

## DISPUTE RESOLUTION SERVICE

D00010660

### Decision of Independent Expert

We Buy Any Car Limited

and

Mr Alan Quinn

#### **1. The Parties:**

Complainant: We Buy Any Car Limited  
Nixon Street  
Rochdale  
Lancashire  
OL11 3JW  
United Kingdom

Respondent: Mr Alan Quinn  
Vale Chambers 462a Didsbury Road  
Heaton  
Mersey  
Merseyside  
Stockport  
SK4 3BS  
United Kingdom

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

webuyanycarnorthwest.co.uk

#### **3. Procedural History:**

15 December 2011 14:22 Dispute received  
15 December 2011 14:24 Complaint validated

16 December 2011 12:06 Notification of complaint sent to parties  
05 January 2012 10:14 Response received  
05 January 2012 10:15 Notification of response sent to parties  
10 January 2012 12:00 Reply received  
10 January 2012 12:01 Notification of reply sent to parties  
10 January 2012 12:01 Mediator appointed  
13 January 2012 10:00 Mediation started  
27 January 2012 10:24 Mediation failed  
27 January 2012 10:24 Close of mediation documents sent  
06 February 2012 11:33 Expert decision payment received

#### **4. Factual Background**

The Complainant is a company operating using the name or style “WE BUY ANY CAR” since August 2006 and trading in the United Kingdom in the business of buying motor vehicles from consumers for resale. The Complainant has acquired registration of various trade marks as follows:

##### **UK –Trade Marks**

2445197 WEBUYANYCAR.COM & DEVICE in classes 12, 35, 36, 37 and 39

2442651 WEBUYANYCAR.COM & DEVICE (series of 2) in classes 12, 35, 36 and 37

2457645 WEBUYANYCAR.COM & DEVICE (series of 2) in class 39

2541783 WEBUYANYCAR.COM (stylised) in class 35

2560838 WEBUYANYCAR.COM in classes 35 and 36

2541784 WEBUYANYVAN.COM & DEVICE in classes 12, 35, 36, 37 and 39

##### **Europe – Community Trade Marks**

008946303 WEBUYANYCAR.COM & DEVICE in classes 12, 35, 36, 37 and 39

009431131 WEBUYANYVAN.COM & DEVICE in classes 12, 35, 36, 37 and 39

The Respondent has set up a website to which the Domain Name resolves for what appears to be the same or a similar trading purpose of buying cars on or about 4 January 2011.

## 5. Parties' Contentions

### Complaint

The Complainant observes that the Domain Name was granted registration on 4 January 2011, whereas its Trade Marks 2442651, 2445197 and 2457645 were all filed and registered prior to that date. The Complainant says that its Trade Mark 2560838 was filed on 7 October 2011 and granted registration on 3 June 2011 and furthermore that its Trade Marks 2541783 and 2560838 achieved registration by virtue of their having acquired distinctiveness through use. Moreover, the Complainant says that its Trade Marks 2541783 and 2560838 achieved registration after the submission of substantial evidence from first use in August 2006 up to the date of filing. The Complainant submits that this is evidence of the marketing and advertising campaigns run by the Complainant with respect to WEBUYANYCAR.COM.

The Complainant says that its statutory and common law rights as described are highly similar, if not identical in dominant elements, to the Domain Name. The Complainant observes that the addition of "northwest" is merely a geographical indicator and provides no distinction; indeed, a consumer would presume that the Domain Name was simply the Complainant's northwest regional business. The Complainant goes on to say that the mere addition of "northwest" does nothing effectively to distinguish the Domain Name from the Complainant's Trade Marks: an average consumer's eye would not notice "northwest" as it is commonplace and a descriptive term. The Complainant feels that, in terms of the phonetic similarities, the consumer would pronounce the Domain Name as "webuyanycar" as a consequence of the Complainant's advertising campaigns and consumers' familiarity with the brand of WEBUYANYCAR. The Complainant fears that, for the purposes of a domain name, the average consumer would be confused since the average consumer pays little attention to the spelling of a URL web address, and the only distinction is non-distinctive as a geographical term.

The Complainant submits that, at the time of registration (4 January 2011) and as a result of subsequent use, the Domain Name is an Abusive Registration as it has taken unfair advantage of and is detrimental to the Complainant's statutory and common law rights.

The Complainant asserts that the Respondent was no doubt aware of the Complainant's rights and trading activities using the Trade Marks, which had been intensive. By the time of registration, the Complainant gives evidence that it had been using the Trade Marks for many years and built up significant business in the UK and had further undertaken large scale promotional campaigns including TV and radio. It would be impossible, according to the Complainant, for any motor trader not to know of the Complainant's activities using the Trade marks WEBUYANYCAR and WEBUYANYCAR.COM since August 2006. The Complainant refers to evidence that it undertakes large scale advertising campaigns in the national press e.g. the Sunday Times and on TV e.g. sponsoring the motor programmes on the cable channel DAVE.

The Complainant says that the Respondent's use of the Domain Name following registration is unfair as he is using it to offer the services of purchasing cars and so actively trading under the Domain Name. The Complainant refers to the webpage to which the Domain Name resolves which uses WEBUYANYCAR and in smaller letters NORTHWEST. Furthermore, the Complainant observes that the Respondent on his website is using WEBUYANYCAR in bold letters and uses the same alternating colour style as used by the Complainant. According to the Complainant, this creates an impression of association with the Complainant commercially and economically. The Complainant says that the Respondent is "piggybacking" on the Complainant's rights and branding campaigns, associating himself with the Complainant, causing detriment to the Complainant's brand. The Complainant fears that the Domain Name is being used to lure consumers to the website and is being used abusively.

The Complainant says that the Respondent has not accepted a fair offer to buy the Domain Name. The Complainant asserts that the Respondent is using the Domain Name in order to carry on the same business as the Complainant i.e. buying cars, well knowing the Complainant's position in the marketplace and branding jingle. The Complainant's position is being tarnished by the connection and continues to be so tarnished, according to the Complainant. The Complainant says that the Respondent is continuing to use the Domain Name, which will confuse users, even by initial interest confusion as a result of the near identical nature of the Domain Name to the Complainant's statutory and common law rights.

The Complainant says that the Respondent is continuing to profit from the Domain Name's use without any promotion, as he has admitted. The Complainant concludes that the Respondent registered the Domain Name as an abusive registration, as he must have been aware of the Complainant's rights and his subsequent use and continued active home page of the Domain Name shows that it is still being used as an Abusive Registration and is simply copying the Complainant's established rights.

## **Response**

The Respondent states that he contacted WEBUYANYCAR.COM to see if they would be interested in buying the Domain Name. The Respondent says that the Complainant's representative emailed him to say that the Complainant was interested but the Complainant was not prepared to offer an amount acceptable to the Respondent.

The Respondent says that the Complainant's representative has threatened to sue the Respondent. The Respondent objects to being bullied in this way.

## **Reply**

The Complainant refers to the evidence in the Complaint. The Complainant agrees that it is correct that the parties could not come to terms about the price to be paid by the Complainant for the Domain Name.

The Complainant's representatives told the Respondent that a Complaint would be filed with Nominet with regard to the Domain Name.

The Complainant repeats that the Domain Name was registered on 4 January 2011 which is after establishment of the Complainant's rights.

The Complainant also observes that the Respondent has active content using the Domain Name and so is trading commercially, making it highly likely to cause confusion in the marketplace among consumers.

## **6. Discussions and Findings**

The Complainant in a complaint under the DRS Policy must establish two things: firstly, that he has "Rights" as defined by the DRS Policy and, secondly, that the registration or use of the Domain Name by the Respondent is an "Abusive Registration", again, as defined by the DRS Policy. These two issues must be analysed in order.

### **Rights**

"Rights" are defined by the DRS Policy (paragraph 1) as meaning, "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning". By paragraph 2 of the DRS Policy, the Complainant has the burden of proving that he "has rights in respect of a name or mark which is identical to or similar to the Domain Name".

The Complainant has produced a plethora of material relating to its registration of trade marks both in the UK and in Europe. Those trade marks are in respect of both "WEBUYANYCAR.COM" and "WEBUYANYCAR", both alone and in conjunction with a device (or "logo"). Where the words occur in conjunction with a device, then the words appear prominently together with a depiction of a car in side view, or a line of cars and vans in side view. Where the trade mark relied on is "WEBUYANYVAN.COM", the device represents (as may be expected) a series of trucks and vans in side view. In all cases where the words appear with a device, the words are at least as big as the device and in all cases form a prominent part of it.

The Complainant has also produced a witness statement by Paul Coulter, head of marketing with the Complainant, who details the marketing efforts undertaken by the Complainant in the area of securing, maintaining and advertising the various trade marks. He also sets out some of the particulars relating to the marketing and advertising undertaken by the Complainant. He refers to extensive bundles of material put together by the Complainant

evidencing the various activities described in the Complaint and in Mr. Coulter's witness statement. Those activities are broad indeed, taking in the internet, broadcast and print media.

In a very short Response, the Respondent has not done anything to challenge or dispute the evidence adduced by the Complainant. Having looked through the exhaustive evidence submitted by the Complainant, I see no reason to doubt any of it and I accept what the Complainant says in relation to this issue.

While the words alone ("WEBUYANYCAR") might be thought to be commonplace and descriptive, on the balance of probabilities I would accept that common law rights have vested in them since 2006 sufficient to bring them within the definition of "Rights" in the DRS Policy. While the words might well have started as being entirely descriptive of the business undertaken by the Complainant, I accept that, on the basis of the extensive evidence adduced by the Complainant as to the advertising of those words with reference to the Complainant's business, they have come to refer to a specific business i.e. that undertaken by the Complainant. They are words, in short, which have acquired a secondary meaning beyond the original, descriptive meaning.

In any case, the Complainant has produced comprehensive evidence of registration of marks both with a device and without. Even when the words appear with a device, the words are a prominent part of the trade mark as a whole. There can be no doubt that the Complainant has shown that it has rights in those marks, both at the UK and European levels.

When it comes to the question of whether the Rights are in respect of a name or mark which is identical to or similar to the Domain Name, the words include at the end ".COM" but otherwise are identical to the opening element of the Domain Name. Indeed the only difference is the geographical identifier ("NORTHWEST"). The difficulty, to my mind, of adding a geographical identifier to the words constituting the Complainant's Rights is that the Domain Name will likely appear to the average consumer as closely linked to the Domain Name – as if it were just the north western part of the Complainant's whole operation. In other words, while the words protected by the Rights are not identical to the Domain Name, they are similar to it.

That being so, I conclude that the Complainant has Rights as required by the DRS Policy, and that those Rights are in respect of a name or mark similar to the Domain Name.

That does not of itself answer the next question, which is whether the Respondent's use of the Domain Name is an Abusive Registration.

### **Abusive Registration**

The DRS Policy (paragraph 1) defines "Abusive Registration" as 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 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"

Paragraph 3 of the DRS Policy sets out a non-exhaustive list of factors pointing to Abusive Registration. These include where the Domain Name has been registered or acquired

- Primarily for the purpose 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
- Primarily for the purpose of unfairly disrupting the business of the Complainant

Other factors pointing to Abusive Registration include the Respondent's 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.

As against paragraph 3, paragraph 4 of the DRS Policy provides a list of non-exhaustive factors pointing to the absence of an Abusive Registration.

I will deal with the factors under each of these paragraphs separately.

### **Paragraph 3 of the DRS Policy**

Looking at the evidence, I conclude that there is a clear likelihood that internet users arriving at the Respondent's website using the Domain Name will be confused into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant. I reach this conclusion on the basis of the evidence of the similarity of the two businesses which the Complainant and the Respondent are operating and the very close similarity of the words included in the Domain Name and the Complainant's Rights.

I do not regard this as a case of mere "initial interest confusion" – which happens where internet users find themselves on the Respondent's website by following the Domain Name and then quickly realise that the website operated by the Respondent is in reality nothing to do with the Complainant. In this case, such is the similarity of the Rights and the Domain Name and the similarity between the two businesses, that internet users following the Domain Name are likely to think that they have reached a website operated

by the Complainant but dedicated to a particular geographical area namely the North West.

I have concluded that the Respondent's operation of a website for the purpose of trading in cars using a name which is almost identical with the Complainant's Rights (save for a geographical description) is highly likely to draw custom away from the Complainant and unfairly disrupt its business by causing internet users to believe that the Respondent's business is in some way connected with that of the Complainant.

The Complainant also makes the point that the Respondent has refused its offer of £500 for the transfer of the Domain Name and has instead held out for £5,000. At Exhibit PC11 of Mr. Coulter's witness statement, there is included an email exchange between the Respondent and the Complainant's representatives. It starts with an offer on 24 August 2011 from the Respondent to sell the Domain Name to the Respondents. In that email, the Respondent states, "hi webuyanycar i have a web address for sale called [www.webuyanycarnorthwest.co.uk](http://www.webuyanycarnorthwest.co.uk) if this web address is any good for you please email be back [all sic]".

The Complainant's representatives replied on 1 September 2011 with an offer of £500, which was immediately rejected by the Respondent. After further exchanges and negotiations, the Respondent replied on 8 September 2011 saying, "ok I will try selling it to one of the other car buyers ..."

I take into account that the initial approach was made by the Respondent and that it took place not long after the registration of the Domain Name. I also take account of the extensive evidence submitted by the Complainant about its activities in marketing and advertising their Rights and the scale of its business, as set out in Mr. Coulter's witness statement and its exhibits. I accept the Complainant's submission that it is unlikely that the Respondent would not have heard of the Complainant and did not know of its activities at the time he registered the Domain Name. I have no evidence of the scale of the Respondent's costs of registration but they are unlikely to have been £5,000 or even near that sum. I conclude from all these various matters that the Respondent did indeed primarily register the Domain Name with a view to selling it to the Complainant or a third party for a sum in excess of his out-of-pocket costs in acquiring the Domain Name.

#### **Paragraph 4 of the DRS Policy**

There are other factors to be taken into account and paragraph 4 of the DRS Policy sets out other factors which point to its not being an Abusive Registration.

When it comes to a consideration of whether any factors are present which come within paragraph 4, given the dearth of evidence submitted by the Respondent, and the paucity of his submissions, it is simply not possible from what the Respondent says to determine whether any of those factors are here present or not. Reviewing the evidence and submissions submitted by the



Complainant, it does not seem to me, with one exception, that there is any basis for any finding that any of the factors in paragraph 4 come into play.

The only factor there set out which may come into play is that set out at paragraph 4.a.ii of the DRS Policy which states, “[t]he Domain Name is generic or descriptive and the Respondent is making fair use of it”.

I can see that the Domain Name might be regarded, in a sense, as generic or descriptive, since it simply provides that the registrant of the Domain Name will buy any car and goes on to suggest that this activity takes place in the North West. I note the comments of Expert in DRS No. 4620 where he quotes from the decision of the Appeal Panel in DRS 03316, “the mere fact that a generic word happens also to be a trade mark cannot lead to the trade mark owner monopolising all uses of the word. Certainly for the purpose of complaints under the DRS Policy, there has to be something more”.

However, as I said above, I accept the Complainant’s evidence regarding its extensive advertising and marketing of its Rights and I conclude that it would have been impossible for anyone involved in the car trade not to have heard of the Complainant; indeed, such is the scale of the advertising that it would be hard for anyone not to have some idea of the Complainant’s Rights and the business operated by it. I take account of the fact that the Respondent’s business as disclosed by the website to which the Domain Name resolves is ostensibly similar or well-nigh identical to that of the Complainant: it sets out a three-stage procedure for the selling of cars to the Respondent. For all intents and purposes, it is a business in direct competition with that operated by the Complainant. For these reasons, I do not accept that the Complainant’s use of the Domain Name is fair and the factor under paragraph 4.1.ii is therefore not made out.

For all the reasons given above, I find that the Domain Name is an Abusive Registration in the hands of the Respondent.

## **7. Decision**

I direct that the Domain Name should be transferred to the Complainant.

**Signed Richard Stephens**

**Dated 1 March 2012**