

DISPUTE RESOLUTION SERVICE**D00023374****Decision of Appeal Panel**

FF Bequest Limited

and

Brilliant British Limited

1. The Parties:

Complainant: FF Bequest Limited
Northcliffe House
Bequest, FF, Level 4
London
W8 5EH
United Kingdom

Respondent: Brilliant British Limited
2nd Floor
167-169 Great Portland Street
London
W1W 5PF
United Kingdom

2. The Domain Name:

bequests.co.uk

3. Appeal Panel Declaration

Ian Lowe, David King and Claire Milner (together, the "Panel") have each made a statement in the following terms:

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

4. Procedural History

This is an appeal against the decision of Tim Brown (the “Expert”) issued on 29 March 2021 in favour of the Respondent. Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy (as in effect from 1 October 2016) (the “Policy”) unless the context or use indicates otherwise.

For convenience the Panel will continue to refer to the parties as the “Complainant” and “Respondent”.

5. The Nature of This Appeal

Paragraph 20.8. of the Policy provides that: “The appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters. The appeal panel should not normally take into consideration any new evidence presented in an appeal notice or appeal response, unless they believe that it is in the interests of justice to do so”.

The Panel concludes that insofar as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits.

6. Formal and Procedural Issues

Paragraph 20.3 of the Policy states “An appeal notice should not exceed 1000 words, should set out detailed grounds and reasons for the appeal, but shall contain no new evidence or annexes.” However, in its Appeal Notice, the Complainant raises new matters that were not referred to in the original proceedings, without identifying it as new evidence and without making any formal request for the new evidence to be considered. The new evidence does not raise any relevant issues or ones that the Panel considers it to be in the interests of justice to admit (in accordance with Paragraph 20.8 of the Policy cited above). The Panel accordingly declines to accept such new evidence.

7. The Facts

The Complainant is a startup company incorporated on 17 December 2019, carrying on business as Bequest. It is the registrant of the domain name <bequest.co.uk> that resolved at the time of the Complaint to a website at www.getbequest.com, and now resolves to www.bequest.com, where the Complainant promotes its Will writing and Life insurance business. The Complainant is the proprietor of UK trade mark number 3452648 BEQUEST registered on 13 March 2020 in Class 36 in respect of insurance and life insurance services, with an application date of 18 December 2019. It has been authorised by the Financial Conduct Authority since 30 June 2020 to arrange insurance.

The Respondent acquired the Domain Name as one of a substantial portfolio of domain names on 21 February 2019. It resolves to a website comprising several webpages listing details of providers of various services, including life insurance, equity release, funeral plans, ISAs and Wills.

8. The Parties' Contentions

Complaint

Rights

The Complainant claims that it has Rights in the word mark "bequest" in view of its UK trade mark. It notes that it has registered other domain names, including <bequest.co.uk>, related to the term "bequest". It also contends that, as a financially regulated business, it has reported a claim of passing off to the Financial Conduct Authority.

Abusive Registration

The Complainant says that it considers its customer group to be a "protective demographic", that it goes to great lengths to ensure that its customers know that they are speaking to the right company, and that it is protective of its brand name for the benefit of its users. It submits that the Domain Name causes confusion and it has provided a LinkedIn article about the Complainant's company which tagged the Complainant's business but linked to the Domain Name. It says that the Domain Name "continues to be misused" which will result in the Complainant incurring costs in retrieving users who intended to visit the Complainant's company.

The Complainant contends that the design of the Respondent's primary logo was inspired by the Complainant's logo. The Complainant also has a product called "Bequest Wills" which has its own logo, and it submits that the Respondent copied it for use on the Respondent's will writing business by flipping it and placing it on a sketched piece of paper.

The Complainant repeats that it has filed a passing off claim with the Financial Conduct Authority. It says that the Authority is now processing it.

The Complainant contends that, when the Domain Name website was created, it was a "content farm". It says that the Respondent introduced its own will writing service not long after the Complainant went live with its "Bequest Wills" service.

The Complainant alleges that the Respondent is trying to confuse its customers and attract traffic in order to generate revenue, which it considers to be an appalling abuse of all the hard work the Complainant has done.

The Complainant refers to correspondence with the Respondent on LinkedIn and contends that the Respondent purchased the Domain Name in order to seek transfer fees of £100,000.

Finally the Complainant says that the Domain Name website "uses meta tags that are styled to be confusing and misleading" and that this indicates that the Respondent knew that it was misleading customers.

Response

Rights

The Respondent points out that it acquired the Domain Name in February 2019, 10 months before the Complainant was incorporated in December 2019.

It says that the Complainant does not use its domain name <bequest.co.uk>, which now resolves to <bequest.com> which the Complainant has acquired. The Respondent submits

that, in any event, <bequest.co.uk> did not appear to be in use until March 2020 (according to archive.org screenshots provided by the Respondent).

The Respondent notes that the Complainant's trade mark is registered only in Class 36. The Respondent says that, while it does have content about insurance providers on its website, it makes it clear in its disclaimer that it does not provide any sort of financial service or advice and that the insurance content is modest.

Abusive Registration

The Respondent denies the Complainant's contentions.

It says that its brand is "bequests.co.uk" and that the ".co.uk" is an integral part of its brand identity whereas the Complainant uses the more generic "Bequest".

The Respondent says that the idea for its website occurred in the summer and early autumn of 2019 and that it started with wills which seemed logical in view of the Domain Name. It states that, at the time of launch, it was not aware of any competitors using the name or any likely issues, as the term seemed very generic.

The Respondent submits that the Complainant commenced business in 2019 after the Respondent's business was launched and that the Complainant's trade mark was granted at a later date.

In a non-standard submission which was accepted by the Expert, the Respondent provides evidence of substantial expenses it has incurred on external writers, digital PR and marketing. It says that the sum of £100,000 referred to in the correspondence with the Complainant would "not be just for the domain but for the time, effort and opportunity cost lost to no longer using it".

As regards the use of the incorrect URL in the LinkedIn article, this is irrelevant and it notes that it cannot control how others choose links.

The Respondent contends that it does not make money from the life insurance content and that it only tries to make money via an affiliate agreement with UK Legal Wills.

The Respondent denies that it has copied the Complainant's logos and says that it chose its main logo through a design brief issued to a website at "99designs.co.uk", and took its will writing logo from a website offering free logos (the logo is shown at https://www.flaticon.com/free-icon/last-will_1450727?term=wills&related_id=1450727).

The Respondent also denies the Complainant's contentions regarding meta data or that it is operating a "data farm". It says that it has "no ads on the site and only one affiliate deal for wills".

The Respondent says it has received no correspondence from the Financial Conduct Authority.

Finally, the Respondent requests a finding of Reverse Domain Name Hijacking. It contends that the Complainant is trying unfairly to gain control of the Domain Name rather than paying the fair market price for work done.

Reply

The Complainant contends that there has been a complete disregard as to why it is pursuing its complaint.

It says that it is regulated by the Financial Conduct Authority and “despite being involved in wills since 1998, we became a brand in 2019, following a successful partner with Aviva PLC”. It submits that the term “Bequest” has not been widely used in the industry and that no-one has branded the term or attempted to use it to confuse customers.

The Complainant refers to its trade mark. It still believes that the Respondent was heavily inspired by its previous domain. It contends that its trade mark is being ignored.

The Complainant says that, after consulting legal counsel, it concluded that the Respondent’s offer to sell for £100,000 was the kind of cost asked for by domain-squatters. Subsequently the Complainant found out that it could make a complaint to Nominet.

The Complainant states that it is only seeking to remove further confusion over the two brands, one a regulated insurance company and the other an advertising firm.

The Complainant submits that both the Intellectual Property Office and the Financial Conduct Authority are aware of its claims but that “the system in place encourages us to seek mediation via Nominet”.

Finally, the Complainant makes further reference to evidence of its ownership and alleged trade mark infringement. It says that there is no economic benefit from its obtaining the Domain Name and that the benefit is purely on the customer and the end of any confusion.

Appeal Notice

The Complainant says that it decided to appeal following legal advice on the closeness of the Domain Name to its trade mark, with a singular trade mark covering also its plural, and both parties engaging in the same activity Class (36).

It claims that it had been trading for a long time before its date of incorporation and the other party’s launch, since it had acquired a relevant company and the domain name <bequest.co.uk>, which was originally registered in 1998.

It points out that the Respondent’s website as examined by the Expert had changed in some respects from how it was when the Complaint was made.

It goes on to reiterate points made in its original Complaint and Response. It also adds some new evidence which, as explained in section 6 above, is not allowed by the Policy, and which the Panel does not feel needs to be admitted in the interests of justice.

Finally, as evidence of having established secondary meaning in the word *bequest* it points to startup awards that it has received.

Appeal Response

The Respondent suggests that the new evidence in the Appeal Notice should lead to the Appeal being rejected. He adds that the remaining material in the Appeal is all repetition of previous arguments which have already been responded to, but for the sake of completeness the Appeal Response goes through them once again. In particular, it restates the following points.

The Complainant's regulated business, in insurance, is only one aspect of the Respondent's business conducted using the Domain Name, and the website makes it clear that the Respondent does not provide advice on insurance.

The Complainant has provided no evidence to support its claim of active trading long before its incorporation, while the Respondent has provided web archive evidence showing that <bequest.co.uk> was inactive before the registration of <bequests.co.uk>.

The Respondent claims that he has not in fact changed the website's metatitle during these proceedings (as suggested in the Appeal Notice); however, the Complainant has amended theirs.

The Respondent alleges that the Complainant's claimed primary concern, of avoiding customer confusion between the two parties, is not genuine, since the Complainant has chosen not to take opportunities open to it to reduce confusion. Rather, the Respondent suggests, the Complainant is trying to use Nominet's DRS to acquire the Domain Name for less than its market value.

9. Discussion and Findings

Pursuant to paragraph 2.1 of the Policy, the Complainant must prove in relation to the Domain Name that, on the balance of probabilities:

- 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.

Rights

"Rights" are defined in the Policy as "... rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning."

The Complainant is the proprietor of a UK trade mark for BEQUEST. Although this was registered in March 2020, more than a year after the Domain Name was acquired by the Respondent, it is well-established for the purposes of the Policy that the Complainant need only hold relevant Rights as at the date of the Complaint.

The Respondent does not expressly dispute that the Complainant has the necessary Rights. Ignoring the country code gTLD ".co.uk" for this purpose, the Domain Name differs from the Complainant's mark only by the addition of the letter "s" at the end, making it plural, a minor change in English. Accordingly, the Panel finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive Registration

In order to establish that the Domain Name in the hands of the Respondent is an Abusive Registration, the Complainant must show that the Domain Name either:

- i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

- ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Acquisition of <bequests.co.uk>

The system of registration of domain names is a “first come, first served” system. As a general rule (subject to exceptions not relevant in this case), anyone may register (or subsequently sell or buy) any available domain name. In order to show that a domain name constitutes an Abusive Registration under i) above, a complainant generally needs to show on the balance of probabilities:

- a) that the respondent was aware of the complainant, and/or its rights in a mark identical or similar to the domain name, at the time it was registered or acquired; and
- b) that the respondent intended to target the complainant or its trade mark.

This was the view expressed by the appeal panel in DRS 4331 (<verbatim.co.uk>) and the Panel regards that general principle as applicable in this case.

The Respondent acquired the Domain Name in February 2019. The Complainant’s domain name <bequest.co.uk> was registered in 1998 and the Complainant says that it was acquired along with a will writing firm, that had operated from that date, when the Complainant started in business in 2019. The Complainant does not state explicitly when the <bequest.co.uk> domain name was acquired, but the Panel infers that it was at about the same time as the Complainant was incorporated in December 2019. The Complainant does not adduce any evidence as to the prior use of the <bequest.co.uk> domain name by the will writing firm. The Respondent’s evidence is that, according to the Web Archive at web.archive.org, the website at www.bequest.co.uk was last available in August 2018 and then only returned a HTTP 403 error. The Complainant does not dispute this, or the Respondent’s evidence that the Complainant’s website at www.getbequest.com was not active until 29 March 2020.

Since the Complainant was not incorporated until December 2019, there is no question of the Respondent’s being aware of the Complainant at the time of acquisition of the Domain Name. In the circumstances set out above, there is also no evidence to support the Respondent’s having been aware of any relevant predecessor business of the Complainant, or of any rights that any such business may have had in the mark BEQUEST at that time. In the circumstances, the Panel is satisfied that the Respondent’s acquisition of the Domain Name neither took unfair advantage of nor was unfairly detrimental to the Complainant’s Rights.

Use of <bequests.co.uk>

In order to establish Abusive Registration, therefore, the Complainant must show that the Respondent’s use of the Domain Name has taken unfair advantage of, or has been unfairly detrimental to, the Complainant’s Rights.

The Panel notes that “bequests” is a generic term. Paragraph 8.1.2 of the Policy lists as one of the factors that may be evidence that the Domain Name is not an Abusive Registration that “the Domain Name is generic or descriptive and the Respondent is making fair use of it.” The appeal panel in DRS 4884 (<maestro.co.uk>) observed that “where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive if it is to be held to be an Abusive Registration under the DRS Policy.” The Panel in this case agrees with that observation.

In order to establish secondary meaning in a mark, it is necessary to show that despite the mark being a generic word it has become distinctive of the brand owner. It typically takes a number of years of effort and activity on its part such that the consuming public comes to

recognise the significance of the mark as referring to that brand owner's goods or services, despite its genericism.

In the Panel's view, the evidence adduced by the Complainant does not begin to show that it has established any secondary meaning in respect of "Bequest", let alone an "overwhelming secondary meaning". The Complainant points to its having won a number of startup awards in 2020, related to its inchoate insurance business, but those awards reflect recognition of the efforts the Complainant has made in seeking to establish a life insurance business and its use of technology in looking to do so. There is no evidence of any revenue at all in relation to that business and, as the Respondent pointed out in its Response, a user clicking on the "Sign Up" button on the Complainant's website in relation to Life Insurance was simply invited to join a Wait List, raising doubt as to the extent to which the Complainant was in fact engaged in revenue earning business in relation to life insurance.

The Respondent's website at www.bequests.co.uk went live on about 9 December 2019, before the Complainant was incorporated. The Respondent asserts that, bearing in mind the Domain Name, it started at that time with listings of various will writing services, as shown in the content captured by web.archive.org. It then expanded into other areas such as funeral plans, equity release, life insurance, SIPPs and ISAs. In all cases, the website has comprised listings of the services of third parties only. It does, however, have a link to UK LegalWills, which claims to be the UK's best online will writing service. The Respondent states that it has not monetised any links or listings on its website, save for an affiliate agreement with UK LegalWills that has not yet generated any revenue.

The Complainant complains that the Respondent has copied its logos in order to confuse customers, but the Respondent maintains (with supporting evidence) that its logos were independently arrived at. The Panel does not accept in any event that the two primary logos (each is of four disjoint shapes, but these differ in colour, shape and orientation) could be said to be confusingly similar. The two will-writing logos are similar, each including a stylised quill pen, but this is only to be expected when using images that are freely available online.

The Complainant complains that the Respondent's website started as a "content farm" and only introduced a will writing business after the Complainant went public with Bequest Wills, its will writing service. The Respondent points out that Wills were a natural first subject of its website listings, given the Domain Name, before the Complainant existed, and the Panel accepts that an affiliated link to a will writing service was a natural extension of such listings and cannot be said to amount to taking unfair advantage of the Complainant's Rights. The Complainant's will writing business is handled by a third party on its behalf.

The Complainant is particularly concerned about the scope for confusion between the Respondent's website and its life insurance business, an area understandably the subject of regulation by the Financial Conduct Authority. However, given the nature and history of the two businesses, the Panel does not consider that there is any evidence that the Respondent is seeking to benefit from any such confusion or that it has tailored its website since the Complainant was established in order to take unfair advantage of the Complainant's mark. The confusion, such as there may be, is simply a function of the fact that both the Complainant and the Respondent are using the same generic term.

Finally, the Complainant places some reliance on the fact that in an exchange of correspondence with the Respondent, initiated by the Complainant, the Respondent offered to sell the Domain Name together with all associated assets to the Complainant for £100,000. Since, as the Panel has found, there is no basis for alleging that the acquisition of the Domain Name by the Respondent was abusive, there can be no question of the Respondent having acquired the Domain Name for the primary purpose of selling it to the Complainant for an excessive consideration.

For the reasons set out above, the Panel finds that the Complainant’s evidence of abuse is far from persuasive, and that it has failed to show on the balance of probabilities that the Domain Name in the hands of the Respondent is an Abusive Registration.

10. Reverse Domain Name Hijacking

Finally the Respondent has accused the Complainant of Reverse Domain Name Hijacking (RDNH).

The Policy provides that RDNH “means using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name”.

Although the Complainant has failed to establish that the Domain Name is an Abusive Registration, it does not follow that the Complaint was made in bad faith. To support a finding of RDNH there needs to be evidence of some objectionable behaviour or motive on the part of the Complainant.

The Panel has found that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. The Panel is satisfied that, in all the circumstances of the case, it was reasonable for the Complainant to make a complaint under the DRS process in order to try and resolve the dispute. The Panel has not seen any evidence that the Complaint was brought in bad faith.

Accordingly, the Panel declines to make a finding of RDNH.

11. Decision

The Panel concludes that the Complainant has Rights in a mark which is similar to the Domain Name, but that it has failed to establish that the Domain Name is an Abusive Registration. Accordingly, the Panel upholds the original Decision and dismisses the Appeal.

Signed:
Ian Lowe

Dated: 17/05/2021

Signed:
Claire Milne

Dated: 17/05/2021

Signed:
David King

Dated: 17/05/2021