

PRO-FACE UK LIMITED

- v -

MR. DENNIS PRICE

Nominet UK Dispute Resolution Service

DRS 00399

Decision of Independent Expert

1. **Parties**

Complainant: Pro-Face UK Ltd.

Address: 21 Tenter Road
Moulton Park
Northampton
Northants

Postcode: NN3 6AX

Country: UK

Contact Details

Contact: Mr. Steve Broadbent

Business name: Pro-Face UK Ltd.

Address: 21 Tenter Road
Moulton Park
Northampton
Northants

Postcode: NN3 6AX

Country: UK

Respondent: Mr. Dennis Price

Address: Bank House
16-21 Church Street
Tamworth
Staffordshire

Postcode: B79 7DH

Country: UK

Contact Details

Contact: Mr. Mark Mathews

Business name: Mark Mathews & Co

Address: Bank House
16-21 Church Street
Tamworth
Staffordshire

Postcode: B79 7DH

Country: UK

2. **Domain Name:**

<proface.co.uk> (“the disputed Domain name”)

3. **Procedural Background:**

The Complaint was lodged with Nominet UK (“Nominet”) by e-mail on May 16, 2002 and a hard copy of the Complaint was received by Nominet on May 17, 2002. Nominet validated the Complaint and notified the Respondent of the Complaint on May 20, 2002, giving him 15 working days within which to lodge a Response. A Response was received by Nominet on June 11, 2002 and it was forwarded to the Complainant on the same day. Later on June 11, 2002 a non-standard fax containing additional details was sent to Nominet by the Respondent’s representative and this was copied to the complainant on June 14, 2002. A reply to the Response was received from the Complainant on June 20, 2002 and a copy was sent to the Respondent on the same day. Nominet initiated its Informal Mediation procedure on June 25, 2002 but it would seem that an acceptable resolution through mediation was not achieved, for on July 30, 2001 the Complainant paid to Nominet the appropriate fee for a Decision by an Expert pursuant to paragraph 6 of the Nominet Dispute Resolution Service Policy (“the Policy”).

On August 2, 2002 the undersigned, Mr. David H Tatham (“the Expert”), confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an 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. He was subsequently selected by Nominet as the Expert for this case.

4. **Outstanding Formal/Procedural Issues (if any)**

The letter from Nominet appointing the Expert states that only the initial complaint has been checked for validity and that it is up to the Expert to decide on how much weight should be given to any non-compliant or incomplete submissions. Nominet’s published Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”) refers only to a Complaint (paragraph 3), a response to which must be filed within 15 working days (paragraph 5), and a reply by the Complainant which must be filed within 5 working days (paragraph 6).

In this case, all the documents were filed within the time allowed, so the procedures have been complied with and there are no outstanding procedural issues.

5. **The Facts**

The Complainant describes itself as a subsidiary of the international Pro-Face group, with exclusive rights in the UK as first-level distributor of Pro-Face industrial automation products. Its letter paper carries the banner: “**Pro-face.** Human Machine Interface”. No other factual information has been supplied, other than a copy of a certificate of registration for the trade mark ‘Pro-face’ in the United Kingdom.

The Respondent is a Director of MMI Solutions Ltd. and he claims to have acquired and registered the domain name in 1998 in order to advertise the fact that MMI Solutions Ltd. distributed Proface Products manufactured by Digital Equipment Corporation of Japan. He says that MMI Solutions Ltd. was one of about ten companies distributing Proface products at that time.

The disputed Domain Name was registered on October 18, 1998, and according to the copy of the relevant page which was supplied to the Expert as part of the papers provided by Nominet, it dissolves to a page which carries the following legend: “Your domain is registered and parked for you.”

6. The Parties’ Contentions

Complainant

The Complainant asserts that the domain name is identical to one in which it has rights and alleges that the registration is an abusive registration.

The Complainant claims that it is the only company using the Pro-Face name in the UK, and that MMI Solutions Ltd., of which the Respondent is a director, and which is one of its direct competitors, has never at any time had any rights to sell Pro-face products in the UK. Consequently, the Respondent's use of the disputed domain name would be misleading, and amount to an attempt to unfairly steal business from the complainant. It is therefore a case of reverse domain name hijacking.

Respondent

The Respondent alleges the domain name has not been registered or otherwise acquired:

- 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 Respondents 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.

The Respondent further asserts that the Complainant company was only registered on the 25th January 2002. Previously it had been known as XYCOM Europe Ltd and XYCOM Automation Ltd. from 19th July 1988 and 28th January 1999 respectively. These companies did not trade in Proface products. Accordingly the domain name was in existence for some 3 years prior to the Complainant coming into existence and the Complainant therefore has no automatic right to use it.

The Respondent’s use of the disputed domain name has not confused people or businesses into believing that the domain name is registered to, operated or authorised by or otherwise connected with the Complainant. The Complainant does not (and indeed cannot) establish or show that the Respondent is engaged in a pattern of making abusive registrations.

The Respondent does not accept or agree that the Complainant has rights in a name or mark that is the same or similar to the disputed domain name. MMI Solutions Ltd. has had rights to sell, distribute and supply Proface products since January 1998, and the Complainant is totally wrong to assert that MMI Solutions Ltd. has never at any time had any rights to sell Proface products in the UK.

The Respondent's use of the domain name is not and never has been misleading nor has it been an attempt to unfairly steal business from Proface UK Ltd. The Complainant fails entirely to show or prove its assertions and these are utterly vexatious and ill-founded. The Complainant is making an attempt to secure a domain name which was registered and acquired prior to its existence.

Following the filing of a Response by the Respondent, his representative faxed to Nominet a copy of a letter from a Mr. Trevor Bennett. In this Mr. Bennett states that in 1996 he was the Managing Director of a company called Taylor industrial Software Ltd. when it was acquired by Total Control Products which was a major shareholder of Pro-face Europe at the time. Taylor Industrial Software Ltd. changed its name to Total Control Products Ltd. and was appointed the sole primary distributor of Pro-face products in the UK from early 1997. He goes on: *"I can not be sure of the date without some further research, but MMI solutions was appointed a main distributor of the Proface and Total control products range and carried out this function for some time subsequently. I vaguely remember that you registered a URL address, which contained the word Proface, but we never got around to doing anything with it as we were taken over, by GE Fanuc, shortly afterwards and everything else became a secondary issue. GE Fanuc closed down Total Control UK at the end of 1999 and I was surplus to requirements and so can not verify the facts after this point in time."*

Complainant's Reply

The Complainant states that, although on the 18th October 1998 MMI Solutions Ltd. was distributing products manufactured by Digital Equipment Corporation, contrary to the Respondent's assertions they were not branded Pro-Face products. Although they were similar products, they were branded "TCP" or "Total Control Products. The Respondent may have anticipated that his company might become a Pro-Face distributor at some time in the future, but it was never appointed as such, and the Respondent has not produced any evidence to prove his assertion. Furthermore, the TCP distributorship was eventually terminated, and MMI now distribute a product range ("Hakko") which is a direct competitor to Pro-Face.

Since registration, the web site has been left unused or "parked" and the e-mail address unused, for nearly four years, and in fact the registration was renewed in the Respondent's name earlier this year. In this light it is hard to imagine any other intent than that it was registered as a blocking registration against a name or mark in which the Complainant has rights, or primarily for the purpose of unfairly disrupting the business of the Complainant.

It is true that the Complainant company was only registered on 2nd January 2002, but there was another company with this name, whose trade and assets were transferred to the Complainant on that date, as a result of an amalgamation of the Pro-Face and Xycom organisations. This company (no. 3927088) had been registered on 16th February 2000 as a subsidiary of the Digital Electronics group, and was the main UK Pro-Face distributor from then until the 2nd January 2002.

Although the Complainant accepts that there is no evidence that the disputed domain name has been used to confuse people, or to steal business unfairly from Pro-Face UK Ltd in the past, given the Respondent's recent renewal of the registration, at a time when he is in direct competition to the Complainant, the Complainant is concerned that this may not continue to be the case. If the Respondent had used either the web site or e-mail address to pass themselves off as in any way representing Pro-face in the UK, the Complainant would have considered legal action to prevent misrepresentation, and announces its intention of doing so if such a situation presents itself in the future.

The Complainant also accepts that there was no company trading under the Pro-Face name in the UK at the time when the Respondent registered the domain name. However, the Complainant's parent company, the Digital Electronics Corporation, held at that time (and still holds) the sole right to use the Pro-Face name and trade mark in the UK, and has never expressly granted use of that name for any purpose whatsoever to MMI Solutions Ltd. A copy of the trade mark registration certificate was annexed to the Reply. It is the Respondent's continued ownership of the domain name in the current circumstances, and particularly its recent renewal that we regard as abuse.

It is not true that MMI Solutions Ltd. had rights to sell, distribute and supply Pro-face products since January 1998. As explained above, and according to the Complainant's parent organisation, Digital Electronics Corporation, MMI Solutions Ltd. had at one time rights to distribute TCP products, but has never been appointed a distributor for Pro-Face products.

7. Discussion and Findings

General

According to paragraph 2 of the Policy, in order to succeed in a Complaint, the Complainant has to prove to the Expert that, on the balance of probabilities -

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

Complainant's Rights

There is no doubt that the disputed domain name is identical to the trade mark 'Pro-face' in which the Complainant claims to have rights. It is customary in domain name disputes to disregard both the suffix '.co.uk' as having no relevant significance and because it is generic, as well as an insignificant piece of punctuation such as a hyphen. Therefore the only question to be answered is whether or not the Complainant has rights in 'Pro-face'. These are defined, in paragraph 1 of the Policy, as being rights that are enforceable under English law.

According to the copy of the registration certificate of UK trade mark No. 1506884 that was annexed to the Complainant's Reply, the mark 'Pro-face' was registered in

1992 in the name of Digital Electronics Corporation. It should have been renewed after 7 years and, as no renewal certificate was filed by the Complainant, the Expert checked the mark in the database of the UK Patent Office and confirmed that the registration was renewed in 1997 and that it remains in the name of Digital Electronics Corporation.

The Complainant states that it has exclusive rights to distribute Pro-face products in the United Kingdom. It describes itself – at different times – as being “a subsidiary of the international Pro-Face group” and as having the Digital Electronics Corporation as its parent. No copies of any Licence or Distribution Agreements have been supplied, but the copy of the trade mark registration certificate contains indications that it has been faxed from Japan, which would seem to indicate that someone in Japan, possibly the Digital Electronics Corporation, supplied the original copy. If so there would indeed seem to be a close relationship between the Complainant and the owner of the trade mark. It is also noteworthy that the word ‘Pro-face’ forms part of the Complainant’s name.

The Respondent casts doubt upon the Complainant’s right to the name ‘Pro-face’, saying that the Complainant itself was only incorporated in January 2002 and so was not in existence when the disputed domain name was first registered in 1998. The Complainant points out that when it was formed it took over the assets of another Pro-face company which had been in existence since February 2000. This too was after the date when the disputed domain name was registered, but all of this is irrelevant, for the trade mark Pro-face was registered in 1992, it was being used on certain products made by the Digital Electronics Corporation and so was known in the trade before 1998 and, as outlined above, the Complainant is clearly using it with the permission of the owner of the trade mark.

The Expert is therefore prepared to accept that the Complainant does have rights in the name Pro-face and he is satisfied as regards the first leg of the Complaint, namely that the Complainant does have Rights in a name or mark which is identical or similar to the disputed Domain Name.

Abusive Registration

In paragraph 3(a) of the Policy is a non-exhaustive list of factors which may be evidence of an Abusive Registration

As there is no indication that the Respondent has ever attempted to sell the disputed domain name, paragraph 3(a)(i)A is not applicable, but paragraphs 3(a)(i)B and C would appear to be pertinent in this case. These paragraphs state that the Respondent has “registered or otherwise acquired 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.”

The Respondent argues that he had every right to the name Pro-face as MMI Solutions Ltd. of which he is a Director, was in 1998 a duly appointed distributor of “Proface products that were manufactured by Digital Equipment (sic) Corporation of Japan”. However the Complainant says that this was not the case, as these products were never branded with the name ‘Pro-face’, nor had MMI Solutions Ltd. been given distribution rights for anything other than TCP products.

It might be convenient at this point to deal with the letter from Mr. Bennett and its admissibility. This letter is dated June 10, 2002 and it was labelled by Nominet as a 'non-standard response' and for the Expert to decide whether or not to admit it as evidence. The copy of the letter was faxed to Nominet by the representatives of the Respondent on the same day, and within a few hours of, when the Response from the Respondent was filed and so it was received within the time limit for the filing of a Response. It was also referred to in that Response as "to follow". Consequently the Expert sees no reason why it should not be accepted as part of the Respondent's case.

The letter appears to contradict the facts as presented by the Complainant and it is surprising that the Complainant made no reference to it or to any of the statements contained therein in its Reply. The author of the letter was the Managing Director of a company which he describes as "the sole primary distributor of Proface products in the UK" in 1996 and the "main distributors for the Proface range of products from early 1997". He then goes on to say that MMI Solutions Ltd. **was** authorised to distribute Pro-face products but that the writer cannot be sure of the date, although his would appear to be some time after "early 1997". However the letter is perhaps more interesting for what it does **not** say. It does not, for example, confirm that the Pro-face technology as distributed by MMI Solutions Ltd. was actually marked with that name (bearing in mind that the Complainant says that MMI Solution's products were always marked with the name TCP or Total Control Products), nor can it confirm whether the Respondent was a Director of MMI Solutions Ltd. or indeed even an employee of that company at the time, nor does it say when MMI Solutions Ltd. ceased to be a 'Pro-face' distributor, and nor does it enlarge upon the relationship between Total Control and a company called "Proface Europe". Also, although clear on some points, the letter is very vague on others and the author appears to be somewhat selective in the facts that he remembers and those that he does not.

If this were a court of law, no doubt Mr. Bennett could be cross-examined and the true facts ascertained. As it is the Expert can only weigh this single piece of evidence against the facts as stated by the Complainant. These are that it is currently the only true distributor of Pro-face products, and that it does this as the subsidiary of the manufacturer of them who is owner of the name. Although it would have been helpful if the Complainant's bald statements of fact had been backed up with more hard evidence, they have an air of authority and a ring of truth about them which is lacking from the Respondent's ill-spelt Response. Consequently the Expert in this case prefers to believe the Complainant's version of the facts, namely that neither the Respondent nor MMI Solutions Ltd. were ever the official distributors in the UK of products that were marked with the Pro-face trade mark.

The Respondent denies that the disputed domain name is a blocking registration or was registered primarily for the purpose of unfairly disrupting the complainant's business. However clearly the existence of the disputed domain name in the hands of the Respondent who, although he may have believed he had some rights to it in 1998 does so no longer, serves to prevent (i.e. block) the Complainant from using it as a domain name. It would appear from the Complainant's letter paper that it presently does not have a website, but that it uses as an e-mail address <sales@profaceuk.com>. Thus the disputed domain name would be a very useful asset which it is at present blocked from registering or using.

The disputed domain name is not currently being used, but its continued existence in the hands of the Respondent constitutes an ever-present threat, and if the site were to be used by the Respondent in a disparaging way it could become capable of “unfairly disrupting the Complainant’s business” even if that was not why it was registered in the first place. However the Expert is mindful of paragraph 3(b) of the Policy which states that “failure on the Respondent’s part to use the Domain Name for the purposes of e-mail or a web-site is not in itself evidence that the Domain Name is an Abusive Registration”.

For the record, paragraphs 3(a)ii, iii and iv do not apply in this case as the Respondent is neither using the disputed domain name, nor is he apparently engaged in a pattern of making Abusive registrations, nor has he been proved to have supplied Nominet with false details.

Also, in view of the Decision below, the Expert does not find it necessary to rule on the question of reverse domain name hijacking.

8. Decision

The Expert finds that the Complainant has Rights in the name ‘Pro-face’ and that this name is identical or similar to the disputed Domain Name.

The Expert further finds that, on the balance of probabilities, the disputed Domain Name is an Abusive Registration in the hands of the Respondent.

The Expert therefore directs that the disputed Domain Name <proface.co.uk> be transferred to the Complainant.

.....
David H Tatham
August 8, 2002