

DISPUTE RESOLUTION SERVICE

DRS 7184

Decision of Independent Expert

Renault SAS (Non-UK Corporation)
and

Dhugal Clark (UK Individual)

1. The Parties:

Complainant: Renault SAS
Contact Name: Nathalie Dreyfus

Address: 13/15 Quai Alphonse Le Gallo
Boulogne Billancourt
Postcode 92100
Country: France

Respondent: Dhugal Clark
Address: 8 Middleham Street
Manchester
Postcode: M14 7NG
Country: GB

2. The Domain Names:

renaultexpress.co.uk
renault-shop.co.uk
renaultpoint.co.uk
renaultplus.co.uk
renaultstop.co.uk
renaultshop.co.uk

3. Procedural History

The Complaint was received on 12 October 2009 and validated by Nominet on 13 October. A Response was received and notified to the Parties on 2 November. On 10 November, the Complainant issued a Reply to the Response. The Complainant's payment in respect of a full expert decision was received on 22 December. On 23 December 2009 Nominet invited the undersigned Peter Davies ("the Expert"), to act as Expert in the case. On the same date Peter Davies confirmed to Nominet that he knew of no reason why he could not properly accept the invitation, and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality. The Expert's appointment is dated 23 December 2009.

4. Outstanding Procedural Matters

None

5. Factual Background

The Complainant is a vehicle manufacturer and the owner of a number of trademarks and domain name registrations based on the trading name "Renault". The Respondent, in business on his own account, registered certain of the Domain Names in January 2007 and others in October 2008. The Respondent also registered domain names incorporating the Complainant's trading name with the .com suffix.

In their submissions, the Parties refer frequently to "the disputed domain names", meaning both the .com domain names incorporating the Complainant's trade name and the Domain Names at issue in this Complaint. This Decision concerns only the Domain Names set out in paragraph 2.

6. Parties' Contentions

In summarising the Parties' submissions, the Expert refers only to "the Domain Names" for the sake of brevity. However, for the purpose of understanding what the Parties themselves have submitted, this expression may be taken to include the other disputed domain names where the context allows. The Expert has reviewed the evidence submitted by the Parties in support of their contentions and summarises them as follows:

6.1 The Complainant

The Complainant has rights in respect of a name or mark that is identical or similar to the Domain Names.

The Complainant is a leading manufacturer of motor vehicles. The Renault group is currently the world's 4th largest auto maker. It has been present in the United Kingdom since shortly after the First World War and has been a constituent of the French CAC40 index since 1995.

The Complainant has commercial and industrial sites worldwide and offers services such as financing, car rental, maintenance and assistance. It operates in 118 countries, employs 129,000 people and manufactured 2.4 million vehicles in 2008. It is the market leading European brand for utility vehicles. In the first half of 2009, the Complainant's market share of European cars was 8.4 %.

The Complainant is present in the UK through its subsidiary Renault UK Ltd, whose business is marketing Renault passenger cars and light commercial vehicles. There is wide UK press coverage of the Complainant and its activities.

The Complainant owns and communicates on the Internet through various websites. The main one is www.renault.com, but the Complainant has also registered local websites such as www.renault.co.uk. These websites allow Internet users to view models and other customer information.

The Complainant owns RENAULT trademarks throughout the world, including:

- UK Trademark RENAULT 471164 registered on July 5, 1926, covering goods in class 12.
- UK Trademark RENAULT 695493 registered on January 23, 1951, covering goods in class 12.
- UK Trademark RENAULT 1524096 registered on August 12, 1994, covering goods in class 16.
- Community Trademark RENAULT + logo 000089763 registered on December 17, 2001, covering goods and services in classes 2, 4, 7, 8, 9, 11, 12, 14, 16, 18, 24, 25, 27, 28, 34, 36, 37, 39, 40, 41 and 42
- International Trademark designating the United Kingdom RENAULT 533627 registered on January 12, 1989, covering services in classes 35, 36, 37, 38, 39, 40, 41 and 42.

The Complainant operates many domain names incorporating its trademarks including: www.renault.com and www.renaultshop.com. The Complainant and its subsidiary Renault UK Ltd own and operate renault.co.uk through which it offers products and services in the UK. This domain name was registered before August 1996, more than 10 years before the registration of the Domain Names.

The trademark RENAULT has been protected since 1999 in the European Union, several years before the registration of the Domain Names. The Respondent could not be unaware of the trademark owned by the Complainant.

The addition of the words "shop", "express", "plus", "point", "your" and "stop" are insufficient to give any distinctiveness to the Domain Names. These terms are common English words and adding generic words is not sufficient to distinguish

the Domain Names from the Complainant's trademarks (DRS 2455, Compaq Trademark B.V. v. Balata.com LLC).

The ".co.uk" extension must not be considered significant as it simply denotes the country code and is therefore descriptive.

The term "Renault" is known only in relation to the Complainant. It has no meaning whatsoever in English or in any other language. A Google search of the word Renault displays several results, all related to the Complainant.

The registration of the Domain Name is an Abusive Registration

The Respondent is not affiliated to or authorised by the Complainant in any way.

The Respondent has no prior rights or any legitimate interest in the Domain Names. When the Respondent faxed the Complainant to sell the Domain Names, he did not take the opportunity to state his rights or interest in the Domain Names. The Complainant's rights in the RENAULT trademark precede the Respondent's registration by a considerable length of time.

Respondent is not known under the name "Renault" or any similar term.

The Respondent is not making legitimate, non-commercial use of the Domain Names as they had hitherto resolved to a page offering them for sale. The Domain Names now resolve to a blank page. The Respondent uses the Domain Names to generate revenue. The Respondent has no other reason to choose domain names incorporating the trademark "RENAULT" than to profit from the Complainant's goodwill (DRS6524, Expedia, Inc. v. Bluestone Ventures Pty Ltd).

The reproduction by the Respondent of "Renault" combined with generic and descriptive terms such as "point", "stop", "shop" or "express", proves that the Respondent was aware of the existence of Complainant's trademark. Furthermore, the Respondent registered eleven domain names similar to the Complainant's trademark primarily for the purpose of selling them.

6.2 The Respondent

The registration of the Domain Names is not an Abusive Registration:

EU block exemption and anti-monopoly laws aim to erode the restrictive practices of large oligopolies, The Respondent believes that there will be a growing number of small businesses wanting to take advantage of this, providing specialist services for manufacturers' vehicles. This applies particularly to the motor trade where slow implementation of the block exemption regulations has restricted this expansion.

The Domain Names were registered with the intention of providing websites to run in co-operation with Renault SAS. The 'stop' and 'your' domains were potentially more suitable for non-trading forum sites. The Domain Names were registered to enable the provision of fair competition.

The inclusion of a trademarked word within a domain is not prohibited. The Complainant did not have any mark identical to the Domain Names. Trademarks require precise reproduction of lettering, not incorporation, for infringement to apply. The Complainant was clearly aware of this when they registered extensions of their main trademarks. No trademarks existed for any of the Domain Names.

Trademark infringement requires “Use of a trademark in the course of trade”. While the Respondent registered the Domain Names intending to conduct legal business at some point after registration, no trade could be said to have occurred, as no income has been generated. The Domain Names have not been registered with any search engines and no attempt has been made to attract traffic. The number of hits to the Domain Name sites is very low and could be accounted for by the Respondent’s activities and by the Complainant in the period prior to the Complaint.

The Respondent aims to provide bona fide competition by offering goods and services via some domains, and non-commercial use for others. The Respondent aims to use the non-hyphenated Domain Names to provide a range of sales and services, with each domain having different focus. This is no different to other companies currently operating with Renault included in their name. As the trade would be Internet based, and the sites accessible throughout the EU, an attempt to remove the Domain Names from his possession should be seen as ‘An abuse which may affect trade between Member States’.

Many other trading websites exist, incorporating ‘Renault’ and known to the Complainant, which have not been subject to interference. The owners of <http://www.renault-spares.co.uk> were contacted by the Complainant’s solicitors, complaining of logos, but no comment was made about inclusion of ‘Renault’ within their domain.

The Respondent has written ten thousand lines of code for use with the Domain Names. This permits the sale of vehicles and parts, storing of customer favourite vehicles, email marketing, booking and supply of services, all integrated with email notifications and marketing to registered customers. Although not all modules would be immediately applicable, their relevance will increase as implementation of EU anti-monopoly law develops. It would have been fruitless to write the code before registering the Domain Names as they would have been registered by the time the code was finished. The code was completed a year ago and is ready for use.

Companies House confirms that the Respondent would have been allowed to register the company names RenaultShop Ltd, YourRenault Ltd, etc. According to Paragraph 26c of the Companies Act 1985, clearly in force at the time of registration, it would only be rejected if it were ‘the same as a name appearing in the register’, i.e. identical. They confirm that they do not check the Trademark Registry when deciding whether a name is permitted. No rights are afforded to any entity, in the registration of new company names, because of their previous similar registrations. Therefore, the Respondent may register companies corresponding exactly to the Domain Names. The registration procedure does not allow rejection of a name by similarly named companies. Evidence is submitted of businesses incorporating ‘Renault’ in their name. If the Respondent can register a

company called RenaultShop Ltd, no permission should be needed to register a domain name 'RenaultShop.co.uk'.

Trading Standards confirm that it is legal for the Respondent to operate a company, including the word Renault in the name, which offers products or services for Renault vehicles, provided no attempt is made to falsely 'pass off' goods or services.

Trading Standards agree that it is in the public interest to be able to find and easily identify businesses that supply services for Renault vehicles, and it is correct and advisable for a company to include the word Renault in its name and domain if it is providing services exclusively for Renault vehicles. They stated 'How else would the consumer know that a business was providing services for Renault vehicles?'

Responses to Complainant's points

The statement that 'no answer' was sent to the Complainant's reminder on May 22nd is false. The Respondent answered within 30 minutes.

The Complainant expressed a wish to reach an amicable settlement. It is hard to believe that this is possible when the first communication was a demand to transfer legal rights and to pay huge expenses to have that occur. The Respondent tried to reply, but had many other claims upon his time.

The Complainant states that it operates many domain names. RenaultShop.com redirects traffic to RenaultShop.fr in the same way that abusive registrations sometimes redirect to unrelated sites. Renault does not 'operate the domain name' and it is unlikely that there has ever been a unique site associated with it. The Respondent accepts that the Complainant registered RenaultShop.com before the Respondent registered RenaultShop.co.uk. The Respondent had no knowledge of this at the time of registration and was unaware of it until notified by the Complainant. When making a registration, it is impossible to check the ownership of previously registered domains, and largely irrelevant.

The statement 'Complainant has rights in respect of a name or mark that is identical or similar to the Domain Names' is misleading. The Complainant has rights in respect of one of the two words within the Domain Names. The claim that 'that the mere adjunctions of the words ... are insufficient to give any distinctiveness to the Domain Names' is false. Adding words increases distinctiveness and *reduces* the likelihood of confusion. The Complainant's argument suggests that Renaultpartsgateway.co.uk is even more likely to be confused with Renault.co.uk. The quoted case DRS2455 is irrelevant because no words have been added to form the domains, which are effectively spelling mistakes.

This statement that "the term "Renault" is unique and is only known in relation to Complainant" is false, wrongly imputing exclusive rights to the word 'Renault'. Jean Antonin Renault founded the Renault Company in 1835, producing brandy, and registering Trademark 6030 'RENAULT & CO.' in 1876. The Company has no connection to Renault SAS. The use of the word 'Renault' to describe a brandy

pre-dates the earliest use of the word 'Renault' to describe a vehicle by at least sixty years. It cannot be right to forcibly transfer the Domain Names to a company with a later interest in the word 'Renault'.

The Respondent does not have to be affiliated to Renault to provide services for Renault vehicles. There is no requirement to seek permission from the Complainant to register the Domain Names. Any such requirement would be contrary to EU competition and single market rules.

The Respondent "did not take this opportunity to state its rights and.. interests" previously *in depth* because he was not asked to do so.

The statement that "the Respondent is not known under the name Renault" is irrelevant, as the case is about RenaultShop et al. It is legal for the Respondent to be known by a phrase including the word 'Renault', provided no attempt is made to falsely pass off goods or services as from the Complainant.

The Respondent made preparations for legitimate use of the Domain Names, but cannot be expected to trade immediately or publicise future competition. The Domain Names were made available in a fair manner while preparations were made for their use, at a price affordable to individuals and insignificant to a large company. The Complainant chose not to accept the terms of sale. The Respondent was entitled to quote a price which reflected the added value he had created. However trade in domain names is not the Respondent's aim. The Respondent accepts that, having invested heavily in the Domain Names, his attitude towards selling them changed, and that the offer to sell them should not have been left on the site to which the Domain Names resolved. The Respondent could not be said to have tried to sell the Domain Names. He merely re-iterated a price at which they could be bought, as the Complainant appeared not to understand the crystal clear text on the web pages.

6.3 Reply to the Response

The Complainant exercised its right to submit a Reply to points raised by the Respondent. In this summary of the Reply, the Expert has omitted those points which merely re-state matters set forth in the Complaint.

The Respondent states that it has spent a considerable amount of time and effort preparing a PHP code for the Domain Names. However, the fact that he prepared this PHP code constitutes neither a bona fide offering of goods and services nor a demonstrable preparation to use. The date of creation of the PHP code cannot be ascertained, but, as far as Complainant knows, the document seems to have been created on October 30, 2009. The Domain Names were registered between 2007 and 2008; thus Respondent would have had more than a year to set up the websites that he was intending to create. Furthermore, the Respondent could always use this PHP code for any domain name, as the Domain Names never appear in the PHP code.

7. Discussions and Findings

General

The Expert is required to apply only DRS Policy and Procedure to the Complaint. Apart from the requirement that a Complainant must show he has Rights which are enforceable under the laws of the UK or of another country, DRS Procedure does not attempt to apply the law to Complaints, or to replace legal proceedings.

The Respondent's submissions rely heavily upon discussion of UK and EU law relating to trademarks, competition, company registration, and trade between member states of the European Union. The Respondent offers an interpretation of the law relating to trademarks which challenges the Complainant's claim to have enforceable Rights in respect of a name which is identical or similar to the Domain Names. This falls properly within the scope of the Complaint. However the Respondent's arguments relating to his legal position in registering the Domain Names and to the anti-competitive behaviour of the Complainant are not relevant in the context of the DRS Policy.

The Complainant's Rights

Paragraph 2 (a) of the DRS Policy provides that, in order to succeed, the Complainant must show that

- i. the Complainant has Rights in respect of names or marks which are identical or similar to the Domain Names; and*
- ii. the Domain Names, in the hands of the Respondent, are Abusive Registrations.*

The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

The Expert accepts that the Complainant has rights in the name Renault by virtue of its registered trademarks and the goodwill acquired in the course of its business over many years. The Respondent argues that the Complainant's position is weakened by the existence of an earlier Renault entity operating in a different market. This does not, in the Expert's view, compromise the Complainant's Rights in its trading name.

The Respondent argues that the Complainant's rights are limited to its trading name and its registered trademark. He argues that the combinations of words in the Domain Names create new trading identities over which, in the absence of an intention to deceive on the part of the Respondent, the Complainant may not exert control. The Expert does not agree with this view. The addition of generic or descriptive terms designating the goods or services with which a mark is used does not affect the similarity between the Domain Names and the mark in which the Complainant has Rights.. Accordingly, the Complainant meets the first requirement of the Complaint.

Abusive Registration

DRS Policy states that 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

Paragraph 2 of the DRS Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration which includes the following:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. 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;*
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or*
 - C. for the purpose of unfairly disrupting the business of the Complainant;**
- ii. 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;*

Paragraph 4 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration including the following:

- i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:
 - A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;**

The Complainant alleges that the Respondent's aim is to sell the Domain Names in contravention of Paragraph 2.i.A of the Policy. The Respondent claims to have made no money from his ownership of the Domain Names and that he was

making good faith preparations to use the Domain Names in connection with a genuine offer of goods or services. However, the Respondent does not dispute that prior to the Complaint the Domain Names resolved to pages carrying the Respondent's offer to sell the Domain Names. The Respondent offers an explanation for this fact which is not sufficiently persuasive to avoid a conclusion, on the balance of probabilities, that there was an intention to offer the Domain Names for sale, as contemplated by Paragraph 2.i.A of the Policy. The Respondent admits that a continuing offer for sale took place, and irrespective of his intentions, this could be seen as abusive.

The Respondent seeks to show that he made preparations to use the Domain Names, in accordance with Paragraph 4.i.A of the Policy, and provides evidence in the form of a computer programme. The probative value of this evidence is uncertain however, as it makes no reference to Renault and is not dated, labelled or explained in any way that might connect it unambiguously to the Respondent's defence of his actions.

The Expert therefore finds, on the balance of probability, that the Registrations are Abusive Registrations in the hands of the Respondent.

8. Decision

The Complainant has Rights in respect of names or marks which are identical or similar to the Domain Names and the Domain Names, in the hands of the Respondent, are Abusive Registrations. The Expert directs that the Domain Names be transferred to the Complainant.

Signed: Peter Davies

Dated 15 January 2010