

Nominet UK Dispute Resolution Service

DRS 10174

We Buy Any Car Limited

and

Jason Penn

Decision of Independent Expert

1 Parties

Complainant: We Buy Any Car Limited

Address: Nixon Street
Rochdale
Lancashire

Postcode: OL11 3JW

Country: United Kingdom

Respondent: Jason Penn

Address: 2 Buckhurst Hill, Essex.

Postcode: IG9 5JH

Country: United Kingdom

2 Domain Name

<webyeanycar.co.uk>

3 Procedural History

- 3.1 On 4 August 2011 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy ("the Policy") and DRS Procedure ("the Procedure"). Nominet notified the respondent on 9 August 2011. The respondent responded on 24 August 2011, and the complainant replied on 31 August 2011. The matter was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 27 August 2011 paid the applicable fee.
- 3.2 I was appointed as expert on 7 October 2011. I have made the necessary declaration of impartiality and independence.

4 Factual background

- 4.1 The complainant trades in cars, specialising in valuing and buying cars from the general public.
- 4.2 The respondent registered the domain name on 8 March 2010.

5 Parties' Contentions

Complainant

- 5.1 The complainant says it has traded since 1996, and has UK and EU Trade Marks in relation to WEBUYANYCAR.COM, and substantial common law rights to the words WEBUYANYCAR, WE BUY ANY CAR and WEBUYANYCAR.COM.
- 5.2 It argues that the domain name is highly similar, if not identical, to these names, since it contains all the words "we", "any" and "car"; the fact that the respondent has chosen to spell "buy" as "bye does not alter the overall impression. From a phonetic point of view, the complainant says, the domain name and the complainant's marks are identical.
- 5.3 The complainant argues that the domain name is an abusive registration both at the time of registration and because of its subsequent use. It says it has undertaken large scale promotional campaigns, and that it would be almost impossible for a trader in the motor industry not to be aware of its presence in the market. According to the complainant, the domain name makes no sense except that it apes the complainant's name; and the services offered by the respondent using the domain name are the same as the complainant's.
- 5.4 The complainant argues that the respondent is "piggybacking" on its rights and promotional campaigns, and that its use of the domain name will confuse internet users.
- 5.5 The complainant says there is no evidence the respondent used the trade mark WE BUY ANY CAR before the complainant did.

Respondent

- 5.6 The respondent argues that he has done nothing wrong or in breach of DRS Policy. He says he feels he is being treated unfairly, and that the complainant has a track record of trying to frighten small traders like himself who wish to use the net to buy and sell cars.
- 5.7 The respondent refers to correspondence with the complainant, in which he has argued that he has been trading longer than the complainant, and that he has never tried to pass himself off as the complainant. He has argued in that correspondence there are numerous sites as well as his that are similar to the complainant's name, and that he has invested time, effort and money in developing and advertising his website.

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show 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, and that
 - the domain name, in the hands of the respondent, is an abusive registration.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has produced documentary evidence from the Intellectual Property Office and from the Office for Harmonisation in the Internal Market of its UK and European trade marks in relation to the name WEBUYANYCAR.COM. It uses the domain and website <webuyanycar.com>, and has been trading using the name "We Buy Any Car" since 1996.
- 6.4 At the third level (i.e. disregarding "co.uk") the domain name closely reflects the text of the complainant's name and trade marks. It can be read as consisting of four words. Three of those words are identical to the corresponding words in the complainant's name, in the same order and placement in which they occur in the complainant's name. The other word, "bye", is phonetically the same as the remaining word. When read aloud or heard, the domain name sounds identical to the complainant's name, and conveys the same sense.
- 6.5 In my view, the slight difference in the spelling of the domain name does not make it dissimilar to the complainant's name.
- 6.6 In those circumstances I am satisfied that the complainant has rights in respect of a name which is identical or similar to the domain name.

Abusive Registration

- 6.7 Under paragraph 1 of the Policy, abusive registration means a domain name which either:
- 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
 - has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.8 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using a domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.9 Given the extent of the similarities explained at paragraphs 6.4 to 6.6 above, in my view some initial interest confusion is likely between the domain name and the complainant.
- 6.10 In any event, the complainant's evidence, which is not disputed, shows that the respondent has offered to buy cars using a website connected to the domain name.
- 6.11 It might be argued, relying on paragraph 4(a)(ii) of the Policy, that the domain name is generic or descriptive and the respondent is making fair use of it. However the domain name is not in fact descriptive. It merely looks similar and sounds identical to the complainant's name, which does describe its business. Indeed it is the nature of this similarity, with the use of the letters "bye" in a way which corresponds to the word "buy" in the complainant's name, that suggests the respondent's intended use was not fair.
- 6.12 In my view, it is reasonable to infer from the respondent's use of the domain name that he intended to "piggyback" on the complainant's rights. His choice of the particular domain makes little sense otherwise. And in any case, given the risk of initial interest confusion, it seems likely he has benefited commercially from public awareness of the complainant's name.
- 6.13 In my view, therefore, the respondent has used the domain name in a manner which has taken unfair advantage of the complainant's rights.
- 6.14 It makes no difference what investment the respondent has made in the domain name, or what domain names other traders may have registered.
- 6.15 For these reasons I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

7 Decision

- 7.1 I find that the complainant has rights in a name which is similar or identical to the domain name; and that the domain name, in the hands of the respondent, is an abusive registration.
- 7.2 The complaint is upheld. I direct that the domain name be transferred to the complainant.

Carl Gardner

1 November 2011