

DISPUTE RESOLUTION SERVICE**D00018561****Decision of Independent Expert**

WBOC Ltd

and

Herts Motors

1. The Parties:

Lead Complainant: WBOC Ltd
Manufactory House
Cook + Partners
Bell Lane
Hertford
Hertfordshire SG14 1BP
United Kingdom

Respondent: Herts Motors
Herts Motors
Amwell Street
Hoddesdon,
HERTS EN11 9JL
United Kingdom

2. The Domain Name: webuyvanstoday.co.uk**3. Procedural History:**

I can 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.

17 February 2017 15:19 Dispute received
20 February 2017 11:05 Complaint validated
20 February 2017 11:10 Notification of complaint sent to parties
09 March 2017 01:30 Response reminder sent
09 March 2017 12:06 Response received
09 March 2017 12:06 Notification of response sent to parties
14 March 2017 01:30 Reply reminder sent

15 March 2017 14:33 Reply received
15 March 2017 14:33 Notification of reply sent to parties
16 March 2017 11:19 Mediator appointed
20 March 2017 12:20 Mediation started
24 August 2017 15:58 Mediation failed
24 August 2017 15:58 Close of mediation documents sent
31 August 2017 16:35 Expert decision payment received

4. Factual Background

The Complainant is the proprietor of registered trademarks as follows:

UK Trademark Registration no. 3015699 WEBUYCARSTODAY.COM, registered 22/8/2014

UK Trademark Registration no. 3162884 WEBUYVANSTODAY.COM SELL YOUR VAN THE EASY WAY WITHWEBUYVANSTODAY, registered 2/9/2016

The domain names <webuycarstoday.com> and <webuycarstoday.co.uk> were registered on 14 October 2010 by WBCT Ltd, the predecessor in business of the Complainant.

On 1 January 2015 WBCT Ltd assigned the domain names, trademark registration and goodwill in the trademark WEBUYCARSTODAY.COM to the Complainant.

The Respondent has operated as a trader in motor vehicles, and specifically in commercial vehicles since 1989.

The Respondent registered the Domain Name on 15 November 2012. It currently resolves to a parking page containing a number of sponsored links relating to vehicle purchase, insurance and other services.

5. Parties' Contentions

I have attempted to summarise the Parties' submissions below. This has not been an easy task because of the length of the Complaint, to which the Respondent has necessarily been obliged to respond in equal measure. I have attempted to draw out, from these extensive submissions, such points as I think are relevant to the application of the DRS Policy.

Complainant's Rights

The Complainant claims rights in the Domain Name as follows:

It is the registered proprietor of UK Trademark registration no. 3015699 for the mark WEBUYCARSTODAY.COM registered on 22 August 2014.

It, and its predecessor in business, have been using the marks WEBUYCARSTODAY.COM and WEBUYCARSTODAY.CO.UK for at least five years, giving rise to substantial goodwill in these marks throughout the UK.

It is the registered proprietor of UK Trademark registration no. 3162884 for the mark WEBUYVANSTODAY.COM SELL YOUR VAN THE EASY WAY WITH WEBUYVANSTODAY registered on 2 September 2016.

Abusive Registration

The Complainant argues that the Domain Name is an Abusive Registration because it was primarily registered to prevent the Complainant from registering it despite the earlier rights the Complainant has in the name.

The Complainant asserts that the domain name <webuycarstoday.com> was registered on 14 October 2010 by WBCT Ltd. This company began trading under the trademark WEBUYCARSTODAY.COM at least as early as 4 November 2011. The domain name, trademark and goodwill in the mark WEBUYCARSTODAY.COM were assigned to the Complainant on 1 January 2015.

The Complainant points out that the Respondent registered the Domain Name on 15 November 2012, over a year after the first use of the Complainant's trademark WEBUYCARSTODAY.COM. The Complainant claims to have made extensive and continuous use of this mark since this time.

The Complainant argues that the Respondent's business is the purchase and retail of vans and, as such, it competes with the Complainant. The Complainant's view is that the Domain Name is visually, aurally and conceptually highly similar to the Complainant's mark. The Complainant argues that it only differs visually from its mark by two letters which occur in the centre of the mark and the <. com> suffix. The Complainant further argues that, conceptually, vans are similar to cars and there is likely to be an expectation that a party offering a service purchasing cars under a particular trademark will also offer to purchase vans under that trademark.

The Complainant believes that if the Respondent uses the Domain Name the public are likely to consider the services being provided are the Claimant's, or commercially associated or endorsed by the Complainant. As such, this will lead to misrepresentation in the mind of the public and damage to the Complainant through loss of sales or damage to its reputation.

The Complainant maintains that its trademark WEBUYCARSTODAY.COM is registered for services identical to those provided by the Respondent, namely, "Purchasing services connected with motor vehicles" and, "Retail services connected with the sale of vehicles". On this basis, the Complainant believes it has grounds for an action against the Respondent for trademark infringement.

According to the Complainant, the trademark WEBUYCARSTODAY.COM is visually, aurally and conceptually similar to the Domain Name. Vans and cars are both closely related motor vehicles with some, such as, 'pick-ups' being a cross between the two. In addition, the Complainant states that its trademark WEBUYVANSTODAY.COM SELL YOUR VAN THE EASY WAY, AT WEBUYVANSTODAY is registered in respect of "Purchasing services connected with motor vehicles" and, "Retail services connected with the sale of vehicles".

The Complainant argues that it is common for businesses to develop into associated markets and, the average consumer will expect the interchange of the word, “Cars” to, “Vans” to designate the same, or economically linked, undertakings.

The Complaint points out that the Domain Name contains the dominant and distinctive element of this trademark, namely, WEBUYVANSTODAY in its entirety. As such, the Domain Name is visually, aurally and conceptually highly similar to the Complainant’s trademark. The Complainant repeats its allegation that the Respondent’s services are identical to those protected under the Claimant’s trademark registration and that, in light of the similarity of the marks and the identity of the services there exists a likelihood of confusion. As such, the Complainant’s view is that any use of the Domain Name by the Respondent in relation to the services of its business will again constitute trademark infringement.

The Complainant believes that evidence of an Abusive Registration arises from the fact that Respondent has not used the Domain Name in the four years it has been registered. The Complainant points out that it is being used to advertise services that are in direct competition with its business. Clicking on one of the links for “Buy Used Vans” returns the, ‘Ads’ page in which part-exchange of vehicles is advertised. This is in direct competition to the Complainant’s services and is being advertised under a sign that is highly similar to the Complainant’s trademark.

On 3 October 2016 the Complainant states that it approached the Respondent with an offer of £1000 to purchase the Domain Name and <webuyvanstoday.com>. The offer was substantially more than the Respondent’s costs in registering these domain names. This purchase offer was refused on the basis that it was insufficient.

The Complainant argues that, as the business premises of the Parties were relatively close to each other and that the Complainant’s vehicles bore its trademark, it is highly likely on the balance of probabilities that the Respondent would have seen the Claimant’s vehicles and, therefore, its trademark prior to registering the Domain Name and thus been aware of the Complainant’s prior rights.

Response

The Respondent challenges the validity of the Complainant’s trademarks, claiming that the words used are merely descriptive. The distinctiveness of the Complainant’s mark lies in the choice of colours, typeface and layout.

The Respondent challenges the Complainant’s claim to have been trading consistently for a period of 5 years. It points out that the Complainant’s predecessor in business filed only one set of accounts between November 2011 and January 2016 and that this company was compulsorily struck off the register on 19 January 2016. The Respondent points out that the Complainant company’s first set of accounts was filed in July 2015 showing a loss of £21,000.

The Respondent claims he was contacted by the Complainant prior to 2016 and was informed that the Complainant planned to extend their business to include the purchase and sale of vans, and that it wanted to acquire the Domain Name from the

Respondent. The Respondent maintains that the Domain Name was not for sale and that the Complainant was so notified in this call.

The Respondent asserts that the Complainant subsequently registered its trademark WEBUYVANSTODAY.COM SELL YOUR VAN THE EASY WAY WITH WEBUYVANSTODAY when the Domain Name and its .com equivalent were not in its possession and (as the Respondent had expressly informed them) not for sale.

The Respondent argues that the trademark registered by the Complainant contains the generic expression “we buy vans today” in a conflated form. Such distinctiveness as the mark possesses resides in the varied colours of the text and the format of the logo as a whole. In the Respondent’s view, the trademark suggests association with the .com domain which it does not own, but does not retrospectively give rights to ownership of the Domain Name.

The Respondent denies the Complainant’s claim that the Domain Name was registered as a blocking registration to prevent the Complainant acquiring it. The Respondent can show a continuous trading history since 1989, involving the purchase and sale of commercial vehicles. The Respondent insists that the Domain Name was purchased with an intention to use it for a website capable of sourcing commercial vehicles from prospective sellers and offering these for sale on trade or retail terms from its premises.

The Respondent notes that the Complainant has registered, in January 2016 the domain names

webuycommercialstoday.co.uk
webuycommercialstoday.com
webuyvantoday.co.uk
webuyvantoday.com

The Respondent poses the question as to whether or not these registrations might constitute **abusive** registrations, unfairly detrimental to the Respondent’s rights. The domain name <webuyvantoday> was unquestionably registered in the knowledge that the Respondent owns the Domain Name and can show a trading history of buying and selling vans. The only difference between the Domain Name and the Complainant’s more recent registration is a single letter signifying the difference between “van” in the singular and “vans” in the plural.

The Respondent also notes that while the Complainant has registered the domain names listed above, it has not followed its earlier practice of registering them as trade marks, whereas they have, in January 2016 registered a trademark incorporating a domain name which they do not possess.

The Respondent denies that the Complainant’s offer to buy the Domain Name was refused because it was insufficient. It was refused on the basis that the Respondent is a van dealer and the Domain Name is of use in its business. Accordingly, the Domain Name was not and is not for sale because the Respondent intends to make use of it.

The Respondent disagrees with the Complainant's allegation of an intention on its part to mislead the public. The Parties products and target markets are different, their trade dress is different and their trading names are different.

The Respondent points out that the Complainant's reasoning could allow it to use its trade mark registrations to lay claim to a potentially wide range of domain names using the formula "we buy [whatever products we chose to diversify into] today". By way of example, the Respondent asks whether the Complainant might claim rights in webuytyrestoday
webuymotorbikestoday
webuymotorstoday
webuyboatstoday

The Respondent questions the Complainant's right to appropriate domain names on this basis relating to any commodity that it may in the future decide to start sourcing.

The Respondent challenges the Complainant's claims that its registration of the Domain Name was motivated by a wish to interfere with its successful and expanding business. The Respondent argues that the Complainant offers no convincing evidence that it is trading at all, nor that its business is in any way affected by the Respondent's registration of the Domain Name.

The Respondent also denies that it holds the registration in order to block the Complainant from obtaining it. The Respondent points out that it registered the Domain Name three years before the Complainant's decision to diversify into vans. It is within its rights to take the time it thinks fit to create a suitable website at the Domain Name address.

Complainant's Reply

The Complainant exercised its right to submit a Reply to the Response. The Complainant broadly re-asserts arguments made in the Complaint, re-stating the validity of its trademarks and refuting the Respondent's arguments suggesting that the trademarks were registered in bad faith. The Complainant further argues that the Respondent's arguments about the Complainant's trading history and Companies' House filings are ill-founded and irrelevant. The Complainant also repeats its assertion that the Domain Name is a blocking registration by the Respondent and that the Respondent's delay in making use of the Domain Name supports this argument.

6. Discussions and Findings

Introduction

This Complaint falls to be decided under Version 4 of Nominet's Dispute Resolution Service Procedure, applying to cases brought after October 1st, 2016.

Scope of DRS Procedure

The Complainant, through its legal advisors, has put forward an extremely long submission, to which, perforce, the Respondent has had to make an equivalently lengthy Response. Much of what has been submitted relates to the Complainant's belief that the Respondent is liable under the common law tort of passing off, and/or guilty of trademark infringement under the 1994 Trademark Act.

Version 2 of the DRS Expert Overview on the Nominet website offers guidance to potential parties to DRS disputes and contains the following paragraph from the Chairman's Introduction:

Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the registrant's use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy. Nonetheless, if the DRS Policy and the law are too far apart, the DRS Policy will inevitably lose some of its value. Rights owners or domain name registrants (depending upon the nature of dispute) may prefer the expense of litigation to the likely result under the DRS Policy.

The relevant terms of the DRS Policy are explained below. Submissions relating to trademark infringement or liability for passing off fall outside my remit as Expert and I offer no view on them.

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's claim to Rights in a name which is identical or similar to the Domain Name is based upon its trademark registrations of three marks:

WEBUYCARSTODAY.COM

WEBUYCARSTODAY.CO.UK

WEBUYVANSTODAY.COM SELL YOUR VAN THE EASY WAY WITH
WEBUYVANSTODAY

The Complainant also claims rights at common law, based upon the goodwill generated in the first two of the above marks during its trading history.

It can be seen from this list that only the last registration incorporates (twice as it happens) the conflated expression WEBUYVANSTODAY which forms the whole of the third level of the Domain Name. This mark was registered in 2016, some four years after the registration of the Domain Name by the Respondent. The other two marks, using WEBUYCARSTODAY as their principal element, pre-date the Domain Name registration. It is on these two latter registrations that the Complainant relies to establish its trading history and resulting goodwill. The Complainant argues that the conceptual closeness of vans to cars, and the formulaic use of these words in WEBUYVANSTODAY and WEBUYCARSTODAY shows sufficient proximity to the Domain Name to establish rights for the purpose of this Complaint. I am not persuaded that the equivalence is as convincing as the Complainant suggests. In common usage it is entirely plausible to argue that cars are cars and vans are vans and these collective nouns denote identifiably separate products, separate users and separate target audiences for sales and marketing purposes. However, the Rights threshold in the DRS Procedure is by general agreement designed to be low, aiming simply to establish that a complainant has a good faith basis for making its claim. As such, on the grounds that the expression WEBUYVANSTODAY appears in the third of the Complainant's trademark registrations listed above, I am prepared to accept that the Complainant has rights sufficient to bring this Complaint.

Abusive Registration

The DRS Policy requires the Complainant to show on the balance of probability, that the registration is Abusive in the Respondent's hands. The main thrust of the Complaint is the alleged liability of the Respondent for trademark infringement and/or passing off. I repeat that these matters are beyond the scope of the DRS Policy. Accordingly, I intend to limit discussion to those matters in the Complainant's case addressed by the DRS Policy, paragraph 5.1 of which sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Factors relevant to this Complaint are found in sub-sections 5.1.1 and 5.1.2 of this paragraph as follows:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2. as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3. for the purpose of unfairly disrupting the business of the Complainant;

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;

Translated into the terms of the DRS Policy, the Complainant argues that an offer to buy the Domain Name, for a sum higher than the Respondent's costs in registering it, was rejected by the Respondent as insufficient, contrary to paragraph 5.1.1.1 above.

The Respondent denies that it rejected the Complainant's offer to sell the Domain Name because it was not high enough. The Respondent insists that it told the Complainant that the Domain Name was not for sale.

The Complainant also claims that the Domain Name in the hands of the Respondent is an Abusive Registration because it was primarily registered to prevent the Complainant from acquiring it, contrary to paragraph 5.1.1.2 above.

The Respondent's position is that it registered the Domain Name some years before the Complainant announced its intention to diversify into commercial vehicles and thus could not logically be accused of registering it to deny the Complainant the opportunity to do so.

The Complainant further argues that the Parties compete directly with one another and that the Respondent will have been aware of the Complainant's name and reputation when registering the Domain Name. Given the Domain Name's similarity to the Complainant's trading name, the Respondent is thus unfairly disrupting the Complainant's business, contrary to paragraph 5.1.1.3 of the Policy.

The Respondent argues that there is no evidence of damage to the Complainant's business as there is insufficient evidence of the Complainant's trading activity on which to form a judgement. This portion of the Complainant's case rests upon the proposition that the Parties are in direct competition with each other, which the Respondent refutes.

Finally, the Complainant argues that 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, contrary to paragraph 5.1.2 above. The Complainant's case, (insofar as it can be articulated in terms of the DRS Policy), is that the Domain Name is similar to marks in which it has rights and this similarity has caused, or on the balance of probabilities will cause, confusion as to the identity of the Domain Name proprietor.

The Respondent's view is that confusion is highly unlikely as the Parties trade under very different names, in different locations and address entirely different markets. The Complainant wants the Domain Name because it wants to diversify into a market where the Respondent has successfully traded for many years. As an indication of its intentions in this regard, the Complainant registered a trademark incorporating the Domain Name, which it does not own or operate.

Reviewing the arguments of the Parties, I find the Respondent's case to be the more persuasive. The Complainant relies upon the proposition that its trademark and common law rights in WEBUYCARSTODAY.COM, acquired in 2010, are broad enough to prevail over the use of the expression "we buy vans today" when used in a similarly conflated form in the Domain Name, registered in 2012. This is not the

correct basis for deciding if the Domain Name is an Abusive Registration under the DRS Policy. When registering the Domain Name, it is not obvious to me that the Respondent would be aware of a cause for complaint by the Complainant. While I accept that the Respondent's failure to use the Domain Name for a period of more than four years weakens its case to a degree, such delay does not automatically point to a blocking registration. The Respondent's assertion that it will not sell the Domain Name and that it has genuine plans for its use seems to be plausible on this occasion.

I have found that the Complainant has Rights in a name which is identical or similar to the Domain Name under the DRS Policy. This is based upon the trademark registration WEBUYVANSTODAY.COM, which post-dates the Domain Name registration. Allowing that this registration gets the Complainant past the DRS Rights test does not however mean that these Rights are necessarily unfairly prejudiced by the Respondent. The Complainant has not submitted evidence which allows me to conclude, on the balance of probabilities, that such unfair prejudice has arisen or is likely to arise in the future. I do not believe that confusion on the part of the public is self-evidently likely under the trading circumstances described by the Parties.

I accept that there is a material distance in practice between the Parties' respective businesses. As such, it seems to me that the difference between WEBUYCARSTODAY and WEBUYVANSTODAY is more than the two letter orthographical difference relied upon by the Complainant. Moreover, the Complainant's tactic of including in its trademark registration (for WEBUYVANSTODAY.COM) a domain name already in the Respondent's possession, is, in my view, a flawed means of establishing entitlement to proprietorship of the Domain Name in this case. If the Complainant believes that the Respondent has infringed its legal rights under the Trademark Act or at common law, it is entirely free to pursue these matters through the courts.

7. Decision

For the reasons given above I find that the Complainant has Rights in a name identical or similar to the Domain Name. However, the Complainant has not succeeded in establishing that the Domain Name is an Abusive Registration in the Respondent's hands. No action to be taken.

Signed: Peter Davies

Dated: 20 September 2017