

DISPUTE RESOLUTION SERVICE

D00019925

Decision of Independent Expert

Arnold Clark Automobiles Limited

and

Whois Foundation

1. The Parties:

Complainant: Arnold Clark Automobiles Limited
134 Nithsdale Drive
Glasgow
G41 2PP
United Kingdom

Respondent: Whois Foundation
Ramon Arias Avenue, Ropardi Building, Office 3-C
PO Box 0823-03015
Panama City
0823
Panama

2. The Domain Name:

arnoldclar.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

05 March 2018 13:13 Dispute received
06 March 2018 11:07 Complaint validated
06 March 2018 11:16 Notification of complaint sent to parties
09 March 2018 16:58 Response received
09 March 2018 16:58 Notification of response sent to parties
13 March 2018 11:26 Reply received
13 March 2018 11:31 Notification of reply sent to parties
13 March 2018 11:37 Mediator appointed
14 March 2018 17:25 Mediation started
14 March 2018 17:25 Mediation failed
14 March 2018 17:25 Close of mediation documents sent
15 March 2018 18:00 Expert decision payment received

4. Factual Background

Founded in 1954, the Complainant operates over 200 new and used car dealerships throughout the United Kingdom. The Complainant is the proprietor of UK registered trademarks No. 2103334 for the stylised mark ARNOLD CLARK, registered on April 4, 1997 in classes 36, 37 and 39 and No. 2300325 for the word mark ARNOLD CLARK, registered on December 13, 2002 in class 35.

The Domain Name was registered on June 1, 2017. As at March 5, 2018 it resolved to a website displaying pay-per-click advertisements for cars, new and used. At the foot of the home page appeared the following statement in fine print, to which I shall refer as the Disclaimer:

“The Sponsored Listings displayed above are served automatically by a third party. Neither the service provider nor the domain owner maintain any relationship with the advertisers. In case of trademark issues please contact the domain owner directly (contact information can be found in whois).”

5. Parties’ Contentions

The Complainant submits that it has Rights which are similar to the Domain Name in terms of Paragraph 2.a.i of the DRS Policy and that the Domain Name is Abusive for the following reasons:

- Confusing people or businesses per Paragraph 5.1.2 [mistakenly described in the Complaint as 5.1.1.2], specifically in relation to initial interest confusion;
- Unfairly disrupting the business of the Complainant per Paragraph 5.1.1.3, in relation to the display of third-party advertising;
- A pattern of registrations per Paragraph 5.1.3; and
- There are no factors showing the Domain Name is not an Abusive Registration.

The Respondent says it is a foreign company which owns a portfolio of generic and descriptive domain names which it acquired through lawful and fair methods. As part of its business practice, it has a well-known dispute resolution policy whereby it

invites putative complainants to contact it regarding domain names that complainants believe violate a trademark. It also has a liberal transfer policy whereby it typically agrees voluntarily to transfer domain names, irrespective of the legitimacy of the complainant's arguments, in an effort to avoid the needless time and expense associated with litigation and administrative hearings. Transfers are typically done within one business day.

The Respondent says it was unaware of the Complainant or its marks. The Domain Name on its face appears to be a simple name and a bulk registrant would not have known it was (allegedly) associated with a protected trademark.

Upon learning of this matter the Respondent contacted the Complainant to offer a voluntary transfer of the Domain Name. The Complainant refused this offer.

Therefore, without admitting fault or liability and without responding substantively to the allegations raised by the Complainant, to expedite this matter for the Panel so that its time and resources are not otherwise wasted on this undisputed matter, the Respondent stipulates that it is willing voluntarily to transfer the Domain Name to the Complainant.

The Respondent cites numerous Uniform Domain Name Dispute Resolution Policy (UDRP) decisions in which Panels have consistently ruled that when a complaint has been filed and the respondent consents to the transfer of the domain name, it is inappropriate to issue any decision other than simply ordering the transfer of the domain name and that it would be improper to issue any findings of fact in such cases.

The Respondent recognizes that the Complainant has specifically requested the Panel reach a decision on the merits. But, as recognized by other Panels, it is actually "unwise" to do so in an administrative proceeding where the presentation of evidence is limited (e.g., declarations, unlike live testimony, cannot be tested in the crucible of cross-examination). Both judicial efficiency and judicial wisdom counsel the Panel to order the transfer without an evaluation of the merits.

Accordingly, the Respondent requests that the Domain Name be transferred to the Complainant without further findings of fact or liability.

In its Reply, the Complainant opposes the Respondent's request, contending that it is misconceived and appears to be based upon certain authorities under the UDRP. Reference is made to the Foreword to Version 3 of the Expert Overview which observes:

“Finally, it should be stressed for the benefit of those who have had experience of domain name disputes under the Uniform Domain Name Dispute Resolution Policy (“UDRP”), that the DRS Policy and the UDRP are different systems. In some places they share very similar wording, but there are significant differences and the citation of UDRP decisions in a dispute under the DRS Policy is rarely likely to be helpful.”

In section 5.14 of the Expert Overview which relates to the ‘Respondent’s consent to transfer’ it is noted that a respondent may inform the complainant that he is willing to

transfer a domain name to a complainant without charge, noting that if a complainant agrees to accept the domain name on this basis there is a suitable procedure to be followed. The section adds that “If, however, the Complainant insists on a decision and pays the prescribed fee, the papers will be sent to an Expert for a decision”.

The Complainant contends that it is entitled to a full decision regardless of the terms of the Response, provided that the Complainant pays for this in accordance with section 13 of the DRS Policy. Such decision requires to be a reasoned decision in writing which determines the admissibility, relevance, materiality and weight of the evidence in accordance with sections 18.4 and 24.3 of the DRS Policy respectively. If the Respondent’s request were allowed (assuming the Complainant is able to prove the element of Abusive Registration) the Respondent would thereby be able to evade and subvert the terms of section 5.3 of the DRS Policy regarding a presumption of Abusive Registration where a respondent has been found to have made an Abusive Registration in three or more DRS cases in the last two years.

On the question of whether the Respondent may ultimately be a repeat offender under the DRS and may therefore be seeking to subvert the terms of section 5.3 of the Policy, the Complainant says the Respondent has made an identical request in at least three separate live cases under the DRS Policy in which the complainants have been represented by the same agent. These are DRS 19893 (<aainsuranceservices.co.uk>, <aaroutelanner.co.uk>, <aaroutemaps.co.uk>, <theaaroutfinder.co.uk> and <theaatyres.co.uk>); DRS 19869 (<cragghopper.co.uk> and <wwwcraghoppers.co.uk>) and the present matter DRS 19925 (<arnoldclar.co.uk>).

Assuming findings of Abusive Registration are made in at least two of such cases, section 5.3 of the Policy would be engaged in future cases involving the Respondent and would not be so engaged if the Respondent’s request were granted. One finding of Abusive Registration has already been made against the Respondent in DRS 19551 (<hdmrc.co.uk>, <hmrc-onllnes.co.uk>, <hmrcsubmitareturn.co.uk>, and <hmrc-tx.co.uk>) such that only two further findings are required to engage section 5.3 of the Policy.

Beyond the Respondent’s request discussed above, the Complainant observes that there are no substantive issues raised by the Response which require further comment from the Complainant. The Respondent has not advanced any counter or explanation in relation to any of the Complainant’s arguments on Abusive Registration, nor does it seek to rely on any of the potentially exculpatory factors set out in section 8 of the DRS Policy.

6. Discussions and Findings

As to the Respondent’s request that the Domain Name be transferred to the Complainant without further findings of fact or liability, Paragraph 5.3 of the DRS 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 8.1.4 and 8.3).”

The UDRP has no equivalent provision. Accordingly I regard the UDRP cases on which the Respondent relies as irrelevant and I find, for the reasons advanced by the Complainant, that it is appropriate for me to render a reasoned decision on the merits, to which I now turn.

I note that the Respondent had the opportunity to respond to the substance of the Complaint but chose to limit its Response to its request for transfer without findings of fact or liability. Under these circumstances I do not consider it necessary or appropriate to give the Respondent a further such opportunity.

To obtain an order for the transfer of the Domain Name, the Complainant needs to show, on the balance of probabilities, that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration (DRS Policy, Paragraph 2).

As to Rights, the Domain Name <arnoldclar.co.uk> differs by only one letter, a difference which could easily arise from mistyping, from the name ARNOLD CLARK, in which the Complainant has shown that it has registered trademark rights. The inconsequential ccTLD suffixes “.co.uk” may be disregarded. I find that the Domain Name is similar to the Complainant’s mark.

As to Abusive Registration, the DRS Policy, Paragraph 5.1 sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Complainant invokes the following:

5.1.1.3: Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating 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;

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

As to Paragraph 5.1.1.3, the Complainant avers that the Domain Name is unfairly disrupting its business. However, the fact of any such disruption does not necessarily indicate that the Respondent registered the Domain Name primarily for that purpose. Here it is common ground between the parties that the Respondent, with an address in Panama, has registered many thousands of domain names and the Response refers to “bulk” registration. Under these circumstances I am not persuaded that the

Respondent had the Complainant or its mark in mind when registering the Domain Name nor that its primary purpose in registering the Domain Name was to disrupt the Complainant's business.

As to Paragraph 5.1.2, Paragraph 8.5 provides:

“Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:

- 8.5.1 the nature of the Domain Name;
- 8.5.2 the nature of the advertising links on any parking page associated with the Domain Name; and
- 8.5.3 that the use of the Domain Name is ultimately the Respondent's responsibility.”

The Complainant has demonstrated that the Domain Name is being used to resolve to a website displaying advertising links relating to the kind of business carried on by the Complainant. I find that this 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.

The Disclaimer cannot override the DRS Policy, Paragraph 8.5.3, which clearly places responsibility for those advertising links on the Respondent. Accordingly, I find that the Complainant has shown that, in the hands of the Respondent, the Domain Name is an Abusive Registration in terms of DRS Policy, Paragraph 5.1.2.

As to Paragraph 5.1.3, the Complainant says the Respondent is the registrant of some 46,923 domain names in the .uk space, a number of which appear to incorporate third-party rights which are not associated with the Respondent. The following ten examples are given, all of which resolve to pay-per-click advertising like that associated with the Domain Name.

Domain name	Relates to trademark / Jurisdiction & number	Trademark owner
bankofscotland.co.uk	BANK OF SCOTLAND,EUTM 4622	Bank of Scotland PLC
cathkindston.co.uk	CATH KIDSTON, EUTM 2670412	Cath Kidston Limited
debehnhams.co.uk	DEBENHAMS, EUTM 66720	Debenhams Retail PLC
frestylelibre.co.uk	FREESTYLE LIBRE, EUTM 12071833	Abbott Diabetes Care Inc.
gatwuckairport.co.uk	GATWICK AIRPORT, UK 2375633	Gatwick Airport Limited
jet2holdiays.co.uk	JET2 HOLIDAYS, EUTM 4551875	Jet2.com Limited
karenmilleen.co.uk	KAREN MILLEN, EUTM 814038	Karen Millen Fashions Limited
laredooute.co.uk	LA REDOUTE, EUTM 659151	La Redoute

majeticwine.co.uk	MAJESTIC WINE EUTM 14921373	Majestic Wine Warehouses Limited
nationalexoress.co.uk	NATIONAL EXPRESS EUTM 841023	National Express Limited

The Complainant says these examples demonstrate that the Respondent engages in registering domain names closely related to third-party marks and monetises the associated websites. The Domain Name is being used in the same manner and is therefore part of that pattern.

I find that “arnoldclar” is not based on dictionary words nor on random strings. Rather it is clearly derived from a proper name, which must have been chosen for some reason. As in the ten examples above, the Complainant’s well-known business is the most likely reason.

The Complainant has demonstrated that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which, but for inconsequential mistyping, correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern. Accordingly, the Complainant has shown that, in the hands of the Respondent, the Domain Name is an Abusive Registration in terms of DRS Policy, Paragraph 5.1.3.

7. Decision

I direct that the Domain Name <arnoldclar.co.uk> be transferred to the Complainant.

Signed

Dated April 5, 2018