

DISPUTE RESOLUTION SERVICE

DRS18124

Decision of Independent Expert

Jaguar Land Rover Limited

and

Jaguar Dismantlers

1. The Parties:

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

Respondent: Jaguar Dismantlers
K & H Trading Estate
Upminster
Essex RM14 3PA
United Kingdom

2. The Domain Name(s):

essexjagspares.co.uk
jag-u-r.co.uk
jaguardismantlers.co.uk
jaguardismantlers.uk

3. Procedural History:

I can confirm that I am independent 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 in to question my independence in the eyes of one or both of the parties.

27 October 2016 15:50 Dispute received

27 October 2016 16:08 Complaint validated

27 October 2016 16:16 Notification of complaint sent to parties

15 November 2016 01:30 Response reminder sent

16 November 2016 16:22 Response received

16 November 2016 16:22 Notification of response sent to parties

21 November 2016 01:30 Reply reminder sent
24 November 2016 08:37 Reply received
24 November 2016 08:38 Notification of reply sent to parties
24 November 2016 08:38 Mediator appointed
29 November 2016 11:07 Mediation started
28 April 2017 17:36 Mediation failed
28 April 2017 17:36 Close of mediation documents sent
11 May 2017 02:30 Complainant full fee reminder sent
11 May 2017 10:25 Expert decision payment received

4. Factual Background

The Complainant is a well-known maker of prestige motor vehicles. The Respondent is an independent business offering maintenance and repair services, including the provision of spare parts, for Jaguar vehicles.

The Domain Names were registered by the Respondent as follows:

jaguardismantlers.co.uk	26 July 2004
jaguardismantlers.uk	13 August 2015
essexjagspares.co.uk	23 March 2016
jag-u-r.co.uk	23 March 2016

The Domain Name <jaguardismantlers.co.uk> resolves to a website maintained by the Respondent. <jaguardismantlers.uk> resolves to a “coming soon” page and the remaining two Names reach GoDaddy hosting pages.

5. Parties’ Contentions

I summarise below the pertinent points of each Party’s submission.

The Complainant

The Complainant is a well-known manufacturer of premium motor vehicles, based in the United Kingdom. It operates through authorised dealers selling new and used cars and spare parts and accessories. It provides a range of services including finance, insurance, repair and maintenance.

Complainant’s Rights

The Complainant has built up extensive IP rights, including a large portfolio of trademark registrations and common law rights in its various brands. It owns, amongst others, the following trademarks:

UK trademark no. 625805 JAGUAR in class 12, dated 13 October 1943;
EU trademark no. 001013051 JAGUAR S TYPE in classes 3, 12, 25, 27 and 37, dated 10 December 1998;
EU trademark no. 004967568 JAGUAR XS in class 12, dated 20 March 2006;
UK trademark no. 3061059 JAG in classes 12 and 37, dated 23 June 2014.

At common law, the marks JAGUAR and JAG have acquired extensive goodwill and a substantial reputation throughout the world.

The Complainant owns a number of domain names relevant to the Jaguar and JAG marks, including the following:

jaguar.co.uk
jaguar.com
jaguar-xk8.co.uk
jaguarxkclub.co.uk
jaguarrestoration.co.uk
jagheadlinings.co.uk
jagxkinteriors.co.uk
jagxjinteriors.co.uk

The Complainant argues that the Domain Names are identical or similar to its trademarks. The dominant and distinctive element in each of them is one of the Complainant's trademarks. The remainder of each Domain Name is either a purely descriptive term, such as "dismantlers", "spares" or "essex" or alludes to one of client's other trademarks, JAG, which appears in the Domain name <jag-u-r.co.uk>.

The Complainant states that the Domain Name <essexjagspares.co.uk> incorporates its UK trademark 3061059 JAG. The additional elements "essex" and "spares" are merely descriptive. Similarly, the Domain Names <jaguardismantlers.co.uk> and <jaguardismantlers.uk> incorporate the whole of UK trademark 625805 JAGUAR. The additional element "dismantlers" indicates that the Respondent dismantles Jaguar vehicles for the purposes of repair and/or re-use.

The Domain Name <jag-u-r.co.uk> incorporates its UK trademark number 3061059 JAG and has deliberately been constructed to be phonetically identical to one of the Complainant's marks, JAGUAR.

Abusive Registrations

The Complainant argues that, in respect of the three Domain Names currently resolving to holding sites, the Respondent is already using other domain names containing the Complainant's trademarks to host websites and it is inevitable that these websites will be used in the same way. There is a real risk that they will be used by a third party to direct consumers to websites unconnected to the Complainant, causing confusion to consumers.

The Complainant confirms that the Respondent is not authorised to use its trademarks. The Complainant points out that the Respondent is using the Domain Name <jaguardismantlers.co.uk> to direct consumers to a website which provides identical or similar goods and services to those for which the Complainant has trademark protection. Such use is likely to confuse consumers into believing that the Domain Name is registered to, operated by, connected to or authorised/endorsed by the Complainant. Such use also takes unfair advantage of the Complainant's rights in the trademarks as the Respondent is trading off the back of the reputation and goodwill that the Complainant has built up in the mark.

The Complainant argues that a speculative visitor to the Registrant's website will be visiting in the hope and expectation that the website is operated or authorised by, or

otherwise connected with the Complainant. This initial interest confusion is evidence of the Domain Name being an abusive registration.

The Complainant refers to the case *British Telecommunications Plc & Others v One in a Million Ltd & Others* [1999 1WLR903], where the court held that if a registrant registers a domain name to appropriate the goodwill of another or enable others to do so, there is no reason that the court should not infer that unfair advantage will happen, even if there is a possibility that such an appropriation would not take place.

The Complainant asserts that the Respondent is engaged in a pattern of registrations, within the contemplation of paragraph 3(a)(iii) of DRS Policy, where the Respondent is the registrant of domain names corresponding to well known names or trademarks in which the Respondent has no apparent rights.

The Respondent

The Respondent describes itself as Jaguar Dismantlers, a very small family owned business based in Essex. It has been established for 26 years, dismantling Jaguar motor vehicles and selling used parts. It has owned and used the Domain Name <jaguardismantlers.co.uk> since 2004.

The Respondent states that the Domain Names describe its activities, which involve dismantling Jaguar motor vehicles and selling used Jaguar spares in Essex.

The Respondent asserts that <jaguardismantlers.co.uk> and <jaguardismantlers.uk> were created in accordance with advice from solicitors representing Jaguar Cars Ltd in 1999. The Respondent purports to quote from this advice as follows: “Jaguar has no objection to your use of the word “Jaguar “ in ordinary type-face (where such use is necessary to identify your business of supplying services for JAGUAR motor vehicles)”.

The Respondent confirms that it registered the Domain Name <jag-u-r.co.uk> in the hyphenated form set out herein.

Abusive Registrations

The Respondent takes note of the examples of “evidence that a registration is not abusive” in Paragraph 8 of the DRS Policy, and asserts that it can prove it is using the Domain Names for a legitimate business and that the Domain Names are descriptive and being used fairly in relation to its business. The Respondent points out that the Complainant confirms that the Respondent’s website states that it is “an independent supplier of used and reconditioned Jaguar parts”, which clearly advises consumers that there is no link between the Respondent and the Complainant.

The Respondent refers to the UDRP case *Jaguar Land Rover Ltd v. Parvez Ali* dated October 4th 2016, where the arbitrator found that <rangeroverchauffeur.com> was not being used in bad faith as “the Complainant is not in the business of being a chauffeur”. The Respondent argues that this case supports its position that the Domain Name is not being used abusively as the Complainant does not dismantle vehicles nor do they sell used/second-hand or recycled parts. Thus, argues the Respondent, it is not in competition with the Complainant.

The Respondent maintains that it is complying with all necessary criteria to show that the Domain Name is not being used abusively:

The Respondent is making a genuine offer of the goods in question;

The Respondent uses the site to sell only trademarked goods;

The website clearly discloses there is no affiliation or connection to the trademark owner;

The Respondent claims no monopoly on the Domain Names.

The Respondent asserts that its use of the Complainant's mark is solely for the purpose of advertising the fact that it dismantles Jaguar cars only. The Respondent did not register the Domain Names in bad faith. The primary purpose was not to sell, rent or otherwise transfer them to the Complainant or to a competitor of the Complainant. The Respondent did not register the Domain Names primarily for the purpose of disrupting the Complainant's business. The Respondent did not intentionally attempt to attract Internet users to its website to create a likelihood of confusion with the Complainant's trademark.

Complainant's Reply to the Response

The Complainant points to the Domain Name registration dates set out in the Response and argues that this supports its assertion that its rights came first. The Complainant offers the view that "In any event, it is well settled law that registered trademarks trump other rights such as domain names and company names".

The Complainant notes the Respondent's assertion that as the Domain Names were registered in 2004, there has been delay in bringing the Complaint. The Complainant states that it only became aware of the Domain Names very recently and refers to DRS 15788 Lucasfilm LLC and ABSCISSA.COM Ltd ("Lucasfilm Appeal"). The Panel in that Appeal held that a "delay does not automatically bar an action where the use complained of is ongoing", as is the case in this Complaint.

The Complainant argues that the Respondent is not authorised to use its marks in the Domain Names. The Complainant notes the Respondent's reference to correspondence in 1999 claiming the Complainant gave permission to use its trademarks. The Complainant argues that the correspondence pre-dates the Domain Name registrations by 5 years and does not refer to the Domain Names or authorise use of their trademarks in them. The Complainant also points out that the Respondent has not provided evidence of this correspondence. The Complainant argues that its express permission should have been sought before registering the Domain Names.

The Complainant acknowledges that the Respondent correctly states that the Complainant "has no objection to the use of the word "Jaguar" where such use is necessary to identify the business of supplying services for Jaguar motor vehicles". The Complainant has not objected to use of the Jaguar name on the website where it states that the Respondent is "an independent leading supplier of used and reconditioned Jaguar parts". However, the Complainant maintains that the use of its trademarks in the Domain Names is the equivalent of a brand name on a store front. Such use is not descriptive but rather is indicative of origin.

The Complainant acknowledges that in certain circumstances a third party operating a business involving a trademark owner's goods or services can use a domain name

which incorporates that trademark owner's mark. However the Complainant argues that the circumstances in which this can happen are limited and do not include cases in which that party is using the domain name to take unfair advantage of the trademark owner's rights. The Complainant refers to the Appeal Panel decision in TOSHIBA Corporation v. Laptop Battery Inc. Case No. DRS 079991 and to the judgement of the European Court of Justice in L'Oreal v Bellure [C-487/07] to support the proposition that unfair advantage may arise in these circumstances even in the absence of actual or potential confusion on the part of Internet users.

The Complainant notes the Respondent's reference to the UDRP decision in Jaguar Land Rover Ltd v Parvez Ali dated October 4th 2016. The Complainant argues that the Respondent has failed to understand the reasoning in that decision. This case involved <rangeroverchauffeur.com> where the arbitrator held that the respondent was not acting in bad faith because the complainant was not in the business of being a chauffeur. The Complainant argues that the case is irrelevant. The current complaint is about vehicle servicing and maintenance and not chauffeuring.

The Complainant argues that the Respondent is in competition with the Complainant: the Respondent's assertion that the Complainant does "not dismantle vehicles nor do they sell used/second hand or recycled parts" is untrue. The Complainant argues that while it may not itself dismantle its vehicles, authorised third parties carry out maintenance, repair and servicing offerings on its behalf. The Complainant offers an example of a consumer contacting it about an irreparable exhaust pipe. The Complainant, by removing the old exhaust pipe would, in effect, be dismantling the overall vehicle.

The Complainant states that it provides maintenance, repair, servicing, reconditioning, restoration, inspection, cleaning, painting and polishing services and parts and fittings for its vehicles. The term "reconditioning", for which the Complainant has registered trademark protection, means "to overhaul or renovate". The Complainant undertakes reconditioning of vehicle parts so that they can be used again. As such, the terms "reconditioning and recycling" are synonymous.

The Complainant appreciates that the Respondent may not have deliberately sought to act maliciously or to hijack the Complainant's trademarks, but nevertheless maintains that the Respondent's actions could result in disruption of the Complainants business as a result of a likelihood of confusion.

6. Discussions and Findings

Procedural Matters

This case is determined by reference to Version 4 of Nominet's Dispute Resolution Policy, governing disputes submitted after October 1st 2016.

DRS Policy

Paragraph 1 of the DRS Policy defines Abusive registration as 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

Paragraph 2 of the DRS Policy requires a complainant to show 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

The Complainant has submitted evidence of a number of registered trademarks employing the term JAGUAR or JAG. Unregistered rights are also claimed, based upon the Complainant's reputation and trading history over many years. The Respondent has not challenged the Complainant's claims in this regard and I have no difficulty in finding that the Complainant has the necessary Rights in the marks JAGUAR and JAG.

Similarity of the Complainant's marks to the Domain Names

Three of the four Domain Names comprise its trade marks JAGUAR or JAG, accompanied by the term "dismantlers" in two cases and by the terms "essex" and "spares" in the third. The Complainant argues that these are merely descriptive terms which do not differentiate the Domain Names sufficiently from its registered marks. The Respondent also refers to these terms as being descriptive of its business but implies that the simple factual truth of the descriptions – they are dismantlers of Jaguar cars and they are located in Essex – is enough to distance the Domain Names from the Complainant's marks. On balance, and in accordance with the generally accepted principle that the initial Rights test is not intended to be unduly onerous, I find that the Complainant has Rights in respect of names or marks which are identical or similar to these Domain Names.

In the case of <jag-u-r.co.uk> the Complainant argues that its mark JAG is reproduced in full without any material embellishment, descriptive or otherwise, and that taken as a whole the Domain Name represents an aural version of its mark JAGUAR. The Respondent does not expressly go along with this, but offers no counter-argument. I therefore accept that the Complainant has passed the Rights test described above in respect of this Domain Name.

Abusive Registration

The DRS Policy requires the Complainant to show on the balance of probability, that the registrations are Abusive in the Respondent's hands. Paragraph 5.1 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. While the Complainant addresses the Respondent's behaviour in relation to several factors from this list, I intend to limit discussion to those matters which are most central to the Complainant's case.

Paragraph 5.1.1.3 concerns circumstances indicating that the Respondent "has registered or otherwise acquired the Domain Names primarily for the purpose of

unfairly disrupting the business of the Complainant”. Here the Complainant argues that the Domain Name registrations post-date the Complainant’s marks by several years and that, although it was apparently in contact with the Complainant’s solicitors in 1999, the Respondent did not seek approval for use of its marks in the Domain Names. The Complainant stops short of alleging that the Respondent deliberately set out to disrupt its business, but argues that the Respondent’s actions in registering several domain names incorporating its marks is evidence of a continuing intention to attract visitors to the Respondent’s website by unfairly benefitting from the goodwill in the Complainant’s marks. The Respondent’s reliance upon the advice it received from the Complainant’s solicitors is of limited value. Firstly, a simple quotation is hard to evaluate: the context in which the advice was offered is not clear as the Respondent has chosen not to submit the correspondence itself in evidence. Secondly, as the Complainant points out, the advice as quoted makes no reference to the use of the Complainant’s marks in domain names.

Paragraph 5.1.2 relates to circumstances indicating that the Respondent is “using or threatening to use the Domain Names in a way which has confused or is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant”. The Complainant argues that the facts of this Complaint fall squarely within the scope of this paragraph. The Complainant quotes the Appeal Panel in *Toshiba Corp vs Power Battery Inc* (DRS 07991) to support its view that the Respondent’s use of the Domain Names falsely implies a connection with the Complainant and that prejudice to its registered rights and to its business follow from this fact, with or without evidence of actual confusion on the part of Internet users.

The Respondent relies upon the UDRP decision in *Jaguar Land Rover Ltd vs. Parvez Ali* in <rangeroverchauffeur.com> to argue that the Domain Names indicate activities such as dismantling vehicles and supplying of spare parts in a specific location (Essex) which are not readily associated with the Complainant and therefore the Parties are not in competition and confusion ought not to arise. The Complainant disagrees, noting that the descriptive term in the <rangeroverchauffeur.com> case was “chauffeur”, suggesting an activity which would not necessarily be associated with the Complainant. In the present Complaint, the Complainant argues that the descriptive terms relate to activities and services which are more likely to be associated with it and that, in fact, such activities and services do form part of its business. The Complainant does not submit evidence to support of this, but it seems to me to be plausible to the extent that confusion as to the ownership or control of the Domain Names is a real possibility. Accordingly I find that the use of the Domain Names falls within the scope of paragraph 5.1.2 of the DRS Policy by giving rise to a situation which is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant

The Complainant also refers to Paragraph 5.1.3 of the DRS Policy, alleging that the Respondent is “engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern”. The Complainant’s arguments on this point are persuasive. The Complainant accepts that the Respondent has not necessarily acted

maliciously or in bad faith but its registration of the Domain Names and of others making use of the Complainant's protected marks:

essexjaguarspares.co.uk;
essexjaguarspares.com;
essexjagspares.com;
jaguardismantlers.com;
jag-u-r.com

is evidence of a pattern of registrations which the DRS Policy would recognise as evidence of an Abusive registration.

Paragraph 8 of the DRS Policy sets out a non-exhaustive list of factors which may establish that a Domain Name is not an Abusive registration. The Respondent asserts that it can prove it is using the Domain Names for a legitimate business and that the Domain Names are descriptive and being used fairly in relation to its business, as provided in sub-section 8.1.2 of this Paragraph. This section provides that a registration may not be Abusive where "the Domain Name is generic or descriptive and the Respondent is making fair use of it". It would be hard to argue that the Domain Names are generic, but a central feature of the Respondent's case is that the Complainant's marks are used in the Domain Names in a purely descriptive manner. The Respondent points out that the Complainant confirms that the Respondent's website states that it is "an independent supplier of used and reconditioned Jaguar parts", which clearly advises consumers that there is no link between the Respondent and the Complainant. However, the Complainant challenges the view that its marks, as they appear in the Domain Names, are merely descriptive. The Complainant maintains that the use of its trademarks in the Domain Names is the equivalent of a brand name on a store front and that such use is not descriptive but rather is indicative of origin. This is not a simple black or white matter as there is clearly a descriptive element in the Respondent's use of the marks in the Domain Names. Moreover, it is relevant to ask whether, in this area of business activity, independent providers of goods and services specific to a single brand of vehicle are commonplace. If custom and practice in the trade were to suggest that the inclusion of the Complainant's marks in the Domain Names is not only descriptive but actually necessary, to match car owners with the relevant suppliers, this would affect an assessment of the Complainant's "indicative of origin" case. This is a subjective matter however and the Parties' submissions do not offer much assistance with it. In these circumstances I must take other factors into account and I return in particular to the likelihood or otherwise that the Parties are in competition with each other. I have indicated above that I think they are, at least to the extent that initial interest confusion might arise when Internet users are confronted with the Domain Names. On the balance of probabilities therefore, I accept the Complainant's argument that its marks are indicators of origin in this context and that the Respondent derives unfair benefit from their unauthorised use.

7. Decision

I find that the Complainant has Rights in names which are identical or similar to the Domain Names and that the Domain Names are Abusive registrations in the Respondent's hands. The Domain Names should be transferred to the Complainant.

Signed
[Peter Davies]

Dated 24 May 2017