

DISPUTE RESOLUTION SERVICE

D00019981

Decision of Independent Expert

Marshalls Mono Limited

and

Desmond Walford

1. The Parties:

Complainant: Marshalls Mono Limited

Landscape House Premier Way,
Lowfields Business Park
Elland
West Yorkshire
HX5 9HT
United Kingdom

Respondent: Mr Desmond Walford

18 Wentworth Close
Watford
Hertfordshire
WD17 4LW
United Kingdom

2. The Domain Name:

topmarshalldriveways.co.uk

3. Procedural History:

I 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 in to question my independence in the eyes of one or both of the parties.

16 March 2018 15:22 Dispute received
19 March 2018 13:29 Complaint validated
19 March 2018 13:37 Notification of complaint sent to parties
09 April 2018 02:30 Response reminder sent
09 April 2018 13:37 Response received
09 April 2018 13:37 Notification of response sent to parties
12 April 2018 02:30 Reply reminder sent
12 April 2018 15:45 Reply received
12 April 2018 15:46 Notification of reply sent to parties
12 April 2018 15:46 Mediator appointed
17 April 2018 16:17 Mediation started
02 May 2018 15:27 Mediation failed
02 May 2018 15:27 Close of mediation documents sent
15 May 2018 02:30 Complainant full fee reminder sent
17 May 2018 11:09 Expert decision payment received

4. Factual Background

The Complainant, is a manufacturer of exterior and interior stone and paving products and services. Established over 100 years ago, it has grown to be one of the UK's leading public limited companies.

The Complainant's portfolio of trademark registrations includes the following:

- UK trade mark registration no. 1551957 MARSHALLS registered in classes 06, 19 on 12 July 1996 ;
- EU trade mark registration no. 12115903 MARSHALLS registered in classes 6, 11, 19, 20 and 35 on 03 Feb 2014;
- EU trade mark registration no. 6037816 MARSHALLS registered in classes 6, 7, 8, 9, 11, 16,19, 20, 21, 28, 31, 35, 37, 41, 44 on 22 Jan 2009 ; and
- UK trade mark registration no. 2267320 MARSHALLS PAVING.

Because of the brevity of the Response, there is no information available about the Respondent except for that submitted in the Complaint and on the WhoIs. The Respondent claims that he is no longer in control of the disputed domain name but gives no further information about himself, the disputed domain name, the website to which it resolves or the content posted on the website.

The disputed domain name was registered on 23 August 2013. Within days of registration and by 1 September 2013, it resolved to a website apparently offering products and services associated with driveways, paving and landscaping. It continues to do so.

5. Parties' Contentions

Complainant

The Complainant relies on its rights in its portfolio of registered trademarks and its rights at common law which it claims to have established through the goodwill acquired by the long and extensive use of the MARSHALLS name and mark over a period of 100 years. Its business has grown to a yearly turnover of around £400 million with a large 2,000 person work force employed by the Complainant in which the Complainant trades under the name MARSHALLS and uses the MARSHALLS trademark on virtually all of its products and services.

The Complainant's services include an accreditation scheme for tradesmen who are installers of MARSHALLS paving and driveways who are permitted to use the MARSHALLS logo, and the Marshalls accredited register logo. Given the reputation of the Complainant, the scheme provides consumers with a higher degree of confidence in the skillset and authenticity of the supplier approved under the scheme.

As evidence of the reputation and goodwill of the MARSHALLS trademark, the Complainant has provided copies of the annual reports from 2014-2016 for Marshalls plc, the ultimate holding company of the Complainant's group of companies. The Complainant is the day-to-day trading arm for the activities of the Marshalls Group and holder of the intellectual property rights. These reports show yearly annual revenue of £358.5, £386.2 and £396.9 million, respectively, *per annum*, as well as a spend of around £3 million per year on brand development and marketing.

The Complainant has also provided examples of press coverage mentioning the Complainant and its MARSHALLS brand, which it submits illustrates that there is an interest in and a wide knowledge of the Complainant and its MARSHALLS brand.

The Complainant submits that the disputed domain name is similar and almost identical to its MARSHALLS mark for the purposes of paragraph 2 of the DRS Policy, arguing that its MARSHALLS name and mark is the dominant element in the disputed domain name <topmarshalldriveways.co.uk>.

The Complainant asserts that for the purposes of comparison the country code Top Level Domain Name (ccTLD) extension ".co.uk" is generic and will go unnoticed by Internet users and that there is a natural split of the disputed domain name into three words namely "top", "marshall" and "driveways". Considering these individually "top" and "driveways" have well-known dictionary definitions and together these three words will be commonly understood to simply mean "great quality driveways, which use paving from Marshalls" or "driveways installed by Marshalls/an installer accredited by Marshalls".

The Complainant also submits that the disputed domain name, in the hands of the Respondent, is an Abusive Registration, arguing that the disputed domain name

itself strongly implies a connection between the Complainant and Respondent, which does not exist.

The Complainant submits that by 1 September 2013, within days of its registration on 23 August 2013, the disputed domain name resolved to a website connected with driveways, paving and landscaping. ("the Respondent's Website"). The Complainant has furnished an extract from the Wayback Machine internet archive in support of this assertion.

The Complainant submits that the Respondent is trading under the name TOP MARSHALL DRIVEWAYS and using the MARSHALL logo. The Complainant argues that the word "marshall" is the focal point of the branding on the Respondent's website, being in bright yellow, with "top" in plain black and "driveways" in smaller font. On its webpages, the Respondent claims to "specialise in Driveways, Patios & Terraces, Groundworks"; furthermore, the Respondent wrongly refers to the Complainant, stating "The video above has been produced by Marshalls™ We recommend their products where applicable." The Complainant denies that the video was produced by the Complainant or with its approval.

The Complainant submits that the Respondent's use of the disputed domain name clearly shows that the Respondent is aware of the Complainant's rights. The Respondent's video indicates the Respondent is aware that the Complainant owns trade marks by using the "™" legend; furthermore, the Respondent makes numerous references to "Marshalls" and frequently uses, interchangeably, "Marshalls" and "Marshall" as its brand name without the approval for either from the Complainant.

The Complainant further submits that the disputed domain name and the use of the Complainant's name and mark by the Respondent in the above manner are abusive by unfairly disrupting the Complainant's business. The Complainant argues that by using MARSHALL in combination with the word "driveway" the Respondent piggy-backs on the Complainant's rights and benefit from its goodwill, without contributing to the development and maintenance of the Complainant's positive and long-standing brand image. The Complainant also submits that such use of the Complainant's name and mark diminishes the strength and individuality of the Complainant's brand.

The Complainant also argues that the Respondent's use of the disputed domain name is disruptive and potentially diverts trade from the Complainant, where consumers engage the services advertised on the Respondent's Website.

Further referring to the Respondent's Website, the Complainant submits that the disputed domain name is being used in a way which is likely to confuse people or businesses into believing that it is registered to, operated or authorised, or otherwise connected with the Complainant, resulting in a misrepresentation and damage to the Complainant's goodwill. It is likely that some people and businesses will assume a direct connection with the Complainant.

The Respondent is in the same field of business as the Complainant. It is therefore inevitable that a connection with the Complainant will be assumed by the unauthorised use of the MARSHALL and MARSHALLS name and mark.

The Complainant accepts that it is clear that the Respondent sometimes installs paving that originates from the Complainant but alleges that sometimes the paving that the Respondents install is not the Complainant's product. The Complainant argues, therefore, that there is a risk of a false assumption of a connection with the Complainant, in relation to the services offered via the disputed domain name and "a risk of diversion of trade when the Complainant (*sic*) uses non-MARSHALLS paving." (Note: This Expert takes this reference to the Complainant to be an error in the Complaint and that a reference to the Respondent is intended in line with the meaning and thrust of the Complainant's argument.). Furthermore, the Complainant submits that there is a risk that consumers will assume all paving used by the operator of the disputed domain name is MARSHALLS paving, when it is not. This may also lead to tarnishing of the Complainant's rights, should installation services or non-MARSHALLS paving be sub-standard and dilution of the distinctiveness of the Complainant's rights.

This risk of tarnishment of the Complainant's service mark is increased because the Complainant operates a structured accreditation scheme for installers of MARSHALLS paving. Accredited installers are assessed by the Complainant, which adds prestige and creates an assumption of quality. Consumers can select an accredited installer with trust that the installer has the appropriately high level of skills required by the Complainant. The content on the Respondent's Website implies a connection to the Complainant and paving installation, so consumers may falsely assume that the user of the disputed domain name is accredited by the Complainant. This is extremely damaging not only to the Complainant as it tarnishes its rights in the Registered Trade Marks but also to consumers who may receive, unwittingly, a sub-standard service.

There is no explanation as to how or why the disputed domain name was selected. It can be assumed that the registrant was clearly aware of the Complainant and that the disputed domain name was chosen to refer to the Complainant. The Complainant submits that this is unjustified as there is no legitimate link to the Complainant.

Furthermore, it appears there are no true contact details for the operators of the site, which because the Respondent denies control over the website, appears to be a third party named by the Complainant in the Complaint as Top Marshall Driveways Limited, a British company incorporated on 5 November 2013 according to the print out of a search at Companies House adduced by the Complainant as an annex to the Complaint. Prior to making this Complaint, the Complainant has tried to contact the Respondent and the entities apparently operating the Respondent's Website by email and post, using the details on the Respondent's website, and received no reply but instead received notices from the Post Office that the letters were undeliverable.

Furthermore, the email address shown on the site is not operational; and the Respondent has not engaged in any meaningful negotiations with the Complainant, despite the Complainant's best efforts to resolve the matter without recourse to legal proceedings.

The Complainant has approached the Respondent to try and seek a resolution between the parties. However, there has been either no response, or no cooperation and the registrant has simply stated that he does not control the disputed domain name. The Complainant contacted the Registrant to query how this is the case but no response was received.

Respondent

The very brief and uninformative Response simply states "I no longer have control of the aforementioned domain or website, or contact with its owner. I only registered the domain and nothing else."

Reply

In Reply the Complainant submits that it is not clear to the Complainant how the Respondent can be the listed Registrant, responsible for the operation and renewal of the disputed domain name, and yet have no control of this, as claimed.

Additionally, as set out in the Complaint, the Complainant is aware that the Respondent's Website is operated by named third parties and submits that, in the alternative, if it is shown that the Respondent's claim to have no control is genuine, the Complainant requests the Complaint continues against the aforementioned third parties.

6. Discussions and Findings

In order for the Complainant to succeed in this Complaint, paragraphs 2.a and 2.b of the DRS Policy require 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 disputed domain name; and
- ii. the disputed domain name, in the hands of the Respondent, is an Abusive Registration.

Paragraph 1 of the DRS Policy defines "Abusive Registration" as meaning 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

The Complainant has provided convincing evidence of its ownership of Rights in the MARSHALLS trademark and service mark acquired through its above-listed trademark registrations and at common law through the extensive use of the MARSHALLS mark on its products and services.

The disputed domain name consists of letters which the Complainant has correctly argued naturally form the three words “top”, “marshall” and “driveways”. The words “top” in the context of the disputed domain name is likely to be viewed as a laudatory epithet, the word “driveways” is a dictionary word descriptive of some of the Complainant’s products and the word “marshall” is almost identical to the Complainant’s MARSHALLS trademark, there being only the missing letter “s”.

As the Complainant has argued, the element “.co.uk” has no distinctive character in the circumstances of this Complaint, being merely a functional ccTLD technical extension.

In the circumstances, as the only distinctive element in the disputed domain name is the dominant word “marshall”, this Expert finds that the disputed domain name is similar to the Complainant’s MARSHALLS trademark and service mark.

The Complainant has therefore succeeded in the first element of the test in paragraph 2 of the Policy.

Having considered the evidence adduced by the Complainant and the bare assertion in the Response that the first named Respondent no longer has control over the disputed domain name this Panel has no hesitation in finding that on the balance of probabilities the disputed domain name was registered to take predatory advantage of the Complainant’s name, mark, goodwill and reputation. The Respondent has given no explanation as to why the disputed domain name was chosen and registered. The combination of words clearly references the products and services offered by the Complainant.

Furthermore, on the evidence, the disputed domain name has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights. The Respondent’s Website is likely to confuse and mislead Internet users into believing that it is in the control of or in some way associated with the Complainant.

The Response filed is no defence whatsoever to the Complaint.

The Complainant appears to accept that the Respondent’s Website is in the control of third parties but it is not necessary for this Expert to consider the allegations made against the third parties mentioned by the Complainant. If these allegations are correct they may well be matters for another forum, but while the disputed domain name remains registered to the first named Respondent he is responsible for its use and control and it is being used in bad faith.

The Complainant has therefore also succeeded in the second element of the test in paragraph 2 of the DRS Policy and is entitled to succeed in this Complaint.

7. Decision

This Expert finds therefore that the Complainant has Rights in the name or mark MARSHALLS which is similar to the disputed domain name <topmarshalldriveways.co.uk> and the disputed domain name, in the hands of the Respondent, is an Abusive Registration.

This Expert therefore DIRECTS that the disputed domain name be transferred to the Complainant forthwith.

Signed

James Bridgeman SC
Expert

Dated: