

# DISPUTE RESOLUTION SERVICE

## D00016810 and D00016811 Consolidated Decision of Independent Expert

Jaguar Land Rover Limited

and

(1) Big Marketing Limited

(2) Big Marketing

### 1. The Parties:

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

Respondent: Big Marketing Limited and Big Marketing  
82 - 84 Newport Road  
New Bradwell  
Milton Keynes  
Bucks  
MK13 0AA  
United Kingdom

### 2. Preliminary Matter

The Complainant in Complaints D00016810 and D00016811 requested, by e-mail of 26 November 2015 (the date both Complaints were validated by Nominet), that they be consolidated. The Complainant explained that the *‘Respondents in both actions are one in the same organisation however, because there was a slight difference in the registrant names used when purchasing the domain names in question, we had to file two separate Nominet actions’*. Whilst the domain names in each Complaint are of course different as can be seen from the lists below, having reviewed each Complaint, the Expert is satisfied that they raise the same issues and that accordingly, it is sensible to deal with the Complaints together. The Expert has general powers to consolidate multiple Complaints under paragraph 12(c) of Nominet’s Dispute Resolution Service Procedure and hereby does

so. It should be mentioned that the Complainant’s request to consolidate was foreshadowed in each Complaint and no objection was raised by the Respondents in their Responses. In paragraph 3 below is a list of domain names in each Complaint. There are 47 domain names in all. They will hereafter be referred to collectively as the Domain Names, or Domain Name if referred to in the singular. The Complaints will hereafter be considered as one and no distinction will be drawn between the two Respondents who will be considered as one and the same.

### 3. The Domain Names

<p><b>(D00016810)</b></p> <p>e-typesforsale.co.uk  etypesforsale.co.uk  jaguarapprovedusedcars.co.uk  jaguarfinance.co.uk  jaguarinsurance.co.uk  jaguarsforsale.co.uk  landroverapprovedusedcars.co.uk  landroverassuredusedcars.co.uk  landroverfinance.co.uk  landroverinsurance.co.uk  landroverservicing.co.uk  landroversforsale.co.uk  newjaguars.co.uk  newjaguarsforsale.co.uk  newlandrovers.co.uk  newlandroversforsale.co.uk  newrovers.co.uk  newroversforsale.co.uk  rangeroversforsale.co.uk  rangeroveronline.co.uk  rover-forsale.co.uk  roverapprovedusedcars.co.uk  roverforsale.co.uk  roverinsurance.co.uk  rovers4auction.co.uk  roverservicing.co.uk  roversforsale.co.uk  roveronline.co.uk  usedjaguarsforsale.co.uk  usedlandroversforsale.co.uk  usedrovers.co.uk  usedroversforsale.co.uk</p>	<p><b>(D00016811)</b></p> <p>jaguar-vip-event.co.uk  jaguarevent.co.uk  jaguarnow.co.uk  landrover-now.co.uk  landroverevent.co.uk  landrovernow.co.uk  landrovervipevent.co.uk  preregjaguar.co.uk  preregjaguars.co.uk  prereglandrover.co.uk  prereglandrovers.co.uk  prereg rangerover.co.uk  prereg rangerovers.co.uk  rangeroverevent.co.uk  roveronline.co.uk</p>
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An Annex comprising a complete list of Domain Names with their respective registration dates is attached.

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

I can confirm that I am independent 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 being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

26 November 2015	Disputes received
26 November 2015	Complaints validated
26 November 2015	Notifications of complaint sent to parties
15 December 2015	Response reminders sent
16 December 2015	Responses received
16 December 2015	Notification of responses sent to parties
21 December 2015	Reply reminders sent
22 December 2015	Replies received
24 December 2015	Notification of replies sent to parties
24 December 2015	Mediator appointed
04 January 2016	Mediation started
05 February 2016	Mediation failed
05 February 2016	Close of mediation documents sent
11 February 2016	Expert decision payment received

### **4. Factual Background**

The Complainant is a company incorporated in the United Kingdom with its registered office at Abbey Road, Whitley, Coventry CV3 4LF. It operates through a network of authorised dealers which sell new and approved used cars and parts. The Complainant also provides a range of services including those related to finance, insurance, repair and maintenance.

The Complainant manufactures premium saloons and sports cars, sports utility and all wheel drive vehicles, and operates from its two engineering centres at Whitley in Coventry and Gaydon in Warwickshire, its manufacturing plants in Castle Bromwich and Halewood, and its recently opened engine production site at Wolverhampton. The Complainant employs over 25,000 people in the UK.

The first Land Rover vehicle was launched by the Rover Company at the Amsterdam Motor Show in April 1948, and today the following brands make up the Land Rover vehicle range: Land Rover Defender, Land Rover Discovery and Land Rover Freelander.

The first Jaguar vehicle was launched at the Mayfair Hotel in London in 1935 by the Swallow

Sidecar Company, under the name SS Jaguar. After the Second World War, the company changed its name to Jaguar Cars and produced its first post-war Jaguar car, the Mark V, in 1948. The current Jaguar vehicle range comprises the following vehicles: XE, XF, XJ, F-Type and F-Pace.

The first Range Rover vehicle was launched in 1969 and the current Range Rover vehicle range comprises the following brands: Range Rover, Range Rover Sport and Range Rover Evoque.

The Respondent is a marketing agency and has specialised in the franchised motor trade for over 15 years. In its Response, it comments *'With great hindsight and in support of our specialist field we proactively registered over 600 associated domain names'*. However, the activities of the Respondent are diverse and although the majority of its business is in the motor industry (manufacturers as well as franchised dealers), it also has clients in other fields.

## **5. Parties' Contentions**

### **The Complainant**

This section summarises the main contentions of the parties.

#### *Rights*

In the course of its activities, the Complainant has built up extensive intellectual property rights, including a large portfolio of trade mark registrations and common law rights in the various brands that it uses. It owns, amongst others, the following trade marks:

UK trade mark no. 663199 LAND ROVER in class 12, dated 11 October 1947

UK trade mark no. 625805 JAGUAR in class 12, dated 13 October 1943

UK trade mark no. 2566196 E TYPE in inter alia class 12, dated 02 December 2010

UK trade mark no. 1518902 ROVER in class 12, dated 14 November 1992

UK trade mark no. 920322 RANGE ROVER in class 12, dated 30 January 1968

Furthermore, the LAND ROVER, JAGUAR, RANGE ROVER, E TYPE and ROVER marks have acquired extensive goodwill and a substantial reputation throughout the UK, EU and the rest of the world. They are all very well-known marks.

The Complainant also owns a number of domain names which relate to the Land Rover, Jaguar, Range Rover and Rover marks, including the following:

land-rover.com;

landrover.com;

landrover.co.uk;  
jaguar.co.uk;  
jaguar.com;  
rover.co.uk; and  
rangerover.co.uk.

### *Similarity*

The dominant and distinctive element in the case of each of the Domain Names is one or more of the Complainant's trade marks. The remainder of each Domain Name is either a descriptive term, such as 'insurance', 'forsale', 'new', 'used', 'auction', 'servicing', 'event', 'prereg', 'vip-event' and/or the domain suffix, '.co.uk'.

The Domain Names are therefore identical or closely similar to the Complainant's marks.

### *Abusive Registration*

As well as acquiring the Domain Names incorporating the Complainant's registered trade marks, the Respondent has also acquired a number of domain names which correspond to other well known vehicle brands or registered trade marks in which the Respondent has no apparent rights, for example, LAMBORGHINI, LEXUS, FORD, VOLKSWAGEN, RENAULT.

On 30 July 2015, the Complainant's representatives sent a letter<sup>1</sup> to the Respondent requesting the transfer of the Domain Names. No response was received despite a reminder being sent on 25 August 2015.

On 10 November 2015, the Respondent contacted the Complainant and an offer was thereafter made (on 10 November) to sell the Domain Names<sup>2</sup> to the Complainant for £150 each.

The Complainant contends that it can demonstrate that the Respondent is engaged in a pattern of registrations whereby it has registered domain names which correspond to well known names or trade marks in which it has no apparent rights, and the Domain Names are part of that pattern. Examples of the Respondent's other registrations include:

chevrolet servicing.co.uk  
costpricecitroens.co.uk  
hyundaievent.co.uk  
mercedesevent.co.uk  
newchevrolets.co.uk  
newpicasso.co.uk

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<sup>1</sup> it appears that only 46 domain names were in issue at that time.

<sup>2</sup> or at least 46 of them

newsuzukis.co.uk  
preregaudis.co.uk  
preregchrysler.co.uk  
preregnessans.co.uk  
preregmini.co.uk  
suzukievent.co.uk  
usedmaseratis.co.uk  
protonparts.co.uk  
alfaromeosforsale.co.uk

A number of these domain names follow the same format as the Domain Names the subject of the Complaint, e.g. 'prereg.....co.uk', '.....event.co.uk', 'used.....co.uk', '....forsale.co.uk', '....servicing.co.uk'

The Complainant contends that the Respondent's decision to register such a large number of domain names containing the Complainant's trade marks, as well as the brands and/or trade marks of other automotive companies, demonstrates that it has no legitimate interest in using the same. The Respondent is operating as a marketing company and will therefore have no interest in selling a used car or parts, servicing a car, running a car auction etc. Accordingly, it would seem that registration of the Domain Names has been for the purposes of selling them to third parties or as speculative registrations. This is illustrated by the fact that the majority of the Domain Names are not in use.

The Complainant is aware that the Respondent has had a previous Nominet DRS decision against it i.e. D00012264, BMW vs Big Marketing, dated 1 February 2013, which arises out of the Respondent registering a number of domain names incorporating the trade marks and/or brand names of Bayerische Motoren Werke Aktiengesellschaft (BMW).

The Complainant asserts that the Respondent has a history of block registering domain names incorporating third party trade marks.

In light of the above and the Respondent's offer to sell the Domain Names for £150 each, the Complainant maintains that the Domain Names must be seen as abusive registrations.

### **The Respondent**

The Respondent says that the Domain Names, along with all others it owns, have only ever been used, if at all, in support of the marketing activities it has been asked to undertake by the corresponding franchised dealers. The Respondent's understanding is that the dealership concerned would be authorised to use the names in question. For example, Ridgeway Jaguar who retained the Respondent to build a website called Jaguarnow.co.uk and to develop a marketing campaign, was, it says, duly authorised by Jaguar's marketing division.

A further example relied on by the Respondent is landrovervevent.co.uk, whereby its client, an authorised Land Rover dealership, retained it to build a website and coordinate a twice yearly sales event. The Respondent states that, *'again this has always been undertaken with full authority from the dealer, Ridgeway Land Rover'*.

The Respondent says that not all of the Domain Names contain registered trade marks of the Complainant and that some are generic and could be used for other clients. For example, jaguarevent.co.uk could be used by a Zoo or wildlife client and roveronline.co.uk could be used for a dog orientated client.

The Respondent offered to transfer ownership of the Domain Names at £150 per domain name, to cover its costs from past years of ownership. It was felt by the Respondent that this offer was more than fair *'and supported the industry in which much of our companies activities are engaged with. It also resembled the basis on which BMW acquired certain domains from us recently in an amicable resolution'*. It is also said by the Respondent that such a nominal cost per domain name provided no reimbursement for loss of profit opportunities in hosting further marketing campaigns for clients and future clients.

The Respondent maintains that it does not use the Domain Names in an abusive manner and is not passing off.

### **The Complainant's Reply to the Response**

The Complainant explains that its authorised dealers are not entitled to own a domain name which contains its trade marks. An authorised dealer is advised accordingly on entering into a contract with the Complainant. The Complainant takes steps to arrange a transfer of a registration if an authorised dealer is found to own a domain name containing one of its trade marks. Had any of the Domain Names been legitimately registered by the Respondent for an authorised dealer, they should have been transferred to that authorised dealer and the Complainant would have then dealt with them as appropriate.

As to the specific Domain Name, jaguarnew.co.uk, whilst the Respondent contends that registration was with the consent of *'Jaguar's marketing division'*, no evidence has been provided in support. Further, as Ridgeway Jaguar is an authorised dealer of the Complainant, it would know that the Respondent would not be entitled to own the Domain Name, even if on the Complainant's behalf.

It is not accepted, as the Respondent contends, that the Domain Names do not all contain registered trade marks of the Complainant - each Domain Name contains one of the Complainant's trade marks. The Complainant points out that the Respondent has not identified which of the Domain Names it had in mind when making this assertion.

As to the Respondent's comments regarding the generic nature of some of the Domain Names which could be used for other clients, the Complainant further points out that there

were other similar domain names containing the Complainant's trade marks. For example, in addition to jaguarevent.co.uk, the Respondent has also registered landroverevent.co.uk, landrovervipevent.co.uk and rangeroverevent.co.uk. Similarly, with respect to roveronline.co.uk, the Respondent has also registered roveronline.co.uk and rangeroveronline.co.uk.

As to the Respondent's offer to sell the Domain Names, the Complainant makes the point that as this was on the basis of £150 per domain name, given there are 47 Domain Names, a total payment of £7,050 was sought.

The Complainant says that the fact that BMW also had to purchase domain names in this manner, makes it apparent that the Respondent is a prolific registrant of domain names containing third party trade marks which are then used in an abusive manner, namely to hold to ransom the trade mark owner and force them to purchase the domain name(s). The Complainant also makes the point that no evidence has been provided by the Respondent to demonstrate that the cost of registering each Domain Name was £150. The Complainant assumes it could fairly easily have been provided. The Complainant speculates that the Respondent chose the amount of £150 on the assumption that it is not a huge sum of money and that the Complainant would rather have paid it than pursued DRS proceedings.

Finally, as to the Respondent's comments about the suggested price of £150 not including loss of profit opportunity, the Complainant's position is that such would not be justified given that the Respondent had no legitimate right to purchase domain names containing the Complainant's trade marks in the first place.

## **6. Discussions and Findings**

Under the provisions of Nominet's Dispute Resolution Service Policy (the Policy), for a Complaint to succeed, a Complainant is required to 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 in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

### **Complainant's 'Rights'**

The meaning of 'Rights' is defined in the Policy 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*'.

The Complainant has registered rights in the LAND ROVER, JAGUAR, ROVER, RANGE ROVER and E TYPE trade marks.

These marks have been used extensively in the Complainant's activities in the UK and



elsewhere over many years and it is accepted by the Expert that the Complainant has acquired extensive goodwill and a substantial reputation in those marks throughout the UK and elsewhere. Accordingly, there is little doubt that the Complainant also enjoys unregistered or common law rights in these marks, in addition to its registered rights.

### Similarity

The Domain Names all encapsulate the Complainant's marks. None use a mark unadorned. Each one of the Domain Names include, in addition to the mark, a word or words of a generic or descriptive nature. Some indicate an ancillary product one might expect to be offered by a motor manufacturer or main dealer e.g. finance or insurance, or an activity i.e. servicing. Others are indicative of the kind of event one might expect to be organized by a motor retailer e.g. 'vip' event. The Complainant's marks are more often than not the first word in the Domain Names, but not exclusively so. Howsoever used though, the marks are the dominant element of each of the Domain Names.

The Complainant's marks and corresponding Domain Names are similar and, accordingly, the Expert is satisfied that the Complainant has Rights in names or marks which are similar to the Domain Names for the purposes of the Policy.

The Expert must now therefore consider whether the Domain Names are Abusive Registrations in the hands of the Respondent.

### Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'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 which *'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights;'*.

A useful guide as to what might constitute an Abusive Registration is contained in paragraph 3(a) of the Policy. It contains a non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration. Such factors include circumstances indicating that a respondent has registered or otherwise acquired a domain name primarily for the purposes of selling, renting or otherwise transferring it to the complainant (or a competitor) for valuable consideration in excess of the respondent's out-of-pocket costs, as a blocking registration against a name or mark in which a complainant has rights, or for the purpose of unfairly disrupting the business of a complainant.

Other factors suggesting an Abusive Registration include a respondent using or threatening to use a domain name in a way which has confused or is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the complainant, or where the complainant can demonstrate that the respondent is engaged in

a pattern of registrations whereby it is the registrant of domain names which correspond to well known names or trade marks in which it has no apparent rights, and the domain name in question is part of that pattern.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This paragraph contains a useful guide as to what does not constitute an Abusive Registration and is dealt with further below.

## Discussion

The Complainant's case on Abusive Registration is essentially that:

- A) the Respondent is engaged in a pattern of registrations of domain names corresponding to well known names or trade marks in the automotive sector in respect of which the Respondent has no apparent rights, and the Domain Names are part of that pattern;
- B) that the Respondent has a history of block registering domain names incorporating third party marks;
- C) the Respondent is a marketing company and has no interest in selling cars or engaging in any of the other activities suggested by the Domain Names and that therefore registration of the Domain Names was for the purpose of selling them to third parties *'or as speculative registrations'*;
- D) there has been a previous decision against the Respondent arising out of the registration of a number of domain names incorporating the trade marks or brand names of BMW.

### *Pattern of Registration/block registrations*

The Respondent does appear to be a habitual registrant of domain names containing the names or marks of others. Indeed, the Respondent says as much in its Response when stating *'We are an accredited marketing agency specialising in the franchised motor trade for over 15 years. With great hindsight and in support of our specialist field we proactively registered over 600 associated domain names'*. It would appear that registration of the Domain Names was part of a conscious policy on the part of the Respondent. Given the format of other domain names it has registered, which incorporate the trade marks or brand names of other motor manufacturers together with identical or similar generic or descriptive terms - [chevrolet servicing.co.uk](http://chevrolet servicing.co.uk) (cf. [landrover servicing.co.uk](http://landrover servicing.co.uk), [roverservicing.co.uk](http://roverservicing.co.uk)), [preregaudis.co.uk](http://preregaudis.co.uk) (cf. [prereglandrovers.co.uk](http://prereglandrovers.co.uk), [prereg rangerover.co.uk](http://prereg rangerover.co.uk)), [newchevrolet s.co.uk](http://newchevrolet s.co.uk) (cf. [newjaguars.co.uk](http://newjaguars.co.uk), [newrovers.co.uk](http://newrovers.co.uk)), there is a clear context or link to the Respondent's registration of the Domain Names and other domain names in its portfolio. Of course, it might be that not all other domain names

in the Respondent's portfolio are or could be regarded as objectionable, but it is clear from the BMW decision referred to earlier, that some were.

The fact that the Respondent makes block registrations, which is clear from the Annex (e.g. 16 registrations on 9 December 1999), supports what the Respondent has said about its domain name registration strategy. It also however supports the Complainant's case on pattern of registration, which the Expert finds is made out.

### *Selling/speculative registrations*

The only evidence of an intention to sell the Domain Names (whether a 'primary' intention or otherwise), comes from the Respondent itself when comparing its offer to the Complainant with the arrangement struck with BMW: *'It also resembled the basis on which BMW acquired certain domains from us recently in an amicable resolution'*. (The Expert assumes that the Respondent is referring to domain names other than those the subject of the DRS Summary Decision referred to earlier but, in any event, the Expert is not satisfied that there is evidence to suggest that a sale of the Domain Names was the Respondent's intention (let alone 'primary' intention, as envisaged under paragraph (3) of the Policy). As can be seen from the Annex, some of the Domain Names have been held since as far back as 1999 (with the others held since 2000, 2006, 2007, 2012 and 2103). This suggests to the Expert that a sale was not upper-most in the Respondent's mind, if at all, at the time of registration. In any event, the circumstances envisaged in paragraph 3 of the Policy are that the (primary) purpose of the registration was to sell the domain name for an amount *'..in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name'*. As already noted, some of the Domain Names were registered over 15 years ago. None are very recent. If one were to take into account renewal fees, it is not a forgone conclusion that, at least in every case, £150 would be regarded as an amount in excess of the Respondent's costs. However, given the Expert's view on this part of the Complaint, the point need not be considered further.

As to the assertion of speculative registration, it seems that that is exactly what the Respondent says it was doing – registering domain names that could be useful in the future for clients in the franchised motor trade (*'With great hindsight and in support of our specialist field we proactively registered over 600 associated domain names'*).

Finally, and for the sake of completeness, it might be said that the Respondent's business model is, in effect, the 'renting' of Domain Names to those with an obvious interest in using them i.e. the Complainant's authorised dealers. That, in itself, might be regarded as an abusive use in the circumstances of this Complaint, but as it is not part of the Complainant's case and given the other findings in this Decision, this point also need not be analysed further.

### *Previous decision against the Respondent*

Paragraph 3(a)(vii) of the Policy provides: *'There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the Complaint was filed. This presumption can be rebutted (see paragraphs 4(a)(iv) and 4 (c))'*.

The Complainant has put forward evidence of only one case. Whilst that case can be taken into account in a general sense, it cannot, on its own, result in a 'presumption' for the purposes of paragraph 3(a)(vii) of the Policy.

### *Confusion*

Finally, it is perhaps appropriate to mention the issue of confusion. The Complainant has not asserted that the Respondent is threatening to use the Domain Names 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. That is no doubt because the Domain Names have not been widely used and any use that has been made of them, has been on behalf of authorised dealers with an obvious connection to the Domain Name concerned.

However, the Domain Names clearly incorporate the Complainant's well known marks. They are very much the dominant element, more often than not appearing first in the Domain Name followed by a generic or descriptive word or words and in a minority of cases, preceded by such. If the Domain Names were to be used in a slightly different way for a slightly different purpose, there is a clear possibility of not just confusion, but very real detriment too. For instance, if the Respondent was to use one of the Domain Names for a non-franchised car dealer selling the cars of a variety of manufacturers, the circumstances become all together more serious. Even though the Domain Names are not being used in this way, the possibility exists, especially given the Respondent's focus on the motor trade. Given the possibility of abusive use and absent any justification for the holding of the Domain Names, there could be a finding of Abusive Registration based on confusion too.

In all the circumstances, absent any persuasive countervailing factors (which will be considered below), there are grounds for a finding of Abusive Registration on the basis that the Respondent has engaged in a pattern of registrations whereby it is the registrant of domain names which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Names are part of that pattern. Furthermore, as indicated earlier, there might be other bases upon which such a finding could be made as well.

Given the above, the Expert must now consider, the Complainant having established that the Respondent has a case to answer, whether the Respondent has an answer to the case.

Such a consideration invariably involves a review of Paragraph 4 of the Policy. It is this

paragraph which sets out matters which, if established to the satisfaction of the Expert, are likely to be regarded as a satisfactory answer to the Complainant's case. However, the matters set out therein are not exhaustive, and the Expert is entitled to examine any suggested countervailing factors raised by the Respondent. Nevertheless, Paragraph 4 is a good starting point.

Paragraph 4(a) of the Policy states:

*'A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:*

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

As Paragraph 2 (and indeed the examples of countervailing factors in Paragraph 4) of the Policy makes clear, an Expert must consider the question of Abusive Registration by examining the *'..Domain Name, in the hands of the Respondent..'*. Thus, one must look at the actual Respondent in the case rather than a hypothetical Respondent.

The Respondent's answer to the case boils down to the following:

- A) the Domain Names, if used at all, have only been used in support of marketing activities by franchised motor dealers who have an obvious connection with the Domain Name e.g. the project for Ridgeway Jaguar which used jaguarnow.co.uk;
- B) the Respondent's understanding is that, in the circumstances described immediately above, the dealership are *'authorised to use the names in question'* and that, in fact, *'Jaguars marketing division'* did so authorise the Ridgeway Jaguar project;
- C) that the project for Ridgeway Land Rover (described earlier) using landroveripevent.co.uk was *'undertaken with full authority from the dealer, Ridgeway Land Rover'*.
- D) Some of the Domain Names are generic and could be used by other clients in different sectors and not all contain the marks of the Complainant.

## *Authority*

It seems clear from the assertions of the Respondent, that it considers carefully the domain names it registers with a view to maximizing the chances of those domain names being used for future projects for existing or future clients in the franchised motor sector. Accordingly, a great number of well known marks and brand names have been registered in the normal course of its business. It also seems clear that the Respondent assumes that it will be given appropriate authority to use domain names that encapsulate the trade mark or brand name of the motor cars concerned, as and when needed for a particular project. It appears to be the Respondent's position, or at least a possible corollary of what it has said, that until use is authorised, its domain names incorporating brands and/or trade marks of well known motor manufactures, will not be used.

In the Expert's view, the Respondent recognises the need for authority to use a domain name containing the Complainant's marks in marketing campaigns for authorised dealers.

In the case of jaguarnew.co.uk, the Respondent says that they had the authority of '*Jaguars marketing division*'. This appears to be disputed by the Complainant, who point out that no evidence has been provided. One of the two attachments to the Response is a .tiff file, which is described as a 'Jaguar Now Home Page'. It appears to be a draft. At its foot it bears, under the heading 'JAGUAR NOW', a copyright notice as follows '© JAGUAR LAND ROVER LIMITED 2013'. One would have expected, given the relatively recent date and formal nature of the page, that evidence of authority might readily have been available. As a marketing business, the Respondent will know the value of brands and the importance of controlling their use by others, including the documenting of authority for any permitted use.

The other attachment to the Response appears to concern the Domain Name, landrovervevent.co.uk and is a .png file, being a page described as 'Jaguar Vip Event'. It refers to an event in September 2013. The Respondent again says that it had '*full authority*', from the dealership concerned, but again no evidence has been provided.

The Complainant says that their authorised dealers are not allowed to own domain names containing the Complainant's trade marks. Given this prohibition, it would seem odd that an authorised dealer would feel able to authorise a third party to use a domain name which it, itself, could not own. Maybe the dealership concerned assumed that the Respondent, owning domain names incorporating the Complainant's marks, had been authorised (by the Complainant) to use them for the benefit of its dealers. But in those circumstances, it would not itself need to give '*full authority*'. It might be that the Respondent draws no distinction between authority to use the Complainant's marks in the normal course of an authorised dealer's business, e.g. a marketing campaign, and specific consent to use (or own) a domain name. Whatever the position, there is no independent evidence of consent being given by the Complainant (or on its behalf) to the Respondent to use (or own) any of the Domain Names yet for reasons earlier explained, the issue of authority would seem to be crucial to

the Respondent's case. A possible exception might be (on the Respondent's case) where one or more of the Domain Names described as generic could be used by other clients, a point dealt with under the next heading.

Were the Respondent themselves selling the Complainant's cars, or providing products or services in relation to them, depending on the precise circumstances, it could perhaps be argued that the Respondent's use was in relation to a genuine offering of goods or services or otherwise legitimate. But it doesn't. What the Respondent seems to say is that it does not use the Domain Names in an abusive manner because it only ever uses them with authority. (It also says that it is not passing off, but any analysis of infringement of the Complainant's common law rights, as opposed to their existence for the purposes of having standing to bring a Complaint in the first place, is beyond the scope of DRS proceedings and therefore this Decision). But to hold a domain name that one cannot use without the authority of the trade mark owner whose trade mark is encapsulated within it (or the authority of a third party empowered to give authority on behalf of the trade mark owner e.g. an authorised dealer), seems a curious basis upon which to argue that the registration is fair or legitimate under the Policy.

#### *No reference to Complainant's marks/Generic domain names*

The Respondent is wrong when it says that not all of the Domain Names contain the trade marks of the Complainant; they do.

The Respondent argues that some of Domain Names are generic and could readily be used for other clients. It gives the example of jaguarevent.co.uk, which might be used by a 'Zoo or wildlife client' and roversonline.co.uk, which '*may apply to a dog orientated client*' .

Whatever description one might attach to the domain names identified by the Respondent (i.e. generic or otherwise), what is clear is that the Complainant has rights in respect of JAGUAR and ROVER which are similar to these specific Domain Names. The fact that a zoo or dog business might also have a right to use them does not assist the Respondent because, as already noted, an Expert must consider the question of Abusive Registration by examining the '*..Domain Name, in the hands of the Respondent...*'. It should be unsurprising that a domain name could be an Abusive Registration in the hands of one respondent but not another, or that a finding of Abusive Registration could have been avoided by a Respondent using a domain name in a different way.

It is clear that these domain names, described by the Respondent as generic, were registered with future marketing campaigns for the motor trade very much in mind – as can be seen from the Annex, jaguarevent.co.uk was registered on 11 January 2007, the same day as landroverevent.co.uk and rangeroverevent.co.uk were registered, and roversonline.co.uk was registered 16 December 1999, the same day as rangeroversonline.co.uk was registered.

The Expert finds that the Complainant has made out a case of Abusive Registration based on the Respondent's pattern of registration. There could be other grounds too to support such a finding (the potential threat of abusive use or the renting of the Domain Names). The Respondent does not demur from the assertion that it embarked on widespread registrations of domain names. Indeed, that is its business model. The difficulty is, at least in relation to the Domain Names and those the subject of the Summary Decision in the BMW case referred to earlier, that the registrations corresponded to well known names or trade marks in which the Respondent has or had no apparent rights. Whilst the Respondent seems to appreciate the need for authority to use the Domain Names, and claims to have had authority in two instances, it has not provided anything that could be regarded as proof of such authority, or authority to use the Domain Names generally. Its other points about some Domain Names not incorporating the marks of the Complainant, being generic in nature or it not passing off, are either plain wrong, provide no justification for the registrations or are irrelevant. In short, the Respondent appears to have no answer to the case made out by the Complainant. The Expert does not consider the elapse of time since the registrations took place (albeit over 15 years in some cases) has prejudiced the Respondent in anyway (and indeed the Respondent has not suggested that it has) and accordingly, the Expert finds little difficulty in concluding that there is sufficient evidence to support a finding of Abusive Registration.

## **7. Decision**

The Expert finds that the Complainant has rights in names or trade marks similar to the Domain Names and is satisfied, on the evidence before him, that the Domain Names in the hands of the Respondent are Abusive Registrations. Accordingly, the Expert directs that the Domain Names listed in paragraph 3 above (and in the Annex) be transferred to the Complainant.

Signed .....  
**Jon Lang**

**Dated: 1 March 2016**



## ANNEX

Domain Names	Date Registered	Registrant
e-typesforsale.co.uk	10-Jan-00	Big Marketing Limited
etypesforsale.co.uk	10-Jan-00	Big Marketing Limited
landroversforsale.co.uk	16-Sep-99	Big Marketing Limited
roveronline.co.uk	16-Feb-06	Big Marketing
rangeroversforsale.co.uk	16-Sep-99	Big Marketing Limited
roversforsale.co.uk	16-Sep-99	Big Marketing Limited
jaguarsforsale.co.uk	16-Sep-99	Big Marketing Limited
jaguarevent.co.uk	11-Jan-07	Big Marketing
roverforsale.co.uk	16-Sep-99	Big Marketing Limited
landroverevent.co.uk	11-Jan-07	Big Marketing
rangeroverevent.co.uk	11-Jan-07	Big Marketing
roveronline.co.uk	16-Dec-99	Big Marketing Limited
rovers4auction.co.uk	30-Nov-99	Big Marketing Limited
rangeroveronline.co.uk	16-Dec-99	Big Marketing Limited
rover-forsale.co.uk	16-Sep-99	Big Marketing Limited
landroverassuredusedcars.co.uk	26-Jan-00	Big Marketing Limited
jaguarapprovedusedcars.co.uk	06-Dec-99	Big Marketing Limited
landroverservicing.co.uk	09-Dec-99	Big Marketing Limited
landroverfinance.co.uk	09-Dec-99	Big Marketing Limited
landroverapprovedusedcars.co.uk	09-Dec-99	Big Marketing Limited
landroverinsurance.co.uk	09-Dec-99	Big Marketing Limited
roverservicing.co.uk	09-Dec-99	Big Marketing Limited
roverinsurance.co.uk	09-Dec-99	Big Marketing Limited
roverapprovedusedcars.co.uk	09-Dec-99	Big Marketing Limited
jaguarinsurance.co.uk	09-Dec-99	Big Marketing Limited
jaguarfinance.co.uk	09-Dec-99	Big Marketing Limited
jaguarnow.co.uk	19-Oct-12	Big Marketing
landrovernow.co.uk	19-Oct-12	Big Marketing
landrover-now.co.uk	11-Jan-13	Big Marketing
jaguar-vip-event.co.uk	05-Aug-13	Big Marketing
landrovervipevent.co.uk	05-Aug-13	Big Marketing
preregrangerovers.co.uk	02-Oct-07	Big Marketing
usedrovers.co.uk	01-Dec-99	Big Marketing Limited
newrovers.co.uk	01-Dec-99	Big Marketing Limited
newjaguars.co.uk	06-Dec-99	Big Marketing Limited
newroversforsale.co.uk	09-Dec-99	Big Marketing Limited
newjaguarsforsale.co.uk	09-Dec-99	Big Marketing Limited
usedroversforsale.co.uk	09-Dec-99	Big Marketing Limited
usedjaguarsforsale.co.uk	09-Dec-99	Big Marketing Limited
usedlandroversforsale.co.uk	09-Dec-99	Big Marketing Limited

newlandrovers.co.uk	09-Dec-99	Big Marketing Limited
newlandroversforsale.co.uk	09-Dec-99	Big Marketing Limited
preregjaguar.co.uk	01-Oct-07	Big Marketing
prereglandrover.co.uk	01-Oct-07	Big Marketing
prereg rangerover.co.uk	01-Oct-07	Big Marketing
preregjaguars.co.uk	02-Oct-07	Big Marketing
prereglandrovers.co.uk	02-Oct-07	Big Marketing