

## ADJUDICATOR DECISION

<b>CASE NUMBER:</b>	<b>ZA2008-0014</b>
<b>DECISION DATE:</b>	<b>29 May 2008</b>
<b>DOMAIN NAME</b>	<b>citroen.co.za</b>
<b>THE DOMAIN NAME REGISTRANT:</b>	<b>Mark Garrod</b>
<b>REGISTRANT'S LEGAL COUNSEL:</b>	<b>Lematics (Pty) Ltd</b>
<b>THE COMPLAINANT:</b>	<b>Automobiles Citroën</b>
<b>COMPLAINANT'S LEGAL COUNSEL:</b>	<b>Bowman Gilfillan Inc.</b>
<b>THE 2<sup>nd</sup> LEVEL DOMAIN NAME ADMINISTRATOR:</b>	<b>UniForum SA</b>

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## 1. Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (“SAIPL”) on 17 March 2008. On 17 March 2008 SAIPL sent a request to UniForum SA for the registry to suspend the domain name, and on the same day UniForum SA confirmed this step.
- 1.2 SAIPL formally notified the Registrant of the commencement of the Dispute on 17 March 2008. The due date for the Registrant’s Response was 15 April 2008, and the Registrant submitted its Response on that date. SAIPL verified that the Response satisfied the formal requirements of the Regulations and SAIPL’s Supplementary Procedure (hereinafter, as necessary, “the Regulations”) and forwarded the Response to the Complainant. A Reply was submitted on 23 April 2008.
- 1.3 SAIPL appointed Adv. Owen Salmon as the Adjudicator. He has submitted the necessary Statement of Acceptance and Declaration of Impartiality and Independence.

## 2. Factual Background

The following are salient facts which the Adjudicator accepts as not in dispute.

- 2.1 The domain name was registered on 16 March 2000.
- 2.2 The Complainant is the French automobile manufacturer Automoblies Citroën, of 62 Boulevard Victor Hugo, Neuilly Sur Seine, France. It was founded in 1919 by Andre Citroën.

- 2.3 The trade mark CITROËN is very well known in relation to motor vehicles, and it is a determinative and well known designation of source for the Complainant's goods and services.
- 2.4 CITROËN is registered as a trade mark in South Africa, either *simpliciter* or in combination with other material, in respect of a fairly wide variety of goods and services predominantly relating to motor vehicles. The trade mark was first registered in South Africa in 1953.
- 2.5 The Complainant has a website which was officially launched in April 1997 at the domain citroen.com. On average, the website receives in excess of 45 million unique visitors per month and it uses this site to promote various motor vehicles, to make downloads available for customers, as well as to publish news about existing and forthcoming products.
- 2.6 It is a matter of dispute on the papers as to whether the Complainant has continuously had an established business in South Africa. Given the approach of the authorities,<sup>1</sup> and given the admission by the Registrant of the relevant qualities of the CITROËN trade mark summarised in 2.3 and 2.4 above, it is not necessary to address this. Indeed, the Registrant's admitted rationale for his site proceeds on the premise that the mark CITROËN has brand signification in South Africa, and has had so from before the registration of the domain.
- 2.7 The Registrant has been an enthusiast of Citroën cars since he was a young boy in the late 1970's, and he still is. He has owned about 30 Citroën cars in his lifetime, and currently owns 5 Classic Citroën

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<sup>1</sup> Compare McDonalds' Corporation v Joburgers Drive-In Restaurants (Pty) Ltd 1997 (1) SA 1(A) at 27I-28J; Caterham Car Sales and Coachworks Ltd v Birkin Cars (Pty) Ltd 1998 (3) SA 938 SCA at paras. [15], [16] and [20].

cars, a number of which have been imported into South Africa from the United Kingdom.

2.8 He has been a member of various branches of the Citroën Car Club for many years. He was a member of the United Kingdom Car Club from 1995 to 2001, which was before he registered the domain in question. He is a member of the Citroën Car Club South Africa, and his membership certification indicates that he was a member before he emigrated to the UK in 1996.

2.9 At the time, the Registrant registered the domain name (on 16 March 2000) he was living in the UK, but intended to return to South Africa and wanted to establish a website in tribute to Citroën cars.

2.10 From the date of registration, Registrant hosted the domain with various service providers. For a period from May 2001 until the full website was launched in November 2004, there was only one page at the domain, which had a concept drawing of a Citroën DS car on it and some words, including “under construction”.

2.11 In about November 2004, the current website replaced the “under construction” home page. The website can be viewed at the domain. No other website has appeared at the domain, and it has not been used for any other purpose. On the website appears the following:

“Welcome to [www.citroen.co.za](http://www.citroen.co.za), the official website of Citroen enthusiast Mark Garrod.”

2.12 The website was always intended to be, was always, and still is operated solely in tribute to Citroën cars. The Registrant has made no money from the website and does not make a living with regard to Citroën cars, it is his hobby. He runs and makes a living from a

totally unrelated business. Registrant does not charge for a classified ad to be placed, in a section which assists Registrant and other Citroën enthusiasts to trade Citroën cars. New cars are not sold on the website.

2.13 No other make of car is mentioned on the website. The Registrant does not criticise Complainant's business in any way. There are no links to other businesses, no links to other sites, and no advertisements on Registrant's website. The Registrant has never used the domain name to direct visitors to another site.

2.14 There is no indication that the Registrant used the domain to extract compensation, or attempt to do so.

2.15 Since at least 2001, sporadic attempts were made to resolve the matter, but these proved to be in vain. The parties describe at length their countervailing arguments as to why a settlement collapsed. The Adjudicator does not consider it necessary to decide, in the outcome, who was reasonable and who was not. It is unfortunate that the matter was not settled, but what is relevant is that the Complainant made it clear that it required a resolution in order to avoid formal measures. Nothing turns on this aspect.

2.16 The Registrant admits that the Complainant has rights in respect of the trade mark CITROËN, and that the domain name is identical. He accepts that the burden of proof shifts to him to show that, in his hands, the domain name is not an abusive registration as contemplated by Regulation 5(c).

### 3. The Complaint

3.1 The Complainant contends that the domain name is an abusive registration in terms of Regulation 3(1)(a) within the meaning of the Regulations.

3.2 An abusive registration means a domain name which either –

(a) 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

(b) Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

3.3 An indication is given in the Regulations as to what could be considered an abusive registration. In terms of Section 4(1), such factors include:-

*“(a) Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to –*

*(i) Sell, rent or otherwise transfer the domain name to a Complainant or to a competitor of the Complainant, or any third party, for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name;*

*(ii) Block intentionally the registration of a name or mark in which the Complainant has rights;*

*(iii) Disrupt unfairly the business of the Complainant; or*

- (iv) *Prevent the Complainant from exercising his, her or its rights;*
- (b) *circumstances indicating that the registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorized by, or otherwise connected with the Complainant;*
- (c) *evidence, in combination with other circumstances indicating that the domain name in dispute is an abusive registration, that the Registrant is engaged in a pattern of making abusive registrations;*
- (d) *false or incomplete contact details provided by the Registrant in the Whois database; or*
- (e) *the circumstances that the domain name was registered as a result of a relationship between the Complainant and the Registrant, and the Complainant has –*
  - (i) *been using the domain name registration exclusively; and*
  - (ii) *paid for the registration or renewal of the domain name registration.”*

This list is not exhaustive or definitive of when a registration can be “abusive”.

3.4 An indication is also given as to what would not be an abusive registration. In terms of Section 5, factors which may indicate this include:-

- “(a) *before being aware of the Complainant’s cause for complaint, the Registrant has –*
  - (i) *used or made demonstrable preparations to use the domain name in connection with a good faith offering of goods or services;*

- (ii) *been commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name; or*
    - (iii) *made legitimate non-commercial or fair use of the domain name;*
  - (b) *the domain name is used generically or in a descriptive manner and the Registrant is making fair use of it;*
  - (c) *that the Registrant has demonstrated fair use, which use may include websites operated solely in tribute to or fair criticism of a person or business: Provided that the burden of proof shifts to the Registrant to show that the domain name is not an abusive registration if the domain name (not including the first and second level suffixes) is identical to the mark in which the Complainant asserts rights, without any addition”*

3.5 In terms of Section 9, one of two outcomes is possible in the case of a complaint that the domain is an abusive registration: refusal of the dispute, or transfer of the disputed name.

3.6 To find for the Complainant, the Adjudicator must be satisfied on a balance of probabilities, that:

- (a) It has rights in respect of a name or mark which is identical or similar to the domain name;<sup>2</sup> and
- (b) The domain name, in the hands of the Registrant, is an abusive registration (i.e. as defined).

As indicated, the Registrant has admitted (a), and has accepted the onus to show that the domain name is not an abusive registration. Given the (albeit uncomfortably located) wording of the proviso in Regulation 5(c), this is where the onus anyway lies.

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<sup>2</sup> Section 3(1)(a) of the Regulations.



3.7 The question to be decided, therefore, is whether the domain name is abusive, and this means whether it:-

- (a) was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights; or
- (b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

#### 4. **The Complainant's Contentions – (Summary)**

4.1 The Registrant was fully aware of the Complainant's CITROËN trade mark rights and its reputation when registering the disputed domain name. Thus, the contention proceeds, in The Met Office v Mr Christopher Fell of BUYdomain.co.uk (DRS 00297) the honourable expert considered this to be a factor in determining that the domain name registration in question was an abusive registration. (The Adjudicator agrees that it is one of the factors to be taken into account.)

4.2 The Complainant alleges that *"by cornering the domain name market and registering the disputed domain name and by refusing to settle this matter on reasonable terms, it is reasonable to infer that the registration of the disputed domain name was done in mala fides by the Registrant."* (The Adjudicator does not agree with this contention. *"Cornering the domain market"* is, in the Adjudicator's view, an exaggerated submission not borne out by the facts – which show, at least, that the Complainant has its own site at citroen.com. Several others would be available.)

4.3 The Registrant has registered the name to disrupt the business of the Complainant or as a way of capitalising upon the Complainant's goodwill in the CITROËN trade mark and confusing Internet users

that the person owning the name is somehow connected with the Complainant.

- 4.4 At the time the domain name was registered, Registrant was not commonly known by third parties by the name “Citraën”. The Complainant is the exclusive owner of the CITROËN trademark.
- 4.5 Registrant is not making use of the disputed domain name in connection with the good faith offering of goods or services, nor is Registrant making legitimate non-commercial or fair use of the domain name.
- 4.6 Registrant’s offer to sell the domain name, demonstrates that Registrant is aware of Complainant’s rights in the CITROËN trademark and that Registrant therefore registered the domain name primarily to block intentionally the registration of a domain name in which Complainant had rights and prevent Complainant from exercising these rights.
- 4.7 The registration of the identical domain name by Registrant has the effect that Complainant is barred from registering and using this domain name. Reliance is placed on Red Bull GmbH v. Harold Gutch (D2000-0766).
- 4.8 By using the word “official” in his disclaimer, the Registrant creates the impression that the website has some relationship with the Complainant, which the Registrant does not have. This disclaimer clearly does not explain the relationship between the Complainant and the Registrant. Reliance is placed on Epson Europe BV v Cybercorp Enterprises (Case No. DRS 03027).
- 4.9 By registering the disputed domain name in the largest and principle .za name space, the Registrant has gone well beyond any potential legitimate use of the disputed domain name. The fact that the Registrant has cornered the market is compounded by the fact that

Internet users entering the disputed domain name would expect to be taken to the Complainant's website. Reliance is placed on DaimlerChrysler A.G. v Donald Drummonds (Case No. D2001-0160).

4.10 The name was registered on 16 March 2000. At this time the Registrant was residing in the United Kingdom, and accordingly, the Registrant would have had no interest in the registration of a co.za domain, unless the intention of the Registrant was to take unfair advantage of the Complainant's rights. (This contention is speculative as to the facts, and is countered by the Registrant's positive assertions to the contrary. See paragraph 2.9 above.)

4.11 Reference is placed on the decision in fifa.co.za (ZA2007-007) for the finding that a domain name registration is abusive when a Registrant registers a domain name which is (i) identical to a name in which Complainant has rights; (ii) that name is exclusively referable to Complainant; (iii) there is no obvious justification for Registrant having adopted that name for a domain name; and (iv) Registrant has come forward with no explanation for having selected the domain name. (That case is distinguished by the facts, for integer IV is satisfied in the present matter.)

4.12 In conclusion, the Complainant submits that the registration:

- (a) is intentionally blocking the registration of a name or mark in which the Complainant has rights;
- (b) is unfairly disrupting the business of the Complainant;
- (c) is preventing the Complainant from exercising its rights; and
- (d) has been done in a way that leads people or businesses to believe that the domain name is registered to, operated or

authorised by, or otherwise connected with the Complainant.

## 5 The Registrant's Contentions – (Summary)

- 5.1 Registrant contends that, at the time when the registration took place, it did not take unfair advantage of or was unfairly detrimental to the Complainant's rights. Registrant intended to return to South Africa and wanted to establish a website in tribute to Citroën cars. At the time, Complainant was not operating in South Africa, and his understanding was that Complainant had not been trading in South Africa for some 23 years, and that Complainant did not intend returning to South Africa.
- 5.2 The obvious choice for a domain to pay tribute to Citroën cars in South Africa was <citroen.co.za>. Registrant could have registered a domain such as <ilovecitroen.co.za>, but because Registrant honestly believed that Complainant did not want to exercise its rights in South Africa, Registrant believed the best domain to pay tribute to Complainant was <citroen.co.za>.
- 5.3 The domain name has not been used in a manner that takes unfair advantage of, or is unfairly detrimental to Complainant's rights.
- 5.4 The website at the domain name was always intended to be, was always and still is operated solely in tribute to Citroën cars. The Registrant has made no money from the website and does not make a living with regard to Citroën cars, it is his hobby. He runs and makes a living from a totally unrelated business. Registrant does not charge for a classified ad to be placed, in a section which assists

Registrant and other Citroën enthusiasts trade cars. New cars are not sold on the website.

5.5 No other make of car is mentioned on the website. Nothing other than Citroën cars is mentioned, and the Registrant does not criticise Complainant's business in any way. There are no links to other businesses, no links to other sites, and no advertisements on Registrant's website. The Registrant has never used the domain name to direct visitors to another site.

5.6 It has taken Complainant 8 years to bring the complaint, which indicates that the use of the domain name is not unfairly detrimental to Complainant. If there were substantial economic detriment, Complainant would have taken action a long time ago. There is no economic detriment because Complainant's website encourages people to buy Citroën cars which would lead to an economic advantage for Complainant. Complainant is able to exercise their rights by using <citroensa.co.za> or one of many other domains.

5.7 With regard to the factors contemplated by Regulation 4, Registrant contends that:

5.7.1 Regulation 4(1)(a)(i) When Registrant registered the domain, Registrant had no intention of transferring the domain. The intention was to use the domain to tribute to Citroën cars. Registrant has never tried to transfer the domain to a competitor or any third party. Only on Complainant's request, he provided his "*reasonable out-of-pocket expenses directly associated with acquiring or using the domain name*", and never asked for valuable consideration in excess thereof. Complainant does not make reference to Regulation 4(1)(a)(i), and this is

effectively an admission by Complainant that this factor does not exist.

- 5.7.2 Regulation 4(1)(a)(ii) Registrant did not register the domain to intentionally block the registration of the name Citroën. If Registrant wanted to do this, he would have registered multiple domains that include the name Citroën. There are many other domain names that Complainant can use, and is currently using <citroensa.co.za>. Registrant never tried to block that registration. It cannot be said that Registrant tried to corner the market. If Registrant had wished to do so he would have registered <citroen.org.za> for example as well.
- 5.7.3 Regulation 4(1)(a)(iii) There is no evidence that Registrant has ever unfairly disrupted Complainant's business.
- 5.7.4 Regulation 4(1)(a)(iv) Registrant believed that Complainant did not want to exercise its rights to register the domain. Even after Complainant decided to return to South Africa, Complainant was not prevented from exercising its rights. Complainant could register any number of domains that include the name Citroën and indeed they did register citroensa.co.za and have been using it.
- 5.7.5 Regulation 4(1)(b) Complainant only refers to part of the wording from the website in the Complaint. The Citroën logo does not appear on the Registrant's website. The words "THE WEBSITE OF CITROEN ENTHUSIAST MARK GARROD" appear in ALL CAPS and in a large font in the top right corner of the website. Some of the other wording is "*Please note that this site is purely a collectors site and has no links to Citroen South Africa*". (sic) This wording and the

manner in which it is displayed is sufficient to ensure that the majority of people (if not everyone) would not be misled *“to believe that the domain name is registered to, operated by or authorised by, or otherwise connected with”* Complainant. The disclaimer considered in full clearly explains the relationship between Complainant and Registrant. No false impression can be created that there is a commercial connection between Complainant and Registrant.

5.7.6 The word *“official”* relates to Mark Garrod and not Complainant. Registrant is a well known Citroën enthusiast in South Africa, and he wanted to make it clear that this website is his official website. Internet users entering the disputed domain name would expect to be taken to a website related to Citroën cars, but not necessarily Complainant's website.

5.7.7 Regulation 4(1)(c) Registrant has not engaged in a pattern of making abusive registrations.

5.7.8 Regulation 4(1)(d) Registrant has never provided false or incomplete contact details. Registrant has also been contactable, co-operative and responsive.

5.7.9 Regulation 4(1)(e) Complainant admits that there is no relationship between Complainant and Registrant.

5.8 With regard to the factors contemplated by Regulation 5, Registrant contends that:-

5.8.1 Regulation 5(a)(i) Registrant did use and make demonstrable preparation to use the domain name in

connection with a good faith offering of goods or services. The “under construction” website was publically available at the domain before Registrant became aware of Complainant’s cause for complaint and the “under construction” website was consistent with Registrant’s intention of operating a website in tribute of Citroën cars. Registrant was preparing to offer good faith services to Citroën enthusiasts in South Africa, such as the ability to advertise their cars for sale.

- 5.8.2 Regulation 5(a)(ii) Registrant is not commonly known by the name Citroën, but was commonly known as a Citroën enthusiast. Registrant owned many Citroën cars and was a member of the Citroën car club and was therefore legitimately connected to the trade mark Citroën.
- 5.8.3 Regulation 5(a)(iii) By putting up the “under construction” website, Registrant made legitimate non-commercial or fair use of the domain name.
- 5.8.4 Regulation 5(c) Registrant has demonstrated fair use.
- 5.8.5 Regulation 5(c) specifically makes mention of “websites operated in tribute to” a business. One can only pay tribute to a business if one knows of the business. Registrant did not believe that registering <citroen.co.za> would disrupt the business of Complainant because Complainant was not conducting business in South Africa. Registrant was not preventing Complainant from exercising its rights because Registrant believed Complainant did not want to exercise its rights to register <citroen.co.za>. In addition, Registrant does not own multiple domains that include the name Citroën.



5.9 In conclusion, Registrant submits that he has proved, on a balance of probabilities, that:

5.9.1 he registered the domain in a manner which, at the time when the registration took place, did not take unfair advantage of or was unfairly detrimental to Complainant's rights; and

5.9.2 he has not used the domain in a manner that takes unfair advantage of, or is unfairly detrimental to Complainant's rights; and

5.9.3 there is no evidence of an abusive registration, including none of the factors mentioned in regulation 4; and

5.9.4 there are many factors (including two mentioned in Regulation 5) that indicate that the domain name is not an abusive registration.

## 6 **Complainant's Reply**

The Complainant filed a Reply raising contentions against the Registrants Submissions, but it is not necessary to review them given the decision at which the Adjudicator has arrived.

## 7 **Discussion and Findings**

7.1 The parties filed submissions which are both thorough and comprehensive, and which demonstrated responsible respect to their causes both in the arguments raised and in the supporting evidence. The Adjudicator has reviewed them fully. In light of the

findings that follow, it is not necessary to traverse all the respective submissions and authorities relied upon.<sup>3</sup>

- 7.2 The circumstances of the Registrant's registration and use of the domain, and the correspondence do not, in the adjudicator's view, evince an intention to primarily act as contemplated by Section 4(1)(a). There is no indication of registration in order to sell the name. An inference of an intention primarily to block the Complainant, or to disrupt its business, or to prevent it from exercising its rights, in the Adjudicator's view cannot be made from the facts.
- 7.3 There is no evidence, furthermore, indicating that the Registrant has been engaged in the pattern of making abusive registrations as contemplated by Section 4(1)(c). There is no question of incomplete contact details having been provided in the Whois data base as contemplated by Section 4(1)(d), and there is no relationship between the Complainant and the Registrant as contemplated by Section 4(1)(e).
- 7.4 Are there circumstances which indicate that the Registrant has used or has registered the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by or otherwise connected with the Complainant as contemplated by Section 4(1)(b)? In the Adjudicator's view there is nothing in the evidence to cast the use of the name (i.e. the relevant website) in this light.

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<sup>3</sup> One other noteworthy comment arising from the parties' submissions is that references to authorities are of limited assistance in the adjudication process unless they are specific. An adjudicator ought not to be expected to search through precedents, for the principle sought to be relied upon, which is otherwise postulated by mere citation of previous decisions.

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- 7.5 The problem in this case is the conflict between the legitimacy of (the name for) a tribute site, and the rights of the Complainant in and to its trade mark.
- 7.6 In the view of the Adjudicator, the criteria by which (allegedly) tribute sites are to be assessed cannot exclude, but indeed should be lead by, the criteria in terms of which the unauthorized use of a trade mark is permissible. Once trade mark rights are in issue (as opposed to, for example, merely a person's name, or a domain name, which has no brand significance) the scope of trade mark law cannot be excluded. It is by the measures of trade mark law that the use and appropriation for use by third parties is judged acceptable or not.
- 7.7 It is so that domain names have an esoteric quality to their use, granted by the exigencies of the medium, so that one character difference in the name has potentially a huge difference in identifying the enterprise behind the name. But this cannot be the only consideration. The appropriation of a trade mark remains just that, whatever the medium, and (whilst allowances for the idiosyncrasies of internet usage must be made in the assessment of acceptability or not) the fact remains that property (i.e. intellectual property) has been appropriated by another. In the balancing of the interests that compete in such an event, the well trodden paths of legal principles concerning trade marks cannot be ignored or eschewed for some alternative regime.
- 7.8 One principle is applicable in its guidance for the present context. Under what circumstances is it permissible to use (i.e. appropriate) the mark of another?
- 7.9 Recently, our Supreme Court of Appeal had to decide this point in Commercial Autoglass (Pty) Ltd v BMW AG [2007] (6) SA 637

SCA.<sup>4</sup> It was common cause that BMW's registered trade mark was used without authority in the course of trade in relation to the goods in respect of which the BMW trade mark is registered. Ordinarily, this would satisfy the requirements for a finding of infringement, but Commercial Autoglass relied on the spare parts defence, or "exception" to infringement, contained in Section 34(2)(c) of the Trade Marks Act.<sup>5</sup> It argued that it used the BMW trade mark to inform the public that it is selling windscreens that fit BMW cars, and not that the windscreens are original BMW windscreens. In other words, it contended, it is not misleading the public.

7.10 The Supreme Court of Appeal disagreed. Harms ADP, giving the judgment of the Court, stated:-<sup>6</sup>

*"The object of Trade Mark Law as reflected in Section 34(1)(a) and (b) is to prevent commercial "speech" that is misleading. Trade Mark use that is not misleading (in the sense of suggesting provenance by the trade mark owner) is protected, not only constitutionally but in terms of ordinary trade mark principles...."*

and then continued:-

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<sup>4</sup> In this case, the Appellant sold windscreens not manufactured by or under the authority of BMW, but in relation to which it advertised them, and listed them with their prices in a number of ways in which the BMW trade mark was used. For example, in advertising it listed windscreens as follows:-

*BMW E30 3 series 83-92 R355,00*

*BMW E36 3 series 91-97 R460,00*

*BMW E46 4 series 98 R490,00*

On each windscreen was a stick-on label which included the mark BM E36 and in the quotes Commercial Autoglass gave it undertook to fit a "BMW E36 windscreen". Its invoices for work done described the goods sold as "BMW E36" windscreens.

<sup>5</sup> This provides that:  
*"A registered trade mark is not infringed by –  
(c) the bona fide use of the trade mark in relation to goods or services where it is reasonable to indicate the intended purpose of such goods, including spare parts and accessories, and such services;*

*Provided further that the use contemplated .... is consistent with fair practice."*

<sup>6</sup> Commercial Autoglass, supra, para. 8.

*“The question that arises is why the Appellant insists on conducting its business in the manner described. Why can it not, through the use of a few words, convey the true facts to the public? .... from this one can only deduce that the Appellant wishes to obtain an unfair advantage from the use of the trade mark and does not wish to inform the public of the true facts concerning the origin of the windscreens. In other words, the argument that the advertisements “consist wholly of descriptive, truthful commercial speech” is without factual foundation. “*

7.11 Now the facts of cases are rarely the same, as is so with the case at hand. But the principle is this: when the mark of another is appropriated, it must be in a manner that cannot leave scope for doubt but that it is wholly descriptive and truthful. When that happens, jurisprudence deems the use acceptable, otherwise not. In the Adjudicator’s view, <www.citroen.co.za> does not meet this test.

7.12 Furthermore, what of the following considerations? If the Registrant did want to convey to the web-browser his genuine tribute website, why could he *“not, through the use of a few words, convey the true facts....”*? The Registrant himself postulated <ilovecitroen.co.za> as a possibility for the domain name, but offers no explanation as to why this would not be appropriate. He instead avers that <citroen.co.za> *“would be the best domain to pay tribute to the Complainant”*. The Adjudicator has difficulty understanding why, and it is not explained.

7.13 In his submissions the Registrant emphasized that he thought the Complainant had left the country, and he believed that it would not want to register the name. This, the contention proceeds, justified for him the outright appropriation of the Complainant’s trade mark. One difficulty the Adjudicator has with this is why, being an undoubtedly avid Citroën supporter, at no stage did the Registrant enquire whether his adoption of the mark was acceptable. Surely no

better an accolade for a tribute site would be the tributee's endorsement? It is tempting to draw the inference that anticipated rejection prevented the enquiry.

7.14 Another corollary of the aforementioned principle is that, *prima facie*, a trade mark owner – at least, particularly a registered trade mark owner – ought to be able to register a domain name comprising his trade mark, and nothing but his trade mark. In the modern world of e-commerce, this is de rigeur. Why should a trade mark proprietor be held to ransom (metaphorically speaking) because he was not quick enough?

7.15 The decision in knightsletting.co.uk<sup>7</sup> is relied upon by the Registrant. This domain concerned a criticism (as opposed to tribute) site. Whilst, on the facts (and given the slight differences in the United Kingdom Dispute Resolution Service Policy on domain names) the expert there refused the complaint that the domain name was abusive, the Adjudicator does not consider that the decision assists the Registrant. Relevantly, the expert stated:-

*"The Decision of the Appeal Panel in DRS 02193 (Guidestar.co.uk) sets out the basis of dealing with "protest sites" where the name used is identical to a name in which the complainee has rights.*

*"Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is.*

*Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy. Various decisions under the DRS Policy have condemned such practices including the following:*

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<sup>7</sup> Knights Letting Ltd v Mr Lyndon Watkins (Nominet) DRS 4285, and which discussed scoobydoo.co.uk [Hanna-Barbera Productions Inc. V Graeme Hay, (Nominet) DRS 00389 Appeal] and guidestar.co.uk [Guidestar UK v Wilmington Business Information Ltd (Nominet) DRS2193] also relied upon by the Registrant.

*“In the view of the majority of the Panel, in the context of a tribute site, the vice is in selecting a domain name, which is not one’s own name, but which to one’s knowledge is identical to the name of another, which one has selected precisely because it is the name of that other and for a purpose which is directly related to that other. For a tribute or criticism site, it is not necessary to select the precise name of the person to whom one wishes to pay tribute or criticise. In this case the domain name could have been ‘ilovescoobydoo.co.uk’, for example.*

*Taking the Domain Name in these circumstances arguably amounts to impersonation of the owner of the name or mark. Substantial numbers of people will have visited the Respondent’s website (the Respondent admits to a total of over 37,000 visitors to his site) believing that they were visiting the site of the Complainant, a phenomenon sometimes referred to as ‘initial interest confusion’. Prior to the posting of the disclaimer, those visitors might well not have been disabused. The fact that the Respondent was selling official merchandise may have encouraged those visitors in their belief that they were visiting an authorized/licensed site. Notwithstanding the Respondent’s denial of any advantage, the Panel is of the view that on the balance of probabilities there must have been an advantage to the Respondent of some kind. Whether or not that ‘advantage’ has led to financial gain is irrelevant. The question is as to whether the advantage he has taken has been fair.” [Appeal decision DRS 00389 – scoobydoo.co.uk]*

and:

*“The Expert should also add that, although there is no evidence to suggest the Respondent’s purpose of registering the Domain Name, was one of the three purposes set out in paragraph 3(a)(i) of the Policy, the Expert concludes that there is no obvious reason why the Respondent could possibly be justified in registering the Domain Name for any legitimate purpose. The Domain Name comprises a distinctive made up name. IT is identical to the Complainant’s trade mark. There is no other UK company using the inventive word which comprises the Complainant’s trade mark. In the hands of the*

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*Respondent the Domain Name constitutes a threat hanging over the head of the Complainant and there are many obvious and potentially damaging uses to which the Domain Name could be put.” [DRS 00193 – harmankardon.co.uk]*

*The fact, if it be a fact, that the Domain Name is being used as part of a URL for a protest site is not of itself indicative of fair use. Paragraph 4.b of the DRS Policy merely indicates that such a use may constitute fair use. Much will depend upon all the surrounding circumstances, including in particular the identity of the domain name itself. A finding of fair use will be much more likely in relation to a ‘-sucks’ domain name e.g. guidestarsucks.co.uk.”*

7.16 The Adjudicator considers that those dicta lend support for the views set out above.

## 8 **Decision**

For the foregoing reasons the Adjudicator’s conclusion is that the Registrant has not discharged the onus of showing that his domain name is not abusive. In accordance with Regulation 9, the Adjudicator orders that the domain name be transferred to the complainant.

**ADV. OWEN SALMON**  
SAIIPL SENIOR ADJUDICATOR  
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