

## DISPUTE RESOLUTION SERVICE

D00014236

### Decision of Independent Expert

Data Cars LLP

and

Data Cars

#### 1. The Parties:

Complainant: Data Cars LLP  
107 Hindes Road  
Harrow  
Middlesex  
HA1 1RU  
United Kingdom

Respondent: Data Cars  
24 Cornmarket  
Pontefract  
West Yorkshire  
WF8 1BJ  
United Kingdom

#### 2. The Domain Name:

data-cars.co.uk

#### 3. Procedural History:

20 May 2014 17:10 Dispute received  
21 May 2014 13:15 Complaint validated  
21 May 2014 13:23 Notification of complaint sent to parties  
10 June 2014 02:30 Response reminder sent  
12 June 2014 08:32 Response received  
12 June 2014 08:32 Notification of response sent to parties

17 June 2014 02:30 Reply reminder sent  
18 June 2014 16:16 Reply received  
18 June 2014 16:17 Notification of reply sent to parties  
18 June 2014 16:17 Mediator appointed  
24 June 2014 13:06 Mediation started  
27 June 2014 15:39 Mediation failed  
27 June 2014 15:41 Close of mediation documents sent  
08 July 2014 13:53 Expert decision payment received.

I was appointed as Expert on July 14, 2014. 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

#### **4. Factual Background**

Both parties to this dispute operate private hire taxi and courier services, the Complainant in and around South East London and the Respondent in and around Pontefract in Yorkshire. Both promote their services through domain names which resolve to their respective websites, the Complainant through <datacars.co.uk> and <datacars.com> and the Respondent through <data-cars.co.uk> (“the Domain Name”).

The Complainant was incorporated in the United Kingdom on July 22, 2010. It is the current registrant of the domain name <datacars.co.uk>, first registered on March 18, 1999. Prior to the incorporation of the Complainant, Mr. Les Chapman, who is associated with the Complainant, registered the domain name <datacars.com> on January 30, 2003.

The Domain Name was registered in the name Data Cars on March 18, 2008. It remains registered in that name and the updated registration details refer to company No. 7670950, namely Data Cars Yorkshire Ltd, which was incorporated on June 15, 2011.

The Complainant is the registered proprietor of two UK Trade Mark Registrations for DATA CARS in Class 39.

#### **5. Parties’ Contentions**

##### **Complainant**

The Complainant makes the following assertions.

The mark DATA CARS has been used by the Complainant in the UK for over 9 years in respect of taxi and private car hire services; arrangement of transportation of passengers by car; transportation of passengers by car; courier services; arrangement of and transportation of parcels and packages by car, van, motorcycle and bicycle, as will be seen from the website [www.datacars.co.uk](http://www.datacars.co.uk).

The name DATA CARS is not a descriptive term and is a registered trade mark in the country in which the Respondent is domiciled, namely, the United Kingdom. It has acquired a substantial reputation and protectable goodwill in respect of the services offered by the Complainant and from which the Respondent seeks to take unfair advantage.

It is of note that the website [www.data-cars.co.uk](http://www.data-cars.co.uk) is similar to the Complainant's website [www.datacars.co.uk](http://www.datacars.co.uk) and of the Complainant's other website [www.datacars.com](http://www.datacars.com). The Complainant has not licensed or otherwise permitted the Respondent to use its trade mark nor has it licensed or otherwise permitted the Respondent to apply for or use any domain name incorporating the mark in this way. The Respondent calls itself "DATA CARS" and purports to provide "private hire taxi services".

A letter was sent to the Respondent at the address shown on the website. No reply has been received.

The Domain Name consists of the expression "data-cars", which is almost identical to the Complainant's name Data Cars LLP and its domain names <[datacars.co.uk](http://datacars.co.uk)> and <[datacars.com](http://datacars.com)> and substantially consists of the Complainant's UK trade mark registration for DATA CARS.

The Domain Name is similar to the trade mark in which the Complainant has rights and is being used for the purposes of attracting and diverting business from the Complainant's business to the Respondent's. Consequently the Domain Name has been registered for the purpose of attempting to attract, for commercial gain, internet users to the website of the Respondent by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

The Complainant seeks transfer to it of the Domain Name.

## **Respondent**

The Respondent makes the following assertions.

The Respondent is based in Pontefract, West Yorkshire. The Complainant is based in London, 190 miles away. Due to the nature of the business both companies run, there is absolutely no chance of overlap or risk to business being redirected to Pontefract from London.

Data Cars in Pontefract have been trading by this name as a non limited company since 2000 and have become a limited company by the name of Data Cars Yorkshire Ltd to distinguish itself from any other company which may be based in a different region of the country.

Data Cars Yorkshire Ltd and the Domain Name <[data-cars.co.uk](http://data-cars.co.uk)> were not registered or otherwise acquired in a manner which took unfair advantage of the registration process and have not resulted in any detriment to the Complainant's rights.

Due to the geographical separation there is no chance of the Respondent taking unfair advantage of the registration of this site address, which has only come to light due to the fact that the Respondent put an App called Data Cars in the market which came to the attention of the Complainant. Following this event the Complainant discovered the web address in question, of which it was previously unaware. Had there been a detrimental effect of the Respondent's registration of the Domain Name the Complainant would have become aware of it much earlier. This demonstrates that the Complainant's concern is unfounded as the Respondent has not infringed on its rights or customers in any way since it registered the Domain Name.

The Domain Name was not registered for resale and has rightfully been registered given that the name of the Respondent is Data Cars Yorkshire Ltd. The Complainant does not own the words "Data" or "Cars" and as such the Respondent has a right to use the name for its domain name as the company name is registered with Companies House under company number 07670950.

The registration does not unfairly disrupt the business of the Complainant. Had this been so the Complainant would have become aware of this disruption much earlier. The geographical separation ensures there is no overlap in the customers for the services being provided by either company.

The Respondent is a well known and popular company in the area of Pontefract and clear distinction is made on its website to ensure there is no confusion with the Complainant's domain name as the Respondent's dark blue colour scheme and its logo are completely independent and instantly recognisable by its customers and would be hard to confuse with the Complainant's design and light blue and yellow colour scheme.

The areas covered by the Respondent's service are clearly listed at the top of its website ("Pontefract, Castleford, Featherstone, Knottingley, Normanton and surrounding areas"), which would ensure there is no confusion with the Complainant's website as there is a distance of 200 miles between the two serviced areas ensuring confusion cannot take place even if one were accidentally to land on the wrong domain.

The Respondent is in no way engaged in a pattern of registration as it has registered only this Domain Name against the company name of Data Cars.

There has never been nor ever will be a relationship between the parties.

Before becoming aware of the Complainant's cause for complaint the Respondent ensured it did not register an exactly same domain as the Complainant by adding a dash between the two words. The Respondent has been commonly known by the name Data Cars legitimately and, without any bias or malice towards the Complainant, it legitimately registered the Domain Name when it felt it was necessary to have a web presence.

The Domain Name contains a generic term used in almost all private hire firms. The word "cars" is a very popular name element used in majority of these types of

businesses. The “data” element comes from the Respondent’s introduction of a data controlled dispatching service.

### **Complainant’s Reply**

The Complainant makes the following assertions in reply.

The Respondent’s date of incorporation is 15 June 2011. The Complainant’s date of incorporation is 22 July 2010.

The Complainant owns exclusive rights in the sign DATA CARS throughout the United Kingdom by virtue of its UK Trade Mark Registration No. 2601907.

The Respondent acknowledges having awareness of the Complainant’s domain name registrations prior to applying for registration of the Domain Name on 18 March 2008. As such the abusive registration was registered in a manner which, at the time when the registration took place, took unfair advantage and was unfairly detrimental to the Complainant’s Rights.

The hyphen between the words “data” and “cars” does not sufficiently alter the appearance of the Domain Name. The expression “data-cars” is almost identical to the Complainant’s name Data Cars LLP and its domain names <datacars.co.uk> and <datacars.com>. Furthermore, it substantially consists of the Complainant’s UK registered trade mark DATA CARS.

The Respondent’s use of DATA CARS on its website, [www.data-cars.co.uk](http://www.data-cars.co.uk), does not include the hyphen that appears in the Domain Name. The Respondent’s use of DATA CARS has been in a manner which has taken unfair advantage of the Complainant’s Rights.

## **6. Discussions and Findings**

Under paragraph 2(a) of the Policy, to obtain transfer of the Domain Name, the Complainant must demonstrate, 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**

The Complaint mentions two registrations held by the Complainant for the trademark DATA CARS and draws attention “in particular” to UK Trade Mark No. 2601907, registered on May 25, 2012 in class 39 in respect of taxi and private car hire services; arrangement of transportation of passengers by car; courier services; and arrangement of and transportation of parcels and packages by car, van,

motor cycle and bicycle. The application was filed on November 18, 2011 in the name of Mr. Les Chapman, who is associated with the Complainant. There is no disclaimer. Accordingly, the rights granted apply throughout the United Kingdom with effect from the application date.

Although the Complaint provides no details of the second trademark registration held by the Complainant for the trademark DATA CARS, the details of trademark 2601907, taken from the UK Intellectual Property Office official database and provided as Annex F to the Complaint, include a link entitled "View owner's other trademarks". That link has led the Expert to find the second trademark mentioned in the Complaint, namely UK trademark No.2392879 DATA CARS, registered in the name of Mr Chapman on June 23, 2006 in class 39 in respect of taxi services; arrangement of transportation of passengers by car; and arrangement of and transportation of parcels and packages by car. The application was filed on May 26, 2005. The registration has the following disclaimer:

"Registration of this mark is subject to the following limitation: The rights conferred are limited to services provided in London and its environs."

The relevance of this disclaimer is discussed under the heading Abusive Registration below.

For the purposes of paragraph 2(a)(i) of the Policy, the relevant date at which the Complainant is required to demonstrate rights in a name or mark is the date of filing of the Complaint.

In determining whether the name or mark in which a complainant has rights is identical or similar to a disputed domain name, the ".co.uk" suffix may be disregarded. Accordingly, the only significant point of difference between the Domain Name and the Complainant's DATA CARS trade mark is the hyphen between the two words. The Expert finds that the Complainant has Rights in respect of a mark which is similar to the Domain Name.

Paragraph 2(a)(i) of the Policy is satisfied.

### **Abusive Registration**

"Abusive Registration" is defined in paragraph 1 of the Policy as a domain name which:

- (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.

The Complainant points to the Respondent's awareness of the Complainant's domain name registrations prior to applying for registration of the Domain Name on 18 March 2008 as a basis for the conclusion that the Domain Name was

registered in a manner which, at the time when the registration took place, took unfair advantage and was unfairly detrimental to the Complainant's Rights.

When the Domain Name was registered on March 18, 2008, the Complainant had no company name because it was not then incorporated. The domain names <datacars.co.uk> and <datacars.com> had been registered on March 18, 1999 and January 30, 2003 respectively and UK trademark No.2392879 DATA CARS, limited to services provided in London and its environs, had been registered since June 23, 2006. Although the Complainant was not then incorporated, the Expert is prepared to treat those domain names and that trademark as if they were those of the Complainant for present purposes. The Respondent was clearly aware of the domain name <datacars.co.uk>, which is why the hyphen was inserted between the two words in order to obtain registration of the Domain Name.

These are the circumstances in which the Respondent registered the Domain Name under the name Data Cars for use in connection with a business in Yorkshire of the same kind as the business being conducted by the Complainant in London.

Having regard to these circumstances the Expert is not satisfied on the balance of probabilities that the Respondent registered the Domain Name in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

In its complaint, the Complainant asserts that the Domain Name is being used for the purposes of attracting and diverting business from the Complainant's business to the Respondent's and that, consequently, the Domain Name has been registered for the purpose of attempting to attract, for commercial gain, internet users to the website of the Respondent by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. This assertion is reminiscent of paragraph 4(b)(iv) of the Uniform Domain Name Dispute Resolution Policy.

The Respondent's website clearly identifies those parts of Yorkshire in which it offers its services, just as the Complainant's websites identify the area in and around London where the Complainant offers its services. The parties' websites offer similar services in their respective geographic areas but differ in appearance.

Under these circumstances, and having regard to the geographic limitation upon the Complainant's trademark rights at the time of registration of the Domain Name, the Expert is not satisfied on the balance of probabilities that the Domain Name has been registered for the purpose of attempting to attract, for commercial gain, internet users to the website of the Respondent by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Complainant makes reference to sub-paragraph 3(a)(ii), namely:

“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”.

On the material before the Expert, the only difference in circumstances between the time when the Domain Name was registered and the filing of the present complaint (apart from the incorporation of the parties) is that on May 25, 2012 the Complainant obtained registration of its trademark 2601907 DATA CARS, having nationwide application within the United Kingdom. Although the Complainant claims valuable goodwill in that mark, it does not expressly allege trademark infringement, no doubt mindful of the remarks of the learned Expert in *Barclays Bank plc v. Mr. Graham Kenny*, DRS 12328 in paragraphs 6.13 to 6.16, including:

6.13...although the questions of abusive registration and trade mark infringement often overlap, they are not the same. In *Seiko UK Limited v. Designer Time/Wanderweb* DRS 00248 the Appeal Panel stated as follows:

“The Panel considers that parties and Experts should not be overly concerned with whether or not an allegedly abusive registration also constitutes an infringement of registered trade mark. The question of trade mark infringement is, as both parties (and the Expert) agree, one for the courts to decide. The question of abusiveness is for the Expert to decide. The two jurisdictions co-exist alongside each other, and no doubt there will be considerable overlap. However there may well be factual scenarios in which an abusive registration under the Policy would not be an infringement of trade mark under the 1994 Act, and where an infringement of trade mark under the 1994 Act would not be an abusive registration under the Policy. The safest course for parties and Experts is simply to address the terms of the Policy.”

The Expert is satisfied that, before being aware of the Complainant's cause for complaint, the Respondent has been commonly known by the name Data Cars and has used the Domain Name in connection with a genuine offering of private hire taxi and courier services in and around Pontefract in Yorkshire. Under the Policy, sub-paragraphs 4(a)(i)A and B, these circumstances may be evidence that the Domain Name is not an Abusive Registration.

There is no evidence that the Respondent's use of the Domain Name has changed since it was registered prior to the incorporation of the Complainant and prior to the registration of the Complainant's trademark 2601907.

There is no evidence of any actual confusion. Even if some confusion is possible, given the similarity between the Domain Name and the Complainant's trademark, the Expert is not satisfied 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.

Accordingly, paragraph 2(a)(ii) of the Policy is not satisfied.

## **7. Decision**



For the reasons set out above, the Complaint is dismissed.

**Signed Alan Limbury**

**Dated: July 16, 2014**