

DISPUTE RESOLUTION SERVICE

DRS 08216

Decision of Independent Expert

Imperial Chemical Industries Limited

and

Mr. Roy Moulton

1. The Parties:

Complainant: Imperial Chemical Industries Limited

Address: Wexham Road
Slough
Berkshire
Postcode: SL2 5DS
Country: United Kingdom

Respondent: Mr. Roy Moulton

Address: 17 Goldings Road
Loughton
Postcode: IG10 2QR
Country: United Kingdom

2. The Domain Name:

duluxtrades.co.uk

3. Procedural History:

The Complaint was lodged with Nominet on 23 March 2010. Nominet validated the Complaint and notified the Respondent. A Response was submitted in time on 25 March 2010. The Complainant did not submit a Reply. The dispute not having been resolved in mediation, on 21 April 2010 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy (“the Policy”).

Sallie Spilsbury, the undersigned (“the Expert”) has confirmed to Nominet that she knows of no reason why she could not properly accept the invitation to act as expert in this case and has further confirmed that she knows of no matters which ought to be drawn to the attention of the Parties which might appear to call into question her independence and impartiality.

There are no outstanding procedural issues in this matter.

4. Factual Background

The Complainant is a subsidiary of Akzo Nobel, one of the world’s largest chemical producers producing paints and speciality products. The Complainant owns the mark DULUX, which is its best known paint brand available across the world, including across the United Kingdom. The website linked to the Complainant at dulux.com lists over 70 countries where internet users can find an authorised website for DULUX in their country. According to the Complainant DULUX is a term known only in relation to the Complainant and it is a distinctive mark in relation to the goods and services provided by the Complainant.

The Complainant is the proprietor of registered trade marks in over 120 countries which comprise the word DULUX or of which the word DULUX is the dominant particular. The registrations cover various goods and services. Most relevant to this matter are the registrations in class 2 for “paints, varnishes and lacquers” amongst other goods. Annexed to the Complaint is a list of trade marks and the countries in which they are registered (Annex 1). The list is extensive and runs to some 26 pages. At Annex 2 the Complainant exhibits copies of some of the trade mark registrations which relate to the United Kingdom. These include a registration for the word mark DULUX registered on 25 July 2000 in class 1 (CTM E1205152), a registration for a stylised version of the word DULUX registered on 10 December 2004 in class 2 (2367613) and three registrations for figurative marks featuring the word “Trade” alongside the word “Dulux” in class 2 (2173788, 2272532 and 1319966) registered over the period 26 May 1989-16 November 2001.

The Complainant is also the registrant of a number of domain names incorporating the mark DULUX either on its own or with a generic term, including the domain names duluxtrade.co.uk, duluxtrade.com and duluxtrade.eu. Details of these registrations are included at Annex 3 to the Complaint.

The Respondent registered the Domain Name on 7 February 2009. Information provided to Nominet indicates that he is a non-trading individual. The Complaint records that during an (undated) telephone conversation between the Respondent and the Complainant's representatives, the Respondent confirmed that he worked in the painting and decorating trade. This is not disputed by the Respondent.

At Annex 4 to the Complaint the Complainant exhibits copies of webpages from the website operated at the Domain Name. These are dated 21 January 2010. They are supported by a snapshot dated 23 March 2010 which has been supplied to the Expert by Nominet. At that time the Domain Name appears to have been parked by the Respondent and the relevant webpages feature sponsored listings providing links to websites operated by painters and decorators and manufacturers of paint products. There are references to suppliers of the Complainant's Dulux paints, alongside references to the Complainant's competitors.

A Google search by the Expert on 16 May 2010 found no results for the Domain Name as at that date.

The Complainant has confirmed that it has not licensed or otherwise permitted the Respondent to use its trade mark.

5. Parties' Contentions

The Complainant

Rights

The Complainant asserts Rights in respect of a trade mark which is identical or similar to the Domain Name. It submits that when a domain name wholly incorporates a Complainant's registered trade mark with a generic term this is sufficient to establish similarity for the purposes of the Nominet Dispute Resolution Policy ("the Policy"). The Domain Name differs from the Complainant's DULUX trade mark only by the addition of the generic term "Trades" as a suffix. This does not negate the dominant impression created by the word DULUX or give any independent distinctiveness to the Domain Name (the Complainant relies on the Expert decision in DRS 2455 Compaq Trademark BV v Balata.com LLC to support this submission). The lack of independent distinctiveness is heightened by the fact that until recently the website at the Domain Name featured sponsored listings for various painting and decorating services, including references to Dulux paint.

Abusive Registration

The Complainant asserts that the Domain Name is an Abusive Registration because the Respondent has used the Domain Name in a way that is likely to confuse people or businesses into believing that it is registered to, operated or authorised by or otherwise connected to the Complainant. In support of this the Complainant argues that the Respondent's connection with the painting and decorating trade means that it is likely on the balance of probabilities that he was

aware of both the DULUX and DULUX TRADE trade marks at the time that he registered the Domain Name in 2009 and that he must have been aware that he was misappropriating the valuable intellectual property of the Complainant in doing so. He had no other reason to choose the Domain Name than to profit from the Complainant's goodwill in the DULUX mark.

The Respondent does not dispute these submissions.

The Complainant also submits that the Respondent is not making legitimate non-commercial use of the Domain Name. The webpage at the Domain Name contains links to third party websites. If these links were followed they would very likely generate income for the Respondent. Even if this were not the case, the website would have taken potential customers (and therefore possible business) away from the Complainant, disrupting the Complainant's business (the Complainant relies on the Expert Decision in DRS 5844 McCarthy & Stone plc v John Tziviskos in this regard).

The Respondent

The Respondent has made no substantive submissions in this matter. The document described by Nominet as the "Response" takes the form of an email dated 25 March 2010 containing "without prejudice" material. This takes the form of an invitation by the Respondent to the Complainant to "make me an offer that would cover all my costs" in return for the transfer of the Domain Name to the Complainant. The Complainant has not taken up this invitation.

6. Discussions and Findings

Complainant's Rights

Rights are defined in clause 1 of the Policy as including, but not limited to, "rights enforceable by the Complainant whether under English law or otherwise".

The Complainant relies on its trade mark registrations to confer Rights. It has produced clear evidence of the existence and currency of an extensive range of registrations comprising the DULUX mark. These clearly confer enforceable Rights in that mark. The evidence also shows that the DULUX mark has been marketed across the world by the Complainant which suggests that the goodwill generated by the brand is strong.

The next question is whether the Complainant's Rights relate to a mark that is identical or similar to the Domain Name. The Expert agrees with the Complainant's submissions that the dominant component of the Domain Name is the word "Dulux". The suffix "Trades" lacks independent distinctiveness and does not detract from the dominant impression generated by the more well-known DULUX mark. The Expert finds that under the Policy the Domain Name is similar to the Complainant's trade mark registrations in which the Complainant has Rights.

The Expert also finds that the trade mark registrations which comprise the words "DULUX TRADE" are similar to the Domain Name. Although the Complainant's marks are figurative, the dominant components of the registrations are the words rather

than the accompanying logos and the registrations do not appear to have a disclaimer that would prevent the registrations being enforceable in relation to the words alone.

It follows that the Complaint has established that it has Rights in marks that are identical or similar to the Domain Name.

Abusive Registration

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

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 or was unfairly detrimental to the Complainant's Rights.

The Complainant relies on the use to which the Respondent has put the Domain Name (clause 1 ii).

Paragraph 3 of the Policy sets out guidance about applying the Abusive Registration test.

Paragraph 3 (ii) refers to

“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.”

The Respondent has used the Domain Name in connection with a website featuring sponsored links. These links enable visitors to the website to access websites operated either by direct competitors of the Complainant or by suppliers of paint products dealing in a range of products, including those of the Complainant's competitors.

The Expert finds that where a member of the public sees the Domain Name they will on the balance of probabilities initially associate it with the Complainant because of the distinctive nature of the Complainant's well known mark. This in itself can amount to confusing use under the Policy. Once at the Respondent's website it remains likely that a visitor would be under the impression that the website is authorised or approved by the Complainant. There are references to the Complainant's paints alongside those of its competitors on the webpages and it seems likely that an average consumer would infer from the Domain Name in combination with the reference to Dulux paints some kind of endorsement of the site by the Complainant. However, as the Complainant states, the potential

consumer is also offered access to a range of websites featuring products that compete with the Complainant. There is a real likelihood that the Respondent's website could serve to divert customers from the Complainant's products causing the Complainant a potential loss of custom and therefore income. This would be detrimental to the Complainant. The detriment is unfair because it derives from the strength of the Complainant's mark. Any advantage to the Respondent, for example any pay per click income, would also be taking an unfair advantage of the Complainant's mark. It would be unfair because it is parasitical. The Respondent has put forward no contrary argument.

It follows that the Expert finds that the Respondent's use of the Domain Name amounts to an Abusive Registration under the Policy. It is likely to confuse customers in a way that causes unfair detriment to the Complainant and that takes unfair advantage of the Complainant's market position and brand.

7. Decision

The Expert finds that the Complaint has proved on the balance of probabilities that it owns 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.

Accordingly, the Expert finds in favour of the Complainant and directs that the Domain Name be transferred to the Complainant.

Signed Sallie Spilsbury

Dated 24 May 2010