

Nominet UK Dispute Resolution Service

DRS 0147

GHI Limited t/a aviance UK–v- Neville Draper

Decision of Independent Expert

Parties:

Complainant's Details

Complainant: GHI Limited t/a aviance UK
Address: 3rd Floor
First Point
Buckingham Gate
Gatwick Airport
West Sussex
Postcode: RH6 0NT
Country: GB

Respondent's Details

Respondent: Mr Neville Draper
Address: 36 West View
Bedfont
Middlesex
Postcode: TW14 8PR
Country: GB

Domain Name:

aviance.co.uk ("the Domain Name")

1. Procedural Background:

The Complaint was lodged with Nominet on 7 December 2001. Nominet validated the Complaint and notified the Respondent of the Complaint on 12 December 2001 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent lodged a purported response on 1 January 2002. The purported response was forwarded to the Complainant on 7 January 2002 and Nominet advised the Complainant it had 7 days within which to lodge a Reply. The

Complainant did not lodge a Reply. On 15 January 2002 Nominet advised the parties that the Informal Mediation stage of the Dispute Resolution service would start on 18 January 2002 and finish on 1 February 2002. The Respondent did not take up the option of Informal Mediation, so no such Mediation was possible. The Complainant was informed accordingly on 1 February 2002 and invited to pay the fee to obtain an Expert Decision pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy"). The fee was duly paid on 4 February 2002.

On 4 February 2002, Nominet invited the undersigned, Niel Ackermann ("the Expert"), to provide a decision on this case and, following an indication from the Expert that he wished to disclose circumstances 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 notified the parties of this and were given until 4.30pm on 8 February 2002 to respond. The Complainant indicated it was happy for the Expert to continue. No response was received from the Respondent within the deadline. Nominet duly appointed the undersigned as Expert with effect from 11 February 2002.

2. Outstanding Formal/Procedural Issues (if any):

The Respondent has lodged a purported response with Nominet. This response, comprising a three paragraph letter from the Respondent's solicitors, in effect, seeks to incorporate by reference the prior correspondence between the parties. This response does not comply with paragraph 5 of the Procedure for the conduct of proceedings under the Dispute Resolution Service ("the Procedure"). In particular, the Respondent has failed to comply with paragraphs 5 c iii, iv, v and vi. It is therefore necessary to deal with the consequences of the Respondent having submitted a response to Nominet but one which does not materially comply with paragraph 5 of the Procedure. The Expert takes the view that the phrase "The response shall:" in paragraph 5 c of the Procedure is peremptory and the failure of the Respondent to comply with the formal requirements, in particular, the failure to comply with paragraph 5 c v of the Procedure, means that the purported response is defective and that the Expert should ignore the purported response as lodged by the Respondent and make his determination as if no response had been submitted pursuant to Paragraph 5.

Paragraph 15 c of the Procedure provides that, in the absence of exceptional circumstances, if a Party does not comply with any provision in the Policy or the Procedure or any request by Nominet or the Expert, the Expert may draw such inferences from the Party's non compliance as he considers appropriate"

In this case, the evidence which the Respondent sought to draw to the Expert's attention is, in fact, contained in the evidence submitted by the Complainant and, in any event, the probable facts are relatively straightforward so that it is not necessary to draw any special inferences.

The Expert has power to ask for further statements or documents from the Parties pursuant to paragraph 13 a of the Procedure but he is not obliged to do so. In the Expert's view, particularly in the case of a party whose Complaint has been prepared with professional assistance, it should only be in exceptional cases that a party should be invited to produce evidence which could easily have been produced at the time of the Complaint. The Expert has considered carefully whether this is a case in which the parties should be asked to comment on or produce further documentation relating to the reputation of the Complainant in the name "Aviance". However, the Expert but has decided that, on balance, the parties having been advised by lawyers who, on the face of the correspondence passing between them, seem well versed in

the law of passing off, this is not an appropriate case to ask for such further evidence.

Generally, the absence of a Response from the Respondent does not, in the Expert's view, entitle an expert to accept as fact all uncontradicted assertions or submissions of the Complainant. In the light of the evidence which the Expert is prepared to consider, the Expert finds the relevant facts as set out in the next following section.

3. The Facts:

1. The Complainant is a subsidiary of Go-Ahead Group plc. It was incorporated on 24 December 1971. The Complainant provides services required by airlines including passenger check in, passenger processing, information desks, VIP lounges, aircraft slot management, baggage loading and unloading, cargo processing, cargo loading and unloading, cargo security screening, aircraft co-ordination, aircraft weight and balance, aircraft push-backs and aircraft towing. It operates at Aberdeen, Birmingham, Cardiff, Dublin, Edinburgh, London Gatwick, Glasgow, London Heathrow, Jersey, Leeds/Bradford, Manchester, Southampton, London Stansted and Teesside airports, employs 4,500 people and deals with over 500,000 flight movements, nearly 25 million passengers and over 420,000 tonnes of cargo each year.
2. The Complainant is part of the "aviance" alliance of companies. The other members are Alyzia Airport Services (aviance France), Euro Handling (aviance Spain), Celebi Ground Handling Inc (aviance Turkey), Laufer Aviation Limited (aviance Israel) and Jet Aviation Handling SA (aviance Switzerland). Alyzia Airport Services (aviance France) was founded in 1948 and operates in Nantes, Paris CDG, Paris ORY and Toulouse. It employs nearly 3,000 people and deals with over 250,000 flight movements, nearly 13 million passengers and 290,000 tonnes of cargo each year. It provides ground services for more than 100 scheduled or charter airlines. It is an associate member of the Airports Council International and a member of the International Air Transport Association Ground Handling Council. Euro Handling (aviance Spain) was founded in 1994 and operates in Barcelona, Madrid, Malaga, Gran Canaria, Lanzarote, Fuerteventura, Valencia, Sevilla and Santiago de Compostela and Bilbao. It employs over 1,500 people and deals with over 220,000 flight movements and nearly 13 million passengers each year. It provides ground services for over 80 scheduled, charter and cargo airlines including Air France, Condor, Air Berlin, Alitalia, Air 2000 and Finnair. Celebi Ground Handling Inc (aviance Turkey) was founded in 1958 and operates in Istanbul, Ankara, Izmir, Dalaman, Antalya, Adana, Corlu and Bodrum. It employs nearly 2,000 staff and deals with almost 180,000 flight movements and 47,700 tonnes of cargo each year. It provides ground services for over 200 airlines including Lufthansa, Air France, Alitalia, Condor, Britannia, Aeroflot, Emirates, Gulf, Saudi Arabian Airlines and El-Al. It is a member of the International Air Transport Association and the Independent Aircraft Handling Association. Laufer Aviation Limited (aviance Israel) was founded in 1975 and operates in Tel Aviv, Jerusalem, Eilat, Ovdah afb and Haifa. It employs 300 people and deals with 20,000 flight movements and 2.5 million passengers each year. It provides ground services for more than 60 airlines including leading scheduled, charter, and cargo and government carriers. It is a long-standing member of the International Air Transport Association Ground Handling Council and the Independent Aircraft Handling Association. Jet Aviation Handling SA (aviance Switzerland) was founded in

1967 and operates in Zurich and Geneva. It employs 750 people and deals with nearly 60,000 flight movements, 4 million passengers and 42,000 tonnes of cargo each year. It provides ground services for over 60 airlines including British Airways, Air France, Lufthansa, Continental Airlines, KLM, United Airlines and Austrian Airlines. It is a member of the Independent Aircraft Handling Association, an associate member of the Airports Council International and a member of the International Air Transport Association Ground Handling Council.

3. The Complainant is the co-applicant of Community Trade Mark ("CTM") application number 1,937,770 for the mark "AVIANCE" in classes 35, 37, 39 and 42. The CTM application was filed on 3 November 2000
4. On 23 February 2001, the Complainant issued a press release that the new United Kingdom company formed by the merger of GHI Limited, Midland Airport Services (Holdings) Limited and British Midland Airways was to trade as "aviance".
5. The Domain Name was registered by the Respondent on 23 February 2001.
6. The Respondent has not submitted any evidence
 - a. of any 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 and services
 - b. that the Respondent has been commonly known by the Domain Name or legitimately connected with a mark which is identical or similar to the Domain Name
 - c. that the Domain Name is generic or descriptive and the Respondent is making fair use of it
7. The solicitors acting for the Complainant wrote to the Respondent on 10 April 2001 drawing his attention to the Complainant's alleged rights in the mark "AVIANCE" and requested the transfer of the Domain Name.
8. In a letter dated 18 April 2001, the Respondent's solicitors stated that the Complainant's solicitors should take the Complainant's instructions "as to the amount which they are prepared to offer to acquire the...Domain Name". The Respondent's solicitors added that the Complainant "will be able to do the necessary calculations to establish what it is worth to them to own this particular Domain Name".
9. In a letter dated 25 April 2001, the Respondent's solicitors stated that the Respondent "has no intention whatsoever of using the Domain Name"

4. The Parties' Contentions:

Complainant:

The Complainant submissions are as follows:

1. The complaint is made in respect of the Complainant's rights and those of the aviance alliance of companies.
2. The Domain Name is identical to the trade mark "AVIANCE" in which the Complainant asserts it has rights.
3. The Complainant claims rights in respect of the goodwill and reputation in the "AVIANCE" mark.

4. The Complainant asserts that "aviance" was formed on 6 November 2000 and brings together nearly 200 years of experience within the industry, covering more than 40 airports in six countries. It handles over 200 airlines and employs nearly 12,000 staff that deal with 1.2 million flight movements, over 57 million passengers and 800,000 tonnes of cargo, including 17% of the Heathrow cargo. As a result, the Complainant asserts that "Aviance" has acquired a substantial amount of goodwill and reputation in its name.
5. The Respondent's registration of the Domain Name is damaging to the Complainant's rights since the Respondent is holding himself out as associated with or connected to aviance or the Complainant and that the misrepresentation made by the Respondent is likely to cause confusion in the minds of the public.
6. The Respondent's registration of the Domain Name constitutes an Abusive Registration since it was registered in a manner which took unfair advantage of and was unfairly detrimental to the Complainant's rights. The Complainant submits that there are a number of factors that are evidence that the Domain name is an Abusive Registration, namely:
 - a. there are circumstances that indicate that the Respondent registered the Domain Name primarily for the purpose of selling it to the Complainant for valuable consideration in excess of his documented out of pocket costs associated with acquiring the Domain Name.
 - b. the Complainant did not ask the respondent to register the Domain Name and did not give the Respondent permission to register the Domain Name. The Complainant submits that there is no obvious reason why the Respondent might be said to have been justified in registering the Domain Name.
 - c. that there are circumstances that indicate that the Respondent registered the Domain Name as a blocking registration against a trade mark in which the Complainant has rights, including that the Respondent has no intention of using the Domain Name and that the Respondent instructed his solicitor to ask the Complainant's solicitor to take instructions "as to the amount which [the Complainant is] prepared to offer to acquire the Domain Name" and "do the necessary calculations to establish what it is worth to them to own this particular Domain Name"
 - d. that there are circumstances that indicate that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. The Complainant has not been able to register a United Kingdom county-code domain name that solely reflects its trade mark "AVIANCE", since the Domain Name has been registered by the Respondent.
 - e. that the Respondent's registration of the Domain Name has disrupted the business of the Complainant, since the Complainant would have liked to have registered and used the Domain Name to promote itself on the Internet.
 - f. that the registration of the Domain Name has unfairly disrupted the Complainant's business since the Complainant is a business that trades under the mark "AVIANCE" and it wishes to register its mark as a domain name and use it to promote itself on the Internet.

- g. that the circumstances that indicate that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant are the fact that the Respondent registered the Domain Name on the same day as the press release.
7. The Respondent cannot be said to have made a legitimate, non-commercial or fair use of the Domain Name since he has not used it

Respondent:

As indicated, the Respondent has not formally responded but the Complainant has filed as evidence copy correspondence including letters from the Respondent's solicitors. The information contained in these letters is, accordingly in evidence before the Expert, but the Expert is entitled under Paragraph 12 c of the Procedure to determine what weight to give this evidence. As the bulk of this evidence is in the form of legal argument, the Expert has determined to give very little weight to the letters from the Respondent's solicitors.

5. Discussion and Findings:

General

The Complainant has to establish under paragraph 2 of the Policy that it has Rights as defined in paragraph 1 of the Policy in respect of a name or mark identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in paragraph 1 of the Policy. Rights, as defined, "includes but is not limited to rights enforceable under English Law". The Complainant has the burden to prove on the balance of probabilities both that it has the Rights and also that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

The Expert holds that the Domain Name is identical to the name or mark in which the Complainant asserts rights.

Paragraph 2 of the Policy requires the Complainant to prove that "it has Rights". There is no explicit requirement as to when those Rights have to exist. Do the Rights have to be in existence before the Respondent applies for the disputed Domain Name or is it sufficient that they exist at the time when the Complaint is lodged? If the former, the evidence is that the Respondent's Application for the Domain Name was applied for on the same day as the Complainant announced that it was going to trade under the "aviance" name. While this seems suspicious, the Complainant has not adduced evidence to prove which came first, the announcement or the application. It seems unlikely that, had the Respondent applied for the Domain Name before the Complainant made the announcement, he would not in correspondence or in a Response in this dispute asserted that fact.

In order to assert its claim, the Complainant has submitted three types of right which it says entitles it to the Domain Name, namely:

1. a Community Trade Mark application
2. the right to sue for passing off under English Law
3. the rights of the "aviance" alliance in the "Aviance" name

The Complainant has not made any submissions as to the date at which these rights have to exist. There are three possible dates which might be relevant:

1. the date the Respondent applied for the Domain Name, namely 23 February 2001
2. the date the Complaint was submitted, namely 7 December 2001
3. the date the Complaint was adjudicated on.

As no further evidence was adduced between the date the Complaint was submitted and the date of the adjudication, for the purposes of this Complaint only the first two dates have any real relevance.

The Complainant has no registered trade mark, merely an application for a CTM jointly with Alyzia Airport Services. The Complainant has not made any submissions as to how it relies on this trade mark application as establishing Rights as defined in the Policy. The Expert can only assume that it intended to suggest that it might be a right enforceable under English Law but it is trite law that the mere application for a trade mark is not a right which is enforceable under English Law. Whether a mere application for a CTM creates rights elsewhere is not addressed in the Complaint. If the CTM application proceeds to grant, the Complainant will clearly have an enforceable right under English Law.

The other rights on which the Complainant relies are rights in relation to “goodwill and reputation”. Rights in goodwill and reputation are enforceable under English Law under the common law provisions for passing off. To succeed on this point, the Complainant must prove that, at the relevant date, it had a reputation, and therefore goodwill, in the marketplace by demonstrating that it uses a name which the relevant market recognise relates to the Complainant’s goods and/or services to the extent that, if someone else were to use that name, they would be confused as to the origin of those goods and/or services. In order to enforce a claim for passing off in England, the relevant marketplace in which the Complainant must have goodwill must exist in England. Goodwill outside the jurisdiction is not sufficient.

In support of its claim that it has the right to sue for passing off, the Complainant has asserted that “the Respondent is holding himself out as associated with or connected to “aviance” or the Complainant”. This is an unsubstantiated assertion which is not borne out by the evidence but, in fact, there seems to be no requirement for the Complainant to prove that the Respondent has infringed its rights other than by proving the second limb of paragraph 2 a of the Policy, namely that the Domain Name in the hands of the respondent is an Abusive Registration. To get over the first limb, the Complainant merely has to establish that it has Rights in the name and not necessarily that it can enforce those rights in the courts against the Respondent.

The Complainant has attached to its Complaint a press release which was posted on the Internet but the Complainant has given no evidence to explain how that press release created goodwill for the Complainant, for example by detailing how many hits that press release had received or whether that press release was picked up and published elsewhere. The Complainant has also attached a brochure but has not explained what this brochure is meant to prove.

The Complainant has submitted a great deal of evidence on the extent of the operations of the “aviance” alliance but the period to which this evidence relates is not clear. The Complainant has submitted very little evidence of the use that has been made of the “Aviance” mark. The global evidence is summarised by the Complainant as follows:

“aviance” was formed on 6 November 2000 and brings together nearly 200 years of experience within the industry, covering more than 40 airports in six countries. It handles over 200 airlines and employs nearly 12,000 staff that deal with 1.2 million flight movements, over 57 million passengers and 800,000 tonnes of cargo, including 17% of the Heathrow cargo.

Insofar as the UK operation is concerned, the Complainant’s evidence (which the Expert accepts as a fact) is:

[The Complainant] operates at Aberdeen, Birmingham, Cardiff, Dublin, Edinburgh, London Gatwick, Glasgow, London Heathrow, Jersey, Leeds/Bradford, Manchester, Southampton, London Stansted and Teesside airports, employs 4,500 people and deals with over 500,000 flight movements, nearly 25 million passengers and over 420,000 tonnes of cargo each year

The date of 6 November 2000 is said to be the date the “aviance” alliance was formed but that does not appear to be the date it commenced trading as “aviance”. The brochure suggests trading under the “Aviance” name might have commenced in January 2001 but the press release suggests it commenced on 23 February 2001. The Complainant’s evidence does not address the issue of what reputation and goodwill the Complainant had acquired in the “Aviance” name by 23 February 2001, if any. If anything, the press release suggests that 23 February 2001 was the first time notice was given to the relevant market (whatever that relevant market might be) of the new trading style. On the evidence before the Expert it seems unlikely that the Complainant had the requisite reputation and goodwill to establish a claim for passing off in England at the date of the application by the Respondent for the Domain Name.

However, that may not be the appropriate date at which the Rights have to exist. If it were, it would have been very easy for the relevant date to have been specified in the Policy or Procedure as, for example, is done in paragraph 4 of the Policy in relation to how a respondent may demonstrate that a domain name is not an Abusive Registration.

The mere registration of a name as a domain name without any trading by the owner under or by reference to that domain name, would not give the owner of that domain name any protection against a claim for passing off in the English courts from a trader who, subsequent to the registration of the domain name but before the domain name owner built up any reputation himself, built up a significant reputation in that name. The prior registration of the domain name would not extinguish the trader’s enforceable right to sue for passing off and the date when the claimant’s rights would be determined would be the date when proceedings were commenced. There seems no particular reason why the same rule should not prevail in these circumstances. The fact that an application for a domain name precedes the existence of a complainant’s rights seems more logically something which needs to be considered under the second limb of Paragraph 2 a of the Policy, namely in determining whether a domain name, in the hands of a respondent, is an Abusive Registration.

While the Expert does not give much weight to this evidence because it is only in the Respondent's solicitors' correspondence annexed to the Complainant's submission, there is evidence that there are others with possibly earlier rights to the name "Aviance". Even if correct, this would not necessarily deprive the Complainant which might have sufficient concurrent reputation to enable it to sue for passing off.

In order to prove reputation and goodwill in the "Aviance" name, the Complainant needs to prove that the relevant market had not only become aware of the "Aviance" name but that the relevant market associates that name with services provided by the Complainant. While the Complainant is clearly a substantial business, the evidence it has submitted does not in the Expert's view establish what the relevant market is nor does it establish any market in which the Complainant can be said to have the requisite reputation and goodwill in the name "Aviance". For example, while the uncontroverted evidence is that "aviance" staff in the UK deal with nearly 25-million passengers, there is no evidence that any such passengers associate the name "Aviance" with the Complainant. The Expert has accepted as a fact that the Complainant provides services required by airlines including passenger check in, passenger processing, information desks, VIP lounges, aircraft slot management, baggage loading and unloading, cargo processing, cargo loading and unloading, cargo security screening, aircraft co-ordination, aircraft weight and balance, aircraft push-backs and aircraft towing but the mere fact that the Complainant provides these services does not mean that the relevant market associates these services with the "Aviance" name. There seems to be a strong possibility that passengers would associate services such as passenger check in, passenger processing, information desks, VIP lounges, baggage loading and unloading with the relevant airline or the airport, rather than with the Complainant. If the relevant market in which the Complainant asserts a reputation is the airlines, the evidence does not prove that, since the Complainant adopted the name "Aviance", that name has become associated with the Complainant.

The fact that the Complainant or the "aviance" alliance traded for many years before adopting the "Aviance" name, does not assist in proving that the Complainant has acquired any reputation in the "Aviance" name nor, for that matter, does the scale of the Complainant's operation.

In the absence of any contradictory evidence from the Respondent, it would be open to the Expert to take at face value any evidence of the Complainant as to how the Complainant has established the requisite reputation in the name "Aviance". However, without such evidence, the mere existence of the press release and the brochure do not establish that reputation. Reputation is not something which the Expert can infer. Even in the absence of a Response, the existence of the Rights relied on have to be proved by the Complainant.

The definition of Rights in paragraph 1 of the Policy, provides that rights other than rights enforceable under English Law can be considered by the Expert. If the Complainant wished to rely on a right, other than rights enforceable under English Law, it is incumbent on the Complainant to explain what right exists and prove that right belonged to it. There is a great deal of evidence in the Complaint as to the nature of the "aviance" alliance's business outside England but this evidence does not establish any right owned by the Complainant outside England. It would appear that each of the "aviance" alliance members will be developing their own reputation and goodwill in the "Aviance" name in their own territory and, therefore, would probably be acquiring any rights in the "Aviance" name in those territories. The mere association between the Complainant and members of the "aviance" alliance does not entitle the Complainant to enforce the other members' rights, if any.

The only evidence to which any significant weight can be attached is that which relates to the Complainant's own rights. In respect of the rights claimed by the Complainant, the Expert holds that:

1. the Community Trade Mark application is not a right enforceable under English Law
2. the Complainant has not proven, on a balance of probabilities, that it had the requisite reputation and goodwill in the "Aviance" name to enforce a claim for passing off under English Law whether at the date of the application by the Respondent for the Domain Name or at the date of the lodging of the Complaint or at the date of this adjudication
3. the rights, if any of the "aviance" alliance in other territories, are not rights which the Complainant can rely on

For the reasons given above, the Expert finds that the Complainant has not proven, on a balance of probabilities, that it has Rights in respect of a name or mark, which is identical to the Domain Name.

Abusive Registration

As the Complainant has not proven that it has Rights in respect of a name or mark, which is identical to the Domain Name, it is unnecessary to decide whether the Domain Name in the hands of the Respondent is an Abusive Registration.

6. Decision:

In light of the foregoing finding, namely that the Complainant has not proven on a balance of probabilities that it has Rights in respect of a name or mark which is identical to the Domain Name, the Expert directs that the Complaint in respect of the Domain Name aviance.co.uk be refused.

Niel Ackermann

21 February 2002

Date