

Nominet UK Dispute Resolution Service

DRS 9708

3M Company

and

Indigo

Decision of Independent Expert

1 Parties

Complainant: 3M Company

Address: 2501 Hudson Road
St Paul
Minneapolis
Minnesota

Postcode: 55144-1000

Country: United States

Respondent: Indigo

Address: Unit 3b, Sopwith Crescent
Wickford Business Park
Wickford
Essex

Postcode: SS11 8YU

Country: United Kingdom

2 Domain Names

<duallock.co.uk>, <3mvhb.co.uk>

3 Procedural History

- 3.1 On 23 March 2011 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent the next day, 24 March 2011. The respondent responded on 25 March 2011, and the complainant replied on 31 March 2011. The matter was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 17 May 2011 paid the applicable fee.
- 3.2 I was appointed as expert on 24 May 2011. I have made the necessary declaration of impartiality and independence.

4 Factual background

- 4.1 The complainant is a well known and diverse global technology firm. Its businesses include making and selling adhesive tapes and fastening systems.
- 4.2 The respondent registered the domain names <duallock.co.uk> on 21 June 2007 and <3mvhb.co.uk> on 13 October 2007.

5 Parties’ Contentions

Complainant

- 5.1 The complainant says it has done business for many years and marketed extensively using the names 3M, Dual Lock and VHB.
- 5.2 It says it has UK trade marks for the names 3M, DUAL LOCK and VHB and European trade marks for the names 3M and VHB, and owns domains including <3m.com> (since 1988) and <3m.co.uk> (since 1992). It argues that the domain names consist solely of its trade marks without any addition or variation.
- 5.3 The complainant says the domain names redirect to websites through which the respondent sells the complainant's and competitors' products. It argues that internet users are likely to have been confused into believing the domain names are connected with the complainant. By using the domain names to attract visitors to its website, it says the respondent has taken unfair advantage of its rights.
- 5.4 According to the complainant, the respondent must have been aware of the complainant's rights when it registered the domain names, because the respondent sells the complainant's Dual Lock and VHB fastening and adhesive products.

- 5.5 The complainant argues that selling the complainant's tapes does not entitle the respondent to use a domain name that incorporates its trade marks.
- 5.6 It argues that whether or not the respondent's competitors have domains including the words 3M and Dual Lock is irrelevant.

Respondent

- 5.7 The respondent argues that it is entitled to the domain names as it sells 3M Dual Lock and VHB tapes. Many of its competitors have, it says, registered domains including the words "3M" and "Dual Lock".

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities that:
- it has rights in respect of a name or mark which is identical or similar to the domain name, and that
 - the domain name, in the hands of the respondent, is an abusive registration.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has produced documentary evidence from the Intellectual Property Office of its UK trade marks for the names 3M, DUAL LOCK and VHB, and from the Office for Harmonisation in the Internal Market of its European trade marks for the names 3M and VHB.
- 6.4 At the third level (i.e. disregarding "co.uk"), one of the domain names, <duallock.co.uk>, consists entirely of the letters "duallock", which reflects very closely the text of one of the complainant's trade marks. Arguably, it is as identical to that trade mark as a domain name can be. But even if the fact that the domain name can be read as one word rather than two means it is not identical to the complainant's trade mark, it is obviously very similar to it.
- 6.5 The other domain name, <3mvhb.co.uk>, can be read as consisting of two elements, each of which is identical to one of the complainant's other trade marks. In my view, the fact that the domain name in effect combines two of the complainant's trade marks, and so can be read as including letters additional to each of them taken individually, does not make it dissimilar to either of them. On the contrary, the inclusion in the domain name of text identical to not one but two of the complainant's trade marks confirms its similarity to each of them.
- 6.6 Neither of the domain names includes any additional text not corresponding closely to one of the complainant's trade marks.

- 6.7 In those circumstances I am satisfied that the complainant has rights in respect of a name which is identical or similar to each of the domain names.

Abusive Registration

- 6.8 Under paragraph 1 of the Policy, abusive registration means a domain name which either:

- 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
- has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.9 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using a domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.

- 6.10 Although in this case neither of the domain names is, arguably, absolutely identical to any one of the complainant's trade marks, the extent of the similarities explained at paragraphs 6.4 to 6.6 above means both domain names use the complainant's trade marks in effect "unadorned". In those circumstances in my view some initial interest confusion is likely between the domain names and the complainant.

- 6.11 In relation to initial interest confusion, the Nominet DRS Experts' Overview, which summarises DRS experts' opinions on common issues under the Policy and the Procedure, states as follows at paragraph 3.3:

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.

In my view this case involves the use of the complainant's names in at least a very nearly unadorned way. The domain names are certainly not far away from the complainant's names.

- 6.12 In any event, applying the approach taken unanimously by the appeal panel in DRS 07991 *Toshiba Corporation v Power Battery Inc.* (<toshiba-laptop-battery.co.uk>), the fact that the respondent uses a domain name to sell competitors' products may render it an abusive registration, regardless of initial interest confusion. In that decision the Panel said (at paragraph 9):

... the Panel unanimously considers that, if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner's consent, to accord with the principles stated above that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent.

- 6.13 In this case, the complainant's evidence, which is not disputed, shows that the respondent sells adhesive products made by other manufacturers on websites connected to each of the domain names. In my view, this means the respondent has used each of the domain names in a manner which has taken unfair advantage of the complainant's rights.
- 6.14 The fact that the respondent sells the complainant's products does not in itself mean its use of the domain names is fair. Whether or not the respondent's competitors have domains including the words 3M and Dual Lock is in my view irrelevant.
- 6.15 For these reasons I am satisfied on the balance of probabilities that each of the domain names, in the hands of the respondent, is an abusive registration.

7 Decision

- 7.1 I find that the complainant has rights in a name which is similar or identical to each of the domain names; and that each of the domain names, in the hands of the respondent, is an abusive registration.
- 7.2 The complaint is upheld. I direct that the domain names be transferred to the complainant.

Carl Gardner

16 June 2010