

DISPUTE RESOLUTION SERVICE

DRS 07364

Decision of Independent Expert

EATON-WILLIAMS GROUP LIMITED

and

IAIN DOHERTY

1. The Parties:

Complainant: Eaton-Williams Group Limited
Address: Station Road
Edenbridge
Kent
Postcode: TN8 6EG
Country: United Kingdom

Respondent: Iain Doherty
Address: Unit 4, Orwell Close
Rainham
Essex
Postcode: RM13 8UB
Country: United Kingdom

2. The Domain Name(s):

discount-wheels.co.uk

3. Procedural History:

The Complaint was received by Nominet electronically on 12 June, 2009. Nominet checked the Complaint and validation was confirmed on 15 June, 2009. Nominet duly informed the Respondent, by both letter and by e-mail on 15 June, 2009, noting that the Dispute Resolution Service had been invoked and that the Respondent had 15 days (until 6 July, 2009) to submit a Response. No Response was received. On 7 July, 2009 Nominet confirmed that Mediation was not possible in this situation and invited the Complainant to pay the fee to obtain an Expert Decision pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy") and Paragraph 21 of the Nominet Dispute Resolution Service Procedure ("the Procedure"). The fee was duly received by Nominet on 15 July, 2009.

Nominet subsequently invited the undersigned, Keith Gymer ("the Expert"), to provide a decision on this case and, following confirmation to Nominet that the Expert knew of no reason why he could not properly accept the invitation to act in this case and 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, Nominet duly appointed the undersigned as Expert with effect from 27 July, 2009.

4. Factual Background

This Complaint is submitted by Bromhead Johnson, patent and trade mark attorneys, for Eaton-Williams Group Limited, (the "Complainant").

Eaton-Williams Group Limited is the parent company of Eaton-Williams Exports Limited, which is the registered proprietor of UK and Community Trade Mark registrations for the mark QUALITAIR (UK 1083430 dating from 1977 and CTM 191122 dating from 1996). The Group operates a business in air-conditioning units and related goods under the QUALITAIR mark (see <http://www.eaton-williams.com/qualitair/index.php>).

According to the information available from the current Nominet WHOIS record, the Domain Name, discount-wheels.co.uk, appears to have first been registered to the Respondent, Iain Doherty, as of 13 May, 2008.

5. Parties' Contentions

Complainant:

In submitting a DRS Complaint, the Complainant is asserting that:

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

In support of its case, the Complainant says:

Eaton-Williams Group Limited is the owner of Eaton-Williams Exports Limited.

Eaton-Williams Exports Limited is the proprietor of United Kingdom Trade Mark Registration No. 1,083,430 for QUALITAIR in Class 11 registered in respect of "Installations and apparatus included in Class 11, all for cooling, drying, and heating; installations and apparatus, all for refrigerating, freezing and ventilating; apparatus and appliances, all for air conditioning, fans and blowers, all included in Class 11; and parts and fittings included in Class 11 for all the aforesaid goods".

Eaton-Williams Exports Limited is also the proprietor of Community Trade Mark Registration No. 191,122 for QUALITAIR in Class 11 registered in respect of "Installations and apparatus, all for cooling, drying, and heating; installations and apparatus, all for refrigerating, freezing, ventilating and air conditioning; air purifying apparatus and air filters; fans and blowers; and parts and fittings for all the aforesaid goods".

The Community Trade Mark has been in continuous use by Eaton-Williams Group Limited and Eaton-Williams Exports since it was registered. The British Trade Mark has been in continuous use by Eaton-Williams Group Limited and Eaton-Williams Exports since it was acquired in 1993.

Eaton-Williams Group Limited's products can be seen on their web-site www.eaton-williams.com. Their QUALITAIR products can be seen on the page www.eaton-williams.com/qualitair/index.php, which are supplied throughout the United Kingdom.

Therefore, Eaton-Williams Exports Limited has the right under the 1994 Trade Marks Act and the Community Trade Marks Regulation to stop use of the mark QUALITAIR in respect of air conditioning apparatus in the United Kingdom. In light of the use made of the mark QUALITAIR by Eaton-Williams Group Limited and Eaton-Williams Exports Limited have the right [*sic*] under the laws of passing off to stop use of the mark QUALITAIR in respect of goods and services relating to air conditioning based on their

long and extensive use of the mark QUALITAIR in respect of air conditioning apparatus and services in the United Kingdom.

Eaton-Williams Group made Complaint No. D2009-0286 with regard to the domain name qualitair4u.com to ICANN. The Decision of ICANN [*a copy of which was annexed to the Complaint*], was to transfer the domain name to Eaton-Williams Group Limited.

Eaton-Williams Group Limited also made Complaint No. D00006938 to Nominet in respect of qualitair4u.co.uk. This was not resolved as the owner turned out to be a dissolved company. The domain registration was cancelled by Nominet. Eaton-Williams Group Limited have now bought the domain name qualitair4u.co.uk. Eaton-Williams Group Limited are now the owners of the domain names qualitair4u.com and qualitair4u.co.uk. The domain qualitair4u.co.uk now points at www.eaton-williams.com/qualitair/index.php.

Why is the domain name an Abusive Registration?

The domain name discount-wheels.co.uk was used to host the website of qualitair4u.co.uk and qualitair4u.com selling products which infringe the QUALITAIR trade mark of Eaton-Williams Group Limited. These pages continue to be displayed on this site. [*The Complaint cited the web address: <http://discount-wheels.co.uk/QA/index.html>*] The products shown on these pages are not products of Eaton-Williams Group Limited or products sold with their consent as can best be demonstrated by viewing the range of Eaton-William's QUALITAIR products, which mainly relate to cellar cooling.

Bromhead Johnson wrote to the entity described on the hosted website and have received no reply.

Eaton-Williams Group Limited made complaint No. D2009-0286 with regard to the domain name qualitair4u.com. The Decision of ICANN was to transfer the domain name to Eaton-Williams Group Limited as the domain registration was being used in bad faith.

When the term "QUALITAIR air conditioning" is entered on the GOOGLE search engine and pages from the UK are selected the pages hosted by discount-wheels.co.uk are found on the third page, previously they appeared on the first page. Eaton-Williams Group Limited recently gained possession of the domain name qualitair4u.co.uk and redirected the e-mail addresses shown on the pages of discount-wheels.co.uk to an email address in their control. Copies of e-mails collected thereby [*which were annexed to the Complaint*], indicate that this web page is receiving hits from potential customers of Eaton-Williams Group Limited who have been confused about the origin of the products. Eaton-Williams Group Limited therefore request transfer of the domain name as this will enable Eaton-Williams to ensure that all trade being misdirected is correctly addressed to their website.

The Complainant requests transfer of the Domain Name discount-wheels.co.uk.

Respondent:

The Respondent offered no Response to the Complaint.

6. Discussions and Findings

General

Paragraph 2 of the Policy states the relevance of the Dispute Resolution Service:

- 2 a. A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Procedure, that:
 - i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.
- b. The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.
- c. We strongly recommend that both Parties use our guidance and help information, which can be found on our web site.

Complainant's Rights

The Complainant in this case has asserted that it has rights in the name and mark QUALITAIR. It apparently considers this to be relevant because various website pages accessed under the Domain Name discount-wheels.co.uk allegedly include content which may infringe the Complainant's rights in its QUALITAIR marks.

The Complainant has plainly failed to read or understand the applicability of the Policy. The Complainant has simply not asserted or demonstrated any "Rights in respect of a name or mark ***which is identical or similar to the Domain Name***" (Expert's emphasis).

It is Rights in relation to the Domain Name, *per se*, which are required under the Policy. Rights to other unrelated names or marks which may appear in content hosted on webpages accessible using the Domain Name are irrelevant. In its DRS FAQ at <http://www.nic.uk/disputes/drs/faq/#serviceright>, Nominet advises potential Complainants to consider:

Is this the right service for me?

You should use the DRS if:

- you have rights in a name or mark similar to the domain name;
- [...];

You should not use the DRS if:

- [...];
- [...];

- you want to object to the content of a website hosted under that domain name, rather than the domain name itself (see our section on objecting to website content);
- [...];

It is unfortunate that the Complainant seems to have overlooked these helpful FAQ.

The Expert therefore finds that the Complainant has no relevant Rights in respect of a name or mark, which is identical or similar to the Domain Name actually at issue, discount-wheels.co.uk, pursuant to Paragraph 2.a.i of the Policy, and the Complaint must necessarily fail under Paragraph 2.b of the Policy for this reason.

Abusive Registration

The Complainant also has to show that the Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines “Abusive Registration” as a Domain Name which either:

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

has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

Although the evidence submitted with the Complaint suggests that the Complainant may have valid trade mark rights in QUALITAIR, which may be infringed by the content accessible via the Domain Name discount-wheels.co.uk, even if this were proven, it would be of no relevance to, or assistance in this DRS Complaint - infringement by virtue of content alone is a matter for the Court, not for the DRS.

Consequently, since the Complainant has no relevant Rights as required under Paragraph 2.a.i of the Policy, and the Complaint therefore fails to meet the condition specified under Paragraph 2.b, in this case, the Expert needs to make no determination as to whether the Domain Name would otherwise have been considered an Abusive Registration.

7. Decision

Having concluded that the Complainant has no Rights in respect of a name or mark, which is similar to the Domain Name, the Expert rejects the Complaint and orders that no action be taken with respect to the Domain Name, discount-wheels.co.uk,

Signed Keith Gymer

Dated: 4 August, 2009

