



DISPUTE RESOLUTION SERVICE

D00022170

Decision of Independent Expert

ŠKODA AUTO

and

Nice-name.com Ltd

1. The Parties

Complainant: ŠKODA AUTO
T?. Václava Klementa 869
Mladá Boleslav II
293 01 Mladá Boleslav
Delivery No.. 29360
Mlada Boleslav
29301
Czech Republic

Respondent: Nice-name.com Ltd
1 Monarch Point
London
SW4 2HW
United Kingdom

2. The Domain Name

myskoda.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 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 On 20 December 2019 the dispute was received. On 23 December 2019 the complaint was validated and notification of it sent to the parties. On 2 January 2020 the response was received and notification of it sent to the parties. On 7 January 2020 a reply reminder was sent. On 9 January 2020 the reply was received and notification of it sent to the parties. On 14 January 2020 the mediator was appointed and on 16 January 2020 the mediation started. On 30 January 2020 the mediation failed and close of mediation documents were sent. On 6 February 2020 the Expert decision payment was received.

4. Factual Background

- 4.1 The Complainant is a joint-stock company registered in the commercial register maintained by the Municipal Court in Prague. The Complainant began the manufacture of cars under the ŠKODA brand in 1928. It is now the biggest car manufacturer in the Czech Republic and has been part of the Volkswagen Group since 1991. Its cars are distributed in Europe, Asia, Africa, South America and Australia. In turnover terms it is the biggest Czech exporter and the largest Czech company.

- 4.2 The Complainant is the owner of the following registered trade marks:
- (a) UK trade mark no 0000876353D for SKODA registered in class 12 on 1 March 1965.
 - (b) International trade mark number 686538B for SKODA registered in class 12 on 15 August 1997.
 - (c) International trade mark number 1466548 for MyŠKODA registered in classes 9, 12, 36, 37, 38, and 39 on 26 March 2019.
 - (d) EU trade mark registration number 018007941 for MyŠKODA registered in classes 9, 12, 36, 37, 38 and 39 on 7 May 2019.
- 4.3 The Domain Name was registered on 2 February 2000.

5. Parties' Contentions

5.1 I set out below a summary of what I consider to be the main contentions of the parties.

Complainant's complaint

- 5.2 The Complainant asserts the following Rights:
- (a) The Complainant relies on its registered trade marks as set out at paragraph 4.2. It says that the Domain Name is identical to its ŠKODA trade mark, 's' having replaced 'š' in the Domain Name as the domain name system does not support Czech diacritics. It also says that its MyŠKODA trade mark is identical to the Domain Name.
 - (b) The Complainant contends that SKODA is inherently connected with the automotive sector and with its designation, company name and overall brand used for its goods and services. The Complainant says it is the proprietor of a vast portfolio of registered trade marks that make its brand even more prolific. It states that it registered the ŠKODA trade mark in the Czech Republic in 1929 and in the UK in 1965.
 - (c) The Complainant says that its business name, Škoda Auto, is a registered trade mark which is well-known, has a good reputation and has been in use since 1925. It contends that the ŠKODA designation is a symbol of quality for consumers which they automatically attribute to the Complainant.
 - (d) The Complainant argues that since its goods and services are inherently connected with SKODA it has common law rights in this mark which it says is well-known and has a good reputation in the UK. The Complainant states these rights and its trade mark registrations pre-date the Domain Name registration.
 - (e) The Complainant contends that its business activities are well enough known around the world so as to be inherently connected with the name SKODA.
 - (f) The Complainant argues that 'my' in the Domain Name is not distinctive. It contends that there is widespread use of 'my' with a company name for personalised services or account management. The Complainant states that it has launched a MySKODA service which is available in 39 countries and in several languages. This is a web based application which allows SKODA car owners to plan maintenance and technical inspections, informs them about special offers and helps them to find their nearest authorised dealer.
- 5.3 The Complainant asserts that the Domain Name is an Abusive Registration for the following reasons:
- (a) The Complainant says the Domain Name consists of its trade marks and company name which the Respondent is not authorised, licenced or approved to use.
 - (b) The Complainant states that the Respondent is not known under 'MyŠkoda' or 'Škoda'.

- (c) The Complainant contends that the Respondent intentionally registered the Domain Name to attract Internet traffic that would normally go to the Complainant's web pages. It says the Domain Name resolves to a page that is automatically and dynamically generated by a tool commonly used by cyber squatters and which contains URLs that link to third party content. The Complainant argues that the site at the Domain Name does not contain any legitimate content.
- (d) The Complainant contends that there has been no genuine use of the Domain Name since registration and the Respondent intended to sell the Domain Name to it.
- (e) The Complainant says it uses 'myskoda' with a local country code as a domain name worldwide. It argues that consumers expect the Domain Name to be operated by the Complainant for UK customers.
- (f) The Complainant asserts that the Respondent is unfairly disrupting its global business by preventing the Complainant from using the Domain Name and at the same time luring the Complainant's customers to pages unrelated to it causing harm to its good reputation and business.
- (g) The Complainant says the URLs on the site at the Domain Name are intentionally named so that ordinary consumers may perceive them as a signpost to its services. It states these URLs are associated with the Complainant's business, but do not link to its site.

Respondent's response

5.4 The Respondent's response is short and can be summarised below. The response has been written in a personal capacity, although I note that the Respondent is a company.

- (a) The Respondent states that it was set up in 1999 with the intention of launching a business based upon internet urls and web pages. It says the business plan was to reserve popular generic names covering all aspects of personal, social and sporting interests.
- (b) The Respondent states that some 200 addresses were registered including addresses beginning with "my" and "its" as it was the intention to build up themes, for example 'myhouse' and 'mygarden'. The Respondent says the business plan was to *"offer those not lucky enough to have exact email addresses matching their names or interests, or urls allowing web pages to match their small one-man businesses. So other domains I registered included mycoffeeshop, myboutique. This would allow be to "sub-let" these for example to john@mygarden or jean@myboutique"*.
- (c) The Respondent says that for a number of reasons the business plan did not go into operation but it is still the intention to go ahead with it broadly as outlined.
- (d) The Respondent states that among the urls registered were those covering some types of cars, as many people's hobbies and interests are around their vehicle. These included myjeep, myroller and myskoda.
- (e) The Respondent contends that the parallel to these domain name registrations are personalised number plates. The Respondent argues that in the same way a car driver would have a personal car registration number SK0DA, it is fair and legitimate for a member of the public to have a personal email address such as john@myskoda.
- (f) The Respondent says it is astonished by the suggestion that it may have marketed Skoda or have blocked any business to the Complainant. It states that this has never been the case or its intention.
- (g) The Respondent says a considerable sum has been invested in setting it up and in renewing the registrations of the urls over two decades. It states that if the Complainant wishes to have exclusive use of the Domain Name and myskoda.co and felt it appropriate to compensate the Respondent for this investment and

loss of potential revenue, it would be happy to consider the Complainant's proposal.

Complainant's reply

- 5.5 The Complainant says that the Respondent admits to registering domain names containing the names of famous car manufacturers and to be willing to use them to establish an e-mailing platform and to sell those emails to customers for profit. The Complainant contends that the Respondent was well aware of and intended to use the Complainant's trade marks, company name and reputation in order to attract paying customers for the Respondent's gain.
- 5.6 The Complainant argues that the Domain Name is part of a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well-known names or trade marks in which the Respondent has no apparent rights.
- 5.7 The Complainant says the Respondent had no reasonable justification for registering the Domain Name, which it says is an exact match to its trade marks.
- 5.8 The Complainant says the Respondent's comparison to car registration plates does not make sense. It argues that there is a difference between having a car registration plate for personal reasons and establishing a business which offers customers the opportunity to have such a plate if they pay you. The Complainant says it understands the wish to have the car registration number plate SKODA for personal use. However, it contends that a business plan to attract customers using the Complainant's trade marks and reputation and to sell customers this as a service for profit is unfair competition and an unfair practice which harms the Complainant and the reputation of its trade marks. The Complainant points out that the Domain Name is not my5sk0da.
- 5.9 The Complainant states that in its response the Respondent has offered the Domain Name for sale for more than the documented out-of-pocket costs directly associated with acquiring or using the Domain Name. The Complainant contends that this is proof that the Respondent's intentions were and still are to sell the Domain Name for valuable consideration beyond out-of-pocket expenses to boost its business.
- 5.10 The Complainant argues that the Respondent's intention was to confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. It argues that an intention to use the Domain Name to provide email addresses is inconsistent with the links on the site at the Domain Name. The Complainant argues that the Respondent could have used the Domain Name for a site or to redirect to a site offering the Respondent's services. The Complainant contends that it is extremely unlikely that the Respondent did not have time in the last two decades to put legitimate content on the site at the Domain Name.

6. Discussions and Findings

- 6.1 Paragraph 2.2 of the Nominet Dispute Resolution Service Policy (**the Policy**) sets out that the Complainant is required to prove to the Expert that both of the following elements are present on the balance of probabilities:
 - 2.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
 - 2.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*
- 6.2 On 17 February 2020 the Respondent emailed Nominet with further information. On the same day Nominet informed the Respondent of the process to submit a further statement in accordance with paragraph 17 of the Policy. The Respondent has not explained why there is an exceptional need for a non-standard submission as required by paragraph 17.3 of the Policy. Paragraph 17.1 of the Policy sets out that the Expert will not be obliged to consider any statements or documents from the parties which she has not received according to the Policy or which have not been requested. I will therefore proceed to make this decision based only on the submissions of the parties

and have not taken into account any of the further information submitted by the Respondent.

The Complainant's Rights

- 6.3 Under paragraph 1 of the Policy, 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.*" It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.
- 6.4 I am satisfied on the basis of the Complainant's trade mark registrations that it has Rights in the MyŠKODA mark. I consider this mark to be identical or similar to the Domain Name (disregarding the .uk suffix which it is common to ignore when making a comparison between the mark and the Domain Name). 'š' is not permitted in .UK domain names and this character has been replaced by 's' in the Domain Name. I do not consider this replacement materially distinguishes the Domain Name from the MyŠKODA mark.
- 6.5 I am also satisfied that the Complainant has Rights by virtue of its trade mark registrations in the SKODA mark and that it has unregistered passing off rights by virtue of its use of this mark (with the Czech diacritic) in relation to cars and automobile services. I consider the SKODA mark to be similar to the Domain Name (again disregarding the .uk suffix). The additional prefix 'my' in the Domain Name is generic or descriptive in nature and does not distinguish the Domain Name from the Complainant's mark.
- 6.6 I therefore find that the Complainant has Rights in names or marks, MyŠKODA and SKODA, which are identical or similar to the Domain Name.

Abusive Registration

- 6.7 Under paragraph 1 of the Policy, 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*
- It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.
- 6.8 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration are set out at paragraph 5 of the Policy. They include the following which are relied on by the Complainant in its complaint:
- 5.1.1 *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
 - 5.1.1.1 *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;*
 - 5.1.1.2 *as a blocking registration against a name or mark in which the Complainant has Rights; or*
 - 5.1.1.3 *for the purpose of unfairly disrupting the business of the Complainant.*
 - 5.1.2 *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.*

- 5.1.3 *The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*
- 5.1.6 *The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.*
- 6.9 Paragraph 5.1.1 of the Policy relates to the Respondent's motives at the time of registration of the Domain Name. For there to be an Abusive Registration under paragraph 1.i. of the Policy it must be established that the Respondent knew of (or in some cases should have known of) the Complainant and/or its Rights at the time of registration of the Domain Name.
- 6.10 In the response the Respondent states that it registered urls covering certain types of cars including the Domain Name. I am satisfied that when the Respondent registered the Domain Name it was aware of the Complainant and the SKODA mark.
- 6.11 So what were the Respondent's motives for registering the Domain Name? The Respondent says that it registered the Domain Name as part of a business plan to offer email addresses to people whose hobbies and interests may be based around their vehicle. I am sceptical of this explanation. The Respondent has not produced any evidence in support of this business plan. Further, the Domain Name was registered 20 years ago and during this time the business plan has not been put in operation. Whilst the Respondent gives a reason for this, I do not consider that it credibly explains why nothing has happened during such a lengthy time period.
- 6.12 I also do not consider the Respondent's registration of the Domain Name is consistent with a business plan of reserving popular generic names covering all aspects of personal, social and sporting interests. The Domain Name is not a generic name, given that it incorporates the Complainant's SKODA mark.
- 6.13 Having weighed the evidence, I do not accept the Respondent's explanation that it registered the Domain Name to provide email addresses. Instead I consider that the Respondent, with knowledge of the Complainant, registered the Domain Name for the purpose of setting up a site containing pay-per click links. There is no evidence that the site at the Domain Name has been used other than for a parking page.
- 6.14 The Complainant has been using SKODA for its business for some considerable time. It is clear from the evidence that this mark is well-known and that the Complainant has built up considerable goodwill in it. Accordingly I consider there is a real risk that Internet users looking for the Complainant who guess the Complainant's URL will visit the Respondent's site. I also consider there is a real risk that Internet users will visit the Respondent's site in response to a search engine request looking for the Complainant.
- 6.15 Once at the Respondent's site Internet users will see pay-per-click links. The Complainant has adduced in evidence a screenshot of the Respondent's site taken on 17 December 2019 which features the links 'Skoda Auto' and 'Car Insurance'. The Complainant's states that these links do not lead to its pages, although it is unclear whether they lead directly to third party sites or to further pages containing pay per click links. Nevertheless, there is a risk that users who find the Respondent's site when looking for the Complainant or its services, such as insurance services, will be diverted to third party sites earning the Respondent click through revenue.
- 6.16 The connecting of a Domain Name to a parking page is not of itself objectionable under the Policy. Paragraph 8.5 sets out that:

Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:

8.5.1 the nature of the Domain Name;

- 8.5.2 *the nature of the advertising links on any parking page associated with the Domain Name; and*
- 8.5.3 *that the use of the Domain Name is ultimately the Respondent's responsibility*
- 6.17 The Appeal Panel considered the use of pay per click links in D19567 (Illinois Tools Works Inc and Successful Internet Limited). It said:
- "The Appeal Panel considers that linking portfolios of domain names to parking pages in this manner is unobjectionable in itself. However the links generated on the parking page may be objectionable; whether they are objectionable is a question of fact depending on all the circumstances of the case. It will be necessary to consider the detail of the links in question and assess to what extent such links are causing or are likely to cause the complainant harm. In circumstances where it seems on the evidence that harm is being caused or is likely to be caused then a respondent may come under an obligation to change the nature or behaviour of the page or risk the domain name being found to have been used in a manner which has been unfairly detrimental to the complainant's Rights. Similar remarks apply to the respondent deriving unfair advantage from the links because of the complainant's Rights".*
- 6.18 In this case I consider the links which the Complainant has adduced in evidence to be objectionable taking into account that the Domain Name incorporates the Complainant's well-known brand and the nature of the links, being the Complainant's name and for services which are offered by the Complainant.
- 6.19 In my view paragraph 5.1.1.3 of the Policy applies. I consider the Respondent registered the Domain Name, with knowledge of the Complainant, for the purpose of unfairly disrupting the business of the Complainant by unfairly taking advantage of the likely confusion of Internet users to divert traffic to third party services to earn the Respondent click through revenue. This is evidence that the Domain Name is an Abusive Registration under paragraph 1.i. of the Policy.
- 6.20 The Complainant relies on paragraphs 5.1.1.1 and 5.1.1.2 of the Policy as evidence of an Abusive Registration under paragraph 1.i. of the Policy. However, I am not persuaded that the Respondent registered the Domain Name primarily for the purposes set out in these paragraphs. The Respondent states in the response that if the Complainant wishes to have exclusive use of the Domain Name and felt it appropriate to compensate the Respondent for its investment and loss of potential revenue, it would be happy to consider the Complainant's proposal. The Respondent has therefore expressed a willingness to sell the Domain Name to the Complainant. However, I do not consider this establishes that the Domain Name was registered primarily for the purpose of selling it 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.
- 6.21 I consider that paragraph 5.1.2 of the Policy applies. As set out above I consider there is a likelihood of Internet users being initially confused into visiting the Respondent's web site in the expectation of finding the Complainant. Further, since registration of the Domain Name, the Complainant has launched MyŠKODA services which use 'myskoda' domain names. I consider there is a real risk that Internet users, particularly those in the UK, looking for these services in the UK will visit the Respondent's site by guessing the url or in response to a search engine request. The Complainant has adduced in evidence a Google search conducted in Prague for 'myskoda' which gives results for the Complainant. However, this does not necessarily mean that an Internet search in the UK for MyŠKODA services would return the same results.
- 6.22 Once at the Respondent's site, by virtue of the links, there is a likelihood of Internet users being diverted to third party web sites in respect of which the Respondent earns click-through revenue. Even if users appreciate that they have not found the Complainant when they reach the Respondent's site, it has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant. This is evidence that the Domain Name is an Abusive Registration under paragraph 1.ii. of the Policy.

- 6.23 The Complainant relies on paragraph 5.1.3 of the Policy that the Respondent is engaged in a pattern of registrations which correspond to well-known names or trademarks in which the Respondent has no apparent rights and the Domain Name is part of that pattern. The Respondent says it has registered about 200 domain names. The Complainant relies on two of these, 'myjeep' and 'myroller', as evidence of a pattern of registrations. However, there is no evidence of what domain names have been registered and when or any identification of the well-known names or marks. I am aware that Jeep is the name of a car brand, so a domain name incorporating 'myjeep' has some similarity to the Domain Name. However, there is no evidence that 'roller' is a well-known name or mark. I understand that this may be slang for the car brand "Rolls Royce"; however, it is also an ordinary dictionary word. In the circumstances I do not consider there is evidence of a pattern of abusive registrations.
- 6.24 The Complainant also relies on paragraph 5.1.6 of the Policy. I consider that the Domain Name is an exact match for the Complainant's MyŠKODA mark, taking into account that 'š' is not permissible in .UK domain names, but not for its ŠKODA mark. It therefore needs to be considered whether MyŠKODA has a reputation and whether the Respondent has no reasonable justification for having registered the Domain Name. My view is that reputation needs to be established at the time of registration of the Domain Name given that this paragraph of the Policy is concerned with the Respondent's reasonable justification or not for registration. The Complainant's trade mark registrations for MyŠKODA are some considerable time after registration of the Domain Name and there is no evidence of any use of this mark prior to registration of the Domain Name. I therefore do not consider this paragraph of the Policy applies.
- 6.25 I do not consider that any of the factors which may be evidence that the Domain Name is not an Abusive Registration under paragraph 8 of the Policy apply.
- 6.26 Accordingly I conclude that the Domain Name is an Abusive Registration under paragraphs 1.i. and 1.ii. of the Policy.
- 6.27 Finally, I note that the complaint has been brought nearly 20 years after registration of the Domain Name, although it is unclear when the Complainant became aware of the Domain Name. The issue of delay was considered by the Appeal Panel in DRS 15788 (Lucasfilm Ltd., LLC and ABSCISSA.COM Limited). The Panel considered that delay does not automatically bar an action where the use complained of is ongoing (as is the case here) but, depending on the facts, it might mean that an otherwise Abusive Registration is acceptable.
- 6.28 In DRS 17490 (Jockey Club Racecourses Limited and Moneta Communications Limited) the Appeal Panel was satisfied that the considerable delay between registration and complaint will not of itself weigh heavily in the scales on the issue of Abusive Registration. The web site had been in continuous use and it had not been suggested that the delay hampered the Appellant's ability to advance its case or had prejudiced a proper consideration of the issues. The Appeal Panel considered that the substantive question was whether the Jockey Club's representations gave rise to a reasonable expectation on the part of the Appellant that the Jockey Club did not object to the registration and use of the Domain Name and if so whether the Appellant relied on that representation to its detriment.
- 6.29 In this case I do not consider that any delay in bringing the complaint has prejudiced the Respondent being able to argue its case nor do I consider that there has been any unfair prejudice to the Respondent as a result of delay. The Respondent has not developed a business under the Domain Name or genuinely offered goods or services but rather has used the Domain Name for click-through traffic. There is nothing to suggest that the Complainant made any representations which gave rise to a reasonable expectation on the part of the Respondent that the Complainant did not object to the registration and use of the Domain Name. I therefore do not consider that any delay in the Complainant bringing its complaint after registration of the Domain Name makes the Abusive Registration in this matter acceptable.

7. Decision

- 7.1 I find that the Complainant has Rights in 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.
- 7.2 I direct that the Domain Name be transferred to the Complainant.

Signed Patricia Jones

Dated 5 March 2020