

DISPUTE RESOLUTION SERVICE

D00009141

Decision of Independent Expert

PPG Industries Ohio, Inc

and

Promain (UK) Limited

1. The Parties:

Lead Complainant: PPG Industries Ohio, Inc
3800 West 143rd Street
Cleveland
Ohio
44111
United States

Complainant: PPG Industries, Inc.
One PPG Place
Pittsburgh
Pennsylvania
United States

Complainant: Ameron International Corporation
245 South Los Robles Avenue
Pasadena
California
91101-2894
United States

Respondent: Promain (UK) Limited
Unit 1, North end Burymead Road
Hitchin
Hertfordshire
SG5 1RT
United Kingdom

2. The Domain Name:

ameron-ppg.co.uk

3. Procedural History:

On 21 December 2009, PPG Industries Ohio, Inc ("PPG") and PPG Industries Inc ("PPG Inc") filed an earlier complaint against Promain UK Limited ("Promain") in respect of the same domain name in issue in this Complaint.

The earlier complaint was subject to a Summary Decision dated 15 February 2010. The Expert in that case (DRS 8065) ordered no action on the basis that:

"There are too many unanswered questions for summary resolution. The Complainants' licence to Ameron has expired and it's not clear what current right is claimed. While the Complainants have registered rights to PPG, this is not distinctive or dominant for similarity. Further, the Respondent was (at registration) and remains an authorised UK distributor/reseller of the Complainants' genuine products and its site (as exhibited) makes that clear. No evidence was submitted of the terms between the parties or confusion".

PPG and PPG Inc filed this Complaint on 6 October 2010 in respect of the same domain name and against the same Respondent, Promain, but now with the addition of a further Complainant, Ameron International Corporation ("AIC"). Again, Promain chose not to respond.

I also note that PPG, PPG Inc and PPG Coatings Nederland NV obtained a Summary Decision in their favour against Promain (DRS 9095) in relation to the domain name sigmapaint.co.uk on 28 October 2010. In that case the Expert stated as follows:

"Even if [Promain] is using the Domain Name solely to identify the Complainants' products sold by it, which is far from clear, it would still fall foul of the Appela Panel Decision in DRS 000248 (seiko-shop.co.uk)".

On 1 November 2010, the Complainants paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

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.

In substance, this decision concerns the circumstances in which an Expert may reconsider a complaint which has reached the Decision stage on a previous occasion.

4. Factual Background

PPG is the registered proprietor of the UK and CTM trade mark registrations Nos. 1356259 and 051789 for a stylised mark for PPG covering paints and coatings, and other goods, with dates of registration of 1 April 1996 and 31 August 1988 respectively.

PPG Inc is said to be the operating company for the PPG business.

AIC is the registered proprietor of UK trade mark registrations Nos. 1207757 and 1207756 for the word mark AMERON covering paints and other goods, both with dates of registration of 23 November 1983.

Under the terms of a licence agreement dated 1 August 2006, which expired on 31 January 2009, AIC granted PPG Inc an exclusive and royalty free license to use the AMERON mark in connection with the manufacture, distribution, marketing and sale of coatings and finishes. The terms of the licence were non-transferable (other than to affiliates). As the licence has expired, PPG and PPG Inc no longer have any rights in respect of the AMERON trade mark.

Details of the Complainants' registrations and a copy of the licence agreement were provided with the Complaint.

The Respondent ("Promain") registered the disputed domain name ("the Domain Name") on 25th February 2008. On entering www.ameron-ppg.co.uk into a browser, a user is taken to a page on Promain's website which displays PPG's stylised registered trade mark in the top left hand corner of the webpage next to the name PPG Protective & Marine Coatings. On the top right hand corner of the same webpage appears a logo incorporating the name "Promain."

The sign "PPG Protective coatings" also appears as a heading on the webpage below the PPG stylised mark and Promain logo. The following text appears under this heading:

PPG Industrial Coatings provides customers with the industry's broadest product offering, distribution, and knowledge. PPG Industrial Coatings provides customers with two comprehensive brand families: Amercoat and the new Sigma Coatings product line. PPG Industrial Coatings offers best-in-class products for: marine, infrastructure, chemical processing, power, oil and gas, offshore and rail industry segments. PPG Industrial Coatings protects customer's assets in some of the world's most demanding conditions and environments.

Adjacent to the above text, there is a section on this webpage which states "UK distributors for...Amercoat, Sigma Coatings, Amerlock," as well as a number of other product lines and brands.

On 1 July 2010, AIC's US attorneys sent Promain a letter to request immediate cessation of the use of the Domain Name together with an assignment of the Domain Name. AIC also offered to reimburse Promain's reasonable costs.

On 16 July 2010 Promain replied stating that it had consulted Nominet. It alleged that Nominet's response "...was not [sic] we were entitled to use the name". Promain invited AIC to make an offer.

I was not provided with any evidence of further correspondence between the parties.

5. Parties' Contentions

The Complainants say that, since AIC was not party to the earlier complaint against Promain:

- (1) there was no evidence before the Expert who made the Summary decision of AIC's registered rights in the mark AMERON or of the fact that Promain did not have authorisation from AIC to use the AMERON mark.
- (3) the matter was not fully considered in the earlier proceedings because AIC was not a party.

They contend that AIC has joined both PPG and PPG Inc as Complainants in order to show that they together have registered rights in the marks PPG and AMERON which, when combined, constitute the Domain Name.

The Complainants allege that, as a result of this Complaint, there is no longer any unresolved issue over trade mark rights because the two registered trade mark owners are now parties to the Complaint. Between them, it is submitted that they own trade mark rights in the two elements constituting the Domain Name.

It is alleged that none of the Complainants have authorised Promain to use the trade marks other than as a distributor of goods bearing their trade marks.

By joining AIC as a party, it is claimed that the circumstances are sufficiently exceptional to justify a re-hearing of the Complaint because:

- (1) Promain is not prejudiced in anyway having failed to respond to the earlier Complaint; and
- (2) a re-hearing would avoid an unconscionable result. It is claimed that it would be unconscionable for Promain to retain the Domain Name as it is constituted by registered trade marks over which it has no rights.

The Domain Name is alleged to be an Abusive Registration on the basis that:

- (1) as a customer of the Complainants, Promain was aware of the Complainants' rights in the trade marks at the time the Domain Name was acquired on 25 February 2008; and
- (2) the use of the Domain Name disrupts the Complainants' businesses by misdirecting or misleading their customers and potential customers;
- (3) the registration of the Domain Name indicates an intention on the part of Promain to trade off of the goodwill and reputation of the Complainants in their registered trade marks;
- (4) the use of the Domain Name by Promain will and does confuse people into thinking that the Domain Name is under the control of the Complainants because:
 - (a) the Domain Name is constituted by the Complainants' trade marks;
 - (b) the Complainants' trade marks are used on Promain's website.
- (5) The Complainants have not consented to Promain's use of their trade marks as or as part of the Domain Name. Any such use is outside the scope of any agreement between the Complainants and Promain relating to the distribution or sale of the Complainants' goods.

6. Discussions and Findings

Paragraph 10 of the Policy states as follows:

e. If a complaint has reached the Decision stage on a previous occasion it will not be reconsidered (but it may be appealed, see paragraph 10(a) and Procedure paragraph 18) by an Expert. If the Expert finds that the complaint is a resubmission of an earlier complaint he or she shall reject the complaint without examining it.

f. In determining whether a complaint is a resubmission of an earlier complaint, or contains a material difference that justifies a re-hearing the Expert shall consider the following questions:

- i. Are the Complainant, the Respondent and the domain name in issue the same as in the earlier case?*
- ii. Does the substance of the complaint relate to acts that occurred prior to or subsequent to the close of submissions in the earlier case?*
- iii. If the substance of the complaint relates to acts that occurred prior to the close of submissions in the earlier case, are there any exceptional grounds for the rehearing or reconsideration, bearing in mind the need to protect the integrity and smooth operation of the Policy and Procedure?*
- iv. If the substance of the complaint relates to acts that occurred subsequent to the close*

of submissions in the earlier decision, acts on which the re-filed complaint is based should not be, in substance, the same as the acts on which the previous complaint was based.

g. A non-exhaustive list of examples which may be exceptional enough to justify a re-hearing under paragraph 10(f)(iii) include:

- i. serious misconduct on the part of the Expert, a Party, witness or lawyer;
- ii. false evidence having been offered to the Expert;
- iii. the discovery of credible and material evidence which could not have been reasonably foreseen or known for the Complainant to have included it in the evidence in support of the earlier complaint;
- iv. a breach of natural justice; and
- v. the avoidance of an unconscionable result.

In substance paragraph 10 of the Policy gives expression to principles which underpin the *res judicata* doctrine but written in the context of the DRS. This doctrine is that a judgment between parties to litigation (in the absence of an appeal to a higher tribunal) is conclusive upon issues actually brought before the court and upon any issues which the parties, exercising reasonable diligence, should have brought forward on that occasion. The same parties, under the *res judicata* doctrine, cannot attempt to re-litigate such issues. The public policy grounds for this principle are rooted in the desire to avoid a multiplicity of proceedings; to bring finality to litigation; and to ensure that no individual is subjected more than once to proceedings for the same complaint.

The first matter for me to consider is whether the complaint is anything more than a resubmission of an earlier complaint or contains a material difference that justifies a re-hearing. Under the Policy I must reject the complaint without examining it if it is a resubmission. Taking in turn the questions I am compelled to consider in this regard by the Policy:

First, are the Complainant, the Respondent and the domain name in issue the same as in the earlier case? They are identical, save for the addition of AIC. I will consider the implications of this in more detail below.

Secondly, does the substance of the complaint relate to acts that occurred prior to or subsequent to the close of submissions in the earlier case? The Complaint plainly relates to acts that occurred prior to the close of submissions in the earlier case.

Thirdly, are there any exceptional grounds for the rehearing or reconsideration? In this respect there is no evidence of serious misconduct on the part of the Expert who determined the earlier complaint, a Party, witness or lawyer; no evidence of false material having been offered to the Expert; nor have I been provided with any credible and material evidence which could not have been reasonably foreseen or known for the Complainants to have included it in the evidence in support of the earlier complaint.

Should the addition of a further party (as here) automatically take a complaint outside of Paragraph 10 of the Policy? In my view, it should not. Each complaint which constitutes a re-filing save for the joinder of a further party should still be considered as potentially subject to paragraph 10 of the Policy in my view. It seems to me that the adoption of a contrary approach would fail to give effect to the intent of Paragraph 10. As the Appeal Panel in DRS 1295 makes clear (which led to the incorporation of the provisions of Paragraph 10), the purpose behind adopting principles in the DRS which find expression in the *res judicata* doctrine, is twofold: (1) to protect the integrity of the DRS by encouraging parties to use the DRS sensibly and efficiently; and (2) to achieve for the parties to a DRS complaint a reasonable degree of certainty and finality.

In my view, if an expert was required to reconsider a complaint simply because a further party had been added, this may well undermine these two fundamental principles. It seems

to me that paragraph 10 of the Policy should still therefore be of potential application in cases where it appears to an Expert that a party has been added to a complaint:

- (1) as a mechanism the effect of which is to frustrate the intent of Paragraph 10; or
- (2) as a means primarily for seeking to adduce evidence as to rights or abusive intent that was omitted first time around even though it could have been reasonably foreseen or known.

I will therefore apply this approach to this case.

In my judgment, I do not believe it could be said fairly that AIC has been joined as a party for the purposes of frustrating the purposes of paragraph 10. However, I have reached the firm view that joining AIC was in substance little more than a mechanism for trying to adduce evidence as to rights in the Ameron mark that was omitted first time around even though it was readily available and could easily have been foreseen. Accordingly I find that paragraph 10 of the Policy applies in this case. However that is not the end of the matter as I still am required to consider the other (non-exhaustive) examples which may constitute exceptional grounds for a re-hearing or reconsideration of the complaint, namely a breach of natural justice or the avoidance of an unconscionable result.

Much has been written about the concept of natural justice but for present purposes it seems to me that it is based on three fundamental principles.

First, that the adjudicator has the authority or jurisdiction to make the decision. I have no reason to doubt the Expert's authority or jurisdiction in this case.

Secondly, that the adjudicator is unbiased, and has no interest in the eventual outcome. In this respect I note that Nominet stipulate under Paragraph 9 of its Procedure that the Expert:

"shall be impartial and independent and both before accepting the appointment and during the proceedings will disclose to us any circumstances giving rise to justifiable doubt as to his or her impartiality or independence."

I have not been provided with, nor seen any evidence, which would indicate to me that the Expert disclosed any such doubt or had in fact any doubt as to his or her independence or impartiality. Nor have I seen any evidence to show that the Expert was in fact biased in any respect, had any conflict of interest or had any personal interest in the decision reached.

Thirdly, that the parties were provided with the opportunity to present their case, and to consider or challenge any evidence. PPG and PPG Inc were clearly afforded the opportunity of presenting their case that the Domain Name was an abusive registration, and did so; they chose to adopt the summary process. In this respect, it is relevant to note that under Paragraph 7 c of the Policy the Expert will only grant a request for summary decision where he or she is satisfied that:

- (1) Nominet has sent the complaint to the Respondent in accordance with paragraphs 2 and 4 of the Procedure;
- (2) The Complainant has, to the Expert's reasonable satisfaction, shown that he or she has Rights in respect of a name or mark which is identical or similar to the Domain Name and the Domain Name is an Abusive Registration; and
- (3) No other factors apply which would make a summary decision unconscionable in all the circumstances.

So far as PPG and PPG Inc are concerned, they could have challenged the summary decision by means of an Appeal. So in respect of those parties I do not see any basis for concluding that there has been a breach of this aspect of the concepts which underpin natural justice.

What about AIC? The difficulty as I see it is that I have not been provided with any evidence which helps me determine whether, for example, AIC:

- (1) knew about the Domain Name prior to the initial complaint being filed;
- (2) was consulted in advance of the initial complaint made by PPG;
- (3) was given any opportunity to assist with the complaint; or
- (4) was notified about the possibility of an Appeal.

Had they been consulted in advance of the initial complaint and been afforded the opportunity of participating in the proceedings (but declined), I may well have concluded on that basis that there had not been a breach of natural justice in its case. Absent such evidence it appears to me that I have to exercise the utmost caution in determining that AIC's remedies under the Policy are exhausted in respect of this particular Complaint, bearing in mind the incorporation within the Domain Name of its registered trade mark.

On the other hand, AIC is a Complainant in these proceedings, and it would have been easy for the parties to have adduced evidence, as to what AIC did or did not know about the initial complaint, and the steps it took thereafter. I note too that it appears to have been advised by US attorneys. In my view, the filing of this Complaint gave AIC the opportunity to present its case, to explain its role in respect of the initial complaint, and to consider or challenge the evidence. I do not therefore believe that there has been any breach of natural justice in respect of AIC.

The Complainants say that a re-hearing would avoid an unconscionable result on the basis that the Domain Name is constituted by trade marks over which it has no rights. While the considerations which are relevant to the question of whether an abusive registration has occurred are not co-extensive with those which underpin the law of registered trade marks, there is often some overlap. I have therefore considered in this regard the fact that the Directive and Regulation which govern the use of registered trade marks in the EEA entitle third parties to use registered trade marks in a variety of ways. While it would not be appropriate for me to examine the merits of the Respondent's use of the Complainants' trade marks under the Directive and Regulation (save in respect of the context of the Policy and Procedure), mere incorporation of another's trade marks within a domain name does not necessarily infringe the marks themselves (though it may amount to an abusive registration). On the limited evidence before me I do not believe there is anything unconscionable about not re-hearing this matter based solely upon the Respondent's use of the Complainants trade marks (whether as incorporated in the Domain Name or otherwise).

Nor do I believe it unconscionable not to re-hear this matter even though PPG and PPG Inc have obtained a summary transfer of the sigmapaint.co.uk domain name against Promain very recently. That is not enough to lead to a gross injustice in this case in my view.

I have also taken into account the fact that the result may have been different the first time around had AIC been added to as party. In the circumstances of this case, that is not enough either to make the result unconscionable.

Finally, the Complainants allege that a re-hearing would be justified because Promain would not suffer any prejudice as it has failed to respond to the earlier Complaint (and indeed this Complaint). In my view, any such lack of prejudice would be insufficient to warrant a re-hearing. It would mean that a re-hearing should always be available in these cases. I have not seen anything in the Policy or Procedure from which I could reasonably infer such an intention on the part of Nominet.

I am required to bear in mind the need to protect the integrity and smooth operation of the Policy and Procedure when determining whether a re-hearing is justified. While an Expert should be careful to ensure that procedural rules do not obscure the need to do justice between parties, in this case it is my view that nonetheless a re-hearing would not be justified.

7. Decision

I find that the Complaint is in substance a resubmission of an earlier complaint and that no action shall be taken in respect of the Complaint.

Signed : Cerryg Jones

Dated 30 November 2010