



DISPUTE RESOLUTION SERVICE

D00017825

Decision of Independent Expert

Jaguar Land Rover Limited

and

Mr Victor Doudko

1. The Parties:

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

Respondent: Mr Victor Doudko
Finchley House
707 High road
London
N12 0BT
United Kingdom

2. The Domain Names:

jagrepairer.co.uk
jagservicecentre.co.uk
jagservicing.co.uk
northlondonjags.co.uk
jaguarservicecenter.co.uk
jaguarservicecentre.co.uk

3. Procedural History:

I 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, that 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.

August 5, 2016	Dispute received
August 9, 2016	Complaint validated
August 9, 2016	Notification of complaint sent to parties
August 29, 2016	Response reminder sent
August 31, 2016	Response received
August 31, 2016	Notification of response sent to parties
September 1, 2016	Reply received
September 1, 2016	Notification of reply sent to parties
September 1, 2016	Mediator appointed
September 6, 2016	Mediation started
May 12, 2017	Mediation failed
May 12, 2017	Close of mediation documents sent
May 18, 2017	Expert decision payment received

4. Factual Background

The Complainant, now known as Jaguar Land Rover Limited, has used the name Jaguar since 1935 through various company name changes. The Complainant, through authorised dealers, trades in new and approved used cars, vehicle parts and accessories, and related services including financial, insurance, repairs and vehicle maintenance. The Complainant positions itself in particularly the premium, sports car and sports utility vehicle markets.

The Complainant owns trademarks for JAGUAR and JAG, including the following:

JAG, United Kingdom Intellectual Property Office (UKIPO), filed June 23, 2014, registered December 19, 2014, registration number 3061059, classes 12, 37;

JAGUAR, UKIPO, filed and registered October 13, 1943, registration number 625805, class 12;

JAGUAR, UKIPO, filed November 18, 1986, registered September 28, 1990, registration number 1292098, classes 16, 24, 28, 36, 37.

The Complainant also owns domain names incorporating its trademarks including jaguar.co.uk, jaguar.com, jaguar-xk8.co.uk, jaguarxkclub.co.uk, jaguarrestoration.co.uk, f-typejaguars.co.uk, jaguarf-type.co.uk, jagrestorations.co.uk and jaguaretyperestorations.co.uk.

The disputed Domain Names have been registered by the Respondent on behalf of the owner of a small independent business specialising in the repair and servicing of Jaguar vehicles. The Domain Names jaguarservicecentre.co.uk and jaguarservicecenter.co.uk have been redirected to the website at ultimatecats.co.uk, which offers independent Jaguar repair and maintenance services. The Domain Names jagrepairer.co.uk, jagservicecentre.co.uk, jagservicing.co.uk and northlondonjags.co.uk are not presently in use.

5. Parties' Contentions

Complainant

Complainant's Rights

The Complainant asserts rights in the registered trademarks JAGUAR and JAG in addition to common law rights in the same trademarks internationally.

The Complainant says the Domain Names each comprise one of the Complainant's trademarks as the dominant and distinctive element, together with one of the descriptive words "servicecentre", "servicecenter", "servicing" or "repairer", referring to the Respondent's business, or "northlondon", referring to the Respondent's location. The Domain Names are each similar to a trademark in which the Complainant has rights and are likely to confuse consumers into believing there is a link between the Complainant and the Respondent.

Abusive Registration

The Complainant says the Domain Names jaguarservicecentre.co.uk, jagservicing.co.uk and jaguarservicecenter.co.uk are redirected to the website at ultimatecats.co.uk, which offers services identical to those of the Complainant. This action is likely to confuse consumers because the Respondent is not connected with the Complainant, is not an authorised dealer, service centre or franchisee of the Complainant and is not authorised to use the Complainant's trademarks.

The Complainant says it believes Paul Vandermolen and Victor Doudko, the latter being the named Respondent, to be related parties, and to be related to the registrant of ultimatecats.co.uk. This is on the basis that ultimatecats.co.uk is registered in the name Andrea Vandermolen, whilst another domain name that is not part of the present dispute but has a link to ultimatecats.co.uk, namely jaguarrepairer.co.uk, is owned by Paul Vandermolen.

The Complainant says that although the Domain Names jagservicecentre.co.uk, northlondonjags.co.uk and jagrepairer.co.uk are not operational, there is a risk they might be used by a third party in future to cause confusion to consumers.

The Complainant refers to other domain names allegedly owned by the Respondent or associated parties that are in similar vein to the disputed Domain Names but are not relevant to the present Complaint.

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

Respondent

The Respondent denies the Complaint.

The Respondent says the Domain Names were registered on behalf of Paul Vandermolen, who has provided most of the Response. The Domain Names were registered to assess for marketing purposes without any intention to confuse customers.

Paul Vandermolen states, through the Response, that he runs a small independent garage, formerly called Jaguar Repairer Ltd, specialising in repairing and servicing Jaguar vehicles. He has always asserted his independence and his headed paper has the disclaimer "the company is not affiliated in any way with Jaguar Cars Ltd, however we do use their parts." After hearing from the Complainant's solicitor, Paul Vandermolen changed his company name to Ultimate Cats Ltd. The Domain Names jagrepairer.co.uk, jagservicecentre.co.uk, jagservicing.co.uk and northlondonjags.co.uk have expired and the others have been temporarily disabled.

Paul Vandermolen says the Domain Names are not for sale. He believes he may qualify under the Block Exemption to be able to use the Domain Names in the future, and therefore wishes to keep them as he could not get them back once lost. He has never attempted to pass off his company as other than an independent specialist operating from home. Companies he has dealings with are aware he is an independent specialist and not an approved repairer, including insurance companies such as Aviva, Elephant, Direct Line, and also the AA and RAC. He does not sell cars.

Complainant's Reply to the Response

The Complainant says the assertions in the Response relating to the Block Exemption Regulation are irrelevant for the purposes of these proceedings, which are founded in the present usage of the Domain Names and not in the future. There is no justification for the Respondent to keep the Domain Names in case the law changes in the future.

The Complainant says the retention of the Domain Names without use, as intimated by the Respondent, is equivalent to their having been registered as blocking registrations and therefore as Abusive Registrations under the Policy.

The Complainant says that when the Complaint was filed, some of the Domain Names were redirected to ultimatecats.co.uk, an action that points to the Domains Names being Abusive Registrations.

Notwithstanding the Respondent's claim that certain of the Domain Names have expired, the Whois shows the registrant name Victor Doudko, which may be out of date, but the Complainant cannot chance that they will not be renewed.

The Complainant says the Response has been filed by Paul Vandermolen whereas the registrant of the Domain Names is Victor Doudko. This may amount to the provision of false contact details, which is further evidence of Abusive Registration.

The Complainant's Reply also reiterated some points made in the Complaint.

6. Discussions and Findings

Identity of the Respondent

Paragraph 1, Definitions, of the Policy, reads in part: "Respondent means the person (including a legal person) in whose name or on whose behalf a Domain Name is registered".

The Complainant states that the Domain Names were registered in the name of Victor Doudko. The Response is opened by Victor Doudko, who states, "I have registered domains in question on behalf of Paul Vandermolen" and, after a few lines, continues with a more extensive quotation of "... what Mr Paul Vandermolen had to add". The Complainant would not have known this when filing the Complaint but has not sought to amend the identity of the Respondent. It appears Victor Doudko and Paul Vandermolen have acted in concert, from Victor Doudko's references to, for instance, "... I just provide technical support" and "... we just registered a few different names ..." Having regard to all the circumstances the Expert accepts that the Complaint has been brought validly against the registrant Victor Doudko as the Respondent. Insofar as the Complaint names a single Respondent and the Response is submitted by Victor Doudko, incorporating a contribution in the name of Paul Vandermolen, it will be convenient to refer to the Respondent in the singular.

Status of the Domain Names

According to the Respondent, the Domain Names jagrepairer.co.uk, jagservicecentre.co.uk, jagservicing.co.uk and northlondonjags.co.uk have expired. The Complainant had included jagservicing.co.uk among those redirected to ultimatecats.co.uk. Whilst the circumstances under

which the Expert should make independent enquiries are limited, as discussed under paragraph 5.10 of the Dispute Resolution Service – Experts’ Overview, version 2, a check of the WhoIs to resolve the discrepancy was considered to be “... a proportionate alternative to either ignoring a point made in the submission in question or initiating a further round of submissions by way of requests for further information”. The WhoIs confirmed the original registrant name and provided the following status information:

jagrepairer.co.uk	Expiry date: May 18, 2016	Registration status: suspended
jagservicecentre.co.uk	Expiry date: May 18, 2016	Registration status: suspended
northlondonjags.co.uk	Expiry date: May 18, 2016	Registration status: suspended
jagservicing.co.uk	Expiry date: Jul 14, 2016	Registration status: renewal required

The above Domain Names may be referred to below as the “four expired Domain Names”. Under the heading “What happens if you don’t renew by the expiry date?”, Nominet advises registrants, in part:

“When your domain has been suspended for 60 days without being renewed, we’ll schedule it for cancellation. We’ll send you one final reminder to renew your domain 83 days after the expiry date. As this is just seven days before your domain is scheduled for cancellation, you’ll have to act quickly if you wish to renew it at this last stage.

Once cancelled, the domain name will become instantly available to others who may wish to re-register it.”

The Respondent asserted that the four expired Domain Names had expired and said that “... due to the lack of searches [i.e., hits] we did not extend registration for [them] ...” and “As a result, we only have jaguarservicecentre.co.uk and jaguarservicecenter.co.uk”. Irrespective of the reason why the four expired Domain Names remain on the WhoIs (which may have to do with the lodgement of the Complaint during the Respondent’s grace period for renewal) the Respondent explicitly does not want them and regards them as expired. The time since expiry of the four expired Domain Names is now considerably in excess of 90 days (over 300 days for the most recently expired, over a year for the others). Accordingly they are deemed to be cancelled and a formal Decision will be recorded to that effect.

The Discussion continues with reference solely to the two current Domain names:

jaguarservicecenter.co.uk	Expiry date: Mar 21, 2019	Registration status: until expiry date
jaguarservicecentre.co.uk	Expiry date: Mar 20, 2019	Registration status: until expiry date

Under paragraph 2.1 of the Policy the Complainant must prove, on the balance of probabilities, that:

“2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

Complainant’s Rights

Paragraph 1 of the Policy defines rights 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”.

The Expert is satisfied by the copies of documentary evidence produced by the Complainant that the Complainant has the Rights required under paragraph 2.1.1 of the Policy in the trademarks JAGUAR and JAG as registered at the UKIPO.

The Domain Names have the extension “.co.uk”, which need not necessarily be considered in the determination of similarity to the Complainant’s trademarks. The Domain Names jaguarservicecenter.co.uk and jaguarservicecentre.co.uk feature the Complainant’s trademark JAGUAR and the descriptive terms “servicecenter” or “servicecentre”, which are found not to be distinguishing but to compound similarity between the respective Domain Name and the Complainant’s trademark in the context, by referring to car servicing.

In the terms of paragraph 2.1.1 of the Policy, the Expert finds each of the Domain Names jaguarservicecenter.co.uk and jaguarservicecentre.co.uk to be similar to a trademark in which the Complainant has rights.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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. is being used or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.”

Paragraph 5 of the Policy lists factors, without limitation, that may be evidence of Abusive Registration, including:

- “5.1.2 Circumstances indicating that the Respondent is using or 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”.

By the Respondent’s own statements, the Domain Names were registered with the intention of being used for the attraction of customers to the company Jaguar Repairer Ltd, recently renamed Ultimate Cats Ltd in response to a communication from the Complainant. As the Respondent put it, “... we just registered a few different names to assess which would be better for marketing purposes”. The Respondent concedes that the Domain Names jaguarservicecentre.co.uk and jaguarservicecenter.co.uk have resolved ultimately to the website of Ultimate Cats Ltd at ultimatecats.co.uk. A copy of the ultimatecats.co.uk website produced in evidence by the Complainant is headed “WELCOME TO ULTIMATE CATS - INDEPENDENT JAGUAR SERVICE CENTRE”. The “Home” and “About us” pages offer “Service and repair work”, “Electronic diagnostics”, “Jaguar MOTs”, “Custom bodywork, restoration & body work repairs”, “Special paint finishes”, “Air conditioning servicing” and “Performance enhancements”. The “Services” page offers “Jaguar service and repair work”, “Jaguar MOTs”, “Jaguar electronic diagnostics”, “Jaguar body work repairs, restoration works & custom bodywork” and “Jaguar air conditioning servicing”. There is also a “Tuning” page.

Under certain restricted circumstances a reseller of a product might be able to establish a justification for incorporating in its domain name a trademark associated with that product. The Respondent is not, however, a reseller, except to the limited extent that, according to its website, “We pride ourselves in fitting only genuine Jaguar parts”. The Respondent’s servicing of Jaguar vehicles cannot be portrayed as a reselling of the Complainant’s services. Nevertheless certain parallels may exist between arguments advanced in reseller cases and cases involving the servicing of trademarked goods.

Whilst previous decisions under the Policy do not have precedential status as such, the Expert notes the arguments canvassed in *Aga Rangemaster Ltd v Keith M Palmer t/a Keith M Palmer & Co* (DRS 12073) in which, significantly, the respective domain name aga-rayburn-service.co.uk incorporated the

word “service” together with the trademarks AGA and RAYBURN. The *Aga* decision included a quotation from the appeal case *Toshiba Corporation v Power Battery Inc* (DRS 07991): “In the case of *BMW -v- Deenik* [C-63/97] the European Court of Justice considered whether the operator of a garage, which was unauthorised by BMW but specialised in BMW sales and repairs, was entitled to use the trade mark BMW in advertisements to describe the goods and services being offered. The Court decided that it was legitimate to use the mark to identify the source of the goods in respect of which the services were being offered, providing the independent operator did not take unfair advantage of the distinctive character or repute of the mark. Such unfair advantage would arise, in particular, where the mark was used in such a way that falsely created an impression of a commercial connection or affiliation with the trade mark owner”. After an exploration of contractual matters, the decision to transfer the domain name in *Aga* ultimately rested on a finding of initial interest confusion.

The *Toshiba* Panel divided over the issue of whether a search for the terms “toshiba”, “laptop” and “battery” together, upon yielding the domain name *toshiba-laptop-battery.co.uk*, would be likely to cause initial interest confusion between that domain name and Toshiba Corporation. Briefly, for a number of reasons, the majority in *Toshiba* decided that the respective complainant had not, on balance, demonstrated that use of the domain name by the respondent would likely lead to any such confusion (the eventual unanimous decision in favour of the complainant, reversing the summary decision, turned on the nature and source of the goods being sold). The minority in *Toshiba* reportedly took the view that the respondent had “... merely appended the words “laptop” and “battery” to the Complainant’s well-known mark, both words reflecting part of Toshiba’s business”, and that “Where, as here, it is quite likely that a substantial number of Internet users, presented with the Respondent’s website in the results of a search, would suppose that there may be some such connection, that is sufficient to give rise to “initial interest confusion””.

Thus, the decision is not straightforward as to the circumstances in which another’s trademark may legitimately be used in a domain name by an entity that makes otherwise innocent usage of that trademark in the ordinary course of business, and the decision must depend partly on the specific facts. The Policy requires the Expert to decide whether the Respondent has taken unfair advantage of the Complainant’s Rights.

The Respondent has cited the Block Exemption Regulation of the European Union, which facilitates the servicing of vehicles other than through a manufacturer’s authorised agents without loss of warranty protection. Competition between service providers including the Complainant and independent garages is therefore a reality.

For attracting and informing customers *via* the Internet the Complainant relies in part on its own domain names, such as *jaguar.co.uk* and *jaguar.com*, which presumably can key customers into its dealership network.

Independent operators must advertise and compete as best they can. Without intending to stray into areas of trademark infringement that are beyond the scope of the Policy, it is probably safe to say that a trader has an implied limited licence to use the trademarks of others innocently to describe what the trader sells, repairs or services, inside a website or generally. Business would be impossible without the ability to state what is for sale or whose products can be repaired. A domain name, on the other hand, is more in the nature of a shop front, sometimes becoming the name by which a business is commonly known, and may well become registered in its entirety as a trademark.

Without the benefit of independent research, the Expert considers it nevertheless reasonable to expect that a number of alternative service or repair providers would welcome or specialise in Jaguars, relying perhaps on unexceptionable terms such as “classic”, “prestige” or “quality” in their domain name shop fronts. Inside, they can elaborate. The Respondent has gone further and has incorporated the Complainant’s trademark into its trial shop fronts *jaguarservicecentre.co.uk* and *jaguarservicecenter.co.uk*. The reasons are clearly stated: “... we just registered a few different names to assess which would be better for marketing purposes”. In other words, the Respondent is

evaluating which of the Domain Names could provide a competitive advantage, having incorporated the Complainant's trademark JAGUAR for the purpose.

The Complainant, independent service operators, and the Respondent, all compete in the same market. Axiomatically the disputed Domain Names have been intended, by their construction and the display of the trademark JAGUAR, to shift the equilibrium of visits away from benign domain names and towards themselves, in order to select those "... better for marketing purposes". Similarly the Respondent says it intends to attract clients who "... would not or could not afford to have their cars worked on at a franchised dealership ...". It is evident that the Respondent seeks to benefit commercially from the use of the Complainant's trademark.

Inescapably the Domain Names are intended to give the Respondent an advantage, but the question remains, is that advantage fairly or unfairly gained? In the Expert's finding the Respondent has crossed the line from innocent usage of the Complainant's trademark in the course of business, to gaining or intending to gain a competitive advantage over others through the strength, the "distinctive character or repute", of the Complainant's well-known, long established, registered trademark. On the balance of probabilities the Respondent is found to have taken unfair advantage of the Complainant's Rights within the meaning of paragraph 1(i) of the Policy at the time of registration of the Domain Names jaguarservicecentre.co.uk and jaguarservicecenter.co.uk, constituting Abusive Registration.

Furthermore, leaving aside any incongruity between the image of a Jaguar Service Centre likely to be generated by the Domain Names jaguarservicecentre.co.uk and jaguarservicecenter.co.uk, and, with respect, the reality that "... cars are dropped off at my house in Stanmore and collected from there once finished", the Expert finds these two Domain Names to have been used in a way likely to confuse Internet users into believing them to be associated commercially with the Complainant, in the terms of paragraph 5.1.2 of the Policy. Both Domain Names are found to project, not merely "a" Jaguar Service Centre, but "the", or at least a major, Jaguar Service Centre (or Center). The presence of disclaimers on the website to which the Domain Names ultimately resolve, or any other obviousness on first sight that the website does not represent the Complainant, is of no consequence, as initial interest confusion is likely to have occurred already upon sight of the Domain Names alone before visiting the website. Accordingly the Expert finds, on the balance of probabilities, that the Domain Names jaguarservicecentre.co.uk and jaguarservicecenter.co.uk have been used in a manner that has taken unfair advantage of the Complainant's Rights under paragraph 1(ii) of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in respect of a name or mark similar to each of the Domain Names jaguarservicecenter.co.uk and jaguarservicecentre.co.uk and that these two Domain Names in the hands of the Respondent are Abusive Registrations. The Domain Names jaguarservicecenter.co.uk and jaguarservicecentre.co.uk are ordered to be transferred to the Complainant.

The Expert finds that the Domain Names jagrepairer.co.uk, jagservicecentre.co.uk, jagservicing.co.uk and northlondonjags.co.uk have intentionally been allowed to expire. For the avoidance of doubt, these four Domain Names are ordered to be cancelled.

Signed Clive Trotman

Dated June 2, 2017