

DISPUTE RESOLUTION SERVICE

DRS 21800

Decision of Independent Expert

European Tyre Enterprise Limited

Complainant

and

Douglas Whytt

Respondent

1 The Parties

Complainant:	European Tyre Enterprise Limited
Address:	Etel House Avenue One Letchworth Garden City Hertfordshire SG6 2HU United Kingdom

Respondent:	Douglas Whytt
Address:	8 Marmora Road London SE22 0RX United Kingdom

2 The Domain Name

eupeantyre.co.uk (the "Domain Name").

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, which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

4 October 2019	Dispute received
7 October 2019	Complaint validated
7 October 2019	Notification of complaint sent to parties
24 October 2019	Response reminder sent
29 October 2019	No Response received
29 October 2019	Notification of no response sent to parties
7 November 2019	Expert decision payment received
21 November 2019	Rule 17.1 request made of Complainant
16 December 2019	Rule 17.1 further statement received

4 Factual Background

- 4.1 The Complainant has been in business under the name European Tyre Enterprise Limited since August 2011. It is a holding company for a number of suppliers of motor tyres in the UK and continental Europe through various brands, including in the UK the well known Kwik-Fit chain. Collectively through its subsidiaries it is the largest retailer of tyres in the UK.
- 4.2 The Domain Name was registered by the Respondent, a private individual, on 5 March 2018.
- 4.3 As from at least June 2019 the Domain Name was used for a website on which, for reasons unknown, the Respondent appeared to masquerade as the Complainant (the "First Website"). In August 2019, at the Complainant's request, access to that website was blocked by the relevant ISP.
- 4.4 As from August 2019, the Domain Name pointed, and currently points, to a pay-per-click parking page (the "Second Website").

5 Parties' Contentions

Complaint

- 5.1 The Complainant says it has traded under the name European Tyre Enterprise Limited (which it confusingly defines, for the purposes of the Complaint, variously as "European Tyre" and as "ETEL") since 23 August 2011 and asserts that it has "over eight years of international goodwill and reputation in the name EUROPEAN TYRE". The Complainant was first incorporated, under another name, on 28 February 2011 and on 23 August 2011 changed its name to European Tyre Enterprise Limited.
- 5.2 The Complainant does not claim to have any registered EUROPEAN TYRE trade marks. It confines its case, as it is entitled to do under the Policy, to its unregistered rights in the EUROPEAN TYRE name, in which it asserts that it "has built up significant goodwill and reputation".
- 5.3 In support of that assertion, the Complainant says that it is the largest supplier of vehicle tyres in the UK and one of the largest in Europe. It says it has over 700 tyre retail centres in the UK where it trades by reference to a number of brands: Kwik-Fit, Stapletons, STS Tyre Pros, Tyre

City, Central Tyre and ITR-CEE (but not by reference to the EUROPEAN TYRE name). In addition, it says it sells tyres through approximately 180 retail outlets in the Netherlands, more than 60 franchises in Italy and Hungary, and a tyre wholesaler in Poland. No information is provided as to the name or mark by which the Complainant trades in those jurisdictions, but in any event it is not said that it is by reference to the EUROPEAN TYRE name.

- 5.4 The Complainant contends, in effect, that it has acquired its unregistered rights in the EUROPEAN TYRE name by reason of the fact that it has been buying tyres - for onward distribution at the retail level - in its company name "and its unregistered mark EUROPEAN TYRE" since 2011. It says that "this [i.e. presumably EUROPEAN TYRE] is the name which is used and has brand value with the world's premier tyre manufacturers, including (but not limited to) Michelin, Bridgestone, Pirelli, Goodyear and Continental". No evidence is provided in support of the assertions either that the Complainant uses the EUROPEAN TYRE name (as opposed to its company name) in trading with its tyre suppliers, or that it is known by that name by its tyre suppliers.
- 5.5 In addition, the Complainant says that it conducts business under its company name with other suppliers and with government. Evidence is provided in the form of an invoice in the company name to Pirelli Tyres Limited, a copy of the Complainant's latest audited accounts, and an invoice from North Hertfordshire District Council. There is no suggestion in any of those documents that the Complainant is trading under the EUROPEAN TYRE name rather than its full company name.
- 5.6 The Complainant says that its group turnover for 2018-19 was around £970 million, and that around £11 million is spent annually promoting the Complainant's retail business, though it is unclear whether that spend relates to the company name and/or the EUROPEAN TYRE name, or to the retail brands mentioned at 5.3 above.
- 5.7 The Complainant explains that it owns the Kwik-Fit business which "has built an excellent reputation and substantial goodwill in Europe especially for providing high quality vehicle maintenance and repair services". The Complainant asserts that "all goodwill that has accrued in the Kwik-Fit brand is associated with European Tyre", though no evidence is provided in support of that assertion. Likewise, it is said that "it is well known amongst members of the relevant purchasing public across Europe that European Tyre is the owner of numerous registered trade marks for both the 'Kwik-Fit' name and logo in many jurisdictions". The Complainant provides details of various UK and EU registered marks in the Kwik-Fit name and logo which are owned by it, but no evidence in support of the contention that the "relevant purchasing public" are aware that it owns those registered marks.
- 5.8 The Complainant contends that its "registered and unregistered trade marks enjoy a significant reputation worldwide, particularly in the United Kingdom and Europe and this has increased the goodwill in the Complainant's brand" (presumably meaning the EUROPEAN TYRE name, as opposed to its retail brands).
- 5.9 The Complainant's case is that the Domain Name is identical to its "widely used unregistered mark EUROPEAN TYRE".
- 5.10 The Complainant adds that "the overall impression is that the Complainant's mark is the dominant part of the disputed domain name and as the Complainant's mark has a strong international reputation, the Respondent has no reasonable justification for having registered the disputed domain name".

Further statement from Complainant pursuant to Rule 17.1

5.11 On 21 November 2019 the Expert made a request, pursuant to paragraph 17.1 of the Policy in the following terms:

"Of the Complainant's assertions that it has:

- *"over eight years of international goodwill and reputation in the name EUROPEAN TYRE";*
- *"built up significant goodwill and reputation associated in [sic] the unregistered mark EUROPEAN TYRE";*
- *"exercised its purchasing power by buying as a Group through ... its unregistered mark EUROPEAN TYRE since 2011";*

please provide evidence of:

1 *the goodwill and reputation in the name EUROPEAN TYRE (as opposed to goodwill and reputation in the various brand names owned by ETEL or in the name of the company, European Tyre Enterprise Limited);*

2 *purchases carried out by reference to the EUROPEAN TYRE mark.*

Of the Complainant's assertions that its turnover for 2018-19 was around £970m and that around £11m is spent annually promoting its retail business:

3 *please clarify whether it is the Complainant's case that such turnover was generated in whole or in part (and if the latter, to approximately what extent) by reference to the EUROPEAN TYRE name;*

4 *please clarify whether it is the Complainant's case that such marketing budget was spent in whole or in part (and if the latter, to approximately what extent) on promoting the EUROPEAN TYRE name, as opposed to the names of the retail brands owned by ETEL; and*

5 *please provide evidence of any such marketing, advertising, branding or sales promotion by reference to the EUROPEAN TYRE name.*

The Complainant is respectfully referred in this regard to paragraph 2.2 of the Experts' Overview."

5.12 On 16 December 2019 the Complainant's representative filed a further statement pursuant to Rule 17.1, together with additional evidence. The Complainant submits that the Respondent had on the First Website made "unauthorised use of and reference to" (a) the Complainant's company name, i.e. European Tyre Enterprise Limited, (b) the Complainant's registered company number, and (c) the Complainant's registered office address.

5.13 The Complainant goes on to contend as follows: "whilst the words EUROPEAN TYRE are used within the domain address itself, it is not the case that the infringer only made reference to those words. It is therefore sufficient, the Complainant would argue, to demonstrate a reputation in a company name for the complaint to meet Nominet's criteria".

5.14 The Complainant further draws attention to the fact that both its company name and the EUROPEAN TYRE name were used by the Respondent "in order to sell (or offer for sale)

articles and services which are identical to the Complainant's trade names, being rights in the nature of unregistered trade marks protected by the laws of passing off and unfair competition".

- 5.15 The Complainant further submits that "the dominant part of our client's company name is the first two words, EUROPEAN TYRE and the words ENTERPRISE LIMITED may be considered descriptive and therefore the use by the infringer of both forms of wording will be taken by internet users as a reference to our client".
- 5.16 The Complainant appends 18 further documents which it contends demonstrated its "goodwill, reputation and genuine business use of the words EUROPEAN TYRE/ EUROPEAN TYRE ENTERPRISE LIMITED". Those documents primarily comprise invoices issued by the Complainant and five contracts entered into by it. The Complainant contends that those documents, which are just a sample of "the large volume of invoices and contracts held in our client's European Tyre Enterprise Limited name" demonstrate that the Complainant "conducts a great deal of business under that name (as opposed to in the name of its subsidiary company Kwik-Fit, for example)". It contends that "the supply-side of our client's business is conducted in the name of European Tyre Enterprise Limited, which will then either consumer [sic] the various goods and services purchased for the benefit of its entire group, or it will onwards supply them to its group companies for use. By reason of those facts, the Complainant contends that it is incredibly well known under the European Tyre name".
- 5.17 The Complainant relies also on the fact that "the rather cumbersome full company name would typically be shortened by people in the industry to 'European Tyre'" and that the dominant part of its logo is the words European Tyre and that therefore "there can be little doubt that our client has built up significant goodwill by trading under and in its company name".
- 5.18 As to the question concerning the extent to which the Complainant's turnover was generated by reference to the EUROPEAN TYRE name, the Complainant explains that "the vast majority of procurement in relation to our client's £970 [million] turnover is conducted in the EUROPEAN TYRE name". The Complainant reiterates that whilst it is its Kwik-Fit and other brands which "are clearly well known amongst the general public", it is the "EUROPEAN TYRE name which is used and has brand value with the suppliers to our client's substantial group".
- 5.19 As to the marketing budget, the Complainant accepts that "it does not actively advertise its EUROPEAN TYRE brand in paid for advertising".

Complaint (continued)

- 5.20 The Complainant explains that on 28 June 2019 it became aware that the Domain Name was being used in the URL for the First Website, which was selling or offering for sale "articles and services which were identical to the Complainant's registered and unregistered marks". It points to the unauthorised use on that website of the Complainant's marks, business name, registered company number and registered office address.
- 5.21 Following representations from the Complainant, on 13 August 2019 the ISP hosting the First Website blocked access to it.
- 5.22 A week later, on 20 August 2019, the Complainant became aware that the Domain Name was now being used on a different website hosted by a different ISP. It contends that such use constituted "the unauthorised use of the Complainant's unregistered marks and business name". It would appear that this is a domain name parking page from which somebody or some entity is deriving income on the usual pay-per-click basis.

- 5.23 The Complainant asserts that the Respondent has no right or legitimate interest in the Domain Name and that there is no legitimate purpose for which it could be used. The Complainant has not been able to contact the Respondent.
- 5.24 The Complainant asserts that the Respondent must have known of the Complainant's existence and nonetheless went on to register the Domain Name without having any authorisation to do so. The Complainant contends that this constitutes unfair disruption of its business as envisaged in paragraph 5.1.1.3 of the Policy.
- 5.25 It further contends that the Respondent deliberately registered the Domain Name "to profit unfairly from the goodwill of the Complainant's mark and brand". It says that the inclusion of the Complainant's business name, company number and registered office address on the Respondent's initial website constituted the provision of false contact details to Nominet as provided in paragraph 5.1.4 of the Policy.
- 5.26 Further, the Complainant contends that the use of the EUROPEAN TYRE mark in the Domain Name was intended to and would have resulted in initial interest confusion contrary to paragraph 5.1.2 of the Policy.
- 5.27 The Complainant relies also on its assertion that the Respondent intentionally misled internet users as to the provenance of the items offered for sale and was "therefore misrepresenting to the public the origin of their undertaking and the articles purportedly for sale". It contends that trade intended for the Complainant was thereby diverted from it, and that the goodwill of the Complainant's brand was tarnished "particularly by damaging the reputation of the Complainant as a retailer of high quality products and services".
- 5.28 The Complainant further alleges that the Respondent was "operating illegally or otherwise unlawfully" in apparently taking payment for EUROPEAN TYRE branded goods and services without its authorisation and providing goods which were not manufactured either by the Complainant or by Kwik-Fit. Such use, it is said, amounted to fraud given that those representations were known by the Respondent to be false and were intended by him to defraud customers.
- 5.29 The Complainant returns to its earlier reliance on paragraph 5.1.1.3 of the Policy asserting that "it is clear" that the Respondent "was aware of the Complainant's global business and through the disputed domain name, intended to unlawfully make use of the goodwill associated with the EUROPEAN TYRE brand by registering the disputed domain name for the purpose of unfairly disrupting the business of the Complainant's Rights". This is said to be "evidently a significant factor" pursuant to paragraph 5.1.1.3 of the Policy.
- 5.30 Finally, the Complainant refers to "paragraph 4(a)(iii) of the DRS Policy" - an erroneous reference to a provision in a long out of date version of the Policy dealing with contractually agreed use by a respondent of a domain name. An equivalent provision may be found at paragraph 8.1.3 of the current Policy, but its relevance to this case is unclear.

Response

No response was filed.

Reply

Accordingly no reply was filed.

6 Discussions and Findings

General

6.1 To succeed under the DRS Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"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) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's rights

6.3 Paragraph 2.1.1 of the Policy requires the Complainant to prove that it *"has Rights in respect of a name or mark which is identical or similar to the Domain Name"*. "Rights" means *"rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"* (paragraph 1).

6.4 The Complainant's case on Rights is confused, to put it kindly. Its difficulty is that the EUROPEAN TYRE name is both generic and descriptive. It is therefore incumbent on the Complainant to demonstrate that it has, by its use of that name, imbued it with sufficient distinctiveness to give rise to the common law rights in that name for which it contends.

6.5 The Complainant does not appear to be entirely clear as to whether its case is that its Rights in the EUROPEAN TYRE name arise from its company name or whether it is its case that the EUROPEAN TYRE name has acquired sufficient life of its own to give rise to the common law rights for which the Complainant contends. The Complainant's case is not enhanced by its decision to use in the Complaint 'European Tyre' as a defined term for its company name, European Tyre Enterprises Limited. Hence, it is totally unclear from its submissions at what point it is contending that Rights arise in the company name and at what point in the EUROPEAN TYRE name.

6.6 This decision refers to the company name by its acronym, ETEL.

6.7 A further complication is that the Complainant appears to be arguing that the trading goodwill in its registered and unregistered retail brands (Kwik-Fit et al) somehow attaches to the EUROPEAN TYRE name. However, no explanation is provided as to why that should be the case. On the face of it, that is not a tenable argument.

6.8 A difficulty also arises from the Complainant's position in relation to similarity. Rather than, for example, advancing an argument that the ETEL name is similar to the Domain Name, the Complainant relies solely on its unregistered rights in the EUROPEAN TYRE name (rather than the ETEL name) as being identical to the Domain Name.

- 6.9 However, as numerous DRS decisions have demonstrated, the threshold for establishing Rights is not intended to be a high one. The Complainant has established by way of evidence a history of trading by reference to its company name, primarily in its purchasing of tyres from tyre manufacturers, and in its associated contractual arrangements.
- 6.10 The question, therefore, is whether the Complainant has thereby acquired Rights in the EUROPEAN TYRE name (as opposed to the ETEL name). Potentially, the Complainant's best point, in this regard, is that the dominant part of the company name is the first two words, EUROPEAN TYRE, with the third and fourth words being descriptive. However, there does not appear to be any evidence to support that interpretation. For example, on the many invoices provided, it is invariably the entire company name which appears, not just the words European Tyre.
- 6.11 Ironically, the only evidence of use of the EUROPEAN TYRE name is by the Respondent on the First Website. It is the Respondent who uses the EUROPEAN TYRE name and makes the link with the Complainant by also referring to ETEL.
- 6.12 The Complainant has therefore failed to demonstrate, on the balance of probabilities, that it has Rights in the EUROPEAN TYRE name.
- 6.13 However, a further point arises, namely whether (notwithstanding that it does not form any part of the Complainant's submissions) the Complainant might have Rights in the company name, European Tyre Enterprises Limited, which – while not identical – would be sufficiently similar to the Domain Name for the purposes of paragraph 2.1.1 of the Policy.
- 6.14 As mentioned at 6.9 above, the evidence provided by the Complainant demonstrates that it trades through its group companies in purchasing tyres for onward sale to the public through its retail brands. Whether a business can acquire trading goodwill in a name solely by virtue of its purchasing activities, and where that name is invisible to the wider public (in this case, because it trades through its retail brands), is not a straightforward issue.
- 6.15 The question is considered by Professor Wadlow in *The Law of Passing-Off* where he expresses the view that:
- "The goodwill of a business does not only exist in relation to the sale of goods or the provision of services to the consuming public ... Several cases acknowledge that a business may have goodwill in its capacity as a purchaser"*¹.
- 6.16 In support of that proposition, the author cites two English cases, the 1919 decision in *Pullman (R&J) Limited v Pullman*² and a more recent Court of Appeal decision in *Chelsea Man Menswear v Chelsea Girl*³, and two Hong Kong cases, *Penney v Penney's*⁴ and *Penney v Punjabi Nick*⁵.
- 6.17 Professor Wadlow makes a similar point⁶ where he cites a 1982 decision⁷ as authority for the proposition that "*A trader may have goodwill with respect to his suppliers and others with whom he does business, although they are not his customers*".

¹ Wadlow: *The Law of Passing-Off* 4th edition, 3-076

² (1919) 36 RPC 240

³ [1987] RPC 189, CA

⁴ [1979] FSR 29

⁵ [1979] FSR 26

⁶ *Ibid.*, 5-131

⁷ *Home Office Box Inc v Channel 5 Home Box Office Limited* [1982] FSR 449

6.18 Accordingly, and not on the basis of any case or argument advanced by the Complainant in its submissions, on the balance of probabilities the Complainant has Rights (as defined in the Policy) in respect of the European Tyre Enterprise Limited name, which is similar to the Domain Name, and the Complaint therefore satisfies paragraph 2.1.1 of the Policy.

Abusive Registration

6.19 The Complainant puts its case on Abusive Registration primarily on the following bases:

6.19.1 provision of false contact details to Nominet (Policy, 5.1.4);

6.19.2 registration primarily for the purpose of unfairly disrupting the Complainant's business (Policy, 5.1.1.3); and/or

6.19.3 use causing confusion or likelihood thereof (Policy, 5.1.2).

6.20 Paragraph 5.1.4 of the Policy provides that a domain name may be an Abusive Registration where it is independently verified that the Respondent has provided false contact details to Nominet.

6.21 The Complainant's case in this regard rests on the fact that the Respondent posted the Complainant's address and contact details on the First Website. However, that is not the same as providing false contact details to Nominet. Paragraph 5.1.4 is intended to cover the situation where, at the time of registration of a domain name, the registrant provides false contact details to Nominet.

6.22 In this case, the Respondent has evidently provided contact details to Nominet. However, the Complainant does not even suggest, let alone evidence, that those details were false. Accordingly, the Complaint fails on this ground.

6.23 Paragraph 5.1.1.3 of the Policy includes, as a factor which may be evidence that a domain name is an Abusive Registration, circumstances indicating that the Respondent has registered the domain name primarily for the purpose of unfairly disrupting the Complainant's business.

6.24 The Complainant submits that the fact of the Respondent's reference on the First Website to the Complainant's company name, registered office and company number "unfairly disrupts the business of the Complainant, which is a ground outlined in paragraph 5.1.1.3 of DRS Policy indicating that the registration is abusive". Alternatively, the Complainant asserts that the Respondent was "aware of the Complainant's global business and through the disputed domain name, intended to unlawfully make use of the goodwill associated with the EUROPEAN TYRE brand by registering the disputed domain name for the purpose of unfairly disrupting the business of the Complainant's Rights". The Complainant's case appears to be, though it is not clearly pleaded as such, that the Respondent's use of its company name, address, etc. in its website demonstrates that the Respondent must have been aware of the Complainant's Rights in the EUROPEAN TYRE name, and that therefore, it is to be inferred, must have registered the Domain Name for the purpose of unfairly disrupting the Complainant's business.

6.25 However, paragraph 5.1.1.3 requires the Complainant to prove that any such unfair disruption was the Respondent's primary purpose at the time of registration (or other acquisition) of the domain name in question. In the present circumstances, it is unclear what was the Respondent's primary purpose in registering the Domain Name and there is no evidence that the Respondent's activities have in fact disrupted the Complainant's business. Accordingly, the Expert is doubtful that this ground is made out, although ultimately the point does not matter, given the further findings below.

- 6.26 Paragraph 5.1.2 of the Policy includes, as a factor which may be evidence that a domain name is an Abusive Registration, circumstances indicating that the Respondent is using the Domain Name in a way which is confusing 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.
- 6.27 The Complainant puts its case in this regard in a number of different ways, but it essentially boils down to a submission that the Respondent was misleading internet users into thinking that the First Website was the Complainant's website in order to sell counterfeit products and services, and that through the Second Website, he is now obtaining a financial benefit from pay-per-click advertising by trading on the Complainant's reputation and/or confusing internet users by using the EUROPEAN TYRE name in the Domain Name.
- 6.28 In the absence of any response, the Respondent does not challenge either of those assertions. However, no evidence is provided by the Complainant that the Respondent was, in fact, selling counterfeit products from the First Website, e.g. by way of a trap purchase. The Complainant has therefore failed to demonstrate such conduct on the part of the Respondent.
- 6.29 It is nonetheless clear from the printouts of the First Website provided by the Complainant that, for reasons which, in the absence of any evidence, remain unclear, the Respondent was masquerading as the Complainant, not only by using the Domain Name, which is similar to the Complainant's company name (in which it has Rights – see above), but also by using on the website the Complainant's company name, registered company number and registered office address. Overall, the First Website masquerades as being a website operated by the Complainant. Why the Respondent has done this and what his ultimate objective was remain unclear. However it is, in the absence of any credible (or any) explanation from the Respondent, very difficult to think of any legitimate explanation for this impersonation.
- 6.30 Further, the factors which may be evidence of Abusive Registration, as set out in section 5 of the Policy, are non-exhaustive. Ultimately, in this regard, the question is whether the Domain Name was registered or used in a way which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. The use of the Complainant's name to set up, first, a website on which the Respondent masqueraded as the Complainant, albeit for reasons which are unclear, and subsequently to generate pay-per-click advertising takes unfair advantage of the Complainant's Rights in its company name.
- 6.31 Moreover, the Respondent has failed to respond to the Complaint at all, let alone to prove any legitimate use of the Domain Name (in the sense of it not being an Abusive Registration under the Policy).
- 6.32 The Complainant has therefore, on the balance of probabilities, demonstrated Abusive Registration pursuant to paragraph 2.1.2 of the Policy.

7 Decision

- 7.1 The Expert accordingly finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name, and that the Domain Name is, in the hands of the Respondent, an Abusive Registration.

7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

David Engel

Signed

Dated 14 January 2020