

DISPUTE RESOLUTION SERVICE

D00012129

Decision of Independent Expert

Doosan International Luxembourg SARL

and

Alistair Thomson

1. The Parties:

Lead Complainant: Doosan International Luxembourg SARL
21 Rue Glesener, L-1631 Luxembourg.
Luxembourg
LU
Luxembourg

Respondent: Alistair Thomson
Middle Balado
Kinross
Tayside
KY13 0NH
United Kingdom

2. The Domain Name(s):

bobcat-scotland.co.uk (the “Disputed Domain”)

3. Procedural History:

08 November 2012 15:46 Dispute received
09 November 2012 11:42 Complaint validated
09 November 2012 12:07 Notification of complaint sent to parties
28 November 2012 01:30 Response reminder sent
30 November 2012 10:21 Response received

30 November 2012 10:22 Notification of response sent to parties
03 December 2012 14:57 Reply received
03 December 2012 15:01 Notification of reply sent to parties
03 December 2012 15:01 Mediator appointed
05 December 2012 11:09 Mediation started
05 December 2012 11:10 Mediation failed
05 December 2012 11:15 Close of mediation documents sent
17 December 2012 01:30 Complainant full fee reminder sent
17 December 2012 10:19 Expert decision payment received
18 December 2012 Michael Silverleaf appointed as expert

4. Factual Background

4.1 There is little or no factual dispute in this case. The summary of the facts which follows is taken from the parties' submissions. I indicate below any points where I have interpolated or there appears to be a difference of view between them.

4.2 The Complainant is a member of a group of companies with wide-ranging interests in the field of construction and elsewhere. One of its businesses is the manufacture and sale of construction equipment under the well-known trade mark BOBCAT. Doosan Benelux SA (which I presume is a sister company of the Complainant) is the EMEA HQ and European distributor of the BOBCAT construction equipment business. Another sister company, Clark Engineering Company, owns European and UK trade mark registrations for the mark BOBCAT in a variety of classes covering construction equipment and vehicles. These include Community registration 28371 in classes 7, 8 and 12 and UK registrations numbers 1427389 in class 7 and 1192693 in class 12. All these marks have been registered for many years and it appears that the BOBCAT name has been used on construction equipment for very many years before that.

4.3 George Colliar Limited was from 1 January 2010 an official distributor of BOBCAT equipment under the terms of a distribution agreement I have not seen. On 29 September 2010 Doosan Benelux served notice of termination of the distribution agreement on George Colliar Limited with effect from 1 January 2011. The notice also made clear that Doosan Benelux would, despite the termination, continue to honour orders for BOBCAT equipment placed by George Colliar Limited up to the end of 2011. Consequently, it seems that George Colliar

Limited continued to act as a distributor of BOBCAT equipment up to 31 December 2011.

4.4 The termination letter made clear that George Colliar Limited should cease using the Complainant's trade marks (presumably including BOBCAT) following termination. This was said to be the effect of clause 16(e) of the distribution agreement.

4.5 According to a WHOIS search, the Disputed Domain was registered in the name of the Respondent on 28 March 2008. The Respondent, Mr Alistair Thomson, works for George Colliar Limited. George Colliar Limited is a wholly-owned subsidiary of Alexander Harvey Seeds Group. Both George Colliar Limited and Alexander Harvey Seeds Group are based in Scotland. The Respondent asserts that the Disputed Domain was registered with the permission and encouragement of the Complainant. The Complainant disputes this. Neither party has provided any information or evidence to support its contentions. The Reply contains a challenge to the Respondent to produce such evidence. None has been forthcoming.

4.6 Whether or not there was active support from the Complainant for the registration of the Disputed Domain, I presume that there must have been some business connection between the parties in 2008 when the registration took place and that that relationship matured into the formal distribution agreement which was made at the beginning of 2010. If not, I cannot see why the Disputed Domain was registered or why a distribution agreement was subsequently entered into without complaint about the Disputed Domain.

4.7 Following the final termination of the distribution arrangements between the Complainant and George Colliar Limited, the Complainant wrote to George Colliar Limited on 23 February 2012 complaining that George Colliar Limited was making unlawful use of the BOBCAT trade mark and, in particular, the Community registration referred to in paragraph 4.2 above and UK trade mark registrations through the Disputed Domain. The letter was also sent by e-mail on 24 February to two individuals at George Colliar Limited. One of these, "Willie", responded on 28 February to say that the website hosted at the Disputed Domain had been cleared and asking for the identity of the company to whom the Disputed Domain should be transferred.

4.8 This was followed by a further e-mail exchange the same day leading to an e-mail from Michelle Gibson at George Colliar Limited

stating that the cost of transferring the Disputed Domain would be £25 plus VAT and asking if this was acceptable.

4.9 The following day there was another exchange of e-mails beginning with one from Doosan Benelux asking for the transfer to begin as soon as possible and offering the assistance of Doosan's service provider. The response to this was an e-mail from Michelle Gibson explaining that there had been a change of instructions from Mr Douglas Harley (the author of the response to the present complaint) and that he now wished to retain the Disputed Domain.

4.10 During the afternoon of 1 March there were further exchanges of e-mails between Michael Potter in the legal department of Doosan Benelux and Mr Douglas Harley. Mr Potter e-mailed Mr Harley to say that it had been agreed that the Disputed Domain would be transferred to Doosan Benelux on payment of the administration fees. Mr Harley responded by asking for a copy of the agreement (although the e-mail had attached to it an earlier exchange which made clear that this was previously the position), stating that domains have a value and asking for the price that Doosan Benelux would pay for the transfer. Mr Potter responded by saying that Doosan Benelux does not treat re-capturing domains which include trade marks as a purchase, asking for the administrative costs and stating that once these were established he would be able to say whether they were reasonable. Mr Harley's further response indicated that a price of £1000 would be reasonable given that George Colliar Limited had built up the IP connected with the Disputed Domain.

4.11 Mr Potter responded the following afternoon rejecting the claim that £1000 was reasonable and asking Mr Harley to explain what IP it was claimed had been built up. He indicated that the content of the Disputed Domain would be monitored for further infringement. At this point the immediate correspondence seems to have ended.

4.12 In the autumn of 2012, Doosan Benelux submitted a complaint to Nominet about the use of the Disputed Domain and mediation was entered into. This failed. Mr Potter wrote by e-mail to Mr Harley on 15 October offering him a final opportunity to negotiate a reasonable sum (lower than £1000 which had previously been rejected) to transfer the Disputed Domain failing which a formal DRS complaint would be made. Mr Harley's response, after a further chasing e-mail on 25 October was as follows: "£3000 and its yours." [sic] The present complaint followed.

4.13 The Disputed Domain appears originally to have hosted a website for George Colliar Limited. Since the complaint was made, it has changed. It now hosts a webpage for the “Bobcat Appreciation Society” of which the “founder member” is “George Colliar Limited. The page has a picture of a cat with the rubric “What is a Bobcat” beneath it. This contains a description of a bobcat. At the top left of the picture are the words “To go to the Founder member’s website click ear”. Clicking on either ear of the cat in the picture takes one to George Colliar’s homepage. On that homepage are offerings of construction equipment which is not BOBCAT branded.

5. Parties’ Contentions

5.1 The Complainant says that George Colliar Limited has continued to advertise construction equipment using the name BOBCAT in its domain name, i.e. using the Disputed Domain. The Complainant contends that the Respondent retained the Disputed Domain with the aim of attracting customers wishing to rent or purchase BOBCAT machines whilst offering alternative equipment. The Complainant says that it is concerned that potential BOBCAT customers following the link from the Disputed Domain to George Colliar’s homepage will take business from the Complainant.

5.2 The Complainant also relies upon the course of e-mail exchanges in which George Colliar Limited has repeatedly raised the price for transferring the Disputed Domain, starting at £25 and currently at £3000.

5.3 The Respondent says that the Disputed Domain was registered with the Complainant’s permission and encouragement, that the Complainant did not request that it be registered in the Complainant’s name, that the Complainant was aware of and did not complain about the Disputed Domain for several years, that the current use does not infringe any trade mark registrations or an action would have been brought and that the current George Colliar website does not mention Bobcat.

5.5 The Respondent also says that the current site is being used to create interest in a Bobcat appreciation society in Scotland (the rubric “Bobcat in Scotland???” appears to the top right of webpage). The

Respondent explains that the site depicts an image of a bobcat which is the wild animal found in North America rather than in Scotland.

5.6 The Respondent also complains that transfer of the Disputed Domain to the Complainant would be unjust as it would allow the Complainant to redirect customers who have bookmarked the site to the Complainant's new agent. The reason given for the injustice is that "the IP that has been created and associated with the [Disputed Domain] was done at our expense".

5.7 The author of the Response, Mr Harley, says that he offered to transfer the Disputed Domain at a very reasonable cost but that the Complainant refused.

5.8 Finally, the Respondent asserts that the DRS guidance offers two definitions of an Abusive Registration, neither of which applies to the present case. The assertion is not further explained. I assume that the Respondent is referring to the two subparagraphs of the definition quoted in paragraph 6.1 below and asserting that the Disputed Domain meets neither test.

6. Discussions and Findings

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008. Paragraph 1 of that policy defines an Abusive Registration as:

"a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights"

6.2 Paragraph 1 of the DRS Policy also defines "Rights" for the purposes of this procedure as including but not limited to those enforceable under English law. Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and

(b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.3 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The relevant factors for the purposes of the present case are

- “(a)i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
- A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights;
 - C. for the purpose of unfairly disrupting the Business of the Complainant;
- ii. 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 remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.4 Clause 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. These include the following which are relevant to the present case:

- “(a)i. Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS) the Respondent has:
- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
 - B. been commercially known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- ...

6.5 The first question in any DRS complaint is whether the Complainant has rights. This, as has been said in many cases, is a low threshold test and there is no doubt in the present case that the Complainant (or the group of companies which it represents) has rights in the name BOBCAT. The group has trade mark registrations and the material submitted to me evidencing long and widely recognised use of the BOBCAT name as a trade mark for construction equipment. I know that this is correct as I am myself aware of the name BOBCAT being used on such equipment from having seen it in use at construction sites over many years.

6.6 The lack of factual dispute in the present complaint means that its determination turns simply upon an application of the agreed facts to the definition of an Abusive Registration.

6.7 It is clear that when the Disputed Domain was originally registered it was not abusive. I can deduce that there was a commercial relationship between the parties and that the Disputed Domain was registered and used by George Colliar Limited (whom the Respondent clearly represents) to further that relationship. Whilst George Colliar Limited was a distributor of BOBCAT construction equipment for Doosan Benelux, the registration of the Disputed Domain by the Respondent worked to both parties' advantage.

6.8 However, once the distribution arrangement came to an end, George Colliar came under an obligation to cease using the BOBCAT trade mark and to remove that mark from all its materials. This was the effect of clause 16(e) of the distribution agreement according to the Complainant and the Respondent has not challenged that this is so.

6.9 The question, therefore, is whether the current use of the Disputed Domain is such as to take unfair advantage of or be unfairly detrimental to the Complainant's trade mark and passing off rights so as to meet the requirements of the definition in sub-paragraph (ii) of the definition of an Abusive Registration (see 6.1 above). This will necessarily be so if that use falls within the prohibition laid down by clause 16(e) of the distribution agreement or is otherwise an infringement of the trade mark rights asserted by the Complainant.

6.10 The Respondent seeks to justify its current use of the Disputed Domain by saying that it is seeking to create interest in a bobcat appreciation society in Scotland. This is despite the fact that the bobcat is an animal found in North America, not in Scotland. This claim is, as the Respondent is no doubt aware, fatuous. The fact that the webpage hosted at the Disputed Domain names George Colliar Limited as the founder member of the alleged society and tells the viewer what to do to access its homepage makes it plain that the purported bobcat appreciation society is simply a front for George Colliar Limited.

6.11 I therefore approach the present dispute on the basis that the Disputed Domain hosts a direct link to the George Colliar Limited homepage at which equipment competing with the Complainant's BOBCAT branded construction equipment is offered for sale and hire. Once that is taken into account, it is immediately apparent that the Disputed Domain is being used in a way which is likely to take unfair advantage of or be detrimental to the Complainant's rights. Any viewer of the Disputed Domain who purchases or hires equipment from George Colliar Limited when he or she was in fact looking for Bobcat branded equipment has been misdirected to the detriment of the Complainant. The fact that such a viewer arrived at George Colliar Limited's website through the Disputed Domain means that unfair advantage has been taken of the Complainant's trade mark and passing off rights. On this basis, there is also a breach of clause 16(e) and an infringement of trade mark by the use which is being made of the Disputed Domain.

6.12 It seems to me accordingly to be clear that, contrary to the Respondent's assertion, the use which is being made of the Disputed Domain by George Colliar Limited falls within the second limb of the definition of an Abusive Registration under the DRS Policy.

6.13 I am reinforced in this view by the Respondent's complaint that transfer of the Disputed Domain would be unjust because it would allow the Complainant to direct those who had bookmarked the page to its current distributor. The author of the Response appears to think that George Colliar Limited is entitled to retain such persons as its customers when it is no longer the distributor of BOBCAT equipment. What this overlooks is that prima facie those persons have bookmarked the page because they want BOBCAT equipment and not because they want to buy or hire equipment from the Respondent. The title of the Disputed Domain encapsulates the fact that BOBCAT

equipment is available in Scotland through it. Once the distributorship arrangement was terminated, that was no longer so.

6.14 The IP which the Respondent has built up is the property of the Complainant and the purpose of clause 16(e) of the distributorship agreement is to ensure that that remains the case. The Respondent is only entitled to retain customers who are its customers rather than customers for BOBCAT equipment. The Disputed Domain attracts customers for BOBCAT equipment. Accordingly, it seems to me to be clear that the Respondent's complaint of injustice has no basis.

6.15 Finally, I should mention the e-mail exchanges about the possible cost of the transfer of the Disputed Domain. It seems to me to be plain that the Respondent was seeking to ransom the Disputed Domain for an ever increasing price. Having agreed that it would be transferred for £25, the cost was peremptorily raised to £1000. When a further attempt to negotiate a fee was made, Mr Harley responded as I have noted above with a request for £3000. Whether he would actually have agreed to transfer it had that demand been acceded to cannot be readily determined. His previous conduct suggests that there is at least a distinct possibility that he would instead simply have sought more money. Such conduct is at best unendearing and does nothing to provoke sympathy in the ultimate decision-maker. I have not taken these matters into account in reaching the conclusion that the Disputed Domain is an Abusive Registration. Had I done so, they would have provided a further ground for that conclusion.

7. Decision

7.1 I find that the Disputed Domain is an Abusive Registration.

7.2 I direct that it be transferred to the Complainant.

Signed: Michael Silverleaf

Dated: 6 January 2013