

# DISPUTE RESOLUTION SERVICE

**D00015259**

## Decision of Independent Expert

Straight Arrow Products, Inc.

and

Katie Black

**1. The Parties:**

Lead Complainant: Straight Arrow Products, Inc.  
Straight Arrow Products, Inc.  
2020 Highland Avenue  
Bethlehem  
Pennsylvania  
18020  
United States

Respondent: Katie Black  
3 Patricia Court  
Manor Park Road  
Chislehurst  
Kent  
BR7 5QB  
United Kingdom

**2. The Domain Name:**

manentail.co.uk

**3. Procedural History:**

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

The dispute was received by the Dispute Resolution Service (DRS) on December 23, 2014. The Complaint was validated on December 24, 2014 and notification of the Complaint was sent to the Parties on the same date.

Following a reminder sent on January 15, 2015, no Response had been received by January 20, 2015 and a notification of no Response was sent to the Parties on the same date. Expert decision payment was received on February 3, 2015.

#### **4. Factual Background**

The factual background is extracted from the Complaint. According to the Complainant, its business since the 1970s has been in shampoos, conditioners and related products for horse manes, and more recently in human hair shampoos, conditioners, and hand and nail therapy products. It operates in 29 countries and through more than 150,000 retail outlets worldwide. Since the 1970s the complainant has used the trade mark MANE 'N TAIL, and owns the following trade marks:

MANE 'N TAIL, European Community Trade Mark (CTM), registration number 198192, registered August 29, 2000, classes 3, 5, 21;

MANE 'N TAIL, CTM, registration number 6654966, registered December 3, 2008, classes 3, 5;

MANE 'N TAIL, United States Patent and Trademark Office (USPTO), registration number 2199136, registered October 27, 1998, class 3;

MANE 'N TAIL, USPTO, registration number 2246880, registered July 15, 1994, class 3;

MANE 'N TAIL, USPTO, registration number 4446463, registered November 19, 2012, class 5.

The Complainant conducts business with the aid of domain names reflecting its MANE 'N TAIL trade mark, namely manentaillequine.com, manentail.com, manentail.ca, manentail.pe, manentail.com.mx, manentail.ph, manentail.tw, manentail.asia, manentail.co.id, manentail.ec, manentail.fi, manentail.jp, manentail.kr, manentail.my, manentail.no and manentail.pt, as well as its Straight Arrow domain name, straightarrowinc.com.

The disputed Domain Name was registered on September 30, 2004 in the name of Katie Black, trading as KBPR, a United Kingdom sole trader. The Domain Name has redirected Internet visitors to the Irish-registered website located at manentail.ie, which is registered in the organisational name of Orchard Equestrian Ltd. For clarity, the website at manentail.ie will be referred to hereafter as the "Irish website". Other "manentail" domain names are owned by Orchard Equestrian Ltd and redirect to the Irish website including manentail.de, manentail.es, manentail.it and manentail.org.

According to the Complainant, Orchard Equestrian Ltd is a reseller or retailer of some of the Complainant's products (and other third party products) but there has never been a formal distribution agreement between the Complainant and Orchard Equestrian Ltd.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant states that it has rights in the trade mark MANE 'N TAIL as listed in section 4 above and has produced images of copies of the relevant CTM and USPTO registration documents. It states that the trade mark has been in use since the 1970s and is well known internationally through magazine publications, product placements in movies, and having

been featured in television programs. The trade mark is stated to be a household name in its field.

The Complainant contends that the disputed Domain Name is identical or confusingly similar to the trade mark MANE 'N TAIL in sound, appearance, meaning and commercial impression.

The Complainant further contends that the Domain Name constitutes an Abusive Registration in the hands of the Respondent. In summary its grounds are that the Domain Name was registered and is being used as a blocking registration against a name or trade mark in which the Complainant has Rights; for the purpose of unfairly disrupting the business of the Complainant; and in a way that has confused or is likely to confuse people or businesses into believing that the Domain Name is connected with the Complainant.

The Complainant says that the Domain Name redirects to the Irish website, manentail.ie, at which Orchard Equestrian Ltd operates a business selling the Complainant's Mane 'N Tail grooming products. It is suggested by the Complainant that the Respondent of record registered the Domain Name on behalf of Orchard Equestrian Ltd and that as the Respondent appears to have acted as an agent in registering or using the Domain Name, relevant references to the Respondent should be seen to include Orchard Equestrian Ltd. Orchard Equestrian Ltd has sold the Complainant's products since about 2009, of which the Complainant was aware. Notwithstanding negotiations that took place, Orchard Equestrian Ltd was never appointed an authorised distributor of the Complainant's products and its supplies were obtained from Transcon Trading and McCormack Pharmacy, being the official distributors in Europe and Ireland respectively. The Respondent should not be considered as having any rights or legitimate interests in the Domain Name.

The Complainant contends there is no evidence to suggest that the Respondent, before becoming aware of the Complaint, used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services. There is nothing to suggest that the Respondent has been commonly known by the Domain Name or a similar name and there has been no legitimate non-commercial or fair use of the Domain Name.

The Complainant contends, and produces evidence in the form of comparative screen captures, that the Irish website has until recently displayed material copied from the Complainant's own website, including tracts of text and certain images.

The Complainant says that the Respondent obtained supplies of Mane 'N Tail products at wholesale prices from the authorised distributors and then attempted to undercut them, and this is evidence that the Domain Name was used for the purpose of unfairly disrupting the business of the Complainant.

The Complainant submits a bundle of correspondence that is mainly between itself or its representative on the one hand, and Orchard Equestrian Ltd on the other hand, with one letter to Katie Black. The correspondence mainly concerns the Irish website, and the Complainant asserts in respect of that website that, *inter alia*:

Its overall look and feel clearly imitates the Complainant's own website at manentail.com;

It incorporates images that appear on the home page of the Complainant's website in a scrolling arrangement, and at least three images from the Complainant's website;

It carries text on the home page and in respect of product descriptions copied from the Complainant's website;

Orchard Equestrian Ltd claimed to be an authorized distributor of the Complainant's products, which was factually incorrect and fundamentally misleading.

The correspondence also asserts that the registration and use of the Domain Name is in contravention of the Complainant's rights and is without the Complainant's written permission.

Furthermore the Complainant had not given permission for the acquisition by the Respondent of the other domain name registrations that redirect similarly to the Irish website.

In the exchange of correspondence, Orchard Equestrian Ltd replied denying the Complainant's allegations, but certain changes were made to the Irish website. The Complainant says that Orchard Equestrian Ltd has continued to imply falsely that it is an authorised distributor of the Complainant's products. The results of a Google search for "manentail" on November 11, 2014 yielded, on the first page, the result "Mane 'n Tail in Ireland Official Site", being Orchard Equestrian Ltd's chosen wording, with a link to the Irish website. Screen prints of the Irish website show the same wording used for the running page title.

The Complainant contends that the Irish website does not sell solely the Complainant's trade marked products but offers a link to the website at orchardequestrian.com, which "specializes in everything for the horse and rider" and offers third party goods in competition with the Complainant. The Complainant contends that the Respondent is using the goodwill embodied in the Complainant's trade mark, for commercial gain, in order to attract Internet users to orchardequestrian.com where competing products are offered, constituting Abusive Registration.

The Complainant contends that Orchard Equestrian Ltd, by registering also the domain names manentail.org, manentail.de, manentail.es and manentail.it, which all resolve to the Irish website, is trying to corner the market in related domain names. Thus the disputed Domain Name was registered and is being used as a blocking registration and is unfairly disrupting the business of the Complainant.

The Complainant has made references to certain previous decisions under the DRS and decisions of the Appeal Panel that it considers may support its position.

The Complainant requests the transfer to itself of the Domain Name.

## **B. Respondent**

The Respondent has not replied to the Complainant's contentions.

## **6. Discussions and Findings**

Paragraph 2(a) of the Policy requires the Complainant to prove, on the balance of probabilities, that:

- "i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration."

### **Complainant's Rights**

The Complainant has produced copies of trade mark registration documents that satisfy the Expert as to the Complainant's rights in the trade mark MANE 'N TAIL for the purposes of the Policy.

### **Identity or Similarity**

The spelling of the operative part, "manentail", of the Domain Name manentail.co.uk, is as close a reproduction of the trade mark MANE 'N TAIL as is technically feasible in a domain name in the .uk registry, since apostrophes or spaces are impermissible characters and upper or lower case are not distinguished. The Domain Name is found to be effectively identical to the Complainant's trade mark in the terms of paragraph 2(a)(i) of the Policy.

## Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.”

Paragraph 3 of the Policy, Evidence of Abusive Registration, reads:

“a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C. for the purpose of unfairly disrupting the business of the Complainant;
- ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;
- iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.
- iv. It is independently verified that the Respondent has given false contact details to us; or
- v. The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
  - A. has been using the Domain Name registration exclusively; and
  - B. paid for the registration and/or renewal of the Domain Name registration.
- b. Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.
- c. There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the Complaint was filed. This presumption can be rebutted (see paragraphs 4(a)(iv) and 4 (c)).”

First it is necessary to clarify the status of the Respondent. The disputed Domain Name manentail.co.uk, according to the WhoIs, is registered in the name of Katie Black, who states

that she is trading as KBPR, a United Kingdom Sole Trader. The website to which the Domain Name ultimately resolves, however, is the Irish website manentail.ie, to which visitors have been transferred seamlessly, although to many visitors this may not be immediately apparent. The Irish website is registered in the name of Orchard Equestrian Ltd and trades under that name.

Paragraph 1 of the Policy defines the Respondent as “the person (including a legal person) in whose name or on whose behalf a Domain Name is registered”. This wording appears to allow an option and the Complainant has named the Respondent of record as Katie Black, being the person in whose name the Domain Name is registered, but thereafter tends to focus on the actions of the Irish website of Orchard Equestrian Ltd. The Complainant’s position is that Katie Black has acted as the agent of Orchard Equestrian Ltd for the purpose of registering or using the Domain Name.

A concatenation of the Respondent’s details, namely Katie Black, trading as KBPR, sole trader, invites the conclusion on the balance of probabilities that Katie Black is engaged in public relations, hence KBPR. The Respondent has elected not to respond or to throw any light on her connection with Orchard Equestrian Ltd and it is not necessary to speculate, except to observe that, in the absence of evidence to the contrary, it was appropriate for Katie Black to be named as the Respondent. In terms of responsibility for the Domain Name, the Respondent or her trading entity appears to stand in the shoes of Orchard Equestrian Ltd. It will be appropriate therefore to consider the actions of Orchard Equestrian Ltd, with this always in mind.

The Complainant asserts there has been Abusive Registration essentially because the disputed Domain Name was registered and is being used as a blocking registration, is unfairly disrupting the business of the Complainant, and is likely to confuse people or businesses into believing that the Domain Name is connected with the Complainant.

Although no formal Response has been received, it is clear from prior correspondence between the Complainant and Orchard Equestrian Ltd produced in evidence that Orchard Equestrian Ltd retailed certain of the Complainant’s products and evidently considered itself to be in the position of an authorised reseller. The Complainant’s position is that although it has indirectly supplied Orchard Equestrian Ltd with product through its authorised distributors for retail sale, and according to the correspondence has consented to certain advertising of its products on the website orchardequestrian.com, it has never appointed Orchard Equestrian Ltd as a distributor. Furthermore it was the owner of Orchard Equestrian Ltd who terminated negotiations over distributorship.

The lack of a Response does not lead to a decision by default. It should therefore be noted that in certain limited circumstances it is conceivably possible that a reseller might legitimately incorporate another’s trade mark into a domain name, subject to a number of constraints. The criteria were summarised by the Appeal Panel of three Experts in 2010 in *Toshiba Corporation v. Power Battery Inc.*, DRS 07991 (toshiba-laptop-battery.co.uk), as follows:

- “1. 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.
2. 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.
3. Such an implication may be the result of “initial interest confusion” and is not dictated only by the content of the website.
4. 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.”

With regard to *Toshiba* criterion (2) above, it is noted that the Complainant's exhibits show that claims on the Irish website have included at various times "We at Orchard Equestrian Ltd are Distributors for Mane 'n Tail Products in Ireland", "Orchard Equestrian Ltd. is based in Limerick, Ireland who are wholesalers of the Mane and [sic] Tail range of products", and "We supply the Mane 'n Tail range of products to Pharmacies and Saddlery Shops etc. If you want to become a stockist, please contact us". These statements are accompanied by prominent and colourful displays of the Complainant's products.

In the light of *Toshiba* criterion (3) above, it is noted that the Domain Name is constructed in the same idiom as most of the domain names owned by the Complainant (section 4, Factual Background, above), i.e., with the trade mark MANE 'N TAIL contracted to "manentail". The website ultimately linked to the Domain Name has displayed page headings proclaiming variously "Mane 'n Tail in Ireland Official Site", and "Mane 'n Tail in Ireland".

On the totality of the evidence the Expert finds that the various versions of the Irish website project convincing images of Orchard Equestrian Ltd as having a commercial connection with the Complainant as an authorised reseller of its products, and significantly, as being vested with the power to appoint stockists. The Expert finds it more probable than not that visitors to the disputed Domain Name, having been redirected seamlessly to the Irish website, would be confused at least initially, by both the Domain Name they have initially selected (manentail.co.uk) and the content they are seeing, into believing they are looking at an authentic website of the Complainant or one that has the endorsement of the Complainant within the meaning of paragraph 3(a)(ii) of the Policy.

The Complainant has produced a screen print of the Irish website dated November 6, 2014, that includes reference to a "large retail business" with a "full equine range of products on our website www.orchardequestrian.com". The Complainant states, and it is not contested, that these include products unconnected with the Complainant. Having regard to *Toshiba* criterion (4) above, the Expert finds the Irish website to be in use for an offering of goods in competition with the Complainant.

The above findings in respect of the Respondent purporting to act as a reseller are collectively embraced by paragraph 3(a)(ii) of the Policy. Having regard to all the evidence, the Expert finds that the Respondent is using or has used the Domain Name in a way that 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. The Domain Name is found to have been used in a manner that has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights in the registered trade mark MANE 'N TAIL and the Expert finds Abusive Registration by the Respondent on those grounds under paragraph 2(a)(ii) of the Policy.

Having found that the Respondent's primary motivation has been to trade profitably on the Complainant's trade mark, it is not necessary to reconsider whether the Respondent's primary motivation may have been to make a blocking registration as proposed by the Complainant (paragraph 3(a)(i)(B) of the Policy). Similarly since the primary function of the Domain Name appears to have been to benefit from actual trade in the Complainant's products, and no evidence was produced of the alleged undercutting of prices by the Respondent, there is insufficient evidence to support the Complainant's contention that the Domain Name was intended primarily to disrupt the Complainant's business (paragraph 3(a)(i)(C) of the Policy).

In reaching the decision, the Expert reiterates that almost all of the available evidence and correspondence has concerned the Irish website having the domain name manentail.ie, which is not the disputed Domain Name manentail.co.uk. The content of the Irish website, however, has been the sole visible and tangible manifestation of the disputed Domain Name and the Respondent must bear the ultimate responsibility for what is presented to visitors to the Domain Name. In accepting the Nominet Terms and Conditions of Domain Name Registration, the Respondent agreed at paragraph 7.4: "by registering or using the domain name in any way, you will not infringe the intellectual property rights (for example,

trademarks) of anyone else". As stated in the Policy at paragraph 4(e)(iii), "the use of the Domain Name is ultimately the Respondent's responsibility".

## **7. Decision**

The Expert finds that the Complainant has Rights in respect of the name and trade mark MANE 'N TAIL; that the disputed Domain Name manentail.co.uk is identical to the Complainant's name; and that the disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name manentail.co.uk is ordered to be transferred to the Complainant.

**Signed** Clive Trotman

**Dated** February 16, 2015