

**NOMINET UK DISPUTE RESOLUTION SERVICE POLICY**

**DOMAIN NAME GEFANUC.CO.UK**

**B E T W E E N:**

**GE FANUC AUTOMATION (UK) LIMITED**

**Complainant**

**- and -**

**PENNINE AUTOMATION LIMITED**

**Respondent**

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**DECISION**

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**1. Parties**

Complainant: GE Fanuc Automation (UK) Limited  
1 Mill Square  
Featherstone Road  
Wolverton Mill South  
Milton Keynes  
MK12 5BZ

Respondent: Pennine Automation Limited  
Brooklands Industrial Estate  
Holywell Green  
Halifax  
West Yorkshire  
HX4 9BH

**2. Domain Name**

gefanuc.co.uk (“the Domain Name”)

**3. Procedural Background**

The Complaint was lodged with Nominet on 26<sup>th</sup> October 2001. Nominet validated the Complaint and notified the Respondent of the Complaint on 31<sup>st</sup> October 2001, informing the Respondent that it had until 22<sup>nd</sup> November 2001

to lodge a Response. The Respondent lodged a Response on 12<sup>th</sup> November 2001. On the same day Nominet notified the Complainant of the Response and that it had until 19<sup>th</sup> November to serve a Reply if any. A Reply was served on 19<sup>th</sup> November 2001.

Mediation not being possible, Nominet so informed the Complainant on 11<sup>th</sup> December 2001 and on 21<sup>st</sup> December 2001 Nominet received the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

On 2<sup>nd</sup> January 2002 Steven A. Maier, the undersigned, confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as Expert in this case and further confirmed that he knew 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.

#### **4. Outstanding Procedural/Formal Issues (If Any)**

There are no such outstanding issues in this case.

#### **5. The Facts**

The Complainant is a joint venture company owned by the General Electric Company of the USA ("GE") and Fanuc Limited of Japan ("Fanuc"). It is a provider of industrial systems including CNC (computer numerical control) control and drive products. GE and Fanuc are the proprietors of registered trade marks in the terms "GE" and "Fanuc". The Complainant asserts, and the Respondent does not dispute, that the business name "GE Fanuc" has been used by the Complainant since 1987 and is widely recognised within the relevant industry in connection with the goods and services which it provides.

The Respondent is a company supplying automation processes to industry. Its business includes the sale of mainly used, but also some new, spare parts for a variety of products, including parts manufactured by the Complainant. It carries out trading activities online and its principal website is at [www.cncspares.com](http://www.cncspares.com). It is the proprietor of a number of domain names including the Domain Name, which it registered on 1<sup>st</sup> November 1999.

The Respondent uses the Domain Name for the purposes of a website at [www.gefanuc.co.uk](http://www.gefanuc.co.uk) where it advertises the sale of Fanuc products. At the date of this Decision, the home page of the site is headed with a prominent banner reading "Fanuc-Spares" and "gefanuc.co.uk" and contains two reasonably prominent notices to the effect that the Respondent is an independent supplier and is not affiliated with the Complainant. There is also a statement: "please note this site will change soon to [www.fanuc-spares.co.uk](http://www.fanuc-spares.co.uk)" although no explanation is given for this. The Respondent

appears to be using the domain name "pennineuk.com", rather than the Domain Name, for e-mail purposes.

## **6. The Parties' Contentions**

### **The Complainant**

The Complainant's principal submission relates to confusion, and may be summarised as follows:

- (a) that the Respondent has used the Complainant's name to sell second hand products originally made by the Complainant;
- (b) that the Respondent used the Complainant's name and logo on its website until "appropriate action" was taken;
- (c) that the Respondent implied that its site was a GE Fanuc website and only included a "small notice" that it was not following correspondence from the Complainant;
- (d) that the Respondent has therefore used the Domain Name in a way that has confused visitors to the site into believing that the Domain Name was owned or operated by the Complainant; and
- (e) that the Respondent's use of the Domain Name has caused unfair disruption to the Complainant's business.

No evidence of actual confusion or disruption is, however, offered in support of matters (d) and (e) above.

The Complainant makes the further submission that the Respondent registered and subsequently used the Domain Name for the purpose of selling the same to the Complainant. In support of this, the Complainant points to an exchange of e-mails in 2000 between GE's corporate Counsel, Patrick J Murphy and Mr Neil Ginley of the Respondent. The history of these communications is that on 3<sup>rd</sup> July 2000 Mr Murphy sent Mr Ginley a "letter before action" by e-mail, requiring the Respondent to cease and desist from using GE trademarks and to cancel or transfer the Domain Name to GE. Mr Ginley replied on 4<sup>th</sup> July, seeking clarification of the trade marks referred to, which Mr Murphy provided on 5<sup>th</sup> July. Mr Ginley then asked:

"... and would you please make us an offer for the domain name for a fast transfer".

On 7<sup>th</sup> July Mr Murphy responded:

"In instances where a GE trademark is registered in a domain name by a 3<sup>rd</sup> party I am only able to offer to pay your registration costs and reasonable costs incurred in acquiring/establishing the name."

Mr Ginley's reply to this, also dated 7<sup>th</sup> July, was:

"dear Sir

we would like 60,000 UK for this domain

or we just keep it

regards neil ginley".

On 10<sup>th</sup> July Mr Murphy responded:

"Your efforts to profit off the trademarks of the General Electric Company plainly constitute bad faith. I believe at this point it would be more appropriate to have this matter resolved by an appropriate court or other dispute mechanism we may choose."

On the same day, Mr Ginley replied:

"ok fine but how long is that going to take

and i bet you would like to know what my new company is called??"

The Complainant also contends that the Respondent has been engaged in a pattern of abusive registrations aimed at the Complainant. In support of this the Complainant asserts:

- (a) that (the Domain Name being unavailable) it registered the domain name "gefanceur.co.uk" on 30<sup>th</sup> June 2000 and used the same in connection with its own website from the Autumn of that year;
- (b) that on 23<sup>rd</sup> October 2000 the Respondent registered the domain name "gefanceur.net" and used it to direct traffic to the Respondent's website;
- (c) that in July 2001, following a solicitors' letter, the Respondent offered to sell the name "gefanceur.net" to the Complainant for £650.

### *The Respondent*

With regard to the principal claim of confusion, the Respondent does not deny (or indeed directly address) the assertions of fact that are made by the Complainant. It does however state that the Domain Name was one of a number acquired, in addition to its principal domain name "cncspares.co.uk", to "assist" in the sale of spare parts over the internet.

The Respondent, which it should be noted is not legally represented, makes the overall response to the Complaint that: "we are not aware of our exact rights in this matter".

Turning to the issue of the sale of the Domain Name, the Respondent states, candidly, that:

“Like many companies early into this arena we were lead to believe, through Domain Name providers, that opportunities also existed to sell these Domain Names on, if desired”.

With regard to the figure of £60,000 relied on by the Complainant, the Respondent points to a letter dated 26<sup>th</sup> July 2001, sent in response to a letter from the Complainant’s solicitors, in which it at that time offered to transfer the Domain Name to the Complainant for a fee of £1,000. The Respondent also asserts that the communications sent by Mr Ginley in July 2000 were “Mr Ginley’s comments and not Pennine Automation’s official position”.

As to the final allegation, that of a pattern of abusive registrations, the Respondent makes no comment save to say in relation to the name “gefanceur.net” that “this site is not owned by Pennine Automation Limited”.

## **7. Discussion and Findings**

In order to succeed in its Complaint, the Complainant is required under paragraph 2 of the Policy to prove, 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 Domain Name; and
- (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.”

The term “Rights” includes, but is not limited to, those enforceable under English law. It does not encompass names which are merely descriptive.

I am satisfied that the Claimant has met the first part of the test under paragraph 2, in that it has intellectual property rights in the name “GE Fanuc”, which is identical with the substantive part of the Domain Name. The Complainant has established sufficient goodwill and reputation in the name to give rise at least to a right to protect the name against passing off, and it is reasonable to infer that it also has rights to use the registered trade marks of which its parent companies are the proprietors.

The Complaint therefore turns on whether or not the Domain Name is, in the hands of the Respondent, an “Abusive Registration”. This term is defined in paragraph 1 of the Policy, as follows:

“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) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights".

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may point to a registration being abusive, including the following:

- "i Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:
  - A. primarily 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; or
  - C. primarily for the purpose of unfairly disrupting the business of the Complainant;
- ii Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;
- iii In combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations..."

With regard to these factors, I would emphasise first that the list is non-exhaustive and secondly that these factors, if established, *may* point to the fact that a registration is abusive. In other words, the factors are merely indicators which are subsidiary to the overriding test of an abusive registration, which is that set out in paragraph 1 of the Policy.

The Complainant's principal submission relates to confusion. As to its specific arguments, it is not necessarily unlawful for a party to use the name of another party in the course of trade for the purpose of identifying the goods or services of that other party. If the name is a trade mark, such use is not unlawful providing the use is in accordance with honest business practices and does not take unfair advantage of the distinctive character or

repute of the mark. Here, the Respondent has used the Domain Name to sell products manufactured by the Complainant and therefore has a *prima facie* argument in opposition to the Complainant's first point. The success or otherwise of that argument will, however, depend upon the overall circumstances of the case.

The Complainant's assertions regarding the Respondent's past use of the Domain Name do not directly assist it under paragraph 3(ii) of the Policy, as that paragraph refers to the way in which the Respondent *is* using the name, ie current as opposed to past use. However, the matters raised by the Complainant (which, I repeat, are not disputed) may still be relevant to an overall assessment of whether the Respondent took unfair advantage of the Complainant's rights for the purposes of paragraph 1(ii) of the Policy, which involves an evaluation of how the Domain Name *has been* used.

Having reviewed the Respondent's site, I am not persuaded that a current visitor to the site would *having viewed the site* be confused into believing that the Domain Name was registered to, operated or authorised by, or otherwise connected with the Complainant. Further, I accept that the Respondent is currently using the site to sell the Complainant's products, which may *prima facie* be a legitimate use of the Complainant's name and the relevant trade marks.

That is not, however, conclusive of the matter, as in my view it is also necessary to consider why a visitor to the Respondent's site would have accessed that site in the first place. In that regard my findings are as follows:

- (a) that the name "GE Fanuc" is the Complainant's business name (which is not merely generic or descriptive) in which it is the owner of intellectual property rights;
- (b) that the Domain Name, "gefanuc.co.uk", is precisely the name which an average user of the internet would intuitively select in the expectation of accessing the Complainant's own UK website; and
- (c) that similar considerations do not apply to the Domain Name in the case of the Respondent.

In these circumstances, I conclude that the effect of the Respondent's use of the Domain Name is to bring its own website to the attention of at least some individuals who intend, in fact, to access the Complainant's website. That is plainly to take advantage of the Complainant's goodwill and, absent strong grounds for concluding to the contrary, it is an advantage that is likely to be unfair. If the Respondent merely wished to associate its site with the Complainant's products, there are other names that it could select in order to do so. I note, for example, that the Respondent also operates a site at [www.fanuc-spares.co.uk](http://www.fanuc-spares.co.uk) which, while still referring to one of the names in which the Complainant has trade mark rights, does not rely on the particular

name that falls foul of the test referred to above.

I now turn to the further grounds relied upon by the Complainant. The first of these relates to the sale of the Domain Name.

On a strict interpretation of paragraph 3(a)(i)(A) of the Policy, it is for the Complainant to show that the Respondent *registered* the Domain Name *primarily for the purpose* of disposing of it to the Complainant (or a competitor) for a sum in excess of out of pocket costs. In view of the fact that the Respondent has used the name for the purposes of a website selling goods manufactured by the Complainant, the exchange of e-mails relied on by the Complainant is not conclusive either of the Respondent's intention at the time of registration or of its primary purpose. The Complainant is, however, supported in its contention by the Respondent's admission that the onward sale of the Domain Name was, at least, a matter within its contemplation.

Moreover, as observed above, the factors set out in paragraph 3 of the Policy constitute a non-exhaustive list and are merely indicators towards the overriding issue of whether the Domain Name was registered, or has been used, in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights. In my view, the exchange of e-mails referred to above points strongly to an abusive use of the Domain Name on the part of the Respondent. As to the Respondent's Response, Mr Ginley was at all material times a director of the Respondent and I therefore see no merit in the claim that the offer to sell the name for £60,000, and the other comments made by him, constituted his personal views rather than the "official position" of the Respondent.

As to its final ground of Complaint, the Complainant is again in technical difficulties as the Policy refers to "a pattern of Abusive Registrations". As this is a defined term, it can only include registrations deemed to be abusive under the Policy, and therefore limited to those within the .uk top level domain. A .net registration is plainly outside this category. However, it is necessary to bear in mind once again that the factors in paragraph 3 of the Policy are non-exhaustive and indicative only towards the overriding test of an Abusive Registration under paragraph 1. With this in mind, I find that the Respondent's conduct concerning the domain name "gefanuceur.net" was intended to raise the stakes with regard to the communications regarding the Domain Name and that it is a further factor pointing to an Abusive Registration of the Domain Name. I attach little weight to the Respondent's claim that it was not the owner of the domain name "gefanuceur.net", since it is evident from a "whois" search that the owner was in fact its director, Mr Ginley.

## **8. Decision**

For the above reasons, I conclude on the balance of probabilities:



- (a) that the Complainant has rights in a name or mark which is identical to the substantive part of the Domain Name;
- (b) that the Domain Name has been used in a manner which took unfair advantage of the Complainant's rights and the registration is therefore an Abusive Registration.

Accordingly, the Complainant succeeds in its Complaint and I direct that the Domain Name be transferred to the Complainant.

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**Steven A. Maier**  
**10<sup>th</sup> January 2002**