

## **ADMINISTRATIVE PANEL DECISION**

Ford Motor Company and Ford Motor Company of Canada, Limited v.  
Gordon Lidgard  
Case No. D2022-0141

### **1. The Parties**

The Complainant is Ford Motor Company, United States of America, and Ford Motor Company of Canada, Limited, Canada, represented by Kucala Law LLC, United States of America.

The Respondent is Gordon Lidgard, New Zealand.

### **2. The Domain Name and Registrar**

The disputed domain name <fordhire.com> is registered with eNom, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 15, 2022. On January 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 18, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 16, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on February 23, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the

Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is the well-known motor company, founded by Henry Ford in 1903. In 1907, the Complainant introduced its FORD mark in a scripted typeface and placed said scripted typeface into a blue oval logo in 1927. Over the years, the Complainant has manufactured and sold millions of motor cars, introducing innovations such as the moving assembly line in 1913. The Complainant manufactures and distributes automobiles across six continents, has a complement of 180,000 employees worldwide and 9,000 dealerships globally. The Complainant has maintained a subsidiary where the Respondent is located, namely Ford Motor Company of New Zealand Limited, since 1936. The Complainant's Internet presence in New Zealand dates back to 1997 when its domain name <ford.co.nz> was first registered. The Complainant notes that said website features its FORD mark in its blue oval/script logo version prominently.

The Complainant is the owner of a global portfolio of registered trademarks in respect of the FORD mark. For example, the Complainant is the owner of New Zealand Registered Trademark no. 269731 in respect of the word mark FORD, registered on September 23, 1997, in Class 12.

The disputed domain name was registered on December 18, 2016. The website associated with the disputed domain name features a prominent reproduction of the Complainant's well-known FORD blue oval logo, modified to read "FordHire", and the message "FordHire is redefining rental vehicles". Said site goes on to offer various vehicles for hire in New Zealand. The Respondent is not an authorized New Zealand dealer or distributor of the Complainant's vehicles.

The Complainant and the Respondent corresponded by email between September 20, 2021, and November 7, 2021. On September 20, 2021, the Complainant issued a formal letter by email to the Respondent noting its concerns as to the Respondent's reproduction on the website associated with the disputed domain name of the FORD script/oval trademark, the Complainant's F in script mark, the Complainant's FORD word mark (including within the disputed domain name), and making unauthorized use of the Complainant's copyright in photographs. The Complainant requested that the Respondent cease and desist from making unauthorized uses of its intellectual property and transfer the disputed domain name to the Complainant.

By email of September 30, 2021, the Respondent indicated that while it would agree to certain aspects of the Complainant's said letter, it did not agree to desist from using the disputed domain name on the grounds that "FordHire" was not a trademark of the Complainant, and that the Respondent had built up good traffic to the disputed domain name, so that it had some intrinsic value. In return for transferring the disputed domain name, the Respondent requested "a good discount" on its next purchase of one of the Complainant's vehicles, amounting to at least NZD 35,490 off the recommended retail price. On October 18, 2021, the Complainant reiterated its demand for a transfer of the disputed domain name, indicating that it reserved the right to proceed with a complaint under the Policy. The correspondence between the Parties continued, during which the Respondent alleged that the name "Ford" was a common surname, and proposed that the Complainant purchase the disputed domain name from the Respondent based upon domain name valuations which the Respondent had obtained. On November 7, 2021, the Complainant wrote to the Respondent indicating that it was unable to provide an offer to purchase the disputed domain name.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant contends as follows:

#### **Identical or confusingly similar**

The Complainant owns strong trademark rights in the FORD mark, which is famous, distinctive and entitled to a broad scope of protection. The disputed domain name is nearly identical and confusingly similar to such mark. The disputed domain name contains the FORD mark as its dominant element. The addition of the descriptive term "hire" does not change the fact that the disputed domain name is confusingly similar to the Complainant's trademark. The term "hire" refers to car hire or car rentals and the addition of such other term would not prevent a finding of confusing similarity.

#### **Rights or legitimate interests**

The Respondent is not affiliated or connected with the Complainant in any way, nor has the Complainant authorized or licensed the Respondent to use the FORD mark in the disputed domain name. The Respondent can show no facts, including those based upon paragraph 4(c) of the Policy, which establish any rights to or legitimate interests in the disputed domain name. The Respondent did not use the term "Ford" prior to the Complainant's adoption and use of its famous and distinctive FORD mark. The Respondent is not using or preparing to use the disputed domain name in connection with a *bona fide* offering of goods or services.

The Respondent's website associated with the disputed domain name is that of a third party which offers self-driving tours and rental vehicles. Such use does not establish nominative or fair use according to the "Oki Data" test. The Respondent does not sell any FORD vehicles and does not sell only the trademarked goods or services but offers FORD branded self-driving tours. The website associated with the disputed domain name does not include any statement accurately and prominently disclosing the Respondent's relationship with the Complainant and in fact gives the opposite impression by modifying the Complainant's logo, and copying its look and feel to give the impression that said site is endorsed by the Complainant when it is not. The Complainant cannot determine if the Respondent has tried to "corner the market" in domain name registrations due to the fact that the Respondent's details are privacy protected.

There is no evidence that the Respondent has been commonly known by the disputed domain name or has any rights predating those of the Complainant. Given the long prior use of over a century by the Complainant of the FORD mark before the Respondent registered the disputed domain name, it is exceedingly unlikely that the Respondent is commonly known by the FORD mark. The Complainant's use of the disputed domain name is commercial in nature and does not constitute a legitimate noncommercial use. The Respondent was well-aware of the Complainant and knowingly adopted the Complainant's mark in the disputed domain name to create the false impression of association or endorsement.

#### **Registered and used in bad faith**

The Respondent knew or should have known of the Complainant's rights in the FORD mark prior to registration of the disputed domain name in light of the well-known character of the trademark. The Respondent intentionally attempted to attract Internet users to the disputed domain name for commercial gain. The Respondent demanded an unreasonable amount of money in order to transfer the disputed domain name. The request for a very substantial discount of about USD 25,000 reflects a clear intent to profit from the registration and use of the disputed domain name and far exceeds any reasonable out of pocket costs. The Respondent infringed upon the Complainant's copyright materials which has been found to amount to bad faith in previous cases under the Policy.

## B. Respondent

The Respondent did not reply to the Complainant's contentions.

## 6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

There are two parts to the inquiry under the first element of the Policy. First, the Complainant must demonstrate that it has UDRP-relevant rights in a trademark. Secondly, in order to determine whether the disputed domain name is identical or confusingly similar to such trademark, the two are compared, typically on a straightforward side-by-side basis to determine whether the latter is recognizable in the former. In the comparison process, the Top-Level Domain ("TLD") is usually disregarded as being required for technical reasons only.

In the present case, the Complainant has established that it has rights in the FORD trademark by reference to the registered trademark noted in the factual background section above, among many others. Comparing this to the Second-Level Domain of the disputed domain name on the basis described above, it can be seen that the first element consists of the Complainant's mark in its entirety, and it is entirely recognizable. The additional word "hire" does not alter such recognizability and would not prevent a finding of confusing similarity (see section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

In all the above circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that the Complainant has carried its burden with regard to paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for

commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”.

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by a respondent, that such respondent has no rights or legitimate interests in a domain name. In the present case, the Panel finds that the Complainant has made out such a *prima facie* case. The Complainant asserts that the Respondent has no affiliation to or connection with the Complainant, is not commonly known by the disputed domain name and cannot rely upon any aspects of paragraph 4(c) of the Policy, adding that the Respondent knowingly adopted the Complainant’s mark in the disputed domain name to create the false impression of association or endorsement.

With regard to the Respondent’s apparent use of the Complainant’s mark to reference the hire of, and tours using, the Complainant’s FORD vehicles, the Complainant’s case focuses upon the principles established by the panel in *Ok i Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). This early case under the Policy has met with widespread approval among subsequent panels and its approach is typically adopted in appropriate cases where a respondent asserts, or where there may be evidence suggesting, that such respondent is making nominative fair use of a complainant’s mark.

The panel in that case put forward four conditions which should be met for a respondent, typically a reseller or authorized distributor of a complainant’s goods or services, to be able to establish that it is making nominative fair use of a trademark for the purposes of the Policy, namely: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark. In the present case, the Complainant makes the unchallenged assertion that the Respondent cannot fulfil items (i), (ii), or (iii) of the conditions and, on that basis, could not be regarded as having rights or legitimate interests in the disputed domain name on the basis of nominative fair use.

In these circumstances, the burden of production shifts to the Respondent to bring forward evidence of its rights or legitimate interests in the disputed domain name. The Respondent has chosen not to participate in the administrative proceeding and accordingly has put forward no submissions or evidence regarding any rights or legitimate interests in the disputed domain name which might have rebutted the Complainant’s *prima facie* case. The Panel has not found anything in the present record or in the Parties’ correspondence which might have provided a suitable rebuttal if put forward by the Respondent. In particular, the Panel accepts the Complainant’s assessment in terms of *Ok i Data, supra*, as it applies to the facts of this case.

In these circumstances, the Panel finds that the Respondent has failed to rebut the Complainant’s *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and accordingly that the Complainant has carried its burden with regard to paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out of pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a

competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location".

In the present case, there is no doubt that the Respondent registered the disputed domain name with prior knowledge of the Complainant's famous FORD mark and with intent to target it. The Respondent reproduces an adjusted variant of the Complainant's well-known blue FORD scripted oval logo on the website associated with the disputed domain name along with the Complainant's copyright imagery, leaving the Panel in no doubt that the Respondent is deliberately referencing the Complainant's mark, despite having no authorization to do so, and that the Respondent is seeking to benefit commercially from a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. This constitutes evidence of registration and use in bad faith in terms of paragraph 4(b)(iv) of the Policy. In addition, it is evident from the correspondence between the Parties that the Respondent attempted to use the disputed domain name as leverage in commercial negotiations with a view to obtaining a substantial discount on one of the Complainant's vehicles in return for the transfer of the disputed domain name to the Complainant. On no view could this be regarded as a good faith activity on the Respondent's part.

Despite having received notification of the Complaint, the Respondent has chosen not to engage with the administrative proceeding and has not made any attempt to address or refute the Complainant's contentions regarding the registration and use of the disputed domain name. In the absence of any input from the Respondent, the Panel has considered the terms of the Parties' correspondence in order to ascertain the Respondent's motivations and finds that this points firmly in the direction of registration and use in bad faith, given that the Respondent attempted in the first instance to sell the disputed domain name for an amount considerably in excess of its likely out-of-pocket costs in relation thereto and ultimately tried to use the same as leverage to obtain a substantial discount from the Complainant. In the meantime, the Respondent was using the disputed domain name in connection with a website which gave the impression that it was an official website of the Complainant, and that the Complainant had moved into the field of car hire and related tours. In this way, the Respondent sought to appropriate the Complainant's goodwill unfairly for its own commercial benefit.

In all of the above circumstances, the Panel finds that the disputed domain name was registered and is being used in bad faith, and accordingly that the Complainant has carried its burden in terms of paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <fordhire.com> be transferred to the Complainant.

*/Andrew D. S. Lothian/*

**Andrew D. S. Lothian**

Sole Panelist

Date: March 9, 2022