

DISPUTE RESOLUTION SERVICE

D00019811

Decision of Independent Expert

AUDI AG

and

Mr Greg Brown

1. The Parties:

Lead Complainant: AUDI AG
AUDI AG
I/EZ-11
Ingolstadt
Bavaria
85045
Germany

Respondent: Mr Greg Brown
Unit 4
Lulworth Business Centre
Nutwood Way, Totton
Southampton
Hampshire
SO40 3WW
United Kingdom

2. The Domain Name:

<myaudi.uk>

3. Procedural History:

3.1 The procedural history of this matter is as follows:

02 February 2018 14:16 Dispute received
05 February 2018 09:32 Complaint validated
05 February 2018 09:46 Notification of complaint sent to parties
07 February 2018 17:13 Response received
07 February 2018 17:13 Notification of response sent to parties
12 February 2018 01:30 Reply reminder sent
12 February 2018 12:07 Reply received
12 February 2018 12:22 Notification of reply sent to parties
12 February 2018 12:22 Mediator appointed
15 February 2018 09:58 Mediation started
12 March 2018 17:23 Mediation failed
12 March 2018 17:54 Close of mediation documents sent
15 March 2018 09:30 Expert decision payment received

3.2 I have confirmed to Nominet that I am independent of each of the parties. I have further confirmed 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 in to question my independence in the eyes of one or both of the parties.

4. Factual Background

4.1 The Complainant is a well known car manufacturer. It manufactures and sells its vehicles around the world, with approximately 1.9 million vehicles being sold in 2016, generating revenues in excess of €59 billion.

4.2 The Complainant is the owner of various trade marks around the world. They include:

- (i) Registered European Trade Mark no 18812 for the word mark "Audi" in classes 09, 12, 14, 16, 18, 20, 25, 27, 28, and 37 dated 1 April 1996; and
- (ii) Registered UK Trade Mark no 2319367 for the word mark "Audi" in classes 12 and 37 dated 23 December 2002.

4.3 The Domain Name was registered on 21 July 2015.

- 4.4 As at the date of this decision the Domain Name diverts internet users to a Youtube page that displays three videos, which appear to have been posted between September 2016 and February 2017. In the first of these a person describing himself as “Greg from My audi” is shown commenting upon an “Audi A6 Avant Black Edition” that he is collecting from an Audi dealer in Southampton in December 2015. The other two appear to feature “Greg” discussing his car.
- 4.5 The Respondent appears to be an individual located in the United Kingdom. He appears to have used a business address for the Domain Name registration.

5. Parties’ Contentions

The Complaint

- 5.1 The Complainant contends that the Domain Name is confusingly similar to its AUDI trade marks, in that it incorporates that term in its entirety with the prefix “my”. That prefix is said not to distinguish the Domain Name from the Complainant’s marks.
- 5.2 The Complainant contends that the Domain Name has been passively held since registration and has simply resolved to a “parking site”. However, the Complainant attaches no evidence (such as for example a print out of that holding page) to support that assertion.
- 5.3 The Complainant further contends that the Respondent must have known of the Complainant at the time the domain name was registered.
- 5.4 The Complainant also claims that a speculative visitor to any site operating from the Domain Name would expect the website to be operated by, authorised by or connected to the Complainant. It relies in this respect upon “initial interest confusion” even if it is apparent when the internet user reached the webpage operating from the Domain Name that the webpage is not operated by the Complainant. In this respect it quotes from paragraph 3.3 of Version 3 of the Nominet Expert Overview.

The Response

- 5.5 The Respondent’s Response is set out in a single paragraph. It is convenient simply to set out the entirety of that paragraph in this decision. It reads as follows:

“Regarding the complaint, the url was not registered in any abusive way. It has been registered as a site on which to host my long term car test with videos about the car. Obviously, this has still not been

completed yet. I own an Audi A6 that I love and if anything want to create a positive impression of the Audi brand and maybe help Audi sell more cars. I chose myaudi as the car is my Audi. I would argue the 'my' part is a very important part of the url as it is not trying to be Audi or represent Audi but demonstrate that 'my' car is an Audi. This is my car and not a car I am test driving for a few hours which adds an element of commitment to the brand. I can therefore give a true and loving ongoing review of the car. Nothing malicious or devious intended and accept my apologies if this is deemed to be the case."

The Reply

- 5.6 In its Reply the Complainant contends that the Respondent has failed to provide any proof of his activities. It also claims that it is implausible that the Respondent's website "has not been completed yet" given that the "Respondent registered the [D]omain [N]ame more than 2.5 years ago and did absolutely nothing with it".

6. Discussions and Findings

- 6.1 To succeed under Nominet's Dispute Resolution Service Policy, the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy) and second, that the Domain Name is an Abusive Registrations in the hands of the Respondent (paragraph 2.1.2 of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy).

- 6.2 Abusive Registration is defined in paragraph 1 of the Policy as follows:

"Abusive Registration means 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. is being or has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's Rights

- 6.3 I accept that the most sensible reading of the Domain Name is as the word "my" combined with the Complainant's AUDI trade mark and the ".uk" top

level domain. Given this I accept that the Complainant has rights in respect of a trade mark that is similar to the Domain Name. Indeed, this does not appear to be contested by the Respondent. It follows that the Complainant has demonstrated paragraph 2.1.1 of the Policy.

Abusive Registration

- 6.4 There is a factual dispute in this case in that the Respondent's claims that he registered the Domain Name for a website displaying videos regarding a long term car test with videos about his car, but the Complainant appears to contend this is implausible.
- 6.5 Were it necessary to definitively determine this point in order to come to a decision in this case, I would face a number of practical difficulties. The first is that although the Complainant has contended that the Domain Name has only been used for a parking page, it has failed to provide any evidence of this. There are for example no print outs of what the page operating from the Domain Name looked like either at the time the Complaint was filed, or from some third party source such as the Internet archive demonstrating how the page has been historically used. This is unhelpful. The Complainant has made reference to the Experts' Overview in its Complaint and as the last sentence of the foreword to the Overview records:
- "Additionally, under the UDRP it is now common practice for panellists to make enquiries of their own by way of, for example, the WaybackMachine. This is not the common practice of DRS Experts. It is the responsibility of the parties to include within their submissions all evidence upon which they wish to rely"*
- 6.6 The second, is that although the Response is very short, the Domain Name does currently redirect internet users to a Youtube page that displays videos that appear to have been created before the current dispute arose and are indeed consistent with the Respondent's contention that the Domain Name was registered with the intention of using it for a website showing him test driving his own Audi car over a period of time. But none of this is addressed in the formal Response.
- 6.7 From what I have seen, including the statement in the Response that the relevant website "[o]bviously, ... has still not been completed yet", it seems likely that the Respondent did have an intention to use the Domain Name in the manner he claims, that he had created videos in relation to his Audi some years ago but did not actively use the Domain Name prior to the current proceedings and has only linked it to a Youtube page displaying his videos in response to those proceedings. But given the way that both parties have presented their case and were these conclusions determinative of the outcome of this case, these are matters in respect of which it would have

been appropriate to invite further submissions from the parties (as to which see paragraph 5.10 of the Experts' Overview).

6.8 However, I have come to the conclusion that it is not necessary to seek such additional submissions. The reason is that even if the Respondent did intend to use the Domain Name for a genuine fan/review site, the Complainant has advanced a case on the basis of "initial interest confusion", which I think succeeds in this case.

6.9 The Domain Name comprises the Complainant's mark in its entirety with the addition of the word "my". It is perhaps fair to say that recently there have been some developments in the approach of panels when it comes to assessing whether or not the adoption of a domain name which comprises another's mark in conjunction with other words or terms is abusive. The Complainant in its complaint relies upon *Land Rover Ltd. v The Hutson Motor Company Ltd*, DRS 00017926, but it is the decision of the Appeal Panel in another Land Rover case that is perhaps more relevant; i.e. *Jaguar Land Rover Limited v Essex Jaguar Spares* DRS 18271 <essexjaguarspares.co.uk>.

6.10 As I stated (starting at paragraph 6.15) in *Pearson Plc v Locus Rags*, DRS19183:

"... The use of another's trade mark in a domain name without further adornment (save for the "co.uk" or "uk" suffix) is nearly always abusive as it likely to be viewed by the internet user as indicating a website that either belongs to or is authorised by the trade mark holder. As such its use will amount to an illegitimate impersonation. However, in the <essexjaguarspares.co.uk> case the appeal panel considered when and in what circumstances the addition of terms to that trade mark in a domain name that is used to promote the sales of goods or services associated with that trade mark might make the use of that domain name legitimate. In doing so the panel made a distinction between those additional terms that are insufficient to dispel a misleading impression of authorisation or connection with the trade mark owner and those additional terms that were sufficient to dispel that misleading impression so as to "take[] the domain name into the category of informative rather than misleading use of the [c]omplainant's trade mark".

... In that particular case the appeal panel suggested that the addition of the words "Essex" and "spares" to the trade mark "jaguar" was sufficient to make the domain name informative, but suggested that the use of "Essex" or "spares" alone was unlikely to do so. In reaching that conclusion it also recognised that it was adopting a "more liberal view (for the registrant) as to where the line is to be drawn than has been applied in at least some previous DRS cases".

- 6.11 Returning to the specific facts of the case before me (and regardless of whether the decision of the appeal panel in <essexjaguarspares.co.uk> was too “liberal”), in my view the addition of the word “my” to “Audi” is insufficient to make the domain name informative rather than misleading, and thereby prevent a finding of abusive registration. The term “my” alone does not sufficiently indicate that the owner of the Domain Name is offering services related to but unauthorised by the Complainant. Even if the Respondent intended this to be a reference to “his” personal Audi, I am unconvinced that others would read it that way as opposed, for example, to a website set up by the Complainant for the Complainant’s customers.
- 6.12 In <essexjaguarspares.co.uk>, the use made of the domain name was commercial, but I believe the same considerations apply where the use made is non-commercial (without making any determination as to whether the use is commercial or non-commercial in this case). This would also appear to be broadly consistent with the approach panellists have taken in the past in relation to fan and criticism sites notwithstanding that paragraph 8.2 of Policy states that “[fair] use may include sites operated solely in tribute to or in criticism of a person or business”.
- 6.13 As paragraph 4.9 of the Expert Overview records:
- “The appeal decision in DRS 06284 (rayden-engineering.co.uk) confirmed the consensus view among experts today that the nature of the domain name is crucial to the exercise. A criticism site linked to a domain name such as <IhateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant”*
- 6.14 Of course the present case does not involve a domain name that takes the form <Complainant.co.uk> or <IhateComplainant.co.uk>, but in my opinion <myaudi.uk> is significantly closer to the former than the latter.

7. Decision

- 7.1 I, therefore, find that the Complainant has Rights in a name which is similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed

Dated 10th April 2018