

DISPUTE RESOLUTION SERVICE

D00012073

Decision of Independent Expert

Aga Rangemaster Ltd

and

Keith M Palmer t/a Keith M Palmer & Co

1. The Parties:

Complainant: Aga Rangemaster Ltd
Address: June Drive
Leamington Spa
Warwickshire
CV31 3RG
Country: United Kingdom

Respondent: Keith M Palmer t/a Keith M Palmer & Co
Address: 5 Heron Road
Leighton Buzzard
Bedfordshire
LU7 4BY
Country: United Kingdom

2. The Domain Names:

aga-rayburn-service.co.uk ("Domain Name")

3. Procedural History:

12 November 2012	Dispute received
15 November 2012	Complaint validated
15 November 2012	Notification of complaint sent to parties
28 November 2012	Response received
28 November 2012	Notification of response sent to parties
3 December 2012	Reply reminder sent

6 December 2012	No reply received
6 December 2012	Mediator appointed
12 December 2012	Mediation started
18 February 2013	Mediation failed
18 February 2013	Close of mediation documents sent
28 February 2013	Complainant full fee reminder sent
4 March 2013	Expert decision payment received
14 March 2013	Steve Ormand appointed as Expert

I am satisfied that Nominet has notified the Respondent at all stages of the complaint in accordance with §2a of the Procedure.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the "Policy") and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the "Procedure") unless the context or use indicates otherwise.

4. Factual Background

The Complainant is a subsidiary company of AGA Rangemaster Group plc. AGA Rangemaster Group Plc was incorporated on 5 July 1939 and was previously known as Glynwed International plc and AGA Foodservice Group plc.

The Complainant was incorporated on 8 July 1999. Prior to this it traded as AGA Consumer Products Ltd, Glynwed Consumer Products Ltd and Glynwed Consumer & Construction Products Limited (Company No 48208 incorporated on 5 June 1986). Before this date it was part of Aga Heat Limited (284063) and Allied Ironfounders Ltd (00238107).

The Complainant manufactures range cookers including brands such as AGA, Rangemaster and Rayburn.

The Respondent offers repair and installation services for Aga cookers and was a member of the Rayburn Guild (operated by the Complainant) from April 2004 until he resigned in October 2012.

The Respondent registered the Domain Name on 11 January 2007.

5. Parties' Contentions

The Complaint

The Complainant contends that it has Rights in the names 'AGA' and 'RAYBURN', and that the Domain Name is similar to these terms, because:

1. It has been manufacturing cookers in the UK under the AGA brand since 1929 and under the Rayburn brand since 1946.
2. Company revenue on the 31.12.2011 was £250.9 million: UK sales were £157.7 million; North America £29.5 million; Europe £57.5 and the rest of the world £6.0 million.¹
3. The Complainant holds a dominant UK position in the manufacturer of premium brand range cookers. AGA and Rayburn cast iron cooker products are sold via its own retail

¹ The Complainant presented no evidence to support these figures.

shops and its own authorised dealers and distributors. Rangemaster and other conventional cooker brands are sold via large electrical multiples, design centres and specialist kitchen appliances retailers.²

4. The Domain Name is identical or similar to a domain name the Complainant has registered: www.aga-rayburn-services.co.uk.³
5. The Domain Name is identical or similar to the following trademarks⁴:
 - a. Rayburn – UK registered trade mark no 749282 in Class 11 registered from 31 December 1950 to 21 December 2014;
 - b. Rayburn – UK registered trade mark no 680576 in Classes 11 and 19 from 28 June 1949 to 29 June 2018;
 - c. Rayburn – UK registered trade mark no 1485216 in Class 21 from 5 February 1993 to 10 December 2018;
 - d. Rayburn Masterchef – UK registered trade mark no 2140084 in Class 11 from 14 August 1998 to 25 July 2017;
 - e. Rayburn Regent – UK registered trade mark no 812010 in Classes 9 and 11 from 14 October 1960 to 14 October 2015;
 - f. Rayburn Royal – UK registered trade mark no 812012 in Classes 9 and 11 from 14 October 1960 to 14 October 2015.
6. The Domain also includes information and images of the AGA brand which is identical or similar to the Complainant's trademarks⁵:
 - a. AGA – UK registered trade mark number 2425089, in classes 3, 6, 7, 8, 9, 11, 14, 16, 18, 19, 21, 25, 35 and 37;
 - b. AGA – UK registered trade mark number 1137735, in class 11;
 - c. AGA – UK registered trade mark number 568654, in class 11;
 - d. AGA- UK registered trade mark number 523495, for the AGA word mark, in class 11;
 - e. AGA – UK registered trade mark number 567600, for the AGA logo, in class 11;
 - f. AGA - UK registered trade mark number 543075, for the AGA word mark, in class 11, 14 and 21.
7. The Complainant's main websites are⁶:
 - a. www.rayburn-web.co.uk;
 - b. www.rayburn-web.com;
 - c. www.rayburnonline.co.uk;
 - d. www.agarayburn.co.uk;
 - e. www.agarayburn.com;
 - f. www.agaliving.com;
 - g. www.agashop.co.uk;

² The Complainant presented no evidence to support this claim.

³ The Complainant presented no evidence of this domain name and a WHOIS search produced no results.

⁴ The Complainant presented evidence that these trademarks are registered to the Complainant's parent company and almost all predate the registration of the Domain Name by more than 50 years.

⁵ The Complainant presented evidence that these trademarks are registered to the Complainant's parent company and almost all predate the registration of the Domain Name by more than 70 years.

⁶ The Complainant presented no evidence of these websites.

- h. www.agaweb.co.uk;
 - i. www.aga-web.co.uk; and
 - j. www.agacookshop.co.uk,
- amongst others.
8. The Complainant has been using the trade mark since 1946 and the longest consistent trade mark registration is the Rayburn UK registered trade mark no 680576 in Classes 11 and 19 from 28 June 1949 to 28 June 2018. The Complainant's AGA trade mark, number 523495, has been in use since 1931.
 9. The Complainant's assets have always been part of a limited company and would have been transferred by a formal divisionalisation agreement which would have transferred the assets and liabilities including goodwill from one company to the next on each occasion when the business has transferred.⁷
 10. The Complainant's trade mark rights in Rayburn have existed concurrently from 1949 to date. All of its domain name registrations pre-existed the Domain Name which was registered on [25 March 2009]⁸. Trade mark rights relating to AGA have also existed concurrently from the earlier date of 1931. The Complainant has several domain names, one of which, www.agaliving.com, has been registered since 23rd February 2000.
 11. The Domain Name is identical or similar to the Complainant's AGA and Rayburn trading names and its principal product is cast iron range cookers. The Complainant sells cast iron range cookers and stoves under the Rayburn and AGA brand/trade mark and full details can be found at: www.rayburn-web.co.uk and www.agaliving.com.
 12. The Complainant uses both trade marks on all respective products, cookers, cookware and other related kitchen appliances.
 13. AGA and Rayburn are two of the most aspirational kitchen appliances and some describe it as a 'dream possession'.
 14. The Rayburn and AGA name are both used in cookery books, marketing brochures and advertising in home living magazines. This year the Complainant has also done online PPC (pay per click) campaigns and adhoc adverts (Farmers weekly, Oil Installer, Wood burning, online eshots from Period Living and Homebuilding & Renovating to their databases) and has advertised at country shows.⁹

The Complainant contends that the Respondent's registration and/or use of the Domain Names are Abusive Registrations because:

1. The Respondent was previously a member of the Rayburn Guild having been admitted in April 2004. On acceptance of membership the Respondent signed a Rayburn Guild agreement¹⁰. This agreement includes a clause which prohibits use of the Aga or Rayburn name or any trade mark of the Complainant without the Complainant's prior approval. The Respondent registered the Domain Name on 11 January 2007 and at the time of registration would have been fully aware that he was not permitted to use the name Aga or Rayburn with a domain name. The Complainant confirms that no permission was sought by the Respondent with regard to the Domain Name.
2. As a result of this dispute the Respondent resigned from the Guild on 15 October 2012. The Complainant cannot provide written evidence of this because it occurred during a

⁷ The Complainant presented no evidence of transferred rights.

⁸ The Complainant is presumed to be referring to the registration of the Domain Name on 11 January 2007.

⁹ The Complainant presented no evidence of advertising.

¹⁰ A copy of the agreement has been provided.

telephone conversation between the Respondent and the Complainant's David Griffiths but a copy of an email from David Griffiths explaining the circumstances is provided. The Complainant no longer has any ties with the Respondent.

3. The Complainant's domain name watching service highlighted the Domain Name to the Complainant. On investigation, the use of the Complainant's registered and unregistered trademarks, copyright images, trading style amongst other things were a cause for concern.
4. The Respondent is the registrant and designer of the website for the company Keith M Palmer & Co, of which the Respondent is also the owner. The Respondent offers repair and installation services for Aga cookers, which are identical or similar to the Complainant's.
5. The Complainant first contacted the Respondent in January of 2011 between the Complainant's David Griffiths and Richard Eagleton and the Respondent. David Griffiths and Amanda Mitchell then contacted the Respondent again in October 2012. Subsequent communication included email, letters and telephone calls. The Respondent became rather irate and refused to cooperate over the telephone, instead he demanded letters stating the laws he had broken. This was followed by further telephone calls. It was explained to the Respondent that if the dispute could not be settled amicably the Complainant would look to use a DRS if appropriate.
6. There was previous communication between Aga Rangemaster Group Plc and the Respondent in 2011. The employees that were in contact with the Respondent are no longer employed by Aga Rangemaster Ltd. However, all copies of their emails have been included with the Complaint.
7. The 2011 communication shows that the Complainant has approached the Respondent with regard to the Domain Name. However, the Respondent refused to transfer the Domain Name on the basis that he was selling his business. The Complainant did not and has never confirmed that use of the Aga and Rayburn names within the Domain Name was acceptable. Due to other work commitments in 2011 the Complainant did not pursue the matter further at that time. Instead it was communicated to the Respondent that the Complainant reserved the right to pursue this matter with the suggested new owners.
8. It was only in July 2012 that Aga Rangemaster adopted a zero tolerance policy in relation to infringement of IP rights and consequently it reviewed all of its Rayburn Guild members and other approved dealers and distributors to ensure they were complying with its rights.
9. The content of the Respondent's website also infringed the Complainant's IP rights, and the Respondent willingly agreed to change the content in accordance with the Complainant's requests. This suggests the Respondent is aware that he should not have used the words Aga or Rayburn in the Domain Name, in addition to the other issues the Complainant highlighted in respect of his website.
10. On several occasions the Respondent has suggested that the Complainant purchase the Domain Name from him for a sum of money. However, he did not specify the sum and he kept contradicting and retracting this offer, explaining that he would not make this process easy.
11. The Domain Name been registered with the primary purpose of stopping the Complainant from using it since it clearly infringes the Complainant's intellectual property rights in terms of trading names, trademarks, copyright and it passing off. It would and has confused members of the public from believing that they were dealing with the Complainant rather than the Respondent and that the website is operated by the Complainant.¹¹.

¹¹ No evidence is presented of actual confusion.

The Response

The Respondent contends that its registration and/or use of the Domain Name is not an Abusive Registration because of the following chronological events and facts:

1. 2001: Aga invite the Respondent to join the Rayburn Guild. He does and as a result Rayburn work and indeed some Aga work is passed to him.
2. 2001 – 2007: Despite advertising in Yellow Pages and a town and country magazine work slowly dwindles. To counteract this the Respondent approached a website designer for help who provides him with a website and IP address for a fee. To encourage visits to this site the designer suggests that he uses Google Adwords for this purpose. The Respondent enrolled with Adwords and after spending hundreds of pounds attained this coveted front page. Up to this point all of this happened with the full knowledge of Aga Rayburn as the Respondent phoned for the Complainant's approval at the time.
3. 2011: Around May/June of this year the Complainant sent an email expressing its disapproval of some wording and use of the AGA logo within the Respondent's website. The Complainant also insisted that he stopped using the IP address. The Respondent complied completely with the former but refused with regard to the latter. All seemed to settle down and no further complaints were made.
4. 2012: A few weeks ago the Complainant sent an email requesting further changes to the website with regard to certain phrases and wished the Respondent to ensure that the website stated very clearly that he was in no way associated with the Complainant. The Complainant also insisted that the Respondent pass his IP address to the Complainant without delay. Again the Respondent complied with the former and ignored the latter. The Complainant has since thanked the Respondent by email for compliance with the website but obviously are still not happy with the IP address.
5. As a 59 year old 'one man band' there is a limited amount of work that the Respondent can do but this website does provide enough interest for him to maintain his current levels of work to provide for his future. There are plenty of domain names for sale that use the words 'Aga' and 'Rayburn' and cost as little as a couple of pounds so the Respondent cannot see where his domain address has any value.
6. The words Aga and Rayburn are generic and it is the only way the Respondent can describe what he does for a living.
7. It seems strange to the Respondent that the Complainant can whole heartedly approve of him and in the next instance wish to disassociate itself in an unfriendly and cold manner with no regard to the consequences to the Respondent. He has been very loyal to the Complainant's cause over the years and has held the Complainant in the highest regard. Sadly this is no longer the case. The aggressive emails surely can be construed as intimidating and designed to unsettle the Respondent and his wife who rely on his income to support themselves as they go towards retirement.
8. There is no evidence in writing to support the Respondent's statement as everything was agreed over the telephone with the Complainant in a friendly manner. He assumed that was all that was required.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

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

Complainant's Rights

Rights is defined in §1 of the Policy as rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

The wholly generic suffix “.co.uk” is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

I am satisfied on the papers before me that AGA Rangemaster Group PLC has registered and unregistered rights in the names and marks AGA and RAYBURN which pre-date the registration of the Domain Name by more than 70 and 60 years respectively.

The Complainant asserts that it has rights to use these marks by way of divisionalisation agreements as it is a wholly owned subsidiary of AGA Rangemaster Group PLC, but has presented no evidence in support of this assertion. In the appeal decision in DRS 00248 (Seiko-shop.co.uk) the panel said that if the Complainant can demonstrate that it is a subsidiary or associated company of the registered proprietor of the rights then a licence, if asserted, will ordinarily be assumed.

I am satisfied on the basis of the company information provided, and a simple check of that information by way of the Companies House online webcheck, that the Complainant is operating and trading as AGA Rangemaster Limited and that it is an associated company of AGA Rangemaster Group PLC. Accordingly, I accept that the Complainant has a licence to use the marks AGA and RAYBURN from the registered proprietor.

The marks AGA and RAYBURN are the distinctive part of the Domain Name. I am satisfied that the addition of “service” does not detract from the dominance and distinctiveness of the marks AGA and RAYBURN and further that the addition of “service” adds to the expectations of visitors to the website that they can expect to find servicing of products carrying those marks.

Accordingly, I find that the Complainant has Rights in names and marks which are similar to the Domain Name.

Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

1. *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*

2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3 of the Policy.

The Respondent says that he registered the Domain Name with the knowledge of the Complainant and has operated it as a member of the Rayburn Guild for the purposes of servicing the Complainant's products. The Respondent believes that the words Aga and Rayburn are generic and that using those words is the only way that the Respondent can describe what he does for a living.

There is a degree of legitimacy to the first part of the Respondent's statement: he is in the business of servicing Aga cookers and Rayburn cookers and, for a number of years, he was undertaking that business as a member of the Rayburn Guild under (or partly under) an agreement with the Complainant which set out the rules of undertaking such servicing when passed to him by the Complainant. When that agreement failed to provide sufficient servicing leads for his business to survive he decided to register the Domain Name as an independent means of generating business. The Domain Name does describe his business.

However, the Respondent's claim that the words Aga and Rayburn are generic is incorrect. They are registered trade marks belonging to the Complainant's parent company.

In the appeal decision in DRS 00248 (Seiko-shop.co.uk) the panel said that the use of a trade mark for a domain name without the consent of the trade mark owner for the selling of genuine products could make the false representation that there was something official or approved about the website which in turn could constitute unfair advantage being taken of rights in the mark by using that domain name.

The DRS Expert Overview states at section 3.3:

"Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix) the activities of typosquatters are generally condemned ... as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity."

What if the Respondent's claim that the use of the Complainant's trade marks and the word service in the Domain Name is the only way that he can describe his business? The appeal panel in DRS 07991(Toshiba-laptop-battery.co.uk) said that:

"EU and UK law does not entitle a trade mark proprietor to prohibit a third party from using the trade mark in the course of trade where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts, provided he uses them in accordance with honest practices in industrial or commercial matters."

Furthermore,

"In the case of BMW –v- Deenik [C-63/97] the European Court of Justice considered whether the operator of a garage, which was unauthorised by BMW but specialised in BMW sales and repairs, was entitled to use the trade mark BMW in advertisements to describe the goods and services being offered. The Court decided that it was legitimate to use the mark to identify the source of the goods in respect of which the services were being offered, provided the independent operator did not take unfair advantage of the

distinctive character or repute of the mark. Such unfair advantage would arise, in particular, where a mark was used in such a way that falsely create an impression of a commercial connection or affiliation with the trade mark owner.”

and,

“In the case of L’Oréal –v- Bellure [C-487/07] it held that the concept of taking unfair advantage ‘does not require that there be a likelihood of confusion .. the advantage arising from the use by that third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark”

In DRS 03027 (epson-inkjet-cartidge.co.uk and 13 others) the appeal panel, referring to BMW –v- Deenik, concluded that a helpful secondary question was whether the use of the domain name created the false impression of a commercial connection between the parties. The panel considered that there was no absolute rule but that confusion may arise, irrespective of the content of the respondent’s website, merely as a result of the adoption of a domain name incorporating the complainant’s mark and that this “initial interest confusion” is admissible in DRS cases.

The Complaint claims that the Domain Name has been registered with the primary purpose of preventing the Complainant from using the Domain Name and that its use by the Respondent would and has confused visitors to the website into believing that they are dealing with Complainant.

The Complainant presents no evidence of actual confusion. The Complainant’s written directions to the Respondent, to make changes to this website in respect of the use of the marks and to make it clear that he was independent of the Complainant, suggests that the Complainant was aware that confusion was possible. The Respondent has complied with the Complainant’s requirements in this respect, but has refused to transfer the Domain Name.

Thus, the only remaining possibility of confusion is initial interest confusion which would arise because visitors are led to believe that the website is operated or authorised or otherwise connected with the Complainant. Initial interest confusion could arise where a user types in “aga servicing” or “rayburn servicing” and is presented with a list of results including the Respondent’s website.

I am satisfied that a speculative visitor to the Respondent’s website would visit in the expectation that it is an offering for servicing of Aga or Rayburn cookers and that this will be provided by the Complainant. On entering the website it is immediately apparent that servicing will be provided by an independent company and that the Domain Name is not connected to the Complainant. Nevertheless, this is initial interest confusion and the visitor has been deceived by the Domain Name.

I am also satisfied that the Respondent registered the Domain Name for the purposes of providing servicing of Aga and Rayburn cookers and chose the Domain Name because it describes that business. In doing so he has ridden “on the coat-tails” of registered trade marks which are distinctive and have long standing reputations.

The question then is whether the Respondent had a commercial connection with the Complainant and/or had authority to use the marks in the Domain Name.

The Respondent had a relationship with AGA Consumer Products Limited in the form of the Rayburn Guild agreement which was established before the registration of the Domain Name. Under this agreement the Complainant could pass Aga cooker and Rayburn cooker servicing work to the Respondent who would undertake such servicing within the framework of Guild membership and in accordance with the stipulations in the Guild agreement.

Under this agreement, the Respondent was required to comply with certain standards including, amongst other things, rules of advertising. The membership agreement states that the member “cannot use the Aga and/or Rayburn brand names or any trademarks of [the Complainant] without prior written approval of the [Complainant]”.

The Respondent says he had approval to use the marks in the Domain Name but that this was verbal. The Respondent’s website states that he is an independent Aga Rayburn servicing engineer but that he has the backing and technical support of the Complainant.

The Complainant denies that any permission was given but has not provided any evidence to this effect.

The length of time between the registration of the Domain Name in 2007 and the Complainant’s first communication requiring the Respondent to amend the content of the website and release the Domain Name to the Complainant in 2011 might suggest that the Respondent registered the Domain Name with the Complainant’s approval. A later hardening of the Complainant’s rules for the use of its marks prompted the communications in 2011 and 2012 and resulted in this dispute.

Conversely, the Complainant’s “cease and desist” letter dated 11 October 2011 states that “it has come to our attention that you are running a business for the service and repair of Aga cookers and Rayburn cookers using the name Keith M Palmer & Co [through the Domain Name].” This would be consistent with the Complainant’s position that it did not give permission for the use of its marks in the Domain Name and had discovered the Respondent’s use of the Domain Name in 2011.

On the parties submissions, and the fact that the Respondent says he has no written record, I am unable to make a decision on the balance of probabilities as to whether or not the Respondent had permission to use the Complainant’s marks in the Domain Name.

Whether or not the Respondent had approval in 2007 to use the marks in the Domain Name pursuant to the Guild agreement, the Complainant is entitled to withdraw any such permission and require the Respondent to comply with its requirements for the use of its marks. The evidence submitted by the Complainant indicates a change in the Complainant’s policy in respect of tighter protection of its intellectual property. The contractual issues arising from such a withdrawal, and the resolution of those issues, is not a concern of the DRS.

The Respondent’s resignation from Guild membership before the commencement of this Complaint is evidenced by an internal email provided by the Complainant. This action has brought about an end to the Guild agreement and with it any permission that may have existed under the terms of that agreement for the Respondent to use the Complainant’s marks.

Accordingly I find that the Respondent’s use of the Domain Name, at least since the Respondent’s resignation from the Rayburn Guild if not since the date of registration of the Domain Name, has caused initial interest confusion, which is an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name (aga-rayburn-service.co.uk) be transferred to the Complainant.

Signed: Steve Ormand

Dated: 2nd April 2013