



NOMINET

DISPUTE RESOLUTION SERVICE

D00017237

Decision of Independent Expert

Arnold Clark Automobiles Limited

and

Mark Wilkinson

1. The Parties:

Complainant: Arnold Clark Automobiles Limited
134 Nithsdale Drive
Glasgow
G41 2PP
United Kingdom

Respondent: Mark Wilkinson
1/1 68 Dunard street
Maryhill
Glasgow
G20 6SH
United Kingdom

2. The Domain Name:

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

21 March 2016 16:19 Dispute received
22 March 2016 13:52 Complaint validated
22 March 2016 13:54 Notification of complaint sent to parties
29 March 2016 08:48 Response received
29 March 2016 08:48 Notification of response sent to parties
01 April 2016 02:30 Reply reminder sent
06 April 2016 08:56 No reply received
07 April 2016 15:44 Mediator appointed
08 April 2016 13:08 Mediation started
19 April 2016 13:47 Mediation failed
25 April 2016 12:36 Close of mediation documents sent
25 April 2016 12:37 Expert decision payment received

4. Factual Background

Founded in 1954 the Complainant is a large independently owned family run car dealership, selling new cars, nearly new cars and used cars with over 200 new and used car dealerships throughout the UK. The Complainant also offers motor servicing, MOT testing and tyre checks and sales. It offers its services online also at www.arnoldclark.com. It is, inter alia, the owner of a UK registered trade mark for ARNOLD CLARK in Class 35 filed in 2002.

The Domain Name was registered on September 4, 2015. It has been offered for sale to the Complainant for £50,000 and then £30,000. It has been pointed to payperclick links offering goods and services unconnected, but competing with the Complainant.

5. Parties' Contentions

The Complainant's submissions can be summarised as follows:

Founded in 1954 the Complainant is Europe's largest independently owned family run car dealership, selling new cars, nearly new cars and

used cars with over 200 new and used car dealerships throughout the UK. The Complainant sells over 200,000 cars per year, employs 9000 staff and enjoys an annual turnover of **over GBP2,9 billion**. The Complainant also offers motor servicing, MOT testing and tyre checks and sales. It offers its services online also at www.arnoldclark.com. It is, inter alia, the owner of a UK registered trade mark for ARNOLD CLARK in Class 35 filed in 2002.

The Domain Name was registered on September 4, 2015 by an individual named Mark Wilkinson in Glasgow. The .co.uk suffix is only required for technical reasons and can be ignored for the purpose of comparing the Domain Name with the Complainant's marks. The additional words 'used' and 'cars' are merely generic and descriptive and are wholly referable to the Complainant, as the sale of used cars is the mainstay of the Complainant's business. These words do nothing to distinguish the Domain Name from the Complainant's business.

The Complainant has rights which are similar to the Domain Name.

The Complainant's agent wrote to the Respondent on March 4, 2016. The Respondent then telephoned the Complainant's agent on the morning of March 8, 2016 and offered to transfer the Domain Name to the Complainant in return for £50,000, later reduced to £30,000 during the course of the phone call.

When the Complainant's agent rejected the Respondent's offer, the Respondent offered to set up a web site on the Domain Name through which he would sell the Complainant's cars and receive sales commissions from the Complainant. Again the Complainant's agent rejected the Respondent's offer, noting the Complainant already had a transactional web site and would not want to pay commission to the Respondent. The Complainant then commenced these proceedings.

The Domain Name currently resolves to pay per click advertising made up of sponsored listings for services and goods related to vehicles provided by competitors of the Complainant.

The Complainant contends that the Respondent's primary purpose in registering the Domain Name was for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or a

competitor of the Complainant for valuable consideration in excess of the Respondent's out of pocket costs directly associated with acquiring or using the Domain Name. The current registrar for the Domain Name charges £7.99 (currently discounted to "£1 per annum) for a .uk domain name. The Respondent's suggested prices for the Domain Name £50,000 and then £30,000 are well in excess of the Respondent's reasonable out of pocket expenses. If the Respondent had any other motive that selling the Domain Name it would have suggested this before the Complainant rejected the Respondent's offer to sell the Domain Name.

After the Complainant refused to purchase the Domain Name the Respondent offered to set up a web site selling the Complainant's used cars for commission. The Complainant avers that if the Respondent were to use the Domain Name as suggested without consent confusion would inevitably result and could not be negated even by use which did not directly relate to the Complainant's activities. There are, therefore, circumstances indicating use likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to the Complainant, When web users arrive at the Respondent's web site there is no indication of non-relationship with the Complainant. Redirection to payperclick advertising is unacceptable as any traffic must necessarily have resulted from the confusion caused by the inclusion of the Complainant's mark as the dominant element of the Domain Name.

The Respondent could not have used the Domain Name in connection with a genuine offering of goods and services as no offering of third party goods under ARNOLD CLARK could be considered genuine. The web site is clearly commercial so is not registered for non-commercial, tribute or critical purposes. The Domain Name cannot be considered generic or descriptive as it clearly refers to the Complainant.

The Respondent's submissions can be summarised as follows:

The Respondent purchased the Domain Name for a friend who was getting married. Her husband's name is Arnold Clark. Because he is a mechanic and sells used cars the Respondent thought it would make a great wedding present. Only when the Respondent showed him did he explain that he could not accept the name due to the clash with the

Complainant. There has been no attempt to build a web site for the Domain Name. The Domain Name was not purchased for any gain from the Complainant. The Respondent bought the Domain Name and is its rightful owner. There was no malice. The Respondent was not legally advised. The Respondent bought another domain name buyingusedcar.co.uk well before the Complainant's domain name was purchased.

6. Decision

General

To succeed in this Complaint, the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy). Right is defined as 'rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'.

Complainant's Rights

The Complainant is the proprietor of, inter alia, a UK registered trade mark for ARNOLD CLARK for services related to vehicles filed in 2002. The Expert is, therefore, satisfied that the Complainant has Rights under the Policy.

The Domain Name is similar to the Complainant's registered and distinctive mark ARNOLD CLARK with the generic words 'used' and 'cars' added. The addition of the word 'used' and 'cars' are not sufficient in itself to distinguish the Domain Name from the Complainant's registered ARNOLD CLARK mark being related in meaning to the Complainant's business. The ccTLD .co.uk may also be disregarded for this purpose.

Accordingly the Expert finds that Complainant has Rights in respect of the

ARNOLD CLARK mark which is similar to the Domain Name for the purposes of the Policy and that the Complainant has satisfied the first limb of the Policy.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines “Abusive Registration” 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 took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. There being no suggestion that the Respondent has given false contact details, has a pattern of registrations or has a relationship with the Complainant, the only potentially relevant ‘factors’ in paragraph 3 are to be found in subparagraph i, ii and iii which read as follows:

i “Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out of pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;”

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 Domain Name has been offered for sale by the Respondent to the Complainant for £50,000 and, later, £30,000. No evidence has been produced by the Respondent of the existence of his friend's husband 'Arnold Clark' for whom he states the Domain Name was a wedding present. When the Complainant declined these offers the Respondent made a proposal to sell cars at the Domain Name in exchange for commission to be paid to the Respondent by the Complainant. Given the highly particular meaning of the Domain Name and the distinctive nature of the mark ARNOLD CLARK for services related to vehicles the Expert finds it likely on the balance of probabilities that the Respondent had the Complainant in mind when the Domain Name was registered and should have been aware that selection of the actual name of the Complainant and references to its business in a domain name could be a blocking registration or would ride on the Complainant's rights taking undue advantage and causing detriment. In so doing, the Respondent must have realised it would be, unfairly disruptive to the Complainant's business. The Respondent even refers to the Domain Name in his Response as the 'Complainant's domain name' which appears to suggest that he knows that the Domain Name, in fact, refers to the Complainant alone. Further, in the opinion of the Expert the Domain Name is likely to confuse and the use outlined by the Respondent to sell cars if the names were not purchased by the Complainant would confuse Internet users into thinking that the site connected to the Domain Name was connected to the Complainant. Finally, the offer to sell the Domain Name by the Respondent to the Complainant for large amounts of money way in excess of the expenses related to registration of a domain name is a clear indication that the Domain Name was registered for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out of pocket costs directly associated with acquiring or using the Domain Name.

Accordingly, in the view of the Expert in its registration and use of the Domain Names the Respondent took unfair advantage of and caused detriment to the Complainant's Rights. Accordingly, the Expert finds that

the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in respect of a registered mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, arnoldclarkusedcars.co.uk be transferred to the Complainant.

Signed ...Dawn Osborne.....

Dated ...25 May 2016.....