

## **DISPUTE RESOLUTION SERVICE**

**D00016525 and D00016526**

**Decision of Independent Expert**

**Bayerische Motoren Werke Aktiengesellschaft**

and

**(1) MR TOBY RUSSEL (D00016525)**

**(2) E DRIVE LIMITED (D00016526)**

### **1. The Parties:**

Lead Complainant: Bayerische Motoren Werke Aktiengesellschaft  
BMW-Haus, Petuelring 130, 80809 Munich  
Munich  
Germany

Respondent in D00016525: Mr Toby Russel  
Caldecote Mill, London Rd  
Newport Pagnell  
Milton Keynes  
Bucks  
MK16 0HA  
United Kingdom

Respondent in D00016526: E DRIVE LTD  
Caldecote Mill, London Rd  
Newport Pagnell  
Milton Keynes  
Bucks  
MK16 0HA  
United Kingdom

## **2. The Domain Name(s):**

edrive.co.uk  
edrivecarbonfiber.co.uk  
edrivecarbonfibre.co.uk  
edriveformulae.co.uk  
edriveltd.co.uk  
edriver.co.uk  
edriveracing.co.uk  
edriveplc.co.uk

## **3. Procedural History:**

I can 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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

17 September 2015 10:22 Dispute received  
17 September 2015 11:31 Complaint validated  
17 September 2015 12:13 Notification of complaint sent to parties  
30 September 2015 08:54 Response received  
30 September 2015 08:54 Notification of response sent to parties  
05 October 2015 02:30 Reply reminder sent  
07 October 2015 09:58 Reply received  
07 October 2015 10:05 Notification of reply sent to parties  
07 October 2015 10:05 Mediator appointed  
14 October 2015 09:11 Mediation started  
16 November 2015 11:34 Mediation failed  
16 November 2015 11:34 Close of mediation documents sent  
23 November 2015 10:30 Expert decision payment received

It is important to record that this Decision relates to two separate complaints under Nominet's Dispute Resolution Service. These are disputes D00016525 and D00016526. Nominet has agreed to combine or merge them given that the parties in both disputes are either the same or closely linked.

## 4. Factual Background

- 4.1 The Complainant in both disputes is the well-known manufacturer and supplier of motor vehicles, Bayerische Motoren Werke Aktiengesellschaft, known widely as BMW.
- 4.2 The Complainant is the registered proprietor of a trade mark for the word mark eDrive. This is an International Registration, which includes Europe, and is registered with effect from 11 September 2007. It is registered in Class 12 for motor vehicles and parts thereof (excluding tyres and inner tubes for tyres) and in Class 28 for miniatures of motor vehicles and parts.
- 4.3 The Complainant uses the mark eDrive on a number of the cars which it manufactures and sells.
- 4.4 The Respondent in DRS 00016525 is a Mr Toby Russel. Mr Russel is also the company secretary, sole director and sole shareholder in the Respondent in DRS 00016526 which is a company called, E DRIVE Limited.
- 4.5 Between them, the Respondents have registered and own the Domain Names. A list of the Domain Names together with their dates of registration is set out below.

Domain Names	Date of Registration
edrive.co.uk	12 January 2013
edrivecarbonfiber.co.uk	23 September 2014
edrivecarbonfibre.co.uk	23 September 2014
edriveformulae.co.uk	23 September 2014
edrivelttd.co.uk	23 September 2014
edriver.co.uk	24 September 2006
edriveracing.co.uk	23 September 2014
edriveplc.co.uk	5 August 2014

- 4.6 None of the Domain Names have been used to point to an active or live website although some of them do point to a holding or parking page. The Domain Name edriver.co.uk points to a page which displays the question, "Interested in this Domain Name? Make an offer?"
- 4.7 Mr Russel is the registered proprietor of UK trade mark number 03086131 for the word mark eDrive in classes 35 and 41. Following an opposition by the Complainant this trade mark is registered in classes 35 and 41 and specifically excludes services related to motor vehicles (which includes hybrid and electrical vehicles) or parts thereof. This trade mark was registered as of 15 December 2014.
- 4.8 Mr Russel also has a pending UK trade mark application for eDrive in classes 35 and 41. This application specifically excludes services relating to motor vehicles (which includes hybrid and electrical vehicles) or part thereof. This application has been opposed by a third party, Enterprise

Holdings Inc. which is not related to this particular dispute. In addition Mr Russel has a further pending UK trade mark application for ELECTRONIC DRIVE. This has been applied for in relation to, "Advertising services via the internet; auctioneering".

- 4.9 There has been some correspondence between the Complainant and its advisors and the Respondents and their advisors. In the course of this correspondence the Respondents have provided an undertaking not to use the trade mark eDrive in relation to the class 12 goods for which the Complainant has a registration (namely motor vehicles and parts thereof (excluding tyres and inner tubes for tyres)) and the Respondents have also offered to sell the Domain Names to the Complainant for either £500,000 or £2,000,000 depending on which combination of the Domain Names, the company name, eDrive Limited and the registered trade mark the Complainant wanted to buy.

## **5. Parties' Contentions**

### **The Complaint**

#### **Rights**

- 5.1 The Complainant contends that it has rights in a name or mark which is similar or identical to the Domain Names for the following reasons:
- The Complainant is the owner of a registered trade mark for the word mark eDrive. This is an International Registration registered with effect from 11 September 2007.
  - The Complainant has used its trade mark, i.e. the mark eDrive on a number of its vehicles and has to date sold 3,768 vehicles on which its mark was displayed. UK revenues from sales amount to £169,837,500. As a result of the very extensive use of this trade mark in the UK, the Complainant enjoys a substantial reputation in relation to the manufacture and supply of motorcars, and services relating to the same.
  - The Domain Names are identical or similar to the Complainant's trade marks because the Domain Names consist of the Complainant's trade mark alongside generic wording which does not serve to distinguish these Domain Names from the Complainant's trade mark. The Complainant says that, for example, the suffixes "limited" and "plc" are generic and the other Domain Names contain generic wordings relating to cars therefore increasing the possibility of confusion.

## Abusive Registration

5.2 The Complainant contends that the Domain Names are Abusive Registrations for the following main reasons:

- The Respondents are using or threatening to use the Domain Names in a way which has confused or is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant (Nominet's Dispute Resolution Policy ("the Policy") paragraph 3a(ii));
- The Domain Names were registered primarily as blocking registrations (Policy paragraph 3a(i)B);
- The Domain Names are registered for the purpose of unfairly disrupting the business of the Complainant (Policy paragraph 3a(i)C);
- The Domain Names were registered in circumstances indicating that the Respondents have registered or otherwise acquired the Domain Names primarily for the purposes of selling, renting or otherwise transferring the Domain Names (Policy paragraph 3a(i)A);

### Confusion (Policy paragraph 3a(ii))

5.3 The Respondent's intention in registering the Domain Names was to use or to sell them for the purposes of advertising or selling vehicles. In doing so the Respondent's sole purpose was to use and/or sell the Domain Names for the purpose of attracting customers to the Domain Names and to promote business which was unconnected to the Complainant;

5.4 In relation to the Respondent's trade mark registration for the mark eDrive the Complainant says that the fact that the Respondent's application originally included, "retail services connected with the sale of electrical vehicles" in class 35 shows an intention by the Respondents to use the Domain Names to advertise and sell cars on the internet, i.e. the same products in industry areas as the Complainant. While the Complainant notes that the Respondent has since amended the specification under class 35 to remove reference to, "retail services connected with the sale of electrical vehicles" on the request of the Complainant importantly in the Complainant's submission the Respondents have refused to give undertakings not to use the mark in trade in relation to such services evidencing, in the Complainant's submission, a continuing intention to use the mark in trade for those services.

5.5 Such is the reputation and goodwill associated with the Complainant's trade mark that a substantial portion of consumers in the UK would assume that the use of the Complainant's trade mark in a Domain Name would signify that the Domain Name, and any website attached to it, would be

connected or associated in the course of trade with the Complainant, especially as it is in a field of activity closely connected with that which the Complainant is engaged.

- 5.6 Use of the Complainant's trade mark and wording relating to cars in the Domain Names by the Respondents is confusing. Visitors searching for the Complainant's eDrive or similar are likely to stumble upon the Domain Names and be misled into believing that the Domain Names were in use by the Complainant or used under licence or otherwise authorised by the Complainant. This is known as, "initial interest confusion".

Blocking registration (Policy paragraph 3a(i)B):

- 5.7 The Respondent's registration of the Domain Names serves, in effect, to block the proper registration and use of the Domain Names by the Complainant. Due to this the Complainant is denied the right to register them for their own legitimate use.

Unfairly disrupting the business of the Complainant (Policy paragraph 3a(i)C)

- 5.8 The use of the Domain Names in connection with services not authorised by the Complainant dilutes the strength of the Complainant's trade mark and is disruptive to the Complainant's business by preventing prospective customers from obtaining information on the Complainant's goods and services through the Complainant's authorised websites and diverting customers for the Respondent's advantage.
- 5.9 Any future use of the Domain Names is calculated to infringe the Complainant's rights as the value in the names consists only in their resemblance to the Complainant's trade mark and the reputation and goodwill associated with the Complainant.
- 5.10 It is not a necessity for the Respondent's business to use the Complainant's trade mark in the Domain Names. The Complainant's trade mark is used in the Domain Names to "free-ride" off the reputation associated with the Complainant's mark.
- 5.11 The only reason why anyone who is not licensed, authorised or approved by the Complainant would use the Domain Names is to pass himself off as so authorised by the Complainant and to use such an impression for financial gain by promoting/selling services linked with and/or owned by entities unconnected with the Complainant.

Registered primarily for the purpose of selling, renting or otherwise transferring the Domain Names for valuable consideration (Policy paragraph 3a(i)A):

- 5.12 The Respondent's offer to sell some or all of the Domain Names (together with the Respondent's various UK trade mark registrations and applications

and company name) for either £500,000 or £2,000,000 according to which combination the Complainant wanted represents a value far in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Names.

- 5.13 The Domain Names do not lead to active websites. Only one Domain Name, edriver.co.uk, mentions making an offer to purchase the Domain Name. Such registration and lack of use suggests that the Respondents registered the Domain names with a view of selling them to the Complainant and/or other interested parties for valuable consideration in excess of the documented out-of-pocket costs.
- 5.14 In the recent correspondence received from the Respondents' lawyers mention is made of the Respondents being in discussions to sell all of the Respondent's trade mark rights and associated domain names to another international company. In the Complainant's submission this must be designed to pressurise the Complainant in order to make it pay the extortionate prices demanded by the Respondents.

### **Respondents' Submissions**

- 5.15 In their Response the Respondents make the following submissions:

5.15.1 The Respondents submit that the Domain Names are identical or similar to the Respondents own trade marks, namely its UK trade mark registration for the word mark eDrive and its UK trade mark applications for eDrive and Electric Drive.

5.15.2 The Respondents submit that the Domain Names are not Abusive Registrations.

### **Rights**

- 5.16 In relation to the question of whether the Complainant has Rights in a name or mark which is similar or identical to the Domain Names, the Respondents say as follows:

5.16.1 The Complainant's International Registration for the mark eDrive should not be assumed to be valid given that it is now more than five years old. The Respondent also submits that this International Registration is registered in respect of goods and does not cover services.

5.16.2 The mark eDrive is always used in conjunction with the Complainant's trade mark BMW and the Complainant has provided no evidence of its use of the mark eDrive alone nor submitted any evidence of goodwill subsisting in that mark alone. As such, it cannot be held that the Complainant is the owner of, "considerable goodwill and reputation" in respect of the mark eDrive.

5.16.3 It should not be assumed that the mark eDrive would be considered by the relevant trade and public to signify only goods/services offered by the Complainant, the prefix “e” is well-known as referring to electrical or electronic. Some examples of this include e-business, e-commerce, e-book and e-mail. Accordingly the term “eDrive” is of very low distinctiveness when used in relation to electric vehicles and is used by the Complainant as a descriptive denotation for electrical vehicles, in combination with the corporate mark BMW.

5.16.4 A number of the Domain Names include additional elements such as “carbonfiber”, “racing” and “formulae”. These additions have a significant impact on the visual, aural and conceptual understanding of the Domain Names as a whole and clearly distinguish these from being “eDrive domains”.

### **Abusive Registration**

5.17 In relation to its trade mark application for eDrive the Respondent says that although this trade mark application did not cover goods which were identical or similar to those covered by the Complainant’s registration in order to avoid becoming embroiled in costly and unnecessary trade mark opposition proceedings the Respondents agreed to amend it. The Respondent makes the same point about its subsequent trade mark application for eDrive which includes a similar limitation.

5.18 The Respondents acknowledge that they have undertaken not to use the mark eDrive in relation to the same goods as are covered by the Complainant’s registration. It refused to give an undertaking in the form demanded by the Complainant because the undertaking demanded was onerous and vague and ultimately extended beyond the scope of the Complainant’s trade mark registration which is limited to goods in class 12 and does not cover services. Furthermore, the Complainant has not demonstrated any goodwill or reputation in the mark eDrive alone and the undertaking clearly extends far beyond any rights that the Complainant can expect to enjoy in the mark eDrive.

5.19 The Respondent denies that its unwillingness to provide an undertaking in the form required by the Complainant is evidence of a continuing intention to use the trade mark for those services. It simply indicates the Respondent’s unwillingness to provide an undertaking which extends far beyond the Complainant’s rights in the mark.

5.20 Other parties use the term eDrive for what could be described as “services relating to motor vehicles”. The Respondent gives as examples, [www.edrivegroup.com](http://www.edrivegroup.com), [www.edriveuk.co.uk](http://www.edriveuk.co.uk) and [www.e-drivetech.com](http://www.e-drivetech.com).

5.21 It is disingenuous for the Complainant to claim that the Respondent’s unwillingness to provide an undertaking is a clear indication of its intention to infringe the Complainant’s rights.



### Confusion, Blocking and Disruption to Complainant's business

- 5.22 The Respondents have not used the Domain Names in any way which is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant.
- 5.23 The Complainants claim that the Respondents registered the Domain Names with the intention to use or to sell them for the purposes of advertising or selling vehicles and the Complainants have not provided any evidence to support this vexatious claim.
- 5.24 The Respondents did not register the Domain Names with the intention to use or sell them for the purposes of advertising vehicles nor was it the Respondents' sole purpose to use and/or sell the Domain Names for the purpose of attracting customers to the Domain Names and to promote business which was unconnected to the Complainant. The Domain Names were registered by the Respondents in good faith with the intention of using these Domain Names to support the Respondents' own business.
- 5.25 The Respondents submit there will be no initial interest confusion because visitors searching for "BMW eDrive" will be directed to the relevant BMW links as the inclusion of BMW in the search will ensure this.
- 5.26 The Domain Names were not registered in order to confuse people or primarily as blocking registrations. The Complainant only became aware of the Domain Names held by the Respondents as a result of potential trade mark opposition proceedings.
- 5.27 Had the Complainant any legitimate commercial interest in the Domain Names the Respondents believe that the Complainant would have taken the necessary steps to register them many years ago considering that the Complainant's trade mark registration for eDrive dates from 2007.
- 5.28 The additional elements in many of the Domain Names will assist in removing the possibility of any confusion. The Respondents point out that people will be no more confused in seeing the Domain Names than they would be in seeing many of the other third party domains which exist containing the name eDrive.

### Sale

- 5.29 The Respondents did not seek out the Complainant to offer the Domain Names for sale. Rather it was part of the discussions around the trade mark opposition and as part of those discussions the Complainant's solicitor requested a price at which the Respondents may be willing to dispose of some of the Domain Names. In response to that communication the offers were made on behalf of the Respondents;
- 5.30 The Respondents do not believe there is anything wrong with the offers as they are owners of the Domain Names quite legitimately and are aware

that Domain Names can change hands for quite substantial sums of money much in excess of the out-of-pocket costs directly associated with or using the Domain Names. In any event, the Complainant had an opportunity to make an alternative or counter offer and failed to do so.

- 5.31 The Respondents are now involved in a trade mark opposition with a separate party. As part of the Respondents' attempts to reach settlement in these proceedings the disposal of the Domain Names is under consideration. Again, the Respondents submit there is nothing wrong with this and they are perfectly entitled to try and reach a settlement with a third party. It is disingenuous of the Complainant to suggest that notifying the Complainant of such attempts to settle with a third party is designed to pressurise the Complainant in order to pay it the amount of consideration previously proposed. In fact, this was done simply as a courtesy to the Complainant.

### **Reply**

In reply to the Response the Complainant submits as follows:

- 5.32 It is incorrect to say that the mark eDrive is always used in conjunction with BMW and the Complainant provides evidence to show that it uses the trade mark eDrive alone both in relation to cars and in relation to various other features of its electric and/or hybrid vehicles.
- 5.33 The Respondents have failed to explain how they intend to use the Domain Names. The Complainant particularly points to the following correspondence:
- A letter from the Respondents representatives to the Complainant dated 3 June 2015 indicating that the Respondents were, "currently refraining from commencing use of the website [www.edrive.co.uk](http://www.edrive.co.uk) and launching a website pending a response [to the Complainants offer]";
  - On 17 July 2015 the Respondents advisors informed the Complainant that the Respondents now considered the matter "complete". However, despite this, no website has been launched at any of the Domain Names;
  - In a letter dated 11 September 2015 the Respondents' solicitors informed the Claimant that the Respondents were, "currently in discussions to sell all the trade mark rights and associated domains to another international company". This willingness to sell demonstrates that the Respondents have no bona fide use for the Domain Names.
- 5.34 In relation to the Respondents' offer to sell the Domain Names the Complainant reiterates the terms of paragraph 3 (a) (i) (A) of the Policy and notes that the Respondents have made no reference to this paragraph in their Response. The Complainant also reiterates that the exorbitant

sums demanded by the Respondents bear no resemblance whatsoever to the out-of-pocket costs in relation to a domain that has not been used.

5.35 In addition, the Complainant submits that the Respondents have not sought to justify the substantial sums demanded for the Domain Names and dismisses the examples given by the Respondents as being in no way comparable to the Domain Names. Additionally, the Complainant points out that the Respondents have not provided any evidence of any other offers for the Domain Names and has failed to demonstrate that the sums requested were market prices. The Complainant submits that any value attributed to the Domain Names would be solely as a result of the goodwill that the Complainant has built up in its trade mark.

5.36 The Complainant submits that the Respondents have not put forward:

- Sufficient evidence of use or demonstrable preparations to use the Domain Names in connection with the genuine offering of goods or services;
- Sufficient evidence that the Respondents have been commonly named by the Domain names;
- Any evidence that the Respondents have made legitimate non-commercial or fair use of the Domain Names.

5.37 The Complainant submits that the distinctive elements of the Domain Names are the Complainant's trade mark and the Respondents are not making fair use of them.

## **6. Discussions and Findings**

6.1 Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:

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

### **Rights**

6.2 As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name(s).

6.3 The definition of Rights in the Policy is 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.*

- 6.4 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.
- 6.5 I have no doubt that, on the balance of probabilities, the Complainant has Rights in the word or mark eDrive or EDRIIVE. I say this primarily because of the Complaint's trade mark registration for the word mark eDrive which has been registered since 11 September 2007. That alone is enough for me to make a finding that the Complainant has Rights in the word or mark EDRIIVE although I note that the Complainant does also appear to have some fairly substantial use of the mark eDrive on its vehicles and has made a substantial number of sales.
- 6.6 The Respondents have suggested that the Complaint's trade mark may not be valid or at least that I should not assume that it is valid. It is important to make the point at this stage that Nominet's DRS is intended to be a relatively informal dispute resolution process and very much a low cost, quicker alternative to litigation. It follows that a decision under Nominet's DRS will not involve a consideration of the validity or otherwise of trade marks nor will it involve a consideration of whether there has been trade mark infringement, passing off or anything else as a matter of law. It is therefore certainly not the forum for me to be examining whether the Complaint's trade mark is valid and therefore for the purposes of this decision under the DRS the fact that the Complainant has a trade mark means that it has Rights.
- 6.7 Having decided that the Complainant has Rights in the name or mark EDRIIVE I must decide whether or not the name or mark EDRIIVE is identical or similarly to the Domain Names. One of the Domain Names "edrive.co.uk" is of course identical to the name or mark in which the Complainant has rights. The others all comprise the name or mark EDRIIVE with the addition of an extra word or letters. In the case of "edriveld.co.uk" and "edriveplc.co.uk" I consider that "plc" and "ltd" are abbreviations that the public are well used to seeing and therefore add little or nothing to the name or mark EDRIIVE.
- 6.8 The other five marks "edriver.co.uk", "edrivecarbonfiber.co.uk", "edriveformulae.co.uk", "edrivecarbonfibre.co.uk" and "edriveracing.co.uk" are slightly different. My view however is that all except "edriver.co.uk" simply consist of the name or mark in which the Complainant has Rights together with another word which serves to describe goods or services which may come to be offered under that domain name. The distinctive or trade mark part of all of these domain names is clearly the first bit i.e. the name or mark "edrive" which is of course the name or mark in which the Complainant has Rights. "edriver.co.uk" is subtly different but given that it differs from the name or mark in which the Complainant has Rights only by

a single letter, the letter “r” I think this must also be close enough to be at least similar to the name or mark in which the Complainant has rights.

- 6.9 I therefore conclude, on the balance of probabilities, that the Complainant has Rights in a name or mark which is identical or similar to each of the Domain Names.

### **Abusive Registration**

- 6.10 Abusive Registration is defined in Paragraph 1 of the Policy as 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.*

- 6.11 This definition requires me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.

- 6.12 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.

- 6.13 The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

- 6.14 In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's Rights. In some cases where the name in which the Complainant has Rights is particularly well known this will be fairly obvious and straightforward while in other cases where the name in which the Complainant has Rights is less well known and/or where there are other meanings or uses which can be made of the name this will require substantial evidence from the Complainant.

- 6.15 The position on knowledge has been summarised by Nominet's Appeal Panel in the earlier case of Verbatim Limited -v- Michael Toth DRS04331 and it is convenient to reproduce the following paragraphs from the Appeal Panel's decision here:

*In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:*

*First, some knowledge of the Complainant and/or its brands/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.*

*Secondly, "knowledge" and "intention" are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.*

*Thirdly, "intention" is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.*

*Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.*

*Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.*

*Accordingly, in the view of this Panel, for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name.*

- 6.16 The approach that I therefore intend to take in this case is to look at the overall question of whether the Respondent's registration or use of the Domain Names constitutes an Abusive Registration. Bound up with that, and indeed central to it, will necessarily be the question of the Respondent's knowledge of the Complainant's Rights. Having done that, and if appropriate to do so, I will then move on to look at each of the non-exhaustive factors from Paragraph 3 of the Policy which the Complainant has highlighted in its complaint.

- 6.17 In making this overall assessment the nature of the name or mark in which the Complainant has Rights is also clearly a factor here. The more descriptive or generic that name or mark is then the more likely it is that the Respondents simply happened upon the Domain Name(s) as a “good domain name(s)” without necessarily having any knowledge of the Complainant’s Rights. Obviously the more well-known and unique that name or mark is then the less likely it is that the Respondents did not register the Domain Name(s) with the Complainant’s Rights in mind.
- 6.18 To put this into context in this Complaint if the Domain Names that we were concerned with included the mark “BMW” then there would be a very strong prima facie case that the domain names were Abusive Registrations and it would be very difficult indeed for the Respondents to show they were not. In other words, with a mark such as BMW there would be a very strong presumption indeed that the Respondents had registered a domain name consisting or containing the mark BMW in order to take unfair advantage of or be unfairly detrimental to the Complainant’s Rights and there would have to be a very credible explanation from the Respondents as to why they had registered a domain name including BMW to avoid a finding of Abusive Registration.
- 6.19 In the current case the Domain Names are basically “EDRIVE” with or without some extra words or letters. In relation to EDRIVE I agree with at least part of what the Respondents say and particularly the following:-
- the prefix “e” is a well-known prefix and is a common and widely used shorthand for “electrical” or “electronic” and the Respondents give the examples of “e-business”, “e-commerce”, “e-book” and “e-mail”. In my experience it is also commonly used to denote things that are done electronically or online which fits in with the Respondent’s examples;
  - the Respondents have identified a number of other businesses which use EDRIVE to provide services relating to motor vehicles. The Respondents give as examples websites at [www.edrivedgroup.com](http://www.edrivedgroup.com), [www.edriveuk.co.uk](http://www.edriveuk.co.uk) and [www.e-drivetech.com](http://www.e-drivetech.com).
- 6.20 The Respondents go further and say that the Complainant has no goodwill or reputation in the mark EDRIVE alone because it is always used with the mark BMW. Conversely the Complainant submits that EDRIVE is highly distinctive of its goods such that the relevant trade and public in the UK take it as signifying the goods offered by the Complainant. It is difficult to say definitively in a DRS case which is correct but my suspicion is that both positions are too extreme. It is however noteworthy that other than some pictures of the mark on cars the Complainant does not provide examples of how it advertises and promotes EDRIVE and I suspect that logically it may well be the case that it is largely used in conjunction with the Complainant’s well known BMW mark.
- 6.21 I think on balance however that the very nature of the name or mark EDRIVE means that it is much more likely to be the sort of name or mark

which a party may innocently adopt as part of a domain name and conversely is less likely to be the kind of name or mark that a party may register or use as part of a domain name to take unfair advantage of the Complainant. I would add that I feel that this view is supported, at least in part, by the fact that there are clearly other “edrive” businesses out there which relate to cars and vehicles and have nothing to do with either party.

6.22 What this means in practice is not that the Complainant’s case automatically fails but that the Complainant has to do more to show that on the balance of probabilities that the Domain Name(s) are Abusive Registrations. It is therefore important to look very carefully at the evidence and submissions that the Complainant puts forward in favour of the Domain Names being Abusive Registrations and to balance this with what the Respondents say by way of Response.

6.23 The Complaint is structured, quite properly, so as to address various of the factors under paragraph 3 of the Policy which may be evidence of an Abusive Registration. What these all amount to in practice of course is different ways of the Complainant saying or evidencing that the Respondents were taking unfair advantage of the Complainant’s Rights by registering or using the Domain Names. It is possible to draw out of the Complaint a number of facts or inferences that together (or separately) in the Complainant’s submission show that the Domain Names are, on the balance of probabilities, in the hands of the Respondents Abusive Registrations. These are as follows:

- (a) The fact that when the Respondents first filed their UK trade mark application for eDrive it included under clause 35 a reference to “retail services connected with the sale of electrical vehicles”. This is of course very close, if not the same, as the Complainant’s area of interest;
- (b) The Respondents have refused to give an undertaking not to use the mark eDrive in trade in relation to such services (although they have given an undertaking not to use the mark eDrive in relation to the Class 12 goods in relation to which the Complainant has a registration);
- (c) Such are the Rights that the Complainant has in the name or mark eDrive that it is clear that the Respondents’ sole purpose in registering the Domain Names was to take unfair advantage of the Complainant’s Rights by suggesting some form of connection with the Complainant and its Rights;
- (d) Many of the additional words which have been added to eDrive in the Domain Names relate to cars or vehicles and this increases the likelihood of a connection being seen between the Complainant and the Domain Names;
- (e) The offer made by the Respondent to the Complainant to buy the Domain Names for a very large sum of money;



- (f) The correspondence between the Respondents and the Complainant in which the Respondents made it clear that they were in negotiations with a third party and that they were holding eDrive.co.uk pending a response from the Complainant (all of which was designed to pressure the Complainant into either accepting the Respondents' offer or making a decent counter-offer).

6.24 This is of course not all that the Complainant says but it does provide a flavour of the evidence relied on by the Complainant against the Respondents.

6.25 In Response, the Respondents say a number of things. All I am concerned with at this stage of the Decision is the reasons why the Respondents say that they registered the Domain Names and applying the same exercise as I have carried out in relation to the Complaint although these can be largely summarised as follows:

- (a) The prefix "e" is a very widely used prefix which denotes, "electric" or "electronic" and there are a number of other companies already using eDrive in relation to car or vehicle related websites which are unconnected with either party
- (b) The amendment to their trade mark application was to remove reference to the retailing of motor vehicles was done in order to avoid a costly opposition.
- (c) It is not fair to infer from the Respondents' refusal to give an undertaking not to use the Domain Names in relation to services relating to motor vehicles and that is what it intends to do.
- (d) The Respondents did not register the Domain Names with the intention to use or to sell them for the purposes of advertising or selling vehicles.
- (e) The Respondents did not register the Domain Names in order to take unfair advantage of the Complainant's rights;
- (f) The Domain Names were registered in good faith with the intention of using them to support the Respondents' own business;
- (g) The Respondents now find themselves in opposition proceedings with a third party and as part of their attempts to settle those proceedings are discussing a possible transfer of the Domain Names;
- (h) The Respondents did not register the Domain Names for the purpose of selling them to the Complainant or anyone else and the offer that was made was made in response to the Complainant's enquiry. In any event the offer that represented a fair value for the

Domain Names and there is nothing to stop the Complainant making a counter-offer.

- 6.26 Again, this is not everything that the Respondents say but hopefully provides a fair flavour of it.
- 6.27 What is missing from the Respondents' submissions is any real explanation of why they registered the Domain Names or what they intend to do with the Domain Names. The Respondents have produced some evidence which they say evidences their preparations to trade. This does not really amount to very much at all. Perhaps the most convincing is an invoice from a brand agency for a deposit to create a brand and a website and for a year's webhosting. However there is no evidence that this invoice was actually paid or the work took place. There is certainly no evidence that the Respondents have made any serious preparations to trade at this stage.
- 6.28 I am, however, also very conscious that there is nothing inherently wrong with the practice of buying domain names to sell them on and also, the fact that the Respondents have not used any of the Domain Names does not necessarily mean that they are Abusive Registrations and again there is nothing inherently wrong with buying Domain Names and not using them.
- 6.29 What this all really comes down to is whether the Complainant has shown enough to prove that on the balance of probabilities the Respondents knew at some level about the Complainant's Rights when they came to register the Domain Names and therefore whether that registration of the Domain Names takes unfair advantage of or is unfairly detrimental to the Complainant's Rights. In doing this the principal point which the Complainant must overcome is the fact that the name or mark in which it has rights is the kind of name or mark which someone may easily have come up with independently of the Complainant largely due to the very commonly used prefix "e". As I have said this makes the Complainant's task harder than it usually would be. Against this my feeling is that the Respondents have been less than transparent and it is not clear why the Respondents have not been more transparent about their plans for the Domain Names.
- 6.30 The high point of the Complainant's case is the nature of the Domain Names (all are clearly electronic car or vehicle related) and the Respondents' original trade mark application. I think those factors are stronger pointers to an Abusive Registration than what came next. The refusal to give undertakings, the excessive offer and the Respondents' conduct after they were contacted by the Complainant do not, in my view, assist very much. I find it very difficult to infer anything from a refusal to give undertakings and the offer, while possibly misjudged, was just that – a fairly opportunistic offer made in order to make some money out of the situation that the Respondents found themselves in and in response to pressure from the Complainant. I do not think that it can be inferred from this offer that the Respondents registered the Domain Names with a view to selling them to the Complainant.

- 6.31 Given that many if not all of the Domain Names are probably most relevant to motor vehicles I think it not an unreasonable inference that the Respondents intended to do something loosely connected with or in the same field as motor vehicles or driving probably related to electric or “e” vehicles. Indeed, that would be the natural use for domain names such as the Domain Names and would also fit with the fact that the Respondents originally applied to register the trade mark eDrive in relation to “retail services connected with the sale of electrical vehicles”.
- 6.32 Nevertheless, there is the absence of any real evidence that the Respondents knew about the Complainant’s Rights and set out to take unfair advantage of them. It seems to me entirely possible that the Respondents have simply selected a fairly obvious name i.e. EDRIIVE which they liked the sound of and then registered some domain names around that. Given the nature of the name or mark in which the Complainant has Rights I would need some fairly strong evidence to find on the balance of probabilities that the Respondents registered (or indeed used) the Domain Names in knowledge of the Complainant’s Rights.
- 6.33 At the end of the day I do not know what the Respondents’ true intentions were and I am not helped very much, if at all, in their Response at least in relation to their intentions. Ultimately, however the nature of the name or mark EDRIIVE, and the fact that it is a name or mark that would clearly be a natural and even popular choice for a business relating to cars, and particularly electronic or electric cars, leads me to conclude that there is sufficient doubt that the Respondents knew about the Complainant’s Rights when they registered the Domain Names not to make a finding of Abusive Registration.
- 6.34 I should stress that this was a very marginal decision. It would certainly be open to the Complainant to file a fresh complaint when the Respondents, or anyone else, begin to use the Domain Names and indeed the nature of at use may well supply the crucial piece of evidence which the Complainant needs to get over the line in terms of showing on the balance of probabilities that these Domain Names are Abusive Registrations.

## **7. Decision**

- 7.1 I find that, on the balance of probabilities, the Complainant has Rights in a name or mark which is identical or similar to each of the Domain Names. I do not however find that, on the balance of probabilities, the Complainant has established that the Domain Names, or any of them, are an Abusive Registration. I therefore direct that no action be taken in relation to the Domain Names.

**Signed Nick Phillips**

**Dated 14 December 2015**