

## **DISPUTE RESOLUTION SERVICE**

**D00020016**

### **Decision of Independent Expert**

Taylor Wimpey PLC

and

Whois Foundation

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

Lead Complainant: Taylor Wimpey PLC  
Gate House  
Turnpike Road  
High Wycombe  
HP12 3NR  
United Kingdom

Second Complainant: Taylor Wimpey Holdings Limited  
Gate House  
Turnpike Road  
High Wycombe  
HP12 3NR  
United Kingdom

Respondent: Whois Foundation  
Ramon Arias Avenue, Ropardi Building, Office 3-C, PO Box 0823-03015  
Panama  
0823  
Panama

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

talorwimpeypensions.co.uk  
taylorwimpeypension.co.uk  
tayorwimpeypensions.co.uk  
wwwtaylorwimpeypensions.co.uk

## **3. Procedural History:**

3.1 I, the undersigned, Ravi Mohindra, can confirm that I am independent of each of the Parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the Parties.

### **3.2 Timeline**

The Complaint was filed with Nominet on 26 March 2018. Nominet validated the Complaint on 27 March 2018 and notified the Respondent by post and by email, stating that the Response had to be received on or before 19 April 2018. The Response was filed on 19 April 2018 and Nominet notified the Response to the Parties on 20 April 2018. Nominet notified the Complainants that a Reply had to be received on or before 27 April 2018. The Complainants' Reply was received on 24 April 2018 and the mediator was appointed on the same day.

The Informal Mediation procedure started on 24 April 2018 and failed to produce an acceptable solution for the Parties and so on the same day Nominet informed the Complainants that they had until 9 May 2018 to pay the fee for the decision of an Expert pursuant to section 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 24 April 2018 the Complainants paid Nominet the required fee.

3.3 For the purposes of this Decision, references to the "Complainant" shall be to the Lead Complainant, and "Complainants" shall mean, together, the Lead Complainant and the Second Complainant.

## **4. Factual Background**

4.1 The Complainants are two entities within a group of related companies. The Lead Complainant – Taylor Wimpey PLC - is the group's main trading entity.

4.2 The Lead Complainant is one of the largest British based housebuilding companies. It is listed on the London Stock Exchange and is a constituent of

the FTSE 100 Index. It was formed in 2007 as a result of the merger of the housebuilders George Wimpey and Taylor Woodrow. During the 2017 financial year the First Complainant built 14,688 new homes in the United Kingdom and Spain and enjoyed revenues of £3,965.2m and profit before tax of £682.0m.

- 4.3 The Second Complainant – Taylor Wimpey Holdings Limited - holds assets, such as intellectual property-related registrations, on behalf of the group companies.
- 4.4 The Complainants’ group operates a website from the URL <https://www.taylorwimpey.co.uk>, the home page of which clearly displays the “Taylor Wimpey” brand name. In terms of social media presence, the Complainants have over 100,300 “followers” on Facebook and over 31,100 “followers” on twitter.
- 4.5 The Complainants also operate a website from the URL <http://taylorwimpeypensions.co.uk>. This site publishes information, updates and news about the Complainants’ group pension scheme and from which employees can log in and administer their pensions.
- 4.6 The Complainants have supplied evidence of the trade mark rights in the word mark TAYLOR WIMPEY, which was registered as a European Trade Mark (number 005787271) with effect from its filing date of 26 March 2007, covering classes 19, 36, 37, 42 and 44, in the name of the Second Respondent.
- 4.7 The Respondent holds a large portfolio of domain names. It registered the Domain Names on the following dates:
  - <taylorwimpeypension.co.uk> - 05-May-2017
  - <taylorwimpeypensions.co.uk> - 11-May-2017
  - <taylorwimpeypensions.co.uk> - 16-May-2017
  - <wwwtaylorwimpeypensions.co.uk> - 31-May-2017
- 4.8 As at the date of the Complaint, each of the Domain Names was associated with a website displaying pay-per-click advertisements. All of these advertising links displayed on each of the websites forward users to third-party websites unrelated to the Complainants.

## **5. Parties’ Contentions**

### The Complainant

### Complainants’ Rights

- 5.1 As noted above, the Second Complainant is the proprietor of a European Trade Mark registration for the word mark TAYLOR WIMPEY.
- 5.2 In addition, the Complainants note that they have successfully enforced their Rights under the DRS before with a summary decision in Taylor Wimpey PLC & Taylor Wimpey Holdings Limited v. Ronny Schmidt (DRS 13032, taylorwimpey.co.uk, taylowimpey.co.uk & taylorwhimpy.co.uk).

### Abusive Registration

- 5.3 The Complainants submit that the Domain Names are Abusive Registrations for the following reasons:
- the Domain Names confuse people or businesses per Paragraph 5.1.1.2 of the Policy, and specifically, in relation to initial interest confusion;
  - the Domain Names unfairly disrupt the business of the Complainants' group per Paragraph 5.1.1.3 of the Policy, in relation to the display of third-party advertising;
  - a pattern of registrations exists per Paragraph 5.1.3 of the Policy; and
  - there are no factors showing the Domain Names are not Abusive Registrations.
- 5.4 In relation to confusion, the Complainants contend that the Domain Names are highly likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainants' group in terms of Policy paragraph 5.1.1.2.
- 5.5 The Complainants say that the Domain Names differ from the Complainants' TAYLOR WIMPEY mark only by the addition of the word 'pension(s)' and various typographical variants of this mark. Equally, the Complainants assert that the Domain Names are similar to the URL from which the Complainants operate their own pension scheme website, namely <taylorwimpeypensions.co.uk>. The Complainants submit that the Domain Names are therefore all inherently confusing, in and of themselves, in the manner suggested in of Paragraph 3.3 of the Expert's Overview.
- 5.6 The Complainants' contend that the Domain Names are unfairly disrupting the business of the Complainants' group in terms of Paragraph 5.1.1.3 of the Policy as they divert web users expecting to find content relating to the Complainants' group and its pension scheme (by virtue of the inclusion of the Complainants' group's mark as the dominant element of each of the Domain Names alongside the word 'pension(s)') to a variety of third-party advertisers.

- 5.7 The Complainants observe that while Paragraph 8.5 of the Policy notes that the sale of traffic is not of itself objectionable the Expert will take into account:
- i. the nature of the Domain Name;
  - ii. the nature of the advertising links on any parking page associated with the Domain Name; and
  - iii. that the use of the Domain Name is ultimately the Respondent's responsibility.
- 5.8 The Complainants aver that (a) the diversion of web users to monetised content they were not expecting to see is inherently disruptive to the Complainants' group, especially where any traffic to the related websites must have necessarily resulted from the confusion caused by the fact that the Domain Names are similar to the Complainants' group's TAYLOR WIMPEY marks, and (b) the sale of traffic in these circumstances is objectionable and that it takes unfair advantage of and is unfairly detrimental to the Complainants' group's Rights.
- 5.9 The Complainants submit that Respondent is engaged in a pattern of registrations which correspond to well-known names or trademarks in which the Respondent has no apparent rights and the Domain Names are part of that pattern.
- 5.10 The Complainants contend that the Respondent is the registrant of some 46,923 domain names in the .uk space, a significant number of which appear to incorporate third-party rights which are not associated with the Respondent. Ten example domain names are listed below:

Domain Name	Relates to Registered Trade Mark	Trade Mark Owner
bankofscotland.co.uk	BANK OF SCOTLAND EUTM 4622	Bank of Scotland PLC
cathkindston.co.uk	CATH KIDSTON EUTM 2670412	Cath Kidston Limited
debehnhams.co.uk	DEBENHAMS EUTM 66720	Debenhams Retail PLC
frestylelibre.co.uk	FREESTYLE LIBRE EUTM 12071833	Abbott Diabetes Care Inc.
gatwuckairport.co.uk	GATWICK AIRPORT UK 2375633	Gatwick Airport Limited
jet2holdiays.co.uk	JET2 HOLIDAYS EUTM 4551875	Jet2.com Limited
karenmilleen.co.uk	KAREN MILLEN EUTM 814038	Karen Millen Fashions Limited
laredooute.co.uk	LA REDOUTE EUTM 659151	La Redoute

majesticwine.co.uk	MAJESTIC WINE EUTM 14921373	Majestic Wine Warehouses Limited
nationalexoress.co.uk	NATIONAL EXPRESS EUTM 841023	National Express Limited

5.11 The Complainants note that these 10 domain names listed above resolve to pay-per-click advertising like that associated with each of the Domain Names. The Complainants contend that these further registrations demonstrate the Respondent engages in registering domain names closely related to third-party marks and monetises the associated websites. The Complainants contend that the Domain Names are being used in the same manner and therefore are part of that pattern. Such a pattern is, in the Complainants' view, highly indicative that the Domain Names are, in the hands of the Respondent, Abusive Registrations.

5.12 The Complainants note that the Respondent was held to have registered domain names Abusively in very similar circumstances in DRS 19551. In that case, the expert noted:

*“Trading in Domain Names for profit and/or holding a large portfolio of domain names, is not, of itself, objectionable under the DRS or at law (Policy, paragraph 8.4).*

*However, in this case, it is plain from the evidence provided by the Complainant that the Respondent is engaged in large scale registration of domain names which appear to infringe the rights of third parties, because they are identical to the names or marks of those third parties, because they are deliberate mis-spellings of the third-party name or mark, or because they include a third-party name or mark and an appendage (often mis-spelled).”*

5.13 Finally, the Complainants contend that the Respondent cannot rely on any of the factors set out in section 8 of the Policy to show that the Domain Names are not Abusive Registrations as (i) the Domain Names are not being used in association with a genuine offering of goods or services, (ii) to the knowledge of the Complainants, the Respondent has never been known by or legitimately connected with the term TAYLOR WIMPEY or TAYLOR WIMPEY PENSION(S) or any of the typographical variants featured in the Domain Names, (iii) there is no evidence that the Domain Names were registered for legitimate, non-commercial or any 'fair use' purposes, and (iv) the Domain Names are not generic or descriptive; rather, they relate entirely to the Complainants' and their group companies.

#### The Respondent

5.14 In summary, the Respondent contends as follows:

- it owns a portfolio of generic and descriptive domain names which it acquired through lawful and fair methods;
- as part of its business practice, it has a well-known dispute resolution policy whereby it invites putative complainants to contact it regarding domain names that complainants believe violate a trademark. It also has a liberal transfer policy whereby it typically agrees to voluntarily transfer domain names, irrespective of the legitimacy of the complainant's arguments, in an effort to avoid the needless time and expense associated with litigation and administrative hearings. Transfers are typically done within one (1) business day;
- upon learning of this matter and, pursuant to its business practices, in an effort to resolve this matter expeditiously and without a substantial investment of time and expense by either party or the Expert, the Respondent contacted the Complainant to offer a voluntary transfer of the domain names at issue. No agreement was reached prior to the date of the Response;
- without admitting fault or liability and without responding substantively to the allegations raised by the Complainants, to expedite this matter so that time and resources are not otherwise wasted on an undisputed case, the Respondent is willing to voluntarily transfer the Domain Name to the Complainant, but with a request that the transfer be ordered without findings of fact or conclusions as to Policy 4(a) other than the Domain Names be transferred; and
- numerous Uniform Domain Name Dispute Resolution Policy (UDRP) decisions have been issued in which Panels have consistently ruled that when a complaint has been filed and the respondent consents to the transfer of the domain name, it is inappropriate to issue any decision other than simply ordering the transfer of the domain name and that it would be improper or unwise to issue any findings of fact in such cases.

### The Reply

- 5.15 The Complainants oppose the Respondent's request for the Expert to order the transfer of the Domain Names without finding of fact or conclusions other than that the Domain Names be transferred, on the grounds that the request is misconceived and appears to be based upon certain authorities under the UDRP. They cite the Expert's Overview which states that UDRP decisions are "*rarely likely to be helpful*" in a DRS proceeding.
- 5.16 The Complainants also refer to paragraph 5.14 of the Expert's Overview which provides that "*if, however, the Complainant insists on a decision and pays the prescribed fee, the papers will be sent to an Expert for a decision*".

The Complainants contend that they are therefore entitled to a full reasoned decision under the DRS.

- 5.17 The Complainants state that the Respondent has not advanced any counter or explanation in relation to any of the Complainants' arguments on Abusive Registration, nor does it seek to rely on any of the potentially exculpatory factors set out in section 8 of the Policy.
- 5.17 Finally, the Complainants note that since they brought the Complaint, the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the last two years (namely DRS 19893, DRS 19869, DRS 19925 and DRS 19551), per paragraph 5.3 of the Policy. Whilst the Complainants note that this paragraph stipulates that these Abusive Registrations must have occurred "*before the complaint was filed*" for the presumption of Abusive Registration to apply, the findings in these recent cases demonstrate that it is highly indicative that the Domain Names in the present dispute are also Abusive Registrations in terms of the Policy.

## **6. Discussions and Findings**

### Should there be a reasoned decision in this DRS proceeding?

- 6.1 As the Complainant notes, the Respondent in this case has been a Respondent in four cases under the DRS. In three of these cases (DRS 19893, DRS 19869 and DRS 19925), the Respondent appears to have made the same request that it has made in this case, namely that the respective domain names be transferred to the relevant complainant without further findings of fact or liability. With regard to this request of the Respondent, I come to the same conclusion as each of the Experts did in each of those three cases.
- 6.2 Where either party to a DRS proceeding has applied for a full decision (as the Complainants have in this case), then paragraph 18.4 makes it clear that the decision shall be in writing and provide the reasons on which it is based (emphasis added).
- 6.3 Those reasons will, by virtue of the fact that the proceeding has been brought under the DRS Policy (to which a respondent must submit if a complainant makes the relevant assertions (in summary, rights and abusive registration) per section 2 of the Policy), be based on the parties' submissions and the DRS Policy (per paragraph 18.1 of the Policy).
- 6.4 Further, I also accept the Complainants' argument that, were a bare transfer order made in these circumstances, respondents could potentially avoid the consequences of the rule reversing the burden of proof where they are found to have made an abusive registration in three or more DRS cases in the two years before a complaint is filed.

- 6.5 Finally, for the avoidance of doubt, whilst my decision in this case comes after the Respondent has been found to have made three or more Abusive Registrations in the last 2 years, as the Complainants themselves note, the Complaint was filed on 26 March 2018 – prior to the rule under paragraph 5.3 of the Policy taking effect against this Respondent. Accordingly, the Complainants cannot rely on this rule in this DRS proceeding.
- 6.6 I will therefore proceed to issue a full decision on the character of the Domain Names based on the Parties' submissions and the DRS Policy, notwithstanding the Respondent's voluntary offer to transfer the Domain Names to the Complainant.

### General

- 6.7 For the Complainant to succeed with its Complaint it is required under paragraph 2.2 of the Policy to prove to the Expert, on the balance of probabilities, that:
- I. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - II. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### Complainants' Rights

- 6.8 Section 1 of the Policy provides that Rights means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.9 Further, it is well accepted that the question of whether the Complainant has Rights falls to be considered at the time that the Complainant makes its Complaint and is a test with a low threshold to overcome.
- 6.10 The Second Complainant is the owner of a European Union trade mark registration for the word mark TAYLOR WIMPEY, registered in 2007.
- 6.11 Further, the Complainants have provided evidence demonstrating trading activity under the TAYLOR WIMPEY brand name.
- 6.12 The Domain Names incorporate either (i) the TAYLOR WIMPEY mark in its entirety – and in one case coupled with a www prefix or (ii) very slight misspellings of the TAYLOR WIMPEY mark. They are all suffixed with the

singular or plural version of the word “pension”. The misspellings are so slight that they do not detract from the Complainants’ TAYLOR WIMPEY mark and all are classic cases of typo-squatting, and the additions are of a generic and descriptive word which does not render the Domain Names sufficiently different to the mark in which the Complainants have Rights.

- 6.13 I therefore find that the Complainants have Rights in respect of the mark TAYLOR WIMPEY and that this mark is similar to each of the Domain Names.

#### Abusive Registration

- 6.14 Section 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 has been unfairly detrimental to the Complainant’s Rights.*

- 6.15 Section 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The factors under Section 5 on which the Complainants rely are as follows:

*“5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;*

*5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant; and*

*5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern”.*

- 6.16 The Complainants have submitted evidence showing use of the mark in which they hold Rights, namely TAYLOR WIMPEY, across digital channels including websites and social media. The mark is not generic and is a brand name referring to the Complainants and their businesses.

- 6.17 In light of (a) the evidence provided by the Complainants in relation to (i) the Complainant's trading history, (ii) its business operated under the TAYLOR WIMPEY brand and (iii) the Second Complainant's long standing trade mark registration in the mark TAYLOR WIMPEY, and (b) the absence of any explanation from the Respondent as to why it chose to register the Domain Names (all of which incorporate various slight misspellings of the TAYLOR WIMPEY mark), I am prepared to accept that the Respondent would have been aware of the Complainants and the TAYLOR WIMPEY brand when it registered the Domain Names, and the Respondent had the Complainants' Rights in the TAYLOR WIMPEY mark in mind at that time.
- 6.18 Further, given the high degree of similarity between each of the Domain Names and the strength of the Complainants' well-established Rights at the date of registration of each of the Domain Names (together with the fact that the Complainants operate their own pension scheme and use the domain name <taylorwimpeypensions.co.uk>), I find it improbable that the Domain Names were chosen and registered by the Respondent for any reason other than to create a false association with the Complainants' TAYLOR WIMPEY mark and to take some kind of advantage of the goodwill attached thereto. I also accept that some confusion is likely between the Domain Names and the Complainants. That can only be disruptive of the Complainants' business and such disruption can only be unfair.
- 6.19 Finally, section 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is not an Abusive Registration. The Respondent does not specifically address any of these factors in its Response but makes an assertion that it owns a portfolio of generic and descriptive domain names which it acquired through lawful and fair methods. With this in mind, I note that paragraph 8.4 of the Policy states:
- “trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.”*
- 6.20 The Complainants have submitted uncontested evidence to show that the Respondent is the owner of a number of domain names which, but for inconsequential mistyping, correspond to well-known names or trademarks in which the Respondent has no apparent rights. The Domain Names at issue in this case have the same character.
- 6.21 I am therefore also prepared to find that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which and the Domain Names are part of that pattern, and so the Respondent falls foul of paragraph 5.1.3 of the Policy.

- 6.22 Whilst the rule regarding a presumption of Abusive Registration under paragraph 5.3 of the Policy does not apply to this case (given the date on which the Complaint was filed and the number of adverse decisions issued against the Respondent in the two years prior to that date), the Domain Names in this case correspond to a mark in which the Complainants have Rights and the Respondent has no connection with either of the Complainants.
- 6.23 No credible counter or explanation is advanced by the Respondent in relation to any of the Complainants' arguments on Abusive Registration. In particular, there is nothing before me which explains how this is anything other than a classic case of typo-squatting, despite the Respondent's bare assertion that it owns a portfolio of generic and descriptive domain names.
- 6.24 In these circumstances I find that each of the Domain Names was registered in a manner which, at the time when the relevant registration took place, took unfair advantage of or was unfairly detrimental to the Complainants' Rights and therefore that each of the Domain Names, in the hands of the Respondent, is an Abusive Registration.

## **7. Decision**

- 7.1 The Complainants have established that they have Rights in respect of a mark which is similar to each of the Domain Names and that each of the Domain Names, in the hands of the Respondent, is an Abusive Registration.
- 7.2 Accordingly, the Complaint succeeds and I direct that the Domain Names <talorwimpeypensions.co.uk>, <taylorwimpeypension.co.uk>, <tayorwimpeypensions.co.uk> and <wwwtaylorwimpeypensions.co.uk> be transferred to the Complainant.

**Signed**      **Ravi Mohindra**                      **Dated**              **21 May 2018**