

DISPUTE RESOLUTION SERVICE

D00016960

Decision of Independent Expert

Verband der Automobilindustrie e.V

and

Mr Simon Smith

1. The Parties:

Lead Complainant: Verband der Automobilindustrie e.V
Behrenstraße 35
Berlin
10117
Germany

Respondent: Mr Simon Smith
9 Longmans Close
Carlisle
Cumbria
CA1 3TL
United Kingdom

2. The Domain Name:

adblueremoval.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 into question my independence in the eyes of one or both of the parties.

15 January 2016 18:10 Dispute received

19 January 2016 12:37 Complaint validated
19 January 2016 12:44 Notification of complaint sent to parties
19 January 2016 16:18 Response received
19 January 2016 16:18 Notification of response sent to parties
22 January 2016 01:30 Reply reminder sent
26 January 2016 09:22 Reply received
26 January 2016 09:22 Notification of reply sent to parties
26 January 2016 09:22 Mediator appointed
29 January 2016 10:19 Mediation started
15 February 2016 11:48 Mediation failed
15 February 2016 11:49 Close of mediation documents sent
18 February 2016 12:31 Expert decision payment received

4. Factual Background

The Complainant is an umbrella organisation of the German automotive industry, founded in 1901 and, since 1946, trading under the name Verband der Automobilindustrie e.V. It is the registered proprietor in many countries of the trade mark ADBLUE, including CTM No. 3945938, registered in 2006 for, *inter alia*, additives for lessening the output of hazardous materials in exhaust gases from internal combustion engines.

The mark is used in connection with a 32.5 % solution of urea in de-ionised water. The use of ADBLUE urea solution in conjunction with pollution control technology installed in the exhaust system of diesel vehicles called Selective Catalytic Reduction or SCR leads to a reduction of nitrous oxide emissions.

The Complainant has appointed numerous licensees of its ADBLUE mark, including BP, licensed in the UK since 2010. ADBLUE urea solution is available at filling stations and dealers all over Europe. The mark is used on vehicles, car parts and in car manuals. On diesel vehicles equipped with SCR technology there is a separate tank for ADBLUE urea solution for which the filler cap is labelled with the ADBLUE mark.

The Domain Name was registered in 2012. It leads to a website headed “Adblue Emulator – Disable Adblue Now!” which states on the first page, *inter alia*, “We specialise in adblue removal devices for trucks, our emulator boxes will disable your adblue system” and “Currently this is working on the following trucks with the Adblue system”, followed by a list of truck manufacturers.

A statement at the foot of the second page reads: “Adblue™ is a registered trade mark of the German association of the automotive industry, We use the word Adblue™ on this website purely for descriptive purposes None of the manufactures [sic] above support our services, all images and logos are for illustrative purposes only.”

5. Parties' Contentions

Complainant

In addition to its numerous registered trade marks, the Complainant claims common law rights in its ADBLUE mark.

It says the Domain Name is closely similar to a name in which it has rights and that the Domain Name is an abusive registration because the Respondent is using it in a way which is likely to confuse people or businesses into believing that it is registered to, operated or authorised by or otherwise connected to the Complainant.

Members of the public will be confused as to the identity of the proprietor of the Domain Name. Its dominant element is the distinctive ADBLUE trade mark. The appended word 'removal' does not detract from that distinctiveness. Nor does it suggest that the Domain Name is not linked or in some way associated with the Complainant. The term 'removal' is a non-distinctive and descriptive term which would take on its ordinary meaning of "the taking away of something unwanted" and would not be seen to be anything more by consumers. Consequently, it is likely consumers could believe the Domain Name to be authorised by the Complainant as the ADBLUE trade mark is associated in the minds of the public with the Complainant and its authorised licensees.

The generic term for the Complainant's ADBLUE product would be 'urea solution' or 'Diesel Exhaust Fluid (DEF)'. A number of companies manufacture and sell DEF under their own different brand names. Therefore, the Respondent could use domain names such as defremoval.co.uk, dieselexhaustfluidremoval.co.uk, scrsystemremoval.co.uk or ureasolutionremoval.co.uk to offer his products and services.

The Domain Name is in use in relation to a website which promotes DEF disabling services and which provides DEF emulator boxes and their installation. DEF disabling services are not recommended and are certainly not advocated by the Complainant as the disabling/removal of DEF will mean the vehicle in question will no longer comply with the legal requirements for exhaust emissions in some countries. Consequently, the use of the Complainant's trade mark ADBLUE in the Domain Name, which hosts a website promoting such services and providing products to assist with the same, is detrimental to the reputation of the Complainant as consumers may think the Domain Name is authorised by the Complainant or owned by one of the Complainant's licensees. Consequently they may believe that the Complainant endorses such services and/or non-compliance with legal regulations. For consumers to have such beliefs about the Complainant would be seriously damaging to its reputation as an association representing the automotive industry and to the reputation of the ADBLUE trade mark.

The Respondent's use of the trade mark ADBLUE in the Domain Name without any clear indication or dissociation from the Complainant or its authorised licensees will clearly imply to members of the public that the Domain Name and the associated website are either registered to, operated or authorised by or

otherwise connected with the Complainant or its authorised licensees, when that is not the case.

The Complainant seeks cancellation of the Domain Name.

Respondent

The Respondent asks why he is being targeted for his domain name, saying he sells adblue removal boxes for trucks; his boxes disable adblue which is why he purchased the Domain Name because this is exactly what he does.

A Google.co.uk search for “adblue removal” shows other companies that use adblue in their domain name. The Respondent asks why his domain name should be taken down and the other companies get away with it? Examples are <<https://adblueremoval.com>> and <<http://adblueproblems.com>>.

On the Respondent’s site it is clearly stated that Adblue™ is a registered trade mark of the German association of the automotive industry, He uses the word Adblue™ on this website purely for descriptive purposes. None of the manufacturers above support his services; all images and logos are for illustrative purposes only.

The Respondent has had this Domain Name since 2012, resolving to the same website.

Complainant’s Reply

The Respondent advises that he sells “adblue removal boxes” but the generic term for ADBLUE is Diesel Exhaust Fluid (DEF). He therefore sells DEF removal boxes and consequently, DEF should be the term used in his domain name, not ADBLUE.

The misuse of the ADBLUE trade mark by third parties does not make the Respondent’s use acceptable nor does it mean that such misuse is condoned by the Complainant nor that the Complainant is not also taking action against such misuse.

The use of the trade mark ADBLUE in the Domain Name is not descriptive use and is not purely for illustrative purposes. Therefore such statement on the website is incorrect and is not sufficient to ensure consumers are not confused.

The fact that the Domain Name was registered in 2012 does not detract from the misuse of the ADBLUE trade mark in the Domain Name. Through its attorneys the Complainant contacted the Respondent in December 2015, as soon as it became aware of the use of the ADBLUE trade mark in the Domain Name.

6. Discussions and Findings

Under paragraph 2 of Nominet’s DRS Policy, to obtain transfer or cancellation of the Domain Name, the Complainant is required to prove, on the balance of probability, that it has Rights in respect of 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, defined in paragraph 1 as a domain name which either 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 Complainants' Rights; or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

I find the Complainant's ADBLUE trademark to be well known in the motor vehicle industry and amongst operators of diesel fuelled vehicles. The Domain Name combines that trademark with the descriptive word "removal" and the inconsequential "co.uk" suffix, which may be disregarded. The word "removal" does not detract from the distinctiveness of the ADBLUE mark and I therefore find that the Complainant has Rights in respect of a mark which is similar to the Domain Name.

Under paragraph 3 of the Policy, a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration includes:

- ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Experts' Overview explains that the 'confusion' referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name.

The Domain Name couples the ADBLUE trade mark with the modifying word "removal", a word that conveys the idea of a service that could be provided by the Complainant or by others competent in the field and thus does not clearly disassociate the Domain Name from the Complainant. Contrary to the Respondent's submission, I find that the word "adblue" on the Respondent's website is not used purely descriptively. It follows that many Internet users familiar with the Complainant's ADBLUE product are likely to believe that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. This conclusion is reinforced by the circumstance, as appears from the complaint and from the Respondent's website, that in certain countries and in off road situations, the disabling of ADBLUE is not unlawful.

The website to which the Domain Name resolves promotes the disabling of ADBLUE and the consequent claimed advantages in fuel and cost savings. The disclaimer set out above appears in the bottom right corner of the second page. Its language and location do not sufficiently dispel the representation inherent in the Domain Name that the services offered on the website may be provided by or with the authority of the Complainant.

The Complainant's rights in its ADBLUE mark pre-date the Respondent's registration of the Domain Name, so the fact that the Respondent's website has remained unchanged since 2012 is of no consequence. Likewise, the fact that other parties are using the word "adblue" in their domain names in ways which

may or may not infringe the Complainant's rights is immaterial to the determination of this proceeding.

I find that the Respondent must have been fully aware of the well-known ADBLUE mark when registering the Domain Name and that the Domain Name has been used in a manner which has taken unfair advantage of the Complainant's Rights.

7. Decision

For the above reasons I find that, on the balance of probabilities, the Complainant has rights in a name or mark which is similar to the Domain Name and that, in the hands of the Respondent, the Domain Name is an Abusive Registration.

As requested by the Complainant, I therefore direct that the Domain Name be cancelled.

Signed: Alan Limbury

Dated March 9, 2016