



## **DISPUTE RESOLUTION SERVICE**

**D00022925**

### **Decision of Independent Expert**

Dr. Ing. h.c. F. Porsche Aktiengesellschaft

and

Drakesphere Ltd

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

Complainant: Dr. Ing. h.c. F. Porsche Aktiengesellschaft  
Porscheplatz 1  
Stuttgart  
70435  
Germany

Respondent: Drakesphere Ltd  
Block 2 Unit 4  
Shenstone Trading Estate, Bromsgrove Road  
Halesowen  
West Midlands  
B63 3XB  
United Kingdom

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

*porscheshop.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.

- 14 August 2020 - the Dispute was received.
- 17 August 2020 - the Complaint was validated.
- 17 August 2020 - the Notification of the Complaint was sent to the Parties.
  
- 04 September 2020 - the Response reminder was sent.
- 22/23 September 2020 - the Response was received.
- 23 September 2020 - the Notification of Response was sent to the Parties.
- 28 September 2020 - the Reply reminder was sent.
  
- 15 October 2020 - the Reply was received.
- 15 October 2020 - the Notification of Reply was sent to the Parties.
- 20 October 2020 - a Mediator was appointed.
- 21 October 2020 - Mediation started.
  
- 02 November 2020 - Mediation failed.
- 02 November 2020 - the close of Mediation documents were sent.
- 11 November 2020 - the Expert decision payment was received.
- 12 November 2020 - the Expert was appointed.
- 23 November 2020 - the Respondent provided a non-standard submission, accepted by the Expert.
  
- 7 December 2020 - the Complainant provided its Response to the Respondent's non-standard submission.
- 10 December 2020 - the Respondent provided its second non-standard submission, which was not accepted by the Expert.

### 4. Factual Background

- 4.1 The Complainant is a well-known German car manufacturer founded in 1931 that specialises in producing and selling high performance cars under its name "PORSCHE" (the 'Name'), along with the spares and components for those cars, and branded accessories (such as clothing). The Complainant enjoys a global reputation.
- 4.2 The Complainant is the registered proprietor of various registrations for the trade mark "PORSCHE" and variations thereof including logos and other elements (e.g. CARRERA,

BOXSTER) in the UK (e.g. 1308394) and EU (e.g. 11737368) (collectively the 'Marks') - covering a broad range of goods including cars, and car parts and accessories.

- 4.3 The Complainant holds the domain name registration for [www.porsche.com](http://www.porsche.com), registered in 1996.
- 4.4 The Respondent was incorporated in 1993 and provides various Porsche related aftermarket services, such as the sale of parts and components for Porsche cars and related accessories and gifts (e.g. cufflinks), alongside other branded goods such as clothing (e.g. Adidas, Mahle).
- 4.5 The Domain Name was registered by the Respondent on 15 December 1998.

## 5. Parties' Contentions

### The Complaint

The submissions received were extensive, in particular from the Respondent (including multiple witness statements and tables). The Expert has read these but, for the purposes of the Decision, has summarised the submissions only insofar as the Expert considers that they are relevant to the matters that he is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons set out below.

### The Complainant's Rights

- It has Rights in the Domain Name based on its Marks and the goodwill and reputation it holds in the Name, having traded since 1931.
- The Complainant has acquired goodwill and a reputation in the Name through its market share, advertising, promotion, intensity of use and the geographical extent and duration of use.

(In support of its goodwill and reputation, the Complainant provided a selection of website printouts and articles.)

- The Complainant's Name/Mark "PORSCHE" and the Domain Name are highly similar, differing only by the descriptive and non-distinctive suffix element "SHOP".
- The addition of the generic word "SHOP" to the Complainant's Name/Mark is merely descriptive of general premises (virtual or bricks and mortar) for selling

goods of the Complainant and does not distinguish the Domain Name from the Complainant's well-known Rights.

- Indeed, the distinctive component of the Domain Name is the Complainant's Name/Marks.

### **Abusive Registration**

- The Complainant stated that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting its business.
- The Domain Name, which consists of the Complainant's distinctive Name/Mark and the descriptive word "SHOP", is highly similar to the Complainant's *www.porsche.com* URL, and inclusion of the word "SHOP" does nothing to distinguish the Domain Name from the Name/Mark, since the Name/Mark are associated in the public mind with the Complainant.
- Potential and actual consumers would automatically assume that any goods and services bearing the Name/Mark being sold through the website linked to the Domain Name (the '**Website**') originate from the Complainant.
- Use by the Respondent of the Name/Mark on its Website, and inclusion of the Name/Mark in the Domain Name, constitutes a misrepresentation of the goods sold via the Website as being the Complainant's, with such misrepresentation resulting in damage to the reputation of the Complainant and loss of sales.
- Referencing Trustpilot reviews for the Respondent (example screenshots of which were provided), the Complainant submitted that the reviews show evidence of both damage to its reputation and actual consumer confusion with the Respondent - noting that *"74% of the reviews given are 'bad'"* and that the reviews mention that the Respondent sells *"cheap copies"* and had sent *"a cheap crappy aftermarket version from eBay"* of a product to one reviewer.
- Further, the positive Trustpilot reviews show evidence of consumer confusion, with consumers reviewing the PORSCHE goods themselves and not *"porscheshop.co.uk goods"*, citing as an example a review from a person stating how the Complainant's cars are the *"best sportscars in the business."*
- The Respondent sells a large number of products bearing the Name/Marks via the Website. These goods include car parts, such as wheels, locking nuts, wheel caps, bonnet badges, air valve caps, as well as general merchandise.
- There have been goods sold by the Respondent on the Website that bear the Name/Marks but are counterfeit products, including: valve caps; car stickers; a

watch; horn push buttons; cufflinks; and, wheel rims (from “*Veloce Wheels*” but which have the Complainant’s Marks/logo on them, and more general ones).

- The Respondent’s sale of counterfeit goods on the Website in this way shows that the Respondent has been “*morally reprehensible in its actions and has caused damage through trade mark infringement and sale of counterfeit goods*” and that it follows that the Domain Name is an Abusive Registration.
- The Complainant noted that there are numerous references on the Website to “*genuine*” Porsche products and that, generally, websites containing genuine products do not need to refer to the products as being “*genuine*”; such references infer that other products on the Website are not genuine and is an inference that would also be held by consumers.
- The counterfeit goods being sold by the Respondent on the Website support a finding of an Abusive Registration. The Complainant submitted that what is or is not fair can be considered not by the Respondent’s intent but “*wholly objectively and that to gain or cause damage by way of trade mark infringement is necessarily unfair irrespective of the motives of the Respondent.*”
- The Complainant then referenced, in particular, the following paragraphs in the Policy as support:
  - Paragraph 5.1.1.3, the Complainant submitted that the Respondent had registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant.

Use of the Domain Name to sell counterfeit goods is a clear attempt to divert sales from the Complainant to the Respondent by confusing consumers into thinking that the Website is connected to the Complainant’s *porsche.com* website and that it sells genuine products; which takes unfair advantage of the Complainant’s Rights and is also detrimental to the Complainant’s business by selling counterfeit goods under the Name/Marks.

- Paragraph 5.1.2, commonly, Internet users visit websites either through search engines or by guessing the relevant URL and it is highly probable that an Internet user looking for the Complainant’s website could incorrectly guess the Complainant’s website to be the “.*co.uk*” extension, which would lead to the Website and not the Complainant’s website.

In such cases, the speculative visitor will be visiting the incorrect webpage in the expectation that the Website is “*operated or authorised by, or otherwise connected with the Complainant*” and that any purchased goods will be genuine. This is termed ‘initial interest confusion’.

Further, and given the highly similar domain name addresses between the Respondent and the Complainant (*porscheshop.co.uk* and *porsche.com* respectively) and the use of the Name/Marks on the Website, it is extremely likely that Internet users would believe that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The use of the Domain Name by the Respondent implies a close relationship with the Complainant; that the user is going to a PORSCHE Shop site and consumers would infer that they would be able to purchase genuine goods from this website: to use the Website to sell counterfeit goods but represent them as the genuine goods of the Complainant cannot be said to be use "*in good faith and in accordance with honest business practices, to the benefit of the Complainant.*"

The fact that the Respondent is liable to make or be perceived as making a representation that there is something approved or official about the Website constitutes unfair advantage being taken of the Complainant and its business, and is an unfair detriment to the Complainant.

The present case is even more severe as the use of the Name/Marks on the counterfeit goods could reasonably mean that the consumer is continually deceived up to and after the point of purchase.

- Paragraph 5.1.6, the Domain Name "*is highly similar to the Mark*" in which the Complainant has Rights, the Mark is exclusively referable to the Complainant, and there is no obvious justification for the Respondent to have adopted that name other than to unfairly disrupt the business of the Complainant and confuse consumers into thinking the Respondent and the Complainant are the same or connected entities.
- The Complainant requests that the Domain Name is transferred to the Complainant.

### **The Respondent's Response**

5.2 In summary, the Respondent submitted that the Domain Name should not be transferred to the Complainant for the reasons set out below.

- The Complainant has been aware of the Respondent's use and registration of the Domain Name for over twenty years, supplying the Respondent with goods, fostering a relationship with the Respondent, and commending the Respondent for its business carried out via the Domain Name.

- The Complainant has written to the Respondent on various occasions - objecting to such things as the font used by the Respondent when referencing the Complainant's "PORSCHE" mark (in 2003), making infringement allegations in respect of the use of "PORSCHESHOP", alleging the sale of counterfeit products, and threatening Nominet DRS proceedings in respect of the Domain Name (in 2010, 2012, 2019, 2020), but has not followed up on any of them.

(The Respondent provided details of the solicitor correspondence that it received "*whilst building the Porscheshop business*".)

- Further, by not following up on this correspondence, "*[a]t law, there has been meaningful delay and reliance on this delay*" by the Respondent.
- In such circumstances, it is "*unconscionable for the Complainant to pursue DRS proceedings against the Respondent, having taken no action for so long while encouraging Respondent's business and allowing Respondent to act on that encouragement not only in collaboration with Complainant but also with Complainant's agents.*"
- The Complainant now "*seeks to forcefully misappropriate Respondent's Domain Name and, therefore, its business*", with this Complaint being "*a case of reverse domain name hijacking.*"
- The Respondent submitted that it hoped, noting the above, the unfairness of the 2019 and 2020 demands made by "*the Complainant is obvious, as is [the] longstanding good faith use of the PORSCHESHOP name not only with customers, but indeed with*" the Complainant.
- A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration includes that, before being aware of the Complainant's cause for complaint (not necessarily the Complaint itself), the Respondent has: "*used... the Domain Name... in connection with a genuine offering of goods or services; [or] been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name* (per paragraphs 8.1.1.1, 8.1.1.2 of the Policy).
- In reference to paragraphs 8.1.1.1 and 8.1.1.2 of the Policy, the Respondent submitted that it has an independent reputation under the name PORSCHESHOP as distinct from that of the Complainant's Name/Mark.

(The Respondent provided in support a timeline of events for the business under the "PORSCHESHOP" name, which included invitations from the Porsche Club of GB to attend their events (please see page 12 for a general description of the Porsche

Club of GB), details of awards won by the Respondent, and details of Porsche events that the Respondent sponsored.)

- The Respondent stated that the Complainant and the Porsche Club of GB had dealt with it by reference to the name “PORSCESHOP”, having “*at different times praised [the] business, and have encouraged [its] involvement in official Porsche activities and [the] business’ increasing involvement in the supply of parts and componentry sourced directly from [the Complainant].*”
- In this way, the Complainant and “*related entities Porsche GB and the official UK Porsche Club [Porsche Club of GB] have been aware of and in fact supportive of [its] activities as PORSCESHOP for some time*”, as seen by:
  - In 2001, the Respondent was certified by the Complainant as a “*Member of the Porsche Trade Parts Programme*”, giving it a special status amongst dealers of parts and preferred pricing arrangements for parts and components supplied by the Complainant.
  - In 2005, the Complainant contacted the Respondent to ask if it could train the Respondent’s staff to use the “*Lexcom Partslink24*” system to assist it with its stock management for parts and components.
  - in 2006, Porsche GB, the Complainant’s subsidiary in the UK, forwarded an intellectual property disclaimer for all known trading partners to include on their websites, to the Respondent - effectively demonstrating that the Complainant acknowledged that the Respondent dealt in authentic Porsche products that featured Porsche trade marks and IP and, therefore, that it should publish a trade mark notice on its site to inform its customers of this.
- It is disingenuous for the Complainant to allege that all products on the Website are counterfeit as the Respondent sells authentic products via the Website and has done so for over twenty years – with the majority of products being sourced from the Complainant and others sourced from reputable, recognised sellers and distributors.
- The Respondent has “*never knowingly sold counterfeit products.*” In relation to the goods identified by the Complainant as being counterfeit, the Respondent stated:
  - in relation to the valve caps, the Respondent noted that they were sourced from another supplier, and the Respondent “*had no reasonable expectation that the sourced products would not be licensed or authorised.*”
  - In relation to the car stickers, which had been seized by custom officials in Germany purportedly *en route* to the Respondent, the Respondent was



*“entirely unaware of the shipment, had not ordered the products and would not have sold them had they arrived.”*

- In relation to the watch, *“all watches featuring Porsche branding featured on the Website have been provided directly by the Complainant through its agents.”*
  - In relation to the horn push buttons, *“these were genuine Porsche items, sourced by the Respondent through its usual reliable channels.”*
  - In relation to the cufflinks, *“this item is genuine, product was sourced by the Respondent through its normal established channels.”*
  - In relation to the Veloce Wheels bearing the PORSCHE Name/Mark, the Respondent *“believes that Veloce use these images to help its customers distinguish between wheels that are adapted for different types of vehicles [and there] is no intention to mislead, deceive or provide counterfeit product.”*
  - Other wheels are *“all manufactured by the Complainant and sourced by the Respondent through its usual channels.”*
- The Respondent stated, through its controlling director, that while it appreciates *“that an issue has been raised in respect of the [...] valve caps otherwise, to our knowledge, there is absolutely no doubt in respect of any of the other products featured on our website.”*
  - While the Respondent has received negative feedback on Trustpilot, the negative feedback represents a *de minimis* proportion of the Respondent’s overall business.
  - There are also activities that, as a foreign corporate entity, the Complainant cannot undertake in the UK and therefore uses the Porsche Club of GB as its agent for these activities, and the Complainant’s World Wide Club Co-ordinator has been involved with or a contact point for a number of the Respondent’s activities working with Porsche Club of GB, including some of the events that the Respondent has sponsored.
  - The controlling director of the Respondent was made an honorary member of Porsche Club of GB in 2011, in part due to his involvement in the Porsche community in the UK, and his longstanding commitment to supporting and sponsoring Porsche Club of GB’s events (e.g. rally events, Isle of Man tours, etc).
  - Based on the above, the Respondent submitted that the Complainant, along with Porsche GB and Porsche Club of GB have all, at various times, acknowledged that its

business is commonly known by the name “PORSCESHOP” and it is legitimately connected with this name (since the late 1990s).

- Further, the Marks have been used and have always been used in connection with a genuine offering of goods and services, and the Respondent is unaware of any incidents of actual confusion between its business and the Complainant, with the Respondent having *“developed its own goodwill in the Domain Name ... customers – all of whom are discerning, discriminating purchasers as owners of high-performance and costly automobiles – understand that the Domain Name and its [W]ebsite are not owned by or affiliated with”* with the Complainant.
- The Respondent has always used the name “PORSCHE” to identify the nature, use and purpose of the (authentic, often Complainant-procured) goods sold on the Website.

### The Complainant’s Reply

5.3 In summary, the Complainant replied that:

- The Respondent’s submissions are so extensive that the Complainant does not propose to respond further to the individual points made.
- The statements provided by the Respondent attempt to convey a special or preferred dealer relationship between the Respondent and the Complainant, to justify its use of the Complainant’s Name/Marks; however, no such special relationship exists between the Parties and the Complainant has, at no time, accepted the Respondent’s use of the Domain Name, a fact supported by the previous correspondence between the parties and their representatives.

(The Complainant referenced various correspondence between it and the Respondent in support, including a 23 April 2012 email which noted specifically that the Domain Name and the business name “PORSCESHOP” are regarded by the Complainant *“as an official website of Porsche.”* The email requested the transfer of the Domain Name and a change of the “PORSCESHOP” business name.)

- The correspondence, when viewed in its entirety, leaves no doubt that the Complainant has consistently objected to the use of the Domain Name and it was the discovery of counterfeit goods on the Website that prompted the resumption of correspondence between the Parties and steps towards legal proceedings.
- It is impossible for consumers to determine whether goods offered for sale on the Website are genuine or counterfeit.

- The Respondent appears surprised that “only” seven items were alleged by the Complainant to be counterfeit but the sale of one counterfeit item bearing the Complainant’s Mark constitutes trade mark infringement and is sufficient for a finding of an Abusive Registration.
  - In relation to the valve caps, the Respondent does not dispute that the valve caps are counterfeit goods and contrary to the Respondent’s assertion, such goods were offered for sale on the Website for a year: the “Respondent’s untruth undermines his credibility.”
  - In relation to the car stickers, the Respondent claims they were unsolicited samples - however, noting that the seized shipment of car stickers contained 260 individual stickers intended for application on the back of vehicles, it is “implausible” that a prospective supplier would send 260 individual units as samples. The seized shipment contained numerous of the same items (e.g. at least five individual stickers bearing the Mark “911” and two each bearing the Marks “BOXSTER, MACAN and CAYMAN”), indicating that they are not samples but an order placed by and shipped to the Respondent.
  - In relation to the watch/clock, the Complainant clarified its reference, the reference being to a counterfeit speedometer wall clock which was on sale on the Website in 2017, with the image of the clock still appearing on the Website (although it is no longer possible to order the clock from the website). This example highlights that the Respondent's claims of only sourcing goods from reputable/authorised suppliers of Porsche branded goods are untrue.
  - In relation to the horn push buttons, the Complainant cannot verify that this is a genuine item, asks for the “usual reliable channels” the Respondent refers to be revealed, and noted that the price of the button is “suspiciously low.”
  - In relation to the cufflinks, the Complainant shared images of what the genuine Porsche cufflinks and their packaging look like.
  - In relation to the wheels, it is undisputed that the Respondent used the Complainant's Mark on *Veloce Wheels*, which were not manufactured by the Complainant or with its consent, and the Respondent offered those wheels for sale bearing the Complainant's Mark on the Website. Further, the Complainant noted that many wheels are offered for a fraction of the RRP and are offered in sets of four.

The Complainant noted that the Respondent also offers wheels described as “replica wheels for Porsche 911s” which, in its view, makes it clear that the Respondent's assertion that he sells only original products is untrue.

- The Respondent's position that it does not and has never knowingly sold unauthorised or unlicensed branded products *"is [therefore] nonsense"* and the *"evidence provided above and in the original Complaint demonstrates this."*
- The Respondent also offers goods bearing several other brands (e.g. Ferrari, Adidas, Mahle) via the Website. (The Expert searched on the Website and found, for example, clothing and footwear ranges for sale from Adidas.)
- The Complainant clarified the distinction between Porsche Cars Great Britain Ltd and Porsche Club of GB - which it stated are wholly separate entities. Porsche Club of GB is an association for Porsche enthusiasts set up by Porsche owners in the 1960s and, while supported by the Complainant, is not part of its distribution network.
- The Respondent is not unique in being part of the Porsche Trade Parts Programme or having access to 'Partslink 24'. These services are basically available to all traders purchasing goods from the Complainant (and other car manufactures), along with the requisite training to use them.
- Even if the registration of the Domain Name *"had been tolerated at an earlier point in time"*, any such tolerance was *"revoked by the Complainant's express objections, in particular the letters since 2010."*

#### The Respondent's Non-Standard Submission

- 5.4 The Respondent requested that the Expert consider a non-standard submission, providing in support its response to the Complainant's Reply and various witness statements. In its statement under paragraph 17 of the Policy, requesting the acceptance by the Expert of that submission, the Respondent stated that it wanted to submit as part of this process *"compelling evidence to dispel most if not all of Complainant's allegations as to its business, good faith and reputation"* which is essential to *"the fair consideration of the matter and therefore, in the interests of justice, should be admitted into the proceedings."*

On that basis, the Expert allowed the non-standard response to be submitted. However, in the Expert's view, the points raised in the non-standard submission, which was extensive and included accompanying witness statements, were in the main repeating points already made by the Respondent. The main basis of the points raised related to the issue of whether or not the Respondent was selling counterfeit goods via the Website, its reputation in the name 'PORSCESHOP' and the unfairness that it submitted will be caused by the transfer of the Domain Name.

### The Complainant's Response to the Non-Standard Submission

- 5.5 In summary, the Complainant provided a short response, questioning the relevance of the witness statements provided and restating its position.

### The Respondent's Second Non-Standard Submission

- 5.6 The Respondent also requested that the Expert allow a second non-standard submission to be submitted but this request was turned down.

## **6. Discussions and Findings**

### **General**

- 6.1 To succeed in the Complaint, the Complainant has to prove that, pursuant to paragraph 2 of the Policy, on the balance of probabilities:

2.1.1. *[It] has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

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

- 6.2 Addressing each of these limbs in turn:

#### **2.1.1 Rights in respect of a name or mark which is identical or similar to the Domain Name**

- 6.3 The Expert considers that, for the reasons below, the requirement set out in paragraph 2.1.1 of the Policy is met.

- 6.4 Paragraph 1 of the Policy defines 'Rights' as:

*[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;*

- 6.5 Given the Complainant's Marks, and noting the evidence presented as to the Complainant's goodwill and reputation in the Name/Marks, the Expert considers that, at the time of the Complaint, the Complainant had Rights in respect of the well-known Name/Marks which are similar to the Domain Name "PORSCHESHOP".

- 6.6 In concluding the above, the Expert has disregarded the Domain Name suffix "co.uk."

### **2.1.2 Abusive Registration**

- 6.7 For the reasons set out below, the Expert considers that the requirement set out in paragraph 2.1.2 of the Policy is met.
- 6.8 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. 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 In relation to the definition of Abusive Registration in sub paragraph (i), the Policy, at paragraph 5, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration.
- 6.10 Specifically, the Expert considers that the factor set out at paragraph 5.1.1.3 of the Policy, as referenced by the Complainant (*registered primarily for the purpose of unfairly disrupting the business of the Complainant*), is relevant.
- 6.11 Noting in particular the Complainant's evidence as to the length of its service provision and its goodwill and reputation, and the Respondent's business model (sourcing and selling the Complainant's aftermarket products), the Respondent would have been very aware of the Complainant, its brand, and the goods and services it provides, prior to registering the Domain Name.
- 6.12 While the Respondent would likely have had other reasons for acquiring the Domain Name, such as to set up business as a dealer in car parts, the Expert considers that the primary reason for the Respondent to choose to register the Domain Name was to attract customers searching for the Complainant itself (or an authorised dealer) to the Website and, thus, unfairly disrupt the Complainant's business.
- 6.13 Indeed, on the balance of probabilities, the Expert is completely satisfied that the Respondent specifically chose to register the Domain Name at that time with the intention of benefitting from the Complainant's Name/Marks and general goodwill and reputation in order to sell the aftermarket products to those who have bought the Complainant's cars.
- 6.14 For the reasons set out above, the Expert considers that the registration of the Domain Names took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

- 6.15 So far as the definition of Abusive Registration in sub paragraph (ii) is concerned, the Expert considers that the Domain Name was and is an Abusive Registration as a result of its manner of use by the Respondent, for the reasons explained below.
- 6.16 Specifically, the Expert considers that the factor set out at paragraph 5.1.2 of the Policy, 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”*, is relevant.
- 6.17 As evidenced to the Expert, the Respondent uses the Website to sell, among other things, the aftermarket products of the Complainant - products which compete with the Complainant who sells the same/similar goods. The Respondent also sells clothing on the Website from Adidas that is in direct competition with the Complainant’s clothing range, Martini Racing e.g. tops (based on a search by the Expert of the Website).
- 6.18 Further, the Expert notes that a great deal of time was spent in the submissions related to discussions as to whether or not certain of the goods sold by the Respondent on the Website, as highlighted by the Complainant, were counterfeit.
- 6.19 In this respect, the Expert considers that, based on the submissions before him, the Respondent did sell, though highly likely unintentionally, at least valve caps that were counterfeit (noting that the Respondent, through its controlling director, acknowledged that an issue had been raised in respect of the valve caps). The Respondent also did sell *Veloce Wheels* that used, unauthorised, the Complainant’s Name/Mark on its goods as a selling point (pictures were provided of said wheels as part of the submissions).
- 6.20 Both of these instances are, in the Expert’s view, sufficient to have confused those accessing the Website that the goods being sold there are either the Complainant’s genuine goods or endorsed by the Complaint for sale, which neither were.
- 6.21 Given this, the Expert considers that anyone accessing the Website would likely be confused, at least initially (see paragraph 3.3 of the DRS Experts’ Overview (version 3)), into thinking that the goods offered on the Website are the Complainant’s or that the Website is somehow connected with the Complainant, which is not the case, with the Complainant potentially losing sale opportunities and incurring reputational damage by such confusion.
- 6.22 The Expert is not persuaded by the argument that a person accessing the Website would soon realise their mistake, that the Website is not linked to the Complainant, as the damage to the Complainant’s business would already have been done. The Expert considers that it is likely that at least some persons accessing the Website would have done so only because of the Complainant’s general goodwill and reputation in the

Name/Marks (through, for example, putting the word “PORSCHE” and “SHOP” in Google search – which the Expert did, noting that the Website came up fourth in the search list).

6.23 For completeness, and noting the submission made by the Complainant regarding the application of paragraph 5.1.6 of the Policy, the Expert considers that paragraph of the Policy does not apply on these facts as the Domain Name is not an “*exact match*” for the Complainant’s Name/Mark (indeed, the Complainant itself accepted this when referencing this paragraph, when it submitted that the Domain Name “*is highly similar to the Mark*” rather than being “*an exact match*”).

6.24 In support of its position, the Respondent drew the Expert’s attention in particular to paragraph 8.1.1 of the Policy, paragraphs 8.1.1.1 and 8.1.1.2, which state that:

*Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:*

*8.1.1.1 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; [or]*

*8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*

6.25 However, the Expert considers that both submissions fall at the first hurdle, namely and for the reasons set out above at paragraphs 6.11 to 6.13, the Respondent would have been well aware of the Complainant’s cause for complaint before registering and then using the Domain Name.

6.26 The Expert has considered whether there is any other evidence before him to demonstrate that the Domain Name is not an Abusive Registration, including whether the Respondent is making fair use of the Domain Names, but does not consider that there is.

6.27 Unconscionable behaviour of the Complainant, finally, the Expert notes the submissions put forward by the Respondent that it is unfair to transfer the Domain name to the Complainant as there has been a meaningful delay in the Complainant’s failure until now to raise a DRS Complaint, which the Respondent has relied on. In particular, the Respondent highlights that the Complainant has been aware of the Respondent’s registration and use of the Domain Name for over twenty years and the Complainant has benefited financially from the Respondent purchasing goods from it.

6.28 While the Expert notes that there has been a certain amount of delay in the bringing of this Complaint, the Expert considers that such delay has not, for the Expert, sufficiently rebutted the strength of the Complainant’s position under the Policy as set out above. In particular, the Expert notes that there is no time limit set out in the Policy as to when a



Complainant has to bring its complaint by or otherwise forfeit its domain name rights and protections as set out in the Policy.

- 6.29 Further, the Expert notes that there are previous DRS Nominet decisions that have considered that delay is not in itself a bar to a finding of Abusive Registration (see for a discussion appeal D00015788 re. starwars.co.uk), though he also notes that there could be facts making it unjust for such a finding in a particular case.
- 6.30 That said, in the Expert's view there is nothing in the current facts before him to indicate that the Complainant has done anything which would make it unconscionable to bring the Complaint at this stage, and the Respondent has not done anything to its detriment in reliance on any assurance from the Complainant that it would not bring a complaint. On the contrary, the Expert considers that the Complainant has continued to voice its objections over a long period of time regarding the Domain Name and its use through various correspondence with the Respondent.
- 6.31 For the reasons set out above, the Expert considers that the use of the Domain Name by the Respondent took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

## **7. Decision**

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

**Signed: Dr. Russell Richardson**

**Dated: 20 December 2020**