

DISPUTE RESOLUTION SERVICE

DRS11743

Decision of Independent Expert

H-D Michigan LLC

and

Brian Watson

1. The Parties:

Lead Complainant: H-D Michigan LLC
315 W. Huron Street, Suite 400
Ann Arbor
MI
48103
United States

Respondent: Brian Watson
6 Southbrae Drive
Glasgow
Scotland
G13 1PX
United Kingdom

2. The Domain Name(s):

Harley-Davidson-tours.co.uk

3. Procedural History:

06 August 2012 12:25 Dispute received
07 August 2012 11:25 Complaint validated
07 August 2012 11:29 Notification of complaint sent to parties
13 August 2012 10:08 Response received
13 August 2012 10:08 Notification of response sent to parties
16 August 2012 02:30 Reply reminder sent

16 August 2012 12:41 Reply received
16 August 2012 12:43 Notification of reply sent to parties
16 August 2012 12:43 Mediator appointed
22 August 2012 12:55 Mediation started
22 August 2012 12:58 Mediation failed
22 August 2012 12:59 Close of mediation documents sent
22 August 2012 14:04 Expert decision payment received

Cerryg Jones, the undersigned, (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual Background

The Complainant is the well know manufacturer of Harley-Davidson motorcycles. It also trades in associated products and services. These include motorcycle hire, factory tours and guided motorcycle tours on Harvey-Davidson motorcycles undertaken through approved tour operators.

The Respondent is an individual based in Glasgow, United Kingdom. He is the company secretary, shareholder and sole director of a business called Harley Davidson Tours Limited, which was incorporated on 26 January 2010. He registered the Domain Name on 3 January 2010. The Respondent’s company offers motorcycle holiday tours exclusively on Harley-Davidson motorcycles.

The Domain Name Resolves to the URL www.harley-davison-tours.co.uk, which promotes the Respondent’s business. The bottom of the home page carries the following disclaimer:

“Harley-Davidson Tours Ltd is an independent Scottish registered company that is not associated with Harley-Davison Motor Company.”

Correspondence between the parties failed to resolve the dispute over the Domain Name. An offer to purchase the Domain Name was rejected.

5. Parties’ Contentions

Complainant’s Submissions

Rights

The Complainant makes the following submissions:

- 1 It began in 1903 and is now one of the most successful motorcycle manufacturers and iconic brands in the world. Its annual report filed with the Complaint reveals revenue in 2011 of USD\$5.31 billion.

- 2 The Harley-Davidson brand was voted the third of the UK's "Coolest Brands" for 2011/12 in a study co-ordinated by The Centre for Brand Analysis and covering over 10,000 independently identified brands.
- 3 It has a very large following amongst its customers; the Harley Owners Group has more than one million members.
- 4 Revenue derived from non-motorcycle manufacture amounted to USD\$259.1 million in 2010. These areas of business include merchandising, clothing, motorcycle hire, factory tours (which began in 1919) and guided motorcycle tours carried out through approved tour operators, (which commenced in 2009).
- 5 There are comprehensive world-wide registered (and unregistered) rights for Harley-Davidson, including:
 - (a) Community trade mark, no 1797018 filed on 07 August 2000.
 - (b) UK trade mark, no 658029 on 9 April 1947.
 - (c) US registered trade mark, no 71531112 filed on 12 August 1947.
- 6 The addition of "tours" does not distinguish the Domain Name from Harley-Davidson, particularly because of the Complainant's tour business, evidence of which is supplied in the form of:
 - (a) a factory tour leaflet dating from around 1928.
 - (b) material relating to tours of its facilities in York, Pennsylvania; Tomahawk, Wisconsin; Kansas City, Missouri and Menomonee Falls, Wisconsin (an estimated 64,000 visitors across all sites in 2011)
 - (c) extracts from the Harley Owners Group magazine (distributed to approximately 100,000 Harley Owners Group members across Europe, the Middle East and Africa on a quarterly basis), including:
 - (i) Spring 2009 issue - Harley-Davidson authorized tours - we don't do direct, we do interesting
 - (ii) Spring 2009 issue - 2010 AT A GLANCE - Harley-Davidson Authorized Tours. On Tour In Europe.
 - (iii) Autumn 2009 issue - "My Harley® adventure"
 - (iv) Spring 2010 issue - 2010 AT A GLANCE - Harley-Davidson Authorized Tours.
 - (d) The website www.authorizedtours.Harley-Davidson.com, which is dedicated to the promotion of the Complainant's motorcycle tours. Between 1 September and 24 November 2011, the Complainant claims it received 20,904 site visits, 76,215 page views and 270 contact requests, enquiries or reservations related to its tours.

- 7 DRS 06973 is said to support the Complainant's case. In that regard the following comment by the expert is cited:

"The Domain Name consists of the Complainant's distinctive trademark and the descriptive word "blind", which does nothing to distinguish the Domain Name from the mark, since the mark is associated in the public mind with the Complainant's blinds."

- 8 The Complainant has unregistered rights in respect of names or marks which are identical or similar to the Domain Name because of its use of the mark Harley-Davidson Tours, which predates the registration of the Domain Name.

Abusive Registration

The Complainant makes the following submissions in support of its allegation that the Domain Name constitutes an Abusive Registration:

- 9 First, that the Domain Name causes unfair detriment to and takes unfair advantage of the Complainant's business because its authorised tour operators are required to adhere to a strict and detailed Standards and Procedures Manual (a redacted copy of which was exhibited to the Complaint). The Complainant cannot control the quality of the Respondent's tours as he is unauthorised.

- 10 This lack of control creates a risk that the Respondent's tours will not be of the same standard as the Complainant's. This might damage the Complainant's reputation because the public will attribute the use of the Domain Name to the Complainant.

- 11 Under the Complainant's website and email guidelines, authorised tour operators are not permitted to use domain names which may have the potential to cause confusion. The Complainant refers to the following extract from its manual:

Tour Operator domain names must conform as closely as possible to the Tour Operator's DBA name. Domain names which refer generally to Harley-Davidson Motor Company or any of its specific Trademarks, products or services (e.g., tour-a-harley.com; harleybikesforrent.com, harleytours.com, tourhd.com, etc.) are reserved for use by Harley-Davidson Motor Company and may not be reserved by any one Harley-Davidson® Authorized Tour Operator for its exclusive use.

- 12 This restriction also applies to any domain names that end with a country code extension, irrespective of whether the reference is to Harley-Davidson Motor Company or any of its trade marks, or whether the language used is English or another language.

- 13 At Harley-Davidson Motor Company's discretion, authorised tour operators who may already have registered domain names inconsistent with this policy may be required to assign such domain names.

- 14 Because of such restrictions, the Complainant claims there is a paucity of third party domain names which include Harley-Davidson.
- 15 In these circumstances, the Respondent's inclusion of the Harley-Davidson mark within the Domain Name accentuates the detriment caused to the Complainant's mark, reputation and brands.
- 16 Secondly, the Respondent's use of the Domain Name falls outside permitted uses of a third party registered trade mark. It has been used in a manner which is likely to confuse the public into believing that the Respondent is the Complainant itself, or is approved by, or associated or affiliated with, the Complainant, not least because of the Complainant's trade in motorcycle tours.
- 17 In this respect, the Complainant refers to the Appeal Panel decision in DRS 07991, and the four principles which, the Complainant submits, are material to its Complaint:

It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.

A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.

Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.

Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.

- 18 The Complainant also refers to Paragraph 3.3 of the Expert's Overview, which states:

"The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration".

- 19 The Complainant contends that the natural way of describing or promoting the Complainant's own tours via a domain name is through the combination of its Harley-Davidson mark and the term "tours". The Respondent chose to adopt the Domain Name so it could benefit from initial interest confusion and the additional traffic it would bring to his website.
- 20 The Complainant alleges that the content of the Respondent's website does not dispel the confusion; the initial paragraph on the Respondent's website states:

Our motorcycle tours offer a luxury vacation at an affordable price and are a unique alternative to the typical biking holiday; you will travel at a leisurely pace, live in quality accommodation, explore wonderful locations, visit interesting places, eat wholesome local produce and of course you will be riding some fantastic roads on an iconic Harley-Davidson.

- 21 The Complainant claims that an internet user would assume from this that the Respondent is either the Complainant or an authorised tour operator.
- 22 At the time of the Complaint, it is alleged that the only indication that the website is not endorsed by the Complainant is the trade mark notice and design credit which appears at the bottom of the first page (which are ineffective):

Harley-Davidson® is a registered trade mark of Harley Davidson Motorcycles Inc

© 2010 - 2011 Design: Brian Watson & Co.

- 23 The Complainant further contends that the Domain Name must necessarily have been made in a manner which took unfair advantage of the Complainant's Rights because of the prominence of the Harley-Davidson mark.
- 24 The Complainant contrasts the Domain Name with an alternative hypothetical use of its mark as in "Unofficial Tours on Harley Davidson Motorbikes" which the Complainant considers might go some way towards dispelling initial interest confusion.
- 25 The Complainant cites DRS 00058 in support, which concerned the registration of nokiaringtones.co.uk. The Complainant alleges this case is analogous to the present dispute, citing the following expert comment:

The Respondent's arguments that the use of NOKIA is merely descriptive and somehow in accordance with honest practices in such matters are entirely unconvincing. Such arguments might conceivably have had some merit if the Respondent had adopted a more realistically descriptive domain name such as "ringtones4nokiaphones.co.uk"

- 26 The Complainant submits that the Domain Name is indistinguishable from the Harley-Davidson mark and that it is not a merely descriptive or a generic use.
- 27 Thirdly, the Complainant contends that the Domain Name, as operated by the Respondent, unfairly disrupts the business of the Complainant. This is because internet users searching for information about the Complainant's motorcycle tours will be diverted to the Respondent's website. Once they arrive at the Respondent's site they may purchase the Respondent's products and services at the expense of the Complainant's tour business.

- 28 The Complainant says this is not fair competition because its marks are being wrongly appropriated to promote a rival business.
- 29 The Complainant submits that although the Domain Name is a reflection of the Respondent's company name, this does not assist the Complainant in this case. In this respect, the Complainant refers to Paragraph 1.7 of the Expert's Overview: -
- "Can a company name registration (per se) give rise to a right within the definition of Rights?"*
- The consensus view of recent Experts' meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose.*
- 30 The Complainant alleges that the Respondent cannot have used the Domain Name in connection with a genuine offering of goods and services because:
- (a) the Domain Name makes illegitimate use of the Complainant's Harley-Davidson marks;
 - (b) the Respondent is not a licensee of the Complainant; and
 - (c) the Respondent has not received any permission or consent from the Complainant to use its trade marks.
- 31 Nor can the Domain Name be described as generic or descriptive as it is designed to trade off and benefit from confusion with the Harley-Davidson mark and its extensive reputation.

Respondent's submissions

The Respondent makes the following submissions:

- 1 The Domain Name is operated by Harley-Davidson Tours Limited, a company registered in Scotland (No. SC371750). The Respondent is a director and shareholder. Domain name registrations for a motorcycle tours business, including the Domain Name, were made broadly contemporaneously with the application to register the company name.
- 2 After registration of the Domain Name, the company's representative, Planet Domain, was instructed to amend the registrant details from the Respondent to Harley-Davidson Tours Ltd following its incorporation. The Respondent believes the instruction has only recently been implemented. He accepts that he is the beneficial owner of the company operating the Domain Name and that no distinction need be drawn between the two for the purposes of this Complaint.

- 3 The Domain Name promotes the Respondent's motorcycle tour business, which exclusively uses Harley-Davidson motorcycles. He cannot realistically promote his business without using the Harley-Davidson mark.
- 4 Harley-Davidson Tours appropriately describes the Respondent's business and the Domain Name should be considered as a case of nominative fair use. Upholding the Complainant's objection will create a monopoly on the use of the Harley-Davidson mark.
- 5 The Respondent's business grew from an initial request for advice in 2005 from a group of friends based in the USA who were planning a motorcycle tour of Europe. The Respondent is an experienced motorcyclist of around 38 years standing, and a qualified senior observer with the Institute of Advanced Motorists. He has extensive knowledge of the routes in Scotland, and other areas, that motorcyclists are likely to find most interesting and challenging.
- 6 He realised renting motorcycles in the region to be toured offered a better solution to owners than transporting their motorcycles to the holiday destination. Harley-Davidson had a growing number of dealers who operated rental fleets using new and well maintained bikes. The Respondent recognised that partnering with these providers would ensure the quality of machines that he needed for this new business.
- 7 The business took some time to come to fruition because the Respondent wanted to obtain feedback on his proposed tour packages. Due to other work commitments, his venture was put on hold until late 2009 when the Respondent began preparations for the 2010 season.
- 8 The Respondent wanted to enter into a formal partnership or trading relationship with Harley-Davidson, but this failed to materialise.
- 9 The Respondent sets out a detailed time line which in his view establishes that:
 - (a) he initiated contact with the Complainant;
 - (b) he conducted due diligence as to his entitlement to use the Domain Name;
 - (c) he sought to engage the Complainant prior to embarking on his business to ensure that any concerns they may have had were addressed;
 - (d) he communicated his plans for his business to the Complainant at the outset, and that he inferred from its failure to respond that it did not have any legal objections to the Respondent's business;
 - (e) in the period between the Complainant's failure to respond to the Respondent and this Complaint, he has incurred effort and expense on search optimisation, and other costs such as stationary,

brochures, other marketing materials, t-shirts, and high visibility vests which all bear reference to Harley-Davidson Tours Limited.;

- (f) he was properly entitled to seek compensation for transfer of the Domain Name to mitigate the expenses he would have to incur in rebranding;
 - (g) the Complainant's offer to purchase the Domain Name (and others) was insufficient; and
 - (h) that he has acted entirely properly throughout.
- 10 It was reasonable for the Respondent to expect a response from The Complainant's Licensing department.
- 11 The Respondent has made every endeavour to avoid any infringement of the Complainant's rights.
- 12 The use of "Harley-Davidson" has become pervasive and is now synonymous with motorcycling. The words "Harley-Davidson tour" can be used to describe any motorcycle tour and cannot be reserved exclusively for the Complainant. In those circumstances, he rejects the suggestion that he cannot use this mark in the absence of a licence.
- 13 The Respondent says he was "oblivious" to the Harley Owners Group publications cited in the Complaint but accepts he did see a press release dated 15 December 2011 entitled "Harley-Davidson launches Global Authorised Tours Programme". However, he says that this press release was published two years after the Respondent registered the Domain Name.
- 14 The Respondent claims that his business is of benefit to the Complainant as he has introduced Harley-Davidson bikes to a wider audience.
- 15 The Respondent accepts that he is not a member of the Complainant's authorised tour programme but that this was not through any want of trying. In any event, the Complainant itself is not responsible for the authorised tours as they are operated through independent tour operators who pay a fee to the Complainant.
- 16 The Respondent dismisses as irrelevant the fact that the Complainant imposes controls on its authorised tour operators; the Respondent runs a highly professional and ethical business, which is fully compliant with the relevant regulatory regime, and which carries appropriate professional indemnity and other insurance.
- 17 The Respondent adds that he would not knowingly do anything illegal or unethical; all of his tour guides are either senior observers from The Institute of Advanced Motorists or retired police motorcyclists.
- 18 His tours have all been accident free and no complaint has ever been received by him or his company. The Respondent believes that his business

would meet all criteria set out in the Complainant's terms and conditions with tour operators, with the exception of his adopted business name.

- 19 The Respondent says he supports all efforts to eradicate cyber squatters and abusive registrations. He contrasts, favourably, his own website, which promotes Harley-Davidson, to the website located at the URL www.Harley-Davidson-tours.com. He claims this site promoted motorcycle touring in Poland, predominantly featured Honda motorcycles and did not contain a single image of a Harley-Davidson within the site content.
- 20 The Respondent distinguishes the present case from the DRS decisions cited by the Complainant, which concerned use of the trade marks Velux, Toshiba and Nokia, because they promoted competitors' products.
- 21 By contrast the Respondent only offers Harley-Davidson motorcycles on his tours and they are supplied wherever possible by Harley-Davidson dealers.
- 22 The Respondent says he invariably introduces his clients directly to the appropriate rental agent and that he receives no commission or other reward for so doing. In addition, the Respondent has received many requests for rental only services and that these leads are passed over as a goodwill gesture to a rental agent in the area of interest wherever possible.
- 23 The Respondent refers to Toyota Motor Sales, U.S.A., inc. v Farzad Tabari & Lisa Tabari in the United States Court Of Appeals For The Ninth Circuit No. 07-5534.
- 24 This case involved the domains buy-a-lexus.com and buyorleaselexus.com in connection with the Defendant's genuine business in relation to Lexus vehicles. The Defendant's use was held to be nominative, fair use.
- 25 Although the Respondent accepts that this case is not under Nominet's jurisdiction, it is said to be analogous to the facts of this dispute.
- 26 The Respondent also refers to DRS 00009096 in support of his position, which concerned the domain name shabby-chic.co.uk. The complainant in that case failed to prove that that the disputed domain name was an Abusive Registration. The Respondent says the Complainant itself recognises that this case is analogous in certain respects to the facts of DRS 00009096.
- 27 The Respondent says that some of the DRS cases cited by the Complainant did not involve trade in genuine products, and that in those circumstances it was inevitable that the registrations were held to be abusive.
- 28 Harley-Davidson Tours Limited operates the Domain Name and is similar to the Domain Name. As such 4aiB of the DRS Policy is satisfied; this states that a factor which may be evidence of a non-abusive registration is that before being aware of the Complainant's cause for complaint, the Respondent has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

29 The Respondent admits that the Domain Name has a commercial purpose but denies that any attempt has been made to trade off, or create confusion with, the Complainant's reputation.

30 The Respondent says the Complainant's evidence in respect of the Respondent's website, in the form of a screenshot, was taken prior to the initial contact from the Complainant's representative Demys on 15 October 2011.

31 At that time, the Respondent acknowledged the Complainant's view that confusion may arise and therefore altered the notice to read:

enquiries@Harley-Davidson-tours.eu

Harley-Davidson Tours Ltd is an independent Scottish registered company that is not associated with Harley-Davidson Motor Company.

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32 The Respondent submits that, as a result of this alteration, the notice is more prominent and appears on the foot of every page. He says such notices are now commonly regarded by internet users as performing the same function as a business letterhead.

33 The Respondent submits that detailed information about his business is also contained within the site. He says it is highly unlikely therefore that any reasonably attentive user could believe that the site was in any way connected to Harley-Davidson or its subsidiaries.

34 The Respondent claims never to have received any communication from anyone believing his business to be in any way connected with the Complainant.

35 The Respondent denies using the Complainant's trade mark. The distinctive Bar and Shield, Harley-Davidson font, colours, and so on have all been intentionally omitted to avoid any confusion.

36 While the Respondent accepts he uses a colour theme that compliments the Complainant's branding, he contends his shade of orange is more vibrant, and that he has adopted grey colours instead of the black colouring favoured by the Complainant. He reiterates the fact that the use of Harley-Davidson is appropriate and essential bearing in mind the nature of his business.

37 The Respondent claims that his business began as a "lifestyle" business with the intention of allowing the Respondent to spend the summer motorcycling at a subsidised cost with the long term view of building it to become income producing.

38 He says it is not his primary business and to date he has not made a profit. The Respondent earns fees from the service as a tour guide and he does

not add any profit element to the other components of the holiday, including rental. In these circumstances, the Complainant's allegation that the Respondent has tried to profit from its mark is false.

- 39 The Respondent says it is permissible for one party to use another's trade mark if the product or service cannot be readily identified without using the trade mark. As the Respondent's business only uses Harley-Davidson motorcycles the use of the name Harley-Davidson should be regarded as nominative fair use, as should the use of the word "tours".
- 40 The Respondent has done nothing to suggest sponsorship or endorsement by The Complainant.
- 41 He says that arguably the Complainant is barred from making this Complaint because, by making an offer to purchase the Domain Name, it impliedly recognised that the Respondent is the rightful owner of the Domain Name.
- 42 The Respondent also contends that he has been prejudiced because of the Complainant's delay in filing the Complaint. Irrespective of the merits of the case, he argues that this should be taken into consideration.
- 43 He submits that, in practice, no-one would confuse a Harley- Davidson factory tour with a bike tour, and that the evidence presented by the Complainant in relation to its factory tours from 1919 is irrelevant and should be dismissed.
- 44 The motorcycle tours offered by The Respondent legitimately use the Complainant's branded product and do not require the Complainant's permission to do so.
- 45 No counterfeiting, fraud, deception or trading-off has occurred. The Respondent has justifiably used the Complainant's brand to describe what is on offer.
- 46 The Complainant has failed to establish how it is being affected by the Domain Name and its use. Nor has the Complainant produced any evidence to demonstrate that confusion has occurred despite having had over two years to gather such evidence.
- 47 The Respondent refers to the case of Michael Toth v Emirates [2011] EWPC 18. He says that the court held that it does not have jurisdiction to decide whether a domain name is an abusive registration and that it is for the independent expert appointed by Nominet to decide this question.
- 48 Furthermore, the Respondent says he is domiciled in Scotland and that his company is a Scottish registered company. As such the Courts of England would not have jurisdiction in any other civil matter that might arise surrounding this matter. He says that, should any legal proceedings follow, they would need to be governed under Scottish Law.

- 49 Notwithstanding this, the Respondent accepts that Nominet's Disputes Resolution Service has jurisdiction in this matter.

Complainant's submissions in Response

- 1 Insofar as relevant to the Response, the Complainant contends as follows in its Reply.

- 2 It denies that the Respondent's registration and use constitutes descriptive, fair use, and refers to the European Court of Justice in *BMW v. Deenik* in support. It accepts that this case envisages circumstances where it is legitimate for an independent operator to use a third party trade mark in the course of its business...

"...unless the mark is used in a way that may create the impression that there is a commercial connection between the other undertaking and the trade mark proprietor, and in particular that the reseller's business is affiliated to the trade mark proprietor's distribution network or that there is a special relationship between the two undertakings."

- 3 The Complainant says that *Deenik* has also been followed by *Gillette v. LA Laboratories* in which the ECJ noted:

The use of the trade mark will not be in accordance with honest practices in industrial and commercial matters if, for example:

it is done in such a manner as to give the impression that there is a commercial connection between the third party and the trade mark owner;

it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute;

- 4 In the present case, the Domain Name does not constitute descriptive use as the Complainant's globally famous mark is the primary, most distinctive and significant element. The Domain Name creates an impression that the Respondent as a minimum is the Complainant or is endorsed by or has a special relationship with it.

- 5 The Respondent says that he contacted the Complainant with a view to receiving the Complainant's permission to trade using the Domain Name. The Respondent says that he did not receive any consent and assumed there was no objection to his trading under it.

- 6 The Complainant receives many thousands of licensing requests annually. The Complainant submits that it is under no obligation to grant, consider or even acknowledge licensing requests. At no point are potential licensees given consent to use the Complainant's marks until a formal licence is granted. A lack of response from the Complainant's licensing department cannot and does not constitute implied permission. This is normal business practice and is not unique to the Complainant.

- 7 Moreover, the very fact that the Respondent sought the Complainant's permission to trade using the Domain Name evidences the Respondent's belief that he in fact needed the Complainant's permission.
- 8 The Complainant notes that at the very least the Respondent was put on notice by Demys' letter of 13 October 2011 in which it was stated:
- Please also note that you should not continue or commence any operations using the Domain Names for any commercial activity which may further infringe our clients' intellectual property. Such activity would include (without limitation) operations which may confuse our clients' customers into believing that any websites to which the Domain Names are pointed, or goods and services featured on such websites, are sponsored, affiliated, or endorsed by our clients*
- 9 However, the Respondent continued to use the website and the Domain Name despite this letter.
- 10 As to the Respondent's submissions on jurisdiction and personal bar under Scottish law, the Complainant contends that these are irrelevant to these proceedings as they are brought under Nominet's contractual dispute mechanism.
- 11 Issues of jurisdiction would be dealt with in any future court proceedings. For clarity, to the knowledge of the Complainant, no court proceedings have been commenced.
- 12 In relation to the costs incurred by the Respondent, the Complainant's agents offered to make an ex gratia payment to bring about a speedy resolution to this matter. In the context of the correspondence it is clear that payment was offered for a settlement involving the transfer of the dispute Domain Name and one other. It was not a payment for any of the Respondent's products, goodwill in his business and did not acknowledge that he had any right to use the Complainant's marks.
- 13 The Respondent says that the Complainant's tours were not launched until December 2011 and exhibits a press release relating to this. The Respondent also makes reference to an employee of the Complainant referring to the authorized tours as "new".
- 14 The exhibited articles in the Harley Owners Group ("HOG") magazine are dated 2009 and 2010 and demonstrate the Complainant's motorcycle tours had been publicised prior to Domain Name's registration.
- 15 HOG has more than one million members worldwide and HOG magazine is available to non-owners.
- 16 In any event the Complainant contends the extent of its publicity and whether its launch post-dated the Domain Name's registration is irrelevant. There are no circumstances in which the registration could not be Abusive given the incorporation of the Complainant's globally famous mark as the

primary and most significant part of the Domain Name, which takes unfair advantage of the Complainant's rights.

- 17 The Respondent says that his business and the Domain Name have been to the benefit of the Complainant in that they introduced people to the concept of riding a Harley-Davidson motorcycle. The adoption of the Complainant's marks by a third party will cause confusion.
- 18 The Complainant's mark as used within the Domain Name is not under its control - it cannot enforce the same standards it can with its formal licensees, nor control the manner in which its marks are being used and it has no way to enforce their use.
- 19 The Complainant enforces strict standards on its tours which cannot be imposed on the Respondent's business. Accordingly, the use of the Domain Name in these terms, given that it implies authorisation by the Complainant, is unfairly detrimental to the Complainant's rights and is therefore Abusive.
- 20 Such appropriation of its marks will be unfairly detrimental to the Complainant's rights and, as such, is Abusive.
- 21 The Respondent says the Complainant's authorized tours are provided by independent tour operators who pay a fee to the Complainant. The Complainant concurs and notes that the Respondent is receiving the benefit of associating his business with the Complainant's marks and brands for free.
- 22 As to the Respondent's attempts to distinguish the DRS disputes referred to in the Complaint, (i) Velux was cited to show that an additional word, such as "tours", could not render the Domain Name distinctive from the Complainant's marks; and (ii) Toshiba and Nokia were referenced not because they related to disputes involving third party products but because it was held in those cases that the relevant marks were not considered to constitute a bona fide descriptive use.
- 23 In any event, the Complainant contends that the question of whether the product referred to is genuine or not does not determine the questions of descriptive use, confusion or indeed unfair detriment regarding a domain name.
- 24 On this point the Complainant draws the Expert's attention to *Seiko UK Limited v. Designer Time/Wanderweb* in which the Appeal panel noted:

That it is unfair for a mere agent to appropriate to himself the trading style of his principal is a well-established principle of UK and international law...The Panel takes the view that in the light of the evidence before the Expert and in the light of the submissions before him and on appeal, it is just as unfair for Wanderweb to appropriate Seiko's trade marks as a domain name.

- 25 The Respondent draws attention to a Unites States Court of Appeals decision. The Complainant notes that this is a trade mark infringement case relating to domain name issues and should be accorded little weight in proceedings under the DRS.
- 26 In any event, the Complainant contends the Domain Name is not an example of 'nominative fair use' and does suggest sponsorship or endorsement by the trade mark holder.
- 27 As to Shabby Chic Brands LLC v Jacqueline Fabian, the Complainant submits that this case is not relevant as it relates to competing legitimate interests in a generic and widely used term, rather than the use of a globally famous trade mark as the most distinctive part of a disputed domain name.
- 28 In respect of the Respondent's submissions as to his lack of profit and lack of mark up on various services, the Complainant submits this is irrelevant as the Respondent's intention was to create a profit-making business, the notoriety of which was and continues to be increased by the Abusive use of the Complainant's marks.
- 29 Confusion can occur without profit being generated and such confusion takes unfair advantage of the Complainant's rights and is Abusive.
- 30 As to the allegation that users will not mistake factory tours with motorcycle tours, the Complainant says that via initial interest confusion, the Domain Name will confuse internet users searching for any type of tour that could be operated by the Complainant - whether factory, motorcycle or other. This species of confusion is noted in the DRS Expert overview:
- 31 *...the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. [Emphasis added by Complainant]*
- 32 The Complainant contends that the incorporation of the Complainant's globally famous mark as the primary and most distinctive part of the Domain Name will cause confusion and thus render it Abusive.

Discussions and Findings

- 1 Under paragraph 2 of the Policy, the Complainant is required to prove to the Expert on the balance of probabilities that:

- (a) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - (b) The Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 2 An Abusive Registration is defined in paragraph 1 of the Policy as a Domain Name which either:
 - (a) 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
 - (b) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;
- 3 Rights are defined under paragraph 1 of the Policy as:

“rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.
- 4 The first question that needs to be decided is whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- 5 The Complainant has satisfied this test by virtue of the rights conferred on it through use and registration of the Harley-Davidson trade mark.
- 6 The next issue to be determined is whether or not the Domain Name, in the hands of the Respondent, is an Abusive Registration. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under the Policy is as follows (so far as relied upon by the Complainant):
 - (a) 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.
 - (b) Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- 7 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration (so far as relied upon by the Respondent) is as follows:

- 8 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 fair use of the Domain Name.
- 9 The Domain Name is generic or descriptive and the Respondent is making fair use of it.
- 10 At the heart of this Complaint is the manner in which a third party, trading in the goods or services of a trade mark owner, can use that trade mark in a domain name.
- 11 In this respect, it is important to bear in mind that, while the case law which has developed in respect of registered trade mark infringement may have some relevance to an Expert's determination, the criterion to be satisfied is whether or not a domain name constitutes an Abusive Registration, not whether a registered trade mark has been infringed.
- 12 I do not believe on a balance of probabilities that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. In my view, based on the facts and submissions before me, the Respondent's motive was to adopt a Domain Name which reflected the nature of his business. I found the explanation offered by the Respondent convincing in that respect.
- 13 However, that is not determinative of the matter. While this was the Respondent's intention, nevertheless I believe that the Domain Name is being used in a way which has confused, or is likely to confuse internet users into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- 14 This is because the dominant and distinctive part of the Domain Name is the Complainant's trade mark. There is nothing in the Domain Name which serves to indicate to an internet user that the Respondent is an independent business. This confusion is likely to be accentuated by the parties' common trade in motorcycle tours and the fact that this word is descriptive of this business. In my view, the Domain Name is the natural guess of a speculative visitor searching for information about the Complainant's motorcycle tours business.
- 15 For that reason, there is a substantial risk that speculative internet users will access the Respondent's website in the expectation that they believe the website is the Complainant's website, or is authorised by the Complainant (as part of its authorised tour operators programme, for example). This is a

paradigmatic case in my view of a Domain Name which will give rise to initial interest confusion. Once an internet user arrives on the Respondent's website, the damage is done as the visitor has already been deceived, whether the content of the Respondent's website corrects that mistaken belief or otherwise.

- 16 Furthermore, because the Respondent is a competitor, there is a substantial risk that an internet user may in fact purchase the Respondent's services even though such a user's initial intention was to find out information about the Complainant's motorcycle tour services. Inevitably this will be unfairly detrimental to the Complainant's Rights.
- 17 The fact that the Domain Name reflects the Respondent's business name Harley-Davidson Tours Limited is of no assistance in these circumstances, not least because the choice of company name itself suffers from the same type of potential confusion (that it is a Harley-Davidson company, or connected to Harley-Davidson in some manner).
- 18 Nor is the Respondent here assisted by the fact that his business is genuine, or that he genuinely believed he could register or use the Domain Name. While the Respondent's belief was genuine, under the terms of the DRS his belief is mistaken. The abuse in these circumstances rests in the fact that the Domain Name itself – regardless of the content of the site - is inherently confusing irrespective of the motive of the Respondent. The Domain Name does not contain anything which would help distinguish itself from the Complainant, or from the Complainant's network of authorised tour operators (by the use of, for example "independent").
- 19 I accept that the Respondent cannot realistically promote his business without using the Harley-Davidson mark but his manner of use within the Domain Name is confusing. He can use the Harley-Davidson mark in a way which would legitimately promote his business but which avoids the likelihood of confusion. Accordingly, this is not a case of nominative, fair use.
- 20 While the Respondent points to the lack of complaints from customers I do not regard this as sufficient on the facts of this case as it is likely that instances of confusion will go undetected. Equally I do not regard the lack of evidence of confusion adduced by the Complainant as determinative either; confusion is very likely in practice given that the Domain Name (i) is identical to the Complainant's Harley-Davidson mark, other than the addition of the descriptor "tours"; and (ii) is used by the Respondent in relation to services which are identical or at least highly similar to the services for which the Complainant's trade mark are used. Confusion is very unlikely to be detected because there is no inherent reason why persons believing that the Complainant's goods and/or services are linked to the Respondent should contact the Complainant and say so.
- 21 For completeness I will deal with the other arguments advanced by the Respondent insofar as they are relevant to the DRS.

- 22 The Respondent contends that the Complainant is barred from making this Complaint because in making an offer it impliedly recognised that the Respondent is the rightful owner of the Domain Name. No such implication can be made in respect of the Complainant's offer. It was an offer made without any admission that the Respondent's registration and use was legitimate within the meaning of the DRS.
- 23 Nor do I believe that any prejudice which might have been caused to the Respondent by reason of the Complainant's alleged delay is relevant here. The Complainant never gave any indication that it agreed to the Respondent's registration and use of the Domain Name. In fact the evidence points the other way.
- 24 Finally, the Respondent appears to suggest that the Harley-Davidson name is in some sense "generic" and has become synonymous with motorcycle tours. There is no evidence to suggest at all that this mark has ceased to operate as a designation of commercial origin, or has become interchangeable with "motorcycle tours."

6. Decision

In the light of the foregoing findings, namely that the Complainant 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, I direct that the Domain Name be transferred to the Complainant.

Signed: Cerryg Jones

Dated: 3 October 2012