

DISPUTE RESOLUTION SERVICE

D00011223

Decision of Independent Expert

Bayerische Motoren Werke Aktiengesellschaft

and

Mr Paul Miles

1. The Parties:

Lead Complainant: Bayerische Motoren Werke Aktiengesellschaft
BMW - Haus
Petuelring 130
Munich
Germany

Complainant: Rolls-Royce Motorcars Limited
Ellesfield Avenue
Bracknell
Berkshire
RG12 8TA
United Kingdom

Respondent: Mr Paul Miles
Warfield Cottage
Shorland Oaks
Warfield
RG42 2JZ
United Kingdom

2. The Domain Name(s):

rollsroycephantomhire.co.uk

3. Procedural History:

17 April 2012 16:50 Dispute received
18 April 2012 10:28 Complaint validated
18 April 2012 10:33 Notification of complaint sent to parties
08 May 2012 02:30 Response reminder sent
11 May 2012 10:34 No Response Received
11 May 2012 10:35 Notification of no response sent to parties

23 May 2012 02:30 Summary/full fee reminder sent
28 May 2012 11:54 No decision payment was received
29 May 2012 12:31 Dispute opened
29 May 2012 16:02 Expert decision payment received

4. Factual Background

- 4.1 The Complainants are both members of the BMW group of companies. In this decision they will be referred to respectively as BMW AG and RPMC.
- 4.2 RPMC is a wholly owned subsidiary of the German company BMW AG. RPMC is incorporated under the laws of England and Wales.
- 4.3 BMW AG is a well-known multi-national corporation which manufactures, distributes and markets BMW and MINI motor cars. RPMC is responsible for the manufacture of all Rolls-Royce motor cars in the UK, and for marketing and selling those cars throughout the world, both directly and through a network of authorised dealers. Rolls-Royce is a premium brand of motor cars.
- 4.4 RPMC is the registered proprietor of the word mark ROLLS-ROYCE. BMW AG is the registered proprietor of other marks used in connection with Rolls-Royce motor cars, including the mark PHANTOM. BMW AG licences RPMC to use the mark PHANTOM on and in connection with Rolls-Royce motor cars.
- 4.5 The mark ROLLS-ROYCE was first registered for motor cars in 1907, and first used on motor cars in 1904. The mark PHANTOM was first used in relation to the motor cars built by Rolls-Royce in 1925, and has been used on a range of Rolls-Royce motor cars since. BMW acquired the PHANTOM trademark in 2003, at the same time of RPMC introducing its first motor car under the new ownership of BMW AG, the Rolls-Royce Phantom.
- 4.6 Both the ROLLS-ROYCE and PHANTOM brands are extensively advertised and promoted throughout the world in a variety of media (including through RPMC's website at www.rolls-roycemotorcars.co.uk).
- 4.7 As part of their policy of protecting their rights in the marks in question, the Complainants seek to control ownership and use of primary domain names which refer directly to ROLLS-ROYCE, or to ROLLS-ROYCE and PHANTOM.
- 4.8 The Respondent is an individual based in Berkshire, who appears to have been involved in a number of car sale and car hire businesses. He registered the Domain Name on 5 June 2007.
- 4.9 The Complainants first became aware of the Respondent and the Domain Name in April 2010, when an employee of RPMC came across the website at the Domain Name. The Complainants' solicitors wrote to the Respondent, alleging trade mark infringement and passing off, seeking undertakings including the transfer of the Domain Name. After several months and a number of chasing letters the Respondent replied to the solicitors stating that he no longer owned the Domain Name, and claimed to have transferred it to a Mr. Tej Randeve in January 2010. As a result, the Respondent claimed that he was no longer able to transfer the Domain Name to the Complainants.

- 4.10 Subsequently, the Respondent has claimed that he is unable to transfer the Domain Name or make amends to the Registrant's details held by Nominet, on the basis that only Mr. Tej Randeva has access to the website and the Domain Name.
- 4.11 The Complainants' solicitors then wrote to Mr. Tej Randeva alleging trade mark infringement and passing off, seeking undertakings. On 5 July 2011 Mr. Randeva contacted the Complainants' solicitors to confirm that he had purchased the Domain Name, and that he had paid a sum of money for the Domain Name and it was worth a lot of money to him. Therefore, he did not want to cancel the Domain Name, nor transfer it to the Complainants. According to the Complainants' solicitors' attendance note of the conversation, he made a number of suggestions as to the Complainants either allowing him to continue to use the Domain Name, or that there be a three month grace period in which the Domain Name could be connected to a new domain name, or that the Domain Name should be allowed to connect to one of the Complainants' websites, but that Mr. Randeva be allowed to keep ownership of the Domain Name.
- 4.12 Those various proposals were unacceptable, as the Complainants' solicitors informed Mr. Randeva on 14 July 2011. At the time, the Domain Name was used in connection with a Cars for Stars website (which offered a chauffeured car hire service). The Complainants' solicitors suggested that Mr. Randeva be allowed to continue to use the Domain Name for three months, in connection with the Cars for Stars website. After that, all use of the Domain Name should cease, and Mr. Randeva should allow the Domain Name to lapse when it became due for renewal. There has been no response to that letter.
- 4.13 The Domain Name now directs to a different website www.rentaroller.co.uk, which displays a range of hire services in various locations across the United Kingdom, including Rolls-Royce motor car hire. None of the hire businesses are authorised Rolls-Royce car dealers, or connected to RRMC.
- 4.14 The Domain Name remains registered in the name of the Respondent, not Mr. Randeva.

5. Parties' Contentions

Complainants' Submissions

Rights

- 5.1 The Complainants rely upon the registrations of ROLLS-ROYCE and PHANTOM referred to above and say that the Domain Name "consists solely of a combination of the Complainants' marks". The only minor difference is the removal of the hyphen between "ROLLS" and "ROYCE".

Abusive Registration

- 5.2 The Complainants say that the Respondent has never sought to explain or justify the registration and the use of the Domain Name, and there is no

obvious justification for it. Accordingly, the Complainants rely on the presumption established in DRS00292 Chivas Brothers Limited –v- David Plenderleith (and subsequently) that it will ordinarily be reasonable for an Expert to infer that the Respondent registered the Domain Name for an abusive purpose.

- 5.3 The Complainants also assert that there is overwhelming evidence that the registration of the Domain Name is an Abusive Registration under paragraphs 3.a.i.B, 3.a.i.C and 3.a.ii of the Nominet Dispute Resolution Policy (“the Policy”).
- 5.4 The Complainants say that the registration unfairly disrupts the business of the Complainants, and confuses customers. The Domain Name is used as a URL and as a trading name to advertise services which are not connected with the Complainants. Any web traffic going to the Domain Name must intend and expect to find RPMC’s website or a website authorised or approved by RPMC. The Domain Name must have been used therefore for the purposes of trying to attract customers, and to divert them from RPMC, rather than for information purposes. This dilutes the strength of the Complainants’ marks, and is disruptive to RPMC’s business by preventing prospective customers from obtaining information on RPMC’s own goods and services.
- 5.5 A substantial proportion of consumers in the UK would assume that the use of the words Rolls-Royce and Phantom in a domain name would suggest a connection or association in the course of trade with RPMC. Although the Domain Name is used for car hire services (for which the Complainants’ marks are not registered), car hire services are services relating to motor cars and are therefore similar services to those for which the marks are registered. Members of the public would have assumed (wrongly) that the Domain Name was either in use by RPMC, or otherwise licensed or authorised by RPMC. Once on the website, the use of trade marks in the trading names, and the use of a Phantom RR logo do nothing to dispel that impression.
- 5.6 The Complainants contend that the registration and use by the Respondent of the Domain Name constitutes trademark infringement pursuant to Section 10(3) of the Trade Marks Act 1994, where registration, use and retention of the Domain Name is without due cause, and also in order to “free-ride” off the reputation associated with the Complainants’ trademarks in order to attract customers. The registration, use and retention of the Domain Name is also said to constitute passing off.
- 5.7 Finally, the Complainants claim that the registration and renewal of the Domain Name is a blocking registration, in denying the Complainants the right to register the Domain Name for their own legitimate use.
- 5.8 The Complainants seek transfer of the Domain Name to themselves.

The Respondent’s Submissions

- 5.9 The Respondent has not replied.

6. Discussions and Findings

- 6.1 In order to succeed in these proceedings, paragraph 2.b of the Policy requires the Complainants to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that :
- i. the Complainants have Rights in respect of names or marks which are identical or similar to the Domain Name; and
 - ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

- 6.2 The Complainants have set out extensively their trade mark rights in respect of both ROLLS-ROYCE and PHANTOM, and provided extensive evidence to demonstrate the recognition of both of those marks separately, and as a combination of the two marks. The Expert agrees with the Complainants that the hyphen in the Rolls-Royce name is immaterial for these purposes. The Complaint does not, however, address the relevance of the addition of the word "hire" as part of the Domain Name. Although it is not clear to the Expert why that point has not been addressed in what is otherwise a lengthy Complaint, it seems to the Expert that the addition of "hire" is essentially only descriptive of the services offered by the Respondent, or Mr. Randeva, and does not alter the conclusion that the Complainants have rights in the marks ROLLS-ROYCE and PHANTOM, which in combination are similar to the Domain Name. The Complainants therefore have Rights for the purposes of paragraph 2.b of the Policy.

Abusive Registration

- 6.3 The Policy contains, in paragraph 3.a, a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Although the Complainants have also referred to both trade mark infringement and passing off, neither is directly relevant to a finding of Abusive Registration under the Policy and the Expert does not therefore propose to address those issues separately.
- 6.4 According to the evidence submitted by the Complainants, the Domain Name has been used for a website, which includes the trading name "Rolls-Royce Phantom Car Hire". The company behind that trading name appears to be Cars for Stars Limited. The Complaint exhibits copies of pages from the website dated 17 October 2011. At that time, it would appear that the cars which were for hire were all Rolls-Royce Phantom cars. More recently, as is described above, the Domain Name has been pointed to the www.rentaroller.co.uk website, on which, in addition to Rolls-Royce Phantom cars, other Rolls-Royce cars seem to be available for hire, as well as vintage, classic and other luxury car makes from other manufacturers. The trade name "Rolls-Royce Phantom Hire" is again used, as is the trade name "Rent a Roller".
- 6.5 It seems to be the case from the evidence attached to the Complaint that the person behind those websites is Tej Randeva, and not the Respondent himself. In the correspondence attached to the Complaint, the Respondent has asserted on a number of occasions that he has sold the Domain Name (with other domain names) to Mr. Tej Randeva, and that the Complainants'

course of action should be to deal with Mr. Randeva, rather than him. It also appears to have been explained to the Respondent on a number of occasions that he would have to initiate any transfer of ownership of the Domain Name through Nominet to Mr. Randeva, in order to change the registrant details in Nominet's records. However, he has failed to do so. Mr. Randeva, for his part, obviously wanted to try to hold onto the Domain Name when he contacted the Complainants' solicitors, because he thought it was of value to him in relation to his chauffeured car hire business.

- 6.6 It does not seem to be disputed that the use of the Domain Name is for a genuine chauffeured car hire site. However, it equally seems to be clear (particularly in the absence of a response from the Respondent) that the use of the "ROLLS-ROYCE" and "PHANTOM" brand names for those purposes is not authorised or approved of by the Complainants.
- 6.7 In adopting and using a Domain Name which incorporates the two brand names of the Complainants, with the addition of only the descriptive suffix "hire", it would appear very likely that the Respondent and/or Mr. Randeva intended to take advantage of the repute of the Complainants' trademarks, to lead traffic directly to the site, and in the Expert's opinion to suggest an association or connection with the Complainants when no such association or connection existed. The Expert agrees with the Complainants that, in those circumstances, the onus is upon the Respondent to explain his position, and to justify the registration and use of the Domain Name (if there is an appropriate justification or explanation). In the absence of such justification or explanation, it would ordinarily be reasonable for an Expert to infer that the registration was for an abusive purpose. As there is no such justification or explanation provided in this case or in the preceding correspondence, the Respondent has not rebutted that inference.
- 6.8 Therefore, the Expert finds that the Complainants have made out the factor set out in paragraph 3.a.ii of the Policy, namely: "circumstances indicating that the Respondent is using or is 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".
- 6.9 The Expert is not convinced by the Complainants' contentions that the registration and use must have been for the purposes of disrupting the Complainants' business (the use appears to the Expert to have been for the purposes of advancing the Respondent's business, rather than hindering that of the Complainants, not least because the Complainants admit that they have not registered the marks for hire services, suggesting that they do not offer a directly competing business to that of the Respondent/Mr. Randeva); nor does it seem likely that the registration was for the purposes of blocking the Complainants from registering the Domain Name themselves (for essentially the same reasons); and, as noted above, allegations of trade mark infringement and passing off are not strictly relevant for the purposes of the Policy.
- 6.10 However, in the absence of any justification or explanation by the Respondent, it is sufficient for the Complainants to prove their case on the balance of probabilities in relation to the factor set out in paragraph 3.a.ii, and the Expert therefore concludes that the registration, in the hands of the Respondent, is an Abusive Registration within the wording of the Policy.

7. Decision

- 7.1 The Expert finds that the Complainants have rights in the marks ROLLS-ROYCE and PHANTOM, which in conjunction, are similar to the Domain Name. The Expert further finds that the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore directs that the Domain Name should be transferred to the lead Complainant, BMW AG.

Signed Bob Elliott

Dated 22 June 2012