

DISPUTE RESOLUTION SERVICE

D00011349

Decision of Independent Expert

Which? Ltd

and

Mr Jeanpaul Huntington

The Parties

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

Respondent: Mr Jeanpaul Huntington
50A Church St
Ecclesfield
Sheffield
S35 9WE
United Kingdom

The Domain Name

whichmagazine.org.uk

Procedural History

1. The procedural history is as follows: -

21 May 2012 12:41 Dispute received

21 May 2012 13:51 Complaint validated

22 May 2012 11:07 Notification of complaint sent to parties

12 June 2012 02:30 Response reminder sent

15 June 2012 08:58 No Response Received

15 June 2012 08:58 Notification of no response sent to parties

26 June 2012 09:08 Expert decision payment received.

Stephen Bate was appointed as the Expert for the case on 28 June 2012 and on 9 July 2012 signed a written declaration that he was independent of each of the parties and that there were no facts or circumstances that were required to be disclosed in connection with that independence

2. The Respondent has not served a Response.
3. I am satisfied that the Complaint including its documentary annexes was served in accordance with the requirements of the DRS Procedure.

Factual Background

4. The Complainant is Which? Limited, a company incorporated under the laws of England and Wales and a registered charity, first established in 1957 as 'The Consumers Association'. It publishes "WHICH?" magazine and other WHICH? magazines dedicated to particular areas of commerce, providing independent opinions on consumer goods and services. It also lobbies for consumers' rights. Since 1996 it has been publishing WHICH? online from www.which.co.uk and www.which.com.

5. The Respondent registered the Domain Name on 31 January 2012. Subsequently, a web site was operated at that URL address, offering what was stated to be independent advice on various goods and services. Following letters sent to the Respondent on behalf of the Complainant on 24 February and 19 March 2012, the web site was taken down leaving a blank page. There were no replies to either letter nor to a subsequent letter dated 29 March 2012.

Parties' Contentions

6. The Complainant's case is as follows, -
 - 6.1 It is a registered charity existing to promote the interests of consumers. Following its establishment in 1957 as 'The Consumers Association', it was incorporated on 13 December 1960 and in the same year launched "WHICH?" magazine, aimed at providing accurate information and independent advice to UK consumers on goods and services. The magazine now has a circulation of nearly 600,000.
 - 6.2 Over the years, other WHICH? magazines have been added so there is now a stable of WHICH? magazines dedicated to particular areas of commerce, such as computers and cars. The magazines also contain independent tests of consumer products. The Complainant has lobbied for consumers' rights, and in a number of instances enhanced consumer legislation or other positive legal outcomes for consumers have resulted, e.g. in the holiday, bank and replica football markets. Since 1996 it has been publishing WHICH? online on a web site operated from the two addresses referred to in paragraph 4 above. The Complainant's web site is one of the most popular (visited) in the United Kingdom, with 300,000 subscribers to its online service and many more visitors who are not subscribers. The Complainant uses a number of internet domain names

incorporating “which” for its online business. It has also secured a number of other domain names, which wrongly used the WHICH trade mark, to strengthen its online trading presence.

- 6.3 The Complainant also operates a “Which? Best Buy” scheme: it awards a Best Buy status after independent evaluation of products. Companies place a significant value on that endorsement, as evidenced by the scheme under which award-winning companies take a licence from the Complainant to use the Best Buy logo on its packaging and marketing materials.
- 6.4 The Complainant owns 50 registered EU and UK trade marks, including WHICH, WHICH?, WHICH MAGAZINE and 35 other marks that include WHICH. It has also built up a considerable goodwill in the UK in the word WHICH? such that this word (whether or not accompanied by a question mark) used in connection with particular named markets and as a keyword in internet domain names has become synonymous with the commercial activities of the Complainant.
- 6.5 The Complainant first became aware of the Respondent in February 2012, when a broadband service provider drew its attention to the web site attached to the Domain Name. The Complainant discovered a fully operational web site hosted at that online address. The site offers a service purporting to offer independent evaluations of goods and services.
- 6.6 The Domain Name has been registered and used in a manner which takes unfair advantage of and is detrimental to the Complainant’s Rights.
- 6.7 The Domain Name is identical to the Complainant’s trade mark WHICH MAGAZINE and confusingly similar to other WHICH trade

marks of the Complainant. The Domain Name itself will appear on a Google or like search and lead persons wishing to visit the Complainant's online platform to believe that it is the official domain name of the Complainant.

- 6.8 Visitors to the web site are likely to have concluded that it was operated by the Complainant or under licence or authorisation from it. The Respondent was offering consumers online expert and independent reviews of goods and services. It has no legitimate interest in the Domain Name but was using it to trade off the back of the Complainant's business.
- 6.9 Plusnet, the broadband services operator, informed the Complainant about the Respondent's web site in February 2012. Letters of complaint were sent to the Respondent on behalf of the Complainant on 24 February and 19 March 2012. After the second letter the web site was taken down, leaving a blank page. There were no replies to either letter or to a subsequent letter dated 29 March 2012. Despite removal of the web site, the Domain Name remains registered in the name of the Respondent.
- 6.10 The use has been detrimental and unfair because the content of the site infringes the Complainant's intellectual property rights, with particular reference to the treatment of the words WHICH and MAGAZINE with a question mark after the former, as well as use of important text from the Complainant's web site. There is also copying of the sign 'WHICH BEST BUY' and of 'WHICH MAGAZINE', the latter appearing on each alternate page of the web site. As a result, there has been trade mark infringement and passing off.

Discussion and Findings

7. The Complainant is required under subparagraphs 2a. and 2b. of the DRS Policy (“the Policy”) to prove to the Expert on the balance of probabilities that: -
 - 7.1 it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - 7.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

8. By paragraph 1 of the Policy, -

“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.”

9. These are my findings. I repeat the facts set out in paragraph 4 above. The Complainant is a registered charity existing to promote the interests of consumers. It was incorporated on 13 December 1960 and in the same year launched “WHICH?” magazine, aimed at providing accurate information and independent advice on goods and services in the UK. The magazine now has a circulation of nearly 600,000. Other WHICH? magazines have been added to form a stable of WHICH? titles, dedicated to commerce in general and also to particular areas of commerce, such as computers and cars. The Complainant has lobbied for consumers’ rights, and in a number of instances enhanced consumer legislation or other

positive legal outcomes have resulted for consumers, e.g. in the holiday, bank and replica football markets. Since 1996 the Complainant has been publishing WHICH? online on a web site operated from the two addresses referred to in paragraph 4 above. Its web site is one of the most popular (visited) in the United Kingdom, with 300,000 subscribers to its online service with many more visitors who are not subscribers. The Complainant uses a number of internet domain names incorporating “which” for its online business. It has also secured a number of other domain names, which used the WHICH trade mark, so to strengthen its online presence.

10. The Complainant also operates a “Which? Best Buy” scheme to award “Best Buy” status after an independent evaluation of products. Companies place a significant value on that endorsement, as evidenced by the scheme under which award-winning companies take a licence from the Complainant to use the Best Buy logo on their packaging and marketing materials.
11. The Complainant owns a number of CTM and UK trade marks which include the word ‘WHICH’ or ‘which’ with and without a question mark. In particular, it owns UK trade marks ‘WHICH’ (no.2432015), WHICH? (no. 2432014) and WHICH MAGAZINE (no. 2470588) the last of these having been registered on 28 March 2008. It has also built up a considerable goodwill in the UK in the word WHICH? such that this word (whether or not accompanied by a question mark) used in connection with particular named markets and as a keyword in internet domain names has become synonymous with the commercial activities of the Complainant. In view of the commercial history of WHICH magazine, the same is true of these two words with reference to that magazine.
12. Thus, the Complainant has established Rights, both trade mark rights and rights in passing off. These are in a name or mark, namely ‘WHICH MAGAZINE’, identical to the Domain Name. Thus, the Complainant has established that it has Rights.

Abusive Registration

13. Paragraph 1 of the Policy states, -

“Abusive registration means a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or other 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.”*

Paragraph 3 of the Policy states -

“3. Evidence of Abusive Registration

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:-*
 - i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
A....
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 to, the Complainant.
.....”*

14. The following represent my findings on the issue of Abusive Registration. They are limited to those necessary to dispose of this complaint in accordance with the Policy and the DRS Procedure.
15. The Appeal Panel in DRS 04331 *verbatim.co.uk* determined that, for a complaint to succeed, -

“the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name.”

I adopt this approach, noting what was observed by the Appeal Panel in DRS 03733 *mercero.co.uk*, that the requirement of prior knowledge on the part of the registrant is ordinarily required.

16. I am satisfied that the Respondent had the Complainant in mind and was aware of it when he registered the Domain Name on 31 January 2012. He has put forward no explanation for his choice of domain name. The business operated at the web site attached to the Domain Name is a deliberate imitation of the business carried on by the Complainant in the publishing of information and evaluation of consumer products and services: see further below. Use of the words ‘which’ and ‘magazine’ for an online business of that description made no sense unless the intention was to impersonate, or at the very least, suggest an authorised connection with, the Complainant.
17. It is likely that there was ‘initial interest confusion’ as a result of the Respondent’s choice of domain name. If unaware of either www.which.com

or www.which.co.uk, persons seeking to visit the Complainant's online publishing content or to find out other information about WHICH? are likely to have carried out an internet (Google or like) search, which will have shown up the Domain Name. Inclusion of the word 'org' as part of the Domain Name will have reinforced the impression that the site was operated by the organisation behind WHICH? magazine.

18. It is not necessary for the purposes of this decision to conduct an analysis of infringements of the Complainant's intellectual property rights before the web site was taken down soon after 19 March 2012. The content of the site constitutes a clear attempt to imitate and indeed impersonate the Complainant and its business. The home page of the web site announced itself as 'which magazine' with the words 'org.uk' appearing in smaller writing. The page went on to state, 'Welcome to Which magazine'. Taken as a whole, the home page represented that it was Which? magazine online. That was untrue. The text on the home page proceeded as follows, -

"Welcome to Which magazine. Which magazine does more than just review and test, we give honest, independent advice. We campaign to get a fairer deal for all and publish online expert, unbiased professional information that helps you make the right choice, whatever you're buying".

The 'About Us' section of the Complainant's web site contains the words, -

"We campaign to get a fairer deal for all consumers and publish expert, unbiased information to help you make the right choice, whatever you're buying."

The extract from the Respondent's home page referred to immediately above this extract was, as I find, taken and copied from the Complainant's web site. The colouring of the words, red lettering for 'which', where it first appears on the erstwhile home page of the Respondent's site, was also designed to confuse visitors to that web site in its original form. A very

similar colour red is used as appears in device marks and logos of the Complainant for 'WHICH'.

19. The content of the Respondent's site was similar to that of the Complainant in terms of content, containing views, reviews and reports on various consumer products.
20. Although the Respondent has taken down the web site, he has not engaged with the Complainant or his solicitors, even though those solicitors sent him a further letter dated 29 March 2012. He has not engaged with the DRS process either.
21. The upshot is that there will still be initial interest confusion, which will not be dispelled when a visitor reaches the web site. The likely conclusion that a visitor to the Respondent's web site would draw is that this is an inactive site, operated by or with the authorisation of the Complainant.
22. Thus, there will still be initial interest confusion suffered by persons wishing to seek out the Complainant online and the Complainant also has hanging over it the implicit threat of the Respondent resuming his commercial activities using the Domain Name to imitate and impersonate the Complainant.
23. Taking into account the findings set out in paragraphs 15-22 above in particular, I conclude that the Domain Name was acquired by the Respondent for the purpose of unfairly disrupting the business of the Complainant. Further, in view of the findings set out in those paragraphs, there are circumstances indicating that the Respondent is using the Domain Name to generate initial interest confusion and is threatening to use the Domain Name in a way which has confused and is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to, the Complainant.

Decision

24. The Complainant has Rights in a name or mark, which is identical to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore determines that the Domain Name 'whichmagazine.org.uk' be transferred to the Complainant.

Signed: STEPHEN BATE

Dated 12.07.12