

## **DISPUTE RESOLUTION SERVICE**

**D00019191**

### **Decision of Independent Expert**

Jaguar Land Rover Limited

and

Mr Kevin Vanhoeck designxkr

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

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

Respondent: Mr Kevin Vanhoeck designxkr  
8 Towergate ind park  
Colebrook Way  
Andover  
Hampshire  
SP10 3BB  
United Kingdom

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

designevoque.co.uk  
designjaguar.co.uk  
designrangerover.co.uk  
designxkr.co.uk  
dxkr.co.uk

### **3. Procedural History:**

The Expert has confirmed (1) he is independent of each of the parties; and (2) to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need to be disclosed because they might be of such a nature as to call into question his independence in the eyes of one or both of the parties.

31 July 2017 14:51 Dispute received  
02 August 2017 12:32 Complaint validated  
02 August 2017 14:56 Notification of complaint sent to parties  
21 August 2017 02:30 Response reminder sent  
23 August 2017 16:21 Response received  
23 August 2017 16:21 Notification of response sent to parties  
29 August 2017 02:30 Reply reminder sent  
29 August 2017 15:53 Reply received  
29 August 2017 15:54 Notification of reply sent to parties  
12 September 2017 12:03 Mediator appointed  
13 September 2017 11:58 Mediation started  
23 November 2017 11:11 Mediation failed  
23 November 2017 11:21 Close of mediation documents sent  
27 November 2017 17:44 Expert decision payment received

### **4. Factual Background**

The Complainant is a manufacturer of premium saloon cars, sports cars, sports utility vehicles and all-wheel drive vehicles, based in the Midlands region of England, operating through a network of authorised dealers. It is a company incorporated in the United Kingdom, with a registered office in Coventry.

The Respondent is an individual who has provided an address in Andover, Hampshire, as the contact address for all of the domain names except [www.designxkr.co.uk](http://www.designxkr.co.uk), for which he claims to be a non-trading individual who has opted to have his address omitted from the WHOIS service.

The Domain Names were registered on the following dates:

- 1) [www.designxkr.co.uk](http://www.designxkr.co.uk) - 6 December 2005
- 2) [www.designjaguar.co.uk](http://www.designjaguar.co.uk) - 13 January 2010
- 3) [www.designevoque.co.uk](http://www.designevoque.co.uk) - 6 October 2011
- 4) [www.designrangerover.co.uk](http://www.designrangerover.co.uk) - 6 October 2011
- 5) [www.dxkr.co.uk](http://www.dxkr.co.uk) - 15 January 2014.

At the time of the Complaint it would appear that the Domain Names all pointed to active websites which used the brand name designXKR. As at 3 December 2017 when the Expert was appointed, only the designxkr.co.uk and dxkr.co.uk domains pointed to an active website.

## **5. Parties' Contentions**

### **The Complainant Rights**

The Complainant is globally renowned for its vehicles, and is the top automotive manufacturer in the United Kingdom, employing over 25,000 people in the UK. Its main brands are JAGUAR (a brand which dates back to 1935) and LAND ROVER (a brand which dates back to 1948). XKR is one of its historically well-known models for Jaguar vehicles. RANGE ROVER is one of the vehicles sold under the Land Rover range, and EVOQUE is a sub-brand to RANGE ROVER (the vehicles are sold under the RANGE ROVER EVOQUE brand).

The Complainant owns, inter alia:

- 1) EU Trade Mark no 8797425 EVOQUE in Class 12 filed on 7 January 2010;
- 2) UK Trade Mark no 920322 RANGE ROVER in Class 12 filed on 30 January 1968;
- 3) EU Trade Mark no 26625 JAGUAR in Classes 12, 36 and 37 filed on 1 April 1996;
- 4) EU Trade Mark no 1467653 XKR in Classes 12, 17 and 37 filed on 20 January 2000.

The Complainant also claims extensive goodwill and a substantial reputation in the UK and EU in the JAGUAR, EVOQUE, RANGE ROVER and XKR brands as a result of over 60 years' use of the LAND ROVER and JAGUAR brands.

The Complainant also owns a number of domain names relevant to the trade marks JAGUAR, EVOQUE, and RANGE ROVER.

The dominant element of all of the Domain Names is one of the Complainant's trade marks, with the remainder of the Domain Names being the non-distinctive word "design" or the letter "d" together with the suffix .co.uk. Therefore, the Domain Names are identical or closely similar to names/marks in which the Complainant has rights.

### **Abusive Registration**

The Domain Names were registered to the Respondent a significant number of years after the start of the Complainant's registered trade mark rights. Therefore, the Respondent would have been fully aware of those rights at the time he registered the Domain Names. The websites to which the Domain Names pointed at the time of the Complaint are commercial websites retailing a mixture of genuine and non-genuine parts for vehicles in the Complainant's vehicle range. The websites offer vehicle servicing, and advertise customised vehicle parts. In the case of dxkr.co.uk it points to the same website as designxkr.co.uk. The non-genuine parts are third party goods originating from Arden, a manufacturer of accessories to customise vehicles and provider of customisation services. It is not affiliated to the Complainant.

The websites at [www.designevoque.co.uk](http://www.designevoque.co.uk) and [www.designrangerover.co.uk](http://www.designrangerover.co.uk) promote Arden's service and products and display the Arden shield trade mark prominently. They also retail mainly Arden-manufactured products.

The Complainant relies upon Paragraph 3(a)(ii) of the DRS Policy (presumably, paragraph 5.1.2 of the DRS Policy now in operation). It says that the use of the Domain Names containing the Complainant's trade marks suggests that the products and services offered are provided by or endorsed by the Complainant. The addition of the word "design" or the letter "d" does nothing to dispel that connection. Also, by using the Domain Names to promote the goods or services of a third party, Arden, the Respondent takes unfair advantage of the Complainant's trade mark rights, suggesting that those are authorised by or endorsed by the Complainant, which is not the case. Therefore, the use is misleading to consumers resulting in confusion, or at least initial interest confusion. There is no need for the Respondent to use the Domain Names to host his websites, when he could easily trade under a distinct separate brand, as many of the Complainant's authorised dealers do.

The Complainant seeks transfer of the Domain Names to itself.

### **The Respondent Rights**

The Respondent does not appear to contest the Complainant's Rights, except to say that designxkr is a descriptive identifier.

### **Abusive Registration**

In relation to the designxkr.co.uk and dxkr.co.uk Domain Names, the Respondent says that his business "designxkr" started trading in 2005, and designxkr Limited is registered at Companies House. The websites make clear that the business is a "Leading Jaguar Independent Specialist" providing services to owners of the Complainant's vehicles from a "simple service to a complete engine rebuild or a car rebuild". It uses genuine parts purchased from a local Jaguar dealer.

It also offers "upgrades" with options of body kits, in-car entertainment systems and Satellite Navigation ("SatNav") systems not available from the Complainant. The Respondent is the UK partner of Arden GmbH, which is a German company manufacturing body kits and upgrades for the whole Jaguar range of vehicles. Those are listed on the websites as options for customers to upgrade. The Respondent is not seeking to trade off the goodwill and reputation of the Complainant, and in fact customers use businesses such as his because they are not affiliated with the Complainant. The use of the Arden GmbH logo and supply of their products through the websites does not in any way suggest that they are approved by the Complainant.

As to the remaining Domain Names, designjaguar.co.uk, designevoque.co.uk and designrangerover.co.uk, the Respondent says that those were added as the business expanded and offered services to owners of other vehicles in the Jaguar and Range Rover range. The use of "Jaguar" in the domain was a descriptive identifier making it easier for prospective customers to find a Jaguar and Range Rover independent.

The use of any of the Complainant's trade marks does not impact upon the Complainant's business.

The Respondent claims that some of the prints of the websites provided by the Complainant are misleading and out of date, some dating from 2010 or 2011. Although the Respondent says he will provide the updated front pages, he does not do so.

Other authorised dealers and independents use one of the Complainant's trade marks in their domain names, such as (for authorised dealers): stratstone.newcastle.jaguar.co.uk, harwoods.brighton.jaguar.co.uk, and marshall.oxford.jaguar.co.uk, and (for independents): jaguaredinburgh.co.uk, jaguarservicedarlington.co.uk, and jaguarrepairer.co.uk. The Respondent provides a list with some 30 independents' domain names and 20 authorised dealers' domain names each using the Complainants' trade marks (including also RANGE ROVER).

## Reply

The Complainant points out that when the Respondent started his business in 2005 that was a significant number of years after it had acquired rights in its brands other than EVOQUE, which had not then been released as a model.

Only one of the websites mentions that the Respondent is an independent trader ([www.designxkr.co.uk](http://www.designxkr.co.uk)). The fact that one website does so does not eradicate initial interest confusion for that particular website, as consumers will be attracted to the website in the first place, and may stay on it, taking business away from the Complainant even once they are aware that the Respondent is not affiliated with the Complainant. Nor does it help the Respondent in respect of the other websites which do not have that addition.

"designxkr" is not descriptive – it suggests the Respondent designs/designed the XKR vehicle, which he does/did not.

The registration of the company designxkr Limited post-dates the registration of 4 out of the 5 Domain Names, and is in any event not a defence to the Complaint.

The advertisement of supply of upgrades which have not come from the Complainant (including products originating from Arden) through websites hosted on domains containing the Complainant's trade marks is misleading, and trades off the Complainant's goodwill and reputation.

The website prints provided with the Complaint are all dated 31 July 2017, and therefore the Complainant does not accept that they are out of date.

Other third parties' use of the Complainant's trade marks in their domain names is irrelevant to these proceedings, and the Respondent is not aware of any correspondence the Complainant may have had with such third parties..

## 6. Discussions and Findings

In order to succeed in its Complaint, in accordance with the Policy, the Complainant needs to establish:

*"i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

*ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration."*

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is as follows:

***"Abusive Registration means 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”.*

The definition of Rights under 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.”**

### **Rights**

The Respondent does not contest the Complainant's enforceable rights in the trade marks XKR, EVOQUE, RANGE ROVER, and JAGUAR, all of which are registered trade marks which predate the registration of the respective Domain Name. The only question for the Expert is whether the addition of “d” or “design” to each in the respective Domain Names makes them no longer similar to those marks. Paragraph 2.3 of the Experts' Overview makes it clear that the wording of the DRS Policy is intended to introduce a relatively low first hurdle for a Complainant to get over, which includes demonstrating a bona fide basis for bringing the Complaint. Each of the Domain Names incorporates one of the Complainant's trade marks, without alteration. The addition of the letter “d” can hardly be said to make a significant difference, and in the Expert's view, the word “design” is not a distinctive one and merely a description of a service. It is in any event a descriptive term which most if not all consumers would regard as being one of the services which a manufacturer of motor vehicles would provide. Therefore, the Expert finds that the Complainant has Rights in the names or marks XKR, EVOQUE, RANGE ROVER, and JAGUAR which are similar to the Domain Names.

### **Abusive Registration**

Paragraph 5 of the Policy provides as follows, in relation to Abusive Registration:

*“A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:.....*

*5.1.2 Circumstances indicating that the Respondent is using or is 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 evidential basis for the Complainant relying upon this paragraph of the Policy is a little blurred. The Respondent says that the Complainant is relying upon out of date web pages, but does not provide evidence to back this up. On the face of it, the pages provided by the Complainant are all dated 31 July 2017 and appear to be prints of some pages from the sites on that date. It is unlikely that these have been fabricated in some way. The Expert is unable to test this himself - as at 3 December 2017, only the website associated with the dxkr.co.uk

and designxkr.co.uk Domain Names was operative. However, the Expert notes that the Respondent does not dispute what the Complainant says in substance about the other websites, and in particular that (1) they do not make clear that the business is independent of the Complainant (2) the websites offer a variety of services and upgrades associated with the Complainant's vehicles, and (3) Arden GmbH's logo is used, and products from that company are advertised.

There are two other elements of the websites which have not been mentioned by either party and which may be relevant. One is that at least some of the websites seem to have (or to have had) a disclaimer along the lines that "*desinJaguar (sic) has no affiliation with, and is no way or form associated with JaguarLandRover Ltd, and in no way or form intends to pass itself off as such. All trade marks belong to their respective owners*". This disclaimer typically seems to appear at the foot of the home page. The other is that the business is described as "*Part of the designAutoGroup*". It is not explained what that group involves, and the Expert suspects that it is not a separate corporate entity, but merely an intended reference to the group of websites operated by the Respondent. The Respondent refers in his Response to the registered company designxkr Limited, but that does not seem to feature on the websites in any way.

The Respondent says that "design" is a descriptive identifier, but in his explanation of the services which are offered he mentions servicing, engine rebuilds, car rebuilds, and upgrades consisting of body kits, in car entertainment systems and SatNav. One of the websites itself refers to the design of vehicle interiors, but this is not mentioned in the Response. It seems to the Expert that very little of the Respondent's business could properly be described as involving design, and none of it as designing the vehicle itself (as opposed to alterations and additions).

The previously decided cases concerning domain names incorporating trade marks with additions to describe what is being offered by way of genuine goods or services (reseller cases) include the Appeal Panel decisions of *Seiko-shop.co.uk*, DRS 00248, and *Toshiba-laptop-batteries.co.uk*, DRS 07991. As is explained in paragraph 4.8 of the Experts' Overview, it is possible that a registration may be abusive, even where there is no serious risk of any confusion, although each case has to be assessed on its own facts. It is not automatically unfair to incorporate a trade mark in a domain name, although it will be unfair if there is a false suggestion of a commercial connection (which may be as a result of initial interest confusion). Also, one of the possible reasons for a finding of unfairness is if the website offers competitive goods (as was the case with *Toshiba-laptop-batteries.co.uk*, DRS 07991). More recently, the decided cases have also been reviewed in the Appeal Panel decision of DRS 00016416, *wweshop.co.uk* in the light of recent Court cases (notably before the ECJ). In that case, the Appeal Panel considered how an Expert should approach a dispute concerning a website which sells only the genuine goods or services of a third party with relevant Rights in respect of a name or trade mark. The guidance provided by the Panel included the following:

*".....5. Use of the name or trade mark concerned in unadorned form as a domain name is likely to amount to an Abusive Registration.*

*6. Use of the name or trade mark concerned is also likely to amount to an Abusive Registration if the name or trade mark is combined with a term or terms that results in a domain name which would readily be considered to be that of the owner of the name or trade mark concerned.*

*7. Such use is less likely to amount to an Abusive Registration if the name or trade mark concerned is combined with a term or terms that results in a domain name which would not readily be considered to be that of the owner of the name or trade mark concerned."*

The guidance was expressed in terms of not setting out "absolute rules", and all relevant circumstances need to be taken into account in each case, including (inter alia) the nature, appearance and content of the website in question, and the use of disclaimers. The Panel also noted that one of the factors which might be determinative was the offer of competing or counterfeit goods. In that case (as with *Seiko-shop.co.uk*, DRS 00248), the addition of "shop" to the trade mark of the Complainant did not take the domain name the right side of the line, and the registration was found to be abusive.

The Appeal Panel's decision in DRS 00016416, *wwe-shop.co.uk* was itself considered in August 2017 by the Appeal Panel in DRS 00018271, *essexjaguarspares.co.uk*. The case involved the same Complainant as this dispute, although was not referred to by the Complainant's representatives in their submissions (the Complaint in this case preceded the Appeal Panel's decision). The Panel suggested that words such as "dealer" or "distributor" or "official" or "servicecentre" or "approved" in combination with a trade mark, in the context of the sale of parts for motor cars and the servicing of motor cars, are all likely to suggest an economic connection of some form with the trade mark owner. On the other hand, words such as "specialist" or "unofficial" appeared far less likely to suggest that type of connection. The word "spares" to the Panel seemed to be borderline, but when combined with a further modifying geographical term, that seemed to the Panel to fall the right side of the line. It did not feel that the domain name would "readily" be taken to be that of the trade mark owner, and the registration was found not to be abusive. A disclaimer on the website was felt not to be a material factor in its reaching its decision as it would only be seen by someone scrolling down the landing page, and could be removed in the future. It is, however, worth noting (as the Appeal Panel did) that the conclusion in that Appeal was against the background of 11 previous DRS decisions involving the same Complainant which were decided in its favour (including one against the same respondent, where one of the domain names concerned was *essexjagspares.co.uk*). It may also be worth noting that the Panel did not have before it admissible evidence as to how the Complainant controlled use of its trade marks in domain names by its authorised resellers (a submission from the Complainant that it did not allow them to be used was inadmissible as "new" evidence submitted during the appeal process, and would also appear to be possibly incorrect in view of the evidence submitted by the Respondent in this case as to third party use, which the Complainant has not directly disputed).

In the light of these recent Appeal Panel decisions, the Expert in this case proposes to adopt the approach of looking first at the Domain Names themselves, and then at all relevant circumstances, against the background of the guidance given. In this case, as has already been noted above, rather than being distinctive of the Respondent and his business, in the Expert's opinion the addition of "design" to the Domain Names suggests something which the Respondent does not do (in terms of designing cars), or at best seems to be only a small part of his offering (in terms of alterations/upgrades). It is, however, something which the Complainant will and does do. This suggests to the Expert that the starting point is that the Domain Names may be the wrong side of the line, without taking into account all other relevant factors. It seems at least likely that there will be initial interest confusion resulting from the Domain Names themselves insofar as those consist solely of the use of "design"



with one of the Complainant's trade marks. The addition of "d" to the dxkr.co.uk Domain Name is unlikely to mean much if anything to a consumer (certainly not that it stands for "design"), and, in the Expert's opinion, is likely to be disregarded, again suggesting initial interest confusion would be likely.

Turning to other relevant factors, do the websites offer a "genuine" service? On the one hand, they do seem to be solely concerned with services aimed at owners of the Complainant's vehicles (there is no suggestion that the services are aimed at owners of other marques). However, it does not seem to be disputed that the websites have all offered Arden products alongside possible supply of genuine parts sourced from an authorised dealer of the Complainant. This is likely at least to be potentially confusing to a customer, who may feel that the Arden products are authorised, approved by or otherwise connected with the Complainant in the absence of a clear statement to the contrary. The Expert agrees that this is likely to take unfair advantage of the Complainant's trade mark rights. It is true that there is or has been a disclaimer of sorts on the websites, and one of the websites states that the Respondent is an independent trader. However, those statements are not going to stop initial interest confusion arising from the Domain Names themselves – as the Complainant points out, at least some consumers looking for the Complainant or those commercially connected with it will be induced by the use of the Complainant's trade marks to look at the site, and then remain on it, having found it. The statement about independence from the Complainant only appears on one of sites. The trade mark disclaimer seems not to be consistently used, and then only at the foot of the home page where it appears. The sites themselves also could be much clearer as to the identity of the entity or person behind them – for instance, who is the designAutoGroup? The uncertainty as to the identity of the trader does not help to distance the websites from the Complainant. The Complainant does not provide evidence of actual confusion, although at least one of the Domain Names has been registered for 12 years. However, it is not necessary for a Complainant to provide evidence of actual confusion if it can show that confusion is likely (including initial interest confusion). As to the third party use of the Complainant's trade marks in domain names which the Respondent references, on balance the Expert agrees that it is not particularly relevant to this individual case. It would, however, have been helpful to have a proper explanation from the Complainant in its Reply as to why there is apparently such extensive third party use, rather than the "sidestep" it provided.

In summary, on balance the Expert does not feel that there is sufficient assistance for the Respondent from all the other relevant circumstances to alter the Expert's initial conclusion that the Domain Names are the wrong side of the line. Therefore, on the balance of probabilities, the Expert finds that the Complaint succeeds.

## **7. Decision**

The Expert finds that the Complainant has Rights in the names or marks XKR, EVOQUE, RANGE ROVER, and JAGUAR, which are similar to the Domain Names, and that the Domain Names in the hands of the Respondent are Abusive Registrations. The Expert therefore directs that the Domain Names be transferred to the Complainant.

**Signed: Bob Elliott**

**Dated 10 December 2017**