

DISPUTE RESOLUTION SERVICE

D00015056

Decision of Independent Expert

Jaguar Land Rover Limited

and

Craig Owen

1. The Parties

Complainant: Jaguar Land Rover Limited
Abbey Road
Whitley
Coventry
CV3 4LF
United Kingdom

Respondent: Craig Owen
17 Cygnet Close
Ashington
Northumberland
NE63 0DF
United Kingdom

2. The Domain Names

<jaguaradvertiser.co.uk>
<landroveradvertiser.co.uk>
<rangeroveradvertiser.co.uk>
<roveradvertiser.co.uk>
<www-landrover.co.uk>

("the Domain Names")

3. Procedural History

14 November 2014 17:22 Dispute received
17 November 2014 11:46 Complaint validated
17 November 2014 12:04 Notification of Complaint sent to parties
04 December 2014 01:30 Response reminder sent
09 December 2014 09:01 No Response received
09 December 2014 09:01 Notification of no Response sent to parties
15 December 2014 11:44 Expert decision payment received
16 December 2014 11:50 Expert appointed

The Expert has confirmed that he is independent of each of the parties. To the best of the Expert's 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 into question his independence in the eyes of one or both of the parties.

4. Outstanding Formal or Procedural Issues

On 18 December 2014 the Respondent submitted a non-standard submission to Nominet. In accordance with paragraph 13(b) of the Nominet DRS Procedure ("the Procedure"), the Respondent submitted an explanatory paragraph, which is required to contain "a brief explanation of why there is an exceptional need for the non-standard submission." The explanatory paragraph stated:

"I apologise for not providing a response at the correct time. This was a mistake as I thought that the information was only for mediation purposes. I have previously been involved in mediation of one of the domain names before with Landrover and it was a waste of several months as they did not offer any workable solution, they pulled out and resubmitted.

The end result is that they do not want anyone to register a domain name containing any words that they believe are part of their trademarks."

The Expert notes that in an earlier email communication with Nominet the Respondent stated:

"I did not reply to case 15056 as Landrover cancelled the previous case against me DRS14537 wasting many hours that I had spent trying to work a solution with the mediator."

The Respondent also requested that Nominet forward the details of that previous case to the Expert, which Nominet explained it was unable to do.

The Expert is satisfied that Nominet sent to the Respondent, at the appropriate times, both the Notification of Complaint in this case and also a Response Reminder Notice, both of which made clear that if the Respondent did not respond

to the Complaint by 8 December 2014 he would nevertheless be bound by any decision made about the Domain Names. In the circumstances, the Expert does not consider that the Respondent's explanatory paragraph discloses any exceptional or compelling reason why a non-standard submission (i.e. a Response served out of time) should be considered in this case and the Expert therefore declines to consider the Respondent's non-standard submission.

5. Factual Background

The Complainant is a company incorporated in the UK which is based in the Midlands region of England. It is a manufacturer of saloons, sports cars and sports utility vehicles.

The Complainant is the proprietor of UK registered trade marks including the following:

- UK registered trade mark number 625805 for JAGUAR filed on 13 October 1943 in International Class 12 for motor vehicles
- UK registered trade mark number 663199 for LAND ROVER filed on 11 October 1947 in International Class 12 for goods including motor vehicles and parts
- UK registered trade mark number 920322 for RANGE ROVER filed on 30 January 1968 in International Class 12 for goods including motor vehicles and parts
- UK registered trade mark number 1518902 for ROVER filed on 14 November 1992 in International Class 12 for goods including motor vehicles, parts and fittings

The Respondent registered the Domain Names <jaguaradvertiser.co.uk>, <landroveradvertiser.co.uk>, <rangeroveradvertiser.co.uk>, and <roveradvertiser.co.uk> on 6 June 2010 and the Domain Name <www-landrover.co.uk> on 23 August 2011.

According to screen shots exhibited by the Complainant and dated in each case 6 November 2014, each of the Domain Names resolved on that date to websites as follows:

- The Domain Name <jaguaradvertiser.co.uk> resolved to a parking page operated by 123-reg.com, which included a number of links to Jaguar vehicles or dealers and a featured advertisement for a business named "Petrotechnics", which stated "Managing Operational Risk and Workload in Hazardous Industries with Proscient"
- The Domain Names <landroveradvertiser.co.uk>, <rangeroveradvertiser.co.uk> and <roveradvertiser.co.uk> resolved, in each case, to parking pages operated by 123-reg.com, which included a number of links to discount hotels, budget

hotels and hotel booking services and a featured advertisement for “Trivago Hotel Search”

- The Domain Name <www-landrover.co.uk> resolved to a web page showing a photograph of a Land Rover Discovery, with the captions “My Land Rover ® Discovery ®” and “Looking good, not bad for 11 years old” and a statement that “This site is not affiliated to Land Rover ® in any way and conforms to their trademark standards.”

6. Parties’ Contentions

Complainant

The Complainant states that it is a globally renowned manufacturer of premium saloons, sports cars and sports utility vehicles. In addition to relying on the registered trade marks referred to above, it submits that the trade marks LAND ROVER, JAGUAR, RANGE ROVER and ROVER have acquired extensive goodwill and a substantial reputation throughout the UK, the EU and the world and, as a result, are very well known in these territories (however, the Complainant does not provide any particulars of how such goodwill has arisen, e.g. by virtue of sales or promotion over a period of time, or any other evidence in support of its submission). The Complainant states that it is the owner of a number of “.com” and “.co.uk” domain names which incorporate the above trade marks, including <landrover.co.uk>

The Complainant submits that it has rights in trade marks which are identical or similar to each of the Domain Names. It states that each of the Domain Names comprises one of its trade marks referred to above and that (except in the case of <www-landrover.co.uk>) each of the Domain Name uses that trade mark together with the term “advertiser”, which is a descriptive term.

The Complainant submits that the Domain Names, in the hands of the Respondent, are Abusive Registrations. In particular, the Complainant submits that it can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern (paragraph 3(a)(iii) of the Nominet DRS Policy (“the Policy”)).

The Complainant exhibits a list of 59 domain names which it states are owned by the Respondent and which, it contends, incorporate well known trade marks relating to the automotive industry in which the Respondent has no apparent rights. In addition to the Domain Names, The Complainant cites by way of example the following domain names in particular:

<www.bentley-rollsroyceadvertiser.co.uk>
<www.bmwadvertiser.co.uk>
<www.ferrariadvertiser.co.uk>
<www.lamborghiniadvertiser.co.uk>

<www.lanciaadvertiser.co.uk>
<www.maseratiadvertiser.co.uk>
<www.porscheadvertiser.co.uk>
<www.protonadvertiser.co.uk>
<www.tvradvertiser.co.uk>
<www.www-merc.co.uk>
<www.www-volkswagen.co.uk>

The Complainant states that all the above domain names were registered between 29 May and 7 June 2010 and that this suggests that the Respondent does not have any legitimate interest in the names.

The Complainant provides screen shots of the web pages to which each of the 59 domain names to which it refers resolved on 6 November 2014. With the exception of <www-landrover.co.uk>, each of the names resolved to a 123-reg.com parking page with similar content to the pages described above, i.e., containing links that appear, in some cases, to correspond to the distinctive part of the domain name, but in every case, other links that appear to relate to unrelated goods or services.

With regard to the domain name <www-landrover.co.uk>, the Complainant exhibits a screen shot dated 19 December 2013 which appears to be a web page advertising various Land Rover vehicles for sale. The Complainant contends that the Respondent changed the website to the “My Land Rover ® Discovery ®” content referred to above purely to avoid an adverse finding in these proceedings.

The Complainant seeks the transfer of the Domain Names.

Respondent

As discussed above, the Respondent has failed to file an admissible Response in this case.

7. Discussions and Findings

The Complaint falls to be determined according to the Policy and the Procedure. Under paragraph 2 of the Policy:

- “(a) *A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, 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.*
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “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.”*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has established that it has longstanding UK registered trade mark rights in each of the names JAGUAR, LAND ROVER, RANGE ROVER and ROVER. Despite the lack of supporting evidence, the Expert also finds, as a matter of common knowledge, that each of these trade marks is well known in the UK and in other parts of the world.

Each of the Domain Names <jaguaradvertiser.co.uk>, <landroveradvertiser.co.uk>, <rangeroveradvertiser.co.uk> and <roveradvertiser.co.uk> comprises one of the Complainant’s trade marks referred to above, together with the term “advertiser” and the formal suffix “.co.uk”, which is to be disregarded for the purpose of comparison. The Expert accepts that the term “advertiser” is descriptive in nature and does not serve to distinguish any of the four Domain Names from the Complainant’s respective trade marks, which comprise in each case the distinctive part of the Domain Name.

With regard to the Domain Name <www-landrover.co.uk>, this comprises the Complainant’s trade mark LAND ROVER together with the prefix “www-” and the formal suffix “.co.uk.” Clearly the prefix “www-”, which denotes the “world wide web” and is generally used for the purposes of an Internet URL, does not serve to distinguish the Domain Name from the Complainant’s mark.

Accordingly, the Expert finds that the Complainant has Rights in a name or mark that is similar to each of the five Domain Names. The first limb of the test under paragraph 2 of the Policy is therefore satisfied.

Abusive Registration

Taking first the Domain Name <www-landrover.co.uk>, the Expert considers this name to be inherently deceptive, in that the Expert can conceive of no explanation for combining the term “www-” with the Complainant’s well-known trade mark LAND ROVER other than improperly to take advantage of Internet users who are intending to access the Complainant’s own website located at “www.landrover.co.uk”. This appears to represent no more than an obvious case of “typosquatting” and the Expert has no hesitation in finding this Domain Name to be an Abusive Registration in the hands of the Respondent.

Turning to the four other Domain Names, each of these comprises one of the Complainant’s well-known trade marks together with the term “advertiser”. In contrast with the Domain Name referred to above, the Expert does not consider these Domain Names to be “automatically” abusive, because in certain circumstances a third party who is operating a legitimate business genuinely revolving around a trade mark owner’s goods or services can legitimately use a domain name which incorporates that trade mark owner’s mark. However, the circumstances in which an unauthorised third party can legitimately do so are limited and do not include cases in which that party is using the domain name to take unfair advantage of the trade mark owner’s rights. Cases of this nature were considered by the Nominet Appeal Panel in *Toshiba Corporation v. Laptop Battery Inc.* Case No. DRS 079991, where the Panel accepted that unfair advantage may be apparent even in cases where Internet users are not likely to be confused into believing that the domain name is operated or approved by the trade mark owner. The panel referred in particular to the judgment of the European Court of Justice in *L’Oréal v Bellure* [C-487/07] to the effect that unfair advantage:

“does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark’s image.”

In the present case, the Expert considers that each of the Domain Names <jaguaradvertiser.co.uk>, <landroveradvertiser.co.uk>, <rangeroveradvertiser.co.uk> and <roveradvertiser.co.uk> has been used in a manner which has taken unfair advantage of the Complainant’s trade mark rights. While each of the Domain Names was registered in June 2010, it appears from the evidence submitted by the Complainant that, as of November 2014, over four years later, each of the Domain Names was being used for the purposes of a 123-reg.com parking page which contained advertisements and links to various goods and services including those having no apparent connection with the Complainant or its products. In the view of the Expert, Internet users are likely to have been attracted to the websites in question because of the reputation and goodwill which attaches to the Complainant’s well-known trade marks and to the extent that the Respondent

may obtain a commercial benefit from those pages, e.g. by way of “pay-per-click” or other revenue, such benefit arises from an unfair advantage being taken of the Complainant’s marks.

The Complainant relies specifically on the Respondent’s registration of numerous other domain names reflecting other well-known motor marques as establishing a pattern of abusive registrations for the purposes of paragraph 3(a)(iii) of the Policy. The examples cited by the Complainant include the name <www-volkswagen.co.uk> as well as numerous names which combine the names of well-known motor marques, such as “bmw”, “ferrari” and “porsche” with the term “advertiser”.

While care must be taken in reaching any conclusions concerning registrations which are not the subject-matter of the immediate case, the Expert has a similar difficulty with the domain name <www-volkswagen.co.uk> as in the case of <www-landrover.co.uk>: the name is inherently deceptive and the Expert is unable to conceive of any use that the Respondent could legitimately make of it. With regard to the various other “advertiser” names, the Expert accepts that these all appear to have been registered at around the same time and that all have resolved to 123-reg.com parking pages which appear to offer goods or services including those that have no apparent connection with the trade mark owner. On the basis that the Expert has already found that such conduct is liable to take unfair advantage of a well-known trade mark, the Expert concludes for the purposes of paragraph 3(a)(iii) of the Policy that the Respondent has been engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and that the Domain Names are part of that pattern.

Accordingly, the Expert finds that each of the five Domain Names was registered and/or has been used in as manner which took unfair advantage of the Complainant’s Rights and, in addition, that paragraph 3(a)(iii) of the Policy is of application in this case. The Expert therefore finds that each of the five Domain Names in the hands of the Respondent is an Abusive Registration.

8. Decision

The Complainant has established that, in the case of each of the five Domain Names, it has Rights in a name or mark that is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore directs that the Domain Names <jaguaradvertiser.co.uk>, <landroveradvertiser.co.uk>, <rangeroveradvertiser.co.uk>, <roveradvertiser.co.uk>, and <www-landrover.co.uk> be transferred to the Complainant.

Signed: Steven A. Maier

Dated: 5 January 2015