

Nominet UK Dispute Resolution Service

DRS 12602

Ford Motor Company

and

Nicholas Horridge, trading as Newford Parts Centre

Decision of Independent Expert

1 Parties

Complainant: Ford Motor Company

Address: One American Road
Dearborn
Michigan

Postcode: 48126

Country: United States of America

Respondent: Nicholas Horridge, trading as Newford Parts Centre

Address: Newford Parts Centre
Abbey Mill
Abbey Village, near Chorley
Lancashire

Postcode: PR6 8DN

Country: United Kingdom

2 domain name

<newfordparts.co.uk>

3 Procedural History

- 3.1 On 13 March 2013 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy ("the Policy") and DRS Procedure ("the Procedure"). Nominet notified the respondent on 14 March 2013. No response was received. The complainant requested referral of the matter for expert decision under the Procedure, and on 17 April 2013 paid the applicable fee.
- 3.2 I was appointed as expert on 22 April 2012. I have made the necessary declaration of impartiality and independence.

4 Factual background

- 4.1 The complainant is an internationally well-known car manufacturer.
- 4.2 The respondent registered the domain name on 25 July 2000.

5 Parties' Contentions

Complainant

- 5.1 The complainant says it has traded since 1903, and first registered the FORD trade mark in the United States in 1909. It has produced documentary evidence of that registration. It has also produced a list of its many trade marks registrations for the mark FORD throughout the world, including in the UK and the EU. It says its name is distinctive and famous, and that it achieved that fame long before the respondent registered the domain name. It says it owns the domain names <ford.com> and <ford.co.uk>, and maintains a website at each.
- 5.2 The complainant argues that the name FORD is the dominant element of the domain name, so the domain name is similar to its trade mark. The addition of the descriptive terms "new" and "parts" does not, it argues, make the domain name different from the complainant's name.
- 5.3 The respondent has, it says, no legitimate interest in the domain name. It is in no way connected to or associated with Ford.
- 5.4 The complainant says the domain name automatically redirects to a website which implies an association with the complainant. The website contains a page headed "Links to other Ford Sites" which it says implies that the respondent's site is a "Ford site".
- 5.5 The complainant argues that the respondent has used the domain name in a way which is likely to confuse internet users into thinking the domain name is connected to the complainant. It says the respondent registered the domain name to take advantage of the complainant's reputation.
- 5.6 The complainant says the respondent's use of the domain name is not made

legitimate by its trading under the name "Newford Parts Centre", since that business name is not being fairly used either. The respondent is using both domain name and its business name to trade off the fame of the complainant.

Respondent

5.7 No response has been provided.

6 Discussion and Findings

General

6.1 Under paragraph 2(a) of the Policy a complainant must show 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, and that
- the domain name, in the hands of the respondent, is an abusive registration.

Rights

6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.

6.3 The complainant has long traded globally under the brand *Ford*, that it has trade marks for that name and that it owns the domains <ford.com> and <ford.co.uk>.

6.4 At the third level (i.e. disregarding "co.uk"), the dominant element of the domain name is the word "ford".

6.5 It might be argued that an alternative reading of the domain name is to be preferred, in which its dominant element is not the complainant's name but an element of the respondent's business name, "Newford". Even if that argument were accepted, it would not follow that this was the only reasonable reading, or necessarily remove any similarity to the complainant's name. But I do not accept it, since it is reasonable in the circumstances of this case to infer that the respondent's business name is itself designed to incorporate the word "Ford" and so indicate the nature of the goods the respondent sells.

6.6 In my view, the inclusion within the domain name of the additional words "new" and "parts" does not make it dissimilar to the complainant's name. On the contrary, the inclusion of the word "parts" in particular strengthens the apparent connection with the car industry, and so if anything reinforces the domain name's similarity to the complainant's name.

6.7 In those circumstances I am satisfied that the complainant has rights in respect of a name which is similar to the domain name.

Abusive Registration

- 6.8 Under paragraph 1 of the Policy, abusive registration means a domain name which either:
- was 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
 - has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.9 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using a domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.

- 6.10 I do not accept the complainant's contention that the respondent's website implies that it has a connection with Ford. While the complainant has produced evidence in the form of screenshots taken in 2010 showing the website as featuring the complainant's oval logo, overall the screenshots it has produced from 2010 and 2013 do not suggest that the respondent's website implies any commercial connection with the complainant. On the contrary, the impression given is that Newford is an independent firm with a history of its own, which is explained on the website. No reader could reasonably think, from its website, that the respondent is associated with the Ford Motor Company.

- 6.11 But given that the domain name includes the complainant's name together with an additional word which strengthens the likelihood of an inference that the domain name is connected to the complainant, and given that goods offered using the domain name – parts for Ford cars – relate to the complainant's goods, in my view some initial interest confusion is likely between the domain name and the complainant.

- 6.12 Generally in relation to the question of abusive registration, the appeal panel in *Toshiba Corporation v Power Battery Inc* (DRS 07991, <*toshiba-laptop-battery.co.uk*>) analysed the principles to be applied when assessing the legitimacy of a reseller's incorporation, within a domain, of the complainant's trade mark. The appeal panel summarised the applicable principles as follows:

1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.

2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.

3. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.

4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.

6.13 The appeal panel went on to explain further its approach to the fourth principle:

The further issue, however, is whether the fact of the offering of competitive products on the Respondent's website is sufficient to render the registration abusive, even in the absence of "initial interest confusion". On this question, the Panel unanimously considers that, if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner's consent, to accord with the principles stated above that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated.

6.14 The appeal panel's decision in that case is not binding on me, but does have persuasive force.

6.15 I have already explained at paragraphs 6.10 and 6.11 my view that some initial interest confusion is likely. Applying the second and third principles set out by the *Toshiba* appeal panel, this is a suggestive of abusive registration.

6.16 But even if I am wrong about initial interest confusion, applying the fourth *Toshiba* principle there is another reason why the respondent's use of the domain name is unfair.

6.17 The screenshots produced by the complainant show that, as well as genuine obsolete Ford parts, the respondent sells through its website generic third-party manufactured "pattern parts" or "after parts", made to be compatible with Ford vehicles. It does not therefore sell only the trade mark owner's genuine products.

6.18 There is in my view room for debate about how the fourth *Toshiba* principle should be applied where a reseller trades in generic "after parts" as well as the trade mark owner's goods.

6.19 On the one hand, generic products may damage the trade mark owner's business significantly if they are sold as direct substitutes for its branded goods.

6.20 On the other hand, if generic products are sold only where the trade mark owner's goods are no longer available then no "substitution" may in fact occur. There may be no "offering of competitive goods", to use the language of the fourth *Toshiba* principle. It would arguably be wrong if the *Toshiba* principles operated so as to allow a trade mark owner to bar another firm from using a domain containing its trade mark but which fairly described the respondent's legitimate business in a secondary market the trade mark owner no longer served.

6.21 Much may depend on the particular nature of the market in question, the need for

buyers to rely on generic products and the extent to which the respondent sells them. As the *Toshiba* appeal panel said, the question of abusive registration will depend on the facts of each particular case.

- 6.22 In this case, the screenshots mentioned above suggest that the respondent only supplies pattern parts in extreme circumstances and as a last resort "when a part is not available". Had the respondent made any response to the complaint, it might have made submissions about the extent of its sales of pattern parts, and the significance I should attach to that.
- 6.23 However, even assuming there is no offering of competitive goods in this case, and that it could be fair for the respondent to carry on its trade using a domain similar to the complainant's name, it does not follow that it would be fair for it to do using the domain name.
- 6.24 In my view it is not fair for the respondent to use the domain name in this way. The domain name <newfordparts.co.uk> is not in my view fairly descriptive of a business selling both obsolete Ford parts in the strict sense, and pattern parts for use in vintage Ford cars. I am influenced in reaching this view by three factors. First, it is not clear that obsolete Ford parts can fairly be described as "new". Second, not all the parts sold by the respondent are "Ford parts" in the strict sense; what it sells might arguably be more fairly described as "parts for Fords". Thirdly, the inference that the respondent's business name is itself designed to incorporate the complainant's name (an inference I think reasonable in the circumstances, as I said at paragraph 6.5) slightly influences my feeling that the way the respondent presents its business using the domain name is not completely fair.
- 6.25 Therefore, and because of my view on initial interest confusion, it is not necessary for me to depart from the *Toshiba* principles or to modify their application.
- 6.26 To summarise my conclusions, there is some risk of initial interest confusion, which is evidence of abusive registration. Applying the *Toshiba* principles, this initial interest confusion suggests abusive registration, and the respondent's use of the domain name is also unfair because it does not use it only to sell the complainant's genuine products.
- 6.27 In my view therefore, the respondent appears in the circumstances to have used the domain name in a manner which has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.
- 6.28 It is for the complainant to make good its case. However, for the reasons I have given the evidence before me establishes a prima facie case of abusive registration. The respondent has provided no response.
- 6.29 In those circumstances therefore I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

7 Decision

- 7.1 I find that the complainant has rights in a name which is similar to the domain name; and that the domain name, in the hands of the respondent, is an abusive registration.
- 7.2 The complaint is upheld. I direct that the domain name be transferred to the complainant.

Carl Gardner

14 May 2013