

## **Nominet UK Dispute Resolution Service**

**DRS 0063**

**Fiat S.p.A and WDOT Internet Limited**

### **Decision of Independent Expert**

#### **1. Parties:**

Complainant: Fiat S.p.A  
Address: Via Nizza  
250 Torino  
Postcode: 10126  
Country: Italy

Respondent: WDOT Internet Limited  
Address: 94 High Street  
Markgate  
St Albans  
Hertfordshire  
Postcode: AL3 8LE  
Country: United Kingdom

#### **2. Domain Names:**

fiatfinance.co.uk;  
alfaromeofinance.co.uk; and  
fiatvans.co.uk (together "the Domain Names").

#### **3. Procedural Background:**

The Complaint was lodged with Nominet on October 25, 2001. Nominet validated the Complaint and notified the Respondent of the Complaint on October 31, 2001 informing the Respondent that it had 15 days within which to lodge a Response. The Respondent failed to respond. Mediation not being possible in those circumstances, Nominet so informed the Complainant on November 23, 2001. On November 26, 2001 Nominet was contacted by the Treasury Solicitor who informed Nominet that the Company had been dissolved on June 19, 2001 and that the Domain Names were bona vacantia and title to the Domain Names had passed to the Crown. On November 30, 2001 the Complainants paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 8 of the Nominet UK Dispute Resolution Service Procedure ("the Procedure").

On December 4, 2001, Tom Thomas, the undersigned ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

#### **4. Outstanding Formal/Procedural Issues:**

The Respondent has failed to submit a response to Nominet in time in accordance with paragraph 5a of the Procedure.

Paragraph 15b of the Procedure provides, inter alia that “If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in this Policy or the Procedure, the Expert will proceed to a Decision on the complaint.”

Are there exceptional circumstances present in this case? Although the evidence before the Expert may indicate unusual circumstances to the extent that the Domain Names are bona vacantia they do not in the Experts view constitute exceptional circumstances for the purpose of paragraph 15b and accordingly the Expert will now proceed to a Decision on the Complaint and not withstanding the absence of a Response.

Paragraph 15c of the Procedure provides that “If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure....., the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate.”

When considering what inference if any to draw from the Respondent’s failure to submit a response the Expert recognises that there are of course many reasons why the Respondent may have failed to provide Nominet with a response. In this particular case although the dissolution of the Respondent may well have been a factor in the Respondent’s failure to provide a response, the Expert does not consider it necessary to speculate further or find this to be the case as a question of fact.

Since the probable facts of this case are not controversial, there is no need in the Expert’s opinion to draw any special inferences. For the purpose of this decision, the Expert is satisfied that the probable facts asserted by the Complainant (if not the assertions founded on those facts) set out in the following section are indeed facts.

The Expert has considered whether the dissolution of the Registrant has any bearing on the Expert’s ability to proceed to a Decision. In the view of the Expert this would only be the case if domain name registrations automatically lapsed or were cancelled on dissolution of a company. The Nominet UK terms and conditions of domain name registration which incorporates the Procedure and the Nominet UK Dispute Resolution Policy (“the Policy”) make no such provision and the Expert therefore concludes that it is competent for the Expert to proceed to a Decision.

#### **5. The Facts:**

The Complainant is a well known manufacturer and distributor of motor vehicles and associated branded products of many years standing. The Complainant and its associated companies have the benefit of a portfolio of registered trade marks relevant to the United Kingdom in terms of UK and Community Trade Mark registrations including registrations for the words “Fiat” and separately “Alfa Romeo”.

The Complainant also trades from a web site at [www.fiat.com](http://www.fiat.com) and is the proprietor of a number of domain names incorporating the Fiat and Alfa Romeo trade marks including fiatvans-online.co.uk, alfaromeofinance.com, alfaromeo.co.uk and fiat.co.uk.

On 22<sup>nd</sup> October 1999 the Respondent registered the domain name fiatvans.co.uk and on 9<sup>th</sup> December it registered the domain names fiatfinance.co.uk and alfaromeofinance.co.uk. The

domain name fiatvans.co.uk links to a web page entitled vandirectory.co.uk. The other domain names fiatfinance.co.uk and alfaromeofinance.co.uk do not currently link to active websites.

On 30<sup>th</sup> May 2001 a representative of the Complainant wrote to the Respondent requesting the transfer of the domain names fiatfinance.co.uk and alfaromeofinance.co.uk offering on behalf of the Complainant to pay the Respondent £500 for the release of each address. The Respondent did not reply.

On 17<sup>th</sup> August 2001 the Complainant's legal advisers wrote to the Respondent asserting that the Domain Names had been registered by the Respondent in bad faith and seeking the transfer of the Domain Names to the Complainant. Again the Respondent did not reply.

## **6. The Parties' Contentions:**

### **Complainant:**

The Complainant's contentions are as follows:-

1. The Complainant is the proprietor of a number of registered trade marks for the mark "Fiat" and Fiat Auto S.p.A., an associate company of the Complainant, is the proprietor of a number of registered trade marks for the mark "Alfa Romeo".
2. The Complainant trades from a web site at [www.fiat.com](http://www.fiat.com) and is the proprietor of a number of domain names including domain names incorporating the Fiat and Alfa Romeo trade marks including fiatvans-online.co.uk, alfaromeofinance.com, alfaromeo.co.uk and fiat.co.uk.
3. All of the Domain Name registrations took place over 30 years after the registration of the Complainant's (and its associated company's) trade marks
4. The Domain Names are identical or similar to the trade marks and domain names in which the Complainant has rights.
5. The domain name fiatvans.co.uk is linked to a web site at [www.vandirectory.co.uk](http://www.vandirectory.co.uk) although no further information or services are provided at this site.
6. The domain names alfaromeofinance.co.uk and fiatfinance.co.uk are not linked to active websites.
7. The Respondent's use of the domain name fiatvans.co.uk in relation to a website which purports to (but does not) provide information about vans and related products and services, is likely to result in members of the public and businesses being confused into believing that the domain name is registered to, operated or authorised by or otherwise connected with the Complainant.
8. The non-use of the other disputed domain names, while not in itself evidence of abusive registration, when viewed with the confusing use of the fiatvans.co.uk domain name demonstrates a pattern of abusive registration.
9. The Respondent has failed to make any claim to a legitimate interest in any of the Domain Names nor has it used any of them in connection with a genuine offering of goods or services. The Respondent has not been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Names, nor has the Respondent made any legitimate non-commercial or fair use of the Domain Names.

### **Respondent:**

The Respondent has not responded.

## **7. Discussion and Findings:**

### **General**

In accordance with paragraph 2 of the Nominet UK Dispute Resolution Service Policy (“the Policy”) the Respondent must submit to proceedings under the Dispute Resolution Service if, in respect of each of the Domain Names, the Complainant satisfies the Expert on the balance of probabilities that :-

- “(i) The Complainant has Rights in respect of a name which is identical or similar to the Domain Name; and
- (ii) The Domain, in the hands of the Respondent, is an Abusive Registration”

Definitions of “Rights” and “Abusive Registration” are provided in paragraph 1 of the Policy.

### **Complainant’s Rights**

The Complainant is the proprietor of a portfolio of registered trade marks comprising of, or incorporating, the word “Fiat” and is the proprietor of a number domain names including alfaromeo.com, alfaromeofinance.com and fiatvans-online.co.uk. In addition its associate company Fiat Auto S.p.A. is the proprietor of various trade marks comprising of, or incorporating, the word “Alfa Romeo”.

When comparing any name or mark in which the Complainant has Rights with the Domain Names the first and second level suffixes of each of the Domain Names, being generic in nature, are to be discounted.

In relation to fiatvans.co.uk and fiatfinance.co.uk the Expert is satisfied the Complainant’s direct proprietary interest in the Fiat name and the substantial goodwill associated with that brand constitute sufficient grounds to conclude that the Complainant has Rights in respect of a name which is similar to each of those domain names.

In relation to alfaromeofinance.co.uk the position is less clear. It occurs to the Expert that Fiat Auto S.p.A. would appear to have more obvious grounds for complaint. Certainly if this were a case of infringement of an Alfa Romeo trade mark decided at court (or at the Trade Mark Registry) then as proprietor of the various Alfa Romeo trade marks Fiat Auto S.p.A. and not the Complainant would undoubtedly be the Plaintiff in those proceedings. The mere association between the Complainant and Fiat Auto S.p.A. does not of itself entitle the Complainant to enforce the other company’s rights on it’s behalf.

So independently of the rights of its associate company is there any basis upon which the Complainant could claim Rights ? The only factor of assistance to the Complainant is its claim to beneficial ownership of the domain names alfaromeo.co.uk, alfaromeo.com and alfaromeofinance.com. The Expert does not consider mere ownership of these domain names to be sufficient in itself to constitute a Right, however the Expert is prepared to accept that in these particular circumstances, the fact that the Complainant owns these domain names infers that the Complainant has a right or licence to use the name Alfa Romeo sufficient to constitute a Right for the purpose of this Decision. Accordingly, and in the absence of any response from the Respondent to challenge the Complainant’s assertion of Rights the Expert is satisfied on the balance of probabilities that the Complainant has Rights in a name which is identical, or at least similar, to the domain name alfaromeofinance.co.uk.

## **Abusive Registration**

Paragraph 1 of the Policy defines “Abusive Registration” as:-

“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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

The Policy provides (at paragraph 3a) a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. Of these factors there is no inference or assertion in the Complaint of any of the factors referred to in paragraph 3.a.i. or 3.a.iv. This leaves the Expert to consider paragraphs 3.a.ii and 3.a.iii., in turn.

Paragraph 3.a.ii refers to:-

“Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant”

There being no assertion in the Complaint of use of the other domain names in dispute, it is only in relation to fiatvans.co.uk that paragraph 3.a.ii. may apply. The difficulty for the Complainant is that although they are able to speculate upon the possibility of the necessary confusion arising they have failed to produce any evidence of actual confusion taking place. Paragraph 3.a.ii. is clear, the Complainant must show evidence of actual confusion and the Complainant’s submissions are therefore not sufficient in the Expert’s opinion to found upon paragraph 3.a.ii..

This leaves paragraph 3.a.iii which states:-

“In combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations”

In the Complaint the Complainant seeks to rely on this paragraph in relation to fiatfinance.co.uk and alfaromeofinance.co.uk the Complainant’s contention being that the non-use of these domain names, “when viewed with the confusing use of the fiatvans.co.uk domain name, demonstrates a pattern of abusive registration.”. Clearly in this respect the Registrant’s conduct in relation to fiatvans.co.uk is only relevant in relation to demonstrating a pattern of Abusive Registrations and then only if the Complainant can show that fiatvans.co.uk is an Abusive Registration.

In making this submission the Complainant acknowledges the provisions of paragraph 3.b. which state that failure to use a domain name is “not in itself evidence that the Domain Name is an Abusive Registration” So what “other circumstances” are present to suggest that either of fiatfinance.co.uk or alfaromeofinance.co.uk are Abusive Registrations ? Although the Complaint contains relatively detailed evidence in support of the Complainant’s assertions with regard to its Rights the Expert finds no evidence in the Complaint of any factors which amount to “other circumstances”.

Even if such other circumstances were present to successfully rely on paragraph 3.a.iii. the Complainant must still demonstrate that the Registrant is engaged in a pattern of Abusive Registrations which on the Expert’s view means that there must be evidence of at least one

other Abusive Registration. In this case the Complainant is relying on its assertion that the fiatvans.co.uk domain name is being used in a manner likely to cause confusion in the minds of members of the public and businesses. This is not in the Expert's view good enough as evidence to support a pattern of Abusive Registrations and the Expert accordingly finds that the Complaint fails on this ground.

Are there any other factors for the Expert to take into consideration ? The only other contentions made by the Complainant in its Complaint relate to factors referred to in paragraph 4. of the Policy which the Registrant may have sought to rely on in its defence had it submitted a response. The Expert therefore finds that there are no additional factors to be taken into consideration as evidence of Abusive Registration in relation to any of the Domain Names.

## **8. Decision:**

The Experts finds that on the balance of probabilities, the Complainant has rights in names which are identical or similar to each of the Domain Names but that none of the Domain Names are, in the hands of the Registrant, Abusive Registrations. The Expert therefore directs that the Complaint in respect of each of the Domain Names be refused.