

ADMINISTRATIVE PANEL DECISION

Ford Motor Company, Ford Motor Company of Canada, Limited v. Domain Admin, Whois Protection / Domain Administrator, Radio plus, spol.s r.o.
Case No. D2022-0954

1. The Parties

The Complainants are Ford Motor Company, United States of America (“United States”) and Ford Motor Company of Canada, Limited, Canada,¹ represented by Kucala Law LLC, United States.

The Respondent is Domain Admin, Whois Protection / Domain Administrator, Radio plus, spol.s r.o., Czech Republic, represented by Zdenek Kubik, Czech Republic.

2. The Domain Name and Registrar

The disputed domain name <fordirect.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 17, 2022. On March 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 21, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 29, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 30, 2022.

The Center verified that the Complaint together with the amended 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”).

¹ This decision will refer to the Complainants together as “the Complainant”, unless any reference is made specifically to each of the Complainants.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2022. The Response was filed with the Center April 20, 2022.

On April 25, 2022, the Complainant submitted a Supplemental Filing responding to some of the information presented in the Response. On April 26, 2022, the Respondent submitted a Supplemental Filing responding to the Complainant's Supplemental Filing.

The Center appointed Reyes Campello Estebaranz, Sandra J. Franklin and The Hon Neil Anthony Brown KC as panelists in this matter on May 19, 2022. The Panel finds that it was properly constituted. Each member of 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 was founded in 1903 and is a global automotive industry leader, manufacturing and distributing automobiles across six continents, with over 180,000 employees, over 9,000 dealerships, and with a worldwide revenue of USD 127 billion in 2020. The Complainant's products and services are marketed under the trademark FORD, as well as other brands, including FORD PROTECT, FORDDIRECT, and FORDDIRECT.COM. The Complainant has extensively and continuously used the FORD mark and the FORD Oval logo since 1940, and the FORDDIRECT and FORDDIRECT.COM marks since July 2000.

The Complainant Ford Motor Company holds a large portfolio of registered trademark rights in the mark FORD, the FORD Oval logo, as well as in the marks FORDDIRECT, FORDDIRECT.COM, in many jurisdictions, including:

- United States Registration No. 2,884,529, FORD, word, registered on September 14, 2004, in Class 36;
- United States Registration No. 1,997,203, FORD, figurative (oval logo), registered on August 27, 1996, in Class 12;
- United States Registration No. 1,574,747, FORD, word, registered on January 02, 1990, in Classes 12 and 17;
- European Union Registration No. 4527677, FORD, word, registered on July 3, 2006, in Class 36;
- European Union Registration No. 4670618, FORD, word, registered on April 1, 2008, in Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 22, 24, 25, 27, 28, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, and 43,
- United States Registration No. 2,750,838, FORDDIRECT, word, registered on August 12, 2003, in Classes 36 and 39;
- United States Registration No. 2,767,266, FORDDIRECT, word, registered on September 23, 2003, in Class 35;
- United States Registration No. 2,976,517, FORDDIRECT, word, registered on July 26, 2005, in Class 38;
- United States Registration No. 2,767,294, FORDDIRECT.COM, figurative, registered on September 23, 2003, in Class 38; and
- United States Registration No. 2,735,207, FORDDIRECT.COM, figurative, registered on July 8, 2003, in Class 35, (collectively the "FORD mark", the "FORD Oval logo", the "FORDDIRECT mark", and the "FORDDIRECT.COM mark").

The Complainant further own various domain names that include its trademarks, including <ford.com> (registered on September 1, 1988), and <forddirect.com> (registered on July 20, 1998).

The disputed domain name was registered on May 31, 2001, and, according to the evidence provided by the Respondent, it was acquired by the Respondent on March 7, 2013. According to the evidence provided by the Complainant, the disputed domain name has been redirected to a website of a competing automotive manufacturer offering various vehicles of a different trademark, specifically the website “www.nissanusa.com”, and it is offered for sale at the Afternic platform for the sum of USD 9,746.

5. Parties' Contentions

A. Complainants

Key contentions of the Complaint may be summarized as follows:

Due to extensive promotion and continuous use over a century, the FORD mark is well-known internationally, as it has been recognized by multiple prior UDRP decisions. Accordingly, the FORD brand is entitled to a broad scope of protection.

The disputed domain name was first registered on or around May 31, 2001, by one of its authorized vehicle dealership, Burd Ford, in Indiana. This dealership closed in 2012 and the disputed domain name went into redemption soon thereafter, probably being acquired by the Respondent in late 2014.

The disputed domain name is virtually identical to the FORDDIRECT mark, and confusingly similar to the famous FORD mark. The disputed domain name incorporates these trademarks with a minor misspelling, deleting the letter “d” in the word “direct”.

The Respondent has not rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name, and is not affiliated with the Complainant not being authorized to use its trademarks. The Respondent is an entity based in the Czech Republic that appears to operate the online electronics store (“www.svetsoucastek.cz”). The Complainant started the use of its trademarks well before the Respondent acquired the disputed domain name, and it is not used in connection with a *bona fide* offering of goods or services, or a legitimate or fair use. The disputed domain name redirects to websites for competing automotive manufacturers, such as, Nissan, diverting traffic away from the Complainant, and it is offered for sale for the sum of USD 9,746.

The disputed domain name was registered and is being used in bad faith. Due to the reputation of the Complainant and its trademarks, the Respondent knew or should have known of its Prior Rights. A simple trademark search would have revealed the Complainant's registrations. The Respondent's bad faith is corroborated by the use of the disputed domain name to redirect to competing websites in the automobile field. The Respondent is likely earning revenue by this redirection. The Respondent registered and uses the disputed domain name in bad faith with the intent to capitalize on the Complainant's fame and reputation by creating a likelihood of confusion with its trademarks, in an attempted to increase the traffic of the Respondent's site for a commercial gain. The offer to sell the disputed domain name for more than reasonable out of pocket costs (almost USD 10,000), and the use of a misspelling of the Complainant's trademark, are further evidence of bad faith.

The Complainant has cited previous decisions under the Policy that it considers supportive of its position, and requests the transfer of the disputed domain name.

Key contentions of the Complainant's Supplemental Filing may be summarized as follows:

The Respondent's allegation that the disputed domain name does not redirect to websites of Ford's competitors is incorrect. The evidence provided by the Respondent is referred to a different subdomain ("ww1.fordirect.com"), and shows that the disputed domain name may be associated with software that is downloaded onto the visitor's computer. As the Respondent only submitted the intermediary redirecting pages, there is no evidence that the visitor ultimately did not reach the website of one of the Complainant's competitors. The Respondent has not provided any evidence that supports its allegation that the disputed domain name redirects based on previous searches or IP address locations.

The Respondent failed to provide any supporting UDRP decisions for its arguments that there is no bad faith in the circumstances of this case.

There is no basis for a finding of Reverse Domain Name Hijacking ("RDNH"), because the Complainant has provided detailed evidence and arguments, which largely remain unchallenged by the Respondent. The Respondent has not alleged any specific facts to support a claim of bad faith or harassment on behalf of the Complainant.

B. Respondent

Key contentions of the Response may be summarized as follows:

The Complainant's allegations and cited cases are irrelevant. The disputed domain name is not similar to the FORD mark, as it does not contain the FORD mark but the preposition "for". There are 100 domain names with the generic Top-Level Domain ("gTLD") ".com" containing the phrase "ForDirect"; there are over 100,000 domain names containing the string "Ford"; and there are 900 domain names starting with the string "Ford", and not all of them belong to or were authorized by the Complainant. The disputed domain name is not primarily similar to the Complainant's brands because it is a phrase by itself.

The Respondent has rights or legitimate interests in the disputed domain name. The disputed domain name has nothing to do with the Complainant's trademarks. "For direct" is a common and popular phrase, with 187 million results in Google; more results than other common phrases, and more results than the FORD DIRECT mark (with only thousands results in Google). Furthermore, there are companies all over the world named "For direct".

The disputed domain name was acquired and is being used in good faith in 2013. There was no content in the Complainant's domain name <forddirect.com> until March 2014 (according to the Internet Archive WayBackMachine), so it is not possible to target an inexistent website. The Respondent did not know about the brand FORDDIRECT until this proceeding was notified. This brand is not famous, being likely unknown outside the Complainant's dealers circle. When this proceeding was notified, the Respondent thought it must be from a different company (the company running business on domain name <for.direct>).

To buy, sell, and park domain names is a *bona fide* business. The disputed domain name is offered for sale at Afternic platform (for a minimum bid of USD 1,625), where it is simply listed for sale, not targeting anyone in particular. The Respondent has not offered the disputed domain name to the Complainant. There is no "cybersquatting" domain names in the Respondent's portfolio. The Respondent has won four prior UDRP cases, one of them with declaration of RDNH, and it lost only one case.

The disputed domain name redirects based on previous searches, IP address location and other factors, not always redirecting to "www.nissanusa.com", and technically this website is not competing with the Complainant's services under the FORDDIRECT mark, as the Complainant's site "www.forddirect.com" is a page for dealers, while the site "www.nissanusa.com" is a page for buyers.

The Respondent requests the Panel to deny the remedies requested by the Complainant.

Key contentions of the Respondent's Supplemental Filing in response to the Complainant's Supplemental Filing may be summarized as follows:

Buying and selling domain names is legitimate business, not being necessary to cite any UDRP case to support this allegation, and it is not possible to sell domain names just for "out of pocket costs". It is necessary a bigger margin to make the business work (average turnover is only 1% of portfolio per annum).

The disputed domain name was acquired as a popular term, and if it redirects someone to Nissan based on previous searches, that is collateral and not intentional, not being under the Respondent's control. The site "www.fordirect.com" is also a subdomain, same as "ww1.fordirect.com". Anyone can arrive to anywhere from a landing page, when previously has done a search in the search option, based on that search.

6. Discussion and Findings

A. Unsolicited Supplemental Filings

Unsolicited supplemental filings are generally discouraged by UDRP panelists, unless specifically requested by the Panel. See section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

However, taking into consideration the circumstances of the case, with the aim to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, the Panel, under its general powers, articulated, *inter alia*, in paragraph 10 of the Rules, admits the supplemental filings of the Parties.

B. Decision of the Majority of the Panel

The Majority of the Panel, consisting of The Hon Neil Anthony Brown KC and Sandra J. Franklin, has provided the following text in the form of a document that was sent to the Presiding Panelist as reproduced below with minor amendments made only for clarity.

OPINION

This document deals with two proposed decisions prepared by the Presiding Panelist which recommend a finding in favour of the Complainant and it expresses a contrary opinion to both of those proposed decisions. The first of the two proposed decisions, called the "Final Version", presumably meaning the final version of numerous previous versions of the decision, was sent by the Presiding Panelist to other members of the Panel on 6 June 2022. It is discussed in Part A of the document that the reader is now perusing. The decision reached in the Final Version was to the effect that the Complainant should prevail and that the disputed domain name should be transferred to the Complainant.

The second proposed decision was sent by the Presiding Panelist to other members of the Panel on 9 June 2022 and is discussed in Part B of the document that the reader is now perusing. It was described as the "Final Draft", presumably meaning the final draft of numerous previous drafts of the decision. The decision reached in the "Final Draft", essentially only an amended version of the Final Version, was also to the effect that the Complainant should prevail and that the disputed domain name should be transferred to the Complainant.

The present decision, i.e., the document that the reader is now perusing, proposes that the Panel's work has been compromised by the use of private research by the Presiding Panelist that was not drawn to the notice of either party so that they could respond to it and either rebut it or support it and that this private research was pivotal to the Final Version and therefore pivotal to the Final Draft that was based on it. Consequently, the opinion of the majority was and is that the Respondent should prevail and that the opinion that the domain name should be transferred should not be supported. The Complaint should be dismissed and the disputed domain name should remain with the Respondent. The Complainant should have liberty to file and serve a fresh complaint without prejudice if it wishes, so that a new panel can be formed that does not include any panelist involved in the present proceeding.

Both the proposed decision of 6 June 2022 (“the Final Version”) and the proposed decision of 9 June 2022 (the “Final Draft”) are dealt with together in this decision because:

- (1) examining both proposed decisions will inform the Panel whether it should decide in favour of the case advanced in Part A or Part B or an order not yet proposed in either of Part A or Part B;
- (2) it is clear in comparing the two decisions, that the Final Draft builds on, takes into account the Final Version and is really only a refined version of the Final Version;
- (3) irrespective of what is contained in the Final Draft, its author has made it clear that the decision in the Final Draft could not have been made without, and is pivotal to, the decision that had already been reached in the Final Version.

Summary of this document

The point that is sought to be made in this document is that the Final Version cannot be accepted because it is based on and in substance consists of so-called evidence that has been obtained by private research by the Presiding Panelist only, which was not brought to the notice of either party and which neither party had an opportunity to rebut or even to adopt, if it were so minded. The parties were simply not told about it and had no opportunity to test it or reply to it with their own evidence. The evidence produced by this private research was not limited but was extensive. Indeed, the bulk of the evidence in the Final Version was evidence adduced from the private research. Moreover, all of it was directed at the Respondent alone and was used to deny the Response and enable the Complainant to prevail in the proceeding.

The private research undertaken was not justified and its use contaminated the entire Final Version. The UDRP makes it plain in paragraph 4 that a complaint must be “proved”, which means proved by “evidence.” It should not be necessary to spell out to anyone, particularly lawyers, that “evidence” means evidence adduced according to generally accepted principles and in particular so that it can be tested and rebutted. The so-called evidence used against the Respondent in this case was summoned up in private, without any notice and proposed to be used without either party having the opportunity to rebut it.

In particular, the private research undertaken under Rights and Legitimate Interests in the Final Version consisted of:

- (a) information said to have been revealed by the Wayback Machine at www.archive.org and relating to “stored captures”;
- (b) other stored captures and other “captures” not specified, from the period beginning in 1998 and thus many years before the Respondent acquired the domain name, but then used against him;
- (c) various links to unnamed 3rd party sites; and
- (d) reliance on “10 prior UDRP decisions”, all of them unnamed and unnumbered, but then used against the Respondent.

The private research allegedly undertaken under Bad Faith was similar and included numerous uses of the Wayback Machine and references to internet links, including links originating in the years 2001 to 2011, before the Respondent acquired the domain name.

None of this secret process was brought to the notice of the Respondent or, for that matter, the Complainant.

Accordingly, the Final Version is so contaminated by private research and improperly obtained evidence that it should not be accepted by the Panel, being based as it is on a substantial failure of due process.

The subsequent Final Draft now presented to the Panel by the Presiding Panelist is the Final Version with, apparently, the only amendments made being deletions of the private research or some of it. However, the thrust of the Final Draft remains the same, is based on its originator, the Final Version and with full knowledge that the private research had been undertaken and that it had heavily influenced the proposed decision to find against the Respondent.

As the Final Version cannot remain because of the defective process that led to it and the influence of it that remains in the Final Draft, so in turn it would be unfair to allow the sanitised Final Draft to remain; that proposal should therefore also be rejected to do justice to the parties and maintain the integrity of the UDRP process which must remain free from any taint of improper procedure or failure of due process.

This document will now deal in more detail with the contentions that have been summarised above

Part A- The proposed decision of 6 June 2022 (the “Final Version”).

On 6 June 2022, the Presiding Panelist in this proceeding sent an email to members of the Panel which presented to the panel what was described as the “Final Version” of the Panel’s decision.

The Final Version should be rejected, with the result that the Complaint should be dismissed and the disputed domain name should remain with the Respondent. This recommendation is made because:

- (a) the “final version” is based on findings that were not raised by the parties, not addressed by them, not put to them so that they could address those matters, and not established by evidence, but which arise from extensive private research done by the Presiding Panelist, the alleged results of which were not brought to the notice of either party and, in particular were not brought to the notice of the Respondent against whom they were used as a principal reason for finding against him and ordering transfer of the domain name;
- (b) the result is that the Respondent has not been accorded due process, natural justice or a fair hearing, not merely in a minor respect, but to the extent that has permeated the whole proceeding and which casts doubt on the veracity of the proposed decision; and
- (c) the private research and its use are so integral to the proposed decision in the Final Version that it cannot simply be ignored or excised from the decision, as is apparently sought to be done in the later Final Draft; the only way of rectifying the situation just outlined and maintaining the integrity of the UDRP process is to dismiss the Complaint and to give the Complainant leave to bring such other proceedings as it may be advised on a without prejudice basis.

PRIVATE RESEARCH

As the right of a panelist to conduct private research and the extent of that right is at the essence of this opinion, it should be said immediately that there is no opposition in principle to the notion of conducting private research. In so far as there is a general view on whether it should or may be performed as part of the UDRP process, it is probably along the lines that it is permitted as a matter of principle, its use is always subject to the Policy and the Rules, it should be constrained in quantity, should not take the form of making submissions that it is the responsibility of the parties to prepare and it must at least have regard to the question of whether the parties should be given notice of its results so that they may reply to them.

The Final Version of the Panel decision expresses its understanding of the issue by stating:

“The Presiding Panelist notes the authority to perform some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules. Panelists Sandra J. Franklin and The Hon Neil Anthony Brown QC rely solely on the record as presented by the parties.”

Rule 10 gives power to the panel to conduct the proceeding in such manner as it considers “appropriate”. But the power is not unlimited and it has to be exercised, as Rule 10 itself provides, “in accordance with the Policy and these Rules.” Rule 10 then goes on immediately to say that the parties are to be “treated with equality and that each Party is given a fair opportunity to present its case.” The power under Rule 10 therefore gives the right to conduct private research, but if it is undertaken at all, it clearly must be undertaken so that the parties are treated with equality and so that each party is given an equal opportunity to present its case. Even if Rule 10 were not constrained in this way, general principles of due process and procedural fairness would require it to be so constrained and a court would ensure that it was exercised in that manner.

It should therefore not be surprising that commentary on the issue tends to suggest that private research may be done, but that if it is done it must be done with great care. Thus, the prestigious textbook on the subject, Levine, *Domain Name Arbitration*², notes the principle, but goes on to add that it “could conceivably strain the Panel’s neutrality if the party prejudiced by it is not given an opportunity to respond to the research.” Another commentator³ raised the same question in an article in *Domain Times*⁴. Moreover, although prior UDRP decisions are not precedents, it is notable that at least one panelist has expressed caution about the use of private research and the use of material that goes beyond the record in the proceeding of what each party has put before the panel as its case.⁵ Thus, the panelist concerned noted:

“However, there is a more fundamental objection here. The Complainant must prove her case. It is not for the Panel to make the Complainant’s case for her. It is one thing for a panelist to view a web site to verify a parties’ assertions **and quite another to embark upon an independent investigation as to what a complainant’s case may be.**” (Emphasis added).

The Presiding Panelist in the present case has done exactly that and has “embark(ed) upon an independent investigation as to what a complainant’s case may be.” Indeed, the Final Version seems to have gone even further than that and “embark(ed) upon an independent investigation” as to what the complainant’s case should have been and why the Respondent therefore has no defence.

Thus, the generally accepted approach to private research by a panel is not the way in which the power has been exercised in the present case. First, the private research that has apparently been undertaken is not “limited” at all but is very extensive. It is so extensive in quantity and significance that it goes to the root of the case against the Respondent and his defence and is used in the Final Version as a series of reasons for finding against the Respondent, although the Respondent has never been given an opportunity to reply to any of them.

Secondly, it is patently wrong to say that the panel’s “general powers” under Rule 10 justify obtaining evidence from private research and using it in the way it has been used in this case, with no notice to either party. Such evidence may only be used if obtained properly and so that Rule 10(b) is complied with, i.e., so that the parties are treated with equality and are each given a fair opportunity to present their case.

Private research on Rights and Legitimate Interests

In particular, the Presiding Panelist’s private research has been used to show, so it is asserted, that

“...contrary to the Respondent’s allegations, some stored captures related to the disputed domain name show a redirection to additional dealers in the automobile industry,...”.

In other words, it is said that the private research rebutted the Respondent’s case and shows that the domain name was redirected not to the single case of redirection to Nissan that the Complainant relied on, but to “additional dealers in the automobile industry”, using the plural of dealer.

This is a significant addition to the Complainant’s case. Accordingly, the research used against the Respondent was not “limited” but extensive and was not brought to the Respondent’s notice so that he could rebut it or explain it. Thus, he was not given a fair opportunity to present his case, as he was prevented from knowing the full extent of the case against him that had been discovered and accepted by the Presiding Panelist without telling either of the parties. It also follows that the parties were not treated with equality, as the Complainant was given a clear advantage.

² Legal Corner Press, New York, Second Edition, pages 579-581.

³ Panelist Brown who is a member of the Panel in this proceeding.

⁴ See <https://www.domaintimes.info/post/evidence-the-curious-panel-can-it-use-private-research>.

⁵ Mr. Mathew Harris in *Silvie Tomcalova a.k.a.Sylvia Saint v. Juan Campas* [D2006-0379](#) (WIPO May 5, 2006).

Indeed, the Final Version makes it clear that one of the pivotal reasons for the finding that the Respondent had engaged in targeting of the Complainant was that the private research showed “the Respondent’s use of the disputed domain name to redirect to competitors (plural) in the automotive industry”, not simply Nissan. This may have been true, for all that the Panel knows, but the Respondent should have been told that private research was about to be used against him in this way, and what it was, so that he could explain it and/or rebut it. He was not given that opportunity and thus was denied “a fair opportunity to present its case”, in breach of Rule 10 (b).

The private research also shows, allegedly, that the domain name currently resolves to sites including “Roadside Response Assistance” and that assertion is then relied on in the Final Version to make the finding that the Respondent has no right or legitimate interest in the domain name. But the disputed domain name does not currently resolve in the way the private research claims, which shows the danger of looking for evidence that is not on the record or presented in a proper way. It seems to show sites relating to auto insurance, but also to general insurance. In any event, the Respondent was not told of this private research or its alleged result so that he could reply to it and yet it was used to formulate the adverse finding made against him. This shows the importance of using only evidence that is on the record unless it is shown to the party concerned in advance of the decision so that it can be rebutted or explained. As Panelist Harris noted in *Silvie Tomcalova a.k.a. Sylvia Saint v. Juan Campas (supra)*, in an observation equally applicable to the present proceeding:

“... the Panel does not think it appropriate to proceed in this fashion in this case. There is the practical issue that websites change over time. The parties can not be certain what the panelist sees and what the panelist sees may not represent the true position at the relevant time.”

Indeed, the present case shows exactly why Panelist Harris was correct in expressing his concern. The Final Version allegedly shows that the Respondent was using the domain name to re-direct to “Roadside Response Assistance” (although that result is somewhat dubious as has just been shown) which is clearly an assertion that he was trading on Ford’s name and getting a free ride on its fame by promoting automotive links. But the sites to which his domain name resolves, are also for life insurance, fire, theft and earthquake and small business insurance for painters, hairdressers and pastry cooks, none of which have any connection with Ford or the automotive industry at all. Thus, had the Respondent been given notice of this alleged “evidence” against him, he would have been able to show that he was not using the domain name to trade on Ford’s name but for general inquiries “for direct” access to a long list of non-automotive goods and services, for which he was perfectly entitled to use his domain name. So, when the evidence is examined closely, it seems that the Respondent may have been using his generic “for direct” domain name to solicit “for direct” sales of goods and services that have nothing to do with Ford or the automotive industry.

The private research also shows, so it is said, that:

“Additionally, the Presiding Panelist, under its general powers, has corroborated through the WIPO’s Decisions Database that the Respondent has been involved (as respondent) in 10 prior UDRP cases, and six of them have been decided in favour of the respective complainants.”

But as with websites that “change over time”, these bare records are open to interpretation and the Respondent should have been given an opportunity to explain the decisions referred to. But he was not given that opportunity, which is a clear denial of due process.

Thus, evidence of that sort which casts the Respondent in a dubious light and which is such disparaging evidence, should be brought to the notice of the party adversely effected by it so that it is given an opportunity to reply. But that did not happen in this case.

Private research on alleged Bad Faith

Private research undertaken by the Presiding Panelist was also relied on to claim that the Respondent registered and used the disputed domain name in bad faith. This research was again by means of the Wayback Machine, and allegedly showed that:

- (a) the Respondent re-directed the domain name to “other dealers” in the automotive industry;
- (b) at the date of drafting the decision, the disputed domain name resolves to a parked page displaying PPC links, some of them related to services in the automotive field (roadside assistance services);
- (c) the active presence of the Complainant’s website (“www.forddirect.com”) since 1998 showed that the Respondent has used the domain name in bad faith (*sic*);
- (d) the disputed domain name had been used for a number of years, during the period 2001-2011, by a Complainant’s dealership (Burd Ford). This is said despite the fact that the Respondent did not acquire the domain name until 2013.

Conclusion on Part A- The proposed decision of 6 June 2022 (the “Final Version”).

It should be emphasised that the factual matters alleged by the Presiding Panelist may be true. That is not the issue. It may also be true, when all of the facts are known, that the Respondent registered and used the domain name contrary to the Policy. But nor is that the issue. The point is that the “evidence” against the Respondent should have been brought to his notice, so that he could rebut or qualify it and by that means have a fair opportunity to present his case. That he was not given that opportunity undermines the proposed decision to transfer the domain name. The reasons why that is so are such a major part of the proposed decision that it is unsafe to order transfer of the domain name.

The Complaint should therefore be dismissed. But the Complainant is not to blame for this imbroglia and should have the right to file and serve a further Complaint without prejudice.

Part B- The proposed decision of 9 June 2022 (the “Final Draft”).

As has already been explained, the sequence of events shows that the Final Draft is in substance only a variation of the Final Version and was influenced by it. Accordingly, it remains unsafe to order the transfer of the domain name, influenced and informed as it is by wrongly admitted evidence from the extensive private research outlined above. Thus, it cannot be the case, as paragraph 4 of the Policy requires, that the three elements that must be proved before transfer have in fact been proved by properly obtained and admitted evidence.

The decision in the Final Draft could not have been made without, and is pivotal to, the decision that had already been reached in the Final Version, based as it was on such defective evidence.

It is therefore unsafe to order the transfer of the domain name, as to do so would be contrary to Rule 10 (b) that requires the parties to be treated with equality and that they are given a fair opportunity to present their case.

The Complaint should be dismissed and the disputed domain name should remain with the Respondent. The Complainant should have liberty to file and serve a fresh complaint without prejudice if it wishes, so that a new panel can be formed that does not include any panelist involved in the present proceeding. The Panel should so order.

/The Hon Neil Anthony Brown KC/

The Hon Neil Anthony Brown KC

Panelist

13 June, 2022

CONCURRING OPINION

Upon initial review of this case, the undersigned found that it was possible to decide this case without going outside the record. After the Presiding Panelist presented the Panel with several draft decisions containing her extensive research, the undersigned stated more than once the firm opinion that it was unnecessary and incorrect to conduct that level of private research, effectively adding to one party's case for them. The Presiding Panelist expressed that her research was necessary to her findings in the case. Due to all of these circumstances, I concur with the Honourable Neil Brown's opinion above and agree that this case must be dismissed without prejudice to the Complainant.

/Sandra J. Franklin/

Sandra J. Franklin

Panelist

June 12, 2022

7. Decision

For the foregoing reasons, the Complaint is dismissed without prejudice to the Complainant.

/Sandra J. Franklin/

Sandra J. Franklin

Panelist

Date: June 12, 2022

/The Hon Neil Anthony Brown KC/

The Hon Neil Anthony Brown KC

Panelist

Date: 13 June, 2022

DISSENTING OPINION

(Reyes Campello Estebarez, Presiding Panelist)

The Presiding Panelist Reyes Campello Estebarez respectfully disagrees with the decision of the Panel and submits the following Dissenting Opinion under paragraph 15 of the Rules.

On a number of levels, the Presiding Panelist deplores the direction which the majority members of this Panel have deemed fit to give to this case. This dissent from their decision is founded on the following observations.

It is uncontroversial that panels may confirm the allegations, facts, and evidence submitted by the Parties, as may be useful to assessing the case merits and reaching a decision. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8, summarizes this long-settled precedent as follows: "it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision". The rationale for such discretion is to serve "the interest of fairness and of deciding the case on the basis of the most complete available record", see *Arla Foods amba v. Moniker Privacy Services / Janice Liburd*, WIPO Case No. [D2011-0492](#), or "to confirm some of the assertions in the Complaint" or in the Response, see *WorldVentures Ltd. v. EWORLDVENTURES.COM*, WIPO Case No. [D2010-1797](#).

Specifically, it is common practice for panels to refer to the Wayback Machine in order to ascertain archived uses of a disputed domain name, see *The Franchise Group v. Jay Bean*, WIPO Case No. [D2007-1438](#).

Panels often also consider it prudent to visit the disputed domain name, particularly to assess disputed claims about its use, see *Humble Bundle, Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2016-0914](#). Similarly, panels may assess previous UDRP proceedings in which a party has been involved, notably if there are contradictory claims between the parties or the parties rely on related patterns to support their case, see *Philip Morris USA Inc. v. Farris Nawas*, WIPO Case No. [D2014-2282](#).

Falling into these three practical categories, the performed searches pursued the mentioned purpose of ascertaining, as reasonably possible, the fairness and accuracy of the Panel decision. They concerned matters of public record invoked by the respective parties and their results were shared with the Panel for consideration and potential inclusion in the decision; these results were further included in some of the various drafts on the table of the deliberations of the Panel (none of them final). In this process, the Presiding Panelist furthermore remained open (and offered) to the Panel granting the parties an opportunity to comment on the results, if it considered that appropriate, although the rest of the Panel declined such option.

Before describing the more specific background to the searches, the Presiding Panelist notes that it is important not to lose the forest for the trees here. The search results confirmed the Presiding Panelist's assessment of the Respondent's intent and conduct as cybersquatting – a determination with which the majority does not appear to disagree – on account of a number of core factors:

- (i) the FORD mark is well-known and used worldwide;
- (ii) the disputed domain name incorporates the FORD mark in its entirety, as well as the FORDDIRECT and FORDDIRECT.COM marks almost in their entirety, with an obvious and common misspelling of these marks that moreover carries no alternative genuine meaning;
- (iii) the disputed domain name used this misspelling for the Respondent's commercial gain, making for a classic case of typosquatting; and
- (iv) the disputed domain name has been linked to third-party web presence in the automotive industry, as well as to parked pages displaying pay-per-click links.

Additional consideration factors include the disputed domain name's use from 2001-2012 by a Complainant-network dealership before the Respondent's acquisition of the disputed domain name in 2013, and the disputed domain name having been offered for sale at a price exceeding reasonable out of pocket costs.

In the interest of transparency and further to the particulars of the majority decision, set out below is a more specific background description of the respective searches.

(a) The historical use of the disputed domain name was alleged in the Complaint (paragraphs 19, 58, 61 of the Complaint),⁶ providing in Annex A a report from Domain Tools on the historical use of the disputed domain name since its creation in 2001. The report included various captures of websites linked to the disputed domain name in a small size and a quality that do not permit full appreciation of their complete content, with some blurry text and small images. Some of these captures included images of vehicles and trademarks for vehicles, such as VOLVO or HYUNDAI,⁷ and some historical captures related to a FORD

⁶ The Complainant alleged that the disputed domain name was originally registered and used by one of its dealers, and, since its acquisition by the Respondent, it has been redirected to competing websites in the automotive industry.

⁷ In connection with the trademark VOLVO, see, e.g., capture dated July 8, 2020, in pages 24, 26, 27, 28, 30, and 32 of the report; or capture dated February 20, 2020, in pages 34, and 36, of the report (Annex A to the Complaint). In connection with the trademark HYUNDAI, see, e.g., capture dated March 20, 2016, in pages 57, 59, 61, 63, 65, 67, 69, 71, and 73, of the report (Annex A to the Complaint).

dealer, Burd Ford.⁸

The Respondent had received the above-mentioned report as part of the evidence and allegations of the Complainant, and provided its response, asserting that this content was only caused by prior searches, IP address locations, and other factors beyond its control. The Respondent however did not submit evidence in support.

(b) The use of the FORDDIRECT mark was ascertained following the invitation and the link provided by the Respondent in the Response, with page 5 offering a link to the public Internet Web Archive WayBackMachine related to the Complainant's website "www.forddirect.com".⁹

Contrary to the Respondent's allegations, this link revealed many captures of the Complainant's website stored over the years since 1998. The evidence provided by the Respondent suggests that the Complainant's website "www.forddirect.com" has been continuously used since 1998.

(c) The involvement of the Respondent in prior cases under the Policy likewise was invoked by the Respondent, on page 6 of the Response.¹⁰ While not determinative by itself and not a core factor for the decision in this case, it can be helpful to pursue such provided leads.

(d) The use of the disputed domain in connection with PPC links was included in the mentioned report on the historical use of the disputed domain name. This report showed various parked pages displaying PPC links, but the small size and blurry quality of captures made it difficult to review its content.¹¹ ¹²

For the foregoing reasons, the Presiding Panelist, under paragraph 15 of the Rules, respectfully dissents from the decision of the Panel, and considers that this case should have been decided in favor of the Complainant ordering the transfer of the disputed domain name instead of unfairly burden the Parties with the need of refiling.

/Reyes Campello Estebaranz/
Reyes Campello Estebaranz
Presiding Panelist
Date: June 24, 2022

⁸ See, e.g., capture dated May 23, 2012, in pages 111, and 112 of the report; capture dated January 2, 2012, in pages 113, and 114 of the report; capture dated February 14, 2011, in pages 115-120 of the report; or capture dated November 8, 2010, in pages 121-122, of the report (Annex A to the Complaint).

⁹ The Respondent indicated in page 5 of the Response: "*Complainant claims, that we acquired ForDirect.com in 2014, but we actually acquired it already in 2013 (see "Fordirect-Namejet.pdf"), and there was no webpage on their domain "ForDDirect.com" till Mar 2014; see: http://web.archive.org/web/20140901000000*/forddirect.com So we could not have been even targeting non-existent webpage when acquiring this domain name as complainant claims. Not that this is much important anyway.*"

¹⁰ The Respondent indicated in page 6 of the Response: "*You will not find any "Cybersquatting" domains in our portfolio, we won FOUR UDRPs, one with RDNH (agcs.com). Only once we lost, unfairly imho. See attached "UDRP-radioplus.pdf".*"

¹¹ See, for example, capture dated October 9, 2014, in pages 79, 81, 83, 85, 87, 98 of the report; capture dated August 4, 2017 included in pages 53, and 55 of the same report; or capture dated July 15, 2021, included in pages 7, 9, 11, 13, 15, 17, 19 and 21, of this report (Annex A of the Complaint).

¹² At the time of drafting the various drafts for the decision of this case, the Presiding Panel ascertained that the disputed domain name resolved to a parked page comprising PPC links, under various sections, including a section entitled "Roadside Response Assistance." Other sections of this page were "Easy Dropshipping", and "Industrial Shopping Online."