

DISPUTE RESOLUTION SERVICE

D00017223

Decision of Independent Expert

Ford Motor Company

and

Ford Parts UK

1. The Parties

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

Respondent: Ford Parts UK
Ford Parts Unit 10-11
Brama Teams Industrial Park Team S
Gateshead
NE8 2RG
United Kingdom

2. The Domain Name

fordpartsuk.co.uk

(‘the Domain Name’)

3. Procedural History

Nominet checked that the complaint received on 16 March 2016 complied with its UK Dispute Resolution Service ('DRS') Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint and invited it to file a response. No response was received so mediation was not possible and, on 12 April, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 20 April.

On 27 April I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I have confirmed that I am independent of each of the parties and that, 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 they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

4. Factual Background

I have visited the website at the Domain Name and the Complainant's main websites at <ford.com> and <ford.co.uk>. From those visits, the complaint and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant is a United States company that designs, builds and sells motor vehicles. It also services and repairs such vehicles and sells vehicle parts. It has been marketing motor vehicles under the name 'Ford' since at least 1903. The Complainant has registered as trade marks both the name 'Ford' and a logo bearing the name 'Ford', in script, within a blue oval. There is a comprehensive list of the Complainant's global trade marks, including those in force in the UK, attached in support of the complaint. The Complainant's first registration for 'Ford', covering 'automobiles and their parts', was in 1909. It has since sold billions of dollars' worth of goods and services under the mark 'Ford' and has spent billions of dollars advertising and promoting the name 'Ford' throughout the United Kingdom and around the world. In 2015, Interbrand ranked 'Ford' as number 38 on its list of 'Top 100 Best Global Brands'.

The Complainant registered the domain names <ford.com> and <ford.co.uk> in August 1988 and August 1996, respectively, and uses both as websites.

Information about the Respondent is limited largely to what can be gathered or inferred from the website at the Domain Name, which was registered on 11 March 2004.

The home page of the website at the Domain Name carries what appears to be the business name 'Ford Parts' and says it was established in 1989. The main section of text says:

New and used Ford spares at Trade Prices to the public.
23 Years of Mail Order and Export Experience.

Ford Parts is the largest licensed, indoor Ford dismantler in the North East.

Our purpose built dismantling site in Gateshead, Tyne & Wear meets all the requirements of the *"End of Life Vehicle (ELV) Directive"*. Our tested and guaranteed parts are stored indoors on racking systems and sold throughout the UK and world-wide, as well as across the North East. With a 30,000 sq foot site our stock is changing daily making it hard to beat us on price.

Why buy used from Ford Parts?

1. Trade prices to the public.
2. 23 years of experience in Fords.
3. The right part first time.
4. All used spares are genuine Ford quality parts, not lesser quality pattern parts.
5. Don't waste the World's resources and your cash on a new part when a used part is waiting for you.

As an Authorized Treatment Facility we are approved to collect and dispose of your scrap cars in compliance with EEC regulations. DVLA Certificate of Destruction issued on site.

Breaking all Ford models from the past 20 years up to date. Fords are our speciality so you'll find our trained team helpful, knowledgeable and able to offer practical, cost-effective advice.

Below this text is a search box, inviting visitors to 'view a selection of our breakers'. There then appears to be a choice between searching on 'Ford' and searching on 'all types' but either way the models listed appear all to be made by Ford.

The footer bears the following text:

FORD PARTS - Brama Teams Industrial Park - Ropery Road -
Dunston - Gateshead - Tyne & Wear - NE8 2RD.

Copyright FordPartsUK © 2012. All Rights Reserved.

Ford Parts have no association with the Ford Motor Company. We are not a main dealer nor do we charge main dealer prices.

There are six tabs at the top of the home page. One of those tabs is for the home page itself. The other five, which lead to further pages, are:

Recycle
Currently Breaking
Workshop and Parts
Find Us
Contact Us

The text at the 'Recycle' tab includes the following:

"The Largest Licensed Dismantler of End of Life Vehicles (ELV) in the North East."

Environment Agency Approved

Auto Recycling Centre buyers of all makes and models of unwanted cars, MOT failures, unfinished projects, crash-damaged and write-offs. The Largest Licensed Dismantler of End of Life Vehicles (ELV) in the North East.

We sell only Ford parts. All other makes are recycled.

The 'Currently Breaking' tab opens a web page in a separate window and offers access to a 'Parts database'. Whether these are filtered to include only Ford items, or left unfiltered ('Display all types'), the results returned are all related to Ford vehicles.

Just above the footer in the 'Contact Us' tab there is the following text:

Igloo Homes Ltd. Trading as Ford Parts.
Company Number 3824713

Registered address: Brama Teams Industrial Park, Ropery Road,
Dunston, Gateshead. NE8 2RD

On 11 March 2004, the Respondent also registered the domain name <autorecyclingcentre.co.uk>.

Igloo Homes Limited, which is shown as trading as Ford Parts, the Respondent here, trades as 'Spaceman Storage' at the same address and phone number as the Respondent. It registered the domain name <spacemanstorage.co.uk> on 16 June 2009.

5. Parties' Contentions

Complaint

The Complainant says it has rights in the name 'Ford' and that the Domain Name, being made up of that name, plus a modifier, is similar to the name in which it has rights.

It says that this is an abusive registration for the following reasons.

(i) The use of the name in which it has rights, as part of the Domain Name, is likely to cause confusion, causing consumers to believe mistakenly that the Respondent is in some way connected with the Complainant. It refers to the appeal decision in relation to the domain name <toshiba-laptop-battery.co.uk> (Toshiba Corporation v Power Battery Inc. - DRS 07991), where the panel summarised the factors to be taken into account in situations involving resellers or distributors of a complainant's goods. The Complainant argues that, by reference to these factors, the Domain Name is an abusive registration. On 14 May 2013 and 12 October 2014, the Complainant was successful in two other Nominet disputes relating to the domain names <newfordparts.co.uk> and <newfordpartsonline.co.uk>. The implication is that the reasoning in these decisions, which reflects the Toshiba appeal factors, applies equally here.

(ii) The Respondent's use of the Domain Name takes advantage of the reputation and goodwill of the Complainant and its 'Ford' trade mark. It is no defence to claim that the Domain Name merely reflects the Respondent's business name, because its use of the Complainant's trade mark in that name is not legitimate either. In addition, The Respondent also trades as 'Spaceman Storage' and so is not primarily known as 'Ford Parts.'

(iii) The Domain Name is not descriptive nor is it being used fairly because the Respondent cannot show that it uses the Domain Name only to sell genuine 'Ford' products. The Complainant says that 'upon information and belief', the Respondent does not only sell Ford parts. It points to some of the text from the website at the Domain Name:

Why buy used from Ford Parts?

1. Trade prices to the public.
2. 23 years of experience in Fords.
3. The right part first time.
4. All used spares are genuine Ford quality parts, not lesser quality pattern parts.
5. Don't waste the World's resources and your cash on a new part when a used part is waiting for you.

and argues that it seems unreasonable to believe that the Respondent dismantles and recycles all makes and models of vehicles, but only sells 'Ford parts'.

(iv) The Respondent also owns the domain name <autorecyclingcentre.co.uk>, which immediately redirects to a page within fordpartsuk.co.uk. It is therefore using the 'Ford' trade mark to draw traffic to

its Auto Recycling Centre business for all makes and models of unwanted cars.

(v) The Domain Name is not legitimately being used non-commercially nor does its commercial use constitute a bona fide offering of goods or services.

(vi) The Respondent's purpose in using the Domain Name is to disrupt the Complainant's business and it is therefore acting in bad faith.

Response

There has been no response.

6. Discussion and Findings

To succeed in this complaint, the Complainant must 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; and that
- the Domain Name, in the hands of the Respondent, is an abusive registration.

Rights

The Complainant has been using the name 'Ford' for decades and has spent billions of dollars promoting it. In addition to the goodwill it will have built up in this way, it also has long-established registered rights in the name.

Ignoring the .co.uk suffix as simply a characteristic of Nominet's domain name register, the Domain Name is made up of the name in which the Complainant has rights and the terms 'parts' and 'uk'. Neither of those additions seems to me to lessen the significance of the name 'Ford' in the Domain Name. The name 'Ford' appears to me to be similar to the Domain Name.

I conclude that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name.

Registration

As defined by the Policy, an abusive registration is a domain name which:

- 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

- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is, or is not, an abusive registration and the complaint touches on a number of them. But at the heart of the Complainant's reasoning here is the appeal decision in relation to the domain name <toshiba-laptop-battery.co.uk> and the two first instance DRS decisions that reflect the principles highlighted there. I therefore analyse the Toshiba decision and apply it here; analyse the two first instance decisions and compare them with the present case; and consider the Complainant's other arguments.

toshiba-laptop-battery.co.uk

In *Toshiba Corporation v Power Battery Inc.* (DRS 07991) the appeal panel considered the registration and use of the domain name <toshiba-laptop-battery.co.uk> and summarised the factors to consider in situations involving resellers or distributors of a complainant's goods. The factors identified were 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 (*sic: the appeal panel here clearly meant the incorporation in the domain name of the name in which the complainant had rights*) is unfair. One such reason is the offering of competitive goods on the respondent's website.

In relation to 'initial interest confusion' (3 above) the *Experts' Overview* (section 3.3) says:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose. In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and

expectation that the web site is a web site 'operated or authorised by, or otherwise connected with the Complainant.' This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with...a commercial web site, which may...advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name...

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)...The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration.

The panel in the Toshiba appeal went on to amplify 4 above:

The further issue...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. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated.

The false implication that there is a commercial connection between a respondent and a complainant turns on there being confusion. In the words of the relevant factor in the Policy, that means using the domain name in a way likely to confuse people or businesses into believing that it is somehow connected with the complainant.

In the absence of evidence of confusion in this case I have to take a view about its likelihood. The probability of initial interest confusion here seems to me to be low. Adding the word 'parts' to a trade mark in a domain name may not make much difference, either way, to how strongly there is an implied connection with the owner of the trade mark. But here there is the addition of 'uk' too, in this context sitting awkwardly alongside the 'uk' element of the .co.uk prefix. In my judgement, that clunking repetition of 'uk' is not something internet users would typically associate with the rights holder, who might more naturally be expected to use something more direct (as indeed the Complainant does here, with <ford.co.uk> and <ford.com>). It seems to me, in

the words of the *Overview*, to take the Domain Name further away from the Complainant's name, and to materially reduce the chance that anyone seeing the Domain Name would infer that it is connected with the Complainant.

In the Toshiba appeal, the panel noted that the complainant had neither presented evidence of actual confusion, nor argued that anyone who visited the website to which the domain name resolved would believe it to be an official Toshiba site. The panel continued:

The only remaining possibility of confusion, therefore, would appear to involve 'initial interest confusion', i.e. circumstances where Internet users will visit the Respondent's site in the first place because they have been led to believe it is a site operated or authorised by or otherwise connected with the Complainant.

The Panel does not believe that any reasonable Internet user who was looking to find an official Toshiba UK website in order to buy a genuine Toshiba battery would actually type the address www.toshiba-laptop-battery.co.uk. However, 'initial interest confusion' could arise where, as is much more likely, a user types the terms 'toshiba laptop battery' into a search engine and is then presented with a range of results including the Respondent's website address incorporating the Domain Name. The question is whether the Internet user would, at that point, be confused into believing that the Respondent's site was operated or authorised by the Complainant or was otherwise connected with the Complainant.

The view of the majority of the Panel is that the Complainant has not demonstrated, on the balance of probabilities, that the Respondent's use of the Domain Name would be likely to give rise to any such confusion. The majority panelists do not consider that either the Domain Name itself or the results of a search of the terms in question would be likely to result in any such confusion in the mind of the average Internet user, bearing in mind that a typical search page includes a short description of each 'hit' as well as the actual domain name. So far as the name itself is concerned, the majority Panel believes that the Domain Name in this case falls into a very different category from cases involving the 'unadorned' use of a trade mark (e.g. <toshiba.co.uk>), where Internet users may be presumed to believe that the name belongs to or is authorised by the complainant. In this case, two extra hyphenated words turn the domain name as a whole into a rather clear description of the main goods on offer at the website (replacement batteries for Toshiba laptop computers). In addition, this lengthy 'adornment' may reasonably be seen as atypical of the usage of major rights owners, who are free to use much shorter unadorned names.

The difficulty of the decision here is reflected in the fact that this was a majority view – there was one member of the panel who took a different line and decided that the threshold for 'initial interest confusion' was lower – and

that it was passed in that case. These are questions of fine judgement in which it is possible for different people quite reasonably to reach different conclusions. The Toshiba appeal panel decided overall that the domain name <toshiba-laptop-battery.co.uk> was an abusive registration, but because there was competitive selling, not because there was confusion. The majority view expressed by the panel seems to me essentially to cover the present situation. In particular:

two extra...words turn the domain name as a whole into a rather clear description of the *main* goods on offer at the website (replacement *batteries* for *Toshiba laptop computers*)

becomes:

two extra...words turn the domain name as a whole into a rather clear description of the *only* goods on offer at the website (replacement *parts* for *Ford motor vehicles*).

The Policy (paragraph 10 c) says that appeal decisions do not create binding precedents but will have 'persuasive' value to experts in future decisions. On balance, I am persuaded that there is no material prospect of 'initial interest' confusion here.

It also seems plain that, once at the website, visitors are clear that there is no connection between the Respondent and the Complainant – even before they come across the express disclaimer. That disclaimer –

Ford Parts have no association with the Ford Motor Company.

– puts the matter beyond doubt. There is no confusion there either.

With the factors identified in the Toshiba appeal in mind, that leaves the question of whether there is an 'offering of competitive products' on the website. The text there says that the Respondent only sells Ford parts. The Complainant asserts otherwise ('on knowledge and belief...') but offers no evidence for that assertion. Such evidence as there is points the other way. The screenshot highlighted by the Complainant says:

All used spares are genuine Ford quality parts, not lesser quality pattern parts.

The 'recycling' tab at the website does say that the Respondent (or a linked business) breaks and recycles all makes of vehicle but in my judgement it is too much of a stretch to say that this is an offering competing with the Complainant's sales of new cars or car parts.

Taking all that into account in relation to the Toshiba factors:

1. this analysis proceeds on the basis that it is not automatically unfair for a reseller to incorporate a trade mark into a domain name and that the

question of abusive registration will depend on the facts of each particular case.

2. it does not seem to me that the effect of the Respondent's use of the domain name is falsely to imply a commercial connection with the Complainant.

3. on that basis, the question does not arise of how such an implication might have been created.

4. I do not find that, in this case, there are other reasons why the reseller's incorporation of the Complainant's trade mark is unfair. In particular, there is no offering of competitive goods on the Respondent's website. The Respondent is not taking unfair advantage of the Complainant's rights by 'riding on its coat-tails'.

I now review the two other decisions referred to in the complaint that involve the Complainant and that turn on the same factors.

newfordparts.co.uk and newfordpartsonline.co.uk

Ford Motor Company v Nicholas Horridge t/as Newford Parts Centre (DRS 12602) concerned the domain name <newfordparts.co.uk>. Briefly, the facts were that the respondent was using the website at the domain name to sell both genuine obsolete Ford parts and third party 'pattern' parts designed to be compatible with Ford cards. The domain name redirected traffic to a website containing a page headed 'links to other Ford sites' which the complainant argued (though the expert disagreed) implied that the respondent's site was a 'Ford' site.

The expert decided that the domain name was an abusive registration for the following reasons.

(i) There was confusion. The content at the website did not imply a connection with the complainant so, once internet traffic had arrived, there was no confusion. But there was 'initial interest' confusion because

- the domain name included the complainant's name plus the additional word 'parts', strengthening the apparent connection with car industry and, if anything, reinforcing the similarity between the domain name and the name in which the complainant had rights.
- the goods being sold related to the complainant's goods.

(ii) The domain name was not fairly descriptive of the respondent's business because what were being sold

- were mainly obsolete parts, not 'new' ones

- included not only parts made by the complainant but also parts manufactured by third parties and compatible with Ford vehicles.

(iii) It simply did not feel fair that the respondent's business name was designed to incorporate the complainant's name – and that unfairness was also reflected in the domain name.

Ford Motor Company v Neoteric UK Ltd (DRS 14578) concerned the domain name <newfordpartsonline.co.uk>. The respondent was using the website at the domain name to sell parts for Ford vehicles. At one time that website also contained the oval Ford logo. The parts being sold were mostly genuine though obsolete Ford parts, but also, 'as a last resort', pattern parts.

The expert decided that the domain name was an abusive registration for the following reasons.

(i) Again, there was confusion. The content at the website did not imply a connection with the complainant so, once internet traffic had arrived, there was no confusion. But there was initial interest confusion because

- 'new', 'parts' and 'online' all strengthened the likelihood of internet users inferring that the domain name was connected with the complainant (for example, expecting that the domain name would resolve to a website operated by one of the complainant's authorised dealers)
- there was nothing in the domain name that served to indicate to an internet user that the respondent was an independent business or clearly not connected with the complainant.

(ii) The domain name was not fairly descriptive because the respondent's business sold parts that were

- obsolete, not 'new'
- pattern - i.e. made by third parties, not by the complainant.

(iii) The availability of pattern parts through the website at the domain name meant that the respondent was potentially offering goods made by competitors of the complainant.

Looking across both cases, the common reasons why the registrations were regarded as abusive were that:

- use of the domain names caused or was likely to cause confusion
- the domain names were not fairly descriptive of what was on offer at the website to which they resolved

- what was for sale included, or potentially included, goods from competitors of the complainant.

In the present case, by contrast,

- there is no evidence of confusion and in my judgement, no prospect of actual confusion once at the website and no material likelihood of initial interest confusion before traffic arrives there
- the Domain Name is an accurate description of what is on offer at the website
- there is no evidence of sales of goods made or supplied by competitors of the Complainant.

Using the numbering in section 5 above, that covers the Complainant's arguments about (i) confusion, and (iii) the extent to which Domain Name is descriptive or being used fairly.

other arguments

I now deal with the Complainant's other arguments:

(ii) that the business name itself is not legitimate – either because it is not right for the Respondent to use the Complainant's trade mark or because it is not an accurate description because the Respondent also trades as 'Spaceman Storage' and so is not primarily known as 'Ford Parts'. I take no view about the legitimacy of the business name and confine my assessment to the character of the Domain Name. The name of the Respondent's other trading ventures, and whether or not it is known 'primarily' as 'Ford Parts', does not seem to me to be relevant to that question.

(iv) that an adverse conclusion is to be drawn from the fact that the Respondent also owns the domain name <autorecyclingcentre.co.uk> and that traffic to that site is immediately redirected to a page at the website to which the Domain Name resolves. The Complainant says that this is evidence that the Respondent is using the 'Ford' trade mark to draw traffic to its Auto Recycling Centre business for all makes and models of unwanted cars. But as described the traffic is actually in the opposite direction: the Respondent is using <autorecyclingcentre.co.uk> to draw traffic to the website at the Domain Name. I do not see that this helps the Complainant's case.

(v) that the Domain Name is not being used non-commercially and that its commercial use does not constitute a bona fide offering of goods or services. The Policy's list of factors that may be evidence that a domain name is not an abusive registration includes circumstances where, before being aware of the complainant's cause for complaint, the respondent has made legitimate non-commercial or fair use of the domain name or has used the domain name in connection with a genuine offering of goods or services. I agree that use here is not 'non-commercial', so this factor is irrelevant, but it

seems clear that the commercial use of the Domain Name does reflect a genuine offering of goods.

(vi) that the Respondent's purpose in using the Domain Name is to disrupt the Complainant's business and that it is therefore acting in bad faith. To accept this argument would be to conclude that whenever there is intentional disruption to a complainant's business there must be bad faith. Within the terms of the Policy that is not an inevitable conclusion and I make no finding of bad faith here.

summary

In summary, it seems to me that, in this case:

- there is no realistic likelihood of confusion, initial or otherwise
- the Respondent is not riding on the Complainant's coat-tails, gaining an unfair advantage by using a name in which the Complainant has rights in order to attract business. Rather, the Respondent is using the name in which the Complainant has rights to describe the goods it is offering commercially
- on the evidence before me, at the website to which the Domain Name resolves there is no offering of goods from manufacturers or sellers in competition with the Complainant
- there is no attempt to disrupt the Complainant's business
- the Domain Name is descriptive and fair, reflecting a genuine commercial offering.

Some of these judgements are fine but, based on them, the Complainant has not discharged its obligation to prove, on the balance of probabilities, that either registration or use of the Domain Name takes unfair advantage of or is unfairly detrimental to its rights.

7. Decision

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name but that the Domain Name, in the hands of the Respondent, is not an abusive registration.

In the light of that, I direct that the Domain Name be left undisturbed.

