

DISPUTE RESOLUTION SERVICE

D00018271

Decision of Appeal Panel

Jaguar Land Rover Limited

and

TalkTalk Business Group Limited
(as the registrant of the disputed domain name on behalf of its client Lynda
Beaumont, t/a Essex Jaguar Spares)

1. The Parties:

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

Respondent: TalkTalk Business Group Limited (as the registrant of the disputed
domain name on behalf of its client Lynda Beaumont, t/a Essex Jaguar
Spares)
Garrett Field, Birchwood
Warrington
WA3 7BH
United Kingdom

TalkTalk Business Group Limited is the registrant of the Domain Name and is therefore named as the Respondent. However it is not in dispute that TalkTalk Group Limited registered the Domain Name on behalf of a client, Lynda Beaumont, trading as “Essex Jaguar Spares”, who is the beneficial owner of the Domain Name¹.

¹ The Panel notes that Nominet’s terms and conditions provide that a domain name registration is not an item of property and therefore cannot be owned. The Panel uses this terminology as convenient shorthand for the relevant contractual rights. The same issue arises elsewhere in this decision.

Accordingly references in this Appeal Decision to the Respondent are, unless otherwise stated, references to Essex Jaguar Spares/Lynda Beaumont.

2. The Domain Name

The domain name in issue is:

essexjaguarspares.co.uk

It is referred to in this decision as the “Domain Name”.

3. Procedural History

This is an appeal against the decision of Alan Limbury (the Expert) issued on 2 June 2017 in favour of the Respondent. Definitions used in this decision have the same meaning as set out in the Nominet Dispute Resolution Service (DRS) Policy Version 4, applicable to all disputes filed on or after 1 October 2016 (the Policy) unless the context indicates otherwise.

The procedural history prior to the Expert’s Decision is set out in that decision and does not need to be repeated here. The subsequent history of relevance to this Appeal is as follows:

2 June 2017	Expert’s decision in favour of the Respondent
16 June 2017	Appeal Notice filed
29 June 2017	Appeal Response
7 July 2017	Appeal Panel appointment

Nick Gardner, Anna Carboni and David King (the Panel) have each made a statement in the following terms:

“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 in to question my independence in the eyes of one or both of the parties”.

4. The Nature of This Appeal

Paragraph 20.8 of the Policy provides that *“The Appeal Panel will consider appeals on the basis of a full review of the matter and may review procedural matters”*. The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a redetermination on the merits. It is not therefore necessary to analyse the first instance decision in any detail.

At this point, the Panel simply records that the Expert in a carefully reasoned decision concluded that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name but that the Domain Name is not an Abusive Registration in the hands of the Respondent.

For convenience the Panel will continue to refer to the parties as the “Complainant” and the “Respondent”.

5. Formal and Procedural Issues

There are no outstanding formal or procedural issues

6. The Related Domain Names

In its Complaint the Complainant referred to a corresponding complaint that it had filed under the DRS regarding the registration of the domain names <jaguardismantlers.co.uk>, <jaguardismantlers.uk>, <essexjagspares.co.uk > and <jag-u-r.co.uk> (the “Related Domain Names”). That complaint was dealt with under DRS 18124, in which the respondent was Jaguar Dismantlers, the registrant of the Related Domain Names; it was not consolidated with the dispute regarding the Domain Name (the subject of this Appeal) because of the differing registrant details. In fact it appears that Jaguar Dismantlers is simply another trading name for Lynda Beaumont, the underlying beneficial owner of the Domain Name

DRS 18124 resulted in an Expert’s full decision dated 24 May 2017. The Expert found that the Complainant had Rights in names which were identical or similar to the Related Domain Names, that the Related Domain Names were Abusive Registrations in the hands of the Respondent, and that they should be transferred to the Complainant. No appeal was lodged against the decision. Further reference to DRS 18124 is made later in this Appeal decision.

7. The Facts

There is little if any dispute about the relevant facts, which can be set out briefly, as follows.

The Complainant is a UK-based company that manufactures a very well-known range of saloons, sports cars, SUVs and all-wheel drive vehicles under various brands including the “Jaguar” brand, as well as spare parts for these vehicles. It distributes these through a network of authorised dealers, who also provide a range of services for the vehicles, including repair and maintenance services.

The Complainant is the registered proprietor of various relevant trade marks, including: UK trade mark no. 625805 JAGUAR in class 12, registered as of 13 October 1943; EU trade mark no. 001013051 JAGUAR S TYPE in classes 3, 12, 25, 27 and 37, registered as of 10 December 1998; and EU trade mark no. 004967568 JAGUAR XS in class 12, registered as of 20 March 2006.

The Domain Name was registered on 17 October 2012 by the telecoms provider, TalkTalk Business Group Limited, on behalf of Lynda Beaumont, who runs a business based in Essex called Essex Jaguar Spares (also known as Jaguar Dismantlers). The Domain Name is used to host a website through which Essex

Jaguar Spares trades describing itself as “the Jaguar Specialist” and offering “high Quality servicing and the supply of used and re-conditioned parts”.

8. The Parties’ Contentions

The Parties’ contentions before the Expert are set out in his decision and do not need to be repeated verbatim here. In this section the Parties’ contentions so far as relevant to the Appeal are summarised. The Complainant’s are set out first, as it is the Appellant.

Complainant’s Contentions

The Complainant contends that it has Rights in a name or mark which is similar or identical to the Domain Name and that the registration is Abusive. The main points it advances are as follows:

As regards Rights, it is globally renowned and has built up extensive intellectual property rights, including a large portfolio of trade mark registrations and common law rights in the various brands it uses.

As regards its grounds for appeal:

The Expert ought to have considered DRS 18124, which corresponds to this case but could not be consolidated due to different registrant details, although the respondent for both is in substance Lynda Beaumont, who responded to this complaint on behalf of Essex Jaguar Spares. The Complainant has been successful under DRS 18124 particularly in relation to <essexjagspares.co.uk> which is virtually identical to the Domain Name, which the Complainant argues is more confusing to consumers than <essexjagspares.co.uk>. The Complainant also submits that, as the owner of the Related Domain Names, the Respondent is engaged in a pattern of obtaining domain names which correspond to the Complainant’s trade marks, for which the Respondent has no apparent rights.

The Complainant disagrees with the Expert’s view that the Domain Name is descriptive and fair. Use of a trade mark by a third party is only descriptive when used in conjunction with the everyday name of the product for which the trade mark is used. Using a domain name such as <sparepartsforjaguarvehicles.co.uk> *may* be argued to be descriptive, but using “jaguar spares” in the Domain Name implies that the goods are spare parts provided by the Complainant. Whilst the spare parts may be used and/or recycled parts which originated from the Complainant’s vehicles, the Domain Name suggests a connection with the Complainant rather than the recycling of genuine vehicle parts from used Jaguar vehicles. The Complainant also submits that the caveat on the Respondent’s website, “Essex Jaguar Spares is an independent leading supplier of used and reconditioned Jaguar parts”, was quickly added after the Complaint was filed and can easily be removed after the dispute is concluded. The Complainant says that a decision not to transfer the Domain Name cannot be based solely on such a transient element.²

² In fact, the text referred to by the Complainant in the Appeal Notice (quoted above) was already in the ‘Welcome’ section of the Respondent’s website. The ‘caveat’ that was added to the website at some

The Complainant disagrees with the Expert's assertion that "before being aware of the Complainant's cause for complaint, the Respondent has used the Domain Name in connection with a genuine offering of goods and services". It says that it has trade mark rights in the name Jaguar which date back to at least as early as 1943 and that the Respondent would have been aware of its trade mark rights and its cause for complaint prior to registering the Domain Name on 17 October 2012 and prior to trading as Essex Jaguar Spares 26 years ago.

The Complainant disputes the Expert's claim that there is no evidence that the Respondent is using the Domain Name to sell goods other than goods originating with the Complainant. It says that the Respondent provides services as well as goods, namely vehicle servicing and maintenance for Jaguar vehicles and that, whilst the Respondent may specialise in, and only service, Jaguar vehicles, by using the JAGUAR trade mark a suggestion is made that such services are authorised by the Complainant. Even garages that are authorised service centres of the Complainant are not allowed to use the trade mark JAGUAR in their domain name. Consequently, use of the JAGUAR trade mark in the Domain Name is likely to cause confusion to consumers who may believe the services provided by the Respondent are those of an authorised service centre of the Complainant. This further confirms that the Domain Name is not purely descriptive.

The Complainant also disputes the Expert's claim that the Respondent is not using the JAGUAR mark to attract business. It says that domain names are a "shop front" for a business that has an online presence and that, therefore, use of a domain name is use to attract business. It submits that use of the JAGUAR trade mark in the Domain Name is allowing the Respondent use of the Complainant's trade mark to attract business for a commercial offering which is unconnected to the Complainant.

Respondent's Contentions

In the Appeal Notice Response the Respondent contends that the Expert's decision was correct and that the Respondent had proved – and the Expert fully agreed – that the Domain Name is not an abusive registration, on the basis that:

- 1) The Domain Name is descriptive of the Respondent's activities.
- 2) The Domain Name does not contain the Complainant's trade mark in unadorned form; therefore it is not an abusive registration.
- 3) The Respondent has used the Domain Name in connection with a genuine offering of goods and services in accordance with the Policy paragraph 8.1.1.1, further evidence that the Domain Name is not an abusive registration.

point, and which the Expert referred to in his decision, states (in red text): "*Essex Jaguar Spares is an independent organisation specialising in the dismantling of Jaguar motor vehicles, the sale of used Jaguar parts and the servicing & repair of Jaguar motor vehicles. We have no affiliation, connection or link with Jaguar Land Rover Ltd, or any main dealerships and we are not a franchisee.*"

- 4) The Expert did not consider that visitors to the website will be sucked in or deceived by the Domain Name, and he did not consider that it was a case of “initial interest confusion”.
- 5) The Expert clearly agreed that the website content does not give rise to any mistaken belief as to a connection between the Domain Name registrant and the Complainant. He says that the statement on the website, “*Essex Jaguar Spares is an independent organisation specialising in the dismantling of Jaguar motor vehicles, the sale of used Jaguar parts and the servicing and repair of Jaguar motor vehicles. We have no affiliation, connection or link with Jaguar Land Rover Ltd or any dealerships and we are not a franchisee*”, makes it clear that the Domain Name is not registered to, operated or authorised by, or otherwise connected to the Complainant. The Respondent states that this will not be removed on conclusion of the dispute.
- 6) The Domain Name contains the word “essex” and “spares” which complies with Article 6(1) of the trade mark directive, which provides that a trade mark cannot be enforced against a third party using their own name and address or descriptive indications, provided that these are used in accordance with honest practices in industrial or commercial matters.
- 7) The Complainant’s insinuation that the use of the word JAGUAR in the Domain Name is “likely to cause confusion” to consumers has not been established by the Expert and again points to the fact that the Domain Name is not an abusive registration.
- 8) The Expert noted the following excerpt from the case of *BMW v. Deenik* (C-63/97):

“Furthermore, the use concerned must be held to be necessary to indicate the intended purpose of the service. It is sufficient to note that if an independent trader carries out the maintenance and repair of BMW cars or is in fact a specialist in that field, that fact cannot in practice be communicated to his customers without using the BMW mark.”

“the use of another’s trade mark for the purpose of informing the public of the repair and maintenance of the goods covered by that mark is authorised on the same conditions as those applying where the mark is used for the purpose of informing the public of the resale of goods covered by the mark.”

In conclusion, the Respondent therefore considers that the Expert correctly decided that the Domain Name is not an abusive registration. The Respondent notes that the Complainant acknowledges that there are certain circumstances whereby a third party who is operating a legitimate business around a trade mark owner’s goods can legitimately use a domain name incorporating that trade mark owner’s mark. The Respondent requests the same outcome.

9. Discussion and Findings

General

Pursuant to paragraph 2.1 of the Policy, the Complainant must prove in relation to each of the Domain Names, on the balance of probabilities, that:

- 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.

Rights

“Rights” are defined in the Policy 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 Complainant has established that it is the owner of a number of registered trade marks for the word “JAGUAR”.

The Domain Name is, in the opinion of the Panel, similar to these trade marks. It in substance combines the trade mark with a geographic non-distinctive term and the generic word “spares”. The suffix “.co.uk” may be ignored for the purposes of this assessment. Accordingly, the Panel is satisfied that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

“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”

The issue in this case is as to the principles which apply when a trader, who deals in genuine goods of the Complainant or provides services relating to the Complainant's products, incorporates the Complainant's trade mark in a domain name in combination with other terms. The Complainant itself acknowledges that “in certain circumstances a third party who is operating a legitimate business genuinely revolving around a trade mark owner's goods or services can legitimately use a domain name which incorporates that trade mark owner's mark”.

A considerable number of previous DRS decisions have addressed this issue. The most relevant of these are discussed below. Before doing so the Panel wishes to

consider a number of court decisions of relevance to this issue. In doing so it is important to note that the DRS system and the Policy provide a standalone regime intended to deal with domain names, and wider legal principles relating to trade mark infringement are not necessarily directly applicable to DRS disputes. However, both parties have referred to legal cases in support of their arguments and the Panel considers that the cases referred to below do assist in considering the applicable principles in the present circumstances.

Court Cases

The Complainant relies on *L'Oréal SA v Bellure NV* (Case C-487/07) in support of its contention that the Respondent's use of the Domain Name takes unfair advantage of the Complainant's rights in the name JAGUAR. That case had rather different facts to those here, in that the defendants were not dealing in genuine L'Oréal products, but were using L'Oréal's well-known perfume trade marks in comparison lists to inform retailers which of their own perfumes were designed to imitate L'Oréal's various perfume products. L'Oréal complained that these acts infringed their registered trade marks and argued that, even if consumers were not confused into believing that they were actually connected in the course of trade with L'Oréal, the use took unfair advantage of the distinctive character and repute of L'Oréal's well-known trade marks, which amounted to infringement pursuant to article 5(2) of the Trade Marks Directive 89/104.

The English Court of Appeal referred the case to the European Court of Justice (ECJ) for guidance. The response from the ECJ on which the Complainant relies in this case is that article 5(2) of the Directive – which refers to the taking of unfair advantage of the distinctive character or repute of a mark – does not require there to be a likelihood of confusion, or even a likelihood of detriment to the proprietor, but that:

“The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

The ECJ went on to give an instruction to the referring court that an advertiser who states explicitly or implicitly in comparative advertising that the product marketed by him is an imitation of a product bearing a well-known trade mark is unlawful comparative advertising and therefore that the advantage gained by the advertiser as a result must be considered to be an advantage taken unfairly of the reputation of that mark.

When the case came back to the Court of Appeal in *L'Oréal SA & Ors v Bellure NV & Ors* [2010] EWCA Civ 535, Lord Justice Jacob in the lead judgment expressed regret that he was being forced by the ECJ to rule that the defendants' use of L'Oréal's trade marks in their comparison lists was unlawful free riding which amounted to taking unfair advantage and was thus trade mark infringement, given that – in his assessment – consumers would understand that the defendants' perfumes being advertised in this

way were cheap copies rather than the genuine products and were not even being claimed to be the same quality as the originals. His preference would have been to rule that this was truthful advertising (i.e. informing consumers that the defendants' perfumes were each intended to smell like the various L'Oréal perfumes) which was (in his opinion) permissible to the extent that the products themselves were non-infringing.

While there remains a debate following *L'Oréal v Bellure* whether the ECJ should have been so prescriptive about the use of trade marks in comparison lists, the general proposition that traders should not use a reputed trade mark to 'ride on its coat tails' in order to benefit from its power of attraction, or exploit the marketing effort put in by the trade mark owner without paying any financial compensation, is less contentious. The question in this case, though, is whether that is what the Respondent has done or is doing by virtue of its use of the Domain Name.

Two cases that are rather more analogous to the facts of this case are *BMW v Deenik* (Case C-63/97) and *BMW v Technosport* [2016] EWHC 797 (IPEC) and [2017] EWCA Civ 779. In the former, the European Court of Justice (as it then was) had to consider the principles applicable to a case in which the owner of a garage in the Netherlands used the BMW trade mark in advertisements for his business, which specialised in the sale of second-hand BMW cars and in repairing and maintaining BMW cars, while not being part of BMW's official dealer network. The advertisements used expressions such as "Repairs and maintenance of BMWs", "BMW Specialist" or "Specialised in BMWs".

The ECJ was asked in what circumstances a trade mark proprietor could prevent a third party from using its mark for the purpose of informing the public that he carries out the repair and maintenance of goods which had already been put on the market by the proprietor under the trade mark, or that he was a specialist in the sale or repair and maintenance of such goods. The ECJ held that, if the advertising gave rise to the impression that the trader's business was affiliated to the trade mark distributor's distribution network or that there was a special relationship with the trade mark proprietor, then this would constitute taking unfair advantage of the distinctive character or repute of the trade mark. If, on the other hand, there was no risk that the public would be led to believe that there was a commercial connection between the trader and the proprietor, then the mere fact that the trader derived an advantage from the use of the trade mark as a result of the advertising statements – if they were otherwise honest and fair – would preclude the trade mark proprietor from being entitled to object. As observed by the Court, a reseller who sells second-hand BMW cars or an independent trader who carries out the maintenance and repair of BMW cars and in each case are genuinely specialists in those vehicles cannot communicate that information to customers without using the BMW mark. Whether in fact such advertising creates the impression that there is a commercial connection between the reseller and the trade mark proprietor is a question of fact to be decided on the circumstances of each case.

In the more recent *BMW v Technosport* case, the defendant, Technosport, dealt in the repair and maintenance of cars, mostly BMWs and Minis, but had no formal connection with BMW other than as purchaser and user of BMW manufactured spare parts. BMW complained about its use of the BMW roundel logo on a fascia board

outside its premises and on a banner inside another premises, on the outside of a van used in the business, and on business cards distributed to customers. The first instance judge concluded that the average consumer had come to believe that the BMW logo would only be used by authorised BMW dealers and therefore that this use amounted to infringement of the logo trade mark both on the basis of a likelihood of confusion and on the basis that such use took unfair advantage of the reputation of the mark. However, he concluded that the use of the BMW word mark adjacent to the name “Technosport” on T-shirts worn by the defendant’s staff, in the Twitter handle “@TechnosportBMW”, and in the form “TECHNOSPORT – BMW” on the rear of the van did not convey to the average consumer any implication that the defendant was an authorised dealer and thus did not infringe the BMW trade mark.

BMW appealed to the Court of Appeal on the latter part of the decision, arguing that the immediate juxtaposition of “Technosport” and “BMW” as a trading style gave rise to the risk that the average consumer might gain the impression that the businesses were commercially connected in some way, such impression being reinforced by the known practice of many authorised dealerships of using their name followed immediately by BMW. The Court’s starting point was that it could not be correct either that *any* use of the BMW mark in the course of a business specialising in the repair of BMWs would be an infringement, or that the use of “BMW” in relation to a car repairing service could *never* be an infringement. It said that a distinction was to be made between uses that convey the true message, “my business provides a service which repairs BMWs and/or uses genuine BMW spare parts” and those which convey the false message “my repairing service is commercially connected with BMW”, and that which of these messages is conveyed depends on a close consideration of the detail and context of use. The Court referred to the former (permissible) message as “informative use” and the latter (preventable) message as “misleading use”.

In the circumstances and context of use in *BMW v Technosport*, the Court of Appeal concluded that the use of the combined “Technosport BMW” signs was more than informative use and carried the risk that it would be understood as misleading use.

The Panel finds the concept of “informative” versus “misleading” use quite helpful in assessing whether a domain name is an Abusive Registration, though it is of course not a replacement for the tests of “unfair advantage” or “unfair detriment” which are set out in the Policy.

DRS Cases

Turning to the Policy the question the Panel has to determine is whether or not the use of a domain name that includes the Complainant’s trade mark, in conjunction with modifying terms, is Abusive where that domain name is linked to a website which (on the evidence) only provides goods (namely recycled spare parts) which originated from the Complainant and offers services (namely repair and servicing) of the Complainant’s products. Perhaps not surprisingly this is an issue which has featured in several previous DRS Appeals. Rather than repeat details of all of those here the Panel thinks it convenient to refer to the recent appeal case of D00016416, *World Wrestling Entertainment, Inc v. Daniel Raad*, <wwe-shop.co.uk> which reviewed the earlier cases and attempted to set out some guidance, as follows:

“The Panel does not think it is sensible to try to lay down rigid general rules directed at specific words or terms as cases will depend upon their own facts. However as a matter of broad principle, the Panel considers the position to be as follows in relation to cases where the complaint concerns a domain name where the alleged abuse is said to arise in respect of a website which is used to sell only the genuine goods or services of the complainant.

If:

- 1. a website is linked to a domain name; and*
- 2. the website is used to sell only the genuine goods or services of a third party; and*
- 3. the third party alleges the domain name is an Abusive Registration; and*
- 4. the third party has relevant Rights in respect of a name or trade mark.*

Then:

- 5. use of the name or trade mark concerned in unadorned form as a domain name is likely to amount to an Abusive Registration.*
- 6. Use of the name or trade mark concerned is also likely to amount to an Abusive Registration if the name or trade mark is combined with a term or terms that results in a domain name which would readily be considered to be that of the owner of the name or trade mark concerned.*
- 7. Such use is less likely to amount to an Abusive Registration if the name or trade mark concerned is combined with a term or terms that results in a domain name which would not readily be considered to be that of the owner of the name or trade mark concerned.*

In stating these principles the Panel would add as follows:

- 8. These are not absolute rules, hence the use of the terms “likely” and “less likely” – all relevant circumstances need to be taken into account and other factors may be relevant and result in a different conclusion being reached. As well as the modifying term itself such factors could include for example: the strength or fame of the name or trade mark in question; the nature and price of the goods or services being offered; the sophistication or otherwise of the likely consumers of such goods or services; questions of licence or permission; and any relevant contractual arrangements between the parties. Further factors such as the nature, appearance and content of the website to which the domain name is linked, and the extent to which any disclaimers are used on that website, may also be relevant in a given case if it appears appropriate to consider the case on the basis of matters beyond initial interest confusion.*
- 9. As stated above these principles apply where the website in question is selling only the goods or services of the owner of the name or trade mark concerned. If competing*

or counterfeit products are also or alternatively being sold then still further considerations may apply and a given domain name which would not amount to an Abusive Registration in accordance with these principles may nevertheless be found to be so when such additional considerations are taken into account.

It follows that in any given case the exact point at which a given domain name can be considered to be unobjectionable will depend upon all the facts, including of course the modifying term used. In the Seiko case (above) the Panel thought that “shop” fell the wrong side of the line. In the present case the Panel also considers “shop” to be the wrong side of the line. There is no evidence before the Panel that the letters “wwe” have any other meaning apart from in relation to the Complainant, and they have clearly been adopted by the Respondent, in combination with the term “shop” because of that meaning. The term “shop” itself is simply a very general term suggesting a retail operation – such a term might well be adopted by a trade mark owner to designate a web site which makes available its products for sale and in the opinion of the Panel the domain name wweshop.co.uk might reasonably be thought to be that of the Complainant, particularly when the Complainant operates substantially the same type of on-line retail business itself.”

In the present case the Panel notes that it has been provided with no evidence as to how the Complainant’s authorised dealers trade or what sort of domain names they use³. It has also not been provided with any evidence of actual confusion or as to how members of the public perceive the Domain Name. It is accordingly left to approach this issue on the basis of its own perception. It does so by applying the principles set out in the wwe-shop.co.uk decision (above) which it considers are applicable to the present case.

In the context of the sale of parts for motor cars and the servicing of motor cars the Panel considers that use of words such as “dealer” or “distributor” or “official” or “servicecentre” or “approved” as part of a domain name in combination with a trade mark are all likely to suggest an economic connection of some form with the trade mark owner. Conversely words such as “specialist” or “unofficial” seem to the Panel far less likely to suggest that type of connection. The word “spares” seems to the Panel to be borderline and if used on its own with the trade mark (as in for example jaguarspares.co.uk) may well be abusive. When used, however, with a further modifying geographic term (as in essexjaguarspares.co.uk) that seems to the Panel to fall on the right side of the line. Absent any evidence to the contrary it does not seem likely to the Panel that either the Complainant or its authorised dealers would use a domain name in the form [geographical area]jaguar[spares].co.uk; nor (absent any evidence to the contrary) does it seem likely to the Panel that Internet users who may come across the Domain Name (typically in a page of search results) would take it as being a domain name belonging to the Complainant or one of its authorised dealers. As the Expert put it in his decision:

³ The Panel acknowledges that the Appeal Notice contains a sentence stating that the Complainant’s dealers are not allowed to use “jaguar” in their domain names. The Panel does not consider this to be proper evidence, not least because of the prohibition in the Policy on introducing new evidence on appeal – see para. 20.3 of the Policy

“While Internet users may wonder who is behind the Domain Name, wondering is not the same as and falls short of believing. Nor, in my opinion, would the Domain Name “readily” be considered to be that of the owner of the trade mark concerned.”

The Panel takes the same view. The Panel considers that a fair reading of the Domain Name is to indicate (truthfully) a business of some kind, based in Essex, which deals in some way in spare parts for Jaguar cars. The Panel would have no difficulty in concluding that either “essexjaguar” or “jaguarspares” was too close to the unadorned form of the Complainant’s trade mark and hence could be abusive (depending on the rest of the facts) but the combined effect of “essexjaguarspares” is, in the Panel’s opinion, such as to take that name into an area which does not suggest that whoever is behind the Domain Name either is the Complainant or is authorised by, or economically connected to, the Complainant. To put it another way, and using the language of the *BMW Technosport* case (discussed above), the Panel takes the view that the use of the trade mark in conjunction with the two modifying terms in this case takes the domain name into the category of informative rather than misleading use of the Complainant’s trade mark and is therefore not abusive on the facts of the case.

As a footnote, the Panel would add that the appearance of the ‘caveat’ or disclaimer on the Respondent’s website has not been a material factor in reaching its decision. This will only be seen by someone who scans or scrolls down the landing page and, as the Complainant states, could be removed after a final decision. On the other hand, its presence serves to reinforce the impression given by the rest of the site that the Respondent is a Jaguar specialist as opposed to an authorised Jaguar dealer.

In reaching this conclusion the Panel acknowledges that it may be adopting a more liberal view (for the registrant) as to where the line is to be drawn than has been applied in at least some previous DRS cases. Care needs to be taken in reviewing previous cases as different considerations may arise (for example if the domain name in question is linked to a site selling products that do not originate from the trade mark owner). However, a review of previous DRS cases involving the Complainant (not including summary decisions) illustrates the point:

D00017826	jaguarrepairer.co.uk	transfer
D00017825	jaguarservicecentre.co.uk & others	transfer
D00018124	essexjagspares.co.uk & others	transfer
D00017594	westridingjaguar.co.uk	transfer
D00016811	jaguarevent.co.uk & others	transfer
DRS 03912	wwwjaguar.co.uk	transfer
D00017689	welovejaguar.co.uk & another	transfer
D00018665	thelandyclinic.co.uk	transfer
D00017207	landrover4u.co.uk	transfer
D00017102	rgblandrovers.co.uk	transfer
D00013170	new-landrover-defender.co.uk & others	transfer

Without going into all the facts of each case, and without deciding the point, it seems likely to the Panel that had it applied the approach set out in this decision to the above cases it would have reached the same conclusion as the expert in most, but not all, of the cases (i.e. that transfer was the appropriate remedy). It also seems likely, however, that in a small proportion of the cases it would have reached a different view. The

Panel has considered its decision in the light of this disparity and remains of the view that its approach is correct. First in borderline cases different panels may reach different conclusions – that is inevitable. Second and perhaps more importantly it is important to bear in mind that the DRS system is not intended to provide an alternative remedy for trade mark infringement cases. It is intended to provide a convenient and low cost system for dealing with the abusive registration of domain names. Given that a losing registrant will be deprived without compensation of the domain name in issue it is intended to apply only to clear cut cases. It is not intended to allow a trade mark owner to prevent all use of its trade mark in domain names owned by third parties (as the Complainant in the present case acknowledges). It accordingly follows that there may be cases where a particular set of facts should not lead to a finding of abusive registration, but where the trade mark owner is able to pursue remedies for trade mark infringement. That (in the opinion of the Panel) is as it should be.

The Panel reiterates that where the line between acceptable and non acceptable use is to be drawn depends upon all the facts of the case, but in the present case the Panel considers that the combination of the word “jaguar” with the words “essex” and “spares” into the Domain Name in the form essexjaguarspares.co.uk falls on the right side of the line and is not Abusive.

10. Decision

The Appeal is dismissed. No further action is required.

Dated August 11, 2017

Signed Nick Gardner

Signed Anna Carboni

Signed David King