

DISPUTE RESOLUTION SERVICE

D00013710

Decision of Independent Expert

The Cabinet Office

and

Colette Ferrow

1. The Parties:

Lead Complainant: The Cabinet Office
70 Whitehall
London
SW1A 2AS
United Kingdom

Complainant: Driver and Vehicle Licensing Agency
Longview Road
Morrison
Swansea
West Glamorgan
SA6 7JL
United Kingdom

Respondent: Colette Ferrow
Dunstable Road
Redbourne
Herts
AL3 7PR
United Kingdom

2. The Domain Name:

dvla-driving-licence.co.uk

3. Procedural History:

The Expert can confirm that he is independent of each of the parties. To the best of his 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 in to question his independence in the eyes of one or both of the parties.

09 January 2014 10:12 Dispute received
09 January 2014 10:13 Complaint validated
09 January 2014 10:45 Notification of complaint sent to parties
10 January 2014 10:57 Response received
10 January 2014 10:57 Notification of response sent to parties
15 January 2014 01:30 Reply reminder sent
16 January 2014 15:46 Reply received
16 January 2014 15:47 Notification of reply sent to parties
21 January 2014 12:55 Mediator appointed
22 January 2014 11:48 Mediation started
13 February 2014 17:25 Mediation failed
13 February 2014 17:25 Close of mediation documents sent
24 February 2014 12:14 Expert decision payment received
20 March 2014 Expert's declaration of independence

4. Factual Background

The Complainants are The Cabinet Office and the Driver and Vehicle Licensing Agency ("DVLA"). The Cabinet Office is a department of the British government and the DVLA is an executive agency of the Department for Transport. The Cabinet Office is responsible for the operation of the official DVLA website. The DVLA is responsible for the granting and processing of driving licences in England and Wales and maintaining a record of driver endorsements, disqualifications and medical conditions.

The Domain Name was registered in the name of Peter Hall on 24 March 2013 and was transferred to Colette Ferrow, the Respondent, on 5 December 2013. The registrant type, according to the result of a WHOIS query, is recorded as "UK Sole Trader". The Complainants infer that the transfer was made as a result of a letter sent by their representatives to Peter Hall, the then registrant, on 26 November 2013.

Internet users are able to use the official DVLA website to apply for a driver's licence, change the address on their driver's licence, renew their driver's licence and replace a

lost, stolen, damaged or destroyed licence. The Domain Name is being used for the purposes of a website that offers the same services. The pricing model adopted by the Respondent is to charge a premium for the services which are either available free of charge or at a reduced fee when obtained directly from the official DVLA website.

5. Parties' Contentions

For the purposes of this section of the decision, the Expert has summarised the contentions of the parties but only insofar as they are relevant to the matters that the Expert is required to determine under the DRS Policy. In doing so, the Expert is at this stage making no findings of fact or passing any comment in relation to those contentions. The discussions and findings in relation to the evidence appear in section 6 below.

5.1 Complainant

The Complaint, so far as is material, is summarised below.

The Complainants are The Cabinet Office and the Driver and Vehicle Licensing Agency ("DVLA"). The Cabinet Office is a department of the British government and the DVLA is an executive agency of the Department for Transport within the British government. The Cabinet Office is responsible for the operation of the official DVLA website at www.gov.uk/government/organisations/driver-and-vehicle-licensing-agency.

The DVLA has been known as the "Driver and Vehicle Licensing Agency" since 1990. The DVLA is responsible for, amongst other things, issuing licences to drivers, maintaining and updating drivers' records and maintaining a record of driver endorsements, disqualifications and medical conditions in England and Wales. Many of these services can be accessed through the official DVLA website. Internet users are able to use the official website to change the address on their driver's licence, renew their driver's licence and replace a lost, stolen, damaged or destroyed licence.

Rights

The Complainants claim to have registered and unregistered rights in the mark DVLA.

Registered rights

The DVLA owns a number of trade mark registrations which include:

- trade mark registration UK00002297001 for DVLA (series of 4) in Classes 06, 09, 12, 16, 20, 25, 35 and 42; and
- trade mark registration UK00002297000 for the DVLA Triangle Device (series of 4) in Classes 06, 09, 12, 16, 20, 25, 35 and 42.

The applications for registration of these trade marks were filed on 3 April 2002 which pre-dates the registration of the Domain Name by at least 10 years.

Unregistered rights

The Complainants' website (www.gov.uk/government/organisations/driver-and-vehicle-licensing-agency) is the website for the DVLA and provides a variety of online services, including an online application system to enable users to apply for a driving licence, change the address on their driving licence, renew their driving licence and replace a lost, stolen, damaged or destroyed licence.

The Complainants have supported webpages regarding the DVLA's services on their website (whether at the above website or its predecessor) since at least May 2004. The DVLA also owns and maintains a registration of the domain name www.dvla.co.uk, which was registered before August 1996 and currently links through to the official website. The use and/or registration of these domain names pre-dates the date of the registration of the Domain Name.

Through their extensive use of the same since at least 1996 the Complainants have acquired a significant and valuable goodwill in connection with the DVLA mark, particularly (but not solely), in respect of the online dissemination of information regarding driving licences, and the processing and granting of driving licences. The goodwill and reputation of the Complainants in respect of the DVLA mark is protectable from damage caused by misrepresentation under the English common law tort of passing-off.

The Complainants are therefore the owners of significant reputation and goodwill in the UK in the mark DVLA, including for driving licence applications and ancillary services.

Abusive Registration

The Complainants submit that the Respondent registered or acquired the Domain Name in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainants' Rights. In particular, at the time that the Domain Name was registered or acquired, the Respondent:

- knew of the Complainants' driving licence related services and their DVLA mark;
- registered the Domain Name knowing that it would confuse consumers into believing that the Domain Name was connected to the Complainants in order to increase web traffic to the website by diverting it away from the Complainants;
- intended that the Complainants' customers seeking information on the Complainants' goods and services would be diverted away from the Complainant, such that its legitimate business would be unfairly disrupted.

The Respondent and use of the Domain Name

The Complainants became aware that the Domain Name was registered in the name of Peter Hall (the “Former Owner”) on 19 November 2013. The Complainants’ representatives wrote to the Former Owner on 26 November 2013 in order to try to resolve matters amicably with the Former Owner. However, the Former Owner has been unwilling to engage with the Complainants and has not responded to the Complainants’ representatives’ letter.

The Complainants’ representatives conducted a new WHOIS search which revealed that ownership of the Domain Name had changed and the Domain Name was registered in the name of the Respondent. According to the details on the WHOIS extract, the Respondent is a UK Sole Trader based in Alresford, Hampshire, UK.

The change of registrant appears to have taken place on 5 December 2013, nine days after the date of the Complainants’ representatives’ letter. It seems highly unlikely that this change of ownership is unrelated to receipt of the Complainants’ representatives’ letter, as the addresses for both the Former Owner and the Respondent have the same postcode and a search using Google Maps shows the postcode covers a very small area suggesting collusion between the Former Owner and the Respondent.

Use of the Domain Name

The website at the Domain Name (“the Website”) consists of several pages offering services for sale. These services purport to permit users to make online applications for a driving licence, to change the address on their driving licence, to renew their driving licence and replace a lost, stolen, damaged or destroyed licence, for an additional fee. These same services are offered by the Complainants free of charge or at a reduced fee.

Paragraph 3(a)(ii) of the Policy

The Complainants have no connection with the Respondent. The Respondent is not a licensee of the Complainants. The Complainants have never consented to the registration or use of the Domain Name by the Respondent. The Respondent does not have any legitimate interest in the Domain Name, particularly given that DVLA is a well-known brand in relation to the services on offer, including (amongst other services) online applications to enable users to apply for a driving licence, change the address on their driving licence, renew their driving licence and replace a lost, stolen, damaged or destroyed licence, and is a distinctive mark registered and used by the Complainants.

Given the extent of the Complainants’ goodwill and reputation in the DVLA mark for services relating to driving licences, it is impossible to conceive of any good faith use of the Domain Name by the Respondent. The Complainants submit that:

- the Respondent will never be capable of using the Domain Name for a legitimate purpose as the notoriety of the Complainants’ DVLA mark is such that

consumers will always be confused into believing that there exists a connection between the Respondent, the Domain Name and the Complainants;

- the Domain Name was deliberately registered in order to confuse consumers into believing that the Domain Name was operated by, or connected to, the Complainants in order to increase web traffic to the Website and thereby increase the Respondent's revenue through the services offered; and
- the mere registration of the Domain Name indicates the Respondent's intention to confuse consumers into believing that there is a connection between the Domain Name and the Complainants.

The inclusion of the wording "Our service is not connected to or affiliated with the UK Government or Driving Vehicle Licence Agency [sic]" on the homepage of the Website does not serve to nullify or avoid the Respondent's use of the DVLA mark. The disclaimer on the Website is not prominent being buried in a long piece of small print text. The way it is displayed makes it less likely for a user to read, which in combination with the other factors discussed below, means that the presence of the disclaimer is not likely to prevent confusion.

The Domain Name is confusingly similar

The Domain Name comprises the DVLA mark in which the Complainants have Rights, along with the descriptive, non-distinctive words "driving licence". Driving licence applications and renewals are two of the areas in respect of which the Complainants provide services at their website.

Consequently, the incorporation of the words "driving licence" in the Domain Name directly describes the services provided by the Complainants and only serves to increase the likelihood of confusion between the Domain Name and the Complainants and their services. The Domain Name is therefore confusingly similar to the DVLA mark which is the subject of the Complainants' Rights.

Confusion of consumers

In full knowledge of the Complainants, the Complainants' Rights and the services offered at the Complainants' website, the Respondent registered the Domain Name with the deliberate intention of confusing UK consumers into believing that the Domain Name is connected to, or operated by, the Complainants, causing them to visit the website to which the Domain Name points, thereby increasing Internet traffic to the Website.

A consumer in search of the Complainants' services regarding driving licences is highly likely to enter the DVLA mark and the term "driving licence" into a search engine and to find the Domain Name as one of the search results. It appears that the Respondent has purchased relevant Google AdWords in order to ensure that it is the first sponsored result which is listed when entering search terms such as "DVLA driving licence" into the Google search engine. The combination of the Domain Name containing the DVLA

mark and also appearing as a top result in an Internet search on Google is highly likely to confuse consumers into believing that the Domain Name and the Website are in some way connected to the Complainants, particularly as many consumers are not aware of Google AdWords or how sponsored results are generated. Consumers will therefore click onto the Website in search of legitimate information and services endorsed by the British government regarding driving licences and instead would be directed to the Respondent's services and charged an additional fee for using such services thereby increasing the Respondent's revenue.

This confusion is enhanced as the link entitled "General Enquiries" on the Website's "Contact" page links directly to the Complainants' website. Furthermore the page entitled "Visit DVLA" on the Website also links directly to the Complainants website. These links further suggest a connection between the Respondent and the Complainants, particularly as the Respondent's Website does not contain any form of identification as to who operates the site. This appears to be deliberately vague so as to confuse users of the Website.

Until 17 October 2012 the Complainants provided their Internet services and websites under their DirectGov brand which included a well-recognised orange and white colourway branding. The DirectGov branded websites were hugely popular receiving over 20 million hits a month. After 17 October 2012 the Complainants rebranded their websites, however certain webpages at the Complainants' websites still redirect to webpages bearing the DirectGov orange and white branding.

In addition to using the DVLA mark in the Domain Name, the Respondent has also used the same orange and white branding on its Website. When comparing the screenshots there are many strong similarities between the Complainants' website and the Respondent's Website, (including an almost identical banner at the top of the page, in grades of orange, with white text overlay) signifying an effort and intention on the Respondent's part to enhance the confusion between the Website and the Complainants' website and indicate a connection between the Complainants and the Respondent.

There exists absolutely no logical reason for the Respondent to require a domain name containing the Complainants' trade mark, other than to confuse people into believing that the Domain Name is connected to the Complainants for the Respondent's own personal benefit and financial gain, for example, purportedly charging users of the Website's services £20.00 to change a name on a driving licence and £40.00 to change an address, when both services are provided free of charge through the Complainants' website.

Blocking registration and disruption of business

The Respondent was clearly aware of the Complainants and their Rights at the time of obtaining and registering the Domain Name. By registering the Domain Name the

Respondent has effectively blocked the Complainants from registering the Domain Name itself.

Consumers seeking the Complainants' service of providing and granting driving licence applications will be diverted away from the Complainants' own website to the Website, such that the Complainants' legitimate business will be unfairly disrupted.

The Complainants seek a transfer of the Domain Name.

5.2 Respondent

The Response, so far as is material, is summarised below.

The registration and use of the Domain Name does not breach any trade mark rights. The Respondent offers services over and above those offered by the DVLA and there are disclaimers on every page of the website which are not just in small print at the bottom of the page.

The website clearly offers working links if Internet visitors choose not to use the Respondent's services. The Respondent gets a lot of repeat business because the website offers 24 hour email support. The Respondent wrote to the Complainants' representatives several times and left at least 3 or 4 phones messages but did not hear back.

5.3 Reply

The Reply, so far as is material, is summarised below.

Trade Mark Infringement

The Respondent uses the Domain Name, which wholly contains the Complainants' DVLA mark (alongside the descriptive and non-distinctive words "driving" and "licence"), in respect of identical or highly similar services to those for which the Complainants' DVLA mark is registered which gives rise to a likelihood of confusion on the part of the relevant public, who are likely to believe (mistakenly) that there is a connection between the Respondent, its services and the Complainants. Indeed, the Complainants have received complaints from consumers who have actually been confused into believing that the Website is connected to or authorised by the Complainants. For these reasons, the Respondent's use of the Domain Name amounts to actionable infringement of the DVLA mark under section 10(2) of the Trade Marks Act 1994.

In addition, the Respondent's use of the Complainants' DVLA mark is without due cause, takes unfair advantage of and/or is detrimental to the distinctive character and/or repute of the Complainants' DVLA mark and therefore also amounts to actionable infringement of the DVLA mark under section 10(3) of the Trade Marks Act 1994.

In light of the Complainants' extensive goodwill in the DVLA mark, the Respondent's use of the DVLA mark is highly likely to lead to consumers being deceived into falsely believing that the Respondent is one and the same as, or is otherwise connected with or authorised by, the Complainants which will lead to damage to the Complainants' goodwill and amounts to actionable passing-off.

Consequently, the Respondent's use of the Complainants' DVLA mark clearly infringes the Complainants' rights in its trade marks and goodwill.

Disclaimers

The Respondent states in the Response that "all the disclaimers are on every page of our website and not just in small print at the bottom of the page." The Complainants submit that this statement is incorrect. There is a small disclaimer on the identical web pages entitled "Home", "Apply" and "Driving Licences" at the Website. The other web pages at the Website do not contain an express disclaimer.

Although the web page entitled "Privacy Policy" states that the Website contains links to other sites which the Website operator does not have control over, the general non-specific nature of the wording does not enable a customer to understand that the Respondent and/or the Website is not connected to the Complainants. Indeed, customers would first need to realise that they are in fact clicking on a link to a third party website, which is not apparent from the way in which the Respondent provides the link to the Complainants' website (by clicking on the web page tab entitled "Visit DVLA" on the Website, which one assumes will lead to a description of the Respondent's premises given that it calls itself "DVLA-driving-licence.co.uk" on the Website). It is therefore wholly ineffective as a disclaimer.

Similarly, the web page entitled "Terms and Conditions" states: "11.5.4 You understand that you are able to make applications for a Driving Licence independently without incurring a service; 11.5.5 You understand that the Service Charge is for the Service provided to You by and such Service Charge is payable to and not the DVLA; and 11.5.6 You understand that is an independent private business and is not in any way affiliated with or forms part of the Visa Office" [sic]. These statements are wholly unclear. Importantly, they do not provide crucial information such as who is providing the service and who the charge is payable to and are not, therefore, effective disclaimers.

Furthermore, both the statements on the "Privacy Policy" and "Terms and Conditions" web pages are buried at the end of the relevant web pages and not easily noticeable.

Contact with the Complainants' representatives

The Complainants' representatives have received no telephone messages or written correspondence from the Respondent or the Former Owner.

6. Discussions and Findings

General

The lead Complainant is The Cabinet Office and the second Complainant is the DVLA. For the purposes of this decision, where the context admits, the Complainants collectively are referred to as the Complainant.

In order for the Complainant to succeed it must prove to the Expert, on the balance of probabilities, that:

“it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

the Domain Name, in the hands of the Respondent, is an Abusive Registration.”

The meaning of ‘Rights’ is defined in the Policy in the following terms:

“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.”

An Abusive Registration is defined in the Policy as follows:

“Abusive Registration means a Domain Name which either:

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

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

A non-exhaustive list of factors which may be evidence of an Abusive Registration is set out in paragraph 3 of the Policy. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is set out at paragraph 4 of the Policy.

Complainant's Rights

The Complainant has produced copies of trade mark registrations UK00002297001 and UK00002297000 and these are evidence that the DVLA has registered rights in the mark DVLA.

The Complainant also claims to have unregistered rights in the mark DVLA through extensive use of that mark since 1996 in respect of the online dissemination of information regarding driving licences and the granting and processing of driving licences. The WHOIS result shows that the DVLA registered the domain name <dvla.co.uk> prior to August 1996. The Expert is satisfied, on the balance of probabilities, that the DVLA has both registered and unregistered rights in the mark DVLA. The mark and the Domain Name are similar as the Domain Name consists of the distinctive mark DVLA with the addition of two hyphenated words “driving” and “licence”, which are non-distinctive.

The Complainant has therefore satisfied the Rights test.

Abusive Registration

The Complainant relies upon three of the factors set out in paragraph 3 of the Policy in support of the assertion that the Domain Name is an Abusive Registration. The most developed argument is one of confusion under paragraph 3(a)(ii) of the Policy but the Complainant also relies upon paragraphs 3(a)(i)B and 3(a)(i)C, being a blocking registration and unfair disruption respectively. The Complaint, Response and Reply include some analysis of the law of registered trade marks and reference is made, in the Complaint, to a number of cases determined by WIPO under the Uniform Domain Name Dispute Resolution Policy (“UDRP”). However, the tests that apply to trade mark infringement and under the UDRP are not the appropriate tests for these purposes and the Expert has confined this decision to an analysis of whether the definition of Abusive Registration, as set out in the DRS Policy, has been satisfied.

Paragraph 3(a)(ii)

The Complainant contends that the Respondent’s website is, in effect, a copycat website that is designed to hoodwink those searching online for the driving licence services of the DVLA into paying more than they need for those services. The Respondent contends that she operates a legitimate business model providing a service of value to Internet customers and that any confusion is avoided through the use of disclaimers and links to the official DVLA website.

It is clear on the evidence that there is no commercial connection or affiliation between the parties. The question, under paragraph 3(a)(ii) of the Policy, is whether the Respondent is using the Domain Name in a way which has confused, or is likely to confuse, internet users into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected to the Complainant? The Experts’ Overview (“the Overview”) includes a helpful analysis of what is meant by confusing use and it says the following:

“The ‘confusion’ referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name.”

Actual confusion

Has the Domain Name been used in a way that has led to confusion as to the identity of the person/entity behind it? The Complainant says it has and points to evidence to demonstrate that actual confusion has taken place on at least one occasion. It has produced a series of emails from a third party, whose name has been redacted. In an email dated 25 December 2013 the writer of the emails states:

“It seems I have been the victim of a fraudulent web site that acts as an intermediary for online applications. I was obviously duped, and am both embarrassed and angry.”

In an email dated 4 January 2014 the writer states:

“I was unaware that I had been scammed. The site in question is plainly fraudulent.”

The writer of these emails specifically identifies the Domain Name and the evidence strongly suggests that the writer purchased a service from the Respondent in the mistaken belief that he was dealing with the official DVLA website. The Expert is satisfied, on the balance of probabilities, that actual confusion has taken place on at least one occasion.

Likelihood of confusion

The Complainant also contends that confusion is likely to occur and, in support of that contention, relies upon the following factors:

- the notoriety of the mark DVLA which means that confusion is inevitable;
- the way that information is presented on the website implies there is a connection;
- the look and feel of the website is similar to that previously adopted by the Complainant;
- the use by the Respondent of sponsored AdWords; and
- the fact that the website does not contain any information identifying the person or entity behind the Domain Name.

The Respondent expresses her belief that the registration and use of the Domain Name does not breach any trademark rights but, of course, that is not the relevant test for determining whether a Domain Name is an Abusive Registration. She points out there are disclaimers on every page of the website which are not just in small print at the bottom of the page and that there are clear links to the official DVLA site if Internet visitors choose not to use the Respondent's services. The Respondent claims that the website gets lots of repeat business but has not produced any evidence in support of that contention.

It could be argued that the very existence of disclaimers and links to the official DVLA website is a tacit acceptance by the Respondent that some connection to the Complainant is implied by registration and use of the Domain Name. However, that is insufficient by itself to satisfy the burden of proof, which rests with the Complainant and the Expert therefore turns to consideration of the relevant evidence.

Distinctiveness of the Complainant's mark

DVLA is an acronym of the Driver and Vehicle Licensing Agency and it has become highly distinctive of, and it cannot sensibly refer to anyone other than, the second Complainant. If the Respondent had registered or acquired a domain name consisting of the mark DVLA without adornment it would have created a serious risk of confusion in the minds of Internet users and it would have been a classic case of initial interest confusion. The Overview puts it in these terms:

“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

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.”

In this case, the Domain Name contains two additional hyphenated words but is that sufficient to negate the likelihood of confusion? The words chosen are non-distinctive and generic.

In DRS 07991, the appeal panel considered whether the domain name <toshiba-laptop-battery.co.uk> created the false impression of a commercial connection between the parties. In the absence of a Response, there was no dispute as to the following facts:

- the Respondent had used the Domain Name for the purposes of a website carrying on a business under the name toshiba-laptop-battery.co.uk;
- the website offered for resale a mix of what the Complainant appeared to accept were genuine Toshiba goods as well as products that were said to be compatible with the Complainant's goods;

- the Respondent also offered goods of the Complainant's competitors on its website; and
- the Respondent had no commercial connection or affiliation with the Complainant.

So far as the name itself was concerned, the majority panel decided that the domain name fell into a very different category from cases involving the "unadorned" use of a trade mark (e.g. <toshiba.co.uk>), where Internet users may be presumed to believe that the name belongs to or is authorised by the complainant. In the view of the majority panel, the two extra hyphenated words turned the domain name as a whole into a rather clear description of the main goods on offer at the website (replacement batteries for Toshiba laptop computers). The minority panellist felt that, notwithstanding the addition of the two extra words, this was still a case of initial interest confusion. An aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell, in addition to the Complainant's goods, goods competing with the Complainant's goods and that is what led to a finding of abusive registration in the case.

Each case turns on its facts and it is the Expert's view that the addition of the words "driving" and "licence" to the highly distinctive mark DVLA does not avoid the likelihood of confusion in this case. The addition of the words turns the domain name as a whole into a rather clear description of the services offered by the DVLA which, if anything, increases the likelihood of confusion. Unlike the *Toshiba* case, this is not a dispute between a manufacturer and a reseller of genuine accessories for that manufacturer's branded products. If you wanted to set up an online service designed to assist those who wish to apply for, or replace, a driving licence you could do so without including the name of the issuing authority in the domain name. The DVLA is the only issuing authority for these purposes and so inclusion of the mark DVLA does not serve to distinguish it from any other issuing authority of driving licences.

An Internet user who is looking to apply for, or replace, a driving licence may well put the words DVLA, driving and licence into a search engine given that applications in relation to driving licences are one of the functions performed by the DVLA. In such a case, a speculative visitor to the Respondent's website will be visiting it in the hope or expectation that it is connected to the Complainant. As the Overview points out, the activities of people who attach as appendages to the Complainant's mark a word appropriate to the Complainant's field of activity are generally condemned, see for example the appeal decision in DRS 00248 <seiko-shop.co.uk>.

The insertion of the highly distinctive mark DVLA followed by two non distinctive-words that relate to the Complainant's field of activity into the Domain Name has one purpose only and that is to create the false impression of a connection to the official issuing authority. Even if Internet visitors work out, when they look at the website, that there is no connection to the DVLA, they have still been deceived by the choice of words that have been registered as the Domain Name.

The transfer of the Domain Name to the Respondent does not prevent a finding of Abusive Registration. This is a case of initial interest confusion both at the date of registration of the Domain Name and at the date of acquisition of the Domain Name by the Respondent. When one comes on to consider the use to which the Domain Name has been put, both before and after the transfer to the Respondent, one is left with the very clear impression that the intention was to create the false impression of a connection to the DVLA. The Respondent did not, in her Response, attempt to disassociate herself from the activities of the original registrant but instead attempted to justify the use to which the Domain Name has been put.

The website

The Respondent offers a service on the website which it describes in the following terms:

“Whether you need to replace a lost or damaged driving licence, update your existing one, or apply for a new provisional or full licence, you can do so quickly and easily via our secure online service.

Please start your search by selecting the type of licence you need:”

There is a pricing page on the website which lists the following charges:

- Provisional Licence: £90
- Change of Address on Licence: £40
- Change of Name on Licence: £20
- Replacement of Licence: £60
- Replacement of Licence(70+): £40
- Change the photo on your Driving Licence: £70
- Exchange paper licence for a photo card: £40
- Renew your driving licence (10 year replacement): £70

A number of these services are provided free of charge on the official DVLA website, including a change of name or address and the replacement of a licence for someone aged 70 or over. All of the other services listed above cost £20 on the official DVLA website, save for a provisional licence which costs £50. The Respondent’s business model is to charge an enhanced fee which is said to be justified on the basis that it offers additional benefits. There are a number of additional benefits described on the home page and the one the Respondent chose to highlight in her Response was 24 hour email support. There is nothing objectionable per se about offering a value added service to the public as long as those who purchase that service are not misled into thinking they are dealing with the official body. If they have been misled then they will not have made an informed decision to pay the enhanced fee.

There is a webpage on the website headed “Contact” which divided into two sections. There is a section dealing with order enquiries which is for use once a visitor has

submitted an application through the website and therefore has an order number. For all other enquiries, the visitor is invited to click on a link which takes them to the official DVLA website at <https://emaildvla.direct.gov.uk/emaildvla/cegemail/dvla/en/index.html>. There is also a link on the top navigation bar entitled "Visit DVLA" which links through to the official DVLA website. The fact that a visitor is invited to contact the DVLA if they have a query simply increases the chances that someone will be confused as to the identity of the person or entity behind the website. It implies there is a connection to the DVLA or that the website is authorised in some way by the DVLA.

The website does not contain any company information such as the business name, place of registration, registered number or registered office address of the entity behind it. The privacy policy webpage suggests that the business name is dvla-driving-licence.co.uk but that does nothing to inform Internet users in a way that might avoid confusion.

The Complaint also seeks to rely upon the fact that the Respondent has used an almost identical banner at the top of the home page, using grades of orange with white text overlay, as was used until October 2012 by the Complainant under the DirectGov brand. Whilst the Complainant has rebranded its websites, it has produced evidence that shows that some of the webpages at the Complainant's websites still redirect to webpages bearing the DirectGov branding. The Complainant has provided screenshots and the look and feel of the webpages on the website operated by the Respondent and those that adopt the DirectGov branding is similar in a number of respects. In addition to using a similar banner at the top of the web page, the Respondent has included a left hand navigation box which uses very a similar colour to that used in the case of the DirectGov branding. This is further evidence of an intention to confuse internet visitors.

Google AdWords

The Respondent contends that the Respondent has purchased relevant Google AdWords in order to ensure that the website is the first sponsored result which is listed when entering the search term "DVLA driving licence" into the Google search engine. The Complainant has produced screenshots which show the results of a search in the Google search engine. The first result, which appears to be a sponsored ad, against the term "DVLA driving licence" is the website connected to the Domain Name.

The search results produced by the Complainant have the following heading:

"DVLA – Driving Licence – Apply/Renew Licence with DVLA."

This clearly implies that the website is authorised by, or connected with, the DVLA.

Presence of disclaimers

The Respondent points to the presence of disclaimers on the website which she says "are on every page of our website and are not just in small print at the bottom of the

page.” The disclaimer is not, contrary to the Respondent’s assertion, on every page of the website. It does not appear on the pages headed “Privacy Policy”, “Prices” or “Order Enquiry.”

The following information does appear on the identical web pages entitled “Home”, “Apply” and “Driving Licences”:

“Our service is not connected to or affiliated with the UK Government or Driving Vehicle Licence Agency and acts as an agent processing the application. These services are available from other government sources for no fee.”

The information is presented after the invitation to start a search by selecting the type of licence and is presented in a long block of text that includes reference to the terms and conditions and the Data Protection Act. It is not a particularly prominent disclaimer. The question is whether the presence of such a disclaimer is sufficient to avoid the likelihood of confusion? The answer is plainly no given the finding of actual confusion above and, in any event, even if it is apparent to some visitors that the website is not connected to the Complainant, the visitor has already been deceived by the Domain Name.

The Expert’s reading of the evidence is that the presence of the disclaimer is a spurious attempt by the Respondent to try and defend herself against the suggestion that Internet users are likely to be confused, rather than a genuine attempt to avoid that confusion. The evidence pointing to the fact that the primary motivation behind the Domain Name was, in fact, to cause confusion is considerable. The actions of the Respondent, and those of the original registrant (which the Respondent has in effect attempted to justify), are consistent only with an intention to encourage, rather than dispel, confusion in the minds of Internet users, including the Domain Name itself, the way in which enquiries are directed, the use of AdWords and how search results are presented, the similar look and feel and the presence of links to the official DVLA website. It is telling that efforts have been made to ensure that the true identity of the person or entity behind the Domain Name is not revealed. If one wanted visitors to be clear that the website was operated by a person or entity other than the DVLA it would have been a simple task to identify that person or entity. The Respondent, when confronted with this point in the Complaint, chose to not to respond to it in her Response. As set out above, there is also evidence of actual confusion.

Conclusion on paragraph 3(a)(ii)

It is clear to the Expert that the Respondent intended to create the false impression that there was a connection between the services offered on the website and the Complainant. She became the registrant of a Domain Name which consists of the highly distinctive mark DVLA together with two descriptive words that are appropriate to the Complainant’s field of activity. The Respondent has been using the Domain Name to operate a website that has been designed to increase the chances that Internet visitors will be confused and the Respondent decided to conceal the identity of the

person or entity behind the Domain Name. The attempt to drive Internet traffic to the Respondent's website in this way very clearly takes unfair advantage of the Complainant's rights and is an Abusive Registration.

Paragraph 3(a)(i)C – unfair disruption

The Expert has made a finding that actual confusion that has taken place on at least one occasion and it seems likely that it will have occurred on other occasions and this unfairly disrupts the Complainant's business. It creates dissatisfaction with the DVLA and it has led to at least one request, by the writer of the emails referred to above, for assistance from the DVLA in ensuring that the website is closed down and a request for information about the people behind the website. The Expert finds that the Complainant's case under paragraph 3(a)(i)C is also made out.

Paragraph 3(a)(i)B – blocking registration

The Expert is not satisfied that the primary motivation in acquiring the Domain Name was as a blocking registration. Whilst it is clear that the Respondent was aware of the Complainant's rights in the mark and the registration of a particular domain name inevitably blocks any other party from registering that name as a domain name, the motivation was not to block the Complainant but to confuse the public. In light of the above findings of Abusive Registration, nothing turns on this particular finding.

7. Decision

For the reasons set out above, the Expert is satisfied on the balance of probabilities that the Complainant has rights in a name which is similar to the Domain Name and the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that the Domain Name is transferred to the lead Complainant.

Signed

Dated 21 March 2014

Andrew Clinton