

## DISPUTE RESOLUTION SERVICE

D00014578

### Decision of Independent Expert

Ford Motor Company

and

Neoteric UK Ltd

#### 1. The Parties:

Complainant: Ford Motor Company  
One American Road  
Dearborn, MI  
Wayne 48126  
United States

Respondent: Neoteric UK Ltd  
48 Watling Street Road  
Preston  
Lancashire  
PR2 8BP  
United Kingdom

#### 2. The Domain Name:

newfordpartsonline.co.uk

#### 3. Procedural History:

- 3.1 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 to 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

29 July 2014 19:11 Dispute received  
30 July 2014 08:49 Complaint validated  
30 July 2014 08:52 Notification of Complaint sent to Parties  
31 July 2014 16:28 Response received  
31 July 2014 16:29 Notification of Response sent to Parties  
05 August 2014 02:30 Reply reminder sent  
08 August 2014 08:27 No Reply received  
08 August 2014 08:27 Mediator appointed  
13 August 2014 09:45 Mediation started  
11 September 2014 15:07 Mediation failed  
11 September 2014 15:09 Close of mediation documents sent  
16 September 2014 09:18 Expert decision payment received

3.3 The Complainant references a previous decision under the Nominet DRS Policy in its Complaint, namely *Ford Motor Company v Nicholas Horridge trading as Newford Parts Centre*, DRS 12602 (*newfordparts.co.uk*). Although the named Respondent in this case is different to the respondent listed in DRS 12602, the Respondent's representative is given as Nicholas Horridge, with the same address and contact details as those listed for the Respondent in DRS 12602.

3.4 It is clear from the submissions provided in both the Complaint and the Response that the owner and operator of the Domain Name is Mr Nicholas Horridge of Newford Parts Centre, and Neoteric UK Ltd is simply hosting the website to which the Domain Name resolves.

3.5 For the purposes of this decision therefore, any reference to the Respondent is to Mr Nicholas Horridge and his business operated under the name Newford Parts Centre.

3.6 Finally, although previous DRS cases do not have precedent value, they should not be discounted or ignored. Indeed, given these similarities between the Parties and Domain Name in this case to those in DRS 12602, a number of aspects of my reasoning in section 6 below follow those of the Expert in DRS 12602.

## 4. Factual Background

4.1 The Complainant is a United States corporation organised under the laws of the State of Delaware. It is an internationally well-known car manufacturer.

4.2 The Complainant is the owner of numerous trade mark applications and registrations for FORD in the United Kingdom and other countries around the world. The first trade mark registration for FORD (U.S. registration no. 74,530) covering "automobiles and their parts" in Class 12 was obtained in 1909.

- 4.3 The Complainant is also the owner of the domain names <www.ford.com>, registered on 31 August 1988, and <www.ford.co.uk>, registered before August 1996. It maintains websites under both of these domain names.
- 4.4 The Domain Name was registered on 14 August 2006.
- 4.5 The Respondent operates a UK based business that sells parts for Ford vehicles.

## **5. Parties' Contentions**

### The Complainant

- 5.1 The Complainant's contentions are summarised as follows:

#### Rights

- 5.2 The Complainant has, for many years, designed, developed, manufactured, serviced, repaired and sold automobiles and parts therefor together with related products and services under the mark "FORD". The Complainant has used and/or licensed others to use the mark FORD on a wide variety of goods.
- 5.3 The Complainant has traded since 1903 with the production of the first FORD vehicle. Since that time the FORD trade mark has been continuously used in connection with the promotion, advertising and sale of the Complainant's products and services.
- 5.4 FORD is the leading automotive brand in the United Kingdom. The Complainant has sold billions of dollars' worth of goods and services under the mark "FORD" and has spent billions of dollars advertising and promoting the mark "FORD" throughout the United Kingdom and around the world.
- 5.5 The FORD trade mark enjoys unquestionable fame and a very broad scope of protection as a result of extensive use and favourable public acceptance and recognition. The distinctiveness and fame of the FORD name and mark were achieved long before the Respondent registered the Domain Name.
- 5.6 The Complainant owns numerous trade mark applications and registrations for the mark FORD in the United Kingdom and worldwide. It actively enforces its trade marks and has obtained judgments against others who have made unauthorised use of the FORD trade marks in domain names. In particular, the Complainant recently succeeded in a dispute brought under the Nominet DRS Policy in respect of the domain name <newfordparts.co.uk> (DRS 12602). The domain name in question in that dispute automatically redirected users to the Domain Name the subject of this dispute.

- 5.7 The Domain Name fully incorporates the FORD mark and adds the descriptive terms “new”, “parts” and “online”. The addition of these terms does not serve to differentiate the Domain Name from the FORD mark. Rather, the use of these terms reinforces the connection of this Domain Name to the car industry and to the Complainant. The name FORD is the dominant element of the Domain Name and, thus, the Domain Name is the same or similar to the Complainant’s famous FORD trade mark.

#### Abusive Registration

- 5.8 When Internet users type the Domain Name into their Internet browser, they are taken directly to a website containing parts for Ford vehicles for sale. This website displays (among other things) images of Ford vehicles, parts for Ford vehicles for sale, and the phrase “MAY THE FORDS BE WITH YOU!!!”. It also previously displayed the Ford Oval Logo trade mark on the banner of each page of the site next to the Respondent’s company name. At the time of the Complaint the website displayed the Ford Oval Logo trade mark on images of the Respondent’s product packaging.
- 5.9 The Respondent is not legitimately connected with the Complainant’s famous FORD trade mark. It is not a Ford Main Dealer, a Ford Authorised Repairer or in any way connected to or associated with the Complainant. It is not authorised by the Complainant to use the famous FORD trade mark in the Domain Name or in its business name.
- 5.10 Any claim by the Respondent that its use of the Domain Name is legitimate because it trades under the name “NEWFORD PARTS CENTRE” is flawed and cannot be accepted. The site content does not refer to this name and the Complainant has not authorised the Respondent to use its FORD trade mark in its business name. The Respondent’s use of the Domain Name is not made legitimate by its trading under the name “Newford Parts Centre” since that business name is not being fairly used either. Further, the business Newford Parts Centre sells parts that are not genuine Ford parts as well as parts that are not new. Any argument that the business name is “Newford” and not “Ford” is unpersuasive. The Respondent is simply using both the Domain Name and its business name to trade off the fame of the Complainant.
- 5.11 The Respondent’s use of the Domain Name in connection with the sale of parts for Ford vehicles is likely to confuse Internet users into thinking that the Domain Name is connected to, or associated with, the Complainant. The Respondent registered the Domain Name to take advantage of the Complainant’s reputation in its FORD mark.
- 5.12 It is likely that consumers searching online for authorised new parts for their Ford vehicles could come across the website operated under the Domain Name, and as a result initial interest confusion is likely to arise.
- 5.13 The Complainant believes that the Respondent had actual knowledge of the Complainant’s rights in its FORD mark and the Complainant’s websites

at <ford.co.uk> and <ford.com> at the time that it registered the Domain Name.

### The Respondent

- 5.14 The Respondent's father, John Horridge, started the business known as "Newford Parts Centre" in the late 1960's. The Respondent has continued to run the business since 1987. The business specialises in new obsolete and obsolescent Ford parts.
- 5.15 The name "Newford" is used to describe the parts that the Respondent sells, which are "new" and not "used". The Respondent has been buying and selling new genuine Ford stock since the early 1970s. This stock has been acquired mainly from Ford Dealers in the knowledge that it will eventually be sold on to the general public.
- 5.16 The Respondent's main business is now controlled through its online shop, which is hosted by Neoteric UK Ltd.
- 5.17 It is widely accepted that the Complainant only stocks parts for vehicles up to 10 years of age. The Respondent stocks original parts for vehicles from the late 1920s up to around 15 years of age. It is for this reason that the Respondent receives regular telephone calls from potential customers who have been given the Respondent's name by entities associated with the Complainant.
- 5.18 The Respondent has never been in competition with the Complainant, as the parts that the Respondent sells are non-current and obsolete.
- 5.19 The Domain Name has been in operation for the past eight years, and it describes exactly what the online shop operated under the Domain Name provides. The Respondent is not affiliated with the Complainant and does not sell new parts for new Ford vehicles. Rather, it sells new parts for old Ford vehicles. It does not compete with, nor benefit from, the Complainant.

### The Reply

- 5.20 The Complainant did not submit a Reply.

## **6. Discussions and Findings**

- 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 has established rights in the distinctive mark FORD, through its numerous trade mark registrations around the world, its trading history under the mark and the resulting reputation that it has established in respect of automobiles and related products and services offered under the mark FORD. Accordingly I am satisfied that the Complainant has Rights in the mark FORD.

## Similarity

- 6.4 Disregarding the "co.uk" level, the Domain Name incorporates in its entirety the Complainant's distinctive FORD trade mark together with three other elements, namely the words "new", "parts" and "online".
- 6.5 There could have been an argument to suggest that the "Newford" element of the Domain Name has an association with something other than the Complainant's mark FORD, for example a place name. However, the Respondent has stated that "Newford" describes the automotive parts that it sells.
- 6.6 The inclusion of the word "parts" strengthens the apparent connection with the automotive industry, thus reinforcing the Domain Name's similarity to the Complainant's name and mark FORD.
- 6.7 I therefore find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

## Abusive Registration

- 6.8 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 was unfairly detrimental to the Complainant's Rights.*
- 6.9 Paragraph 3(a) of the Policy sets out a non-exhaustive list of five factors that may be evidence that a domain name is an abusive registration. The

Complainant's case is essentially based on one of these factors, namely paragraph 3(a)(ii) which states:

“Circumstances indicating that the Respondent is using or is 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;”

6.10 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, the goods of the Complainant constitutes an Abusive Registration.

6.11 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.

Applying these four considerations to the present case:

6.12.1 The Domain Name incorporates in its entirety the Complainant's well-known and distinctive mark FORD. It is evident from the materials before me that the Respondent was well aware of the Complainant and its FORD mark when it registered the Domain Name. The Respondent makes it clear in its Response that it adopted the Domain Name for its online business of providing ‘new’ (not ‘old’) parts for Ford motor vehicles.

6.12.2 Given the similarities of this case with that of DRS 12602 ([newfordparts.co.uk](http://newfordparts.co.uk)), particularly in respect of the Complainants, the Respondents and the domain names in question in both cases, I apply the same reasoning in respect of confusion as the Expert applied in DRS 12602.

In particular, other than use of the Complainant's FORD marks on the website to describe the products that the Respondent is selling, there is nothing else on that website to suggest that it has a connection with the Complainant. In fact, once at the website in question the impression given is that Newford Parts Centre is an independent firm with a history of its own. No Internet user could reasonably think, from its website, that the Respondent is associated with the Complainant.

- 6.12.3 However, I find (as the Expert did in DRS 12602) that some initial interest confusion in this case is likely. This is because the dominant element of the Domain Name is the Complainant's distinctive mark FORD, which is then prefixed with the word "new" and suffixed with the words "parts" and "online" (all of which strengthen the likelihood of an inference that the Domain Name is connected with the Complainant – for instance an Internet user may well believe that the Domain Name will resolve to a website operated by someone connected with the Complainant, for example one of its authorised dealers).
- 6.12.4 I do not believe on the balance of probabilities that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. In my view, based on the facts and submissions before me, the Respondent's motive was to adopt a Domain Name which reflected the nature of his business, namely the online trade of parts for Ford motor vehicles.
- 6.12.5 However, that is not determinative of the matter. While this was the Respondent's intention, nevertheless I believe that the Domain Name is being used in a way which has confused, or is likely to confuse internet users into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. This is because the dominant part of the Domain Name is the Complainant's distinctive trade mark. There is nothing in the Domain Name which serves to indicate to an Internet user that the Respondent is an independent business or clearly not connected with the Complainant.
- 6.13 The Appeal Panel in *Toshiba Corporation v Power Battery Inc.*, DRS 07991 provided further explanation on the fourth principle, as follows:
- "The further issue, however, is whether the fact of the offering of 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 otherwise is likely to take unfair advantage of the Complainant's rights by "riding on its coat-tails" for the benefit of the Respondent."*
- 6.14 Although the Respondent in its Response contends that it sells new genuine Ford stock, the website to which the Domain Name resolves states that "We



*do, in extreme circumstances, supply pattern parts. This is only when a part is not available and is seen as a last resort.*" The Respondent does not appear therefore to only sell the Complainant's genuine products, but also trades in generic third-party manufactured "pattern parts" (or "after parts") – i.e. parts made to be compatible with Ford vehicles and potentially therefore competing with goods manufactured and/or provided by the Complainant (or its authorised entities).

- 6.15 While it is debateable whether or not the Respondent's (limited) trade in pattern (or after) parts for Ford vehicles can be said to be an "offering of competing goods" (per the fourth *Toshiba* principle), it is clear that these pattern parts cannot be described as "genuine" products of the Complainant.
- 6.16 In any event, and following the same reasoning as that of the Expert in DRS 12602, it is my view that the Respondent's use of the Domain Name is unfair. This is because the elements of the Domain Name do not accurately reflect the Respondent's online business. That business provides genuine obsolete parts for older Ford motor vehicles, as well as pattern parts for these vehicles.
- 6.17 The Domain Name <newfordpartsonline.co.uk> more accurately describes new (rather than obsolete) parts for Ford vehicles, or indeed parts for new Ford vehicles rather than obsolete parts for older Ford vehicles. The Domain Name does not contain anything which would help distinguish itself from the Complainant, or from the Complainant's network of authorised dealers (by the use of, for example, "independent"). Further, the parts that the Respondent sells might arguably be more fairly described as "parts for Fords" and not "Ford parts". This, coupled with the finding of initial interest confusion, leads me to conclude that the use by the Respondent of the Domain Name is unfair.
- 6.18 It is hard to envisage a scenario where the Respondent can realistically promote his business without using the FORD mark, but its manner of use within the Domain Name is, as stated above, confusing. There are likely to be ways in which use of the FORD mark would legitimately promote the Respondent's business but which avoids the likelihood of confusion (whether that be through initial interest confusion or otherwise). Accordingly, this is not a case of nominative, fair use.
- 6.19 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 I find that the Complainant has Rights in the mark FORD which is similar to the Domain Name, and further that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I therefore direct that the Domain Name should be transferred to the Complainant.

**Signed Ravi Mohindra Dated 12 October 2014**