

# DISPUTE RESOLUTION SERVICE

DRS 10044

## Decision of Independent Expert

E.I. du Pont de Nemours and Company

and

Indigo Industrial Supplies Limited

### 1 The parties

Complainant:	E.I. du Pont de Nemours and Company 2 Chemin du Pavillon Le Grand-Saconnex Geneva CH-1218 Switzerland
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Respondent:	Indigo Industrial Supplies Limited Unit 3b, Sopwith Crescent Wickford Bus Park Wickford Essex SS11 8YU United Kingdom
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### 2 The domain name

*Tyvekcoveralls.co.uk* (the "Domain Name").

### 3 Procedural history

- 3.1 The Complaint was filed on 5 July 2011. It was validated on 6 July and a copy was sent to the Respondent on the same date.

- 3.2 The Response was filed on 28 July and a copy was sent to the Complainant on the same date.
- 3.3 The Reply was filed on 1 August and a copy was sent to the Respondent on the same date.
- 3.4 The dispute then entered the mediation phase. The mediation failed on 2 September. On the same date the parties were notified that the dispute would be decided by an Independent Expert (the "Expert") if the Complainant paid the requisite fees. On 8 September a conflict check was sent to the Expert, who confirmed on 12 September 2011 that he is independent of the parties and knows of no facts or circumstances that might call into question his independence in the eyes of the parties.

## **4 Factual background**

- 4.1 The Complainant is the multinational company, E.I. du Pont de Nemours & Company, more commonly known as Dupont. Its well known brands include Dupont, Teflon and Kevlar. The Complainant is the registered proprietor of UK trade mark TYVEK registered on 23 November 1965.
- 4.2 The Domain Name was registered on 17 April 2007 by an entity named "Indigo". The registrant described itself as "a non-trading individual" and on that basis elected to have its contact details omitted from the publicly accessible part of the Whois database. The Response in this DRS proceeding was filed by a person named Paul Eastwood.
- 4.3 The Domain Name is currently pointing to a page of a website at *www.indigoshop.co.uk* (the "Indigo Website"), which appears to be an ecommerce website operated by Indigo Industrial Supplies Limited. It appears to supply a variety of articles for use in commerce and industry, including adhesive tape, floor and surface protection materials, packaging and work wear.
- 4.4 The page of the Indigo Website to which the Domain Name points offers for sale Tyvek Protech Disposable Coveralls. On that page are links to other pages of the Indigo Website, on which other products are offered for sale. The Indigo Website makes no mention of the Complainant.
- 4.5 Indigo Industrial Supplies Limited is a UK limited company number 04194976 with a registered office at Langford Hall Barn, Witham Road, Langford, Maldon, Essex CM9 4ST. As at 5 April 2011, Mr Eastwood was one of two directors of and shareholders in that company.
- 4.6 In the result, notwithstanding that the registration details provided to Nominet appear to have been incomplete, the Respondent is in fact Indigo Industrial Supplies Limited.

## **5 Parties' contentions**

### Complaint

- 5.1 The Complainant operates in over 90 countries and its turnover last year exceeded US\$32 billion. The Complainant provides an address at 1007 Market Street, Wilmington, Delaware, United States.

- 5.2 One of its product areas is "selective barrier technology and the production of protective fibrous materials", including in the manufacture of protective clothing. One of its best known brands in this field is TYVEK, a breathable but water resistant fabric. One of the Complainant's products in the Tyvek range of products is Tyvek coveralls.
- 5.3 The Complainant asserts that it is the registered proprietor of a UK trade mark in the TYVEK name in class 22 registered on 23 November 1965 with number 887332. The Complainant asserts that that trade mark is "just one of many UK registrations of the mark". However, no evidence is provided of any other registered trade marks.
- 5.4 The Complainant exhibits a screenshot of a Google search against the TYVEK name, which appears to show that all search results relate to the Complainant's brand. However, nothing further is said about the existence or extent of any trading goodwill or reputation in the TYVEK name.
- 5.5 The Complainant contends that the TYVEK mark is similar to the Domain Name. However, it goes no further than that bald assertion and provides no explanation as to why that might be the case.
- 5.6 The Complainant asserts that the Domain Name in the hands of the Respondent is an Abusive Registration as defined in the DRS Policy (the "Policy"). In support of that assertion, it relies on a number of contentions, as follow.
- 5.6.1 The Respondent is using the Complainant's registered mark to attract internet users to its website for commercial gain. Such commercial gain is said to be derived partly from the sale of Tyvek coveralls, but also from the sale of a wide range of other goods, including goods manufactured by a competitor of the Complainant.
- 5.6.2 There are links from the page of the Indigo Website selling Tyvek coveralls to other pages of the same website selling products which have no connection with the Complainant, such as printed tape, industrial wipes, polystyrene and, in particular, adhesive tape made by a competitor of the Complainant, 3M.
- 5.6.3 The Respondent is not an authorised distributor for the Complainant.
- 5.6.4 The Complainant states that: "The Domain Name effectively represents that it is the Complainant as if the Respondent had selected the company name Tyvek Coveralls Limited". It is not clear quite what the Complainant means by this, but it is assumed that this is in effect a complaint of passing off.
- 5.6.5 Internet users will assume that the site to which the domain name points is the official site for Tyvek coveralls, which it is not.
- 5.6.6 The Respondent has "falsely and dishonestly" described itself as a non-trading individual for the purposes of Nominet's Whois database.
- 5.7 The Complainant cites the Appeal Panel decisions in *EPSON Europe BV v Cybercorp Enterprises* (DRS 3027) and in *Seiko UK Limited v Wanderweb* (DRS 248) in support of its contentions in relation to Abusive Registration.

## Response

5.8 The Response is so brief that it may conveniently be set out in full:

*"hi, my response is:*

*we stock and sell the Tyvel [sic] brand of coveralls.*

*we are doing the same as the owner of www.tyvekcoveralls.com they are also not dupont but sell tyvek coveralls*

*regards*

*paul eastwood".*

## Reply

5.9 In its Reply the Complainant confines itself to responding to the second of the above submissions. It says that it is aware of the domain name *tyvekcoveralls.com* and the website to which it points and has taken "preliminary action" against the registrant of that domain name. It says that it sent the registrant a cease and desist email on 18 March 2010 asking the registrant to cancel its registration, that no response was received from the registrant, that it again contacted the registrant on 28 December 2010 and that it is "currently seeking advice in relation to next steps".

5.10 The Complainant therefore contends that there has been no acquiescence on its part in relation to the *tyvekcoveralls.com* domain name and the website to which it points.

## **6 Discussions and findings**

### General

6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

*"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 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."*

### Complainant's rights

- 6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". 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*".
- 6.4 The Complainant takes the fairly high risk route of relying exclusively on a single trade mark registration (see paragraph 5.3 above). It makes no attempt to assert, let alone evidence, any common law rights in the Tyvek name.
- 6.5 The Delaware address of the Complainant shown on the IPO registration details is different from the Geneva address of the Complainant in this DRS proceeding. However, in the Complaint itself, the Complainant provides its Delaware address, not its Geneva address. It is unclear whether this discrepancy is the result of an administrative oversight on the part of Nominet or on the part of the Complainant.
- 6.6 In those circumstances, and given that the identity of the registered proprietor of the trade mark relied upon and of the Complainant company in this proceeding is identical, it is accepted that the Complainant owns that UK trade mark. Accordingly, the Complainant has discharged the burden of proving that it has Rights in the TYVEK mark.
- 6.7 The Complainant contends that the TYVEK mark is similar to the Domain Name. While, strictly speaking, the Complainant has failed properly to make out a case in this regard, it would be unconscionable to ignore the line of DRS decisions pursuant to which it is now well established that the inclusion of generic or descriptive words together with a name or mark in which the Complainant has Rights does not mean that the domain name in question is so dissimilar that it falls outside paragraph 2(a)(i) (see *natwestloans.co.uk* (DRS3390), *tescoestateagents.co.uk* (DR3962), *replicarolex.co.uk* (DRS5764) and *veluxblind.co.uk* (DRS6973), by way of examples).
- 6.8 Accordingly, the Complainant satisfies paragraph 2(a)(i) of the Policy.

#### Evidence of Abusive Registration

- 6.9 The Complainant has failed clearly to set out its case on Abusive Registration, notably by omitting to identify on which of the (non-exhaustive) factors set out in paragraph 3(a) of the Policy it relies. The Complainant puts its case on Abusive Registration in very general terms, relying simply on the definition of Abusive Registration under the Policy set out at 6.2 above.
- 6.10 Two of the Complainant's contentions (see paragraphs 5.6.1 and 5.6.2 above) arguably fall within paragraph 3(a)(i)(C) of the Policy, which provides that circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant may constitute evidence of Abusive Registration.
- 6.11 However, the Complainant makes no positive case in this regard. It does not, for example, say that the Respondent is seeking to disrupt its business by diverting consumers who are looking for its products to the Respondent's website. Nor has it provided any evidence of such disruption, let alone evidence that an intention to cause any such disruption was the Respondent's primary motivation in registering the Domain Name.

- 6.12 Others of the Complainant's contentions (see paragraphs 5.6.3 to 5.6.5 above) arguably fall within paragraph 3(a)(ii) of the Policy, which provides that circumstances indicating that the Respondent is using 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 may be evidence of Abusive Registration. The Complainant has not supported its contentions in this regard with any evidence of such confusion.
- 6.13 The Respondent's position is that it is a reseller of Tyvek coveralls and therefore, presumably (though it does not develop its case this far), that there is no likelihood of confusion.
- 6.14 It does not, however, deny any of the following of the Complainant's assertions:
- that it is using the TYVEK mark to attract internet users to its website for commercial gain;
  - that there are links from the page of the Indigo Website selling Tyvek coveralls to other pages of the same website selling products which have no connection with the Complainant, such as printed tape, industrial wipes, polystyrene and, in particular, adhesive tape made by a competitor of the Complainant, 3M;
  - that it is not an authorised distributor for the Complainant;
  - that internet users will assume that the Indigo Website is the, or at least an, official site for Tyvek coveralls; and
  - that it has described itself as a "non-trading individual" for the purposes of Nominet's Whois database.
- 6.15 The position of resellers often arises under the DRS and useful guidance is to be found in both the Appeal decisions cited by the Complainant (see 5.7 above), as well as in the DRS Expert Overview document, in particular in paragraph 3.3 of the latter which comments on paragraph 3(a)(ii) of the Policy 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"?*

...

*Commonly, internet users will visit websites 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 be referred 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 website 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 website will use the domain name for that purpose.*

*In such cases, the speculative visitor to the registrant's website will be visiting it in the hope and expectation that the website is a website "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 website 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 ... a commercial website, 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 ... The activities of typosquatters are generally condemned ... 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)."*

- 6.16 Applying that guidance and those decisions to the facts of this case, a number of relevant considerations may be identified.
- 6.17 First, it is common ground that the Respondent is using the Domain Name to point to its Indigo Website, which sells not just the Complainant's products but also a wide variety of other products, including products manufactured by a competitor of the Complainant.
- 6.18 Secondly, it is more than likely that the Domain Name falls foul of the distinction drawn in the Seiko case between the domain name *seiko-shop.co.uk* and a name such as *we-sell-seiko-watches.co.uk*. As in the Seiko case, in this case, notwithstanding that the true position may become apparent after the internet user finds himself on the Indigo Website, there is, initially at least, a representation that the Domain Name is authorised by or otherwise connected with the owner of the rights in that name. As the Appeal Panel put it in that case:

*"That it is unfair for a mere agent to appropriate to himself the trading style of its principal is a well-established principle of UK and international law. Section 60 of the 1994 Act, importing into UK law Article 6 septies of the Paris Convention, allows for the refusal of the trade mark application that has been applied for by an agent or representative, if the rightful proprietor of the mark opposes the application."*

- 6.19 In the present case, it is not even as if the Respondent is an agent of the Complainant. But even if it were, the answer to the question whether the Complainant could have successfully opposed registration by the Respondent of a trade mark in the TYVEK COVERALLS name, or for that matter registration of a company named Tyvek Coveralls Limited, is plain. It could have.
- 6.20 Accordingly, the Expert is satisfied, on the balance of probabilities, that initial interest confusion is likely to have occurred as a result of the Respondent's adoption and use of the Domain Name, which incorporates as an appendage to the Complainant's mark the

purely descriptive word "coveralls". As anticipated in the Expert Overview, a Google search against "Tyvek coveralls" does indeed return as a result, on the first page, the Indigo Website.

- 6.21 Thirdly, it is common ground that the Respondent is not in fact an authorised distributor of the Complainant's products, nor is there any question of the Complainant having authorised or consented to the Respondent's registration of the Domain Name.
- 6.22 Fourthly, the Respondent does not rely on any of the exculpatory factors set out in paragraph 4 of the Policy, nor does it appear to the Expert that any of those defences could have been made out by the Respondent, even if it had pleaded them.
- 6.23 The only other defence put forward by the Respondent (in addition to that set out at 6.13 above) is that the registrant of the domain name *tyvekcoveralls.com* is doing the same as the Respondent. The Complainant has explained that it is taking steps in relation to the registrant of that domain name, albeit at a somewhat leisurely pace. Acquiescence or waiver probably does not therefore arise. In any event, the fact that a third party may be similarly misusing the Complainant's mark is neither relevant nor persuasive.
- 6.24 Finally, there is the uncertainty as to the identity of the Respondent (see paragraphs 4.2 to 4.6 above), including in particular the fact that the Respondent represents that it is a "non-trading individual" which appears simply to be incorrect. That is hardly indicative of good faith.
- 6.25 Accordingly, for the reasons set out at 6.17 to 6.24 above, the Expert is satisfied, on the balance of probabilities, that the Domain Name has been used in a manner which took unfair advantage of the Complainant's Rights in the TYVEK mark and/or was unfairly detrimental to those Rights.

## **7 Decision**

- 7.1 Accordingly, the Expert finds that the Complainant has Rights in 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.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

**Signed David Engel**

**Dated 3 October 2011**