

## DISPUTE RESOLUTION SERVICE

D00015299

Decision of Independent Expert

FANUC Corporation

and

Steve Johnson

### 1. The Parties:

Lead Complainant: FANUC Corporation  
Oshino-mura  
Yamanashi Prefecture 401-0597  
Japan

Complainant: FANUC UK Limited  
Seven Stars Industrial Estate  
Quinn Close Off Wheler Road  
Coventry  
Warwickshire  
CV3 4LB  
United Kingdom

Respondent: Mr Steve Johnson  
49 Carters Lane  
Halesowen  
Birmingham  
West Mids  
B62 0DA  
United Kingdom

### 2. The Domain Name(s):

fanuc-cnc-lathe-repair.co.uk  
fanuc-cnc.co.uk

### **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 that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

08 January 2015 11:41 Dispute received  
08 January 2015 13:38 Complaint validated  
08 January 2015 13:52 Notification of complaint sent to parties  
12 January 2015 14:04 Response received  
12 January 2015 14:10 Notification of response sent to parties  
15 January 2015 01:30 Reply reminder sent  
16 January 2015 13:19 Reply received  
16 January 2015 13:20 Notification of reply sent to parties  
16 January 2015 13:20 Mediator appointed  
21 January 2015 10:46 Mediation started  
24 February 2015 17:09 Mediation failed  
24 February 2015 17:10 Close of mediation documents sent  
26 February 2015 11:41 Expert decision payment received

### **4. Factual Background**

The Complainants are part of an international group of companies which provides automation products and services such as robotics and computer numerical control systems.

The Lead Complainant, a Japanese company, was incorporated in 1972 and since then it, and its group companies, have supplied their automation systems in Japan and worldwide under the name FANUC and related names with group sales amounting to 489,000 million yen (approximately £2,806 million) in 2012 and 450,000 million yen (approximately £2,582 million) in 2013.

The Lead Complainant's main website is at <[www.fanuc.co.jp](http://www.fanuc.co.jp)> to which the domain name <[fanuc.com](http://fanuc.com)> also redirects.

The Lead Complainant owns the following portfolio of trade mark registrations enforceable in the United Kingdom for the word FANUC, details of which have been submitted in an annex to the Complaint:

- UK trade mark number 910676 registered as of 13 June 1967 - word mark for FANUC in class 9.
- UK trade mark number 1182663 registered as of 1 October 1982 - word mark for FANUC in class 7.
- UK trade mark 2337783 registered as of 15 July 2003 - word mark for FANUC in classes 7 and 9.
- International trade mark no. 948323 designating the EU registered on 11 June 2007 - word mark for FANUC in classes 7, 9, 37 and 42.

The Second Complainant, a United Kingdom company, has traded in the United Kingdom using the names “FANUC” and “FANUC Robotics” since 1982. It is currently the main entity within the Complainants’ group trading in the United Kingdom, with an annual turnover of approximately £15.5 million in 2012 and £20 million in 2013.

The Second Complainant maintains a website at <www.fanucrobotics.co.uk> for its business offering servicing / repairs and spare parts for its robotics systems. The disputed domain name <fanuc-cnc-lathe-repair.co.uk> was registered on 6 November 2008.

The disputed domain name <fanuc-cnc.co.uk> was registered on 12 November 2008.

## **5. Parties’ Contentions**

### **Complaint**

The Complainants submit that their group of companies is one of the largest makers of industrial robots in the world. Its customers include manufacturers of cars and electronics.

The Complainants rely on the above-listed registered trade marks and their common law rights in the substantial reputation and goodwill in the FANUC trade mark acquired by their extensive trading and marketing activities as described above.

The Complainants submit that the name FANUC is a coined term derived from “Factory automation numerical control”.

The Complainants argue that both of the disputed domain names <fanuc-cnc-lathe-repair.co.uk> and <fanuc-cnc.co.uk> are similar to the Complainants’ FANUC trade mark, disregarding the domain suffix. The domain name <fanuc-cnc.co.uk> wholly incorporates the FANUC trade mark and differs only by addition of the generic and descriptive acronym “cnc” with hyphens between the trademark and the term “cnc”. The Complainant argues that the reference to “cnc” fails to dispel the connection between the domain name and the Complainant’s trade mark, but in fact reinforces the association because the term “cnc” denotes a key aspect of the Complainant’s goods and services, namely computer numerical control (commonly known as “cnc”) systems.

The Complainants additionally argue that the disputed domain name <fanuc-cnc-lathe-repair.co.uk> wholly incorporates the FANUC trade mark and differs only by addition of the acronym “cnc” and the generic words “lathe” and “repair” with hyphens in between each word. As mentioned above, the term “cnc” denotes a key aspect of the Complainant’s goods and services. A “lathe” is a machine tool for which the Complainants’ cnc systems are currently used and the word “repair” simply denotes a repair service being offered in connection with the Complainant’s products. Again, these generic and descriptive terms fail to dispel

the connection between the domain name and the FANUK trade mark but in fact reinforce the association.

The Complainants assert that they have no association with the Respondent and have never authorised or licensed the Respondent to use their trade marks.

As of 29 January 2014 the domain name <fanuc-cnc.co.uk> resolved to a website offering to supply various services, including repairs, relating to cnc systems of competitors of the Complainant as well as to the Complainant's own systems. The Complainant has submitted screenshots of the homepage of the website and a linked page in an annex to the Complaint which shows links to competitors of the Complainant including Bridgeport, Hardinge, Hitachi, Seiki and Victor.

As of 29 May 2014 the domain name <fanuc-cnc-lathe-repair.co.uk> resolved to a website which also contained sponsored links to third party websites offering cnc goods and services competing with those of the Complainant.

On 13 February 2014, the Complainants' solicitor sent a cease and desist communication to the Respondent by email, to which no response was received.

The Complainants further argue that the Respondent registered the disputed domain names for the purpose of unfairly disrupting the business of the Complainants by using the Complainants' trade mark to attract customers seeking the Complainants and diverting the Internet traffic either to a website offering the Respondent's repair services for competing products to which the <fanuc-cnc.co.uk> domain name resolves or to a parking page with sponsored links to the Complainant's competitors to which the <fanuc-cnc-lathe-repair.co.uk> domain name resolves.

The Complainants allege that the disputed domain names have been registered and used by the Respondent to confuse, attract and profit from Internet users who are searching for the Complainants' business in search engines, web browsers and otherwise on the Internet and submit that it is clear from its use of the Complainants' distinctive trade mark that the Respondent had the Complainants and their business in mind when registering and using the disputed domain names.

The Complainants submit that the use of the disputed domain names by the Respondent is intended to create a likelihood of confusion in the minds of the public that there is an association between the Respondent and the Complainant.

Addressing specifically the disputed domain name <fanuc-cnc-lathe-repair.co.uk>, the Complainants allege that it is clearly designed to mislead the public as it is suggestive of a site offering repairs to the Complainants' products, whereas the web page to which it resolves in fact it simply consists of sponsored links to the Complainants' competitors.

The Complainants argue that the likelihood of confusion is not diminished by the fact that Internet users arriving at the Respondent's web site will realise that they have reached the wrong destination. The Complainants submit that it is well established under the DRS that it is abusive for the Respondent to intentionally attract traffic intended for the Complainants by creating "initial interest

confusion” and thereby achieve “a business opportunity that in most cases he would not otherwise have had”. See, e.g., the Appeal Panel decisions in *scoobydoo.co.uk* (DRS 389) and *rayden-engineering.co.uk* (DRS 6284).

The Complainants further submit that while paragraph 4e of the Policy acknowledges that sale of traffic is not of itself objectionable, this Expert is required to take into account the nature of the disputed domain name, the nature of the advertising links on any relevant parking pages and the fact that use of the disputed domain name is ultimately the registrant’s responsibility. The disputed domain name <fanuc-cnc-lathe-repair.co.uk> misleadingly implies that the associated website offers repairs to the Complainant’s products whereas in fact the website is designed to generate revenue from sponsored links to products competing with those of the Complainant.

Addressing specifically the disputed domain name <fanuc-cnc.co.uk>, the Complainant refers to paragraph 4.8 of the DRS Experts’ Overview which sets out the principles applicable in “reseller” cases as summarised by the appeal panel in *toshiba-laptop-battery.co.uk* (DRS 07991):

- a. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
- b. A registration will be abusive if the effect of the respondent’s use of the domain name is falsely to imply a commercial connection with the complainant.
- c. Such an implication may be the result of “initial interest confusion” and is not dictated only by the content of the website.
- d. Whether or not a commercial connection is implied, there may be other reasons why the reseller’s incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent’s website.

The Complainants submit that in the present case, the Respondent has set out to falsely imply a commercial connection with the Complainants by initial interest confusion and, in particular, use of the Complainants’ FANUC trade mark plus an appendage which is highly appropriate to the Complainant’s field of activity. There is nothing in the <fanuc-cnc.co.uk> domain name to signal that the Respondent is an independent repairer of products.

The Complainants refer to the website to which the disputed domain name <fanuc-cnc.co.uk> resolves and submit that it contains a subtle disclaimer in small font at the bottom of the home page that is not likely to be noticed by many users. In any event, for reasons explained above, for the purposes of initial interest confusion it is irrelevant that some users may ultimately realise that the site is not affiliated with the Complainant. In fact, the use of a disclaimer itself indicates that the Respondent was well aware that visitors to its website were likely to assume an association between the Respondent and the Complainant.

As, the Respondent is using the domain name <fanuc-cnc.co.uk> to offer repairs for competitor products in addition to Complainant products, the Complainants

argue that this is of itself unfair irrespective of any implied commercial connection – as indicated in [toshiba-laptop-battery.co.uk](http://toshiba-laptop-battery.co.uk), *above*.

The Complainant also relies on the fact that the Respondent has not responded to, let alone denied, the assertions of abusive registration in the pre-action communication by the Complainant. It is reasonable to assume that if the Respondent did consider that it had legitimate purposes in registering / using the Domains it would have said so.

### **Response**

In a very brief Response the Respondent did not address any of the submissions made by the Complainant and merely stated that he did not really understand why he had been notified of the dispute and, giving a telephone number, he requested that somebody contact him by telephone to discuss the Complaint. He claimed that he has no web sites operating under these names but pays yearly to reserve them for future use if required.

A note on the file states that when contacted by Nominet he stated that he wished to leave his Response as it was and was happy to discuss a resolution at mediation.

### **Reply**

In a Reply the Complainants submit that the Respondent implausibly claims that he has no websites operating at the disputed domain name addresses.

The Complainants refer to their evidence submitted that the domain name <fanuc-cnc.co.uk> continued to be directed to website offering repairs to the products of the Complainant and its competitors were exhibited to the Complaint. The website is operated by Broader Services Ltd of which the Respondent is a director. As to <fanuc-cnc-lathe-repair.co.uk> domain name the Complainants argue that whether or not the Respondent set up the parking page himself, he remains ultimately responsible for the (deceptive) use to which the domain name is put.

The Complainants furthermore complain that the Respondent makes no attempt to address any of the issues on the Complaint, let alone explain what alleged “future use” he had in mind for the disputed domain names or why such “future use” has allegedly not yet materialised despite the fact that the domain names were registered some years ago.

## **6. Discussions and Findings**

In order to succeed in a Complaint, the Complainant is required to prove to the Expert on the balance of probabilities that

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the disputed domain names; and
- ii. the disputed domain names, in the hands of the Respondent, are Abusive Registrations.

An Abusive Registration is defined as meaning 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.

### **Rights and Similarity**

This Expert finds that the Complainants have rights in the trademark FANUC through their above-listed trade mark registrations and at common law which protects the goodwill that they have established in the use of the mark FANUC on goods and services relating to robotics.

The element FANUC is the dominant and distinctive element of both of the disputed domain names. In each domain name the word FANUC provides the first two syllables. The other elements are descriptive and refer to the goods and services that the Complainant provides under the FANUC mark.

In the circumstances, this Expert finds that both disputed domain names <fanuc-cnc-lathe-repair.co.uk> and <fanuc-cnc.co.uk> are similar to the trade mark FANUC in which the Complainant has rights.

This Expert also finds that both of the disputed domain names are Abusive Registrations in the hands of the Respondent.

The Complainants have provided evidence that the Respondent is causing or permitting the disputed domain names to resolve to web sites which provide links to competitors of the Complainants. Such activity is clearly an attempt to intercept Internet traffic directed to the Complainants' websites and divert the traffic through links to competitors of the Complainants. The Complainants have not given permission to the Respondent to use domain names that incorporate their FANUC trade mark.

The Respondent claims that he has not arranged for either of the disputed domain names to resolve to any website notwithstanding that, in the Complaint, the Complainants have provided evidence that on 29 January 2014 the domain name <fanuc-cnc.co.uk> resolved to a website offering to supply various services, including repairs, relating to cnc systems of competitors of the Complainant as well as to the Complainant's own systems and on 29 May 2014 the disputed domain name <fanuc-cnc-lathe-repair.co.uk> resolved to a web page that also contained sponsored links to websites offering cnc goods and services competing with those of the Complainant.

The Respondent has not provided any evidence to support his denial or to give any explanation as to why he registered or is using the disputed domain names except to state that he continues to pay the annual registration costs to keep them for future use if required.

This Expert finds that the disclaimer posted on the website to which the disputed domain name <fanuc-cnc.co.uk> resolves does not change the nature of the registration as Internet users will only see the notice after they have been led to the website for which the Respondent is responsible through initial interest confusion.

In the circumstances, this Expert is satisfied on the balance of probabilities that the Respondent registered and is using the disputed domain names in order to take predatory advantage of the Complainants' goodwill and reputation in the FANUC mark in order to benefit from click through revenue generated from diverted Internet traffic.

The Respondent registered the disputed domain names for the purpose of unfairly disrupting the business of the Complainant by using the Complainants' trade mark to attract customers seeking the Complainants and diverting the Internet traffic either to a website offering the Respondent's repair services for competing products to which the <fanuc-cnc.co.uk> domain name resolves or to a parking page with sponsored links to the Complainant's competitors to which the <fanuc-cnc-lathe-repair.co.uk> domain name resolves.

In the circumstances this Expert finds on the balance of probabilities that both of the disputed domain names were 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 and each domain name has since been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

This Expert finds therefore that each of the disputed domain names <fanuc-cnc-lathe-repair.co.uk> and <fanuc-cnc.co.uk> is an Abusive Registration in the hands of the Respondent and the Complainants are entitled to succeed in their application.

The Complainants have requested that the disputed domains name be transferred but have not indicated to which entity the registrations should be transferred. In the circumstances this Expert directs that both registrations should be transferred to the Lead Complainant.

## **7. Decision**

This Expert directs that, for reasons given above, each of the disputed domain names <fanuc-cnc-lathe-repair.co.uk> and <fanuc-cnc.co.uk> shall be transferred to the Lead Complainant FANUC Corporation.

**Signed James Bridgeman**

**Dated 27 March 2015**