

DISPUTE RESOLUTION SERVICE

D00020834

Decision of Independent Expert

The Pension House Company Limited

and

Jimmy Bennett

1. The Parties:

Complainant: The Pension House Company Limited
Unit 4 Green Lodge Barn
Nobottle
Northampton
Northants
NN7 4HD
United Kingdom

Respondent: Jimmy Bennett
21 Canal Place
Chichester
West Sussex
PO19 8DR
United Kingdom

2. The Domain Name:

pensionhouse.co.uk

3. Procedural History:

I 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 being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

16 November 2018 Dispute received
16 November 2018 Complaint validated

16 November 2018 Notification of Complaint sent to parties
05 December 2018 Response reminder sent
10 December 2018 No Response Received
10 December 2018 Notification of no Response sent to parties
11 December 2018 Expert decision payment received

After considering a brief explanation submitted on behalf of the Respondent as to why there was an exceptional need for a non-standard submission in accordance with Paragraph 17.3 of the DRS Policy, the non-standard submission was accepted on 18 December 2018. Given that such non-standard submission was the only response received on behalf of the Respondent and that it was substantive in nature, the Expert also accepted the Complainant's non-standard submission in reply, which was received by Nominet on 21 December 2018

4. Factual Background

The Complainant is a firm of Independent Financial Advisers that specialises in pensions advice. It was incorporated in 2012. It has a Financial Conduct Authority (FCA) licence (number 595635) and is an appointed representative of The Tavistock Partnership Ltd, which is authorised and regulated by the FCA.

It has three United Kingdom registered trade marks: PENSION HOUSE and THE PENSION HOUSE (a series of two word marks registered under number 3269421 on 23 March 2018 (effective as of 9 November 2017) and "The Pension House" with a roof top design logo, registered under number 3281676 on 15 June 2018 (effective as of 10 January 2018).

The Respondent also operates in the pensions field through Pension House Exchange Ltd.

The domain name in dispute <pensionhouse.co.uk>, (the Domain Name) was registered on 4 October 2016. It resolves to the website of Pension House Exchange Ltd.

A solicitors' letter was sent on behalf of the Complainant to Pension House Exchange Ltd, alleging passing off, on 9 November 2017.

5. Parties' Contentions

The following is a brief summary of the more relevant contentions of the parties, including those contained in their respective non-standard submissions.

The Complaint

The Complainant has rights in the Domain Name because it has used the name "The Pension House" since its incorporation. "The Pension House" is a brand known in financial services and is recognised by pension providers and the public as a business offering regulated

services, specifically pensions advice. The Complainant's business was trading for some four years prior to incorporation of Pension House Exchange Ltd.

Financial advice is a highly regulated activity and only firms with an FCA registration should provide advice to the public in the UK.

The Complainant was unable to secure registration of the Domain Name when it tried on incorporation, taking instead the only suitable domain name left (<pensionhouse.org.uk>). The website at www.pensionhouse.org.uk is the 'official' site for the genuine "Pension House".

Google searches of "the Pension House" will return results for both the Complainant and the Respondent's firm, on the same page and offering similar services. The reputation and goodwill of the Complainant is at risk if another company with a similar name, that is not qualified or authorised, gives advice without the necessary permissions. The public are often confused and mistake the regulated firm with the non-regulated firm. The public worry about having released sensitive data to an unauthorised firm when the Complainant tells them that they are not associated with Pension House Exchange Ltd.

No other firm with the name, Pension House is authorised in the UK or has a right to discuss pension matters with the public.

Ownership of the trade marks should mean that the Complainant is free to trade without hindrance. As a result of the 'cloning' of its firm, the Complainant displays a warning on its web page (a requirement of the FCA). This is a 'negative' however, as it is the first thing a potential customer sees.

If the Respondent had the Domain Name removed, it would make it difficult for Pension House Exchange Ltd. to mirror the Complainant's image so successfully.

The Domain Name in the hands of the Respondent is abusive because it is being used to confuse the public and pension providers into thinking they are dealing with an approved FCA registered firm. The public and pension providers more freely release information if they believe they are working with an accredited firm.

The Domain Name is sufficiently similar to that used by the Complainant to cause confusion.

The primary reason for registration of the Domain Name is for the Respondent to pass his business off as financial advisers. There is evidence that the Respondent has promoted his business as The Pension House and has used the Complainant's registration in correspondence with the public to give the impression they are dealing with the Complainant.

The Complainant makes many other assertions about the Respondent's business, its practices and investor protection and states that the Domain Name is being used to unfairly disrupt its business.

The Complainant's desire is to stop or hinder the Respondent's attempt to pass off his business as that of the Complainant, and as authorised to provide pension advice to the UK public.

The Respondent's non-standard submission

The non-standard submission on behalf of the Respondent is in the form of a letter from a Mr. Ayrton James Mellers, a director of Pension House Exchange Ltd., a business in which the Respondent is also interested. Mr Mellers explains that the original Complaint was not received and that his business partner, the Respondent, is currently off work due to illness.

The letter notes that the Complainant has gone to great lengths to discredit the business of Pension House Exchange Ltd, but that as much of the content of the Complaint is not relevant, the letter is not in the form of a point by point response.

The first issue the letter deals with is the Complainant's trade mark. It is noted that it was not owned when the Domain Name was registered, and that there was no awareness of the Complainant's existence at the time of registration, or until at least six months into trading. Mr Mellers also notes that he first applied to register the 'trade mark' but decided not to pursue the application because of the Complainant's passing off allegation.

The Domain Name was available and it was registered before incorporating Pension House Exchange Ltd.

The second issue the letter deals with is whether or not the Domain Name was registered with intent to cause harm or disruption to the Complainant. It is said that if it was intended to pass off Pension House Exchange Ltd as the Complainant, or disrupt the Complainant's business in any way, there would not be a notice upon immediate arrival on the website of Pension House Exchange Ltd stating that there is no affiliation between the two companies. It is also said that Pension House Exchange Ltd would not have changed its branding, trading name, logo and documentation (suggesting that it did) in order to avoid confusion.

After two years of trading, the Domain Name has been heavily integrated into the operation of Pension House Exchange Ltd.

The letter also mentions that the domain name <pensionhouseexchange.co.uk> has been anonymously registered and that it is suspected that the Complainant is the true registrant.

The letter concludes by wishing the Complainant well and assuring it that there is no intention to cause any harm and that it is hoped that the businesses can co-exist.

The Complainant's non-standard submission

The Complainant's non-standard submission is in response to that of the Respondent.

The Respondent claims that they could not respond in a timely fashion due to the Respondent being off sick. The Complainant however refers to evidence (which has been supplied), suggesting that the Respondent was active and looking well during the period for submission of a (standard) Response to the Complaint.

As to trade mark issues, the Complainant asserts that the Respondent did not apply for the trade mark before the Complainant and that the application numbers bear this out. Pension House Exchange Ltd. abandoned its trade mark application.

It is also said that the Complainant has evidence of communications between Mr Mellers and a client of Pension House Exchange Ltd in which it is said that he is authorised by a Financial Services network, 'Tavistock', which is a direct quote from the Complainant's FCA disclosure statement.

As to what is said on behalf of the Respondent about intent to cause harm, the Complainant makes the point that the notice on the Respondent's website disclaiming any affiliation with the Complainant, was only added in or around December 2017, in an attempt to counter the similar notice on the Complainant's website. It is also said that the Respondent's notice is used only intermittently '*when they know authorities are watching*'. A number of other points are made about the website of the Respondent.

As to the assertion on behalf of the Respondent that they have changed their branding and trading, it is said that whilst it has indeed been changed, the effect of the changes has been to align the Respondent's business even more closely with that of the Complainant, even using the roof top design in its logo.

Moreover, it is said to be untrue that the Respondent was not aware of the Complainant's existence '*when they registered the firm with Companies House*', noting that Companies House made the Complainant aware that a firm with a similar name had been registered and it is assumed that the Respondent would have similarly been notified.

The Complainant refers to a footnote (at the end of the non-standard submission on behalf of the Respondent) stating that 'Pension House' is a trading name of Pension House Exchange Ltd (whereas Pension House is a trade mark belonging to the Complainant).

The Domain Name lends credibility to the Respondent's business, risks bringing the Complainant's business into disrepute and allows the Respondent to successfully convince the public that they are dealing with an authorised firm.

6. Discussions and Findings

Under the provisions of the DRS Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's Rights

The meaning of 'rights' is defined in the DRS Policy as follows: *'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'*.

By virtue of the Complainant's registered trade marks, it clearly has rights in the mark PENSION HOUSE. Moreover, by virtue of its use of the Pension House name in the course of its business since incorporation in 2012, as alleged in its solicitor's letter of 9 November 2017, it no doubt enjoys unregistered rights in the name too, and is likely to have done so for some considerable time prior to registration of the Domain Name in 2016.

Similarity

The Domain Name encapsulates the Complainant's PENSION HOUSE trade mark in its entirety. Apart from the suffix '.co.uk', which may be disregarded for comparison purposes, it is its only element. Accordingly, the Expert is satisfied that the Complainant has Rights in a mark which is identical to the Domain Name for the purposes of the DRS Policy.

The Expert must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'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 which *'is being or has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights'*.

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 5 of the DRS Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name *primarily* as a blocking registration against a name or mark in which the Complainant has rights (para 5.1.1.2), or for the purpose of unfairly disrupting the business of the Complainant (para 5.1.1.3).

Other such factors suggesting an Abusive Registration include the Respondent 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 (para 5.1.2).

If the domain name is an exact match for the name or mark in which the complainant has rights, the complainant's mark has a reputation and the respondent has no reasonable justification for the registration, that too may evidence an Abusive Registration (para 5.1.6).

A non-exhaustive list of countervailing factors is set out in paragraph 8 of the DRS Policy i.e. factors which may indicate that the Domain Name is not an Abusive Registration. Included are circumstances suggesting that before being aware of the complainant's cause for complaint, the respondent has used or made demonstrable preparations to use the domain name in connection with a genuine offering of goods or services (para 8.1.1.1). A respondent being commonly known by a name or legitimately connected with a mark which is identical or similar to the domain name (para 8.1.1.2), or having made legitimate non-commercial or fair use of the domain name (para 8.1.1.3), will also be indicative of a registration that is not abusive. If the domain name is generic or descriptive and the respondent is making fair use of it, that too may indicate that it is not an Abusive Registration (para 8.1.2).

Discussion on Abusive Registration

It can be seen that, at the heart of the DRS Policy, is the requirement to prove unfairness: for a registration to be considered 'abusive' there should be something unfair in the object or effect of the respondent's behaviour.

There can be little doubt that a domain name which incorporates a trade mark in its entirety, even if combined with generic or descriptive terms, may cause confusion as to the identity of the entity behind the Domain Name. However, it does not follow, whatever analysis might be propounded in terms of intellectual property law (or for that matter the regulatory framework for investor protection), that in these circumstances a finding of Abusive Registration must always be made. There are several examples of trade mark owners failing to secure transfers of domain names incorporating their marks. The Complainant must satisfy the requirements of the Policy and it is the Complainant that bears the burden of proof on the balance of probabilities standard in this regard.

The Complainant was incorporated in December 2012. The Respondent's business was incorporated in September 2016.

The Complainant missed out on the Domain Name which the Respondent registered in October 2016 (registering <pensionhouse.org.uk> in December 2012 instead, which it now uses for its website).

It is said on the Respondent's behalf that he did not know of the Complainant's existence when the Domain Name was registered. Given that the phrase "Pension House" is distinctive and non-obvious, that the parties operate in similar fields and the Complainant has an obvious online presence, that assertion seems unlikely. In any event however, it is perfectly possible for a registration of a domain name to become an Abusive Registration by virtue of its use, subsequent to registration. The solicitors' letter written on behalf of the Complainant to Pension House Exchange Ltd on 9 November 2017, refers to the confusion that has arisen in the market. From that date at the least, the Respondent would have known of the Complainant, its pre-existing rights and causes of complaint.

It is also said on the Respondent's behalf that:

'If we truly were trying to pass off as the complainant or disrupt the business in any way then we wouldn't have volunteered to have a notice upon immediate arrival to our website stating that there is no affiliation between the two companies. We also wouldn't have changed our branding, trading name, logo and documentation in order to avoid confusion.'

As to the first point, even if an Internet user ending up at the Respondent's site immediately realises (because of the warning notice) that it is not the website of the Complainant (having thought it would be), it will be a nuisance for the Internet user, who will likely be a customer or potential customer of the Complainant looking to buy, or receive information about pension products and most probably from a regulated entity. Regardless of any issue of investor protection (which is primarily a matter for others), this may well be disruptive to the Complainant's business and, ultimately, detrimental to it.

As to the second point, the Respondent presently uses a roof top design logo similar to that of the Complainant. In these circumstances, it seems an odd suggestion that the Respondent has actually changed its branding to *avoid* confusion, begging the question as to just how similar the sites were before the Respondent made the changes it did.

It appears to the Expert that the Respondent has been using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant.

Accordingly, the Expert is satisfied that the Complainant has made out a case of Abusive Registration in that it has demonstrated that there are circumstances suggesting that the Respondent has acted in a manner which has taken unfair advantage of, or which has been unfairly detrimental to the Complainant's Rights.

It now therefore falls to be decided if the Respondent has an answer to the case. The Respondent's case essentially comes down to three points – the Complainant did not own its registered trade marks at the time the Domain Name was registered, there was no knowledge of the Complainant prior to registration of the Domain Name, and there has been no intent to harm or disrupt the Complainant.

The fact that the Complainant's trade mark registrations post-date registration of the Domain Name does not preclude a finding of Abusive Registration. Unregistered rights have been alleged on behalf of the Complainant (by its solicitor's letter of 9 November 2017) and, as earlier indicated, the Expert has no difficulty in finding that the Complainant enjoyed unregistered rights (and therefore Rights for the purposes of the DRS Policy) in the Pension House mark prior to registration of the Domain Name in 2016. In any event, the requirement of the DRS Policy is that Rights exist at the time of the Complaint.

As to knowledge of the Complainant, the Expert is sceptical about the assertions made on behalf of the Respondent. Any suggestion that the Respondent used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services *before* being aware Complainant's cause for complaint (para 8.1.1.1), cannot be accepted. In any event, even if the Respondent was unaware of the Complainant prior to registration of the Domain Name, its continued use on becoming aware of the Complainant (at the latest in November 2017 when passing off was alleged), could not be considered *fair use* for the purposes of paragraph 8 of the DRS Policy (or, for that matter, *legitimate non-commercial use*).

Finally, intent to cause harm or disruption is not always a requirement of Abusive Registration. What must be demonstrated is that the Domain Name was registered in a manner which, either at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights or that it is now being or has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights. Proof of intent is not required where, as here, the Respondent, without lawful excuse, is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant. It is the effect of the use that is all important.

In all the circumstances, the Expert concludes that the Domain Name was and is an Abusive Registration.

7. Decision

The Expert finds that the Complainant has Rights in a name or mark that is identical to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name, <pensionhouse.co.uk> be transferred to the Complainant.

Signed:
Jon Lang

Dated: 10 January 2019