

DISPUTE RESOLUTION SERVICE

D00017602

Decision of Independent Expert

Jaguar Land Rover Limited

and

Mr Dave Robbie

1. The Parties:

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

Respondent: Mr Dave Robbie
hilltop, main road
ford end
Chelmsford
Chelmsford
CM3 1LL
United Kingdom

2. The Domain Name(s):

<jagracing.co.uk>

3. Procedural History:

3.1 The procedural history of this matter is as follows:

14 June 2016 10:17 Dispute received
15 June 2016 13:41 Complaint validated
15 June 2016 13:42 Notification of complaint sent to parties
04 July 2016 02:30 Response reminder sent
05 July 2016 09:43 Response received
05 July 2016 09:43 Notification of response sent to parties
08 July 2016 02:31 Reply reminder sent
12 July 2016 10:52 Reply received
13 July 2016 09:08 Notification of reply sent to parties
13 July 2016 09:12 Mediator appointed
18 July 2016 13:10 Mediation started
13 June 2017 15:02 Dispute resolved during mediation
20 April 2018 16:43 Dispute opened
06 June 2018 10:19 Mediation failed
06 June 2018 10:19 Close of mediation documents sent
12 June 2018 10:41 Expert decision payment received

3.2 The Respondent also sought to file a supplemental submission in these proceedings (as to which see paras 6.6 to 6.9 below).

3.3 I have confirmed to Nominet that I am independent of each of the parties. I have further confirmed that 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.

4. Factual Background

4.1 The Complainant is the well-known car manufacturer. Its two main brands are "Jaguar" and "Land Rover". So far as "Jaguar" is concerned the business can be traced back to the 1930s, with the company conducting that business launching various cars under that name from the 1940s onwards.

4.2 The Complainant is the owner of various trade marks that comprise or incorporate the term "Jaguar". They include:

- (i) UK Registered trade mark no 1238638 for the word mark JAGUAR in classes 1, 4, 7, 9, 11 and 12, dated 26 March 1985; and
- (ii) UK Registered trade mark no 2220317 for the word mark JAGUAR RACING in classes 3, 9, 14, 16, 18, 21, 25, 28 and 41 dated 25 January 2000.

- 4.3 The Complainant's "Jaguar" branded vehicles are frequently colloquially referred to as a "Jag" or as "Jags".
- 4.4 The Complainant is also the owner of various domain names that incorporate the term "jaguar". At least one of these is used for a website that promotes the Complainant's business.
- 4.5 The Respondent appears to be an individual based in Coventry. He registered the Domain Name on 23 November 2005. At some point since that date it began to be used for a website that:
- (i) under the heading "JAGRACING", described itself as "The Fastest Site for Jaguar racing, Parts, Cars & Information;
 - (ii) recommended a particular retailer for new and used Jaguar cars;
 - (iii) displayed advertisements for various other non-jaguar related businesses;
 - (iv) provided information about certain Jaguar cars;
 - (v) provided information about "Jaguar Racing", which appeared to include information regarding the Respondent's racing activities; and
 - (vi) to some extent promoted the sale of second hand parts for JAGUAR branded vehicles.
- 4.6 On 24 June 2015 the Complainant's attorneys sent a letter before action to the Respondent seeking the transfer of the Domain Name to the Respondent. Subsequently, the Respondent took down the website operating from the Domain Name, but he has not agreed to transfer the Domain Name to the Complainant.

5. Parties' Contentions

Complainant

- 5.1 The Complainant provides details of the history of its business and some of its trade marks. It also appears to claim unregistered trade mark rights in the term "Jag".
- 5.2 The Complainant asserts that the Domain Name comprises the term "Jag" and the word "racing". It claims that the Domain Name is "highly similar" to its JAGUAR RACING registered trade mark as well as its claimed unregistered "Jag" trade mark. Consequently, it maintains that the Domain Name is

identical or closely similar to a name or mark in which the Complainant has rights.

- 5.3 The Complainant further asserts that the use of the Domain Name for a website with the content described in the Factual Background section of this decision takes unfair advantage of the Complainant's rights in the terms "Jag", "Jaguar" and "Jaguar Racing". It also claims that the Domain Name suggests to consumers that the Respondent is authorised by, connected to, affiliated with or endorsed by the Complainant, when this is not the case.
- 5.4 The Complainant further contends that its concerns are "exacerbated [by] the fact that the Complainant, on 15 December 2015, announced that [it] would once again be increasing [its] profile in motorsport as of Autumn 2016 by entering the FIA Formula E Championship with [its] own team."

Respondent

- 5.5 The Respondent denies that he has ever had the intention of creating a website that could be confused with or mistaken for a genuine Jaguar / Land Rover owned website. He claims that the website operating from the Domain Name was set up as a result of his racing activities with the Jaguar Enthusiasts Club XJS race series. Having raced with them since 2003, he claims that he felt it was a good idea to start his own website to post information, race reports and pictures from the club's races.
- 5.6 The Respondent also contends that he has accumulated a number of unwanted used spares that he advertised on the site, but that the website was not set up as a business and was never run as such. He accepts that it has included links to other sites, but these he claims were reciprocal links intended to increase the search engine rating of all parties.
- 5.7 The Respondent denies that the Complainant has registered trade mark rights in the term "Jag" and claims that no one has ever confused his website with that of the Complainant.
- 5.8 The Respondent also denies that he received any letter before action from the Complainant, claiming that various Jaguar employees have been aware of the website over the 11 years or so that it has been in operation. He also appears to contend that the operation of the website is not so important to him but he is concerned that if he loses these proceedings he will no longer be able to use the email address he has used for many years which incorporates the domain name.
- 5.9 The Respondent further asserts that if he wins the proceedings he "would be willing to sell the [Domain Name] to Jaguar at a reasonable cost to cover the work time and inconvenience of changing my personal email details with people and numerous organisations".

6. Discussions and Findings

General

- 6.1 The present case is procedurally unusual in that the Complaint was filed over two years ago in June 2016. It would appear that the reason for the delay in this proceeding to a decision is that there was a protracted but unsuccessful mediation process.
- 6.2 It follows from this that it is the previous versions of the Nominet Dispute Resolution Service Policy (the "Policy") and Dispute Resolution Service Procedure (the "Procedure"), rather than the current version of the policy, that applies to these proceedings.
- 6.3 To succeed under the Policy, the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).
- 6.4 Abusive Registration was defined in paragraph 1 of the Policy in the following terms:
- "Abusive Registration means a Domain Name which either:*
- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights;*
- OR*
- (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*
- 6.5 I will address each of the requirements of the Policy in turn, but it is first necessary to address the procedural issue of the Respondent's request that he be permitted to put in a supplemental submission to deal with issues raised in the Complainant's Reply.

The Respondent's Supplemental Submission

- 6.6 The Respondent has filed an explanatory paragraph pursuant to Paragraph 13b of the Policy as to why he might be permitted to file a supplemental submission. Paragraph 13b stated:
- “Any communication with us intended to be passed to the Expert which is not part of the standard process (e.g. other than a complaint, response, reply, submissions requested by the Expert, appeal notice or appeal notice response) is a ‘non-standard submission’. Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission. We will pass this explanation to the Expert, and the remainder will only be passed to the Expert at his or her sole discretion. If there is no explanation, we may not pass on the document or information.”
- 6.7 The Respondent wishes to submit a further submission addressing the Complainant's claim that the Respondent was sent a letter before action and various reminders in advance of these proceedings, and to address claims made in the Reply that he claims question his integrity and honesty.
- 6.6 I decline to receive that further submission. So far as pre-action correspondence is concerned, it was unhelpful that the Complainant only provided this in its Reply rather than in the Complaint. The sending of such a letter and the content of any reply is often part of the background to proceedings and an expert would ordinarily expect this as a matter of course to be included in any Complaint.
- 6.7 I also note that this letter was sent by email only rather than to any physical address, notwithstanding that at the time the proceedings were commenced, a physical address for the Respondent was available from the publically available Whois details for the Domain Name.
- 6.8 Therefore, I am prepared to assume in the Respondent's favour and without seeking or reviewing his supplemental submission in this regard, that he did not receive either the letter before action or the subsequent emails. If that is so, that is unfortunate. Nevertheless, it has no impact upon the ultimate outcome in this case.
- 6.9 So far as the Respondent's honesty and integrity are concerned (and leaving aside the submissions regarding pre-action correspondence that I have already dealt with), there is no real attack on this by the Complainant in the Reply. The Complainant adopted in its Complaint the usual language of abusive registration and unfair advantage found in complaints. But these are allegations to the effect that the registration and use of the Domain Name falls foul of the Policy, rather than (regardless of how the Respondent may

have interpreted this) any more of a personal attack on the Respondent's integrity. In any event, the claims in the Complaint have already been addressed by the Respondent in his Response. Accordingly, again, there is no good reason to consider any further submission from the Respondent in this respect and I decline to do so.

Complainant's Rights

- 6.10 I accept that the most sensible reading of the Domain Name is as the word "jag" combined with the word "racing" and the "co.uk", top and second level domains. Given this, I accept that the Domain Name is similar to the complainant's JAGUAR RACING registered trade mark. I am also prepared to accept that the Complainant has what is sometimes referred to as unregistered trade mark rights (i.e. rights enforceable under the English law of passing off) in the term "Jag" and that consequently the Domain Name is also similar to that term. It, therefore, follows that the Complainant has demonstrated that it owns Rights within the meaning of paragraph 2(a)(i) of the Policy.

Abusive Registration

- 6.11 There is a dispute between the parties as to whether the website that operated from the Domain Name was commercial in nature. The Respondent seeks to downplay the commercial aspects of the website, stating that his dealing in spares from that site has been minimal and that the commercial links were not for any commercial gain.
- 6.12 Panels have increasingly been prepared to tolerate a moderate degree of commercial activity in the form of advertising on what is otherwise a non-commercial site, such that a registrant can still claim that it is engaged in "legitimate non-commercial or fair use of the Domain Name", within the meaning of paragraph 4(a)(i) C. of the Policy (and the equivalent paragraph 8.1.1.3 of the more recent version of the Policy). However, this will depend upon the exact extent and nature of that commercial activity. In DRS 11271 (opticaexpressruinedmylife.co.uk) the Appeal Panel declared, in the context of advertising that generated £500 a month for a campaign website, as follows:

"The Respondent's campaign in relation to laser eye surgery comprises several elements, namely: (i) to highlight what she perceives as a problem; (ii) to advise or frighten off others intending to go down the non-essential eye surgery route; (iii) to provide assistance to those who have already suffered by going down that route; and (iv) to pressure politicians to introduce regulatory legislation covering those practising in the area. In the view of the Panel the advertisement in question and the website to which the advertisement refers fall fairly and squarely within element (iii), i.e. to enable those who have been

adversely affected to obtain assistance in the form of specialist legal advice.

Accordingly, there is nothing abusive about the advertisement per se or its inclusion as part of the Respondent's campaigning website. So the next question is whether the fact that the Respondent is receiving from the solicitors concerned £500 per month for the advertisement renders the advertisement an abusive use of the Domain Name.

The Panel cannot (nor does it seek to) lay down a hard and fast rule as to whether the receipt of advertising or other commercial revenue will render a registration which is being used in respect of what is otherwise a bona fide protest site, abusive. It is likely to be a question of fact and degree and need assessing on a case by case basis. Inevitably, there will be circumstances where an expert may reasonably come to the conclusion that charging for an advertisement or some other commercial link renders abusive what would otherwise be non-abusive. However, in this case the Panel adopts the view of both experts who have issued decisions in relation to the Domain Name to the effect that one must adopt a proportionate approach.

Where, as is the case here, the advertisement so naturally fits in with the Respondent's campaigning objective and the income received is relatively modest, and the Respondent is clearly expending very significant time and effort, and presumably at least some out of pocket costs, in promoting her campaign (including operating these websites), it would in the opinion of this Panel be unreasonable to brand this use of the Domain Name as abusive."

- 6.13 Even accepting the Respondent's contention that he did not personally gain from the advertisements appears on his website, I am of the view that the website in this case falls on the wrong side of the line, such that the Respondent's activities cannot be characterised as "legitimate non-commercial or fair use" within the meaning of paragraph 4(a)(i) C of the Policy. The advertisements in question here are not incidental banner advertisements. At the top of the home page is the text "HOME PAGE" and then in slightly smaller capital letters "PLEASE VISIT OUR PARTNERS" followed by a picture pointing to the advertisements. The further on in the text of the home page, but still prominently towards the top of the page is the text:

"JAGRACING highly recommend H.S. Fox Jaguar for new and used Jaguar Cars, who have dealerships in [various named locations].

- 6.14 So in substance, the Domain Name which is similar to the Complainant's marks is being used to prominently promote various businesses, some of which have a connection with Jaguar and some that do not.

- 6.15 Then there is the sale of spares. I am prepared to accept the Respondent's contention that the level of sales is minimal and only of unwanted used spares in his possession. The Complainant offers no real evidence to the contrary. Nevertheless, it is another factor that at least in a small way points away from a conclusion that there way from this being "legitimate non-commercial or fair use of the Domain Name".
- 6.16 However, even if I am wrong in my conclusions in relation to commercial use, the Complainant's case succeeds. The reason for this is that quite separately from the question of commercial use, in my view the Domain Name alone is inherently problematic.
- 6.19 Leaving aside the "co.uk" suffix, the Domain Name can be understood as either (a) the entirety of the Complainant's registered mark "Jaguar Racing", but with "Jaguar" being shortened to the more informal "Jag"; or (b) the Complainant's unregistered mark "Jag" to which has been added the word "Racing".
- 6.20 The extent to which it is legitimate to incorporate another's mark in a domain name to refer to activities (commercial or otherwise) associated with that mark is a question considered by the Appeal Panel in *Jaguar Land Rover Limited v Essex Jaguar Spares* DRS 18271 <essexjaguarspares.co.uk>.
- 6.21 As I stated (starting at paragraph 6.15) in *Pearson Plc v Locus Rags*, DRS19183:

"... The use of another's trade mark in a domain name without further adornment (save for the "co.uk" or "uk" suffix) is nearly always abusive as it likely to be viewed by the internet user as indicating a website that either belongs to or is authorised by the trade mark holder. As such its use will amount to an illegitimate impersonation. However, in the <essexjaguarspares.co.uk> case the appeal panel considered when and in what circumstances the addition of terms to that trade mark in a domain name that is used to promote the sales of goods or services associated with that trade mark might make the use of that domain name legitimate. In doing so the panel made a distinction between those additional terms that are insufficient to dispel a misleading impression of authorisation or connection with the trade mark owner and those additional terms that were sufficient to dispel that misleading impression so as to "take[] the domain name into the category of informative rather than misleading use of the [c]omplainant's trade mark".

... In that particular case the appeal panel suggested that the addition of the words "Essex" and "spares" to the trade mark "jaguar" was sufficient to make the domain name informative, but suggested that the use of "Essex" or "spares" alone was unlikely to do so. In reaching

that conclusion it also recognised that it was adopting a “more liberal view (for the registrant) as to where the line is to be drawn than has been applied in at least some previous DRS cases”.

- 6.22 Regardless of whether the decision of the appeal panel in <essexjaguarspares.co.uk> was too “liberal” and regardless of whether this is viewed as a case where part of the mark is removed, or a word is added to a mark, the differences between the Domain Name and the Complainant’s marks are insufficient to make it informative rather than misleading, and thereby prevent a finding of abusive registration. There is nothing in the Domain Name that signals to an internet user that it is unconnected with the Complainant’s business.
- 6.23 In <essexjaguarspares.co.uk>, the use made of the domain name was commercial. However, I believe the same considerations apply where the use made is non-commercial. It also appears to be broadly consistent with the approach panellists have taken in the past in relation to fan and criticism sites notwithstanding that paragraph 4 (b) of the Policy (and the equivalent paragraph 8.2 in its replacement) states that “fair use may include sites operated solely in tribute to or in criticism of a person or business”.
- 6.24 As paragraph 4.9 of the Expert Overview records:
- “The appeal decision in DRS 06284 (rayden-engineering.co.uk) confirmed the consensus view among experts today that the nature of the domain name is crucial to the exercise. A criticism site linked to a domain name such as <lhateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant”
- 6.25 The Domain Name in this case is essentially not that different from <Complainant.co.uk> and as such is abusive. It, therefore, follows that the Complainant has demonstrated in accordance with paragraph 2(a)(i) of the Policy that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

- 7.1 I, therefore, find that the Complainant has Rights in a name which is similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed

Matthew Harris

Dated 4 July 2018