

# **DISPUTE RESOLUTION SERVICE**

D00019329

## **Decision of Independent Expert**

Jaguar Land Rover Limited

and

Helena

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

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

Respondent: Helena  
Vesey House  
Wylde Green Road  
Sutton Coldfield  
West Midlands  
B76 1QT  
United Kingdom

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

jaguarracingworld.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 in to question my independence in the eyes of one or both of the parties.

15 September 2017 10:04 Dispute received  
18 September 2017 13:50 Complaint validated  
18 September 2017 14:14 Notification of complaint sent to parties  
18 September 2017 16:27 Response received  
18 September 2017 16:27 Notification of response sent to parties  
21 September 2017 02:30 Reply reminder sent  
21 September 2017 08:57 Reply received  
26 September 2017 08:51 Notification of reply sent to parties  
26 September 2017 11:54 Mediator appointed  
02 October 2017 14:17 Mediation started  
20 October 2017 12:05 Mediation failed  
20 October 2017 12:06 Close of mediation documents sent  
26 October 2017 13:15 Expert decision payment received

### **4. Factual Background**

- 4.1** The Complainant is Jaguar Land Rover Limited. It is a well-known manufacturer of cars and operates through a network of authorised dealers who sell its new and approved used cars and provide a range of services related to those cars, including financial, insurance, repair and maintenance services.
- 4.2** One of the Complainant's main brands is Jaguar. The first Jaguar vehicle was launched in 1935 and Jaguar motor cars continue to be sold today.
- 4.3** The Complainant is the registered proprietor of a number of registered trade marks. These include trade marks for the word JAGUAR and for the words JAGUAR RACING. The Complainant's trade mark rights in the word JAGUAR date back as far as 1943 and its trade mark rights in the words JAGUAR RACING date back to January 2001.
- 4.4** In addition to its business of selling cars and related services, the Complainant has a long history of racing Jaguar motorcars. This dates back to its first race at Silverstone in the late 1940s and includes a number of appearances at Les Mans, a Formula 1 Team under the name JAGUAR RACING.
- 4.5** The Complainant also owns a number of domain names which include the JAGUAR mark. These include jaguar.co.uk, jaguarcars.co.uk, jaguarracing.com and heritagejaguarracing.co.uk.
- 4.6** The Registrant of the Domain Name is listed as simply "Helena" although the Response has been filed by an individual called Dave Long.

- 4.7 The Domain Name was registered by the Respondent on 24 July 2012 and has historically been used to link to a website which provides information about the Complainant's business and which links to a number of other websites which relate to motor vehicles.
- 4.8 The Domain Name is currently linked to a website which relates to the jungle animal, the Jaguar, and specifically discusses how fast the Jaguar is and what other animals it could beat in a race.
- 4.9 The Respondent is the owner of some 500 plus other domain names. These include the domain names fordracingworld.co.uk, citreonracingworld.co.uk, audiracingworld.co.uk, hondaracingworld.co.uk and bmwracingworld.co.uk.

## 5. Parties' Contentions

### The Complaint

#### Rights

- 5.1 The Complainant contends that it has rights in a name or mark which is similar or identical to the Domain Name for the following reasons:
- The Complainant is the owner of a number of registered trade marks for the marks JAGUAR and JAGUAR RACING. The Complainant's registration for JAGUAR dates back to October 1943 and its registration for JAGUAR RACING dates back to January 2001.
  - In addition to its registered rights, the Complainant and common law rights in the words JAGUAR and JAGUAR RACING which it has built up through its activities within the automobile production and automobile racing industries over the last 90 years.
  - The Domain Name consists of the term Jaguar in combination with the term "RACING" and the non-distinct term "WORLD" as well as the domain suffix ".co.uk". The combination of "JAGUAR" and "RACING" is identical to the Complainant's registered trade mark for JAGUAR RACING and the addition of the term "WORLD" does nothing to distinguish the Domain Name from the names in which the Complainant has rights.
  - The inclusion of the word "RACING" in the domain name does not differentiate the Domain Name from the Complainant's JAGUAR brand as the word RACING is purely descriptive of racing goods and services and positioning the word RACING after the word JAGUAR enhances the level of implied association with the Complainant.

#### Abusive Registration

- 5.2 The Complainant contends that the Domain Names are Abusive Registrations for the following main reasons:
- The Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or business into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the

Complainant (Nominet's Dispute Resolution Policy ("the Policy") (Paragraph 5.1.2)).

- The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well-known names or trade marks in which the Respondent has no apparent rights and the Domain Name is part of that pattern (Policy Paragraph 5.1.3).

#### Confusion (Policy 5.1.2)

**5.3** The Respondent is using [or has used] the Domain Name to host a website which:

- (a) provides information on the Complainant's business;
- (b) advertises third party websites which retail parts for the Complainant's Jaguar vehicles as well as parts for other vehicles manufactured by companies unrelated to the Complainant;
- (c) promotes the sale of second-hand parts for Jaguar branded vehicles from third parties who are unconnected to the Complainant;
- (d) provides links to websites hosted by third parties which provide information on the Complainant's vehicles and retail vehicles which are unconnected to the Complainant.

**5.4** The use of the Domain Name which is so closely similar to a name in which the Complainant has rights, to host a website which provides links, advertises and promotes services of third parties unconnected to the Complainant, takes unfair advantage of the Complainant's Rights in the trade marks JAGUAR and JAGUAR RACING and suggests to consumers that the Domain Name and the websites linked to the Domain Name are authorised or endorsed by the Complainant. This is not the case.

#### Pattern of Registrations (Policy Paragraph 5.1.3)

**5.5** The Respondent has registered a number of domain names which incorporate well-known trade marks relating to the automotive industry for which the Respondent has no apparent rights. These include the Domain Names:

- Fordracingworld.co.uk
- Citreonracingworld.co.uk
- Audiracingworld.co.uk
- Hondaracingworld.co.uk, and
- Bmwracingworld.co.uk

**5.6** All of these domain names follow the same format as the Domain Name, i.e. xxxracingworld.co.uk where xxx is a well-known make of car and were all registered on the same date, i.e. 24 July 2012.

## **Response**

In Response, the Respondent submits as follows:

- 5.7 The Respondent owns some 500 plus domain names and his/her business revolves around the sale of cars.
- 5.8 The Respondent owns several sites which operate in exactly the same way as Auto Trader.
- 5.9 The Domain Name was registered over five years ago and the site has not changed for some four years.
- 5.10 The Respondent owns two classic Jaguar XKs and is a member of two Jaguar owners' clubs.
- 5.11 The Respondent is not trying to be Jaguar nor is it trying to divert trade away from Jaguar;
- 5.12 If the Complainant would like to purchase the Domain Name, then the Respondent would gladly talk to them.

## **Reply**

In reply to the response, the Complainant submits as follows:

- 5.13 It is irrelevant that the Respondent has a business which revolves around the sale of cars, owns over 500 domain names and has several sites operating the same way as Auto Trader. What is relevant is how the Domain Name in question is being used.
- 5.14 The fact that the Domain Name was registered over five years ago, the website has been the same for four years, the fact of the Respondent owning classic Jaguar motor vehicles and/or being a member of two Jaguar owners' clubs is also irrelevant.
- 5.15 The fact that the Respondent did not purchase the Domain Name with a view to trick or deceive anyone does not mean that the Domain Name was not registered to ride on the coat-tails of the reputation and goodwill that the Complainant has built up in the Jaguar brand. Further, confusion may arise regardless of the Respondent's intention.
- 5.16 It is irrelevant that the Domain Name was registered five years ago. This does not bar the Complainant from bringing a complaint and in any event the Complainant's rights date back much further than five years and pre-date the registration of the Domain Name.

## **6. Discussions and Findings**

- 6.1 Paragraph 2.1 of the Policy requires that the Complainant must prove, on the balance of probabilities, that:

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

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

### **Rights**

6.2 As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6.3 The definition of Rights in the Policy is as follows:

*Rights means rights enforceable by the Complainant, whether under English law or otherwise, that may include rights in descriptive terms which have acquired a secondary meaning.*

6.4 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.5 The Complainant clearly has Rights in the words or marks JAGUAR and JAGUAR RACING. Not only is the Complainant the registered proprietor of trade marks for both JAGUAR and JAGUAR RACING, it is also clear that the Complainant has used the mark JAGUAR since 1935 in relation to its very well-known motor cars.

6.6 The names or marks in which the Complainant has rights, i.e. JAGUAR and JAGUAR RACING, differ only from the Domain Name by the absence of RACING WORLD (in the case of JAGUAR) and WORLD (in the case of JAGUAR RACING) and by the addition of the first and second level suffix .co.uk in the Domain Name.

6.7 I do not think that the addition of either RACING WORLD or WORLD does anything to distinguish the Domain Name from the mark or marks in which the Complainant has Rights. It seems to me that the dominant part of the Domain Name in a trade mark or distinctive sense is very clearly the word JAGUAR and both RACING and WORLD are merely descriptive in this context. Alternatively, in the case of the Complainant's Rights JAGUAR WORLD the addition of the word WORLD is merely descriptive. Either way I conclude that the Complainant has Rights in a name or mark which is similar to the Domain Name.

### **Abusive Registration**

6.8 Abusive Registration is defined in Paragraph 1 of the Policy 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. 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.*

- 6.9** This definition requires me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that has been made of it.
- 6.10** Paragraph 5 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is an Abusive Registration and Paragraph 8 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.
- 6.11** The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.
- 6.12** In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's rights. In some cases where the name in which the Complainant Rights are particularly well-known, it should be fairly obvious and straightforward, while in other cases where the name in which the Complainant has Rights is less well-known and/or where there are other meanings or uses which can be made of the name, this will require substantial evidence from the Complainant.
- 6.13** In this case the Respondent is using the name or mark in which the Complainant has Rights, i.e. either JAGUAR or JAGUAR RACING. It is doing so together with the modifying term Racing World or World. There is no dispute that the Respondent has adopted the Domain Name in full knowledge of the Complainant and, indeed, he has done so in order to refer to the Complainant. The real question therefore is whether the Respondent's adoption and subsequent use of the Domain Name amounts to taking unfair advantage of or being unfairly detrimental to the Complainant's Rights.
- 6.14** The general rule that has been applied under Nominet's DRS is that where the respondent uses the name or mark of another without any adornment that will usually amount to an Abusive Registration. This was set out in the Appeal decision in GuideStar UK v Wilmington Business Information Limited (DRS 02193) in which the Panel stated:

*“Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is”.*

This rule has come about largely because where the respondent is making such unadorned use of the name or mark in which the complainant has Rights it will usually follow that there will be confusion or a likelihood of confusion.

**6.15** However, where the respondent uses the complainant's name or trade mark with some addition or adornment, the position is not quite as straightforward. This kind of situation has been explored under Nominet's DRS a number of times most commonly in relation to cases where the respondent is re-selling the complainant's goods. One such case was considered by the Appeal Panel in *Toshiba Corporation v Power Battery Inc. (DRS 07991)* which involved the use of the domain name *toshiba-laptop-battery.co.uk* to resell, amongst other things, batteries for Toshiba laptops. In the *toshiba-laptop-battery.co.uk* case the Appeal Panel identified four criteria as being relevant to the determination of whether a domain name incorporating a complainant's trade mark/name is an Abusive Registration. These were as follows:

- (i) It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
- (ii) A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
- (iii) Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.
- (iv) Whether or not a commercial connection is implied, there may be other reasons why the re-seller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.

**6.16** On the issue of whether or not it would be fair for a respondent to offer competing goods, the Panel in the *toshiba-laptop-battery* case said as follows:

*"The further issue, however, is whether the fact of the offering of competitive products on the Respondent's website is sufficient to render the registration abusive, even in the absence of "initial interest confusion". On this question, the Panel unanimously considers that, if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner's consent, to accord with the principles stated above, that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do otherwise is likely to take unfair 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".*

**6.17** In the present case, the website which has previously been linked to the Domain Name is not a classic re-seller's website but contained a history of the Complainant. However, it did contain a number of links to websites which I would classify as re-sellers' websites in the sense that that these websites are offering a range of goods and services related to Jaguar motor cars and in some cases to other non-Jaguar motor cars. Many of these sites are not connected to the Complainant.

**6.18** I think it is fairly clear that the website to which the Domain Name is linked has been set up to look like it is run by the Complainant or at least is endorsed by it. The Domain Name is very close to the names in which the Complainant has rights i.e. JAGUAR and JAGUAR RACING and differs from these names only by the addition of one (or two) words i.e. WORLD (or RACING WORLD) which are the kind of



words that the Complainant may well adopt itself to describe itself. Also as far as I can see from the screenshots that the Complainant has provided the Respondent has made no attempt on the website itself to make it clear that it is not the Complainant or connected to it in anyway.

**6.19** It follows that members of the public will inevitably believe that the website linked to the Domain Name is connected to the Complainant in some way and are likely to follow the links on this site believing that they are in some way endorsed or approved by the Complainant. In other words, the Domain Name is (or has) been used 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, as set out in Paragraph 5.1.2 of the Policy.

**6.20** My conclusion therefore is that the Domain Name is an Abusive Registration as it clearly seeks to take unfair advantage of the Complainant's rights.

**6.21** I would 2 additional points;

- (a) Firstly, between the Complaint being filed and me writing this Decision the nature of the website linked to the Domain Name has been changed from the website describing the Complainant's business and linking to third party car related sites to a website which describes the speed of jaguar cats and speculates about what other animals they could beat in a race. I do not know precisely why this has been done but I would speculate that it has been done in an attempt to defeat this Complaint. This change of use is however irrelevant for the purposes of my decision and as the definition of Abusive Registration in the Policy makes clear I only need to be satisfied that the Respondent's use has been abusive in the past to make the finding which I have; and
- (b) Secondly, having found that the Complainant has made out its case under Paragraph 5.1.2 of the Policy (i.e. confusion or likelihood of confusion) I have not gone on to consider the Complainant's submissions in relation to Paragraph 5.1.3 of the Policy (i.e. pattern of registrations) as I do not need to do so to decide this Complaint.

## **7. Decision**

I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. I also find that, on the balance of probabilities, the Complainant has established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

**Signed ...Nick Phillips .....**

**Dated .....**