and was instead hosting a web-site at [www.mrpets.co.uk](http://www.mrpets.co.uk). However, he was still using the Domain Name to link to this new web-site and so a domain name incorporating Merial's trade mark was still being used to drive traffic to Mr Parlane's new web-site.
14. On 3 February 2009 Carpmaels & Ransford wrote to Mr Parlane requesting that he cease using the Domain Name to link to the web-site at [www.mrpets.co.uk](http://www.mrpets.co.uk) and to surrender his registration of the Domain Name. Within a month or so of receipt of that letter, Mr Parlane stopped that use but did not surrender the Domain Name. Accordingly, it is still open to him to resume use of the Domain Name or to sell it on for further mis-use by another party. The fact that Mr Parlane took steps to stop using the Domain Name upon request suggests a tacit recognition and acceptance of Merial's rights.
15. The registration is also abusive because it is an infringement of Merial's rights in its registered trade marks and constitutes passing off. The definition of 'abusive registration' under the Nominet DRS must include a domain name the registration of which is an infringement of a registered mark under sections 9 and 10 Trade Marks Act 1994 or one which amounts passing off (see in

particular in *British Telecommunications plc and Others v One in a Million and Others* [1998] EWCA Civ 1272).

16. In view of Merial's reliance on its distribution network, and the need to maintain fair and equal terms for all of the sellers of its FRONTLINE products, Merial cannot allow a minority of sellers to register domain names that include the name FRONTLINE as that could result in those particular retailers deriving an unfair advantage over other sellers of the product.
17. If there were to be a 'free for all' in the registration and use of domain names that incorporate the FRONTLINE name, it would require Merial to expend considerable resources in policing all web-sites containing this name. For this reason, amongst others, Merial has a policy of not consenting to the registration of any domain name containing the FRONTLINE name by any seller of its products.
18. Accordingly, the registration of the Domain Name unfairly disrupts Merial's business in breach of paragraph 3 a) i. c) of the Nominet's Dispute Resolution Service ("DRS") Policy ("the Policy"). Finally, Merial relies on the following cases decided under the DRS, namely buy-epson-uk.co.uk (DRS 07228), clarityn.co.uk (DRS 07186), and the decisions of the Appeal Panel in toshiba-laptop-battery.co.uk (DRS 07991) and seiko-shop.co.uk (DRS 00248).

#### The Response

19. The Response was written by Mr Parlane, who described himself as a consultant to the directors of MPL. The Response was as follows.
20. The Domain Name is currently owned by MPL, a Guernsey registered company. It was purchased by this company from MRV on 15 December 2010. The domain is currently inactive, however, has previously had a redirect to a domain name mrpets.co.uk some time prior to October 2008 under its previous ownership. This was a clearly branded site that did not set out to represent itself as being associated with Merial.

21. Merial owns the rights to the UK and European trade marks for 'frontline' in relation to insecticides and anti-parasitic agents. However, its trade marks appear not to be registered in the Bailiwick of Guernsey. A web-site was hosted on the Domain Name that may be seen as evidence of an abusive registration. However, this was last used in October 2008, outside the limitation period of 2 years indicated in Paragraph 3c of the DRS Policy, 'Evidence of Abusive Registration'.
22. The registration was also not abusive, because no attempt was made by the previous owners to misrepresent themselves as Merial or to make commercial gain from the use. Further, as the trade mark was in use prior to 2000, registration of the Domain Name in 2008 was not a blocking registration.
23. Merial contends that the Domain Name is registered so as unfairly to disrupt its business but also says that it does not retail the 'frontline' products directly to members of the public. In truth, Mr Parlane's actions enhance Merial's business as MPL currently purchases around £300,000 worth of product annually from Merial.
24. Merial asserts that it would be unable to control products sold on sites linked to the Domain Name and ensure their genuine nature. However, there is a business relationship between Merial and MPL and Merial is aware of the purchases of its products by MPL and by the previous owner of the Domain Name and is in a contractual arrangement offering a cash rebate based on these purchases. Merial is put to proof of the assertion that non-genuine products have been sold by the owner or previous owner of the Domain Name.
25. Merial claims that sales of Drontal worming tablets on the web-sites may constitute a risk of damage to Merial, because it markets a worming product Eqvalan. Sales of a product for use in dogs and cats could not affect sales of a product for use in horses. Accordingly, Merial is put to proof of this claim too.
26. In any event, the Domain Name is generic. The case law relating to Epson, Clarity and others has no relevance due to the generic nature of the name.



27. Merial is using the DRS to gain a commercial advantage by intimidation. Mr Parlane has made approaches to resolve this matter which have been rebuffed.

### The Reply

28. The Domain Name presently stands registered in the name of Graham Parlane of Staffordshire, United Kingdom. He has presented no evidence of ownership of the Domain Name by MPL. In any event, the precise present ownership of the Domain Name is irrelevant. The Domain Name is a .uk domain name and is subject to Nominet's Dispute Resolution Procedure. Any use of the domain name as the URL for a web-site would naturally be targeted at potential customers in the UK. Merial has already demonstrated its prior rights in and with respect to the UK via its registrations of the FRONTLINE trade mark, and in passing off.
29. Mr Parlane has remained the registered owner of the Domain Name since it was first registered and, in the event that he is not the present legal owner, he has acted as an agent for each successive owner. The use made of the Domain Name has at all material times been under his control by virtue of his registration as its owner and his control over the account in which the Domain Name is held.
30. The Records held at Companies House for MRV show that Mr Parlane was appointed as a director of the company on 14 May 2008 and that an Extraordinary Resolution To Wind Up the company was filed on 9 March 2011, the date on which the Complaint was filed. This is a striking coincidence of dates that generates the impression that Mr Parlane is somehow attempting to use the dissolution of MRV in an attempt to avoid legal liability for this Complaint or for the acts of trade mark infringement and passing off alleged in it.
31. Mr Parlane accepts that the web-site hosted via the Domain Name in October 2008 'may be seen as evidence of an abusive registration'. This admission should be sufficient for the Complaint to be resolved in favour of Merial.

Paragraph 3c of the Dispute Resolution Service Policy under the heading 'Evidence of Abusive Registration' does not provide an estoppel or other immunity from a Complaint, merely because the web-site usage in question occurred more than two years prior to the filing of the Complaint. Mr Parlane has provided no justified defence to his actions.

32. He says that the registration was not abusive, in that no attempt was made by the previous owners to misrepresent themselves as Merial or to make commercial gain from its use. However, the mere registration and use of a domain name embodying Merial's trade mark for the purpose of selling veterinary products or linking to another web-site belonging to or connected with Mr Parlane that does so amounts to trade mark infringement and passing off (see the authorities cited in the Complaint). The fact that certain veterinary products sold or marketed through the web-site are those of parties unconnected with Merial merely exacerbates the infringement.
33. Further, it is self-evident that the registration of a domain name linked to a web-site through which sales of products may be assisted or transacted constitutes use of the Domain Name for commercial gain.
34. It is said that registration of the Domain Name in 2008 cannot constitute a blocking registration, as Merial registered its FRONTLINE trade marks in 2000. The assertion confuses entry of a trade mark on a trade mark register and entry of a domain name on a domain name registry. Where the trade mark owner has registered trade mark rights and carries on business under that trade mark then the unauthorised registration of a domain name embodying that trade mark by a third party will, amongst other things, deprive the Complainant of its legitimate entitlement to register that domain name for itself, and deprive the Complainant of the exclusive rights in its registered trade mark.
35. It would be no defence to claim that if Merial had wanted to register and use a particular domain name then it should have registered it itself before Mr Parlane did so. The logic of such a claim would be that every trade mark

owner should be obliged to register every one of thousands of possible combinations of domain names that embody its trade mark in order to prevent the possibility of unauthorised third parties from doing so. This is clearly ridiculous. It is enough to show that the registration and use of the Domain Name prejudices Merial's exclusive rights in its trade mark and hampers its business by virtue of the registration and use of the Domain Name.

36. There is no conflict between Merial's method of doing business and its assertion that third parties not having its permission are not entitled to register domain names corresponding with, or embodying its, trade mark. The law requires Merial's products to be sold under appropriate qualified veterinary supervision or under veterinary prescription. Merial is not, and does not operate, a pharmacy or veterinary surgery business; rather, it develops, manufactures, obtains regulatory approval for, markets and distributes its FRONTLINE veterinary products, either directly or indirectly, to persons authorised to dispense its products. As explained in the Complaint, Merial relies on a vast network of pharmacies and veterinary surgeries and other companies to wholesale and retail its products in the United Kingdom. It cannot give, and is not obliged to give, *carte blanche* to every retailer of its product to register domain names and operate websites under URLs that contain its trade marks. To allow or tolerate certain of Merial's retailers to do so could give those retailers an unfair advantage over others, which would be likely to result over time in substantial disruption to Merial's relationships with its distributors and retailers and would potentially impose seriously onerous burdens it to monitor hundreds or thousands of websites whose URL would imply some special legal or economic connection with it.
  
37. It is not denied that Mr Parlane sells considerable quantities of Merial's products each year. However, these sales can be carried out without taking unfair advantage of Merial's trade mark by incorporating it into a domain name of its own. It is arguable (although evidence to the contrary is immaterial to Merial's case) that the primary result of Mr Parlane's registration and use of the Domain Name would not be to enhance total sales of Merial's products in comparison with a situation where the Domain Name

was not registered and used, but that it would merely unfairly attract or divert sales of FRONTLINE products to Mr Parlane that might have otherwise gone to other sellers of FRONTLINE product who had not sought to misappropriate for themselves a domain name embodying the trade mark.

38. Merial has made no allegation that Mr Parlane has sold counterfeit FRONTLINE or other products. The point is that without control of the Domain Name and the business conducted through a web-site the URL of which embodies its trade mark, Merial would be unable to check and control the products sold via the web-site, which conveys some official connection with it.
39. It is a clear mis-use of Merial's trade mark rights to promote or sell the products of third parties by using Merial's trade mark in a domain name. This constitutes a misrepresentation to the public of a connection between the sources of the respective products and a misappropriation of Merial's goodwill in the FRONTLINE mark.
40. The trade mark FRONTLINE is a validly registered trade mark, and under section 72 of the Trade Marks Act 1994, the registration of Merial as the proprietor of UK trade mark registration No.1557026 FRONTLINE is *prima facie* evidence of the validity of the registration. Accordingly, a domain name that embodies it is not 'generic'.
41. Merial is not using the DRS to gain a commercial advantage by intimidation. While it accepts that Mr Parlane approached it in March 2011 with an offer to resolve this matter following the filing of the Complaint, Merial first approached him nearly two and half years ago and at no time between then and the filing of the Complaint did he make any proposals for settlement. When he did approach Merial in March 2011, he offered to transfer the Domain Name for £700 worth of FRONTLINE stock. The price of that offer was far in excess of Mr Parlane's out-of-pocket costs directly connected with the registration of the Domain Name. It is notable that the effective price selected, £700, falls just £50 below the cost of requesting a fully reasoned

decision by a Nominet expert. The inference is that the price offered was carefully calculated in light of Merial's legal costs associated with payment of the Nominet fee. This reinforces the impression that Mr Parlane's conduct falls far short of honest, straightforward and fair dealing.

## **Discussions and Findings**

42. Merial is required under subparagraphs 2a. and 2b. of the Policy to prove to the Expert on the balance of probabilities that: -

42.1 it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

42.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### Rights

43. By paragraph 1 of the Policy, -

*'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.'*

Thus, the definition of Rights recognises rights enforceable under English law and other systems of law. Mr Parlane accepts that Merial is the owner of the registered trade marks on which it relies, being:-

43.1 UK trade mark registration No. 1557026 FRONTLINE for insecticides and anti-parasitic agents, all being veterinary preparations in Class 5.

43.2 EC trade mark registration No. 1966787 FRONTLINE for insecticides and antiparasitic preparations for veterinary purposes in Class 5.

43.3 International registration (UK) No. 771092 FRONTLINE COMBO for veterinary products, namely insecticides and antiparasitic products in Class 5.

Merial's figures for sales in the UK since 2000 and the sums expended by it on UK advertising since 2008 and its other evidence of the company's success are sufficient to establish the goodwill and reputation in the word FRONTLINE necessary to establish a claim in passing off, an unregistered right under English law which also satisfies the definition under paragraph 1 of the Policy.

44. Therefore, the Expert rejects Mr Parlane's contention that Merial has no Rights because it has not demonstrated rights subsisting in relation to the Bailiwick of Guernsey.

45. The rights are in a name or mark, namely FRONTLINE, which is similar to the Domain Name. Thus, Merial has established that it has Rights.

#### Abusive Registration

46. Paragraph 1 of the Policy states, -

*'Abusive registration means a Domain Name which either:*

- i. was registered or otherwise acquired in a manner which, at the time when the registration or other 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 of the Policy states -

#### *'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....
    - 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 to, the Complainant.'*
  - .....
- 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)).'*

Paragraph 4 of the Policy states, -

***'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; or*
    - C. *made legitimate non-commercial or fair use of it.*

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

.....

*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.'*

47. Merial's case is that registration of the Domain Name is abusive on each of the grounds under paragraph 1 of the Policy. Although it makes specific mention of paragraph 3a.i., which pertain to a first registration by a respondent, Merial also relies on totality of the history of events since first registration.
48. The findings set out below are limited to those necessary to decide this dispute under the Policy and the DRS Procedure. It is not necessary or appropriate to make findings as to whether or not Merial's statutory or common law rights have been infringed. The Policy embodies a self-contained code to be applied in its own right, even though that code is informed by principles of intellectual property, which it may be appropriate to take into account in any particular case.
49. Merial carries on business in the development, manufacture and distribution of veterinary products for cats, dogs and horses in particular. It markets and distributes its FRONTLINE veterinary products, either directly or indirectly, to persons authorised to dispense its products. Thus, it is not a retailer. Merial relies on a substantial network of pharmacies and veterinary surgeries and other outlets to wholesale and retail its products in the United Kingdom. The retail sale of veterinary products is a regulated activity. The law requires Merial's products to be sold under appropriate qualified veterinary supervision or under veterinary prescription. Merial does not operate a pharmacy or veterinary surgery business.
50. One of Merial's retail outlets for FRONTLINE products was MRV and there have also been sales of these products by Merial to MPL, which currently purchases around £300,000 worth of product annually from it. Mr Parlane was appointed as a director of MRV on 14 May 2008. Mr Parlane is also connected



to MPL, a company incorporated under the laws of Guernsey, because he describes himself as a Consultant to the directors of that company. Ownership of both companies is unclear.

51. The date of first registration of the Domain Name was 28 September 2008, as appears from Carpmaels & Ransford's letter to Mr Parlane of 12 November 2008. By October 2008 a web-site hosted at the URL address of the Domain Name was advertising for sale veterinary products sold by MRV, as also set out in that letter. The web-site was also offering for sale DRONTAL worming tablets for cats and dogs. Carpmaels & Ransford's letter of 12 November 2008 asserted that registration of the Domain Name and its use for the purpose of operating the web-site was abusive.
52. By 6 January 2009, Mr Parlane had removed the web-site at [www.thefrontlineshop.co.uk](http://www.thefrontlineshop.co.uk) and was instead hosting a web site at [www.mrpets.co.uk](http://www.mrpets.co.uk). However, he was still using the Domain Name to link to this new web-site and so a domain name incorporating Merial's trade mark was still being used to drive traffic to the new web-site.
53. On 3 February 2009 Carpmaels & Ransford wrote to Mr Parlane requesting that he cease using the Domain Name to link to the web-site at [www.mrpets.co.uk](http://www.mrpets.co.uk) and to surrender his registration of the Domain Name. Within a month or so of receipt of that letter, all use of the Domain Name to re-direct visitors to [www.mrpets.co.uk](http://www.mrpets.co.uk) came to an end but the Domain Name was not surrendered. Nothing seems to have happened until March 2011 after the filing of the Complaint (i.e the Domain Name was not in use), when Mr Parlane approached Merial, offering to transfer the Domain Name for £700. Merial refused to accept that offer. In the intervening period MRV and/or MPL purchased FRONTLINE products from Merial for retail sale. On 9 March 2011 an Extraordinary Resolution was passed to place MRV into voluntary liquidation and a liquidator was appointed.
54. Merial says that its FRONTLINE trade mark is highly similar to the Domain Name, as the dominant and distinctive element of the Domain Name is the

word FRONTLINE which, in relation to flea treatment products, is distinctive of Merial's products. It also says that the Domain Name implies, and customers would be likely infer, that any web-site hosted on it is an official web site of Merial or is officially authorised by it.

55. A theme of some DRS cases is where to draw the line between the fair use and taking unfair advantage of a name or mark for the purposes of the re-sale of genuine products where the supplier asserts Rights under the Policy. The decisions of the Appeal Panels in *seiko-shop.co.uk* (DRS 00248) and *toshiba-laptop-battery.co.uk* (DRS 07991) are of particular relevance to this case, subject to Mr Parlane's 'generic' point.
56. Mr Parlane had plainly heard of the name FRONTLINE in connection with veterinary products when he first registered the Domain Name. The inference is that it was the business activities of MRV as a reseller of those products which led him to choose that name, in order to convey to persons interested in FRONTLINE products that MRV was offering an online source of supply where those products were available for sale.
57. It is not the case that instances of abusive conduct are irrelevant if occurring more than 2 years before the date of the Complaint. Paragraph 3c of the Policy does not have that effect at all. It was abusive to offer for sale worming tablets made by Bayer, even if Merial only made worming tablets for horses. It is abusive to use a name or mark to promote the sale of products of a trade competitor of the owner of that name or mark.
58. The offering for sale of the worming tablets was also abusive, because it falsely represented that they were FRONTLINE products, as the web-page complained of by Merial made clear. Mr Parlane's point about there being no possible confusion from the sale of worming tablets is therefore wrong.
59. The suggestion is that Mr Parlane should not be held responsible for that episode, because the Domain Name was then under a different ownership. The point is that in October 2008, Mr Parlane was both the registered owner of the

Domain Name and a director of MRV. Without a detailed and convincing account of why he was not to blame in connection with the sale of the worming tablets, the proper inference is that he, the registrant and a director of MRV, procured or sanctioned use of the Domain Name to market products sold by a trade rival of Merial.

60. Mr Parlane says that when the web-site was taken down and the Domain Name was used to redirect to *mrpets.co.uk*, no attempt was made by 'the previous owners' to misrepresent a connection with Merial. What matters is not what MRV or Mr Parlane attempted to do. It is the likely effect of their conduct that must be considered.
61. The decisions on appeal in *seiko-shop.co.uk* and *toshiba-laptop-battery.co.uk* make it clear that the false implication of a commercial connection between the registrant and the Rights owner may constitute the taking of an 'unfair advantage' even where the registrant is a reseller of genuine goods. The question is whether the registrant crosses the line and makes a representation beyond the fact that he is a mere re-seller of genuine goods.
62. It is necessary to consider what representation was made by the Domain Name. Mr Parlane says that the Domain Name is generic. The portmanteau word 'frontlineshop' is to some extent descriptive of the business formerly carried on by MRV, which now appears to be carried on by MPL, i.e. an online shop where FRONTLINE veterinary products can be purchased. The name FRONTLINE is distinctive of products sold by Merial, as registration of the two word marks 'FRONTLINE' indicate. The portmanteau word 'frontlineshop', though in one sense descriptive, is not generic. That it is preceded by 'the' also suggests that there is something special about the shop.
63. In *seiko-shop.co.uk*, Seiko complained that the registrant had gone beyond making a representation that it was a mere retailer of Seiko 'Spoon' watches, by representing that it was 'the Seiko/Spoon watch shop' or 'the official Seiko Spoon/Watch shop'. The Appeal Panel agreed. The use of 'thefrontlineshop.co.uk' as the URL address for a website operated by MRV

amounted to a representation that went beyond a representation that MRV was a mere reseller of FRONTLINE products; it falsely claimed a connection with the manufacturers of FRONTLINE products by being not only an approved retailer of its products but the official retailer.

64. Persons who wanted to search for those products would have been likely to put the word FRONTLINE (whether in upper or lower case and whether or not accompanied by another word or words such as ‘veterinary products’) into a search engine and been shown the Domain Name on a search result. This would have caused ‘initial interest’ confusion by creating the false impression set out in the previous paragraph. That confusion would not have been dispelled on a click through to MRV’s web-site.
65. Thus, the words ‘thefrontlineshop’, coming to the attention of would-be purchasers of FRONTLINE products using the internet at the time when the Domain Name resolved to the web-site at mrpets.co.uk, constituted a representation that that web-site was registered to, operated or authorised by, or otherwise connected to the business which manufactured FRONTLINE veterinary products, i.e. Merial. That representation went beyond one that MRV or Mr Parlane were mere resellers of FRONTLINE products, implying that their outlet had been specifically approved by the manufacturers of FRONTLINE products as the official shop for those goods and as a result took unfair advantage of Merial’s Rights in the name and mark ‘FRONTLINE’.
66. The use of the Domain Name to host MRV’s web site before 6 January 2009 (i.e. prior to the re-direction to mrpets.co.uk) was abusive even without the advertising of the worming tablets. By making an untrue representation that it was the official shop on the internet for FRONTLINE products, MRV not only implied a connection with Merial that went beyond that of a relationship between a supplier and retailer, but also conferred on itself an unfair advantage over other resellers of FRONTLINE products, to the potential detriment of Merial. That is because over time there might have been a real risk of disruption to Merial’s relationships with its distributors and retailers, who would have been unhappy about one retailer having the unfair advantage

of holding itself out as Merial's official online shop. Merial is not a veterinary pharmacy, an activity which is regulated by law, and the misrepresentation that MRV was Merial's official online shop conveyed the further false impression that Frontline had endorsed or was otherwise commercially connected with this particular outlet.

67. Even if the misrepresentation did enhance sales of the products (as to which there is no evidence), this fact itself is beside the point. Any increase in trade is likely to have been at the expense of MRV's competitors, and for the reasons given in paragraph 66 above that would constitute the taking of an unfair advantage of Merial's trade marks.
68. From early March 2009 the Domain Name has been inactive. However, this review of the brief history of the use of the Domain Name shows that the history of its use during the period before March 2009 (when it was used as part of MRV's business) has consistently been an abuse of Merial's Rights.
69. The fact that there has been a period of inactivity for about two years in use of the Domain Name (after letters of complaint on behalf of Merial) does not establish that future use of it is likely to be fair. Confronted by the allegations in the Complaint, Mr Parlane sought to divert attention away from any conduct prior to 15 December 2010 by putting it down to the conduct of unspecified persons alleged to have been the previous owners of the Domain Name, whereas in truth it was he who procured or sanctioned the abusive use. The conclusions reached in paragraph 59 apply generally to Mr Parlane's responsibility for the abusive use of the Domain Name prior to about early March 2009.
70. Mr Parlane could have promised to ensure that nothing like that would happen again. However, his defence to the Complaint was based on the premise of a change of ownership even though he is still the registrant. No evidence of a change of beneficial ownership, if that is what is alleged, has been produced, let alone any reason to suppose that he no longer has control over the use of the Domain Name. No rationale has been given for this purported change of

ownership and the Expert concludes from this lack of explanation and the timing of the resolution to wind up the company that the winding up had no commercial purpose beyond a misconceived attempt by Mr Parlane to disassociate himself from the past uses of the Domain Name identified in the Complaint, which he procured or sanctioned.

71. Mr Parlane contended that the registration was also not abusive, because no attempt was made by the previous owners to make commercial gain from the use. In addition to Mr Parlane's expressed view that use of the Domain Name actually increased sales, this statement is plainly untrue, given that that the rationale behind the selection of the Domain Name was to use the name 'frontline' to drive sales to MRV's web-sites.
72. The contents of the Complaint are also troubling, because Mr Parlane considers that MPL, a Guernsey company, is beyond the territorial jurisdiction of the intellectual property rights owned by Merial, and beyond the jurisdiction of Nominet's contractual dispute resolution procedure which he, the registrant of the Domain Name, agreed to abide by in the event of a dispute over the registration. Although some care must be used in weighing the significance of this, because it is bound up with Mr Parlane's defence to the Complaint, these matters further undermine any confidence that future use of the Domain Name might be fair.
73. Mr Parlane has suggested no purpose, let alone any legitimate purpose, for the future use of the Domain Name. The purported transfer of the Domain Name to MPL shortly before MRV was placed into liquidation can only make commercial sense if there was some purpose to it. In view of the matters set out in paragraphs 57-72 above, the Expert concludes that there is a real risk that, if the registration is left in the hands of Mr Parlane, he will procure or sanction an abusive use of the Domain Name by MPL to promote its sales of FRONTLINE products from Guernsey or sell the Domain Name to another supplier of Merial's products, in all probability a distributor rather than a rival retailer.

74. The thrust of Merial's case is not that the Domain Name may be used to promote the sale of counterfeit goods, but that without control of the Domain Name and the business conducted through a web-site whose URL embodies its trade mark, Merial would be unable to check and control the products sold via the web-site that conveys some official connection with it. That case is made out.
75. The Expert rejects the assertion that Merial has used the DRS to intimidate Mr Parlane. The facts found in this Decision indicate no more than a complainant seeking to invoke its rights under the DRS, and who entered into unsuccessful discussions for settlement of the dispute.
76. In view of these findings, the Expert concludes that the Domain Name was registered in a manner which, at the time when the registration took place, took unfair advantage of Merial's Rights That is because the Domain Name was registered with a view to unfairly disrupting Merial's business, which is what has happened and is likely to re-occur.
77. In view of the history of abusive registration and the period of subsequent inactivity coupled with a real risk of future abusive use as set out above, the registration has been used in a manner which has taken unfair advantage of Merial's Rights.
78. Therefore, the Expert finds that the Domain Name in the hands of the Respondent is an Abusive Registration.

## **Decision**

79. The Complainant has Rights in a name and mark, which is similar to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore determines that the Domain Name 'thefrontlineshop.co.uk' be transferred to the Complainant.

**Signed STEPHEN BATE**

**Dated 13.05.11**