



DISPUTE RESOLUTION SERVICE

D00017548

Decision of Independent Expert

Renault UK Limited

and

Terry Brown

1. The Parties:

Complainant: Renault UK Limited
The Rivers Office Park
Denham Way Maple Cross
Rickmansworth
Hertfordshire
WD3 9YS
United Kingdom

Respondent: Terry Brown
33 White Hart Lane
HOCKLEY
Essex
SS5 4DQ
United Kingdom

2. The Domain Name(s):

renaultkeycards.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 in to question my independence in the eyes of one or both of the Parties.

15 June 2016, the Dispute was received.

16 June 2016, the Complaint was validated.

16 June 2016, the notification of the Complaint was sent to the Parties.

05 July 2016, the Response reminder was sent.

08 July 2016, the Response was received.

08 July 2016, the notification of the Response was sent to the Parties.

13 July 2016, the Reply reminder was sent.

13 July 2016, the Reply was received.

13 July 2016, the notification of the Reply was sent to the Parties.

13 July 2016, a Mediator was appointed.

18 July 2016, Mediation was started.

04 August 2016, Mediation failed.

04 August 2016, the close of Mediation documents were sent.

11 August 2016, the Expert decision payment was received.

4. Factual Background

4.1 The Respondent registered the Domain Name on 31 January 2013.

4.2 The Complainant is a UK company which, among other things, provides goods and services in relation to vehicle sales, vehicle rentals and the provision of vehicle maintenance and repair services.

4.3 The Complainant is a subsidiary of Renault SAS and Renault SAS is the registered owner of a number of UK and Community trade marks in respect of the word "**RENAULT**" ('**Name**') and the diamond emblem device mark (collectively the '**Marks**') (e.g. UK trade mark 00000695493, Community trade mark 000089763). The Complainant is a licensee of the Renault SAS Marks.

5. Parties' Contentions:

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the

Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

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

The Complainant's Rights

- The Complainant submitted that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- The Complainant contended that *“for many years and continuously since registration of the [...] Marks, Renault has used the [...] Marks in the UK in relation to vehicle sales, vehicle rentals and the provision of maintenance and repair services, amongst others.”*
- Further, the Complainant stated that the Marks have also *“featured in numerous advertising campaigns in the United Kingdom. Each year Renault spends millions of pounds on such advertising.”*
- The Complainant submitted that the Marks have acquired a highly distinctive character in relation to vehicle sales, vehicle rentals and the provision of maintenance and repair services, amongst others, and there is considerable reputation and goodwill in the Marks in the United Kingdom.

Abusive Registration

- The Complainant submitted that the Domain Name, in the hands of the Respondent, is an Abusive Registration as the Domain Name has been used and/or was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- The Complainant submitted that the Domain Name is an Abusive Registration as, despite not being authorised by Renault to do so, the Domain Name uses the word "Renault" and displays the diamond emblem device mark on the website attached to the Domain Name.
- The Complainant submitted that the Respondent's unauthorised use of the Marks for the same goods and services for which the Marks are registered constitutes *“an infringement of Renault's registered Trade Marks.”* The Complainant further submitted that the use of the Domain Name *“is an act of infringement that is likely to cause confusion in the minds of the public, by an association with the [...] Marks”* and takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Mark.

- The Complainant further submitted that the use of the Marks also amounted to passing off.
- The Complainant submitted that, given that “Renault” is a well known brand, the use of the Marks by the Respondent in this context is likely to cause confusion in the minds of the public as to the status of the relationship between the Respondent and the Complainant.
- The Complainant explained that it wrote to the Respondent “on 8 April 2016 to the address named on the “Who Is” result as the registrant’s address, but these letters were returned” but that its legal representatives spoke to the Respondent on 19 April 2016.

Respondent’s Response

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

- The Respondent stated that he offers “an aftermarket solution for the repair and programming of key cards on a national basis” and that all of his customers “know and realise [that he is] an after market solution.”
- The Respondent stated that the “dealers [...] advise [him that] the [Complainant] do[es] not repair Renault key cards.”
- The Respondent noted that the site cost “£5000.00 to build and generates £1000.00 a week in trade and quotes.”
- The Respondent offered to transfer the Domain Name to the Complainant for compensation in “the form of a suggested amount of monies” and suggested that a “figure of £150,000” would be “acceptable given the loss of trade [he] would experience.”

Complainant’s Reply

5.3 In summary, the Complainant submitted that:

- The Respondent’s “continued use of the Domain Name is for the purposes of obtaining consideration in excess of his costs directly associated with acquiring or using the Domain Name.”
- The Respondent had “admitted that the registration of the Domain Name has allowed him to trade off the back of the goodwill in the name “Renault” and

generate income of £1,000 in trade and quotes per week” and has competed with the Complainant’s business by diverting trade from the Complainant.

- The Complainant considered that the Domain Name is likely to cause confusion in the minds of the public as the public may consider that the Domain Name is in some way affiliated with Renault, which it is not.
- That the Respondent offers an aftermarket solution is not relevant, noting that the Complainant through its dealers does provide aftermarket solutions including repairing Renault key cards.
- The mere *“registration of a domain name does not give the registrant rights which it would otherwise not have.”*
- It did not accept the Respondent’s proposal for compensation in order to assign the Domain Name. The Complainant referenced that offer as explaining the Respondent’s incentive to register the Domain Name *“using Renault’s name, to which he has no legal rights”* and that the *“proposed settlement offer is tantamount to a ransom request, and further evidences the abusive nature of the registration.”*

6. Discussions and Findings

General

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

i. [it] 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.

6.2 Addressing each of these limbs in turn:

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

6.3 The Expert considers that, for the reasons set out below, the Complainant has Rights in a name or mark which is at least similar to the Domain Name.

6.4 Paragraph 1 of the Policy defines ‘Rights’ as:

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

The Complainant must have the Rights in question at the time of the complaint (Nominet Appeal decision, *ghd.co.uk*, DRS No. 03078).

- 6.5 The Expert notes that, as referred to by the Complainant and summarised at paragraphs 4.3 and 5.1 above, the Complainant is a licensee of the Marks. The Expert also notes the Complainant's statement that it has used the Marks, which have *"featured in numerous advertising campaigns in the United Kingdom."*
- 6.6 As a consequence, the Expert considers that, through longevity in the market place and the Complainant's reputation (noting also, for example, the date of Renault SAS's UK trade mark 00000695493 registration (23 January 1951), and the UK brand awareness references provided by the Complainant), the Complainant has developed considerable goodwill and reputation in the Name/Marks.
- 6.7 While the Expert notes that the Domain Name also includes the word *"keycards"* (or sometimes referenced as two words *"key"* and *"cards"*) after the Name, the Expert considers that such a word (or words) is merely descriptive and does not sufficiently distinguish the Domain Name from the Name/Marks. In addition, the Expert considers that the Domain Name includes the *".co.uk"* suffix does not sufficiently distinguish the Domain Name from the Name/Marks.
- 6.8 Given those factors, the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Name/Marks which is/are similar to the Domain Name.

Abusive Registration

- 6.9 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.
- 6.10 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*
- 6.11 *In relation to i. above*, the Expert considers that the Domain Name was an Abusive Registration at the time the Domain Name was registered.

- 6.12 The Policy, at paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, the Expert considers that the factors set out at paragraphs 3 a. i. B. and 3 a. i. C. are relevant.
- 6.13 In relation to the above factors, the generally held view amongst DRS Experts is that the Respondent should have had knowledge of the Complainant and/or its Rights when registering the Domain Name for there to be a finding of an Abusive Registration. As referenced above, given the Complainant's goodwill and reputation in the Name/Marks, the Expert considers that the Respondent is likely to have been well aware of the Complainant and its Name/Marks at the time of the Domain Name registration on 31 January 2013.
- 6.14 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name with the intention of benefitting from the Complainant's reputation and goodwill to attract to the website linked to the Domain Name (the '**Website**') users who would be looking for the Complainant and its services (the purpose of which would be to disrupt unfairly the business of the Complainant).
- 6.15 Further, the Expert considers that by registering the Domain Name, the Respondent has prevented the Complainant from so registering its Name/Marks.
- 6.16 The Expert notes that the Respondent has offered to transfer the Domain Name to the Complainant for a "*figure of £150,000*". While the Policy also sets out at paragraph 3 a. 1. A. that a factor which may be evidence that the Domain Name is an Abusive Registration could be where the Respondent registered the Domain Name to sell it to the Complainant, the Expert has no compelling evidence before him that this was the Respondent's intent at the time of the Domain Name's registration.
- 6.17 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 6.18 *In relation to (ii) above*, the Expert also considers that the Domain Name was an Abusive Registration as a result of its manner of use by the Respondent.
- 6.19 The Expert considers that paragraph 3 a. ii. of the Policy is relevant, whereby a factor which may be evidence that the Domain Name is an Abusive Registration is:

Circumstances indicating that the Respondent is using [...] 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;

- 6.20 The confusion referred to above is confusion as to the identity of the person or entity behind the Domain Name. The Expert considers that the Domain Name is near identical to the Complainant's Name/Marks (save for the "keycard" suffix), and cannot sensibly refer to anyone else.
- 6.21 The Expert notes that the Website references on the homepage such things as "ROADSIDE RENAULT KEY CARD PROGRAMMING SERVICES" and uses the Renault logo in its header. As such, the Expert considers that there is a real and tangible risk that the URL for the Website will likely appear high up on the search engine list of a user trying to locate the Complainant's website and that a user will access the Website thinking it is the Complainant's.
- 6.22 The Expert considers that the use of the Domain Name, for the reasons referenced above at paragraphs 6.20 and 6.21, has taken unfair advantage of the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the Name/Marks to generate web traffic to the Website that was meant for the Complainant. Indeed, in this regard the Expert notes that the Respondent has stated that the Website "*generates £1000.00 a week in trade and quotes*".
- 6.23 Further, the Expert is not persuaded by an argument that a person accessing the Website would soon realise his or her mistake as the damage to the Complainant's business would already have been done. Indeed, paragraph 3.3 of the DRS Experts' Overview (http://www.nominet.uk/wp-content/uploads/2015/08/Expert_Overview.pdf) supports the view that a registration is abusive in such circumstances where the Respondent is providing goods and services which do not originate from the Complainant.
- 6.24 The registration of the particular wording of the Domain Name is also unfairly detrimental to the Complainant as web users are likely to conclude that the Complainant has registered a Domain Name suitable for the provision of services in relation to its RENAULT products, which is not the case.
- 6.25 The Expert has considered whether there is evidence before him to demonstrate that the Domain Name is not an Abusive Registration but does not consider there is. Indeed, the Expert considers that there is no obvious justification for the Respondent having registered the Domain Name.
- 6.26 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

7. Decision

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

Signed: Dr Russell Richardson

Dated: 9 September 2016