

DISPUTE RESOLUTION SERVICE

D00021844

Decision of Independent Expert

eBay Inc.

and

Mr Jamshad Ahmed

1. The Parties

Complainant: eBay Inc.

2145 Hamilton Avenue
San Jose
California
95125
United States

Respondent: Mr Jamshad Ahmed

Birmingham
United Kingdom

2. The Domain Name

ebaymotor.co.uk (“the Domain Name”)

3. Procedural History

Nominet checked that the complaint received on 11 September 2019 complied with its UK Dispute Resolution Service (“DRS”) Policy (“the Policy”), before notifying the Respondent and inviting a response. That response was received on 27 September. On 4 October, the Complainant replied to the response.

The offer of mediation did not help resolve the dispute and, on 24 October, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 5 November.

On 6 November I, Mark de Brunner, agreed to serve as an expert under the Policy. I 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 into question my independence in the eyes of one or both of the parties.

4. Factual Background

I have visited the web page to which the Domain Name resolves. From that limited research, the complaint, the response, the reply and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant has since 1995 run an online marketplace for the sale of goods and services. It has nearly 180 million active buyers in 190 million markets. Its main website at <ebay.com>, registered in 1995, is the 9th most visited in the United Kingdom and the 40th most visited in the world. It ranks 3rd for worldwide visitors in the “shopping” category as analysed by web information company Alexa. The Complainant’s website gets one billion page views a day. In 2018, the total value of goods sold through <ebay.com> was £75 billion. The same year, the EBAY trade mark ranked 38th in the Interbrand Best Global Brands index.

The Complainant’s online service includes a platform called “eBay Motors”, hosted at <ebay.com/motors>, for buying and selling vehicles as well as for servicing and upgrading them.

The Complainant’s trade mark registrations include :

- United Kingdom Trade Mark Registration No. UK00002185144, EBAY, registered on 8 December 2000
- European Union Trade Mark No. 001499599, EBAY, registered on 6 June 2001; and

- United States Trade Mark Registration No. 2218732, EBAY, registered on 19 January 1999.

The Respondent has a portfolio of domain names, some of which are made up of dictionary words, including <princeofsaudi Arabia.com>, <photodiagnose.com> and <gamblinghelpline.co.uk>. There is at least one domain name that includes a third-party trade mark: <sony tvchannel.com>. The domain names listed here all resolve to a parking page identical to that to which the Domain Name resolves.

The Domain Name was registered on 5 March 2019. It resolves to a parking page which indicates that the Domain Name itself is for sale:

"Domain 4 sale

This is a memorable, and brandable domain name You can use this domain to better position your company brand, use it for another service or product, or take it off the market for later use before someone else does."

5. Parties' Contentions

Complaint

The Complainant says it has rights in a trade mark that is similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an abusive registration.

On the question of rights, the Complainant says that the addition of the descriptive term "motor" does not stop the Domain Name being similar to the name in which it has rights. The Complainant refers to paragraph 2.3 of the DRS *Experts' Overview*:

"Additional elements rarely trouble experts. For example, in DRS 06973 veluxblind.co.uk the expert commented 'The Domain Name consists of the Complainant's distinctive trade mark and the descriptive word "blind", which does nothing to distinguish the Domain Name from the mark, since the mark is associated in the public mind with the Complainant's blinds.'"

The Complainant also draws my attention to the decision in relation to <ebayuniversity.co.uk> (DRS05366):

"The Expert is then left with a comparison between the mark EBAY and the third level part of the Domain Name 'ebayuniversity'. This amounts to the combination of the generic word 'university' with the Complainant's mark. In the Expert's view, the mark EBAY is the dominant and distinctive component of the Domain Name. The addition of the generic and purely descriptive word 'university' does nothing to distinguish the Domain Name from the

Complainant's EBAY mark. In these circumstances, the Expert finds that the mark EBAY is similar to the Domain Name."

On the character of the registration, the Complainant argues that this is abusive for the following reasons:

- (i) There are circumstances indicating that the Respondent registered the Domain Name primarily for the purposes of selling it to the Complainant, or one of its competitors, for valuable consideration in excess of his costs.
- (ii) The Respondent appears to maintain a portfolio of domain names for sale, at least one of which includes a third-party trade mark in which he appears to have no rights (<sonytvchannel.com>). The Complainant acknowledges that the registration of just two domain names incorporating third party trade marks may be insufficient to establish a "pattern" of abusive registrations within the meaning of the DRS Policy, but it asserts that the Respondent's conduct exhibits an apparent disregard for the trade mark rights of third parties.
- (iii) There is no evidence of the Respondent's using or making demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services.
- (iv) The Respondent does not have any rights in the term "ebay" or "ebay motor" and therefore cannot legitimately claim to be commonly known by the Domain Name.
- (v) The Respondent intends to profit from the re-sale of the Domain Name and, as such, is not making legitimate non-commercial or fair use of the Domain Name. The Complainant acknowledges that the Policy (paragraph 8.4) expressly recognises that trading in domain names for profit, or holding a large portfolio of domain names, is not of itself illegitimate. But it says that this part of the Policy cannot extend rights to a Respondent who has registered and put up for sale a domain name incorporating a third party trade mark, not least because that creates the impression that there is a connection between the Domain Name and the Complainant's business – and that impression is inaccurate.

Response

The Respondent's case is as follows.

- (i) He registered the Domain Name in good faith.
- (ii) If his registration of <ebaymotor.co.uk> were found to be abusive, it would mean that the Complainant could prevent corresponding registrations relating to all the other product categories in its online marketplace (eg ebaybeds, ebayclothes, ebayfood or ebaytoys).

- (iii) Litigation (not relating to the Domain Name) has involved the question whether the Complainant is responsible for infringement of third party trade mark rights by sellers using its online selling platform. The Complainant has argued that it is not responsible for such infringement. That argument is based on an effective separation between the Complainant and its immediate customers (those using its platforms to sell goods) which means it cannot reasonably argue here that it has a legitimate interest in the Respondent's activity in registering the Domain Name (or indeed any of the numerous corresponding domain names that could be registered, relating to all categories of goods sold through the Complainant's online platforms).

Reply

In reply, the Complainant does not address these points but notes that, while the Respondent appears willing to transfer the Domain Name, he has not done anything to make that happen.

6. Discussion and Findings

To succeed in this complaint, the Complainant must prove, 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.

As defined by the Policy, an abusive registration is a domain name which:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.

Rights

Given its long trading history and global trade mark registrations, the Complainant evidently has both unregistered and registered rights in the name "ebay". Ignoring the .co.uk suffix as merely a generic feature of the register, the Domain Name includes the name in which the Complainant has rights and adds the descriptive word "motor". I agree with the Complainant that the descriptive word "motor", does nothing to distinguish the Domain Name from the name "ebay". I conclude that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name.

Registration

The Policy includes non-exhaustive lists of factors that may be evidence that a domain name is or is not an abusive registration, and the complaint draws on several of those factors. But at its heart this seems to me a very straightforward case of potential and deliberately induced confusion. The Respondent has chosen a domain name the main part of which is a name in which the Complainant has rights but in which the Respondent himself appears to have no legitimate rights. As the *Overview* (paragraph 3.3) says:

“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose. In such cases, the speculative visitor to the registrant’s web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived.”

The *Overview* continues:

“Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix) ... The further away the domain name is from the Complainant’s name or mark, the less likely a finding of Abusive Registration. However,...generally condemned [are the activities of] those people who attach as appendages to the Complainant’s name or mark a word appropriate to the Complainant’s field of activity.”

That seems to me to cover the situation here precisely. The Respondent is offering the Domain Name for sale. It seems natural to infer that those likely to be interested in buying could include the Complainant or one of its competitors. At the very least this is a threat hanging over the Complainant, taking advantage of its rights in a way that can only be unfair. Arguably, in these circumstances, the putting up of a parking page at the Domain Name is “use” which is also unfair. In my view, both registration and use of the Domain Name took unfair advantage of the Complainant’s rights.

I accept the Complainant’s arguments in full. For completeness, I will review each of the points made by the Respondent in response:

- (i) The Respondent asserts that he has acted in good faith, but no claim of bad faith is being made here and. under the Policy, it is not necessary to prove bad faith in order to establish that a domain name is an abusive registration.
- (ii) Every case turns on its own facts, but the section of the *Overview* cited above makes clear that a domain name that contains only a name in which a complainant has rights, plus a simple description appropriate to a

field in which it operates, is indeed at risk of being regarded as an abusive registration.

(iii) As I understand the Respondent's argument, because the Complainant argues it is not responsible for trade mark infringements by its customers, it is unable to argue that its own rights have been infringed by its customers. That does not seem to me to follow. Whatever the underlying merits of its case, I can see no inconsistency in the Complainant's seeking to take the position that

- it is not responsible for trade mark infringements by its customers when they are using its platforms, but that
- it is entitled to defend its own rights against infringement.

7. Decision

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an abusive registration.

I therefore direct that the Domain Name be transferred to the Complainant.

Mark de Brunner

25 November 2019