



**NOMINET**

**Dispute Resolution Service**

**DRS 16642**

Arnold Clark Automobiles Ltd.

and

Eric Zhang

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**Decision of Independent Expert**

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**1 Parties**

Complainant: Arnold Clark Automobiles Ltd.

Address: 134 Nithsdale Drive  
Glasgow

Postcode: G41 2PP

Country: United Kingdom

Respondent: Eric Zhang

Address: Tian Hong Shan Zhuang  
Nanjing  
Jiangsu

Postcode: 210049

Country: China

## **2 Domain name**

<arnoldclarkfinance.co.uk>

## **3 Procedural History**

- 3.1 On 16 October 2015 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 the same day. No response was received. The complainant requested referral of the matter for expert decision under the Procedure, and on 9 November 2015 paid the applicable fee.
- 3.2 I was appointed as expert on 13 November 2015. I have made the necessary declaration of impartiality and independence, confirming that I am independent of each of the parties and that 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, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

## **4 Factual background**

- 4.1 The complainant is a big independent car dealership, part of whose business is the provision of loans to car buyers.
- 4.2 The respondent registered the domain name on 22 February 2011.

## **5 Parties’ Contentions**

### *Complainant*

- 5.1 The complainant says it is the owner of trade marks for the mark ARNOLD CLARK.
- 5.2 The complainant argues that the domain name differs from its marks only by the addition of the word “finance”. It says this does not distinguish the domain name from the marks. Indeed, because providing loans is part of its business, the complainant argues that additional word “finance” adds to the potential for confusion between the domain name and its marks.
- 5.3 The complainant argues that the respondent is using the domain name in a way likely to confuse people into believing it is connected with the complainant, since web users are likely to assume they are connected.
- 5.4 It says the respondent has made no attempt to make clear its lack of relationship with the complainant by any disclaimer or other notice on its website.

- 5.5 The complainant says the website associated with the domain name displays “pay per click” advertising links relating to car finance which click through to advertisements about the complainant’s competitors.
- 5.6 It argues that any traffic to the website must have resulted from confusion between the domain name and its mark.
- 5.7 The complainant argues that the respondent is engaged in a pattern of registrations of domain names corresponding to well-known names or trade marks in which the respondent has no apparent rights, and the domain name is part of that pattern.
- 5.8 It argues that no commercial offering by the respondent under the domain name can be considered genuine.
- 5.9 Finally the complainant argues that there are no circumstances (such as those mentioned in paragraph 4 of the Policy) showing the domain name is not an abusive registration.

*Respondent*

- 5.10 There is no response.

## **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 produced documentary evidence from the UK Intellectual Property Office of its UK trade mark registrations for the mark “ARNOLD CLARK”.
- 6.4 At the third level (i.e. disregarding “co.uk”), the complainant’s trade mark is the first, and arguably conceptually dominant, element of the domain name. The inclusion of the complainant’s mark at the beginning of the domain names means that similarity to the complainant’s mark is built in to it.

- 6.5 The inclusion of additional string of characters making up the word “finance” does not make the domain name dissimilar to the mark, given that car finance is closely related to car sales, and part of the complainant's business.
- 6.6 In those circumstances, I am satisfied that the complainant has rights in respect of a mark similar to the domain names.

*Abusive Registration*

- 6.7 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.

- 6.8 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using or threatening to use the domain name in a way likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.9 Given that the domain name includes the complainant's mark together with additional words which may support an inference that the domain name is connected to the complainant, in my view some confusion is likely between the domain name and the complainant.
- 6.10 The complainant has also produced evidence in the form of screenshots showing that the website at the domain name has been used to advertise car sales and car leasing and finance services that compete with those of the complainant.
- 6.11 In my view the advertising of such competitive services using the domain name takes unfair advantage of the complainant's rights.
- 6.12 Under paragraph 3(a)(iii) of the Policy, it may also be evidence of abusive registration if the complainant can demonstrate that the respondent is engaged in a pattern of registrations corresponding to well-known names or trade marks in which the respondent has no apparent rights, and the domain name in question is part of that pattern.
- 6.13 The complainant has produced evidence that the respondent has registered ten domain names corresponding in part to well-known trade marks.
- 6.14 It does therefore seem on the face of it that the respondent is engaged in a pattern of registrations corresponding to well-known names or trade marks in which he has

no apparent rights.

- 6.15 Paragraph 3.5 of the DRS Experts' Overview suggests experts have taken two approaches to the question whether any particular domain name forms part of such a pattern. On one approach —

*There must be evidence to justify the linking of the domain name in issue to the other objectionable domain names. The link may be found in the names themselves and/or in the dates of registration, for example.*

- 6.16 On the other approach —

*If the domain name in issue is a well-known name or mark of the Complainant and the Respondent is the proprietor of other domain names featuring the well-known names or marks of others, the pattern is likely to be established, even if there is no obvious link between the names or the manner or their dates of registration.*

- 6.17 The domain name is not linked strongly to the other objectionable domains, only a few of which relate to cars or finance. Using the first approach therefore it is not clear that the domain name appears to form part of the pattern.
- 6.18 But it is arguably part of the pattern, using the second approach. The domain name relates in part to a quite well-known mark of the complainant, and there is evidence that the respondent owns other domains partly featuring at least similarity with the well-known names or marks of others.
- 6.19 Based on the second approach, I see the respondent's registration of the other domains as well as the domain name as amounting to some evidence of abusive registration.
- 6.20 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 explanation for its registration of the domain name.
- 6.21 In those circumstances 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 mark which is similar to the domain name; and that the domain name, in the hands of the respondent, is an abusive registration.
- 7.2 I direct that the domain name be transferred to the complainant.

Carl Gardner

4 December 2015