

**DISPUTE RESOLUTION SERVICE**

**D00011001**

**Decision of Independent Expert**

Which? Limited

and

Lead Technologies (Europe) Ltd

**1. The Parties**

Complainant: Which? Limited  
2 Marylebone Road  
London  
NW1 4DF  
United Kingdom

Respondent: Lead Technologies (Europe) Ltd  
Wharfebank House  
Wharfebank Business Centre  
Ilkley Road, Otley  
West Yorkshire  
LS21 3JP  
United Kingdom

**2. The Domain Name**

which-advisor.co.uk ("the Disputed Domain Name")

**3. Procedural History**

The Complaint was filed with Nominet on 7 March 2012. Nominet validated the Complaint on 8 March 2012 and notified the Respondent by post and by email, stating that the Response had to be received on or before 29 March 2012. The Respondent filed a Response on 28 March 2012 and Nominet notified the Complainant that a Reply had to be received on or before 5 April 2012. The Complainant filed a Reply on 5 April 2012.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 26 April 2012 Nominet informed the Complainant that it had until 11 May 2012 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet

Dispute Resolution Service Policy ("the Policy"). On 1 May 2012 the Complainant paid Nominet the required fee.

On 3 May 2012 the undersigned, Jane Seager ("the Expert"), confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as an Expert in this case and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question her independence and/or impartiality.

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

##### **The Complainant**

The Complainant is a UK limited company incorporated on 13 December 1960. Its registered office and principal place of business is at 2 Marylebone Road, London, UK. It is the trading arm of the Consumers' Association, a registered charity that exists to promote and protect the interests of consumers. The Complainant's trading profits are thus used for charitable purposes.

In 1957 the Complainant's predecessor body launched the magazine known as WHICH? This promotes the interests of consumers and aims to provide impartial information and advice about a range of products and services. It currently has a total subscription of almost 600,000. The Complainant has a knowledge sharing relationship with all consumer groups worldwide, including the US-based Consumers Union.

The Complainant has continued to add other subscription only titles to its publications including Which? Car, Which? Travel, Which? Gardening, Which? Health and Which? Computing. WHICH? Money is a monthly subscription magazine published by the Complainant with a circulation of nearly 60,000. It deals with all aspects of personal finance in relation to topics of interest to consumers.

The Complainant has also been involved in many high-profile lobbying activities which have for example led to the adoption of new pieces of consumer friendly legislation concerning toy safety and seatbelt use. The Complainant is involved in various campaigns for the protection of consumer rights, for example in relation to unfair charges levied by banks.

In 1996 the Complainant launched a website at [www.which.co.uk](http://www.which.co.uk) / [www.which.com](http://www.which.com). There are now almost 300,000 subscribers to the Complainant's online services and many more visitors who are not subscribers (the website allows access to a certain amount of non-subscriber content).

The Complainant is particularly well known for providing consumers with advice in relation to financial products and services. At [www.which.co.uk/money](http://www.which.co.uk/money) the Complainant publishes information for consumers such as how to calculate monthly payments and find the best interest rates and advice about topics such as payment protection insurance. The Complainant also provides mortgage advice to members via [www.whichmortgageadvisers.co.uk](http://www.whichmortgageadvisers.co.uk) and offers a service to its members called the "Which? Money Help Line".

The Complainant reviews the services offered by banks and other financial institutions and operates a "Recommended Provider" licensing scheme whereby certain financial

services providers are allowed to display the "Which? Recommended Provider" logo to help advertise their services. This is very similar to the "Which? Best Buy" scheme in relation to consumer goods.

The Complainant publishes books under the WHICH marks including a number of well known publications relating to personal finance. These include the Which? Money Saving Handbook, Which? Save and Invest, Which? Managing your Debt, Which? Finance your Retirement, Which? Make the Most of Your Money, Which? Tax Handbook 2011/2012 and Which? Pensions Explained.

The Complainant has obtained registrations for a number of trade marks in both the United Kingdom and the European Community for goods and services in various different classes. In total the Complainant has more than 50 trade mark registrations, and at least 35 incorporate the word "WHICH", sometimes stylised, sometimes not, sometimes with a question mark, sometimes without. The earliest of these trade mark registrations dates back to April 1971.

### **The Respondent and the Disputed Domain Name**

The Respondent is a UK limited company incorporated on 23 April 2008. Its registered office is at Wharfebank Business Centre in Otley, West Yorkshire, UK. Under its business name Oportura, the Respondent is in the business of providing details of potential customers to financial services providers for a fee (a service known as "lead generation").

The Disputed Domain Name was registered by the Respondent on 21 February 2011. The website at [www.which-advisor.co.uk](http://www.which-advisor.co.uk) was launched in March 2011 and offers internet users a free telephone consultation from an independent firm of financial advisers if they supply their details by completing an online form.

In complement to this the Respondent also operates the website [www.oportura.co.uk](http://www.oportura.co.uk) which targets the financial services industry. This website explains how the Respondent can introduce new business leads to various different types of financial services providers. Providers who decide to contract with the Respondent are then sent appropriate leads that are obtained by the Respondent from various sources. Independent financial advisors are supplied with leads obtained by the Respondent via the [www.which-advisor.co.uk](http://www.which-advisor.co.uk) website.

### **The Dispute**

At some point in June 2011 the Complainant received an email (sent from a Hotmail address) from someone claiming to be a member of the public who had mistakenly thought that the website to which the Disputed Domain Name was pointing was owned and operated by the Complainant, and complained of the treatment he received from the Respondent. However, it subsequently transpired that this email was most probably sent by a disgruntled employee of the Respondent who left the Respondent's employment around June 2011.

In any event, a member of the Complainant's in-house legal department wrote a letter to the Respondent on 10 June 2011 complaining about the similarity of the Respondent's branding and asking for it to be changed. He stated that a member of the Complainant's press department had been contacted by another media outlet which had inquired as to

whether there was a connection between the Complainant and the Respondent. The Respondent's response was to offer to make changes and indeed the Respondent sent a redesigned logo to the Complainant's in-house lawyer by email on 17 June 2011. When there was no response the Respondent called the Complainant approximately two weeks later, left a message explaining what the call was about, and was informed that the in-house lawyer had left the Complainant's employment but that someone else from the Complainant would return the call.

The Complainant's solicitors then wrote to the Respondent on 11 August 2011 asking for the signature of various undertakings and the transfer of the Disputed Domain Name to the Complainant. At the time neither the Complainant's solicitors, nor those giving instructions at the Complainant were aware of the earlier correspondence between the Complainant's in-house lawyer and the Respondent.

This correspondence was brought to their attention by the Respondent in emails sent on 16 and 17 August 2011 in response to the letter from the Complainant's solicitors. On 23 August 2011, the Complainant's solicitors wrote to the Respondent stating that the matter could no longer be resolved by making the proposed amendments to the logo and asking again for signature of the undertakings and transfer of the Disputed Domain Name.

The Respondent did not wish to comply and so subsequently instructed solicitors who entered into correspondence with the Complainant's solicitors. The parties were unable to resolve their differences and this resulted in the filing of a complaint under the Policy.

## **5. Parties' Contentions**

### **Complaint**

#### **Complainant's Background and Rights**

The Complainant asserts that its reputation for championing consumer rights and the fact that it is independent of third party commercial interests has made it an extremely valued and authoritative source of guidance for consumers. An example of this is the "Which? Best Buy" scheme.

The Complainant argues that as a result of its long history of high profile activities in the UK over the past 50 plus years and the substantial exposure to the public of the WHICH? mark, the use of the word "which" (whether or not accompanied by a question mark) in conjunction with generic product descriptions such as money, car, gardening, computing, mobile phones, etc and as a keyword in internet domain names, has become synonymous with the Complainant. According to the Complainant, consumers will invariably associate such use of the mark WHICH or WHICH? as indicating the involvement of the Complainant in the publication or website concerned. This is so in relation to magazines, books and other forms of media, especially the internet where the presence of the word "which" in a domain name next to a generic or descriptive term will indicate to consumers a commercial link with the Complainant.

The Complainant asserts that the substantial goodwill and reputation that it has built up by reference to the WHICH brand are extremely valuable assets and essential to the furtherance of its commercial activities and charitable purposes. According to the Complainant the WHICH brand is a guarantee to consumers that advice and information emanating from publications under those marks will come from the Complainant, will be

impartial and will not be influenced by sponsorship or promotion on behalf of any third party commercial interests.

According to the Complainant, the WHICH trade marks have a particularly strong goodwill and reputation in the world of personal finance and advice in relation to such activities. The Complainant notes that among these registrations are the marks WHICH? MONEY (no. 2445087) and WHICH? MORTGAGE ADVISERS (no. 2556368) both in, inter alia, class 35 for provision of advice and information relating to financial services and the marks WHICH (no. 2432015) and WHICH? (no. 2356518) both in, inter alia, class 35 for advice about the characteristics of goods and in the case of the latter mark, for services as well.

The Complainant asserts that in order to exploit the trade marks on the internet and protect the Complainant's intellectual property, it is important that the primary domain names incorporating the Complainant's trade marks are brought under its control. In connection with this, the Complainant, through its solicitors and trade mark attorneys, points out that it has secured a number of important domain names that contain the WHICH trade marks from parties who appear to have no legitimate rights in the names.

For example, the Complainant underlines that it has reached agreement with the registrants of a number of domain names including <whichfinancial.com>, <whichpension.com>, <whichpowersupply.com>, <whichbestbuy.com>, <whichbestbuys.com>, <whichawards.co.uk>, <whichifa.co.uk>, <whichtravel.com>, <whichtravel.co.uk>, <whichholiday.co.uk>, <whichsafe.co.uk>, <switchwithwhich.co.uk>, <whichbroadband.org.uk>, <which-local.com>, <which-prepaid-card.com>, <whichprepaid.co.uk>, <whichprepaidcard.co.uk>, <which-prepaid-card.co.uk>, <whichcar.com>, <whichmanuals.com> and <whichstuff.com> for their transfer to the Complainant.

The Complainant has also obtained a number of transfers of domain names by taking appropriate action when the registrants in question have refused to cooperate with the Complainant. For example, in August 2008 the domain name <whichshop.net> was surrendered voluntarily to the Complainant after it submitted a Complaint to the World Intellectual Property Organisation in accordance with the Uniform Domain Name Dispute Resolution Policy (UDRP). Furthermore, on 27 January 2009, the Complainant successfully obtained a decision under the UDRP for the transfer of the domain name <whichcar.com> to the Complainant and, on 9 June 2010, the Complainant successfully obtained a decision under the UDRP for the transfer of the domain name <whichmanuals.com> to the Complainant. These domain name transfers are in addition to numerous country specific domains that have also been transferred to the Complainant.

The Complainant uses a number of domain names incorporating the word "which" in them for its day to day business. Accordingly, it is submitted that the Complainant clearly has a legitimate right and interest in the marks "WHICH" and "WHICH?" which extends to the use of such marks in the context of internet websites.

The Complainant asserts that the Disputed Domain Name is very obviously confusingly similar to the Complainant's registered trade marks. Members of the public who see the Disputed Domain Name on the internet or enter the Complainant's trading name into an internet search engine and whose search brings back the Disputed Domain Name are bound to believe that the Disputed Domain Name is an official domain name of the

Complainant, attached to the Complainant's official website or used under licence from the Complainant or with its authorisation or approval, but this is not the case. In the Complainant's opinion the risk of confusion or association with the Complainant is heightened by the apparently deliberate use of a similar trading name to the Complainant. The email from a member of the public is a real example of the actual confusion caused by the use of the Disputed Domain Name.

The Respondent has no legitimate interest in respect of the Disputed Domain Name. The Complainant's trade marks were registered long before (in some cases, decades before) the Respondent registered the Disputed Domain Name. The Respondent cannot have acquired any rights in the marks "WHICH ADVISOR" or "which-advisor.co.uk" in priority to those of the Complainant. The Respondent has never had any connection with the Complainant or any company licensed by the Complainant and, furthermore, the Respondent is not commonly known by the Disputed Domain Name. The Respondent neither has, nor has it ever had, any rights of any kind to use the Complainant's trade or service marks (whether registered or otherwise) in any capacity or for any purpose anywhere in the world. The Respondent was not and is not authorised by the Complainant to register, hold or use the Disputed Domain Name.

### **Abusive Registration**

The Complainant submits that the Disputed Domain Name has been both registered and used in a manner which takes unfair advantage of and is detrimental to the Complainant's rights.

The Complainant's trade marks have been registered and in continuous use by the Complainant since 1971. The Complainant's business was well known to the Respondent at the date that the Disputed Domain Name was registered. In the Complainant's opinion this is demonstrated by the content of the associated website and the extensive use of the word "Which" and a question mark.

In the Complainant's opinion the Respondent's offer of a free telephone consultation with an independent financial adviser would clearly appeal to consumers searching for the Complainant's own website, many of whom are particularly vulnerable to confusion. The Respondent's adoption of the Disputed Domain Name, the appearance of the associated website and its offline advertising is likely to exploit that, as evidenced by the email received by the Complainant.

The Complainant asserts that the content of the website was also created in a manner unfair or detrimental to the Complainant's rights because the use of the trading name "WHICH ADVISOR" in the manner the Respondent is using it infringes the Complainant's registered trade marks. The top of each page of the Respondent's website is headed with the name "WHICH ADVISOR" and this is accompanied directly underneath by "Need Financial Advice. We can help". In the name "WHICH ADVISOR" the word "WHICH" is displayed in black text with the word "ADVISOR" appearing in red text. By distinguishing the colour of these two components of the "WHICH ADVISOR" trading name, the Respondent has made the word "WHICH" stand out. Above "WHICH ADVISOR" the Respondent has displayed a red speech bubble. In the centre of this bubble appears a white question mark. This logo is also present in the Respondent's offline advertising. A core element of the Complainant's logo contains a stylised question mark and the Complainant has a number of trade mark registrations for this as well as trade marks for the word WHICH accompanied by a question mark.

The Complainant asserts that the Respondent's use of a question mark in conjunction with the word WHICH constitutes infringement of the Complainant's registered trade marks as well as passing off. This is because the use of signs by the Respondent in the manner above creates a likelihood of confusion with the Complainant's trade marks and suggests that the Respondent's website is associated with the Complainant when this is not the case. The Respondent is using the Disputed Domain Name to intentionally attract, for commercial gain, internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's marks. According to the Complainant that is plainly unfair or detrimental to the Complainant's rights and is one of the example factors set out at paragraph 3(a)(ii) of the Policy demonstrating abusive registration.

The Complainant asserts that there is no doubt that for the purposes of trade mark law, the Complainant's registered trade marks are marks "with a reputation" and enjoy a higher degree of protection under the Trade Marks Act 1994 ("the Act") and the Community Trade Mark Regulation 207/2009 ("the Regulation"). In the Complainant's opinion the deliberate adoption by the Respondent of a similar sign to the Complainant's trade marks in both the Disputed Domain Name and the associated website are likely to create a link in the minds of consumers between the Complainant and the Respondent. The Complainant argues that it is clear that the Respondent is taking unfair advantage of the Complainant's trade marks contrary to section 10(3) of the Act and Article 9(1)(c) of the Regulation. The Complainant states that this is a classic case of "free-riding". Moreover, if left unchecked, the Respondent's activities are likely to be detrimental to the distinctive character of the Complainant's trade marks. The Complainant further submits that the Respondent's registration and use of the Disputed Domain Name also constitutes passing off.

The Complainant asserts that it has the exclusive right to use its trade marks in a domain name (and otherwise in the course of trade) and has an extensive reputation in relation to them, such that members of the public who see the Complainant's trade marks immediately connect such use to the Complainant to the exclusion of all others. The Complainant wishes to use its trade marks in domain names to point to its websites. However, the Complainant is prevented from using the Disputed Domain Name by its registration by the Respondent. According to the Complainant, the registration of the Disputed Domain Name is therefore a blocking registration preventing the Complainant's legitimate use of its trade marks in a domain name.

In the Complainant's opinion it has done all it reasonably can to resolve this matter without invoking the Policy, but it has now been left with no choice but to do so. It is evident that the Respondent will not give up the Disputed Domain Name unless compelled by Nominet or a court. The Complainant believes that it has demonstrated that the Respondent's registration and use of the Disputed Domain Name are abusive within the terms of the Policy.

The Complainant therefore requests that the Disputed Domain Name be transferred to it in accordance with the Policy.

### **Response**

The Respondent points out that it has been operating the [www.which-advisor.co.uk](http://www.which-advisor.co.uk) website for a year and has so far not received any queries from internet users in relation to whether the website is related to the Complainant.

The Respondent's interpretation of the Complainant's argument is as follows:

- The Complainant has used WHICH? as a trade mark for 50 years. It has many trade mark registrations in many classes in both Britain and the European Union. Furthermore, the Complainant enjoys high public recognition because of its testing of products and services for price and quality in respect of which it provides unbiased advice to the public;
- As a result of these facts the Complainant is now entitled to the exclusive right to the use of WHICH and WHICH? in relation to all goods and services, or at least in relation to all of the goods and services which it has tested;
- Consequently neither the Respondent nor any other trader can use WHICH or WHICH? in relation to any goods and services because the public will automatically assume that any goods or services offered which use WHICH or WHICH? emanate from the Complainant or at least have its approval;
- As a result the Respondent cannot have any rights or legitimate interests in the Disputed Domain Name; and
- Therefore the Disputed Domain Name is an abusive registration.

The Respondent argues that the first thing that the Complainant must do is to establish its own rights. The Complainant does not have a class 35 or class 36 registration for the plain (that is, unstylised) word mark "WHICH?" covering lead generation services or financial services. In the Respondent's opinion it appears likely that the reason for this failure is that the word mark "WHICH?" is not considered by trade mark examiners to be capable of distinguishing the goods or services of one undertaking from the goods and services of another.

The Respondent states that the Complainant's only registrations which cover financial services are stylised versions of "WHICH?". Its class 35 registration for the plain word mark "WHICH?" is restricted to the Complainant's core services of providing information on price and quality of goods. None of its registrations including class 35 appear to cover the service of lead generation. In the Respondent's opinion, the word "WHICH" per se when used as a trade mark is unlikely to qualify for trade mark registration unless it is registered in a stylised form.

The Respondent states that although the Complainant commenced using WHICH? in 1957, its earliest trade mark registration dates from 1971. No explanation is given as to why the Complainant waited 14 years to obtain a trade mark registration. However, the Respondent suggests that the likely reason is that the Complainant was unable to qualify for trade mark registration before that time. That is because the Trade Marks Act 1938 required that, even for a registration in Part B of the Register prior to the enactment of the 1994 Act, a trade mark proprietor had to prove that the trade mark had capacity to distinguish. WHICH? is not a word which would be considered to be a distinctive trade mark. The Respondent asserts that it is a word appropriate for use in the normal way of description by all traders in all goods (and services when service mark registration became available). In the Respondent's view under the policy of the 1938 Act it was the type of word that needed to remain in the public domain for general use by other traders. Thus in the Respondent's opinion only by acquiring and demonstrating extensive evidence of use would it be possible for such a word to be granted trade mark registration.



According to the Respondent the relevance of this in the present case is that, although the Complainant is well-known throughout Britain for its activities in testing and comparing prices and the quality of goods and services offered by various organisations to the consumer, it does not have the exclusive right to the use of "WHICH" or "WHICH?" in relation to lead generation or financial services. It is only likely to be granted a registration of "WHICH?" in plain script after establishing very extensive evidence of acquired distinctiveness in relation to the particular goods or services in respect of which such use could be demonstrated.

Therefore, the Respondent argues that the fact that the Complainant has made a great deal of use of the stylised "WHICH?" trade mark in relation to a wide variety of goods and services of interest to consumers does not give it the right to prevent the use of "WHICH" in relation to all goods and services. The Respondent points out that the Complainant stated in its Complaint that it has used its trade marks in relation to many services within the financial services industry and there is no doubt that its stylised trade marks are recognised when they are used in this way. The Respondent points out that the Complainant states:

*"In order to exploit the trade marks on the internet and protect the Complainant's intellectual property, it is important that the primary domain names incorporating the Complainant's marks are brought under its control. In connection with this, the Complainant, through its solicitors and trade mark attorneys, has secured a number of important domain names that contain the WHICH trade marks from parties who appear to have no legitimate rights in the names. For example, the Complainant has reached agreement with the registrants of a number of domain names".*

In the Respondent's view, the Complainant is claiming that it has the exclusive right to the use of the word "which" as a trade mark or as part of a trade mark in relation to all goods and services and that it is taking steps to bring all domain names incorporating "which" "under its control". The Complainant then lists a number of domain names which it has acquired from other domain name owners after having "reached agreement". The Respondent assumes that such agreements were reached after the domain name registrants received letters similar to that sent to the Respondent of 11 August 2011.

The Respondent states that many small businesses receiving such letters from firms of solicitors are panicked and either do not realise that it would be prudent to obtain independent legal advice or do not have the means to do so. In the Respondent's opinion such behaviour is a campaign of bullying aimed at acquiring rights to which the Complainant is not entitled and according to the Respondent the fact that the bully is the self-appointed consumer watchdog and a registered charity does not justify it.

The Respondent points out that the Complainant also refers to two decisions made by a WIPO panel. In the first case the panel found that the respondent did not have any rights or legitimate interests in the disputed domain name because the respondent had displayed links to the complainant's website, and the panel found that the respondent was not making a bona fide offering of goods or services. For this reason, the panel also found that the respondent had registered the domain name in bad faith and was using it in bad faith. In the second case the respondent failed to lodge a response and the complainant was able to satisfy the panel that the respondent had no legitimate rights or interest in the domain name, had registered it in bad faith and was using it in bad faith. The panel was prepared to make this finding on the basis of the criteria set down as evidence of bad faith registration and use taken in conjunction with the fact that the

respondent had not filed a response. In the Respondent's opinion neither case is comparable with the present case.

The Respondent states that it does not deny the fact that the Complainant used the WHICH? trade mark before the Respondent, nor that the Complainant has not authorised or licensed the Respondent to use the WHICH? trade mark. However what it does assert is that the conclusion that the Complainant attempts to draw from this is based on the false premise that the Complainant has the exclusive right to use WHICH? and thus to license or authorise its use, which is not the case.

The Respondent asserts that it does have a legitimate interest in the Disputed Domain Name. It is running a genuine business and the [www.which-advisor.co.uk](http://www.which-advisor.co.uk) website forms an integral part of this. There is nothing underhand about the way in which the Respondent is running its business on this website. The Respondent's company Oportura and its address, email address and phone number are listed. The Respondent spends a substantial amount of money on promoting its WHICH-ADVISOR services both online and in offline media. It has around 200 clients from the financial services industry and attracts roughly 15,000 unique visitors to its website at [www.which-advisor.co.uk](http://www.which-advisor.co.uk) each month.

The Respondent argues that [www.which-advisor.co.uk](http://www.which-advisor.co.uk) is not a website set up to promote third party services or to click through to other websites. The Respondent does not have any history of registering domain names using well-known trade marks in order to sell them either to the owner of the trade mark or some other third party. In the Respondent's opinion no one who visits its website could possibly think that the website was owned by, or in some way connected to, the Complainant.

Despite the above, the Respondent states that Complainant has argued that the Respondent has taken unfair advantage and has behaved in a way unfairly detrimental to the Complainant, both in registering the Disputed Domain Name and in continuing to use it. The Respondent asserts that it has not engaged in any of the activities set out on the Nominet website as being indicative of an abusive registration. Nevertheless, the Complainant describes the Respondent's actions as being abusive. This is so, according to the Complainant, simply because of the use which the Respondent is making of the Disputed Domain Name.

The Complainant goes on to describe the way in which the Respondent conducts its business on the website. However, in the Respondent's opinion, all of the Complainant's allegations in this regard relate to the running of a legitimate business from a website. The only activity to which the Complainant is objecting is the Respondent's choice of a domain name for its business. The Complainant's reason for this objection is that it claims to be of the view that the Complainant has the right to the exclusive use of the word/trade mark WHICH? According to the Respondent, even if this is true (and the Respondent denies that it is true) it is not sufficient to render the registration and use of the Disputed Domain Name abusive within the meaning of the Policy.

In the Respondent's opinion the Policy has been set up to deal with the registration and use of domain names. Transfer or cancellation of such domain names can be ordered when that registration or use has been shown to be abusive. The Respondent has not acted in bad faith either in obtaining the registration of the Disputed Domain Name or in using it since its registration. In the Respondent's opinion if the Complainant objects to the use of [www.which-advisor.co.uk](http://www.which-advisor.co.uk) in respect of a genuine offering of services on the

internet, the proper way for the Complainant to seek to rectify the situation is by taking action for trade mark infringement.

The Respondent therefore requests that transfer of the Disputed Domain Name be denied.

### **Reply**

The Complainant points out that, given the Respondent's business, it has clearly chosen the Disputed Domain Name with great care so as to draw in the maximum numbers of potential leads. In the Complainant's view it follows that in order to do that, the Respondent has every motivation to choose an address for its website that will attract maximum visibility on the internet and in the minds of consumers. The Complainant notes that, despite the Respondent's assertions that it is conducting a "legitimate" business, the Respondent has not explained in its Response the process by which it chose to adopt the Disputed Domain Name, why that particular name was chosen and why it adopted such a confusingly similar trading style to the Complainant.

The Complainant states that the Respondent addresses the circumstances under which its website first came to the attention of the Complainant. It then makes a number of assertions as to the rights enjoyed by the Complainant and questions the scope of those rights. In particular, the Respondent refers to the history of the Complainant's trade mark registrations, the fact that it has some stylised marks and that it does not have registrations for certain specific matters such as lead generation. However the Complainant submits that none of these points assist the Respondent.

As far as the email that first alerted the Complainant to the Respondent's activities is concerned, the Respondent claims that this was an email sent by a disgruntled former employee. Even if what the Respondent says is true, in the Complainant's opinion this makes no material difference to the merits of the case. It is not a requirement of the law of passing off, trade mark infringement or the Policy that any evidence of "actual confusion" between the Disputed Domain Name and the Complainant's mark be proved. Indeed, in the vast majority of such cases there is no such evidence. For the purposes of passing off or trade mark infringement, the tribunal in question must be satisfied that there is a "likelihood of confusion". Moreover, in a case of "taking unfair advantage" of a well known trade mark such as the Complainant's, the presence of confusion is irrelevant. Thus the Complainant concludes that the fact that the email relied on by the Complainant may not be an instance of actual confusion is not a matter of substance.

The Complainant points out that for the purposes of trade mark law and passing off as was clearly held by the English High Court in *OCH Ziff Management Europe Ltd v Och Capital LLP [2011] F.S.R 2011*, English law recognises the concept of so called "initial interest confusion" whereby it is sufficient for infringement purposes that confusion prior to the point of sale occurs even if, at the time of such sale, the buyer is no longer confused as to the trade origin of the goods or services he is purchasing. In other words, in the Complainant's opinion it is sufficient in this case for consumers to be drawn to the Respondent's website believing that it is in some way connected to the Complainant, even if they soon realise that they are not in fact dealing with the Complainant.

The Respondent suggests that the unstylised mark "Which?" has not been registered for lead generation or financial services because such a word mark "is not considered by trade mark examiners to be capable of distinguishing the goods or services of one

undertaking from the goods and services of another." In the Complainant's view this is pure speculation by the Respondent and is denied. The Complainant points out that both the UK Intellectual Property Office and the Office for the Harmonisation of the Internal Market have granted numerous trade mark registrations to the Complainant, including for the plain word "Which?" - both with and without the accompanying question mark - in relation to a host of other goods and services. The Respondent has produced no evidence of any refusal by the relevant trade mark offices to register any of the Complainant's Which? trade marks for lack of distinctiveness and so the Complainant argues that this is a non-point.

In the Complainant's opinion the very fact that so many trade mark registrations have been accepted only serves to underline how distinctive the Complainant's name "Which?" has become in the mind of the public. For example, when a member of the public hears on the radio or on television that a spokesperson for "Which?" is about to be interviewed or is told orally about something the Complainant has done, neither the fact that there is a question mark attached to the word "Which?" nor any stylised visual use of the mark are relevant. The degree to which the Complainant's brand has been used in conjunction with ordinary words to denote its involvement in activities (e.g. which money etc) is already dealt with in the Complaint.

The Complainant also states that the Respondent also appears to have overlooked the fact that the Policy is concerned with whether the Complainant has rights in a name or mark that is identical or similar to the Disputed Domain Name. In the Complainant's view it cannot seriously be disputed that the mark Which? in stylised or unstylised form is at the very least similar to the principal component of the Respondent's domain name.

The Respondent makes much of the fact that there is no specific registration for a trade mark by the Complainant in relation to "lead generation" and suchlike. However in the Complainant's view this ignores the fact that the Complainant's trade marks have a "reputation" under trade mark law which provides for extra protection in relation to the use of well known trade marks against the use, without due cause, of signs that are identical or similar, even where such signs are used in relation to goods or services that are totally dissimilar to the trade marks in question (see section 10(3) of the Trade Marks Act 1994). The Complainant also argues that the references to class 35 registrations do not help the Respondent either because the Complainant has registrations in class 35 which are - at the very least - for "similar" services to those being provided by the Respondent.

The Respondent states that that the Complainant did not register trade marks between 1957 and 1971. The Complainant argues that this is hardly relevant to the current dispute 40 years later. The Complainant has established distinctiveness for the Which? trade marks - as has been accepted by the relevant trade mark registries. In the Complainant's opinion what matters is not what happened between 1957 and 1971, but the reality of the situation as assessed under the terms of the Policy in 2012.

The Respondent asserts that the steps taken by the Complainant to secure other domain names incorporating the Which? brand amount to "bullying". In the Complainant's view this again is a non-point but also a very unfair criticism of the Complainant. Like any other intellectual property rights owner, the Complainant is entitled to protect and enforce its legitimate rights. This is all that the Complainant has done, both itself and via its external lawyers. Indeed as the Respondent itself has pointed out, the Complainant initially went out of its way to seek an amicable resolution of the matter.

Finally, the Respondent has emphasised that it is running a legitimate business and that it is not, for example, engaging in “cybersquatting” or operating a website to benefit third parties. In the Complainant’s opinion this is beside the point. The Complainant is objecting to the fact that the Respondent is benefitting from its substantial investment over many years in building up the Which? brand. By any standards, the Complainant considers that the Respondent is clearly taking unfair advantage of the Complainant’s well known trade mark. The use of the Disputed Domain Name (for which no explanation has been given by the Respondent) and the very obvious play on the Complainant’s branding that appears on the Respondent’s website are, submits the Complainant, clearly evidence of that, and thus the Respondent’s registration is abusive.

## **6. Discussions and Findings**

### **General**

Under paragraph 2(a) of the Policy, for the Expert to order a transfer of the Disputed Domain Name the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

- "(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."*

### **Complainant's Rights**

The Complainant has provided evidence that it holds numerous registered trade marks. The Expert is therefore satisfied that the Complainant has Rights under the Policy (which defines Rights as including, but not limited to, rights enforceable under English law).

Furthermore, the Policy stipulates that the name or mark in which the Complainant has Rights must be identical or similar to the Disputed Domain Name. Unfortunately neither party considered this issue in any detail. Upon closer examination of the Complainant’s trade mark portfolio, it can be seen that the Complainant owns a plain word mark in the term WHICH and two word marks in the terms WHICH BEST BUY and WHICH MAGAZINE. It also owns a plain word mark in the term WHICH? and various other word marks in this term followed by an ordinary English noun such as CAR, COMPUTING, DIGITALSTORE, GARDENING, HOLIDAY, MOBILE, MONEY and TRAVEL. In the Expert’s view these trade marks are similar to the Disputed Domain Name because they are unstylised and consist of or contain the word WHICH or WHICH? followed by an ordinary English noun, much like the Disputed Domain Name.

In this regard it should be noted that it is accepted practice under the Policy to discount the “.co.uk” suffix, and any spaces, hyphens or other similar characters are generally also ignored for the purposes of any comparison under paragraph 2(a)(i) of the Policy. It is also relevant here to highlight the fact that any comparison usually only involves a straightforward consideration of the trade mark and the domain name at issue, and does not take the content of any associated website into consideration. This is because overcoming the Rights hurdle under the Policy is often said to be a relatively low level test, more a question of establishing whether or not a complainant has the standing to bring a complaint under the Policy, and thus the examination of any associated website

should instead fall to be considered under the more complex question of Abusive Registration (see below).

As a result, the Expert finds that paragraph 2(a)(i) of the Policy is satisfied and the Complainant has Rights in respect of a mark which is identical or similar to the Disputed Domain Name.

### **Abusive Registration**

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean a domain name which:

- "(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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

As may be seen from the detailed summary of the parties' contentions above, both concentrate heavily on the intricacies of trade mark infringement and passing off, and there is scant reference to the provisions of the Policy. Whilst it should be noted that such concepts may be of assistance to the Expert in considering Abusive Registration under the Policy, they are by no means determinative, and in this regard the Expert would highlight the wording of the Appeal Panel in *Seiko UK Limited v Designer Time/Wanderweb*, DRS 00248, which reads as follows:

*"The Panel considers that parties and Experts should not be overly concerned with whether or not an allegedly abusive registration also constitutes an infringement of registered trade mark. The question of trade mark infringement is, as both parties (and the Expert) agree, one for the courts to decide. The question of abusiveness is for the Expert to decide. The two jurisdictions co-exist alongside each other, and no doubt there will be considerable overlap. However there may well be factual scenarios in which an abusive registration under the Policy would not be an infringement of trade mark under the 1994 Act, and where an infringement of trade mark under the 1994 Act would not be an abusive registration under the Policy. The safest course for parties and Experts is simply to address the terms of the Policy."*

The Expert would stress that Nominet UK's Dispute Resolution Service (DRS) is essentially a fast, simple procedure designed predominantly for clear cut cases of Abusive Registration under the Policy (often referred to as "cybersquatting"). It is not intended to deal with complex points of English law in relation to trade mark infringement and passing off, which would be better left to a court of competent jurisdiction. In particular, court proceedings would allow for a more detailed examination of the evidence on issues such as the nature and reputation of the Complainant's trade marks, the scope of the Respondent's activities, the likelihood of confusion (if necessary) and the type of damage suffered by the Complainant (again if necessary).

It is with this in mind that the Expert has chosen to not to make any detailed consideration of the parties' assertions with regard to trade mark infringement and passing off and instead to simply consider whether the Complainant has succeeded in making out its case under the terms of the Policy.

Paragraph 3(a) of the Policy sets out a non-exhaustive list of five factors which may be evidence that the Disputed Domain Name is an Abusive Registration, as follows:

- "(i) *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
  - A. *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*
  - B. *as a blocking registration against a name or mark in which the Complainant has Rights; or*
  - C. *for the purpose of unfairly disrupting the business of the Complainant;*
- (ii) *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;*
- (iii) *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 trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*
- (iv) *It is independently verified that the Respondent has given false contact details to us; or*
- (v) *The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:*
  - A. *has been using the Domain Name registration exclusively; and*
  - B. *paid for the registration and/or renewal of the Domain Name registration."*

The Complainant briefly alleges that the Disputed Domain Name is a "blocking registration" as set out at paragraph 3(a)(i)(B) above, but given that the Complainant does not have a trade mark in the term WHICH ADVISOR, the Expert is unconvinced by this assertion as it would follow that the registration of any domain name beginning with the word "which" followed by a suitable noun may fall into the category of a "blocking registration" for the Complainant, which clearly cannot be the case. The Complainant does have a trade mark in the term WHICH MORTGAGE ADVISERS, but the Expert does not feel that this is sufficiently close to the Disputed Domain Name for it to constitute a blocking registration (for example the trade mark in question is a design mark). In the Expert's opinion paragraph 3(a)(i)(B) is not a general catch-all provision to be asserted in almost every case. Instead it only applies in very specific circumstances (which must include the Respondent's primary intent at the time of registration), none of which are made out in this particular instance.

The Complainant also relies on paragraph 3(a)(ii) which certainly seems more pertinent here. It is clear that evidence of actual confusion is not required, and thus nothing turns on whether the email of complaint received by the Complainant was in fact genuine or not. What is relevant is whether the Respondent is using the Disputed Domain Name in such a way that people are likely to be confused and think that it is connected with the

Complainant. It is generally thought that the test is an objective one and does not specifically require intent on the part of the Respondent.

As explained in detail in the Factual Background section above, the Respondent is using the Disputed Domain Name to point to its website upon which appears the Respondent's "Which Advisor?" logo. Internet users who wish to have a free initial consultation with an appropriate independent financial advisor may fill in the online form with their details and the type of advice they require and then the Respondent will arrange this by matching their details with the details of an independent advisor in its database. Consultations are free for internet users, but the Respondent charges the advisors a fee for each "lead". The website clearly states that the Respondent does not itself provide financial advice and merely acts as an introducer to companies who do.

On its websites the Complainant tends to use a red square containing the word "Which" in white followed by a black question mark. The Respondent's logo consists of the words "Which" in black and "Advisor" in red with a red speech bubble above this containing a white question mark. The Respondent uses a blue background, whereas the Complainant's websites use a white background (and indeed the colour blue does not appear to feature prominently on the Complainant's websites). In the Expert's own personal opinion the content and layout of the two websites would make it clear to most people that the Complainant and the Respondent are not connected.

However, the question of potential "initial interest confusion" also falls to be considered. This arises when people are drawn to a website as a result of confusion concerning the domain name at issue, but it becomes immediately apparent that the website is not operated by the party they had in mind. In this case it is likely that internet users will access the Respondent's website as a result of typing a query into a search engine. If such query was very likely to exactly match one of the Complainant's trade marks then in the Expert's opinion the possibility of "initial interest confusion" would be relatively high. However, having reviewed the Complainant's trade mark portfolio, the Expert does not consider this to be particularly likely. As the *Experts' Overview* on the Nominet website states at question 3.3, findings of "initial interest confusion" are most likely to be made when the domain name at issue is identical to the name or trade mark of the Complainant and without any adornment.

Having said this, it would be wrong to find that there is no possibility of confusion whatsoever, whether "initial interest" or otherwise, which raises the question of how "likely" such confusion must be for a successful finding under paragraph 3(a)(ii). As the *Experts' Overview* underlines, the Expert must be able to conclude on the balance of probabilities that such confusion is "more likely than not" (see question 3.4). In addition a finding of confusion itself is not automatically problematic - it must also be shown that such confusion takes unfair advantage of or is unfairly detrimental to the Complainant's Rights under the terms of the Policy.

Clearly this is a very difficult issue and one which falls to be considered in light of all the surrounding facts and circumstances. Indeed the Expert feels that it is very difficult to make a proper assessment based on the evidence provided (much of which was not relevant to the key issues under the Policy), and is ultimately of the opinion that paragraph 3(a)(ii) has not been made out. This is not to suggest that more evidence on the likelihood of confusion should have been provided (far from it, given the volume of the Complainant's submissions), but that the DRS procedure is not the correct forum for the



detailed consideration of cases such as this where the likelihood of confusion is not clear cut and may legitimately be the subject of differing views.

None of the other factors at paragraph 3(a) of the Policy would appear to be relevant in this instance, although as such factors are non-exhaustive the Expert has considered whether anything else in the Complainant's submission would indicate "Abusive Registration" in accordance with the spirit of the Policy. However this would not appear to be the case.

As explained above, neither party's submissions were particularly helpful to the Expert when considering the question of Abusive Registration under the Policy. For the sake of completeness, the Expert would point out that paragraph 4(a) of the Policy contains a non-exhaustive list of factors which may be evidence that the Disputed Domain Name is not an Abusive Registration as follows:

- "(i) *Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:*
  - A. *used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;*
  - B. *been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
  - C. *made legitimate non-commercial or fair use of the Domain Name;*or
- (ii) *The Domain Name is generic or descriptive and the Respondent is making fair use of it;*
- (iii) *In relation to paragraph 3(a)(v); that the Respondent's holding of the Domain Name is consistent with an express term of a written agreement entered into by the Parties; or*
- (iv) *In relation to paragraphs 3(a)(iii) and/or 3(c); that the Domain Name is not part of a wider pattern or series of registrations because the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent."*

In its defence it seems that the Respondent could have attempted to rely on paragraphs 4(a)(i)(A) and 4(a)(ii) but did not specifically refer to them. In the Expert's opinion it is clear that the Respondent is operating a genuine business based on the provision of an actual service to internet users in return for payment from financial advisors, and the Respondent was doing this before it became aware of the Complainant's cause for complaint. Furthermore, the words "Which Advisor?" are both common English dictionary words which could be said to relate to the genuine service on offer, namely the location of a suitable financial advisor, and nor do they become distinctive when placed side by side. They are not invented words which are wholly associated with the Complainant and its services, and indeed the Complainant does not have an exact match trade mark in the term WHICH ADVISOR. In short, it cannot be said that the ordinary meaning of "Which Advisor?" has been displaced by an overwhelming secondary meaning in favour of the Complainant's trade marks.

Despite this, the Expert is of the view that this is a very difficult case and the issues are finely balanced. As alleged by the Complainant, it may well be that the Respondent had the Complainant in mind at the time of registration of the Disputed Domain Name and deliberately chose it to maximise the number of hits on its website. However, given all

the surrounding circumstances the Complainant has not succeeded in proving Abusive Registration on balance of probabilities, as required by the Policy.

In this regard it should be remembered that the DRS procedure was designed and is intended predominantly for clear cut cases where it is evident that the domain name in question is abusive. Domain names are registered on a first come first served basis and in this case the Expert is unwilling to overturn this and deprive the Respondent of what appears to be a not insubstantial business. The DRS is not an appropriate forum in complex cases such as this and should not be seen as merely a cheap alternative to court proceedings. Evidently the parties are of course free to pursue the matter in a court of competent jurisdiction, and by this decision the Expert makes no inferences as to what the outcome of such a case would be.

In summary, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is not satisfied that the Complainant has succeeded in proving, on balance of probabilities, that the Disputed Domain Name is an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

## **7. Decision**

The Expert finds that the Complainant has Rights in a name which is identical to the Domain Name, but is not satisfied that the Domain Name, in the hands of the Respondent, is an Abusive Registration. No action should therefore be taken in relation to the Domain Name.

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Jane Seager  
28 May 2012