

## Dispute Resolution Service

DRS15515

Decision of Independent Expert

**Deere & Company**

and

**Paul O'Gorman**

### 1. Parties

Complainant : Deere & Company  
One John Deere Place  
Moline  
Illinois  
61265-8098  
United States

Respondent : Paul O'Gorman  
27 St Michaels Road  
Melksham  
Wiltshire  
SN12 6HN  
United Kingdom

### 2. Domain Name

johndeerereactors.co.uk (the "Domain Name")

**3. Procedural Background**

On 16<sup>th</sup> February 2015 the Complaint was lodged with Nominet UK Limited (“Nominet”) and validated on 17<sup>th</sup> February 2015. On 17<sup>th</sup> February 2015 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising him to log into his account to view the details of the Complaint, and giving him 15 business days within which to lodge a Response on or before 10<sup>th</sup> March 2015.

On 3<sup>rd</sup> March 2015 the Respondent responded. On 3<sup>rd</sup> March 2015 Nominet informed the Complainant that the Response was available to be viewed via the Complainant’s online services account, and inviting it to Reply to the Response on or before 10<sup>th</sup> March 2015. On 10<sup>th</sup> March 2015 the Complainant replied and Nominet informed the Respondent that the Reply was available to be viewed via the Respondent’s online services account. Mediation documents were generated for the Complaint, and mediation commenced on 13<sup>th</sup> March 2015. Mediation was unsuccessful and concluded on 23<sup>rd</sup> March 2015.

On 8<sup>th</sup> April 2015 the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 14<sup>th</sup> April 2015 Mr. Niall Lawless (“the Expert”) was appointed to act as Expert in this dispute, he is required to give his Decision by 6<sup>th</sup> May 2015. Mr Lawless has confirmed that he knew of no reason why he could not properly accept the appointment, and knew of no matters which ought to be drawn to the attention of the parties which might appear to call in to question his impartiality and -/- or independence.

**4. Outstanding Formal -/- Procedural Issues**

There are no outstanding formal or procedural issues.

**5. Factual background**

The Complainant, Deere & Company, is an American corporation based in Moline, Illinois, USA. The Complainant is involved in the design, development, production and sale of agricultural, construction and forestry equipment and machinery, diesel engines, lawn-care equipment, and related products and services. It is the proprietor of numerous European Community trademark

registrations for the words John Deer. The Respondent is Mr. Paul O'Gorman. The Respondent registered the Domain Name on 5<sup>th</sup> October 2009.

## 6. The Parties' contentions

### The Complainant

The Complainant seeks transfer of the Domain Name. The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration because:-

- The Respondent is not associated or affiliated with the Complainant, the name John Deere or associated trademarks; nor has the Respondent entered into any agreement with the Respondent in respect of registering or using the Domain Name.
- The Respondent's use of the Domain Name is abusive because it was intentionally registered and used for unfairly disrupting the business of the Complainant. The evidence of abuse is that the Domain Name points to a parking page, containing sponsored links to websites and pages containing competing products manufactured by direct competitors of the Complainant.
- The Respondent's use of the Domain Name creates a likelihood of confusion because existing or prospective customers of the Complainant will believe that it is officially authorised by the Complainant and for the purpose of selling or promoting the Complainant's own products.
- The Respondent's use of the Domain Name is an infringement and misuse of the Complainant's trademark rights.

### The Respondent

The Respondent says that the Domain Name is not an Abusive Registration because:-

- The Domain Name has not been used in a way to imply or pretend that the Complainant controls it.
- The Domain Name has not been active in the full period since its purchase.

## 7. Discussions and Findings

### 7.1 General

Nominet's DRS Policy requires that for a Complaint to succeed the Complainant must 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

The Complainant is required to prove to the Expert that the Complainant has Rights in respect of a name or mark identical or similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

## 7.2 Complainant's Rights

The Complainant is Deere & Company, involved in the design, development, production and sale of agricultural, construction and forestry equipment and machinery, diesel engines, lawn-care equipment, and related products and services. The Complainant has provided evidence that it has numerous trademark registrations for the words "John Deere" in Europe and around the world. The Complainant operates numerous country-level domains using the name "deere", and the websites [www.johndeere.com](http://www.johndeere.com) and [www.johndeere.co.uk](http://www.johndeere.co.uk). It is clear that the Complainant has rights in the name "John Deere".

Although the Domain Name includes the letter "s" and the word "tractors", the dominant factor in the Domain Name is clearly the name "John Deere". The additional word "tractor" identifies one of the products for which the Complainant enjoys international renown, and the letter "s" simply implies possession or ownership. The additional letter or word fails to distinguish the Domain Name from the Complainant's name.

Because of the above, I decide that the Complainant has Rights in respect of a name or mark that is similar to the Domain Name.

### 7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy, but it does not state under which part (s) of the Policy. Under Paragraph 3 - Evidence of Abusive Registration - guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

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

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(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;

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainant has Rights; or

3(a)(i)(C). for the purpose of unfairly disrupting the business of the Complainant;

3(a)(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 ...”

#### Unfairly disrupting the business of the Complainant

The Complainant says that the Respondent’s use of the Domain Name is abusive because it was intentionally registered and used for unfairly disrupting the business of the Complainant. It says evidence of abuse is that the Domain Name points to a parking page, containing sponsored links to websites and pages containing competing products manufactured by direct competitors of the Complainant. In its Complaint, the Complainant includes a 13<sup>th</sup> February 2015 screenshot of a parking page the Domain Name resolved to; and in its Reply, the Complainant includes a 10<sup>th</sup> March 2015 screenshot of a parking page the Domain Name resolved to.

The Respondent refers the Expert to the website link: [www.domaintools.com/research/screenshot-history/johndeerestractors.co.uk](http://www.domaintools.com/research/screenshot-history/johndeerestractors.co.uk). He says that because the “DomainTools” website history does not have any previous screenshots for the Domain Name, it proves the Domain Name has not been used unfairly.

Notwithstanding the Respondent’s assertion, the Complainant’s 13<sup>th</sup> February 2015 and 10<sup>th</sup> March 2015 screenshots show that the Domain Name has been used, and has resolved to webpages with sponsored links to competitors of the Complainant, for example Ford, Kuboto, New Holland and Siromer.

This demonstrates that the Respondent used the Domain Name to resolve to webpages containing click-through links to third party websites operating in the same market and offering competing products and services to the Complainant. On the date of writing this decision the Domain Name routes via Sedo to a domain name parking webpage (domain name parking allows owners of domain names to earn money by displaying relevant advertisements).

This disrupts the Complainant’s business in two ways. The Domain Name directs the user to third party products and services depriving the Complainant of commercial opportunity. In addition, if the user is not finding what they expect they may lose interest or begin to search for a competitor’s products or services.

The Respondent’s use of the Domain Name in this way unfairly disrupts the Complainant’s Business and is evidence of circumstances falling within paragraph 3(a)(i)(C) of Nominet’s DRS Policy. However, the test under Nominet’s DRS Policy 3(a)(i)(C) is not that the Domain Name is unfairly disrupting the Complainant’ Business, but that it was acquired for that purpose.

To help me decide if the Domain Name was acquired for that purpose, I would usually have to consider the prominence of the Complainant’s brand and reputation as it would have existed on 5<sup>th</sup> October 2009, the date the Respondent registered the Domain Name. However, in this dispute it is not necessary to do so.

The Domain Name is “johndeeretractors.co.uk”. The choice of the word “tractors” was not random. It is almost certain the Respondent’s choice of the word “tractors” was rational, and selected for incorporation in to the Domain Name only because the Complainant is famous for the manufacture of tractors.

Because of this, I decide that the Respondent was aware of the “John Deere” name and brand when he registered the Domain Name, and consciously chose a domain name incorporating the John Deere trademarks and one of Deere & Company’s well-known products.

When that is linked with the Respondent’s subsequent use of the Domain Name resolving to direct competitors of the Complainant, I decide that the Domain Name was acquired to unfairly disrupt the Complainant’s business and under the test in Nominet’s DRS Policy 3(a)(i)(C) in the control of the Respondent the Domain Name is an Abusive Registration.

In light of this finding, it is unnecessary for me to address the other contentions of the Complainant.

#### 7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name identical or similar to the Domain Name and that the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

### 8. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name be transferred to the Complainant.

**Niall Lawless, Nominet Expert**

**14<sup>th</sup> April 2015**