

DISPUTE RESOLUTION SERVICE

DRS 8934

Decision of Independent Expert

We Buy Any Car Limited

and

Midlands Car Disposal)

1. The Parties:

Complainant: We Buy Any Car Limited
Address: Nixon Street
Rochdale
Lancashire
Postcode: OL11 3JW
Country: United Kingdom

Respondent: Mr Guiseppe Randino
Address: 515 Woodway Lane
Coventry
Warwickshire
Postcode: CV2 2AG
Country: United Kingdom

2. The Domain Name(s):

webuyanymotors.co.uk

3. Procedural History:

The Complaint was filed on 17 August 2010 and validated by Nominet on the same day. The Complaint was subsequently sent to the Respondent on 23 August 2010 noting that the Dispute Resolution Service had been invoked and that the Respondent had until 14 September 2010 to submit a response. No response was received by the Respondent as required by paragraph 5a of the Procedure. On 21 September 2010 the Complainant paid the fee to refer the matter to an expert for a decision to be made. I was subsequently appointed, having confirmed my independence.

Having seen copies of the notification of the Complaint to the Respondent, I have no reason to doubt that the Respondent has been properly notified of the Complaint as required by the Procedure. I also do not have knowledge of any exceptional circumstances (under paragraph 15b of the Procedure) that should prevent me from proceeding to a Decision on the Complaint based on the Complainant's submissions alone.

Notwithstanding the Respondent's lack of response, the Complainant must still prove its case on the balance of probabilities.

4. Factual Background

The Complainant is a UK limited company that has operated under the name of "WEBUYANYCAR" and "WEBUYANYCAR.COM" from August 2006. It also uses these marks in a slightly stylised form and with and without gaps between the words.

The "WEBUYANYCAR.COM" brand has been used in the United Kingdom from its incorporation in August 2006 in television, radio, national, local and auto press, online and outdoor advertisements.

The Complainant's main website is at www.webuyanycar.com, which extensively uses the "WEBUYANYCAR.COM" brand. The Complainant also controls the domain name webuyanycar.co.uk, which I note also resolves to the Complainant's main website at www.webuyanycar.com.

The Domain Name is currently used by the Respondent to resolve to an active website which offers the same type of business as the Complainant, namely the purchase of vehicles from consumers and businesses. The evidence submitted by the Complainant shows that the Respondent also trades under the domain name webuyanymotors.com, which I note resolves to a website that automatically redirects to the Domain Name's website at www.webuyanymotors.co.uk.

5. Parties' Contentions

Complainant:

The Complainant has provided extensive submissions and supporting documentation to support its case. In summary the Complainant says that:

1. The Complainant has rights in the Domain Name because:

a. It trades under the name "WEBUYANYCAR" and "WEBUYANYCAR.COM" (stylised and word) and has done so since August 2006. It exhibits examples of the use made in the form of:

- third party materials referring to the "WEBUYANYCAR" and "WEBUYANYCAR.COM" marks (exhibits "JH1", "JH7", "JH8" and "JH10" of the bundle)
- use of the "WEBUYANYCAR.COM" mark on the Complainant's own website which allows the consumer to play the Complainant's advert online together with historic versions of the Complainant's website ("JH3");
- hard copy advertising materials using the "WEBUYANYCAR.COM" mark including point of sale materials, local marketing and advertisements together with details of where such advertisements have been used (exhibits "JH2", "JH5", "JH6" and "JH9" of the bundle).

b. It has advertised using the "WEBUYANYCAR.COM" mark since August 2006. It has spent £21,547,075.00 since "WEBUYANYCAR.COM" mark was first used in August 2006 (exhibit "JH4" of the bundle);

c. It is the registrant of the domain name webuyanycar.co.uk and webuyanycar.com. The Complainant has used the www.webuyanycar.com website since August 2006; and

d. It is the owner of UK registered trade mark number 2445197 WEBUYANYCAR.COM & Device in classes 12, 35, 36, 37 and 39 and also UK trade mark numbers 2442651 and 2457645 for WEBUYANYCAR.COM & Device.

2. The Complainant emphasizes:

- Up until 10 March 2010, the Complainant was under the control of UK Car Group Limited. All rights to the trade marks are vested in or have been assigned to the Complainant.
- Consumers are very visually aware of the Complainant's branding, specifically the multi-coloured logo with cars displayed underneath the "WEBUYANYCAR.COM" mark.
- There are various third party websites referring to the "WEBUYANYCAR.COM" mark to illustrate the Complainant's reputation ("JH1").
- As of 26 May 2010, the Complainant operates through 185 physical sites throughout the United Kingdom through which the "WEBUYANYCAR.COM" mark is promoted and advertised and on the internet via www.webuyanycar.com (a specific list of addresses has been provided at "JH2").

- The business of the Complainant is to offer consumers the means of selling their cars without any hassle via a free valuation and guaranteed sale.
- The total turnover of sales of goods under "WEBUYANYCAR.COM" mark in the United Kingdom for the last three financial years is 2009 (£142 million); 2008 (£79 million) and 2007 (£52 million). The approximate total turnover in goods sold under "WEBUYANYCAR.COM" mark in the United Kingdom since the marks were first used in August 2006 until the end of April 2010 was £467 million.
- The total approximate amount spent on advertising and marketing materials and promotions by the Complainant under "WEBUYANYCAR.COM" mark in the United Kingdom in the last three years is £5,201,975 (2009); £2,977,800 (2008) and £1,867,300 (2007). The estimated total advertising and marketing spend of the Complainant since August 2006 to date under the marks is £21,547,075.
- The type of advertising used comprises a mixture of national and regional forums. Exhibit "JH4" shows a breakdown of this advertising spend by category, namely television, radio, press, online and outdoor advertisements.
- The Complainant has exhibited a number of examples of its extensive advertising within the United Kingdom using its "WEBUYANYCAR.COM" mark including:
 - a list of those publications in the local press where the trade mark has been advertised since August 2006 (Exhibit "JH5");
 - various examples of point of sale and other miscellaneous advertising materials (Exhibit "JH6");
 - printouts from the Google search engine showing the presence of the "WEBUYANYCAR.COM" mark on the internet when a search is undertaken using the search terms WEBUYANYCAR and WEBUYANYCAR.COM (Exhibit "JH7");
 - printouts from the www.youtube.com website showing the presence of the Complainant's television advertisement when a search is undertaken using the search terms WEBUYANYCAR and WEBUYANYCAR.COM (Exhibit "JH8");
 - copies of advertisements which have appeared in magazines and online including the Sunday Times, the Sun, Skynews, Whatcar, Autotrader, various local publications; printouts from archived newsletters published on the Complainant's own website; and emails from customers to the Complainant endorsing the service provided (Exhibit "JH9"); and
 - a printout from the third party website www.asylum.co.uk which lists a "top 10" advertisements, with the WEBUYANYCAR.COM television advertisement as number 8; (Exhibit "JH10").

- At tab "JH11" are the "Cease & Desist" letters dated 15 February 2010, 8 April 2010 and 12 April 2010 sent by the Complainant's advisors to the Respondent attempting to obtain a voluntary transfer of the Domain Name and the domain name webuyanymotors.com from the Respondent to the Complainant. The cease and desist letters refer to the Respondent having previously verbally advised the Complainant that the Respondent's advertisements of which complaint was being made had been removed and a verbal assurance that no further advertisements would be appearing in any publications, but later having refused to provide confirmation in writing.
3. The Domain Name in the hands of the Respondent is abusive for the following reasons:
- a. the registration of the Domain Name and the manner in which it has been used by the Respondent has taken and continues to take unfair advantage of, and is detrimental to, the Complainant's Rights. The Complainant believes that consumers will be confused between the manner in which the Domain Name is used and the Complainant's own websites www.webuyanycar.com and www.webuyanycar.co.uk because consumers will assume that there is a commercial and economic connection between the two businesses;
 - b. given the amount of money which the Complainant spends on advertising and promoting the "WEBUYANYCAR.COM" mark and websites and how aware the public are of the Complainant's brand in the automotive marketplace, the registration of the Domain Name is abusive by virtue of the unfair advantage being obtained by the Respondent by 'piggybacking' on the Complainant's reputation;
 - c. the Domain name is confusingly similar to the Complainant's own domain name registrations of webuyanycar.com and webuyanycar.co.uk;
 - d. the Complainant finds it hard to believe that the Respondent was unaware of the Complainant's use of webuyanycar.com in light of the extensive advertising and national advertising campaigns undertaken by the Complainant across the United Kingdom;
 - e. by registering and using the Domain Name in the course of trade, the Respondent has intentionally attempted to attract, for personal gain, internet users to its website by creating a likelihood of confusion with the Complainant's established trade marks and online presence; and
 - f. the Respondent has been informed of the Complainant's objection to the Domain Name registration and use by way of the cease and desist letters.

Respondent:

The Respondent did not respond to the Complaint.

6. Discussions and Findings

General

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, i.e. that:

1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. The Domain Name, in the hands of the Respondent, is an Abusive Registration.

These terms are defined in the Nominet UK DRS 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;
- **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.

Complainant's Rights

In order to be successful, the Complainant must pass the first hurdle of proving, on the balance of probabilities, that it has Rights (as defined above) enforceable by the Complainant in respect of a name or mark which is identical or similar to the Domain Name. It is worth pointing out that "Rights" for the purpose of the Nominet DRS include unregistered rights in a name or mark.

The Complainant asserts Rights in the following marks: "WEBUYANYCAR", "WE BUY ANY CAR", "WEBUYANYCAR.COM" and "WEBUYANYCAR.CO.UK". In my view the use of spaces between the marks "WEBUYANYCAR" and "WE BUY ANY CAR" does not make any material difference to the marks. The same principle normally applies to the .com and to .co.uk suffixes which can be ignored when considering whether or not a Domain Name is identical or similar to a name or mark in which the Complainant has Rights. But in this particular case, the .com suffix is expressly part of the Complainant's registered trade mark rights, although the evidence provided by the Complainant suggests that its mark is often shortened to "We Buy Any Car" when in common use by third parties. I do not think anything turns on the addition of the .com suffix and I shall refer to the Complainant's mark as "WE BUY ANY CAR".

Proving the existence of such Rights for the purposes of the Nominet DRS is generally considered to be a fairly low threshold, but in this case the Complainant has an obvious problem to overcome as the words "WE BUY ANY CAR" start out life as being completely descriptive of a business involved in the purchase of cars. However, the definition of "Rights" means that a complainant is able to rely on rights in descriptive terms which have acquired a secondary meaning.

As a general rule, the more descriptive and widely used the term to start with, the harder it is for any one entity to show that it has become distinctive of them. In this case, the mark "WE BUY ANY CAR" had an uphill struggle to overcome. However, despite this, I am persuaded by the substantial evidence provided by the Complainant of its very extensive use and advertising made of the "WE BUY ANY CAR" mark over the past four years, that on the balance of probabilities it has acquired a secondary meaning in the United Kingdom so that it is no longer a generically descriptive term but has now become distinctive as a brand name of the Complainant.

The next hurdle for the Complainant to overcome is whether its mark "WE BUY ANY CAR" is identical or similar to the Domain Name. I note that the test is whether the mark in respect of which the Complainant has rights has to be similar to the Domain Name, not necessarily confusingly similar.

I find on the balance of probabilities that the Complainant's mark "WE BUY ANY CAR" is similar to the Domain Name taking into account the following factors:

- Ignoring the .co.uk suffix, the Domain Name is conceptually similar to the Complainant's mark "WE BUY ANY CAR" given the similarity of meanings between the word "car" and the word "motors";
- The Domain Name is phonetically similar to the Complainant's mark "WE BUY ANY CAR" due to the identity of the first three words "WE BUY ANY", which is a significant part of both the Complainant's mark and the Domain Name; and
- The Complainant's mark "WE BUY ANY CAR" has a substantial reputation in the United Kingdom in connection with the motor vehicle industry.

Therefore I find on the balance of probabilities that the Complainant does have Rights in respect of a name or mark (WE BUY ANY CAR) which is identical or similar to the Domain Name.

Abusive Registration

From the matters relied on by the Complainant in its submissions the following part of paragraph 3 of the Policy (being factors which may be evidence that the Domain Name is an Abusive Registration) are potentially relevant:

Paragraph 3 a. 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;"

The screen shot from the Respondent's website at www.webuyanymotors.co.uk (appendix 1 of the bundle) shows that the Respondent is using the Domain Name in relation to a business similar to that of the Complainant, namely customers submit their car details over the internet and receive a quotation to purchase it. The website www.webuyanymotors.co.uk does not have the same look, feel or get-up as the Complainant's website at www.webuyanycars.com. However, the Complainant has also provided evidence of two advertisements placed by the Respondent in the local press, an example of which is shown below:



This advertisement is headed with the Complainant's other domain name, webuyanymotors.com, and says "refer to website above". As previously mentioned, the Respondent's website at www.webuyanymotors.com automatically redirects to the Respondent's website to which the Domain Name resolves at www.webuyanymotors.co.uk.

One striking feature of the advertisement is the inclusion of a line of five different motor car silhouettes of various colours placed directly underneath the "webuyanymotors.com" heading. The Respondent's other press advertisement complained of by the Complainant also uses the same feature.

The Complainant's registered trade mark number 2445197, and which it extensively uses, is shown below:



It can be seen that the Complainant's mark also includes five motor car silhouettes of various colours placed directly underneath the "webuyanycar.com" heading. The typeface of the domain name, and the layout of the header, are also very similar.

The five silhouette vehicle shapes used by the Respondent in its advertisements are identical in shape to those used by the Complainant in its mark but are placed in a different order. It also appears that the individual colour of each vehicle is the same, although the reproduction of the Respondent's press advertisement makes it difficult to be certain of that.

In any event, these advertisements show that the Respondent is clearly trying to imitate the trading style and get-up of the Complainant's extensively advertised trade mark and trading style. A substantial number of members of the public seeing the Respondent's advertisement are quite likely to be confused into believing that it is an advertisement by the Complainant or at least associated with the Complainant's

business. Anyone who then takes up the Respondent's invitation to "refer to website above" will be redirected immediately to its main website to which the Domain Name resolves. In the circumstances, such use of the Domain Name by the Respondent 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.

Decision

For the reasons outlined above I find that the Complainant has proved, on the balance of probabilities, that it has Rights in respect of the name WEBUYANYCAR, being a name or mark which is identical or similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. In the circumstances I order that the Domain Name be transferred to the Complainant.

Signed: Chris Tulley

Dated 13 October 2010