

DISPUTE RESOLUTION SERVICE

D00010893

Decision of Independent Expert

We Buy Any Car Limited

Complainant

and

Virtual-Showroom.com Ltd

Respondent

1 The Parties

Complainant: We Buy Any Car Limited

Address: Nixon Street
Rochdale
Lancashire
OL11 3JW
United Kingdom

Respondent: Virtual-Showroom.com Ltd

Address: 23 Parsonage Drive
Birmingham
B45 8AR
United Kingdom

2 The Domain Name

webuyanycars4more.co.uk

3 Procedural History

- 8 February 2012 Dispute received. Complaint validated.
- 14 February 2012 Notification of complaint sent to parties.
- 6 March 2012 Response received. Notification of response sent to parties.
- 9 March 2012 Reply received. Notification of reply sent to parties. Mediator appointed.
- 14 March 2012 Mediation started.
- 29 March 2012 Mediation failed. Close of mediation documents sent.
- 16 April 2012 Expert decision payment received.

4 Factual Background

- 4.1 The Complainant is a UK limited company that has traded under the names "Webuyanycar" and "Webuyanycar.com" since August 2006. It values and buys cars from the general public.
- 4.2 The Respondent trades under the name "virtual-showroom.com". It appears to be in the same line of business as the Complainant.
- 4.3 On 10 March 2011, the Respondent registered the Domain Name. Since then it has used it in the URL for its website and has purported to trade as "We buy any cars 4 more". Like the Complainant, the Respondent uses its website to solicit business from members of the general public who might wish to sell their cars.
- 4.4 On 7 April 2011 solicitors acting for the Complainant wrote to the Respondent objecting to the latter's registration and use of the Domain Name. Legal correspondence ensued.

5 Parties' Contentions

Complaint

- 5.1 The Complainant identifies the following trade marks of which it is registered proprietor:
 - 5.1.1 WEBUYANYCAR.COM composite mark in Classes 12, 35, 36 and 37 filed on 3 January 2007 (UK trade mark no. 2442651);
 - 5.1.2 WEBUYANYCAR.COM composite mark in Classes 12, 35, 36 and 37 filed on 31 January 2007 (UK trade mark no. 2445197);
 - 5.1.3 WEBUYANYCAR.COM composite mark in Class 39 filed on 5 June 2007 (UK trade mark no. 2457645)
 - 5.1.4 WEBUYANYCAR.COM stylised mark in Class 35 filed on 11 March 2010 (UK trade mark no. 2541783);
 - 5.1.5 WEBUYANYCAR.COM composite mark in Classes 35 and 36 filed on 7 October 2010 (UK trade mark no. 2560838);
 - 5.1.6 WEBUYANYCAR.COM composite mark in Classes 12, 35, 36, 37 and 39 filed on 11 March 2010 (CTM no. 8946303); and
 - 5.1.7 WEBUYANYVAN.COM composite marks in Classes 12, 35, 36, 37 and 39 filed on 11 March and 7 October 2010 respectively (UK trade mark no. 2541784 and CTM no. 9431131).

- 5.2 The Complainant asserts that UK trade mark registrations 2541783 and 2560838 (5.1.4 and 5.1.5 above) were registered by virtue of "acquired distinctiveness through use".
- 5.3 The Complainant also asserts common law rights in the WEBUYANYCAR mark and adduces extensive evidence of marketing and advertising activities, and expenditure thereon, in support of that contention.
- 5.4 As to similarity, the Complainant asserts that the addition of the characters 4MORE does not sufficiently distinguish the Domain Name from the mark in which the Complainant has rights. It contends that "from a visual, phonetic and conceptual perspective the Complainant's rights and the Respondent's domain name are highly similar".
- 5.5 The Complainant contends that the Domain Name is an Abusive Registration in the hands of the Respondent because it is being used in a manner which takes unfair advantage of and is unfairly detrimental to the Complainant's "extensive statutory and common law rights".
- 5.6 The Complainant relies on the following factors in support of that contention:
- (a) when the Respondent registered the Domain Name, it would have been "near impossible for a trader in the motor industry not to be aware of WEBUYANYCAR.COM because the brand is so well known in the motor trade and further afield";
 - (b) the Respondent is making unfair use of the Domain Name by using it in the URL for its website which competes directly with the Complainant;
 - (c) some of the content of the website itself is an infringement of the Complainant's intellectual property;
 - (d) the Domain Name suggests an economic and commercial connection between the Respondent and the Complainant, which in reality does not exist;
 - (e) the Domain Name is being used to lure consumers to the Respondent's website, and is causing confusion to internet users, particularly given that the service provided by the Respondent is identical to that provided by the Complainant;
 - (f) such use of the Domain Name by the Respondent has tarnished the reputation of the Complainant's business.

Response

- 5.7 The Respondent asserts that its use of the Domain Name is justified because it does "pay more than the competition for cars" and that the Domain Name is purely descriptive.
- 5.8 The remainder of the Response reproduces the content of a letter sent by its solicitors on 28 June 2011, in response to a letter of complaint from the Complainant's solicitors, and much of it is therefore directed to issues such as trade mark infringement and passing off, which do not fall for determination under the DRS. So far as issues relevant to the DRS are concerned, the Respondent relies on the following contentions:
- (a) the Domain Name is owned not by the Respondent but by a company which designed and hosts its website;
 - (b) it points to a website from which a legitimate business is being conducted;

- (c) the expression "we buy any car" is purely descriptive and therefore the Complainant can have no rights in that name;
- (d) the Domain Name is not being used, or being threatened to be used, 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;
- (e) the Complainant has no rights in the phrase "we buy any car"; it does not own and is never likely to own a registered trade mark consisting of the words "we buy any car".

5.9 No evidence is adduced in support of any of the above assertions.

5.10 The Respondent also asks for a finding of reverse hijacking.

5.11 Finally, the Respondent asserts that none of the previous DRS proceedings to which the Complainant was party are of any precedential value because none of them was defended.

Reply

5.12 The Complainant points out that in fact it has succeeded in two defended DRS decisions, *webyeanycar.co.uk* (DRS10174) and *webuyanycarnorthwest.co.uk* (DRS 10660)), in the latter of which the panel accepted that the Complainant had Rights (as defined in the Policy) in the WEBUYANYCAR name.

5.13 The Complainant also points out that the Respondent has not denied being aware of the Complainant's business at the time of registration of the Domain Name.

5.14 Finally, the Complainant says that certain changes made to the Respondent's website following receipt of the Complaint constitute an admission that it was causing confusion to internet users.

Respondent's first non-standard submission

5.15 The Respondent lodged a non-standard submission in which it asserted as follows: "Our intention was to get our company mission statement to the public to give them a better deal in the domain name webuyanycars4more. It tells them when they land on the website that we pay more than our competitors because we are not an automated computerised service and there is a telephone number to call and get a valuation or we call them. We pay more to the public because we do not try to get a margin at the Auction House. We will buy any number of vehicles company fleets etc. Surely a better deal for the British public is in everybody's interest."

5.16 The Respondent also referred to what appears to be an extract from a decision under the DRS, though no reference is given for it, in the following terms: "*The mere fact that a generic word happens also to be a trade mark cannot lead to the trade mark owner monopolising all uses of the word. Certainly for the purpose of complaints under the DRS policy there has to be something more*".

Respondent's second non-standard submission

5.17 The Respondent lodged a further non-standard submission alleging that the Complainant was "seeking to monopolise any name with 'We buy any Car' in the title in any format". The Respondent asserts that its website is not similar to the Complainant's in any way and that

any internet user landing on its site "would realise that immediately as we have a telephone number to call and all colour and signs are different".

- 5.18 The Respondent cites a case brought by McDonalds against a business called McChina in which the Court apparently decided that the similarity in the two names was unlikely to confuse a substantial number of people. No citation or other details are provided for that authority. The Respondent asserts that that decision is very similar to this complaint "Where the generic words in a mission statement are UNLIKELY to confuse a 'substantial' number of people if any".

6 Discussions and Findings

General

- 6.1 To succeed under the DRS Policy (the "Policy"), the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).

- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"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

- 6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "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*".
- 6.4 The Complainant clearly has a number of registered trade marks in WEBUYANYCAR.COM. Almost all those trade marks are composite marks, but in each case the text forms a prominent part of the device.
- 6.5 Further, the Complainant has asserted the existence of common law rights in the WEBUYANYCAR name. It has also provided extensive evidence in support of that assertion, including a detailed 10 page witness statement from its marketing director, and exhibits running to some 425 pages. In light of the fact that the Complainant has been trading successfully since 2006, and has evidently been assiduous in promoting and advertising its brand online, in the press and on television, the Expert agrees with the Expert in *webuyanycarnorthwest.co.uk* (DRS 10660) that, even if the WEBUYANYCAR mark started life as being entirely descriptive of the Complainant's business, the evidence adduced by the Complainant demonstrates that it has now acquired a secondary distinctive meaning beyond the initial descriptive meaning.

- 6.6 Given that such an outcome is specifically provided for in the Policy's definition of Rights (which "*may include rights in descriptive terms which have acquired a secondary meaning*"), the Complainant has therefore demonstrated, on the balance of probabilities, that it has Rights, as defined in the Policy, in respect of both WEBUYANYCAR.COM (the "Registered Mark") and, at common law, WEBUYANYCAR (the "Mark").
- 6.7 The question is therefore whether, pursuant to paragraph 2(a)(i) of the Policy, either or both of those marks is identical or similar to the Domain Name. The only difference between the Mark and the Domain Name is that "car" has been pluralised and the characters 4MORE have been added. In the case of the Registered Mark, .COM has, in addition, been omitted.
- 6.8 The addition of a descriptive phrase, i.e. meaning "for more", would not ordinarily be sufficient to render the Domain Name sufficiently dissimilar from a mark in which the Complainant has Rights. It is now well established under the DRS that the inclusion of generic or descriptive words, together with a name or mark in which the Complainant has Rights, does not mean that the domain name in question is so dissimilar that it falls outside paragraph 2(a)(i) (see *natwestloans.co.uk* (DRS3390), *tescoestateagents.co.uk* (DR3962), *replicarolex.co.uk* (DRS5764) and *veluxblind.co.uk* (DRS6973), by way of examples).
- 6.9 Indeed, there are several decisions dealing with the specific marks in question. The following domain names have all been held to be similar to the Complainant's mark: *webuyanycarchash.co.uk* (DRS 10168), *webuyanycarnow.co.uk* (DRS 9635) and *webuyanycarnorthwest.co.uk* (DRS 10660).
- 6.10 Nor, it therefore follows, does the mere pluralisation of the Mark render the Domain Name sufficiently dissimilar to either the Mark or the Registered Mark.
- 6.11 If it were the case that the distinctiveness of the Registered Mark depended on the missing element, i.e. .COM, the Respondent might have a stronger case on dissimilarity. But that is not the case here. For the reasons discussed, not only is the distinctive part of the Registered Mark the very element included in the Domain Name (WEBUYANYCAR), but that element of the Registered Mark itself constitutes a free-standing common law mark in which the Complainant has Rights.
- 6.12 Accordingly, the Complainant satisfies paragraph 2(a)(i) of the Policy.

Evidence of abusive registration

- 6.13 The Complainant has failed to identify on which of the (non-exhaustive) factors set out in paragraph 3(a) of the Policy it relies. It is therefore necessary to consider whether the Complainant's contentions, summarised at 5.6 above, fall within paragraph 3(a) of the Policy.
- 6.14 Broadly speaking, the Complainant's contentions fall within paragraph 3(a)(i)(C) and/or paragraph 3(a)(ii) of the Policy, i.e. circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant and/or that the Respondent is using 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.
- 6.15 The complaint is essentially that the Respondent is piggybacking on the Complainant's intellectual property and/or causing detriment to the Complainant's brand.

6.16 The Expert accepts the Complainant's submission that its brand is, and was at the time of registration of the Domain Name, well known both within the motor trade and more widely among the general public. It therefore seems, at the very least, more likely than not that the Respondent was aware of the Complainant's business and of the fact that it traded by reference to the Registered Mark and the Mark at the time it registered the Domain Name. Indeed even the Respondent does not take issue with the Complainant's contentions in this regard.

6.17 While the Complainant has not adduced any direct evidence of confusion or likelihood of confusion, useful guidance in this regard is to be found in the DRS Expert Overview document, in particular in paragraph 3.3, which comments on paragraph 3(a)(ii) of the Policy in the following terms:

"The 'confusion' referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an internet user seeing the domain name or the site to which it is connected believe or be likely to believe that 'the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant'?..."

Commonly, internet users will visit websites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the website connected to the domain name in issue. Similarly, there is bound to be a severe risk that an internet user guessing the URL for the complainant's website will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's website will be visiting it in the hope and expectation that the website is a website "operated or authorised by, or otherwise connected with the complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the website that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with ... a commercial website, which may or may not advertise goods or services similar to those produced by the complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment ... The activities of typosquatters are generally condemned ... as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decision in DRS 00248 (Seiko-shop.co.uk)."

6.18 Essentially, the Respondent's defence, while it is not quite put in these terms, is that its use of the Domain Name falls within the provisions of paragraph 4(a)(ii) of the Policy, namely that the Domain Name is generic or descriptive and the Respondent is making fair use of it. This would appear to be the proposition to which the Response and the two subsequent non-standard submissions are primarily directed.

6.19 Had the Respondent registered the Domain Name before the Complainant's business was so well established and widely known, that argument might carry some weight. However, for the reasons discussed, the Complainant plainly had Rights in the WEBUYANYCAR mark before

the Domain Name was registered. As previous DRS decisions have found, even if that expression was at the outset of the Complainant's business purely descriptive, the Complainant has adduced compelling evidence that it had, by the time the Respondent registered the Domain Name, acquired a secondary and distinctive meaning.

- 6.20 The question is therefore whether, by adding the characters "S4MORE" to the Mark, the Respondent has rendered the Domain Name purely generic or descriptive. Clearly, it has not.
- 6.21 What in fact appears to have happened is that the Respondent, who is of course in competition with the Complainant, has sought to exploit for its own benefit the prima facie descriptive nature of the Complainant's mark for its own commercial benefit. It is a clear example of free-riding on the trading goodwill and business reputation of another.
- 6.22 If the Respondent really simply wished to use a generic and descriptive domain name, it could have done so without using the Complainant's mark, for example by registering a domain name such as *moremoneyforyourvehicle.co.uk*, *bettervalueforyourmotor.co.uk*, *getmore4yourjalopy.co.uk*, and so forth.
- 6.23 The Respondent's contention that the Domain Name is not owned by it but by "the company who designed and hosts their web-site", is contradicted by the result of a Whois search which clearly identifies the Respondent as the registrant.
- 6.24 Accordingly, for the reasons set out above, the Expert is satisfied, on the balance of probabilities, that the Domain Name was registered and/or has been used in a manner which took unfair advantage of the Complainant's Rights in the Mark and/or was unfairly detrimental to those Rights.

7 Decision

- 7.1 The Expert finds that the Complainant has Rights in 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.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

Signed **David Engel**

Dated 6 June 2012