

DISPUTE RESOLUTION SERVICE

D00017102

Decision of Independent Expert

Jaguar Land Rover Limited

and

RGB Landrovers

1. The Parties:

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

Respondent:
RGB Landrovers
Rearlands Farm
Chivers Road
Stondon Massey
Brentwood
Essex
CM15 0LJ
United Kingdom

2. The Domain Name:

rgblandrovers.co.uk

3. Procedural History:

3.1 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.

3.2 Timeline

17 February 2016 11:43 Dispute received
18 February 2016 08:50 Complaint validated
18 February 2016 08:54 Notification of Complaint sent to Parties
08 March 2016 01:30 Response reminder sent
11 March 2016 09:39 Response received
14 March 2016 11:00 Notification of Response sent to Parties
22 March 2016 08:56 Reply received
22 March 2016 09:04 Notification of Reply sent to Parties
22 March 2016 09:04 Mediator appointed
29 March 2016 09:46 Mediation started
25 April 2016 11:45 Mediation failed
25 April 2016 11:45 Close of mediation documents sent
05 May 2016 15:32 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is a company incorporated in the United Kingdom. It manufactures a range of motor vehicles and operates from its two engineering centres at Whitley in Coventry and Gaydon in Warwickshire, its manufacturing plants in Castle Bromwich and Halewood near Liverpool and its recently opened engine production site in Wolverhampton. The Complainant employs over 25,000 people in the UK.
- 4.2 The Complainant operates through a network of authorised dealers selling its new and approved used cars. It also provides a range of services for the same, including financial, insurance, repair and maintenance services.
- 4.3 The Complainant's two main brands are JAGUAR and LAND ROVER.
- 4.4 The Complainant is the owner of a UK trade mark registration for the mark LAND ROVER in class 12, dated 11 October 1947, and a EU trade mark registration for LAND ROVER in a number of classes, dated 1 April 1996.
- 4.5 The Complainant is also the owner of the domain names <land-rover.com>, <landrover.com> and <landrover.co.uk>.

- 4.6 The Respondent operates a business under the name RGB Land Rovers. The Respondent registered the Domain Name on 22 January 2007. The Domain Name resolves to a website hosted under the domain name <rgb4x4.com>.
- 4.7 A screenshot of the Respondent's website at www.rgb4x4.com taken on 17 February 2016 is exhibited to the Complaint at Annex 3. It displays text explaining the nature of the Respondent's business in relation to the Complainant's Land Rover vehicle range, pictures of Land Rover vehicles and links to the various services the Respondent provides, including a link which states "Landrovers wanted".

5. Parties' Contentions

This section summarises the main contentions of the Parties.

The Complainant

Rights

- 5.1 The Complainant is a globally renowned manufacturer of premium saloons and sports cars, sports utility vehicles and all-wheel drive vehicles, based in the Midlands region of England.
- 5.2 The first Land Rover vehicle was launched by the Rover Company at the Amsterdam Motor Show in April 1948 and today the current Land Rover vehicle range includes the models Land Rover Defender, Land Rover Discovery and Land Rover Freelander.
- 5.3 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.
- 5.4 The Complainant owns, amongst others, the following trade marks and domain names:
- UK trade mark number 663199 LAND ROVER in class 12, dated 11 October 1947
 - EU trade mark number 143644 LAND ROVER in classes 2, 6, 7, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 22, 24, 25, 26, 27, 28, 34, 36, 37, 39 and 41, dated 1 April 1996
 - <land-rover.com>
 - <landrover.com>
 - <landrover.co.uk>
- 5.5 Furthermore, the trade mark LAND ROVER has acquired extensive goodwill and a substantial reputation throughout the UK, the EU and

the world. As a result, LAND ROVER is a very well-known mark in these territories.

Similarity

- 5.6 The dominant element of the Domain Name is the term LAND ROVER which is the Complainant's trade mark. The remainder of the Domain Name are the letters "rgb" and the domain suffix ".co.uk".
- 5.7 The Domain Name is therefore identical or closely similar to the Complainant's LAND ROVER mark.

Abusive Registration

- 5.8 The Domain Name was registered on 22 January 2007, a significant number of years after the commencement of the Complainant's rights in the mark LAND ROVER (which date back to 1947). The Respondent would, therefore, have been fully aware of the Complainant's rights in this mark at the time of registration of the Domain Name.
- 5.9 The Respondent is using the Domain Name to direct internet users to a commercial website hosted at the domain name <rgb4x4.com>.
- 5.10 This website www.rgb4x4.com promotes and provides vehicle servicing and repair services, the retail of spare parts for vehicles and the retail of vehicles themselves. All of these services relate to vehicles in the Complainant's vehicle range.
- 5.11 The use of a domain name containing the mark LAND ROVER to direct internet users to any website, is to suggest the domain name is in some way connected to the Complainant. The addition of the letters "rgb" merely suggests to internet users that the Domain Name is not hosted by the Complainant themselves but that it is hosted by one of its authorised dealers or representatives, which is not the case with respect to the Domain Name.
- 5.12 Such use is deliberate and takes unfair advantage of the Complainant's trade mark rights in LAND ROVER by trading off the back of the reputation in the Complainant's LAND ROVER trade mark and exploiting the goodwill and prestige that the Complainant has spent considerable time, effort and money to build up.
- 5.13 Further, the use of the Complainant's trade mark in this way is misleading to the consumers who visit the website to which the Domain Name resolves, as upon seeing the Complainant's trade mark, the consumer associates the same as being a mark of quality and therefore, the Respondent's use of the Domain Name is to take advantage of this.

- 5.14 Use of the Domain Name in this way by the Respondent is likely to cause confusion on the part of internet users as they are likely to believe that they have been directed to a website which is connected or associated with the Complainant, or which is authorised by the Complainant, which is not the case.
- 5.15 There appears to be no need for the Respondent to use the Domain Name as he hosts his website at the domain name <rgb4x4.com>. The only reasons to use a domain name containing the Complainant's LAND ROVER trade mark are to trade off the reputation and goodwill that the Complainant has built up in the LAND ROVER trade mark and to suggest an association with, or the endorsement of, the Complainant.
- 5.16 Furthermore, some internet users are unlikely to notice that they have been re-directed to a different domain name and consequently are likely to believe they are visiting a website of one of the Complainant's genuine dealerships.

The Respondent

- 5.17 The Response contains very little information on the nature of the Respondent's business. However, the Respondent says that he started the business of RGB Land Rovers in 1989 and the Complainant says that the website to which internet users are directed to from the Domain Name promotes a business which provides various services relating to vehicles in the Complainant's vehicle range, namely vehicle servicing and repair services, the retail of spare parts for vehicles and the retail of vehicles themselves (as evidenced by a screenshot of the home page of this website, which is attached to the Complaint). The Respondent says that wherever possible he uses genuine parts and on average he says that he spends between £10,000 to £20,000 per year with Lookers in Chelmsford, Essex.
- 5.18 As a sole trader the Respondent cannot understand how he could be competition to a public limited company like the Complainant. He says that in the past the previous owners of the Complainant, namely Ford and BMW, did not complain about him using the name RGB Land Rovers.
- 5.19 The Respondent claims that ".co.uk" domain names containing the term LANDROVER are still able to be bought and that the Complainant is not taking action against those that do so and who do not use any genuine Land Rover parts.
- 5.20 If the Respondent has to stop using the Domain Name (which he says he purchased in good faith) he will be put out of business due to him not being able to use the term LANDROVER in his domain name and on Google AdWords. He says that he has already changed his invoices and bank details from RGB Landrovers to rgb.co.uk.

The Reply

- 5.17 The fact that the Respondent purchases genuine Land Rover products from an authorised Land Rover retailer does not provide the Respondent with the right to use the Complainant's trade mark LAND ROVER in a domain name to promote his business. The authorised retailer in question, Lookers, does not use the LAND ROVER mark in its domain name. This demonstrates that the Respondent does not need to use the LAND ROVER trade mark in a domain name to promote his business.
- 5.18 In addition, by stating that he has only used genuine parts where he could, the Respondent has indicated that he has not always purchased and sold parts originating from the Complainant, and therefore he has used the Complainant's trade mark to sell products other than those which are genuine Land Rover products.
- 5.19 The Respondent has provided no evidence that Ford and BMW did not have a problem with him using the name "RGB Landrovers" and the Complainant disputes such claim. Further, the Respondent has no knowledge as to what other proceedings the Complainant is involved in.
- 5.20 The Respondent has made it clear that he is using the Complainant's LAND ROVER trade mark in the Domain Name to trade off the reputation and goodwill of the Complainant. The fact that the Respondent has ceased using Land Rover in other areas of his business is irrelevant to these proceedings.
- 5.21 The Respondent has provided no evidence of his claim that he purchased the Domain Name in good faith.

6. Discussions and Findings

General

- 6.1 The Complainant is required under paragraph 2(b) of the Policy to prove to the Expert, on the balance of probabilities, that:
- (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

- 6.2 Paragraph 1 of the Policy provides that Rights means "*rights enforceable by the Complainant, whether under English law or*

otherwise, and may include rights in descriptive terms which have acquired a secondary meaning". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

- 6.3 The Complainant is the owner of trade mark registrations for the word mark LAND ROVER in at least the UK and as a EU trade mark, both of which predate the registration date of the Domain Name by a number of years. It is also the owner of various domain names which incorporate the LAND ROVER mark.
- 6.4 Further, the mark LAND ROVER has been used extensively in the Complainant's activities in the UK and elsewhere over many years (a fact not disputed by the Respondent), and as such the Complainant has acquired extensive goodwill and substantial reputation in this mark.
- 6.5 Consequently, I find that the Complainant has Rights in respect of the well-known mark LAND ROVER.
- 6.6 The only differences between the Domain Name (ignoring the space between the words LAND and ROVER (an element which is not possible to replicate in a domain name) and the generic .co.uk top level suffix) and the mark in which the Complainant has Rights are (i) the addition of the letters "rgb" as a prefix to the Complainant's mark and (ii) the addition of the letter "s" at the end of the Complainant's mark. I consider these elements to be non-distinctive and they do not materially distinguish the Domain Name from the mark in which the Complainant has Rights. The dominant element of the Domain Name is the term LANDROVER, being the mark in which the Complainant has Rights and such mark is incorporated into the Domain Name in its entirety.
- 6.7 I therefore find that the Complainant has established that it has Rights in respect of a name or mark which is similar to the Domain Name and accordingly the Complainant has satisfied the first limb of the Policy.

Abusive Registration

- 6.9 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. has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

- 6.10 Paragraph 3 of the Policy sets out a non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may be evidence that the Domain Name is not an Abusive Registration.
- 6.11 The Policy provides for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

Abusive Registration under Paragraph 1(i) of the Policy

- 6.12 Paragraph 3(a)(i) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under paragraph 1(i) of the Policy, as follows:

“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

- A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*
- B. as a blocking registration against a name or mark in which the Complainant has Rights; or*
- C. for the purpose of unfairly disrupting the business of the Complainant;”*

- 6.13 The determining question in this case is whether the incorporation of a trade mark in which the Complainant has rights into a domain name by an independent, unauthorised retailer trading in, inter alia, goods and services which relate to the Complainant constitutes an Abusive Registration.
- 6.14 This particular issue has been examined in numerous decisions under the DRS. In the decision of the Appeal Panel in the case of *Toshiba Corporation v Power Battery Inc.*, DRS 07991, the Appeal Panel helpfully summarised the relevant considerations in cases under the Policy involving resellers/distributors of a complainant’s products. The summary was based on principles which the Panel identified in two previous Appeal Panel decisions, namely *Epson Europe BV -v- Cybercorp Enterprises*, DRS 03027, and *Seiko UK Limited -v- Designer Time/Wanderweb*, DRS 00248. These are as follows:-
- 1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.

2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant. □
3. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.

6.15 Applying these four considerations to the present case:

- The Domain Name incorporates in its entirety the Complainant's well-known and distinctive mark LAND ROVER. The Respondent does not deny the Complainant's assertion that he was aware of the Complainant and its LAND ROVER mark when he registered the Domain Name. Further, the Complainant's Rights pre-date the date of registration of the Domain Name by a significant number of years. Finally, the services provided by the Respondent as advertised and promoted on his website relate to vehicles in the Complainant's LAND ROVER range. All of this strongly suggests that the Respondent was well aware of the Complainant and its LAND ROVER mark when he registered the Domain Name. □
- The Domain Name resolves to a website, the home page of which displays text promoting goods (spare parts) and services (maintenance and service) relating to the Complainant's LAND ROVER vehicle range and pictures of various LAND ROVER vehicles. There is nothing on that home page which makes it clear to the internet user that has arrived at that page that the operator of the site and the underlying business (namely, the Respondent) has no commercial connection with the Complainant and is in fact wholly independent of, and not authorised by, the Complainant.
- The letters "rgb" as a prefix and "s" as a suffix to the Complainant's mark in the Domain Name do not make it clear that any website operating under the Domain Name would in fact have no authorised connection with the Complainant and/or its authorised dealer network. To put it another way, the Domain Name itself is, in my opinion, likely to give Internet users the impression that any website operated under it is either operated, or at least authorised, by the Complainant.
- In any event, given the fact that the Domain Name incorporates in its entirety the Complainant's well-known and distinctive mark LAND ROVER (and only differs from the Complainant's mark by the inclusion of the non-distinguishing prefix "rgb" and the suffix "s") it does not matter for the purposes of assessing confusion under the Policy that

any visitor who reaches a website linked to the Domain Name may then realise that it is not a website operated by the Complainant or someone authorised by the Complainant. To quote from the Expert's Overview:

“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site “operated or authorised by, or otherwise connected with the Complainant.” This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.”

- In light of the above and the facts of this case based on the submissions before me, I consider that initial interest confusion in this case is likely. There is a close similarity between the Domain Name and the Complainant's well-known LAND ROVER mark, and the Domain Name contains no clear distinguishing factors to make it immediately apparent to internet users that it is not in fact connected with the Complainant. It is therefore likely that some Internet users visiting the Respondent's website will be visiting it in the expectation that it is a website which is operated or authorised by, or otherwise connected with the Complainant (for example, a website operated by one of the Complainant's authorised dealers).
- In relation to the fourth consideration as set out by the Appeal Panel in the *Toshiba* case, and in particular when addressing whether it would be fair to offer competing goods, the Panel said the following:

“The further issue, however, is whether the fact of offering competitive products on the Respondent's website is sufficient to render the registration abusive, even in the absence of “initial interest confusion”. On this question, the Panel unanimously considers that, if and insofar

as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner's consent, to accord with the principles stated above that fairness is likely to be dependent upon the retailer only selling the trade mark owner's genuine products. To do so otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent. This element of unfair advantage remains, even where there little or no detriment to the Complainant has been demonstrated."

- In this regard, although the homepage of the website to which the Domain Name resolves does not display or provide for the sale of competing goods to those of the Complainant (the only goods offered by the Respondent on the website appear to be spare parts for Land Rover vehicles), the Respondent says in his Response that he uses genuine parts of the Complainant where possible. I accept that this could imply, as the Complainant asserts, that the Respondent does not always sell genuine products of the Complainant and may in fact be providing goods which compete with goods manufactured and/or provided by the Complainant (or its authorised entities).
- However, even if the Respondent could be said to be selling genuine goods of the Complainant under the Domain Name (in particular only genuine parts for the Complainant's LAND ROVER vehicles and nothing else), the Respondent could not be said to be providing genuine services of the Complainant under the Domain Name. The services promoted by the Respondent on the home page of his website in relation to the service and maintenance of LAND ROVER vehicles are very likely to compete with those provided by the Complainant and/or its authorised dealers, and the Complainant has not authorised the Respondent to provide those services using a domain name which incorporates, in its entirety, the Complainant's LAND ROVER mark.
- I am assisted in this regard by the decision of the Appeal Panel in *World Wrestling Entertainment, Inc. –v- Daniel Raad*, DRS 16416, where the Panel identified seven principles (expressed as not absolute rules) to determine whether a domain name used to sell only the genuine goods or services of the Complainant could be said to be an Abusive Registration. Pursuant to these principles, where the use of the Complainant's name or mark in which it has Rights is "adorned" (ie a domain name which incorporates not only the Complainant's mark but also extra terms), then where those extra terms result in a domain name which would readily be considered to be that of the owner of the name or mark concerned, the domain name is likely to amount to an Abusive Registration.
- The overall composition of the Domain Name in this case would on the balance of probabilities be taken by those seeking the goods or services of the Complainant to have some authorised connection with the Complainant. There is nothing in the Domain Name which makes it apparent that any website operated under it would have no authorised

connection with the Complainant, for example use of the word “independent” or some other term which makes it clear no such connection exists.

- In addition, I note that the Respondent uses the Domain Name to redirect internet users to a website operated under the domain name <rgb4x4.com>. This domain name does not incorporate the Complainant’s mark and therefore has no immediate connection to or with the Complainant.
- 6.16 I therefore find that the Respondent is using the Domain Name in a manner which takes unfair advantage of the Complainant’s Rights in its LAND ROVER mark.
- 6.17 Finally, I note that the Complainant has brought its Complaint more than nine years after registration of the Domain Name by the Respondent. Although the issue of delay has not been raised by the Respondent in this case, I will for completeness briefly consider it.
- 6.18 The issue of delay generally was considered in the case of *Lucasfilm Ltd., LLC –v- ABSCISSA.COM Limited*, DRS 15788 where the Appeal Panel stated the following:

“As a starting point in relation to this issue the Panel notes that the Policy itself says nothing about delay, nor does it contain any provisions requiring a Complaint to be brought within a specific time limit after the date of registration of a domain name. The Expert’s Overview also contains no guidance on this issue. The Panel also notes that as a matter of English law delay per se would not prevent an action to restrain ongoing acts of trade mark infringement (footnote “Delay may however act as a bar for damages in respect of events which occurred prior to the relevant limitation period.”). Whilst a Complaint under the Policy is not the same as an allegation of trade mark infringement it does seem to the Panel that the same broad approach to delay is desirable. It would be undesirable for the Policy to be applied in such a way as to preclude a complaint purely on the basis of delay, if the effect was to force the Complainant to undertake litigation in relation to the same set of facts, and where the litigation was not barred by delay. The circumstances in which delay and other related considerations may operate as a defence to litigation are considered further below. Overall however the Panel considers that, where the use complained of is ongoing, then delay alone should not automatically preclude a complaint being brought.

It is nevertheless the case that the list of factors which may lead to a finding that a domain name is not an Abusive Registration, as set out in paragraph 4 of the Policy, is said to be non-exhaustive. The Panel concludes that in principle, depending upon the relevant facts, this means that it is open to the Panel to reach a finding that whilst delay does not automatically bar an action, delay in a specific case might be such as to mean that an otherwise Abusive Registration is acceptable.

Whether in the particular circumstances of a given case that is the position would depend upon individual facts.

This approach seems to the Panel consistent with that adopted in Emirates v. Michael Toth (DRS 08634), an appeal decision concerning the Domain Name <emirates.co.uk>. In that case the Panel stated:

“The Panel accepts that there may be a case for delay or acquiescence amounting to a defence to a complaint under the Policy but is not at all satisfied that this is such a case. The delay is not such as to prejudice the proper consideration of the issues. Even if the Respondent could properly claim to have acted on the assumption that the Complainant had no objection to his registration and use of the Domain Name, we do not consider that he has suffered any unfair prejudice as a result of the delay. As we have found, he cannot be said to have developed a proper business under the Domain Name or a “genuine offering of goods or services” in the sense of paragraph 4aiA of the Policy. Rather, its use has been for click-through traffic and as a place holder for a valuable domain name. The Panel finds that the Respondent has not in reality developed a business under the Domain Name in the belief that the Complainant had no objection to his using it or with the encouragement of the Complainant.”

- 6.19 As noted above, the Respondent has not raised the issue of delay in arguing that the Complaint should not succeed. Further, the Respondent uses the Domain Name to simply redirect Internet users to a website which is operated under the domain name <rgb4x4.com>. He admits that he has also changed his trading name to rgb.co.uk on his invoices and bank details. With these factors in mind, I do not consider that the delay has in any way unfairly prejudiced the Respondent’s ability to advance its case, in particular its case in relation to the second limb of the Policy. From the Respondent’s own actions, as described above, it should be relatively straightforward for the Respondent to continue to use the domain name <rgb4x4.com> for the same purpose of his existing business should he wish to do so.
- 6.20 In light of the above, I find that, on the balance of probabilities, the Domain Name is being used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant’s Rights and therefore that the Domain Name, in the hands of the Respondent, is an Abusive Registration. □

7. Decision

- 7.1 The Complainant has established that it has Rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration.

7.2 Accordingly, the Complaint succeeds and I direct that the Domain Name <rgblandrovers.co.uk> be transferred to the Complainant.

Signed Ravi Mohindra

Dated 30 May 2016