



NOMINET

Dispute Resolution Service

D00017594

Jaguar Land Rover Limited

and

Dorlin Transport Services Ltd

Decision of Independent Expert

1 Parties

Complainant: Jaguar Land Rover Limited

Address: Abbey Road,
Whitley,
Coventry

Postcode: CV3 4LF

Country: United Kingdom

Respondent: Dorlin Transport Services Ltd

Address: Unit 1, 117 Huddersfield Road
Mirfield

Postcode: WF14 9DA

Country: United Kingdom

2 Domain name

<westridingjaguar.co.uk>

3 Procedural History

- 3.1 On 13 June 2016 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent on the 15 June 2016. The respondent’s response was received on the 6 July 2016, and the complainant’s reply on 12 July 2016. The dispute was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 11 January 2017 paid the applicable fee.
- 3.2 I was appointed as expert on 17 January 2017. I have made the necessary declaration of impartiality and independence. 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.

4 Factual background

- 4.1 The complainant is a well-known car manufacturer. The domain name was registered by the respondent in 2005.

5 Parties’ Contentions

Complainant

- 5.1 The complainant says it owns trade marks in relation to the mark JAGUAR, and that it owns a range of domains based on the string <jaguar>. It says it provides, through a network of authorised dealers, repair and maintenance services.
- 5.2 It says the dominant and distinctive element of the domain name is the term JAGUAR, and that the rest of it is merely a reference to a geographical location (the west riding of Yorkshire).
- 5.3 It says the respondent is using the domain name to host a commercial website offering servicing and repair work for the complainant’s JAGUAR branded vehicles.
- 5.4 The complainant argues that use of a domain name containing its mark to host a website providing identical services to its own is more than merely descriptive, and suggests the domain name is in some way connected to the complainant. It argues that this takes unfair advantage of its trade mark rights, and exploits its goodwill and prestige.

- 5.5 It says the only reason to use a domain name containing its mark is to trade off its reputation and goodwill and to suggest an association with it, or its endorsement.
- 5.6 The fact the respondent genuinely provides services relating to its branded vehicles is irrelevant, the complainant argues, and does not authorise the respondent to use its mark in the domain name.
- 5.7 The complainant denies that it has accepted the respondent's use of the domain name. It says changes the respondent has made to content of the website connected to the domain name are irrelevant to this dispute.

Respondent

- 5.8 The respondent says it has never purported to be anything other than an independent repairer of Jaguar vehicles. It says it has never sought to do more than use the domain name for descriptive purposes.
- 5.9 It says the complainant has done business with it, and so has accepted its use of the domain name.
- 5.10 It says the website connected to the domain name makes its independence of the complainant abundantly clear. It says it has further emphasised its independence by changing its name to "West Riding Independent Ltd" and that it has at the complainant's request changed its website to refer to itself as "Independent specialists of Jaguar Vehicles" and to include an acknowledgement that JAGUAR is a registered trade mark.
- 5.11 It says it needs to retain the domain to enable customers to locate it, since it is commonly referred to as "West Riding Jag" or "West Riding Jaguar". The retention of the domain name is, it says, critical to the future success of its business.
- 5.12 It denies that its registration or use of the domain name is abusive.

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities 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.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise. They may include rights in descriptive terms which have acquired a secondary meaning.
- 6.3 The complainant has produced documentary evidence from the UK Intellectual Property Office of its trade mark registration for the mark JAGUAR.
- 6.4 At the third level (i.e. disregarding “.co.uk”) the domain name can be read, and in my view is most naturally read, as consisting of a three-word phrase, “West Riding Jaguar”. It therefore includes a string of characters corresponding to the complainant’s mark, which in my view represents the dominant element of the domain name.
- 6.5 In my view the addition of the words “West Riding”, which are naturally read as a reference to West Yorkshire, makes no difference. Those words imply a geographical qualification but do not remove the apparent reference to the complainant’s marks or reduce the domain name’s similarity to it.
- 6.6 In those circumstances, I am satisfied that the complainant has rights in respect of a mark which is similar to the domain name.

Abusive registration

- 6.7 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using a domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.8 Given that the domain names include the complainant’s mark, and given that business being carried on via the domain names relates to the complainant’s products, in my view some confusion is likely between the domain names and the complainant. Nothing about the domain name serves to distinguish it from the complainant.
- 6.9 The respondent says the complainant has accepted its use of the domain name, but has produced no evidence in support of that contention.
- 6.10 In my view the changes the respondent says it has made to its website are not sufficient to remove the likelihood of confusion between the complainant and the domain name.
- 6.11 Finally, in my view it makes no difference that the respondent claims a commercial need to retain the domain name. That is irrelevant to the question whether the domain name is an abusive registration under the Policy, which is the question I must decide.
- 6.12 In my view, the respondent appears in the circumstances to have used the domain name in a manner which has taken unfair advantage of the complainant’s rights.

6.13 In the circumstances I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

7 Decision

7.1 I find that the complainant has rights in a mark which is similar to the domain name.

7.2 The complaint is upheld. I direct that the domain name be transferred to the complainant.

Carl Gardner

13 February 2017