

DISPUTE RESOLUTION SERVICE

DRS 19551

Decision of Independent Expert

The Commissioners for HM Revenue and Customs

Complainant

and

Whois Foundation

Respondent

1 The Parties

Complainant:	The Commissioners for HM Revenue and Customs
Address:	C2/17, 100 Parliament Street, West Side London SW1A 2BQ United Kingdom

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

2 The Domain Names

hdmrc.co.uk

hmrc-onlles.co.uk

hmrcsubmitareturn.co.uk

hmrc-tx.co.uk (collectively, the "Domain Names").

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, which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

17 November 2017	Dispute received
21 November 2017	Complaint validated
21 November 2017	Notification of complaint sent to parties
08 December 2017	Response reminder sent
11 December 2017	Response received
14 December 2017	Notification of response sent to parties
14 December 2017	Reply received
14 December 2017	Notification of reply sent to parties
14 December 2017	Mediator appointed
14 December 2017	Mediation started
14 December 2017	Mediation failed
14 December 2017	Close of mediation documents sent
14 December 2017	Expert decision payment received

4 Factual Background

- 4.1 The Domain Names were registered between August 2016 and June 2017, specifically, *hmrc-onlles.co.uk* on 11 August 2016, *hmrc-tx.co.uk* on 10 March 2017, *hdmrc.co.uk* on 3 April 2017 and *hmrcsubmitareturn.co.uk* on 16 June 2017.
- 4.2 The Complainant is the United Kingdom's tax authority, HM Revenue and Customs.
- 4.3 The Respondent's status is unclear.
- 4.4 The Domain Names are currently pointing to websites, apparently hosted by a third party, providing links to websites offering services related to tax returns and other taxation related matters. Each of those secondary websites contains further links, in some cases to third party businesses apparently providing financial services of various kinds, and to the Complainant's own website.

5 Parties' Contentions

Complaint

- 5.1 The Complainant explains that it is a non-ministerial department of HM Government responsible for the collection of taxes, the payment of some forms of state support and the administration of other regulatory regimes. It identifies a number of proceedings under the DRS in which it has successfully recovered domain names incorporating the initials HMRC or the words 'Inland Revenue'.
- 5.2 The Complainant asserts that the Respondent "appears to be a prolific domain name squatter", being the registrant of 53,954 domain names in the .uk ccTLD. Approximately 21,000 of those domain names are exhibited to the Complaint.

- 5.3 In addition, the Complainant identifies, by way of illustration, 10 domain names registered by the Respondent which appear to be examples of 'typo-squatting' (i.e. the practice of deliberately registering as a domain name a mis-spelled version of a well known name or mark), e.g. *agentprovacteur.co.uk*, *bankofscotland.co.uk* and *cathkindston.co.uk*.
- 5.4 The Complainant contends that at the time the Complaint was filed, the Domain Names were associated with websites displaying pay per click advertisements relating to the Complainant's "area of business".
- 5.5 The Complainant relies on its UK registered trade mark number 2471470 for the word HMRC in Classes 9, 16, 25, 26, 35, 36, 38, 41, 42 and 45, as evidenced by an extract from the IPO database.
- 5.6 It also contends that it is "very well known in the United Kingdom and beyond as HMRC" and exhibits media articles, Google search results and evidence of the number of its followers on Facebook and Twitter, to support what appears to be (though is not pleaded as such) an assertion of common law or unregistered rights in the HMRC name.
- 5.7 It contends that the Domain Names are similar to its name and registered mark for the purposes of paragraph 2.1.1 of the DRS Policy (the "Policy") on the basis that they include either "typographical variants of words and phrases related to the Complainant" or the phrase "submit a return".
- 5.8 Specifically:
- 5.6.1 *hdmrc.co.uk* differs from the registered mark only by the insertion of the letter "d";
- 5.6.2 *hmrc-onlles.co.uk* incorporates the Complainant's mark and a typographical variant of the word "online", which is a generic and descriptive word commonly associated with domain names used for internet services;
- 5.6.3 *hmrcsubmitareturn.co.uk* incorporates the Complainant's mark and what the Complainant describes as "a phrase closely associated with the Complainant";
- 5.6.4 *hmrc-tx.co.uk* incorporates the Complainant's mark and a typographical variant of the word "tax", which again is closely associated with the Complainant and its responsibilities.
- 5.9 Finally, the Complainant asserts that the addition of hyphens does "not add anything further to differentiate the Domain Names from the Complainant's mark" and also relies on previous DRS decisions (unspecified) which have found that the *.co.uk* suffix should likewise be disregarded when determining similarity.
- 5.10 As to Abusive Registration, the Complainant relies, firstly, on paragraph 5.1.1.2 of the Policy, contending that the Domain Names are highly likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant. It asserts that, given the prominence of the HMRC mark, "a substantial number of people will be confused into believing that, at least at first glance, the Domain Names are owned, controlled or endorsed by the Complainant", notwithstanding the inclusion of typographical variations of the words "online" and "tax", and of the phrase "submit a return", none of which distinguishes the respective Domain Names from the HMRC mark or make clear the relationship (or lack thereof) between the Complainant and the Respondent.

- 5.11 The Complainant further contends that the Respondent's use of the Domain Names amounts to an impersonation of the Complainant as contemplated by the Nominet DRS Appeal Panel in *scoobydoo.co.uk* (DRS 0089), in which the Panel observed that "impersonation can rarely be fair".
- 5.12 Secondly, the Complainant relies on paragraph 5.1.1.3 of the Policy, i.e. unfair disruption of its business, on the basis that the pay per click advertising on the websites to which the Domain Names direct uses terms which "relate closely to the Complainant's activities". It contends that such use by the Respondent of pay per click advertising is objectionable because "any traffic to the websites must have necessarily resulted from the confusion caused by the fact that the Domain Names are similar to the Complainant's HMRC mark and that the advertisements displayed thereon relate to the Complainant's activities", and accordingly that such use is unfairly disruptive.
- 5.13 Thirdly, notwithstanding its submissions as outlined at 5.10 and 5.11 above, the Complainant relies on paragraph 5.1.2 of the Policy, contending that the Respondent is using or threatening to use the Domain Names in ways which have confused or are likely to confuse people or businesses into believing that they are registered to, operated or authorised by, or otherwise connected with the Complainant.
- 5.14 Fourthly, the Complainant relies on paragraph 5.1.3 of the Policy, contending that the Respondent is engaged in a pattern of registrations which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Names are part of that pattern. It relies in this regard on the Respondent's registration of some 56,000 domain names in the .uk ccTLD. It submits that many of those other domain names resolve to pay per click advertising like that associated with the Domain Names. It says that those further registrations demonstrate that the Respondent "engages in registering domain names closely related to third party marks and monetises the associated websites". It submits that the Domain Names are being used in the same way and therefore are part of that pattern for the purposes of paragraph 5.1.3.
- 5.15 Finally, the Complainant submits that there are none of the circumstances present as set out in section 8 of the Policy by which the Respondent would be able to demonstrate that the Domain Names are not Abusive Registrations. In particular, they are not being used in association with a genuine offering of goods or services (paragraph 8.1.1.1.); to the Complainant's knowledge, the Respondent has never been known by or legitimately connected with the term HMRC or any of the terms reflected in the Domain Names (paragraph 8.1.1.2); there is no evidence that the Domain Names are registered for legitimate, non-commercial or any fair use purposes (paragraph 8.1.1.3); and none of the Domain Names are generic or descriptive, given that the dominant element of each is the distinctive term HMRC which relates entirely to the Complainant and its activities (paragraph 8.1.2).

Response

- 5.16 Unusually, in this case, the Response is confined to what appears to be a very short email to Nominet which reads in full (excluding salutation and valediction) as follows:

"We are agreeable to transferring the domains.

hmrc-onlines.co.uk

hmrc-tx.co.uk

hdmrc.co.uk

hmrcsubmitareturn.co.uk"

Reply

- 5.17 Likewise unusually, the Reply comprises an email from the Complainant's representative to Nominet which simply reads, again in full, as follows:

"Further to your email; my client does not want to settle and has instructed me to ask you to proceed to appointing an Expert to make a decision."

6 Discussions and Findings

General

- 6.1 To succeed under the DRS Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2).

- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"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 acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

(ii) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's rights

- 6.3 Paragraph 2.1.1 of the Policy requires the Complainant to prove that it *"has Rights in respect of a name or mark which is identical or similar to the Domain Name"*. "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"* (paragraph 1).

- 6.4 The Complainant plainly has the requisite Rights (as defined) by virtue of its registered UK mark HMRC.

- 6.5 While the point is therefore moot, it probably also has the unregistered rights described at paragraph 5.6 insofar as its activities generate goodwill in the extended sense recognised for charities, associations and public bodies (see, for example, Wadlow *The Law of Passing Off*, third edition, 3-21 et seq).

- 6.6 As to similarity, the Experts' Overview states in paragraph 2.3 as follows:

"Mis-spelled versions of names are normally found to be similar to their originals. Additional elements rarely trouble Experts. For example, in DRS 06973 veluxblind.co.uk the Expert commented "The Domain Name consists of the Complainant's distinctive trade mark and the descriptive word "blind", which does nothing to distinguish the Domain Name from the mark, since the mark is associated in the public mind with the Complainant's blinds".

- 6.7 It is now also well settled under the Policy that the *.co.uk* suffix, together with hyphens, ampersands and the absence of letter spacing, can be ignored for these purposes.

- 6.8 Taking each of the Domain Names in turn, *hdmrc.co.uk* is a classic case of typo-squatting, by the insertion of a single letter in the mark and accordingly is similar to the mark for the purposes of paragraph 2.1.1 of the Policy.
- 6.9 *hmrc-onllnes.co.uk* and *hmrc-tx.co.uk* both incorporate the Complainant's mark and deliberately mis-spelled versions of generic and descriptive words, namely "online" and "tax". As the Complainant points out, the former is commonly associated with the provision of services online and the latter is plainly closely associated with the Complainant and its activities as the UK's tax authority. For those reasons, the addition of a single letter and of those mis-spelled words does not render those Domain Names sufficiently distinctive to the name and mark in which the Complainant has rights to take them outside paragraph 2.1.1.
- 6.10 Likewise, *hmrcsubmitareturn.co.uk* includes the Complainant's name and mark together with a phrase which, again, is closely associated with the Complainant's field of activity, though this time without any mis-spelling. Again, that is insufficient to take that Domain Name outside paragraph 2.1.1.
- 6.11 Accordingly, the Complainant has demonstrated the requisite degree of similarity between the HMRC name and mark and each of the Domain Names, and has therefore succeeded in proving that it has Rights in respect of a name or mark which is identical or similar to the Domain Names.

Abusive Registration

- 6.12 The Complainant presumably intends (see further below) to submit that this is a case of Abusive Registration on three separate grounds:
- 6.12.1 confusion or likelihood thereof (Policy 5.1.2);
- 6.12.2 unfair disruption of its business (Policy 5.1.1.3); and
- 6.12.3 pattern of infringing registrations (Policy 5.1.3).
- 6.13 Paragraph 5.1.2 of the Policy includes as a factor which may be evidence that a domain name is an Abusive Registration circumstances indicating that the Respondent is using or threatening to use the domain name in a way which is confusing 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.
- 6.14 The references in the Complaint to paragraph 5.1.1.2 of the Policy must, having regard to the contentions as summarised at paragraphs 5.10 and 5.11 above, have intended to refer to paragraph 5.1.2, although, confusingly (as set out in paragraph 5.13 above) the Complainant does separately also cite paragraph 5.1.2. Indeed, the Complainant's submissions on confusion are themselves somewhat confusing.
- 6.15 This decision therefore proceeds on the footing that the Complainant's submissions in relation to what it describes as "5.1.1.2" and also what it describes as "5.1.2" (presumably accurately) are taken compendiously to refer to paragraph 5.1.2 of the Policy.
- 6.16 The Complainant asserts in this regard that it is "inevitable" that a substantial number of people will be confused into believing, at least at first glance, that the Domain Names are owned, controlled or endorsed by the Complainant. No evidence has been provided in support of that assertion. It appears that the Expert is invited to make that inference essentially on the basis of the Domain Names themselves.

- 6.17 The confusion referred to in this paragraph of the Policy is confusion as to the identity of the person or entity behind the Domain Name in question (Experts' Overview, paragraph 3.3). As the Overview explains:

"In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant". This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with... a commercial web site which, may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

...

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant. ... The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned – see for example DRS 03806 (privalege.co.uk) – as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decisions in DRS 00248 (seiko-shop.co.uk) and DRS 07991 (toshiba-laptop-battery.co.uk)".

- 6.18 In this case, none of the Domain Names is identical to the HMRC mark. The question is therefore whether the Domain Names are far enough away from the Complainant's name and mark to avoid a finding of Abusive Registration on the basis of a likelihood of initial interest confusion.
- 6.19 In this Expert's judgment, they are not. The Domain Name *hdmrc.co.uk* is pretty much on all fours with *privalege.co.uk*, the only difference being that a single letter has been added rather than substituted. The remaining three Domain Names all include "appendages" of the sort described in the Overview, the only difference being that two of them are deliberately misspelled.
- 6.20 If a mis-spelling of the mark is not enough to avoid a finding of Abusive Registration under this paragraph, then it is hard to see why a mis-spelling of an appendage which otherwise meets the definition in the Overview would do so.
- 6.21 The Complainant makes two further points in support of its reliance on paragraph 5.1.2 of the Policy.
- 6.22 First, it contends that the Respondent's registration and use of the Domain Names constitutes impersonation of the Complainant, by reference to the Appeal decision in *scoobydoo.co.uk* (DRS 00389). Here, the Complainant is on less certain ground. In the first place, that case concerned a domain name which was identical to the Complainant's registered mark. Further, in that case, the Respondent was selling official merchandise on the site. Both those factors would heighten the likelihood of such impersonation. Finally, in any event the Appeal Panel was somewhat tentative in its finding even in that case: "*Taking the Domain Name in the circumstances arguably amounts to impersonation of the owner of the name or mark*" (emphasis added).

- 6.23 Secondly, the Complainant relies on the Respondent's use of pay per click advertising, which "necessarily resulted from the confusion". However, given that this is, for the reasons explained above, essentially a case of initial interest confusion, it is hard to see what additional support might be derived by the Complainant in this regard from the fact that the Domain Names are being used to point to pay per click sites. Indeed, arguably, once the internet user is directed to such a site, confusion is less not more likely because it will quickly become apparent to many, possibly most, internet users that this cannot have anything to do with the Complainant.
- 6.24 Nonetheless, notwithstanding that the Complainant fails on its two supplemental submissions in relation to paragraph 5.1.2, for the reasons set out in paragraphs 6.16 to 6.20 above, it has succeeded in demonstrating, for the purposes of paragraph 5.1.2, at the very least a likelihood of confusion.
- 6.25 The Complainant also relies on paragraph 5.1.1.3 of the Policy, which includes as a factor which may be evidence that a Domain Name is an Abusive Registration circumstances indicating that the Respondent has registered or otherwise acquired the Domain Names primarily for the purpose of unfairly disrupting the business of the Complainant.
- 6.26 The Complainant relies in this regard on the Respondent's use of pay per click advertising displayed on the websites to which the Domain Names point and the fact that those links use terms "which relate closely to the Complainant's activities". The Complainant's submissions on this point are not particularly clear. Its position is not assisted, of course, by the fact that the Complainant does not conduct business as such. But even if one were to read paragraph 5.1.1.3 as including, in the case of a public authority like the Complainant, the disruption of non-business activities (bearing in mind that paragraph 5.1 is non-exhaustive), the concept of unfairness is not straightforward in this context. If the Domain Names were being used, for example, to incite taxpayers not to pay tax, that might be a different matter. But, in the absence of any evidence of disruption, let alone unfair disruption, of the Complainant's tax collection activities, the Complainant has failed to discharge its burden of proof in this regard.
- 6.27 Finally, the Complainant relies on paragraph 5.1.3 of the Policy, which provides for Abusive Registration where the Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well known names or trade marks in which the Respondent has no apparent rights, and – importantly – the domain name is part of that pattern.
- 6.28 The Complainant has adduced compelling evidence not only of the quantity of the Respondent's registration of domain names (approximately 56,000) but also of the fact that many of them appear to infringe third party rights in the manner contemplated in paragraph 5.1.3.
- 6.29 The Complainant has extracted and exhibited just under 21,000 domain names in a spreadsheet which it says has been generated by Nominet. Some of those are generic and/or descriptive. However, many appear on the face of it to infringe third party rights either because they constitute what appears to be a name or mark in which a third party has rights (e.g. *archerfieldgolfclub.co.uk*, *autotradersonline.co.uk*.) or because they constitute further examples of typosquatting (e.g. *argoscataloge.co.uk*, *asdapricegaruntee.co.uk*, *suthernrail.co.uk*, *weekabix.co.uk*) in addition to the 10 specific examples cited in the Complaint.
- 6.30 Trading in Domain Names for profit and/or holding a large portfolio of domain names, is not, of itself, objectionable under the DRS or at law (Policy, paragraph 8.4).
- 6.31 However, in this case, it is plain from the evidence provided by the Complainant that the Respondent is engaged in large scale registration of domain names which appear to infringe the rights of third parties, because they are identical to the names or marks of those third parties,

because they are deliberate mis-spellings of the third party name or mark, or because they include a third party name or mark and an appendage (often mis-spelled). Moreover, the four Domain Names all also fall into the latter two categories.

6.32 No counter or explanation is advanced by the Respondent in relation to any of the Complainant's arguments on Abusive Registration, nor does it seek to rely on any of the potentially exculpatory factors set out in section 8 of the Policy.

6.33 Accordingly, the Complainant has demonstrated Abusive Registration on the grounds set out in paragraphs 5.1.2 and 5.1.3 of the Policy. The Complainant has, therefore, on the balance of probabilities, demonstrated Abusive Registration pursuant to paragraph 2.1.2 of the Policy.

7 Decision

7.1 The Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Names and that the Domain Names are, in the hands of the Respondent, Abusive Registrations.

7.2 It is therefore determined that the Domain Names be transferred to the Complainant.

David Engel

Signed

Dated 11 January 2018