

DISPUTE RESOLUTION SERVICE

D00016004

Decision of Independent Expert

Toyota Tsusho Automobile London Holdings Limited

and

bali breeze

1. The Parties:

Complainant: Toyota Tsusho Automobile London Holdings Limited
The Hyde
Edgware Rd
London
NW9 6BH
United Kingdom

Respondent: bali breeze
1220 Liberty Way #B
Vista
California
92081
United States

2. The Domain Name:

jemca.co.uk

3. Procedural History:

I can 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 be disclosed as being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

29 May 2015 15:44 Dispute received

01 June 2015 11:58 Complaint validated
01 June 2015 12:13 Notification of Complaint sent to parties
18 June 2015 02:30 Response reminder sent
23 June 2015 11:21 No Response Received
23 June 2015 11:21 Notification of no Response sent to parties
23 June 2015 13:17 Expert decision payment received

4. Factual Background

The Complainant has 8 Toyota and 4 Lexus authorised franchise outlets at different locations within the UK.

It is the only Toyota franchise in the UK selling Toyota and Lexus new and used vehicles with Toyota backed after-sales facilities using the trading name, Jemca. All outlets use the trading name and brand name Jemca and Toyota, which are displayed at the front of its facilities.

The Complainant owns the domain name <jemcacargroup.co.uk>.

Nothing is known of the Respondent other than it is the registrant of the domain name, jemca.co.uk (hereafter the Domain Name), which was registered on 17 March 2008. The Domain Name resolves to a motor car orientated website.

5. Parties' Contentions

What follows represents a summary of what is said by the Complainant in its Complaint.

The Domain Name is identical to the Complainant's Jemca trading name, a name in which it enjoys unregistered rights.

The Complainant has acquired a good reputation in the Jemca name.

The Complainant contends that the Respondent is cybersquatting and that the website to which the Domain Name resolves has been registered to cause confusion.

Neither the links nor associated web pages on the Respondent's website mention the Complainant as a franchise selling Toyota or Lexus vehicles.

The Respondent's website contains links to competitors of the Complainant which could cause confusion and divert users to competitor sites. The Respondent's use of the Domain Name could result in a loss of profit and cause damage to the Complainant's reputation and brand. Moreover, other suppliers of the same goods and services as the Complainant may benefit from an unfair advantage in the UK market.

The Complainant, through an intermediary, has attempted to contact the Respondent with a view to purchasing the Domain Name but contact has proved difficult and no purchase has been effected.

The Respondent has taken no part in these proceedings despite proper notifications having been sent to it by Nominet.

6. Discussion and Findings

Under the provisions of the DRS Policy (the Policy), for a Complaint to succeed, a Complainant is required to prove, 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 in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's Rights

The meaning of 'Rights' is defined in the Policy as follows: *'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'*.

The Complainant has not claimed to be the proprietor of any registered trade mark but that matters not as long it can show rights of some sort which are enforceable. Where a complainant has no registered rights to rely on, rights afforded by the law of passing off are often used to found a complaint. Thus, where either goodwill or reputation in a name or mark can be demonstrated, such goodwill or reputation being ordinarily protectable under the law of passing off, a complainant would usually be treated as having Rights for the purposes for the Policy. (There is no need to consider the other elements of passing off – misrepresentation and damage, because Experts under the DRS are not deciding whether there has in fact been passing off, but only that a complainant has enforceable rights and therefore standing to bring a complaint).

The Complainant has not submitted much in the way of evidence of its Rights and the Expert found it appropriate to look at the Complainant's website in this regard (as he is permitted to do under paragraph 16(a) of the DRS Procedure). The Expert notes that the website refers to Toyota Tsusho Automobile North London Ltd and Toyota Tsusho Automobile South London Ltd as being the proprietors of the Jemca Car Group trading name (with the Group itself stated to be owned by the Toyota Tsusho Corporation), but gives the benefit of the doubt to the Complainant that it is the appropriate entity to bring the Complaint.

Having done so, the Expert must consider whether the Complainant has demonstrated that the rights it claims are sufficient to establish Rights for the purposes of the Policy.

As has been stated in many DRS decisions, the test for demonstrating Rights is at a relatively low threshold, the objective behind this first hurdle being to demonstrate a bona fide basis for the making of a complaint. In all the

circumstances, the Expert is satisfied that the Complainant has Rights for the purposes of the Policy.

Similarity

Ignoring the suffix '.co.uk' as Experts are permitted to do when carrying out a comparison, the Domain Name and trading name of the Complainant are identical.

The Expert finds that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name.

Accordingly, it is necessary to consider whether the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'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 which *'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights;'*

A useful guide as to what might constitute an Abusive Registration is contained in paragraph 3(a) of the Policy. It contains a non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily for the purposes of selling, renting or otherwise transferring the domain name to the complainant (or a competitor) for valuable consideration in excess of the respondent's out-of-pocket costs, as a blocking registration against a name or mark in which a complainant has rights, or for the purpose of unfairly disrupting the business of a complainant.

Other factors suggesting an Abusive Registration include a respondent using or threatening to use a 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. It is this example which seems to most closely encapsulate the Complainant's complaint.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This paragraph contains a useful guide as to what does not constitute an Abusive Registration. It includes factors such as the respondent, before being aware of the Complainant's cause for complaint, *'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'*, or has *'been commonly known by the name or legitimately*

connected with a mark which is identical or similar to the Domain Name', or has 'made legitimate non-commercial or fair use of the Domain Name'.

Discussion

The Domain Name incorporates the Complainant's Jemca mark and there is a likelihood that internet users will be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. Even if, once the internet user arrives at the website to which the Domain Name resolves, they immediately realise, perhaps because of the variety of offerings there, that it is not the website of the Complainant, the fact that there has been this initial confusion, or 'initial interest confusion' as it has come to be known, can provide a basis for a finding of Abusive Registration. On the face of it therefore, absent any persuasive countervailing factors, there are grounds for a finding of Abusive Registration.

Moreover, in circumstances where an identical or similar domain name resolves to a website offering or providing access to goods or services competitive with those of a complainant, there is likely to be a finding of Abusive Registration, regardless of any confusion. Having looked at the Respondent's website as well as the Complainant's (again as permitted under paragraph 16(a) of the DRS Procedure), the Expert is satisfied that competitive goods are offered or available through the website to which the Domain Name resolves. (The Expert should note that there does in fact appear to be a link to the Complainant's website contrary to what has been suggested, but that matters not for the purposes of the present analysis).

In its brevity, the Complaint does not provide information about when the Complainant first used the mark, Jemca. The Domain Name was registered some time ago, on 17 March 2008. The home page of the Complainant's website provides some history and states '*Jemca Car Group was formed from the successful amalgamation of Jemca in North London and the McCarthy Group in South London in 2003*'. Accordingly, the Domain Name, despite its registration some years ago, still post dates use of the Jemca mark by the Complainant (or a related company).

No information is provided as to when the Respondent first started to use the Domain Name in the way that it does. However, as set out earlier, the Policy enables a finding of Abusive Registration where there has been use of a domain name, subsequent to its registration, which has taken unfair advantage of or which is unfairly detrimental to the Complainant's Rights. The Respondent clearly had the Complainant in mind when establishing its website given the emphasis on Toyota/Lexus vehicles, whatever its position might have been at registration.

In all the circumstances, the Expert is satisfied that the Complainant has established its case and is further satisfied, the Respondent having failed to provide or attempt to provide any answer to the case, that there are no circumstances that might suggest a finding of Abusive Registration to be inappropriate.

7. Decision

The Expert finds that the Complainant has rights in a name or mark that is identical to the Domain Name and is satisfied that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name, < jemca.co.uk>.be transferred to the Complainant.

Signed Jon Lang

Dated 8 July 2015