

DISPUTE RESOLUTION SERVICE

DRS 8467

Decision of Independent Expert

1. The Parties:

Complainant: Toyota (GB) Plc

Address: Great Burgh
Burgh Heath
Epsom
Surrey
KT18 5UX
United Kingdom

Respondent: Cambodia Orphan Save Organisation

Address: 074, Nation Road 6, Group 4
Trang Village
Kandek Commune
Prasat Bakong District, Sien Reap
Angkor
Cambodia

2. The Domain Name(s):

yourtoyota.co.uk

3. Procedural History:

3.1 On 29 March 2010 the Complaint was filed with Nominet in accordance with the Nominet UK Dispute Resolution Service Policy ("the Policy"). Nominet validated the Complaint and sent a copy of the Complaint to the Respondent on the same day, advising the Respondent that the Complainant was using Nominet's Dispute Resolution Service to complain about the registration or use of the Domain Name, and allowing the Respondent 15 working days within which to respond to the Complaint.

3.2 No response was received, and mediation was not possible. On 5 May 2010 the Complainant paid the relevant fee to Nominet in order for the matter to be referred to an independent Expert for a full Decision. On 10 May 2010 Bob Elliott was duly appointed as Expert.

4. Factual Background

4.1 The car company Toyota has been established since 1937, and has been trading in the United Kingdom since 1965. It is a manufacturer and retailer of vehicles and vehicle parts, along with associated services. It is the owner of

numerous registered trade marks, including a Community Trade Mark for TOYOTA dating from 1997 in all of the classes from class 1 to class 42.

- 4.2 The Domain Name yourtoyota.co.uk was registered on 13 January 2007. It currently redirects to a website at www.toyotapoint.co.uk, which is a website apparently promoting independent locations for the sale of vehicles and parts. The website is not fully functional, and contains malware. It has what appear to be search and log-in functions, but those do not work, and it does not appear to be linked to any such independent third parties. It does not use Toyota's familiar logo, nor the colour red typically associated with Toyota. Its Home Page contains the following statement: "Welcome to toyotapoint.co.uk Here you will find access to specialist independent companies for your Toyota. We have no connection to the manufacturer of Toyota Vehicles. If you want to access the website of Toyota themselves, go to www.toyota.com". Behind the Home Page are pages with other references to any links being to "independent" companies but the pages seem to be generic and not specifically generated for the www.toyatapoint.co.uk website.
- 4.3 The Complainant tried to make contact with the then registrant of the Domain Name, one Dhugal Clark of Manchester, in January 2010. The letter written by the Complainant to Mr Clark indicated it would be interested in discussing options regarding the transfer of the domain to the Complainant. However, no response was received.
- 4.4 Upon conducting a new WHOIS query on 23 February 2010, the Complainant discovered that the registrant had changed, and was now the Cambodia Orphan Save Organisation, with an address at Angkor, Cambodia. However, the Domain Name continued to be pointed to the website www.toyotapoint.co.uk, and the name servers upon which it was hosted remained the same.
- 4.5 The Complainant tried contacting Cambodia Orphan Save Organisation by telephone, and subsequently by letter. The telephone calls appear to have been inconclusive, but the people spoken to at the Cambodia Orphan Save Organisation said they were unaware of the Domain Name, and have not responded to the subsequent correspondence.

5. Parties Contentions

Complainants' Submissions

Rights

- 5.1 The Complainant relies upon the extensive repute of the Toyota car company, and its trade within the United Kingdom since 1965. It relies upon the Community Trade Mark referred to above (although this is registered in the name of the Japanese company Toyota Jidosha Kabushiki Kaisha trading as Toyota Motor Corporation). The Complainant also provides a link to a page at www.toyota.co.uk website, which is headed "Welcome To Your Toyota". The Complainant says that this is a phrase which it has traded with as part of its owner services for some time, and can clearly be seen on the website, and when conducting an online search, but has produced no evidence of the results of online searches.

Abusive Registration

- 5.2 The Complainant says that the registration of the Domain Name is detrimental to its company image, and may lead to confusion of its customers, taking advantage of its reputable name and a phrase which is regularly and clearly used in online and offline references.
- 5.3 The Complainant also cites the poor quality of the toyotapoint.co.uk website, not meeting W3C standards, with a number of pages that do not work as expected, and prompting a security warning from Google that the site includes elements from a site known to host malware. Each of those elements is said to be detrimental to the reputation of the brand "Toyota", as implied through association due to the Domain Name in use.
- 5.4 The Domain Name uses the registered trade mark TOYOTA, which predates the registration of the Domain Name by 10 years, and most recently "seems to take unfair advantage of the Toyota name by offering services which [the Complainant] offers".
- 5.5 Given the difficulties which the Complainant has had with tracing the current controller of the Domain Name, with the current registrant apparently not being aware of the Domain Name, and with the transfer having occurred only after the previous attempt at contact by the Complainant, the Complainant says that this suggests that the entity controlling the Domain Name is attempting to block its use of the Domain Name. The Complainant notes that the registrar name servers, and destination URL have remained unchanged, the only change being in the registrant's details.
- 5.6 The current registrant has "absolutely no identifiable connection with Toyota or a need for the yourtoyota.co.uk domain name whatsoever", being based in Cambodia. The Complainant notes that the website to which the Domain Name directs is a UK based site, apparently operated by an entirely different organisation.
- 5.7 The Complainant seeks the transfer of the Domain Name to itself.

Respondent's Submissions

- 5.8 The Respondent has not filed a Response.

6. Discussion and findings.

- 6.1 In order to succeed in these proceedings, paragraph 2.6 of the Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that :
- i. the Complainant has Rights in respect of names or marks which are 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 The Complainant's case in relation to Rights is not particularly convincing. There is no explanation of relationship between the Complainant, and the

Japanese registered owner of the Community Trade Mark upon which the Complainant relies. It is not clear whether the Complainant claims to be the licensee of that mark in the United Kingdom, or what other relationship applies if that is not the case. Although the car company Toyota is said to have traded in the United Kingdom since 1965, the Complainant's role in this trading is not explained. The reference to the "Welcome To Your Toyota" page on the www.toyota.co.uk website is also hardly convincing, in showing that the phrase "Your Toyota" (to use the Complainant's description) is one in which the Complainant has Rights. It is a reference to only one use of that phrase, in a way which could well be regarded as descriptive, and the Complainant has produced no evidence of any other use of the phrase.

- 6.3 The definition of "Rights" in the Policy is "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 Expert does not consider that the Complainant has provided sufficient evidence to prove that it has Rights in the phrase "Your Toyota" as such.
- 6.4 At the same time, the Expert is conscious that the test for Rights under the Policy is not intended to be a particularly onerous one for the Complainant, and this is a case where there has been no Response. On balance, the Expert is prepared to accept that the Complainant, as what would appear to be the principal operating company under the Toyota brand in the United Kingdom, has sufficient claim for the purposes of the Policy to have Rights in the name "Toyota". In the Expert's view, the addition of the word "Your" before "Toyota" in the Domain Name is not particularly distinctive, and the Complainant therefore has Rights in a name or mark (Toyota) which is similar to the Domain Name.

Abusive Registration

- 6.5 In order to succeed in its Complaint, the Complainant has to show on the balance of probabilities that the Domain Name is an Abusive Registration. 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 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.
- 6.6 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3.a of the Policy. The Complainant does not directly address any of those factors. However, the Complainant does refer to the possibility of "confusion" of the Complainant's customers, and also an attempt to block the Complainant's use of the Domain Name (by the transfer to Cambodia Orphan Save Organisation).
- 6.7 The reference to confusion could be a suggestion that there are "circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised, or

otherwise connected with the Complainant”, under paragraph 3.a.ii of the Policy.

- 6.8 The reference to “blocking” is presumably intended as a reference to paragraph 3.a.i.B of the Policy: “circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights”.
- 6.9 Taking the “blocking” issue first, there is no evidence that the Respondent (Cambodia Orphan Save Organisation) had any intention to block the Complainant’s use of the Domain Name, when it acquired the Domain Name. The circumstances which the Complainant has described would suggest that, in fact, the current registrant knew nothing about the transfer of the Domain Name into its ownership (although the Expert understands that transfer would not have been effective, without the Respondent’s consent). It might therefore also be relevant to consider the intentions of the previous registrant, when it registered the name, but there is no evidence that the previous registrant had the intention of blocking the Complainant, particularly as the Complainant has not demonstrated its interest in the “Your Toyota” phrase, nor any widespread recognition of that phrase among the public. It is difficult in such circumstances to discern any intention to block the Complainant’s use of the Domain Name.
- 6.10 As regards “confusion”, there is no evidence of actual confusion put forward by the Complainant. The failure of the website itself to meet W3C standards might be detrimental to the reputation of the brand “Toyota”, but that would only be the case if the Complainant could show that the consumer would imply a connection or association with the brand. Offering the same services as Toyota does not necessarily give rise to confusion, nor take unfair advantage of the Toyota name.
- 6.11 Although the Complainant does not put its case in such terms, its Complaint seems essentially to fall within the category of previous DRS decisions as to whether the registration and use of the Domain Name creates the false impression that there is a commercial connection between the Respondent and the Complainant. As to that, there are three decisions of Nominet’s Appeal Panel which fall to be considered. Those are *Seiko UK Ltd v Designer Time/Wanderweb, DRS 00248, Seiko-Shop.co.uk, Epson Europe B.V. v Cybercorp Enterprises, DRS 03027, Cheap-epson-ink-cartridge.co.uk and other domain names*, and the recent decision *Toshiba Corporation v Power Battery Inc, DRS 07991 toshiba-laptop-battery.co.uk*
- 6.12 In DRS 00248 the Appeal Panel said:-

“There are many different traders who may wish to make use of the Trade Mark of a third party, e.g. the proprietor’s licensee (exclusive or non-exclusive), a distributor of the proprietor’s goods (authorised, unauthorised or “grey market”), the proprietor’s franchisee or the proprietor’s competitor engaged in comparative advertising. There are an infinite array of different factual circumstances which could arise under each of these categories.

Accordingly, we are not able to - and we are not going to attempt to - lay down any general rules governing when a third party can make

“legitimate” use of the trade mark of a third party as a domain name. All we can do is decide whether the Expert came to the right conclusion on the evidence and submissions before him.

Essentially Seiko’s complaint is that Wanderweb’s registration of the Domain Names has gone beyond making the representation “we are a shop selling Seiko/Spoon watches” and is instead making the representation(s) “we are *The* Seiko/Spoon watch shop”, or “we are the official UK Seiko/Spoon watch shop”. The latter form of representation is what we understand the ECJ to be referring to when, in the ECJ case C-63/95 BMW -v- Deenik, it speaks of creating “*the impression that there is a commercial connection between the other undertaking and the trade mark proprietor*”. An example of a domain name, which, in the opinion of some members of the Panel, would make the former but not the latter representation was given by the Expert in paragraph 7.28 of the Decision: “we–sell–seiko– watches.co.uk”.

The Panel agrees that if there is support in the evidence for the suggestion that the Domain Names make, or are liable to be perceived as making, the latter representation (i.e: that there is something approved or official about their website), this would constitute unfair advantage being taken by Wanderweb or unfair detriment caused to Seiko”.

- 6.13 In DRS 03027, the Appeal Panel summarised its position regarding the passage cited above from DRS 00248 by saying that it was obviously important not to lose sight of the primary question namely “were the Domain Names registered or used in a manner which takes unfair advantage of or was unfairly detrimental to the Complainant’s Rights”, but that it is helpful in cases of this kind (for the reasons set out in DRS 00248) to ask and to answer the secondary question “does the Respondent’s registration and use of the Domain Names create the [false] impression that there is a commercial connection between the Respondent and the Complainant?”.
- 6.14 In DRS 07991, the Appeal Panel reviewed the previous decisions, in a case where the principal issues were whether the domain name itself amounted to an Abusive Registration, because of its likelihood of creating “initial interest confusion” which might be sufficient on its own, and whether (if not) the registrant’s use of the name for the purposes of sales of competitive products of third parties (ie, other than those of the brand owner) demonstrated the taking of unfair advantage. In seeking to apply the earlier decisions the Panel reached a majority decision that the particular domain name was unlikely to be used as a website address by someone looking for the official Toshiba website, and that if the site turned up as a result of a search using a search engine, there would be sufficient information available to the consumer on the search results to be able to distinguish between them, for there to be little likelihood of confusion. In effect, the descriptive and particular nature of the domain name (toshiba-laptop-battery.co.uk) took it well away from the category of cases concerning “unadorned” use of a trade mark.
- 6.15 As regards the latter point, however, the Appeal Panel was unanimous in finding that the use of the domain name for a site which also offered competitors’ products, took unfair advantage of the Complainant in that case, by “riding on its coat-tails” for the benefit of the Respondent.

- 6.16 Based upon these decisions, the Expert considers that he should consider both the Domain Name itself and whether it is closer to the “unadorned” use cases, or the descriptive type of domains such as in DRS 07991, and if the latter, to examine the nature of the use of the Domain Name to see whether it nevertheless unfairly takes advantage of or is detrimental to the Complainant’s Rights.
- 6.17 The Domain Name here seems to the Expert to be some way between the “unadorned” use cases, and the “brand-laptop-battery” case. It seems unlikely (based upon the Complainant’s evidence) that anyone would use “yourtoyota” as part of a website address, or indeed as a search phrase. However, the addition of “your” is neither particularly distinctive, nor descriptive, and may largely be disregarded by a consumer. The Expert is not convinced it falls clearly either side of the line, and therefore it is necessary to consider the nature of its use.
- 6.18 As to the nature of the use of the Domain Name, in this present case, the Domain Name itself points to the website www.toyotapoint.co.uk. That website contains an explanation that it has no connection to the manufacturer of Toyota Vehicles, and does not appear to adopt any of Toyota’s corporate branding, except for the name “Toyota” itself. As the Complainant has observed, use of the website is not easy. The Expert considers that there is also an element of the site being something of a pretence – it says it links to independent traders, but there are no links. Other than the Home Page, the pages seem generic (albeit apparently geared up to permit car-related searches). The website contains malware, and to the Expert it has the feel of a site which has been set up to pretend it is intended for legitimate trading in OEM goods, but is not in fact being used for that purpose.
- 6.19 There is an additional element here, which is the unexplained transfer of the Domain Name to an organisation which, as the Complainant says, has “absolutely no identifiable connection with Toyota or a need for the yourtoyota.co.uk Domain Name whatsoever”. Technically, this could not have been achieved without the consent of the transferee (who apparently now denies knowledge of the Domain Name). On the face of it, this appears odd, and the Expert suspects it was probably designed in some way to try and make it more difficult for the Complainant (or an associate company) to mount an effective complaint.
- 6.20 In this respect the Expert is conscious that Mr Dhugal Clark (the previous registrant) was recently found to have made Abusive Registrations of 6 domain names which included the mark “Renault”, in DRS 7184, a decision of 15 January 2010. One of the 6 domain names in issue in that case was renaultpoint.co.uk. The basis of that decision appears to have been that Mr Clark intended to offer the Domain Names for sale, but the Expert in that case also did not accept that Mr Clark had made preparations for legitimate use of the domain names. There does not appear to have been any discussion in that case as to the possible element of “confusion”.
- 6.21 Mr Clark took an active role in responding to the Complaint in DRS7184 (unsuccessfully). He has not done so on this occasion, but that may have been as a result of the transfer of the Domain Name to the Cambodian entity. If he had taken an active role, he might have been able to explain the planned use of the www.toyotapoint.co.uk site, but he appears to have decided to take the route of assigning the Domain Name, after receipt of the Complainant’s

correspondence. It is very difficult in such circumstances for the Expert to form any view as to what Mr Clark's motives can have been in doing so, other than possibly (as the Complainant asserts) to suggest that it might have been an attempt to block the Complainant's use of the Domain Name, which is an assertion which is not explained. Certainly, there is no obvious good reason for the transfer, in the absence of an explanation.

6.22 Although the Complaint has not been defended, it is not a strong one, lacking in detail, evidence and argument. The Complaint does not, as such, rely upon "initial interest confusion". However, although the www.toyotapoint.co.uk website contains a reference on its Home Page to "independent companies", a disclaimer of association with Toyota itself, and does not use Toyota's corporate colours, or the well-known Toyota logo, the Expert does not believe it is a site set up for genuine legitimate trading. Although it is possible that any initial interest confusion would be dispelled, the use of the Domain Name in such circumstances seems to the Expert to take unfair advantage of the Complainant's Rights in the Toyota name. Given also the unexplained transfer of the Domain Name, and Mr Dhugal Clark's previous involvement in DRS 7184, on the balance of probabilities, the Expert finds that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.23 Therefore the Complaint succeeds.

7. Decision

7.1 The Expert finds that the Complainant has rights in the name TOYOTA which is similar to the Domain Name yourtoyota.co.uk.

7.2 The Expert also finds that the Complainant has shown on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

7.3 The Expert therefore concludes that the Domain Name yourtoyota.co.uk should be transferred to the Complainant.

Signed: Bob Elliott

Dated: 17 May 2010