

DISPUTE RESOLUTION SERVICE

Joined cases D00015623/15624

Decision of Independent Expert

RAC Motoring Services Limited

and

Mr Andrey Shevchenko (case D0015623)
S. Birrell (case D0015624)

1. The Parties:

Complainant: RAC Motoring Services Limited
RAC, Great Park Road
Bristol
BS32 4QN
United Kingdom

Respondent (1): Mr Andrey Shevchenko
Domain Administrator
Mir Telematiki
19/2 Lva Tolstogo st.
Moscow 119034
Russian Federation

Respondent (2): S. Birrell
<removed address>

2. The Domain Name(s):

rac-online.co.uk
rac-ms.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

11 March 2015 12:32 Disputes received
11 March 2015 14:26 Complaints validated
11 March 2015 14:30 Notification of complaints sent to parties
25 March 2015 D0015623 and D0015624 merged by Nominet
02 April 2015 02:30 Response reminder sent
07 April 2015 09:12 No Response Received
07 April 2015 09:12 Notification of no response sent to parties
07 April 2015 11:43 No Response Received
07 April 2015 11:52 Notification of no response sent to parties
16 April 2015 11:35 Expert decision payment received

4. Factual Background

This is a merged case involving two separate Complaints by the same Complainant, where the Respondents are nominally different, but where the Complaints concern domain names linked to what appears to be an identical website. Nominet decided to merge the two cases in view of the identity of the website in question, at the request of the Complainant. Both cases are non-response cases.

The Complainant is a well-known British automotive services company that trades under the name "RAC". It is wholly owned by the private equity firm The Carlyle Group. It was founded in 1897 as the Royal Automobile Club, and the Complainant body was incorporated as an associate section in 1978. It provides motoring services to private and business motorists, including breakdown cover with roadside assistance, insurance, assistance with purchasing a used car, vehicle inspections and checks, legal services and traffic and travel information.

The Respondents appear both to be individuals: the First Respondent (the registrant of rac-online.co.uk) giving an address in the Russian Federation, and the Second Respondent (the registrant of rac-ms.co.uk) giving an address in Scotland.

At the time of the Complaints, both Domain Names pointed to a website, which was headed with the RAC trade mark, and which purported to offer a service called RAC Protection, to act as a neutral third party to monitor and transact the exchange of payment and vehicle between buyer and seller of a motor vehicle. The scheme would involve the provider of the service being paid by the buyer, and holding the money on the buyer's behalf, until the buyer confirms acceptance of the vehicle, having had the opportunity to inspect it. Neither Domain Name currently connects to that website, apparently following take-down notices from the Complainant addressed to Nominet.

5. Parties' Contentions

The Complainant

Rights

The Complainant has over 8 million members using its services, and in 2014 its patrol force attended to 2.3 million rescue missions. It owns a number of domain names incorporating the RAC trade mark, including the domain name used for its website, rac.co.uk. It has used the RAC trade mark for not less than 24 years, and has registered the RAC word mark in at least 12 classes of goods and services, in both the UK and the Republic of Ireland.

The Complainant therefore claims to have Rights under the DRS Policy in the name or mark RAC, which it says is similar to the Domain Names, as (1) the addition of the suffix .co.uk is of no relevant significance, and wholly generic, (2) the hyphen in both cases can be disregarded, (3) the capitalisation of its trade mark should be ignored as domain names only incorporate lower case letters in their alphanumeric string, and (4) "online" and "ms" do nothing to distinguish the Domain Names from its RAC trade mark, as generic and descriptive terms, when the only distinctive element is its mark.

Abusive Registration

As to abusive registration, the Complainant says the website offering the RAC Protection service is a scam, which has nothing to do with it, and is designed to use the RAC name to add legitimacy to a scheme inducing unsuspecting potential buyers of motor vehicles to entrust their funds to the operator of the website (wrongly believing it to be connected to the Complainant), with the money disappearing once deposited, and the vehicle never materialising. It is a fraud, and the Complainant provides an example of one such transaction, which involves the Respondents (or, presumably, someone connected with them) using a variety of pseudonyms in email exchanges to protect their identity. The scam has been widely publicised (and involves other reputable motoring and financial organisations as well as the Complainant). At least one person has fallen prey to the scam, which has been reported to the National Crime Agency.

The Respondents have clearly targeted the Complainant and used its trade mark to knowingly and intentionally deceive customers, so as to receive monetary gain. The Complainant relies upon para 3.a.ii of the Policy, and says that the Respondents have used the Domain Names in a way which has confused people into believing that the Domain Names are registered to, or operated or authorised by or otherwise connected with it. It points to its "residual goodwill" in its trade marks, the likelihood of initial interest confusion, and the use of a website which uses the Complainant's colour scheme, layout and official RAC logo. The pages represent themselves as the RAC, when there is in fact no affiliation or association.

The Complainant also contends that this case is one which clearly falls within the general definition in the Policy of Abusive Registration as the Domain Names were

registered, and have been used, in a manner which takes advantage of and is unfairly detrimental to the Complainant's Rights.

The WhoIs contact information given is believed by the Complainant to be incorrect, and in the case of rac-online.co.uk it includes the Complainant's own address.

The Respondents cannot rely upon any of the factors in para 4.a of the Policy to show that this is not an Abusive Registration. This is a scam, not a genuine offering of goods or services, the Respondents have never been commonly known by the Domain Names or legitimately connected with the Complainant's mark, and there is no legitimate non-commercial or fair use of the Domain Names.

The Complainant seeks the transfer of the Domain Names to itself.

The Respondents

Neither Respondent has replied.

6. Discussions and Findings

In order to succeed in its Complaints, in accordance with the Policy, the Complainant needs to establish (in respect of both Domain Names):

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

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is as follows:

"Abusive Registration means 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 of 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".*

The definition of Rights under the Policy is 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."

As to Rights, the Complainant has provided significant evidence of the extent of its trading and goodwill, as well as registered trade marks covering a wide variety of goods and services. The trade mark registrations are in the names of either RAC Brand Enterprises LLP or RAC Motoring Services Limited (the latter being the Complainant). The relationship between the companies is not explained, however, the Expert is prepared to accept that the Complainant has established sufficient

Rights in its own name. The Expert also accepts the (unchallenged) submissions by the Complainant as to the insignificance (in terms of similarity) of capitalisation, and use of hyphens, and the relative unimportance of the additions of “online” and “ms” compared to the RAC brand. Therefore, the Expert finds that the Complainant has established Rights in the name or mark RAC, which is similar to both of the Domain Names.

As to Abusive Registration, the Complainant has provided evidence of what appears clearly to be a fraud, using a website which not only takes advantage of its brand name in the Domain Names used, but also features the RAC brand prominently, and mimics the RAC’s own site in its get-up and overall appearance. In using the Domain Names in this way the Respondents have no doubt been seeking to take advantage of the Complainant’s standing and goodwill to seek to lure customers into the scam. It is difficult (indeed, bordering on the impossible) to think of any way in which this could be legitimate, and the Respondents have not attempted to justify their registration and use of the Domain Names. These Domain Names are therefore very clearly Abusive Registrations both within the general definition of Abusive Registration in the Policy, and within the wording of para 3.a.ii of the Policy upon which the Complainant also relies.

The Expert therefore has no hesitation in concluding that the Complainant has succeeded in its Complaints, and that both Domain Names are Abusive Registrations.

7. Decision

The Expert finds that the Complainant has Rights in the name or mark RAC which is similar to both of the Domain Names, and that the Domain Names in the hands of the respective Respondents are Abusive Registrations. The Expert therefore directs that the Domain Names be transferred to the Complainant.

Signed ...Bob Elliott.....

Dated 30 April 2015