

DISPUTE RESOLUTION SERVICE

D00017845

Decision of Independent Expert

Jaguar Land Rover Limited

and

Mr Ricky Singh

1. The Parties:

Lead Complainant: Jaguar Land Rover Limited
Abbey Road
Whitley
Coventry
CV3 4LF
United Kingdom

Respondent: Mr Ricky Singh
4 far pastures road
leicester
LE4 3LF
United Kingdom

2. The Domain Name(s):

<landrover-bodykit.co.uk>

3. Procedural History:

3.1 The Procedural History of this matter is as follows:

11 August 2016 08:37 Dispute received
11 August 2016 10:33 Complaint validated
11 August 2016 11:01 Notification of complaint sent to parties

16 August 2016 12:40 Response received
16 August 2016 12:40 Notification of response sent to parties
17 August 2016 15:04 Reply received
17 August 2016 15:04 Notification of reply sent to parties
24 August 2016 12:44 Mediator appointed
24 August 2016 12:44 Mediation started
11 October 2016 12:43 Mediation failed
11 October 2016 12:43 Close of mediation documents sent
13 October 2016 13:35 Expert decision payment received

- 3.2 I have confirmed to Nominet 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 the well-known car manufacturer. It is the owner of various trade marks that comprise or incorporate the term “Land Rover”. They include UK Registered trade mark no 663199 dated 11 October 1947 for the word mark LAND ROVER in class 12.
- 4.2 The Respondent would appear to be an individual who is located in the United Kingdom. He would appear to trade under the name “Meduza”.
- 4.3 The Respondent registered the Domain Name on 26 February 2013. On the same day the Respondent also registered other domain names that comprise a car brand combined with the term “bodykit”. The ones brought to my attention are <bentleybodykit.co.uk>, <porschebodykit.co.uk>, <audibodykit.co.uk>, <ferraribodykit.co.uk>, <bmwbodykit.co.uk> and <vwbodykit.co.uk>.
- 4.4 Since registration the Domain Name has been used (and this appears to be so in the case of all the “bodykit” domain names that the Respondent has registered) to redirect internet users to a website operating from the domain name <meduza.co.uk> (the “Meduza Website”).
- 4.5 On the Meduza Website the Respondent has offered products, parts and services for use in connection with various car brands. The Respondent also appears to have offered on that website vehicles for sale.
- 4.6 The Meduza Website, continues to operate and can be accessed via the Domain Name to this day.

5. Parties’ Contentions

Complainant

- 5.1 The Complainant provides details of its business and some of its trade marks. It also appears to claim unregistered trade mark rights in the term “Land Rover”.
- 5.2 The Complainant asserts that the Domain Name comprises its trade mark in combination with the term “bodykit”. The term “bodykit” is characterises as a common place descriptive terms used to describe a collection of exterior modifications to a car. As a consequence it maintains that the Domain Name is, therefore, identical or closely similar to a name or mark in which the Complainant has rights.
- 5.3 The Complainant further asserts that the Domain Name suggests to consumers that the Respondent is authorised by, connected to, affiliated with or endorsed by the Complainant, when this is not the case. It further complains that the website operating from the Domain Name misleading suggests a connection with the Complainant. In this respect it asserts that there is no disclaimer on the website making it clear that there is no such association with the Respondent. It also refers to a photograph appearing on the website of a vehicle from which the Complainant’s mark has been removed and has been replaced by the name “Meduza”.
- 5.4 The Complainant relies upon the with the Appeal Panel decision in DRS 07991 *Toshiba Corporation v Power Battery Inc.* (the “Toshiba Case”). It contends that when one applies the four criteria identified in that case, to the use made by the Respondent of the Domain Name, that use should be deemed abusive. In this respect, it asserts that the goods and services provided by the Respondent compete with those of the Complainant and that the Respondent is offering for sale products for vehicles that are not manufactured by the Complainant.

Respondent

- 5.5 In his Response the Respondent uses the word “website” in place of the term “domain name”. If that is so, it would appear to be the case that he confirms that he acquired the Domain Name as part of “a bundle” of other domain names and that at all times it has been used to redirect indirect users to the Meduza Website.
- 5.6 The Respondent further appears to contend that the Domain Name was a natural choice given that he deals in original Land Rover equipment and he denies that his website “implies” that he is the Complainant in any way. He claims that had the Complainant wanted the Domain Name, it should have bought it a long time ago.
- 5.7 The Response also contains the following statement:

“If Land Rover strongly want this website [I] am more than happy to negotiate a fee for this website. I hope this makes my position clear in this matter.”

6. Discussions and Findings

General

- 6.1 To succeed under the Policy, the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

Complainant's Rights

- 6.3 I accept that the Domain Names can only be sensibly understood as a reference to the Complainant's registered LAND ROVER trade marks in combination with the descriptive term "bodykit", together with the "co.uk" suffix. In the circumstances, I have little difficulty in finding that the Complainant has rights in a mark that is similar to the Domain Name.

Abusive Registration

- 6.4 In this case there appears to be no dispute of how the Domain Name has been used; i.e. to redirect internet users to a website that offers body-kits for use with the Complainant's vehicles, but also offers goods and services that are unrelated to those vehicle.
- 6.5 The Complainant also is correct to identify the Toshiba Case as the leading case under the DRS procedure of when and in what circumstances it might be possible to use the mark of another in a domain name that is being used to sell products or services related to that mark.
- 6.6 In that case the domain name took the form <toshiba-laptop-battery.co.uk> and had been used for a website selling batteries for Toshiba laptops.

6.7 In its decision the appeal panel considered much of the existing DRS decisions on that issue and also the well-known (at least to domain name law practitioners) *Okidata* decision under the somewhat different UDRP procedure. Having done so it reached the following conclusions:

“Broadly speaking, these four criteria are consistent with the principles of the two DRS appeal decisions discussed, which can be summarised 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.”*

6.8 On the particular facts of the Toshiba Case the appeal panel held that the Complainant had not made out “initial interest confusion”, but that there nevertheless was abusive use of the domain name because of what was sold on the website. The key passage is in the penultimate paragraph of section 9 of that decision, which reads as follows:

*“In this case, the evidence submitted by the Complainant shows that some of the goods offered by the Respondent **are replacement batteries for laptops made by other manufacturers**. Had the Respondent submitted any Response at either the first instance or appeal stage, it is conceivable that it might have made submissions about the extent of any competitors’ products being offered and the significance that that Panel should attach to that aspect. In the absence of any such submissions, however, the Panel finds on the balance of probabilities that this aspect of the Respondent’s conduct constitutes the taking of unfair advantage of the Complainant’s rights and therefore renders the Domain Name in the hands of the Respondent an Abusive Registration.” [emphasis added]*

6.9 The phrase “replacement batteries for laptops made by other manufacturers” can be read in more than one way, but the most natural reading of “laptops” in that sentence is as a reference to non-Toshiba laptops. This also appears to be borne out by the factual summary on page 3 of the decision that makes references to HP, Dell, IBM, Sony, Acer and

Compaq laptops. In other words, central to the finding of the appeal panel in the Toshiba Case was not the respondent's sale of non-Toshiba batteries for Toshiba laptops, but the sale of batteries that had no connection with Toshiba in any sense.

- 6.10 I believe that the four paragraph summary in the Toshiba case does represent the prevailing view of experts in decisions under the DRS and has been adopted in many subsequent decisions.
- 6.11 It does not follow that how that summary was applied to the facts of the Toshiba case is not uncontroversial. There are, for example, cases where panels have reached somewhat different conclusions on the question of initial interest confusion so far as this sort of domain name is concerned (see for example DRS 12744 <catspares.co.uk>).
- 6.12 Nevertheless, if in the Toshiba Case the domain name that incorporated the Toshiba mark was being used to sell in addition to goods and services related to that mark, goods or services that were unconnected with that trade mark, the finding of abusive use is an unremarkable one.
- 6.13 I have also reached the clear view so far as the Domain Name is concerned that at the very least there is, and has been, that sort of abusive use. The Respondent is using the domain name to divert traffic to a website that not only sells body-kits that relate to Land Rover vehicles, but also sells body-kits for other vehicles and also offers other goods and services that are unrelated to Land Rover. This is not even a case where it might be said that these non-Land Rover related activities are merely incidental.
- 6.14 In the circumstances, I find that the Complainant has demonstrated that the Domain Name has been and is being used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's Rights and that the Domain Name is an abusive registration.

7. Decision

- 7.1 I find that the Complainant has rights in a mark that is similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed Matthew Harris

Dated 30 October 2016