

DISPUTE RESOLUTION SERVICE

D00010455

Decision of Independent Expert

Dr. Ing. h.c.F. Porsche AG

and

Ms Sara Maddock

1. The Parties:

Complainant: Dr. Ing. h.c.F. Porsche AG
Porscheplatz 1
Stuttgart
Germany

Respondent: Ms Sara Maddock
37 School Hill
Storrington
West Sussex
RH20 4NA
United Kingdom

2. The Domain Name:

porscheportsmouth.co.uk

3. Procedural History:

30 October 2011 19:30 Dispute received
31 October 2011 07:21 Complaint validated
31 October 2011 07:42 Notification of complaint sent to parties
17 November 2011 01:30 Response reminder sent
21 November 2011 08:17 Response received

21 November 2011 08:17 Notification of response sent to parties
24 November 2011 12:06 Reply received
24 November 2011 12:06 Notification of reply sent to parties
24 November 2011 12:07 Mediator appointed
29 November 2011 14:49 Mediation started
12 December 2011 12:48 Mediation failed
12 December 2011 12:48 Close of mediation documents sent
29 December 2011 15:20 Expert decision payment received

4. Factual Background

The Complainant is a manufacturer of sports cars and uses "Porsche" as a prominent and distinctive part of its trade name. The Complainant owns numerous registered trade marks in almost every country of the world consisting of or incorporating the name "Porsche". One early example is UK trade mark No 729217 (for "Porsche") with a filing date of 14 April 1954. The trade mark and trade name "Porsche" are known throughout the world. The Complainant's cars enjoy a reputation for high quality and excellent performance.

The Complainant operates a web site at www.porsche.com. The entry page provides drop down menus to select the country of interest. From here the internet user can be transported to a website designed specifically for the country chosen. The UK website is located at <http://www.porsche.com/uk/>.

Porsche cars are distributed worldwide through a network of official dealers, known as Porsche Centres. In the UK there are 35 such Porsche Centres and an internet user is able to search for the most suitable from a further drop down menu.

The Complainant has established subsidiaries to conduct business operations in specific markets. Porsche Cars Great Britain Limited (PCGB Ltd.) is the sole UK and Ireland importer of Porsche cars and is wholly owned by the Complainant. PCGB Ltd. is licensed by the Complainant to manage the registration, maintenance and use of the domain names that are used by various Porsche Centres throughout the UK. Each Porsche Centre has a specific domain name but a common format i.e. "Porsche" followed by the name of the city or area in which the centre is located, for instance, porscheaberdeen.co.uk,

porschesheffield.co.uk and porscheleeds.co.uk.

The domain name in dispute, porscheportsmouth.co.uk, (the Domain Name) was registered by the Respondent on 16 January 2008. The Respondent registered the Domain Name as a non-trading individual and opted to have her address omitted from the WHOIS service.

The Domain Name resolves to a SEDO parking website.

5. Parties' Contentions

The Complainant

- The Domain Name is similar to the Complainant's trade name and trade mark "Porsche".
- The trade name and trade mark "Porsche" is incorporated in its entirety in the Domain Name. The word "portsmouth" is merely descriptive in nature indicating a place where the Complainant operates (or is to operate).
- The public will assume that the Complainant and its subsidiary/licensee is associated with a domain name that consists of the Complainant's name and a geographic indicator.
- The Porsche Centre Bournemouth has to date been responsible for an area that includes Portsmouth. There have been plans, however, for a Porsche Centre in Portsmouth which is scheduled to open in 2012.
- When the Complainant tried to register a domain name suitable for its Portsmouth Porsche Centre, i.e. the Domain Name, it discovered the Respondent's registration.
- The Respondent has made no use of the Domain Name other than to have it re-directed to a SEDO parking website with pay-per-click links, including to products that compete with those of the Complainant (Aston Martin cars), thus earning revenue.

- Moreover, it is likely that the Respondent envisaged selling the Domain Name to the Complainant in that she has registered a domain name that exactly reflects the Complainant's domain name format policy for its Porsche Centres. The Respondent must have been aware of this and intentionally blocked the domain name that is needed by the Complainant for its Portsmouth Porsche Centre.
- There is no conceivable reason why a non-trading individual might register a domain name that consists of the Complainant's famous name combined with the name of a major UK city in which there is likely to be a Porsche Centre at some time in the future.
- After almost 3 years, the Domain Name has not been used for any genuine, non-commercial purpose.
- It has not been established whether the Respondent could have known about the Complainant's plans to open a Portsmouth Porsche Centre or whether there is any breach of confidentiality.
- The Domain Name is an Abusive Registration in that it re-directs internet users looking for the Complainant and its Portsmouth Centre to a SEDO parking website from which the Respondent derives commercial gain and from where internet users can be referred to, amongst other destinations, competing products. The Domain Name thus takes unfair advantage of the Complainant's trade mark.
- By registering the Domain Name as a non-trading individual the Respondent has prevented being contacted prior to the Complaint and prevented a more detailed investigation of the Respondent's background and intentions.

The Respondent

- The name "Porsche" is a popular girls name
- The name "Porsche" sounds like Porscha, Porschia and Porcha. Other similar names are Pascha and Psyche.

- The name "Porsche" is therefore not solely recognised in conjunction with the motor car and it is therefore unreasonable for the Complainant to seek a transfer of the Domain Name.
- Viable alternatives are available to the Complainant such as 'porscheportsmouth.com' or 'portsmouthporsche.co.uk' or '.com'.
- Although the Complainant has rights over the use of the Porsche name with regard to the motor company, it is unreasonable to seek a transfer of a domain name when it contains a particular location which a complainant had no association with at the time of registration.
- The Respondent asks (rhetorically, presumably) in her Response "Would the town of Portsmouth not have equal rights to the ownership of it's name in conjunction with the complainants own?"

The Reply (of the Complainant)

- Instead of explaining why she registered a domain name incorporating the Complainant's name and trade mark and combined it with the name of a city where a Porsche Centre is going to be opened, the Respondent has focused on alternative uses of the word "Porsche".
- The Complainant's assumption that the Domain Name has nothing to do with the female name "Porsche" is supported by the failure of the Respondent to make any connection between Porsche as a female name and herself or her use of the Domain Name. Moreover, there is no mention in her Response of any intention to 'dedicate' the Domain Name to a person called "Porsche", let alone such a person who also has a connection to the City of Portsmouth.
- The Respondent does not appear to dispute the Complainant's allegations regarding the earning of click through fees, and registered the Domain Name as an investment in order to make a profit from the Complainant's name and trade mark.

The Complainant made a number of other points in its Reply to the Response. Some are in relation to the professional background of a person of a different name to that of the Respondent but assumed to be the Respondent. It is not necessary to set out these points.

6. Discussions and Findings

Under the provisions of Nominet's Dispute Resolution Service Policy (the Policy), for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's 'Rights'

The meaning of 'Rights' is defined in the Policy as follows: *'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'*.

The Complainant enjoys long-standing registered (and no doubt unregistered) rights in the mark. It has several trade mark registrations for "Porsche" and the mark has been extensively used in its activities in the UK and elsewhere over many years.

The Domain Name encapsulates the Complainant's mark "Porsche" in its entirety. It is the first and dominant word of the Domain Name, being followed by the geographic indicator 'portsmouth'. The Complainant's mark and Domain Name are similar.

Accordingly, the Expert is satisfied that the Complainant has Rights in a name or mark that is similar to the Domain Name.

The Expert must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'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 which *'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights'*.

The best guide as to what might constitute an Abusive Registration is contained in paragraph 3(a) of the Policy. It contains a non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant (or a competitor) for valuable consideration in excess of the Respondent's out-of-pocket costs, as a blocking registration against a name or mark in which a Complainant has rights, or for the purpose of unfairly disrupting the business of a Complainant.

Other factors suggesting an Abusive Registration include the Respondent using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This paragraph contains the best guide as to what does not constitute an Abusive Registration and is dealt with further below.

Discussion

The Domain Name incorporates the Complainant's mark and is very much its dominant element, being a mark of world-wide fame placed first in the Domain Name. It is then followed by a descriptive geographic indicator. There is clearly a likelihood that internet users will be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The likelihood of

confusion is compounded by the Domain Name following an identical format to other domain names registered by, or on behalf of the Complainant, namely the mark "Porsche" followed by the name of the city or area in which a Porsche Centre is located. It matters not whether there is yet a Porsche Center in Portsmouth – internet users, if aware of the 'house' style or format of domain names used by the Complainant, will think it even more likely, if typing a domain name in that house style, that they will be visiting a website of the Complainant, or at least one associated with the Complainant.

Even if, once the internet user arrives at the website to which the Domain Name resolves, they immediately realise that it is not the website of the Complainant (and given the parking page's reference to Aston Martin cars, an internet user is likely to realise very quickly), the fact that there has been this initial confusion, or 'initial interest confusion' as it has come to be known, can provide a basis for a finding of Abusive Registration. As paragraph 3.3 of the Nominet DRS Expert Overview puts it:

"..... the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name."

On the face of it therefore, absent any persuasive countervailing factors, there are grounds for a finding of Abusive Registration on the basis that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise

connected with the Complainant. In these circumstances it is unnecessary to go on to consider in any detail whether there might be any alternative grounds for such a finding. However, it should be said that in the Expert's view, it does seem strange, absent any proper explanation from the Respondent, that she should register a domain name incorporating the Complainant's mark and in doing so adopt precisely the format adopted by the Complainant, (mark followed by geographic indicator), if it wasn't to block registration of the Domain Name by the Complainant. Her precise level of knowledge as to the Complainant's plans for a Porsche centre in Portsmouth would matter not if her primary intention was to prevent the Complainant registering the Domain Name should the Complainant wish to do so at some point in the future.

Given the above, the Expert must now examine, the Complainant having established that the Respondent has a case to answer, whether the Respondent has an answer to the case.

Such an examination invariably involves a review of Paragraph 4 of the Policy. It is that paragraph which sets out matters which, if established to the satisfaction of the Expert, are likely to be regarded as a satisfactory answer to the Complainant's case. However, the matters set out therein are not exhaustive and the Panel is entitled to examine any suggested countervailing factors raised by the Respondent. Nevertheless, Paragraph 4 is a good starting point.

Paragraph 4(a) of the Policy provides:

"A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. used or made 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 or services;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

C. made legitimate non-commercial or fair use of the Domain

Name; or

ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it

iii.....”

As Paragraph 2 (and indeed the examples of countervailing factors in Paragraph 4) of the Policy makes clear, an Expert must consider the question of Abusive Registration by examining the “..Domain Name, in the hands of the Respondent...” (emphasis added). Thus one must examine the actual Respondent in the case and the actual use or otherwise made by that Respondent, not a hypothetical Respondent or hypothetical uses by the actual Respondent. It should be unsurprising that a domain name could be an Abusive Registration in the hands of one Respondent but not another, or that a finding of Abusive Registration could have been avoided by a Respondent using a domain name in a different way.

What is surprising therefore is that the Respondent has made no attempt to answer the Complainant’s case by seeking to justify her actual use of the Domain Name, particularly given, as the Policy makes clear (Paragraph 4.e.), that earning click-per-view revenue from connecting domain names to a parking page is not in itself objectionable. Instead, however, the Respondent has focused on use of “Porsche” as a person’s name, even though it is not the Respondent’s name and there is no stated connection between the name “Porsche” and the Respondent. Also, in a further argument similarly divorced from the circumstances of these proceedings, the Respondent has raised the question “Would the town of Portsmouth not have equal rights to the ownership of it’s name in conjunction with the complainants own?”.

Neither approach advances any answer to the Complaint. Perhaps the Respondent appreciated, given the use to which she had put the Domain Name, that it would be difficult to argue that her use was non-commercial, fair or in respect of a genuine offering of goods or services.

In any event, whatever the Respondent’s motivation for not explaining and attempting to justify her actual use of the Domain Name, the Expert finds little difficulty in concluding that there is sufficient evidence to support a finding of Abusive

Registration.

7. Decision

The Expert finds that the Complainant has rights in a name or mark that is similar to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name, <porscheportsmouth.co.uk>.be transferred to the Complainant.

Signed Jon Lang

Dated 23 January 2012