

DISPUTE RESOLUTION SERVICE

D00011132

Decision of Independent Expert

Draper Tools Limited

and

P R Services (Yorkshire) Ltd

1. The Parties:

Complainant: Draper Tools Limited
Hursley Road
Chandlers Ford
Eastleigh
Hampshire
SO53 1YF
United Kingdom

Respondent: P R Services (Yorkshire) Ltd
Unit 3 Fernley Green Industrial Estate
Fernley Green Road
Knottingley
West Yorkshire
WF118DH
United Kingdom

2. The Domain Name(s):

tools-draper.co.uk

3. Procedural History:

30 March 2012 11:10 Dispute received
02 April 2012 12:25 Complaint validated
02 April 2012 12:29 Notification of complaint sent to parties
23 April 2012 02:30 Response reminder sent
25 April 2012 10:49 Response received
25 April 2012 10:51 Notification of response sent to parties
03 May 2012 09:03 No reply received
03 May 2012 09:03 Mediator appointed
03 May 2012 09:49 Reply received
03 May 2012 09:53 Notification of reply sent to parties
09 May 2012 09:37 Mediator appointed
09 May 2012 09:44 Mediation started
22 May 2012 16:30 Mediation failed
22 May 2012 16:32 Close of mediation documents sent
05 June 2012 02:30 Complainant full fee reminder sent
07 June 2012 14:50 Expert decision payment received

4. Factual Background

The Complainant's business is in the tools industry. Draper Tools started trading in 1919. The Complainant now sells products in all major tool categories including the automotive, builders, DIY, gardening, construction, decorating and engineering sectors. The Complainant operates a website at www.draper.co.uk which has given it an international presence in addition to its UK trade. It also operates a range of "draper" branded domain names including, but not limited to, draper-tools.co.uk, drapertools.com, drapertools.ie, drapertools-online.com, draper.pl, drapertools.es, drapertools.fr, drapertools.rs.

The Complainant owns a number of registered trade marks featuring the DRAPER mark. These include registrations; 1121350 (registered in 1979), 1261372 (registered in 1986) and 2106572 (registered in 1996) all of which are word only marks registered in classes 8, 6 and 7 of the UK Trade Mark Register respectively for goods including hand tools and parts and fittings, tool boxes and cabinets and compressors and pneumatic tools. It also owns a trade mark featuring a device mark and the words DRAPER THE TOOL COMPANY registered in 1990 for hand tools and parts and fittings (1419698).

The Respondent registered the Domain Name on 2 October 2009. It can be inferred from the documents and annexes in this matter that the Respondent is a distributor of tools made by a range of manufacturers, for example ROCOL and Sealey.

It is clear from the Parties' submissions that the Domain Name has been used by the Respondent in the past in connection with a website, although this use

is not current. No screenshots of the historic use have been supplied to the Expert, but it is possible to infer some details from the Parties' submissions (see section 5 of this Decision below). The Respondent states that this website, and any links to other websites have been closed down until a decision is made on this Complaint. A search by the Expert on 25 June 2012 confirmed that the Respondent's website was not operational.

5. Parties' Contentions

The Complaint

The Complainant asserts that it has exclusive rights to the mark DRAPER TOOLS and relies on its registered trade marks and the extent of use of the DRAPER mark in support.

It submits that the Respondent's use of the Domain Name has caused damage and confusion in the following ways (these submissions are at the date of the Complaint, 30 March 2012):

1. Web users specifically searching for branded Draper tools may believe that the site that the Respondent is operating belongs to, or is operated by or on behalf of the Complainant. The Respondent's site as at the date of the Complaint was poorly designed which may well lead a user to associate the poor quality of the site with the Complainant.
2. Casual browsers aware of Draper branded products may believe that the Respondent is the actual owner or licensee of the Draper registered trade mark.
3. Other independent Draper retailers might wrongly conclude from the use of the Domain Name that the Respondent has an exclusive trading agreement with the Complainant for allowing the use of the trade mark and brand and that such an arrangement is grossly unfair to their businesses. This is extremely detrimental to the Complainant, not just in the UK but internationally.
4. Further confusion is brought by the fact that the Respondent's site is redirected to another site, www.xxx-tools.co.uk which appears to be still under construction. This site makes no mention of the brand Draper Tools, nor are any Draper Tools products listed on the site. By accessing the www.tools-draper.co.uk domain, the user is being redirected to a site that features only Sealey products. This is a deliberate and malicious attempt to direct business away from Draper Tools. Sealey are a company supplying a near identical range of products to Draper Tools and are seen as a close rival in the tools industry. This redirection also wrongly implies a relationship between Draper Tools and Sealey products.
5. Search engine results for "Draper Tools" will undoubtedly include records for the Domain Name. The short synopsis included with these records does nothing to rectify the misconception that the site probably belongs to the

Complainant. An individual would have to visit, explore and possibly contact the site owners to identify the true status. The Domain Name in the hands of the Respondent could therefore be construed as an instrument of deception.

The Complainant has made a number of approaches to the Respondent to resolve the situation but the Respondent has made no counter offer or proposal to resolve the matter.

The Response

The Respondent refers to a history of dealings between the parties. It asserts that it has been communicating with the Complainant since 28 July 2009 and has been a distributor of the Complainant's products for at least the last 4 years. It seeks to demonstrate the trading relationship between the parties by supplying to the Expert a copy invoice dated 4 April 2012 for the supply of goods by the Complainant to the Respondent. It also provides copies of data files about the Complainant's products which were supplied to it by the Complainant during 2009. The Respondent claims that the Complainant was fully aware of its intentions in setting up the domain names tools-draper.co.uk, and xxx-tools.co.uk as well as a third website at prservicesyorkshire.co.uk.

For the duration of the life of all of its websites the Respondent states that it has always had a clear statement that it is not nor part of Draper Tools. All of the above sites have always clearly set out with the Respondent's contact information. This information would be enough for most customers to conclude that the Respondent has never tried passing itself off as the Complainant. There is also no inference that can be drawn that the Respondent has an exclusive trading agreement with Draper Tools Ltd because the Respondent has never used the Complainant's trademark. The Respondent draws attention to other websites incorporating the DRAPER mark as examples of businesses which appear to be using the DRAPER mark without the Complainant's permission.

The Respondent casts doubt on the Complainant's motivations in bringing the Complaint. It points out that in July 2010 a business called Plumbworld launched an e-commerce site specialising in the sale of Draper branded tools. A press release to this effect dated 23 July 2010 is supplied with the Response. The Respondent received an email in the second half of 2010 from Plumbworld asking to purchase the Domain Name. The Respondent now concludes that the Complainant is seeking to reverse hijack the Domain Name on Plumbworld's instructions in order to restrict competition on the Internet and to create an unfair advantage for one of their distributors.

In relation to the website at www.xxx-tools.co.uk, the site is still under construction and hence draper tools have not yet been added due to time constraints. As far as a relationship being implied between the Complainant and Jack Sealey Ltd this submission is rejected. A customer walking into a large retail outlet would see Draper, Stanley, Sealey, Bosch and Toolstream products, along with many other makes, side by side. A customer would not

conclude a relationship between all the makes from this arrangement, only that they were distributed by the same retailer.

Draper Tools Ltd have had every opportunity to advertise their products on a fair and business like basis on all three of the Respondent's domains free of charge.

The Complainant is incorrect when it alleges that the Respondent has done nothing to resolve the dispute between the parties. During a meeting in December 2011 it intimated that if the ownership of the Domain Name was such a problem the Complainant could make a reasonable offer to cover the Respondent's costs of developing the site. This was then followed up by a letter sent to the Complainant dated 18/12/2011 to which no reply was received. A copy of the letter is attached to the Complaint.

The Respondent feels it has done everything in its power to accommodate the Complainant during the trading relationship and that the Complainant has actively encouraged it to promote its products through the Respondent's sites. This relationship changed with the possible involvement of Plumbworld and it believes that the Complainant is now acting to create an unfair advantage for one of their other distributors.

The Reply

The Complainant clarifies that its objection is solely to the use of the Domain Name in connection with the sale of non-Draper products and not to the Respondent's other websites.

Relationship between the Parties- The access to data files that was given to the Respondent was the same as would have been given to any trading partner. It does not imply permission to use the information on any website set up by the trading partner. The Respondent has placed no business with the Complainant in 2012 apart from the single order referred to in the attached invoice.

*Allegations regarding Plumbworld-*The Respondent's submission regarding Plumbworld is rejected. There has never been collusion with Plumbworld to restrict competition. The accusation regarding reverse hijacking will be the subject of further action outside of the Nominet Dispute Resolution Procedures.

Third party websites- steps are being taken in respect of the third party domain names to which the Respondent refers. The Complainant has not consented to use of its trade mark by the businesses concerned.

*Measures taken to resolve the matter-*The offer to purchase the domain was rejected in December 2011 because at the time the Complainant did not consider the ownership of the domain to be an issue. At that stage, it wanted the Domain Name taken down and saw no reason why it should compensate

the Respondent's development costs for a site which it had not requested and that compromised its intellectual property.

The Respondent's letter dated 18th December came after a letter from the Complainant dated 9 December 2011 stating that the Complainant would be commencing Nominet action. As such, it felt that a further reply was inappropriate and that all future correspondence should be through Nominet.

6. Discussions and Findings

Under Paragraph 2 of the Nominet Dispute Resolution Service Policy (the Policy) In order for the Complainant to succeed it must establish on the balance of probabilities, both:

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 as defined in Paragraph 1 of the Policy.

Rights are defined in Paragraph 1 of the Policy as follows;

"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."

If the Complainant satisfies the Expert on the balance of probabilities that it has relevant rights, the Expert must consider whether the registration and/or use of the Domain Name by the Respondent are abusive.

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

"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".

Rights

The Complainant has established that it owns a number of registered trade marks in the DRAPER mark in the UK in respect of goods connected with the

tools industry. These registrations confer rights in the DRAPER mark as defined by the Policy. In addition to registered rights in the DRAPER mark, the Expert accepts the Complainant's submission that its length and extent of use of the mark have conferred unregistered rights on the Complainant in the goodwill generated by the DRAPER mark.

It is also relevant that the Complainant owns at least one mark which features its DRAPER mark in combination with the word "TOOL" (trade mark registration 1419698 featuring a device mark including the words DRAPER THE TOOL COMPANY" referred to in section 4 of this decision). This registration establishes that the word "tool" has been used in combination with the DRAPER mark to identify goods as originating from the Complainant.

Under Paragraph 2 of the Policy, having established Rights in these marks, the Complainant must establish that the marks are identical or similar to the Domain Name. It is customary to ignore the ".co.uk" suffix.

The Domain Name adds a prefix to the DRAPER mark consisting of "tools-". The question is whether the addition of this prefix displaces the connection with the Complainant's mark. The Expert finds that it does not. The dominant element of the Domain Name is the DRAPER component. The word "tools" has no independent brand significance. This finding is reinforced by the fact that tools are precisely the product with which the Complainant and its mark are associated and that the words "DRAPER" and "TOOL" have been used by the Complainant in combination as a trade mark. The fact that the Domain Name features an unusual juxtaposition of word "tools Draper" rather than "draper tools" does not displace the association with the Complainant.

For these reasons, the Expert finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name. The first requirement of the Policy has been satisfied.

Abusive Registration

The Complainant bases its Complaint on the way that the Domain Name has been used by the Respondent. There are no submissions to indicate that the initial registration of the Domain Name in 2009 was in itself an Abusive Registration. The Complainant has therefore to show that on the balance of probabilities the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

There are a number of peripheral submissions in this matter which do not affect this central issue. The willingness or otherwise of the parties to resolve the matter amicably is not a relevant factor. The motivation of the Complainant in bringing the claim is also not a relevant factor under the DRS Policy or Procedure. Even if it were, the Respondent has not established even a prima facie case that the Complainant is bringing this Complaint in bad faith. The allegation of anti-competitive collusion between the Complainant and Plumbworld appears groundless on the information before the Expert and she has disregarded it in reaching this Decision.

Ultimately the issues to be decided are:

(a) how did the Respondent use the Domain Name and did it amount to use which took unfair advantage of or was unfairly detrimental to the Complainant's Rights?

(b) did the Complainant consent to the Respondent's use of the DRAPER mark?

Issue (a)

The use to which the Domain Name has been put is a matter of inference. There is no direct evidence before the Expert. The Complaint breaks down into two main components. The first relates to the quality and content of the website operated at the Domain Name. The Complainant objects to its quality and to the fact that the website created the mistaken impression that the Respondent was an exclusive distributor of the Complainant's products. On the information available, the Expert finds that the Complainant has failed to prove its case on the balance of probabilities. On the one hand, it produces no evidence about what the website looked like. Nor does it provide evidence that customers or other relevant sections of the trade were confused into thinking that the website was operated or authorised by the Complainant. On the other hand, the Response contains assurances that care was taken by the Respondent not to pass itself off as having any formal connection with the Complainant. The balance of evidence is clear. There is therefore nothing before the Expert to support a finding that use of the Domain Name in connection with the website contravened the Policy.

The second type of use of the Domain Name referred to in the Complaint is the link of the tools-draper website to another site operated by the Respondent at xxx-tools.co.uk. This site was under development at the time of the Complaint but it is clear that it was offering for sale only products from tool manufacturers who were in competition with the Complainant e.g. Sealey. The Respondent does not deny this in its Response but points out that because the site was in development at the time of the Complaint there had been no time to include reference to the Complainant's products.

It is the view of the Expert that this use of the Domain Name to link to the xxx-tools website was an Abusive Registration. The use took unfair advantage of the Complainant's rights in the DRAPER mark. The Respondent argues that there is nothing unfair about its website and likens it to a customer in a shop looking at rows of competing products. But this analogy is not accurate. There were no Draper products on display. Even if there has been, the customer's very presence in the virtual showroom has been achieved because of the use of the DRAPER mark. The Respondent was therefore exploiting familiarity with the DRAPER mark to divert custom to other manufacturers. It is also possible that the use has caused unfair detriment to the Complainant's Rights in terms of diverted custom. It makes no difference to this finding that the

Respondent had plans to extend the site to include the Complainant's products.

Issue (b)

The Expert now has to consider the Respondent's submission that the Complainant was aware of the linking of the Domain Name to the xxx-tools.co.uk website and by implication had consented to it.

There was clearly a business relationship of sorts between the Parties dating back from 2009 and continuing, albeit in a limited way, up to 2012. This is evidenced by the parties' submissions and by the supporting documents annexed to the Response. In the Reply, the Complainant clarifies that the relationship amounted to that of standard trading partner and did not amount to a permission to use trading information on the Respondent's website. In contrast, the Respondent states that the Complainant was fully aware of its intention to set up its websites, including the site operated under the Domain Name. Ultimately, the exact detail of the relationship between the Parties cannot be determined on the information available. However, there is an absence of evidence to indicate that the Complainant agreed to the DRAPER mark being used to link to a website selling competing products. Any such agreement would be unusual and would require proof. In these circumstances, the Respondent is not able to displace the Expert's primary finding that the use of the Domain Name was abusive.

The Expert therefore finds that the use of the Domain Name by the Respondent to divert custom to its more general xxx-tools website amounts to an Abusive Registration.

In conclusion, the Expert finds that the Complainant has satisfied the requirements of Paragraph 2 of the Policy and the Complaint succeeds.

7. Decision

The Domain Name to be transferred to the Complainant.

Signed: Sallie Spilsbury Dated: 29 June 2012