

DISPUTE RESOLUTION SERVICE

DRS 21817

Decision of Independent Expert

Verband der Automobilindustrie e.V

Complainant

and

SCC Cars Limited

Respondent

1 The Parties

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| Complainant: | Verband der Automobilindustrie e.V |
| Address: | Behrenstrasse 35 Berlin 10117 Germany |

| | |
|-------------|---|
| Respondent: | SCC Cars Limited |
| Address: | Unit 8, Lord Byron Square Salford Manchester M50 2XH United Kingdom |

2 The Domain Name

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

3 Procedural History

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, which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

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| 4 September 2019 | Dispute received |
| 5 September 2019 | Complaint validated |
| 5 September 2019 | Notification of complaint sent to parties |
| 24 September 2019 | Response reminder sent |
| 26 September 2019 | Response received |
| 26 September 2019 | Notification of response sent to parties |
| 1 October 2019 | Reply reminder sent |
| 3 October 2019 | Reply received |
| 3 October 2019 | Notification of reply sent to parties |
| 3 October 2019 | Mediator appointed |
| 17 October 2019 | Mediation started |
| 20 February 2020 | Mediation failed |
| 20 February 2020 | Close of mediation documents sent |
| 3 March 2020 | Complainant full fee reminder sent |
| 6 March 2020 | No expert decision payment received |
| 6 March 2020 | Dispute closed |
| 20 March 2020 | Dispute opened |
| 20 March 2020 | Expert decision payment received |

4 Factual Background

- 4.1 The Complainant is a long-standing trade association of the German automotive industry. AdBlue is a liquid used to prevent the emission of harmful nitrogen oxide from diesel engined vehicles. A number of suppliers manufacture AdBlue under licence from the Complainant.
- 4.2 The Domain Name was registered by the Respondent on 9 September 2018.
- 4.3 The Respondent is using the Domain Name for a website selling AdBlue products to the general public.

5 Parties' Contentions

Complaint

- 5.1 The Complainant is headquartered in Berlin, with offices in Brussels, Moscow and Beijing. It is a trade association of the German automotive industry, founded in 1901. It has more than 600 members – manufacturers of cars, trucks and buses, and of parts and accessories for such vehicles. Its members include a number of well-known manufacturers such as Audi, Volkswagen and Daimler.
- 5.2 The Complainant explains that it uses the ADBLUE trade mark in relation to a product essential for the operation of Selective Catalytic Reduction technology in diesel vehicles. The technology prevents the emission of harmful nitrogen oxide gas by breaking it down into nitrogen and water, both of which are harmless. Diesel vehicles built after 1 September 2015 in the EU are required

to have a separate AdBlue tank, the filler cap for which is marked with the ADBLUE trade mark and is typically located either in the boot or next to the diesel filler cap.

- 5.3 The AdBlue product is widely available at filling stations and dealerships all over Europe. The generic term for the liquid in question is urea solution or Diesel Exhaust Fluid (DEF). A number of companies manufacture DEF which is sold under a variety of brand names. A list of such manufacturers is exhibited to the Complaint.
- 5.4 The Complainant evidences its ownership of two EU trade marks for ADBLUE, which was first registered in 2006 in a variety of classes. A copy of the relevant print-out from the EU IPO is exhibited to the Complaint, identifying the Complainant as the owner of the marks.
- 5.5 In addition, the Complainant asserts common law rights in the AdBlue name by reference to its "extensive goodwill and a substantial reputation throughout Europe and the world". In support of that contention, the Complainant relies on a study which predicts purchases of AdBlue in Europe to exceed 6 billion litres by 2025, as compared to 2 million litres in 2013. It also annexes pages from the websites of a number of automotive manufacturers – Land Rover, Peugeot and Volkswagen – referring to or recommending the use of AdBlue in their vehicles.
- 5.6 The Complainant asserts that members of the public "only associate the ADBLUE trade marks with VDA", and that accordingly the public has "long recognised" the ADBLUE mark as identifying and distinguishing the goods and services of the Complainant and its authorised licensees from those of other DEFs manufactured by its competitors.
- 5.7 The Complainant contends that its registered ADBLUE mark is the "dominant and distinctive element" of the Domain Name. It says that the addition of the word "buy" has no meaning in relation to its AdBlue mark, nor in relation to the AdBlue product, nor does it "have any distinctive qualities in its own right to suggest the domains are linked to, or authorised by, any entity other than" the Complainant. It asserts that the addition of the word "buy" merely constitutes "an invitation to purchase" the product.
- 5.8 For these reasons, says the Complainant, the Domain Name is confusingly similar to its registered trade mark.
- 5.9 As to Abusive Registration, the Complainant points out that the Domain Name was first registered in September 2018 long after the Complainant's Rights in the ADBLUE mark first subsisted in 2006 and that at the time of registration, the Respondent "would or should have been fully aware of the Complainant's rights in the ADBLUE trade marks". No evidence is provided in support of that contention.
- 5.10 The Complainant explains that the Respondent is not authorised to use the ADBLUE registered trade mark. It says that it first became aware of the Respondent's use of the ADBLUE mark as a result of it using the Domain Name for its website. The Complainant says that it was "impossible to ascertain" whether the products being sold on the Respondent's website were "certified by the Complainant", i.e. genuine AdBlue products.
- 5.11 On 13 May 2019 the Complainant's German lawyers sent the Respondent a cease and desist letter. No response was received, and the Respondent continued to operate its website. A further letter was sent by English lawyers on 13 July 2019. Again no response was received, and the Respondent continued to operate its website.
- 5.12 The Complainant asserts that such use of the Domain Name takes unfair advantage of its rights in the ADBLUE mark and that the Respondent is deliberately trading on the Complainant's goodwill in the mark. It also contends that such use of its mark is misleading the public. It says

that the Respondent's use of the mark together with a reference on the website to at least one of the products being "VDA certified" would lead consumers to "associate the same as being a mark of quality/reliability and, therefore, the Respondent's use of the same is to merely take advantage and to mislead". The Complainant points out that, in reality, the Respondent is neither a licensee nor a franchisee, has undergone no quality audit by the Complainant and therefore has no authorisation to use the ADBLUE mark. The use of the Domain Name to direct consumers to its website which is unconnected to the Complainant but which provided identical or similar goods and services to those provided by the Complainant will "confuse consumers".

- 5.13 Further, the Complainant contends that confusion is likely to be caused because internet users are likely to believe that they have been directed to a website which is connected or associated with the Complainant, which is not the case, i.e. that it is causing initial interest confusion.
- 5.14 It asserts, without more, that "it is clear" that the Respondent has no legitimate interest in the Domain Name, nor in the ADBLUE registered mark. The Complainant cites the decision of the Appeal Panel in DRS 07991 (*Toshiba-laptop-battery.co.uk*).
- 5.15 For these reasons, the Complainant contends that the Respondent's use of the Domain Name falls within paragraph 5.1.2 of the Policy, namely 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.

Response

- 5.16 The Respondent argues that the Complaint is "based on a misapprehension" that the products sold through its website are generic DEF products not being lawfully sold by reference to the ADBLUE trade mark. The Respondent asserts, however, that the products being sold through its website are genuine and carry the ADBLUE trade mark with the Complainant's permission.
- 5.17 It says that the products are provided by three licensees of the trade mark owner, each of which it identifies. Annexed to the Response is a list of the Complainant's licensees, apparently obtained from the Complainant's website, which identifies the Respondent's purported suppliers as such licensees (amongst others).
- 5.18 Also annexed to the Response are copies of invoices evidencing the supply of AdBlue products to the Respondent by those three suppliers.
- 5.19 The Respondent contends that its use of the mark therefore falls within paragraph 8.1.2 of the Policy because the Domain Name is generic or descriptive and the Respondent is making fair use of it. It says it is using the trade mark in a descriptive manner to tell customers and potential customers that the products that it is selling are products properly bearing the ADBLUE trade mark.
- 5.20 Further, the Respondent says that it is selling only genuine AdBlue products through its website and therefore "has a legitimate reason for referring to AdBlue in the Domain Name". It says that there is nothing to suggest that its website is operated by or on behalf of the Complainant. It is not therefore giving a "false impression of a commercial connection" between the parties.
- 5.21 As to the Toshiba laptop battery case DRS 07991, the Respondent points out that a "key finding" was that the use of a registered trade mark in a domain name did not, without more, give rise to confusion. It also asserts that the facts of that case are different from this one because in that case the Respondent was, in addition to selling of products of the trade mark owner, also selling competing products, which is not the case here.

5.22 Finally, the Respondent raises the question of exhaustion of rights, on the basis of which it contends that the Complainant cannot object to its use of the trade mark to sell genuine products where those products have already been put on the market in the EEA by the trade mark proprietor or with its consent.

Reply

5.23 The Complainant rejects the Respondent's characterisation of its case. It says that the issue of whether or not the products being sold by the Respondent on its website are genuine AdBlue products was not its only concern nor the sole basis for its Complaint. It asserts that the Respondent is using its registered mark in a trade mark sense "i.e. as part of a Domain Name".

5.24 The Complainant says that it is not "attempting to stop the Respondent from making reference to the ADBLUE trade mark when in direct reference to genuine AdBlue products or to describe genuine AdBlue products". It explains that its objection is to the use of the ADBLUE trade mark in the Domain Name, which it describes as "the internet equivalent of a store front or shop name". It contends that such use is use in a trade mark sense, i.e. as an indication of origin. It makes the point that the Respondent does not need to use the ADBLUE trade mark in its Domain Name in order to inform its customers that the products it is selling are products properly bearing the ADBLUE trade mark. It says that the very fact that the Respondent has stated that it is using the ADBLUE trade mark "to tell customers and potential customers" that it is selling AdBlue products is evidence in itself that the Domain Name is being used in a trade mark sense.

5.25 The Complainant therefore asserts that such use cannot constitute "fair use" because the Respondent has no legitimate reason for using the ADBLUE mark in the Domain Name.

5.26 In support of its contentions in this regard, the Complainant refers to four cases under the DRS, which it says were the same as this one, in which domain names were transferred to the relevant rights holder: *buycoast.co.uk* (transferred to Coast Fashions Limited), *buytissotwatches* (transferred to the Swatch Group Limited), *buyreductil.co.uk* (transferred to Abbot GmbH), and *buy-epson-uk.co.uk* (transferred to Epson Europe BV).

6 Discussions and Findings

General

6.1 To succeed under the DRS Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"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."

Complainant's rights

- 6.3 Paragraph 2.1.1 of the Policy requires the Complainant to prove that it *"has Rights in respect of a name or mark which is identical or similar to the Domain Name"*. "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"* (paragraph 1).
- 6.4 The Complainant has evidenced its registered ADBLUE trade marks. Accordingly, pursuant to paragraph 2.1.1 of the Policy it has Rights (as defined) in the ADBLUE mark.
- 6.5 Whether or not the Complainant also has common law rights in the AdBlue name is therefore academic, though on the evidence it is overwhelmingly likely that it does.
- 6.6 The Domain Name constitutes the Complainant's registered trade mark together with the non-distinctive word "buy". Numerous decisions under the DRS have found domain names constituting a name or mark, together with a prefix or suffix of an ordinary dictionary word, to be similar to the name or mark in question, for the purposes of paragraph 2.1.1 of the Policy. The decision in DRS 06973 (*veluxblind.co.uk*) is an example.
- 6.7 Accordingly, the Complainant satisfies paragraph 2.1.1 of the Policy.

Abusive Registration

- 6.8 The Complainant puts its case on Abusive Registration primarily on the following bases:
- 6.8.1 at the time of registration, the Respondent was (or should have been) aware of the Complainant's Rights in the ADBLUE trade marks; and/or
- 6.8.2 the Respondent was not authorised to use the ADBLUE mark; and/or
- 6.8.3 the Respondent may not be offering for sale on its website genuine AdBlue products; and/or
- 6.8.4 the Respondent is using the Domain Name in a way that has confused or is likely to confuse internet users into believing that its website is operated by, authorised by, or otherwise connected with, the Complainant (Policy, 5.1.2).
- 6.9 Whether or not the Respondent was at the time of registration aware of the Complainant's rights in the ADBLUE mark at the time of registration is not, in and of itself, determinative. For example, a number of circumstances are set out in paragraph 8 of the Policy where any such knowledge is not inconsistent with fair use. In any event, no evidence, even circumstantial, is provided of any such knowledge on the part of the Respondent.
- 6.10 Again, whether or not the Respondent was an authorised licensee, franchisee or service centre, is not of itself evidence of Abusive Registration.
- 6.11 As to whether the goods offered for sale on the Respondent's website are genuine or counterfeit, the Complainant puts its case only tentatively in the Complaint, and in the Reply appears to resile even from that position, acknowledging that the goods may be genuine AdBlue products, and expressly accepting that it does not object to use of its ADBLUE mark to describe them. Its objection is to the Respondent's use of the mark in the Domain Name.
- 6.12 Paragraph 5.1.2 of the Policy, on which the Complainant also relies, includes, as a factor which may be evidence that a domain name is an Abusive Registration, circumstances indicating that

the Respondent is using the domain name in a way which is confusing 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.

6.13 The Complainant does not provide any evidence that the Respondent's use of the Domain Name has caused actual confusion. Indeed it puts its case under paragraph 5.1.2 no higher than that it is "likely to cause" confusion.

6.14 The Respondent's case is that it is selling genuine AdBlue products, it is not using the ADBLUE mark in the Domain Name in a trade mark sense, and that its use of the mark therefore falls within paragraph 8.1.2 of the Policy.

6.15 Paragraphs 8.1 and 8.1.2 provide as follows:

"A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows: ... the Domain Name is generic or descriptive and the Respondent is making fair use of it".

6.16 Potentially the Respondent could satisfy the first limb of that provision. The Domain Name is not generic. But arguably the phrase "BuyAdBlue" could be said to be descriptive, in the sense that it describes the website, i.e. it is a place where one can buy AdBlue.

6.17 But can such use be said to be fair? That question is in a sense the obverse of the likelihood of confusion issue in paragraph 5.1.2. of the Policy (see 6.12 above), relied on by the Complainant.

6.18 In DRS 00248 (*seiko-shop.co.uk*) the Appeal Panel considered that the registrant's use of the domain name *seiko-shop.co.uk* created "*the impression that there is a commercial connection between the other undertaking and the trade mark proprietor*". In the Seiko case, the Panel considered the respondent to be using that domain name in a way which represented not just that "we are a shop selling Seiko watches" but rather that "we are the Seiko shop" or "we are the official UK Seiko shop", which therefore constituted unfair advantage being taken by the respondent and/or unfair detriment being caused to the complainant.

6.19 This case is slightly different in that arguably the Domain Name could be said to be closer to making the representation "we are a shop selling AdBlue products". Indeed, in the Seiko case the decision records that some members of the Appeal Panel would not have found against the respondent had it instead used the Domain Name "we-sell-seiko-watches.co.uk", which may not be very far from "buyAdBlue.co.uk".

6.20 The Complainant contends that the "argument that use of a third party trade mark in a Domain Name is descriptive/fair has been tried, tested and failed numerous times before". It relies in this regard on four DRS cases concerning domain names consisting of the word "buy" followed by the name or mark in which the Complainant had Rights: DRS 12403 (*buycoast.co.uk*), DRS 11976 (*buytissotwatches.co.uk*), DRS 8578 (*buyreductil.co.uk*) and DRS 7228 (*buy-epson-uk.co.uk*). However, those were all Summary Decisions, i.e. they were undefended and there was therefore no reasoned decision.

6.21 As the *Experts' Overview* (available on the Nominet DRS website) explains:

"The 'confusion' referred to in this paragraph [i.e. 5.1.2] of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that 'the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant?' "

- 6.22 The *Overview* makes it plain that such initial interest confusion is viewed by the overwhelming majority of Experts 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 website that the site is not in any way connected with the Complainant, the visitor has been deceived.
- 6.23 The *Overview* goes on to explain that:
- "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... The further away that the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration".*
- 6.24 However, the *Overview* adds that the activities of registrants who *"attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity"* will generally be found to fall foul of this provision. The *Overview* refers in this regard to the Appeal decisions in DRS 00248 (*seiko-shop.co.uk* – see above) and DRS 07791 (*toshiba-laptop-battery.co.uk*).
- 6.25 Unlike in the Seiko case, the Complainant in this case has provided no evidence that it either manufactures or sells AdBlue products. It appears to be, for these purposes, merely the IP rights holder, and to fulfil some kind of quality control or oversight role. The closest it comes to involvement in selling AdBlue is that, as it explains, it was "involved in the development of a website" at *www.findadblue.com*, which identifies retailers of AdBlue products (the "FindAdBlue Website"). That website is apparently operated by an entity named Integer Research Limited and is funded by a number of the Complainant's licensees, who presumably manufacture and/or supply AdBlue products under licence from the Complainant. There is also a link from the Complainant's website to the FindAdBlue Website.
- 6.26 Unlike in the *Toshiba* case, the Respondent here is not selling products which compete with those of the Complainant (nor with those of its licensees). It is selling only AdBlue products and not any other brands of DEF. On the other hand, that may in itself reinforce the impression in the consumer's mind that this is the official AdBlue website, which it is not. To the extent that there is any website aimed at consumers wishing to buy an AdBlue product, which has the blessing of the Complainant, it is the FindAdBlue Website.
- 6.27 While the merits on the Complainant's paragraph 5.1.2 contentions are fairly evenly poised, on the balance of probabilities it is likely that at least some internet users will be confused into thinking that the Respondent's website is being operated by the Complainant, by a licensee or licensees of the Complainant or by some other party authorised by or connected with it.
- 6.28 As the Complainant points out, there is no need for the Respondent to use the Complainant's trade mark in the Domain Name; there are other ways for it to attract the attention of consumers interested in buying AdBlue products, e.g. search engine optimisation. What it boils down to is that the Respondent's use of the Domain Name takes unfair advantage of the Complainant's Rights.
- 6.29 The Complainant therefore succeeds under paragraph 2.1.2 of the Policy.

7 Decision

- 7.1 The Expert accordingly finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration.

7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

David Engel

Signed

Dated 9 April 2020