

DISPUTE RESOLUTION SERVICE

D00017926

Decision of Independent Expert

Jaguar Land Rover Limited

and

The Hutson Motor Company Limited

1. The Parties:

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

Respondent: The Hutson Motor Company Limited
Pawson Street
Bradford
West Yorkshire
BD4 8DF
United Kingdom

2. The Domain Name(s):

e-typecars.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.

Chronology:

06 September 2016 13:55 Dispute received
06 September 2016 14:51 Complaint validated
06 September 2016 14:54 Notification of complaint sent to parties
23 September 2016 02:30 Response reminder sent
28 September 2016 10:27 Response received
28 September 2016 10:28 Notification of response sent to parties
03 October 2016 02:30 Reply reminder sent
04 October 2016 10:11 Reply received
04 October 2016 10:12 Notification of reply sent to parties
04 October 2016 10:12 Mediator appointed
10 October 2016 10:47 Mediation started
06 January 2017 16:30 Mediation failed
06 January 2017 16:30 Close of mediation documents sent
11 January 2017 16:11 Expert decision payment received
12 January 2017 Keith Gymer appointed Expert with effect from 17 January 2017

As the filing date of this Complaint was prior to October 1, 2016, the Expert notes that this Decision is to be made under Version 3 of the DRS Policy and Procedure.

4. Factual Background

The Complainant, Jaguar Land Rover Limited is incorporated in the UK, where it manufactures and sells motor vehicles, under the Land Rover and Jaguar brands and others. It operates from its two engineering centres at the Whitley plant in Coventry and the Gaydon site in Warwickshire, its manufacturing plants in Castle Bromwich, Solihull near Birmingham and Halewood near Liverpool, and its recently opened engine production site in Wolverhampton. It employs over 25,000 people in the UK and is the largest automotive manufacturing employer in the UK.

The E-Type Jaguar sports car was launched in 1961 and is well recognised as a ground-breaking classic car model.

The Complainant owns various registrations for the E TYPE mark, including:

- a) EUTM 1170216 E TYPE in classes 12, 27 and 37 dated 12 May 1999;
- and
- b) EUTM 10203008 E-TYPE in classes 12, 35 and 37 dated 17 August 2011.

The Respondent, The Hutson Motor Company Limited is also a UK based business, operating in Bradford, West Yorkshire as “*MG ‘T’ Series, Jaguar E-Type Parts and Panels Specialists*”. It uses the disputed Domain Name, e-typecars.co.uk, for a website in support of this business.

According to the Nominet WhoIs records (which are reportedly not entirely complete before 2008), the disputed Domain Name was first registered as of 28 January, 2000 to an unidentified third party, and the Domain Name was subsequently transferred into the Respondent’s name in 2006.

5. Parties' Contentions

Complainant

The Complainant provided brief information on the history of Jaguar cars and submits that the Domain Name in dispute is identical or similar to a name or mark in which it has Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration.

Complainant's Rights

As noted at 4 above, the Complainant owns, amongst others, the following relevant trade mark registrations:

- a) EUTM 1170216 for E TYPE, filed 12 May 1999; and
- b) EUTM 10203008 for E-TYPE, filed 17 August 2011.

Additionally the Complainant asserts claims to Common Law rights on the basis that the E-TYPE marks have acquired extensive goodwill and a substantial reputation throughout the UK, the EU and the world and, as a result, are very well-known marks.

The Jaguar E-TYPE was first revealed on 15 March 1961 in Geneva to huge excitement from the world's press. Sir William Lyons, the founder of Jaguar, realised that he had something very special on his hands and had a second car delivered overnight from Coventry to Switzerland in order to allow more test runs at the show.

The E-TYPE was a revolutionary car in many ways but it was Malcolm Sayer's beautiful bodywork that set it apart from anything else on the road. The E-TYPE is still considered by many to be one of the greatest car designs ever, with Enzo Ferrari famously describing it as "*the most beautiful car in the world*". In March 2008, the Jaguar E-TYPE ranked first in The Daily Telegraph online list of the world's "100 most beautiful cars" of all time".

The Complainant also owns a number of domain names relevant to the E-TYPE vehicle model, including the following:

- a) jaguaretyperestoration.co.uk
- b) jaguaretyperestorations.co.uk
- c) e-typesforsale.co.uk
- d) etypesforsale.co.uk

The Complainant argues that the dominant, distinctive element of the Domain Name e-typecars.co.uk is identical to the E-TYPE mark, in which the Complainant has rights. The remainder of the Domain Name, "cars", is purely descriptive. As such, the Complainant asserts that this Domain name is likely to confuse consumers into wrongly believing that there is a link between the Complainant and the Respondent.

Abusive Registration

As can be seen from the Respondent's website, the Respondent manufactures and retails replacement parts, replacement panels, frames and steel works for the MG 'T' Series and E-TYPE vehicles, and provides repair and restoration services for such vehicles.

The Domain Name was registered many years after the launch of the E-TYPE vehicle by the Complainant. The Respondent would therefore have been fully aware of the Complainant's rights in the E-TYPE trade mark when registering the Domain Name.

The Domain Name is being used by the Respondent to direct consumers to a website which is not connected to the Complainant but which provides identical/similar goods and services to those for which the Complainant has registered trade mark protection. Such use is likely to confuse consumers into believing that the Domain Name is registered to, operated by, connected with, or authorised/endorsed by the Complainant. Such use also takes unfair advantage of the Complainant's rights in the trade marks as the same is being used to trade off the back of the reputation that the Complainant has built up in the E-TYPE mark, and exploiting the goodwill and prestige that the Complainant has spent time and effort in building up.

In addition, the use of the Complainant's trade mark in the Domain Name is misleading to the consumers who visit the website to which the Domain Name resolves as, upon seeing the Complainant's trade mark, the consumer associates the same as being a mark of quality and therefore, the Respondent's use of the Domain Name is to take advantage of this.

A speculative visitor to the Registrant's website will be visiting in the expectation that the website is operated or authorised by, or otherwise connected with the Complainant. This initial interest confusion is evidence of the Domain Name being an Abusive Registration.

In addition, as noted in the decision of the Appeal Panel in the case of Toshiba Corporation v Power Battery Inc., DRS 07991, the Appeal Panel, commenting on whether it would be fair if a Domain Name incorporating the Complainant's trade mark right, also sold competing goods, stated that:

"... if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name... that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do so otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated."

The Domain Name is currently in use by the Respondent to direct to a website which provides parts and services in respect of the MG 'T' Series vehicle and not just E-Type cars.

Remedy Requested

Transfer of the Domain Name to the Complainant.

Respondent

In Response, the Respondent makes the following observations and arguments.

The Respondent was established in 1986 as manufacturer of the Hutson TF1700 Sports car, supplier of MG 'T'- Series body shells and parts, and, from 1988, of Jaguar E-Type panels and parts.

When in 1989/90 [*sic*] websites came into vogue the Respondent checked if there were any trade marks for E-Type and there were not. As Jaguar had changed hands several times since first producing E-Type vehicles (spending many years in the British Leyland Group), it appeared to have neglected to register or maintain any related trade marks, and the Complainant itself didn't register E-Type as a trade mark until later, this being the basis of their retrospective Complaint.

The Complainant claims it has acquired extensive goodwill and substantial reputation throughout the UK, EU and World, and that E-TYPE is a very well known mark in these territories.

In fact the Complainant only became involved in the restoration and supply of classic E-Type parts since 2014, when they followed Mercedes, and then Aston Martin, into what had become a highly lucrative and prestigious field – catering for their long obsolete models, many of which had become valuable collectors' items.

To these ends, the Complainant made six 'New' £1 Million reproduction lightweight E-Types in 2015, and then announced the opening of a restoration department.

Since Jaguar's original production of the E-Type finished in 1974, the supply of panels and parts to restore and repair these vehicles has been undertaken by several specialist independent companies – of which the Respondent is one. For over thirty years the independent specialists have kept these cars on the road and supplied quality parts which have in many ways enhanced the original vehicles. In contrast, throughout the 80's, 90's and 00's Jaguar understandably concentrated on a) staying in business, and b) new models.

Since launching their restoration department, the Respondent has been made aware from other independents that the Complainant has employed legal representatives to 'Hoover Up' all competitors in this field, by sending out demands for domain names and company names to be handed over.

The Respondent itself received a demand letter dated 30.7.2015, which threatened dire legal consequences, should it not hand over our domain name E-Typecars.co.uk. The terms of acceptance were draconian and demanded signing within 21 days!

In the 25 years the Respondent has been using (originally Fasthosts) Nominet it has not had one complaint or claim from customers or competitors that the Domain Name deceived or misled them into believing the Respondent was in any way associated with the Complainant nor passing its products off as genuine Jaguar.

Indeed the majority of parts supplied by the Respondent were not, and still are not, available from the Complainant. It is quite wrong to say that the Respondent uses the Domain Name in an abusive way, as any 'reputation' and 'extensive goodwill' generated by the Domain Name and supply of E-Type parts has been created by those involved in this trade for the past thirty years – not the Complainant, whose input has been minimal since 2014 at best.

It is the Complainant who is seeking to take unfair advantage by 'Hoovering up' all E-Type related domains and businesses to divert decades of goodwill to the Complainant's newly established restoration department.

The Respondent has offered to display a disclaimer that it is in no way part of the Complainant, nor are its parts or services provided by Jaguar.

Most of the Respondent's new customers come via e-Bay advertisements and YouTube, as well as a few trade magazine adverts. The Respondent is unaware of anyone who has ever typed in the domain name E-Typecars.co.uk to find it. Typing in EType or E-Type into a search engine will bring up a host of companies dealing in Jaguar E-Type cars, parts and services. None of these need have E-Type in the composition of their domain name – search engines don't work in that way.

The Respondent's view is that, if you have just set up an E-Type Jaguar related restoration company – then the domain name E-Typecars.co.uk is a catchy one to have.

Complainant's Reply

In response to the Respondent's comments the Complainant replied that in relation to use of its trade marks

- a) it has never sought to prevent legitimate use of its trade marks for trade in its goods and/or in genuine goods related thereto and/or the provision of services related to their vehicles; and.
- b) it accepts that traders who deal in its goods or who offer servicing, maintenance or repair of vehicles that it manufactures, may refer to its trade marks in their business activities honestly and in good faith and for the purpose of specifically describing the goods and services on offer only.

However, the use of the E-TYPE mark within the Domain Name is not acceptable because, whether deliberately or not, it implies there is a connection between the parties. As put by the Respondent, the use of the Complainant's trade mark is for the reason that it is "a *catchy one to have*" and the Respondent is thereby benefiting from the reputation and goodwill established by the Complainant in the mark.

By using the Complainant's trade mark within the Domain Name, the Respondent gains an advantage over competitors, and takes unfair advantage of the Complainant's reputation and goodwill in its brand. Registration of a distinctive Domain Name using a registered trade mark can amount to an infringement, and also passing-off, as it makes a (mis)representation that the Respondent is connected to and/or associated with the trade mark owner. This erodes the goodwill in the mark and causes damage to the owner, even if the Respondent has not acted dishonestly.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both 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 as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant has asserted earlier registered trade mark rights, and common law rights, in the mark E-TYPE (and E TYPE). Copies of the current EUTM Register details were provided to validate the registered trade mark claims.

The disputed Domain Name comprises the identical mark "e-type" with the addition of the word "cars", together with the SLD domain suffix .co.uk. Clearly, ordinary English readers will read the domain name as "E-Type cars" – i.e. referring directly to the Complainant's familiar sports car models of that name. "E-Type" has clearly been incorporated in the Domain Name in the expectation that customers will make that association.

The Expert therefore finds that the Complainant does have Rights in respect of a name or mark, which is identical or similar to the Domain Name, and that the conditions of Paragraph 2a.i. of the Policy are met.

Abusive Registration

The Complainant also has to show that the disputed Domain Name is 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 a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant's submissions, the following ground is principally applicable in this case:

3a.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;

Paragraph 4 of the Policy additionally provides observations on "How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration", of which the following may be considered pertinent to the present Complaint:

4.a.i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:
A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
C. made legitimate non-commercial or fair use of the Domain Name;

The factors listed in Paragraphs 3 and 4 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In accordance with the Policy Paragraph 2b, it is for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

In summary, the Complainant's case is essentially that:

- a) it is the owner of the trade mark rights and goodwill in the E-TYPE mark for cars;
- b) its Rights predate the registration and use of the Domain Name by the Respondent;
- c) the Respondent's use of the Domain Name for a website is liable to mislead and confuse consumers, who would expect the Domain Name to be associated with the Complainant, and that the Respondent is taking unfair advantage of the Complainant's rights, particularly as the website does not relate solely to E-Type cars nor to genuine E-Type parts from the Complainant.

Against these claims, the Respondent asserts that;

- a) it has been an independent supplier of parts and panels for E-Type car restorations since 1988;
- b) since then, there has never been any customer complaint, or evidence, of alleged confusion before the Complainant raised the issue in 2015;
- c) the Complainant had effectively abandoned its trade mark rights in the 80's 90's and 00's, so any goodwill from use of the mark accrued to

- those independent suppliers, like the Respondent, who used the mark for their parts supply businesses;
- d) it is the Complainant who is seeking to take unfair advantage by “Hoovering up” E-Type related domain names from independents as a latecomer to the parts and restoration business itself.
 - e) the Domain Name, E-Typecars.co.uk, “*is a catchy one to have*” ...“if you have just set up an E-Type Jaguar related restoration company”.

Regardless of what may have happened with trade mark registrations in the intervening period from 1975 after Jaguar ceased its original production of the E-Type sports cars, the evidence is that the Complainant certainly has had relevant registered trade mark rights (under EUTM 1170216) since May 1999.

In its Response, the Respondent does not specify when it actually acquired the Domain Name, nor when it first began using the Domain Name for its website. However, with references in its Response to “When websites came into vogue in 1989/90...” and “In the 25 years [it] has been using ...Nominet” the Respondent appears to imply that it had operated the website prior to 1999. Nominet’s current WhoIs records in fact show the Domain Name was first registered in January 2000, but that it was apparently not actually transferred into the Respondent’s name until 2006. The screenshots of the Respondent’s website submitted in evidence by the Complainant all carry the footer “Copyright © 2007 Hutson Motor Company Limited”, which would be consistent with a 2006 acquisition of the Domain Name. Of course, it may be that another website was operated on behalf of the Respondent by a previous registrant prior to 2006, but no evidence of this has been provided.

In the absence of any evidence of registration or use of the Domain Name by the Respondent predating the Complainant’s earlier registered rights, the Expert therefore concludes that the Complainant has Rights which existed prior to the original registration of the Domain Name in 2000, and the apparently later date of actual transfer of the Domain Name to the Respondent, and the Respondent’s first use of the Domain Name for its website.

The Respondent’s arguments that the Complainant had abandoned its trade mark rights, and that any reputation and goodwill arising from use of the E-Type mark in relation to the Respondent’s business should be considered to have accrued to the Respondent are unconvincing, and irrelevant in these circumstances.

The evidence submitted in the Complaint to support the contention that E-TYPE is an instantly recognisable, well-known brand of car produced by Jaguar is perhaps somewhat thin, but the Expert doubts that there could be any serious argument to the contrary. Anyone with even a passing interest in classic sports cars may be expected to recognise an E-TYPE Jaguar. The Respondent’s website refers to the owner’s own collection having grown, and to its “exquisite restoration” services for E-TYPE cars. That cars originally produced from 1961-1974 still merit the expense of “exquisite restoration” in 2017 is clear evidence that the brand and its association with Jaguar (and therefore with the Complainant) endures.

That the Complainant is only lately taking action to enforce its rights in respect of domain names incorporating the E-TYPE mark, after so many years of apparent

indifference or neglect, as the Respondent has argued, raises the question of whether the delay (*laches* in legal terms) should exclude the Complainant from seeking remedy under the Policy.

This question has recently been addressed at some length in the Decision of the Appeal Panel of 7 December, 2016 in Jockey Club Racecourses Limited v. Moneta Communications Limited DRS 17490 (Cheltenham-festival.co.uk) with references to other earlier cases which also considered the issues. The Expert does not intend to extract large sections from that Decision, which is available for further reference if desired. The key points (as also originally expressed by the earlier Appeal Panel in Lucasfilm Ltd., LLC v. Abcissa.com Limited DRS 15788 (star-wars.co.uk)), of note, with Expert's emphasis added, are:

“...the Panel notes that the Policy itself says nothing about delay, nor does it contain any provisions requiring a Complaint to be brought within a specific time limit after the registration of a domain name.

...The circumstances in which delay and other related considerations may operate as a defence to litigation are considered further below. Overall, however, the Panel considers that, where the use complained of is ongoing, then delay alone should not automatically preclude a Complaint being brought.

It is nevertheless the case that the list of factors which may lead to a finding that a domain name is not an Abusive Registration, as set out in Paragraph 4 of the Policy, is said to be non-exhaustive. The Panel concludes that, in principle, depending upon the relevant facts, this means it is open to the Panel to reach a finding that, whilst delay does not automatically bar an action, delay in a specific case might be such as to mean that an otherwise Abusive Registration is acceptable. Whether in the particular circumstances of a given case that is the position would depend on the individual facts.”

In the present case, the Respondent's use is ongoing, and the delay may simply have been due to that use not appearing on the Complainant's radar before. The Expert takes the view that this is not a situation where the delay between registration and Complaint and the circumstances of use should deny the Complainant from seeking a remedy under the Policy.

The Domain Name comprises simply the E-TYPE mark together with the generic name of the products produced by, and associated exclusively with, Jaguar [the Complainant] – i.e. cars, followed by the CCTLD suffix .co.uk, indicative of a commercial business.

In the Expert's opinion, this makes a direct representation that the Domain Name relates exclusively to E-Type Cars, with the likely inference that it will lead to a Jaguar company site, or possibly to a dedicated history, or fan site. It does not. It leads to the Respondent's website,

which refers to the “Hutson TF, an updated version of the celebrated MG of the early 50’s” (with what appears to be a picture of an Austin Healey) and identifies the business as “MG “T” Series, Jaguar E-Type Parts & Panels Specialists”.

The “catchy” Domain Name, as the Respondent appropriately describes it, is effectively being used to hook online browsers and to draw them in to the Respondent’s website promoting its business beyond replacement E-Type parts and panels. The Expert believes that this is inherently misleading and inevitably likely to confuse. Although the Respondent denies any incidence of actual complaint or confusion, to quote again from the Appeal Decision in DRS 17490 (supra) *“The absence of evidence of confusion is just as likely to be attributable to the fact that the visitors in question may be indifferent or oblivious to the underlying misrepresentation, or unaware to whom they should report it.”*

Consequently, the Expert concludes that the Respondent’s registration and use of the Domain Name takes unfair advantage of the Complainant’s Rights, and is therefore an Abusive Registration for the purposes of the Policy.

Decision

Having found that the Complainant has relevant Rights and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert orders that the Domain Name be transferred to the Complainant.

Signed: Keith Gymer

Dated: 3 February, 2017