

**DISPUTE RESOLUTION SERVICE**

**DRS 07802**

**Decision of Independent Expert**

Trader Publishing Limited

and

Froggatts Range Rover Sales

**1. The Parties:**

Complainant: Trader Publishing Limited

Address: 1 Woodlands Business Park  
Ashton Road  
Newton Le Willows  
Merseyside

Postcode: WA12 0HE

Country: United Kingdom

Respondent: Froggatts Range Rover Sales

Address: Masons Garage  
Bosley  
Macclesfield  
Cheshire

Postcode: SK11 0PN

Country: United Kingdom

**2. The Domain Name(s):**

northwestautotrader.co.uk

This domain name is referred to below as the "Domain Name".

### 3. Procedural History:

A hardcopy of the Complaint was lodged with Nominet on 7 October 2009. Nominet validated the Complaint and notified the Respondent. A Response was submitted in time on 27 October 2009. The Complainant did not submit a Reply. The dispute not having been resolved in mediation, on 3 February 2010 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy (“the Policy”).

Sallie Spilsbury, the undersigned (“the Expert”) has confirmed to Nominet that she knows of no reason why she could not properly accept the invitation to act as Expert in this case and has further confirmed that she knew of no matters which ought to be drawn to the attention of the Parties which might appear to call into question her independence and impartiality.

On 23 February 2010 the Expert made a request of the Complainant for further information under paragraph 13a of the Nominet Dispute Resolution Service Procedure (“the Procedure”). The Complainant was given two working days to comply with the request. No response was forthcoming. The Expert will accordingly decide this matter based on the Complaint (and its annexes) and the Response (and its annexes). The details of the 13a request will be discussed at section 4 of this Decision.

### 4. Factual Background

#### The Complainant

The Complainant is the owner of a motoring magazine called “*Auto Trader*”. In addition to containing advertisements for the sale of motor vehicles and accessories, the magazine also contains information about motoring related matters. The magazine was launched in 1981 and is published weekly in 11 regions across the United Kingdom, including a North West edition entitled *North West Auto Trader*. An annex to the Complaint gives the circulation figures for the North West edition of *Auto Trader* as 42,206 as at July-Dec 2004 (more recent information is not provided).

In addition to the magazine the Complainant operates an associated website at [www.autotrader.co.uk](http://www.autotrader.co.uk) which was launched in 1996. The Complaint describes the website as “currently Europe’s largest motoring website”. In August 2007 it had a 38 % share of the automotive classified market and in March 2008 it ranked as the second largest ABCe audited UK website with over 400,000 vehicles listed on the site at any one time. (ABCe is an organisation which measures and verifies website activity.)

The Complainant states that it is the owner of a number of UK and Community trade marks featuring the AUTO TRADER mark, as follows:

Jurisdiction	Mark	No.	Nice Classification	Date registered/filed
UK	AUTO TRADER	2019603	16	18 Oct 1996 Registered
UK	Auto Trader	2327224	9, 16, 35, 41	13 May 2005 Registered
CTM	Auto Trader	002410298	9, 16, 35, 36, 38, 42	30 August 2006 Registered
CTM	AUTO TRADER	002414795	9, 16, 35	26 June 2006 Registered
CTM	AUTO TRADER	002880821	9, 38, 41, 42	11 April 2006 Registered
CTM	Auto Trader.co.uk	006645121	9, 16, 35, 36, 38, 41, 42	25 January 2008 Filed (NOT YET REGISTERED)

The Complaint refers to “attached printouts at Annex 4” containing further details of the trade mark registrations (paragraph 1.2 of the Complaint). This printout was missing from the version of the Complaint that was submitted to Nominet. There is a list of the annexes at the end of the Complaint and this does not refer to any printouts showing details of trade mark registrations. On 23 February in order to clarify the matter, the Expert made a request under 13a of the Procedure for production of the printouts referred to at paragraph 1.2 of the Complaint. No response has been received to that request. The implications of this will be discussed below at section 6 of this Decision.

In addition to the above matters the Complainant is also the registrant of a number of domain names that incorporate the AUTO TRADER mark including autotrader.co.uk, auto-trader.co.uk and autotradermagazine.co.uk.

### **The Respondent**

The Respondent registered the Domain Name on 19 January 2000. It trades in used motor vehicles and is based in North West England. It has been in business for around 25 years.

The Response states that the Domain Name was registered to promote the Respondent’s business and website. For many years the Domain Name was redirected to the Respondent’s website at [www.froggatts.com](http://www.froggatts.com). More recently (the

exact date is not given) the Domain Name was used in newspaper advertisements. At the same time the page on the froggatts.com website to which the Domain Name was directed was headed “NORTHWEST AUTOTRADER’S”. The Respondent explains that this more recent use of the Domain Name was in part prompted by the national scarcity in used vehicles and was an attempt by the Respondent to obtain more used vehicles for purchase as stock in trade.

A search of the Domain Name was carried out by the Expert on 18 February 2010. No results were found at that time.

## **5. Parties’ Contentions**

Clause 2a of the Policy provides that a Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts according to the Procedure, 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.

### *Rights in a mark identical or similar to the Domain Name*

#### *The Complainant*

The Complainant contends that its trade mark registrations confer Rights in the AUTO TRADER mark. It acknowledges that the Domain Name does not exactly match the trade marks but asserts that the “Northwest” prefix is an element of the Domain Name that is merely descriptive and that it does not therefore prevent the Domain Name being similar to the registered marks. In support of this submission the Complainant refers to the Expert Decisions at DRS 04596 (coventryricoharena.co.uk) and DRS 6161 (autotraderni.co.uk) as examples of disputes in which the addition of geographical indicators were found to be insufficient to differentiate the domain name from the name in which the Complainant had Rights.

In addition to the trade mark registrations, the Complainant also asserts common law rights in the goodwill that has been generated through the length and extent of its use of the AUTO TRADER mark.

#### *The Respondent*

The Respondent appears to challenge the Complainant’s Rights in what it regards as a descriptive name. It makes the following observation in the Response:

“[The Complainants] are trying to insinuate they can have rights to a common name for a profession like carpentry, fishing, farming and all its variants. Auto (everything to do with automobiles) and trader (the world could not function without trade) plus and all prefixes and suffixes (sic)”.

## *Abusive Registration*

### *Complainant*

The Complainant makes the following submissions in relation to Abusive Registration:

The Respondent has acquired the Domain Name for the purpose of unfairly disrupting the Complainant's business. "Auto Trader" is a well known brand and registered trade mark of the Complainant and it is unlikely that the Respondent has acquired the Domain Name independently of any knowledge of the trade mark. It is the Complainant's contention that the Respondent had the Complainant and its business in mind when registering and/or acquiring the Domain Name. This is evidenced by the fact that the website at the Domain Name includes references to Auto Trader. The website located at [www.northwestautotrader.co.uk](http://www.northwestautotrader.co.uk) offers a similar service to that of the Complainant. The Respondent is making a financial gain from users visiting the website of the Domain Name. There is no reason why the Respondent would own such a website, other than for financial gain. It is likely that users will visit the website in error, as the Domain Name contains the Complainant's trade mark "Auto Trader".

The Respondent is using the Domain Name for its own commercial gain. The Respondent is using the Domain Name for the sale and purchase of cars specifically targeting the United Kingdom with a similar service to that provided by the Complainant. This is evidenced in screenshots attached at Annex 2 to the Complaint of a webpage on the Respondent's site at [froggatts.com](http://froggatts.com) to which the Domain Name dissolved (the Respondent does not dispute this use).

This use has the effect of causing confusion in the market place in view of the fact that a similar mark is being used in association with an identical service for which the Complainant has registered trade mark rights in the "Auto Trader" brand.

The Respondent has acquired the Domain Name as a blocking registration against a name or mark in which the Complainant has rights. This can be seen from the fact that the Complainant sent a cease and desist letter to the Respondent on 1st April 2009 to advise the Respondent that they consider the Domain Name to infringe their trade mark rights. They received no response. This has had the effect of blocking the Complainant from acquiring a Domain Name in which the Complainant has Rights.

### *Respondent*

The Domain Name is one of a number registered by the Complainant to encourage traffic to its website at [froggatts.com](http://froggatts.com). The Domain Name was registered because it described the Respondent's business "I registered

northwestautotrader.co.uk because that is what I am, that is my profession I am a motor trader, used vehicle dealer, auto trader from the north west of England. I have every right to have registered this name. I registered it to promote my site and my kind of business.” People searching for North West autotraders access the Respondent’s site very frequently.

In recent times, the Respondent has used the Domain Name in order to increase its stock of used vehicles. There is a difference between the Complainant and the Respondent’s business. The Complainant does not itself trade in used vehicles. Their magazine and website only exists because the general public and motor traders patronise it.

The Response includes an annex of Google search engine results featuring a range of companies that promote their business using names relating to the motor trade (for example a business trading under the strap line “*northwest auto trader Buyers and northwest auto traders importers*”).

The Respondent refers to the disparity in size between his small business and the Complainant “I think it is very unfair that they appear to be using their might to Hoover (sic) up all related sites.”

The Complainant has already registered the domain name northwestautotrader.co.uk.

The Complainant has sought to purchase the Domain Name from the Respondent over the period 2006-8. The correspondence is annexed to the Response. The Complainant now seeks to be trying to take the Domain Name from him for nothing.

## **6. Discussions and Findings**

### **Complainant’s Rights**

Rights are defined in clause 1 of the Policy as including but not limited to “rights enforceable by the Complainant whether under English law or otherwise”.

### **The Complainant’s Rights**

#### *Registered Rights*

The Complainant relies on its trade mark registrations to confer Rights. Under the Policy the Expert must be persuaded that on the balance of probabilities the trade mark registrations are in place. A printout from the trade mark registry would suffice, as would a copy of the registration certificates. A statement in the Complaint will not generally be sufficient.

No registry printouts or registration certificates have been produced by the Complainant. It seems that at some point the Complainant intended to produce

such printouts because there is a reference to them in the body of the Complaint. But for whatever reasons they have been produced. The 13a request by the Expert has not been responded to. It follows that the Complainant has failed to establish the existence and ownership of the registrations and it is not therefore appropriate for the Expert to take them into account in this Decision.

### *Unregistered Rights*

The definition of “Rights” in the Policy is not limited to registered rights. Unregistered rights arising from goodwill or a trading reputation will fall within the definition. Does the Complainant have such Rights? This issue essentially involves the Complainant establishing that the AUTO TRADER mark has acquired brand significance for the Complainant.

The Expert finds that the Complainant’s use of the AUTO TRADER mark has generated goodwill in the brand. The existence of goodwill is supported by the success of the Complainant’s *Auto Trader* magazine over a number of years and also of its website operating at [autotrader.co.uk](http://autotrader.co.uk). Although the Complainant has not produced specific evidence to show that the public recognise the AUTO TRADER mark as being associated with the Complainant, the Complainant’s position as a market leader in the sphere in which it operates would suggest on the balance of probabilities that this is the case.

The Complaint has therefore established common law (unregistered) Rights in the AUTO TRADER mark for the purposes of the Policy.

The Expert is mindful that the Complainant has for some time published a successful regional edition of its magazine entitled *North West Auto Trader*. The most recent weekly circulation figures for this magazine date from 2004. At that time they were significant. It is therefore possible that the Complainant has unregistered Rights in the “*North West Auto Trader*” mark. In order to make such a finding the Expert would require evidence that members of the public with an interest in motoring matters would associate the *North West Auto Trader* title with the Complainant. But in the absence of evidence showing the way in which the title has been used and/or more recent evidence of sales figures, the Expert finds that the Complainant has not established a separate and independent goodwill in the regional title in its own right.

This decision will therefore be based on the AUTO TRADER mark alone.

The next issue is whether the Complainant’s Rights are identical or similar to the Domain Name. The Expert finds that the Domain Name is similar to the AUTO TRADER mark. The words “Auto Trader” are the dominant components of the Domain Name. The words “North West” act as a reference to the geographic locality in which the AUTO TRADER brand operates but they do not imply that the mark no longer refers to the Complainant or its services. It follows that the Complainant has Rights in a mark which is identical or similar to the Domain Name.

The other domain name registrations to which the Complainant refers do not in themselves confer Rights under the Policy without supporting evidence of the way that they have been used by the Complainant.

### **Abusive Registration**

Abusive Registration is defined in clause 1 of the Policy as follows:

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 was unfairly detrimental to the Complainant's Rights.

Paragraph 3 of the Policy contains guidance about applying the Abusive Registration test.

The following are of relevance to this Complaint:

a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

i. 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;

ii. 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;

Paragraph 4 of the Policy lists factors which if established to the satisfaction of the Expert will provide an answer to the Complaint's case. These include:

a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:



- i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:
  - A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
  - B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
  - C. made legitimate non-commercial or fair use of the Domain Name; or
- ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it

#### *Respondent's motivation at the time of registering the Domain Name*

In relation to the Respondent's motivation in registering the Domain Name the only evidence comes from the Respondent who states that he registered it in order to attract traffic to his website in order to drum up business for his trade as a motor dealer. He claims that the name was selected because of its descriptive nature rather than because of any connection with the Complainant. He points out that many traders in the motor trade make use of descriptive marketing strap lines. He also points out that his business is not identical to that of the Complainant in that he deals directly in cars whereas the Complainant operates a forum for traders and members of the public to advertise. The Respondent does not contend that he was unaware of the Complainant or its AUTO TRADER mark at the time of securing the registration. The Complainant asserts that the Respondent must have been aware of its existence when registering the Domain Name and that he had it in mind when doing so as a way of making a financial gain.

The Expert does not find that the Respondent's primary motivation in registering the Domain Name in January 2000 falls within the factors listed in clause 3(i) above or was otherwise abusive. Registration took place over 10 years ago. There is no direct evidence of any bad faith on the part of the Respondent at that time and any such finding should be based on more than mere inference.

The Respondent has not himself approached the Complainant to sell or rent the Domain Name at a profit. While the Domain Name has been used by the Respondent, the circumstances do not suggest that this use was primarily motivated by an intention to disrupt the Complainant's business nor are there any circumstances which suggest that the Respondent was primarily motivated by a desire to block the Complainant from acquiring the Domain Name. As such the Expert does not find that the registration of the Domain Name was in itself abusive under the Policy.

#### *Use of the Domain Name*

The Complainant bases its submissions on the more recent use made by the Respondent in which the Domain Name dissolved to a webpage on the frogatts.com site headed "NORTHWEST AUTO TRADER'S". The date on which

this recent use began is unclear, although the Respondent links it to the recent downturn in economic conditions which would suggest that the use began during the last 2 years, if not more recently. The Respondent indicates that during the period 2006-8 he had been in correspondence with the Complainant over the Domain Name. This indicates that at the time the Respondent began to use the Domain Name more extensively he was aware of the Complainant's concerns about his ownership of the Domain Name. The change of use of the Domain Name would therefore have taken place against a background of knowledge of the Complainant's concerns. It follows that the Respondent cannot show that the use of the Domain Name that is now complained of began before he became aware of the Complainant's cause for complaint. As such paragraph 4a(i) of the Policy does not assist the Respondent in rebutting the Complainant's case on Abusive Registration.

The Respondent's major submission is that the Domain Name is descriptive. This falls to be considered under paragraph 4ii of the Policy.

*Is the Domain Name descriptive?*

At one level, as the Respondent points out, the words AUTO TRADER and NORTH WEST AUTO TRADER might be taken to be descriptive of a type of business- a trader buying and selling automobiles. But what the Respondent ignores when making this submission is that for many years the Complainant has used the words AUTO TRADER very successfully and in such a way that any descriptive nature of the words will have been transcended. The Expert finds that the words have come to indicate the particular services operated by the Complainant rather than to describe a type of trade carried out by a number of businesses.

Although there is no evidence before her the Expert would also query whether "Auto Trader" is actually a commonly used description in everyday language. The word "auto" is not often used to describe a motor vehicle. Even the longer form of the word "automobile" would be more likely to be used in the USA than the UK. If the Domain Name were a more commonly used phrase such as "North West Motor Trader" the descriptive quality would be more readily apparent.

For the above reasons the Expert finds that the Respondent has not established on the balance of probabilities that the Domain Name is descriptive under paragraph 4(ii) of the Policy.

*Has the Domain Name been used in an abusive manner (paragraph 3ii of the Policy)?*

Because the Domain Name does not function in practice as a descriptive indicator of a type of business, when a member of the public types AUTO TRADER or NORTH WEST AUTO TRADER into their search engine it is not credible that they are seeking a generic list of motor dealers. More likely, they will be expecting to locate the Complainant or its goods and services and they will associate the website hosted at the Domain Name with the Complainant. This amounts to confusing use under paragraph 3 ii of the Policy. Once at the website it is unlikely that customers will remain under any impression that they have reached the

Complainant's site but nevertheless the Respondent has obtained an advantage. A customer wishing to place an advertisement to sell their car in the Complainant's magazine or website may now decide to do business with the Respondent. Thus, the Complainant loses custom and potential revenue to the Respondent. This advantage is unfair because it is parasitical. It derives from the strength of the Complainant's brand.

The Expert is not convinced by the Respondent's submission that it is not in the same type of business as the Complainant (and presumably that confusion is therefore less likely to occur). The Domain Name was used by the Respondent to advertise the Respondent as a purchaser of used vehicles. Such promotion is exactly the nature of the service that the Complainant provides. The activities for which the Domain Name was used and the Complainant's services overlap directly.

It follows that the Expert does not find the Respondent's explanation for the use of the Domain Name to be convincing. Although it may not have been his primary motivation for choosing the Domain Name, the Respondent must have been aware that a significant reason for the success of the Domain Name in attracting traffic to his website was *because* it consisted of the well-known brand of a related business. As his business began to suffer under the recent economic conditions, the Respondent chose to expand his use of the Domain Name to attract more custom. The clear inference being that he appreciated its value in facilitating a supply of used cars for his business. The Respondent must have been aware that the Domain Name took advantage of the market strength of the Complainant. This underlines the unfair nature of the advantage that accrued to the Respondent.

The Respondent's references to what it perceives as a power imbalance between the parties do not change the application of the Policy. The Respondent chose to use a Domain Name whose benefit derives from the Complainant's Rights. To this extent he has benefitted from the Complainant's position as a major player in the used car market. It is disingenuous for the Respondent to seek to turn that position against the Complainant.

The previous approaches by the Complainant in relation to the sale or transfer of the Domain Name are not relevant to this Complaint. The Complainant is within its rights to seek redress under the Policy, whatever unsuccessful approaches had been made previously.

## **7. Decision**

The Expert finds that the Complainant has proved on the balance of probabilities that it owns 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.

Accordingly, the Expert finds in favour of the Complainant and directs that the Domain Name be transferred to the Complainant.

**Signed** Sallie Spilsbury

**Dated** 4 March 2010