

DISPUTE RESOLUTION SERVICE

D00017574

Decision of Independent Expert

Unbiased Ltd

and

Accountant Brokers Ltd

1. The Parties:

Complainant: Unbiased Ltd
Unbiased Ltd
12-14 Berry St
London
EC1V 0AU
United Kingdom

Respondent: Accountant Brokers Ltd
36 Esher Green
Esher
Surrey
KT10 8AF
United Kingdom

2. The Domain Name:

<unbiasedfinancialadvisors.co.uk> (“the Domain Name”)

3. Procedural History:

07 June 2016 16:58 Dispute received
08 June 2016 09:28 Complaint validated
08 June 2016 09:28 Notification of complaint sent to parties
23 June 2016 08:18 Response received
23 June 2016 08:18 Notification of response sent to parties
28 June 2016 02:30 Reply reminder sent
01 July 2016 12:04 No reply received
01 July 2016 12:04 Mediator appointed
11 July 2016 15:39 Mediation started
12 July 2016 14:30 Mediation failed
12 July 2016 14:31 Close of mediation documents sent
22 July 2016 02:30 Complainant full fee reminder sent
22 July 2016 11:30 Expert decision payment received

I, Tony Willoughby, the undersigned Expert, 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. Factual Background

The Complainant, which was incorporated in December 2008 acquired the business of its predecessor, IFA Promotion Limited, by way of a management buy-out in 2010. The Complainant trades online in the United Kingdom *via* its website connected to its <unbiased.co.uk> domain name, a domain name which was registered by its predecessor on 8 July 1999. It provides for consumers a list of professional advisers (mortgage advisers, lawyers and accountants), most of whom are financial advisers, the details of whom it claims to have verified with their various professional and regulatory bodies.

The business has operated continuously *via* its <unbiased.co.uk> website since its foundation in 1999. The Complainant has produced substantial evidence as to its high profile in the marketplace.

The earliest of the Complainant's trade mark registrations is for its original logo (no longer used) comprising a roundel and the domain name <unbiased.co.uk> in a stylized form. It is UK registration no. 2422000 filed on 17 May 2006 for goods and services in classes 9, 16, 17, 18, 21, 25, 27, 35, 36 and 41. It has now expired. The next in time is for another logo featuring a four coloured dot device and the <unbiased.co.uk> domain name. It is UK registration no. 3012853 filed on 5 July 2013 for goods and services in classes 16, 35 and 36. The latest is for the domain name <unbiased.co.uk> as a word mark. It is UK registration no. 3017515 filed on 9 August 2013 for goods and services in

classes 16 and 35.

In 1999 the Respondent incorporated his company under the name Accountant Brokers Limited, its purpose being to obtain clients for local chartered accountants. In 2000 he introduced a specific service for Independent Financial Advisers using a website connected to the domain name <ifabrokers.co.uk>. That service continued under that name until early May 2016 when he changed the name of his company to Unbiased Financial Advisors Limited.

The Domain Name was registered on 4 January 2012 and a week later on 11 January 2012 the Respondent registered the domain name <unbiased.uk.com>.

On 15 January 2015 the Complainant filed a complaint against the Respondent under the CentralNic Dispute Resolution Policy with the National Arbitration Forum (FA 1501001599868) in respect of the domain name, <unbiased.uk.com>. The complaint succeeded. The panelist found that that domain name had been registered by the Respondent in bad faith to exploit the reputation and goodwill of the Complainant. The domain name, <unbiased.uk.com> was ordered to be transferred to the Complainant.

On 21 December, 2015 the Complainant filed a complaint under the Policy (D16735) against an unrelated third party in respect of the domain name <unbiasedfinance.co.uk>, which had been registered on 8 September 2011. The complaint succeeded. The expert found that the domain name in the hands of the registrant was an Abusive Registration and directed that the domain name be transferred to the Complainant.

5. Parties' Contentions

The Complainant

The Complainant contends that it has rights in a name or mark which is confusingly similar to the Domain Name.

The Complainant further contends that in the hands of the Respondent the Domain Name is an Abusive Registration in that it was registered and is being used to take unfair advantage of the Complainant's rights. The Complainant states: *"The registrant is relying on diverting our legitimate traffic by confusing consumers into visiting his own website."*

The Respondent

The Respondent denies the Complainant's contentions.

The Respondent draws attention to the fact that the word "unbiased" is an ordinary dictionary word as are the words "financial" and "advisors". The Respondent contends

that the combination represented in the Domain Name is apt to describe the business of his company and is also his company name.

The Respondent states that he decided to adopt the word “unbiased” following a change in the law in 2013 which led to financial advisers being divided into two categories, “independent” and “restricted”. He serves independent financial advisers who, unlike restricted financial advisers, are necessarily unbiased, being required to put their clients first, charging a pre-agreed fee, and are debarred from receiving commissions.

The Respondent contends that the word “independent” does not adequately indicate to consumers that independent financial advisers are necessarily unbiased.

The Respondent asserts that he was not alone in taking this approach and points to other similar domain names such as <unbiasedifa.co.uk>, <unbiased-advice.co.uk>, <unbiasedfp.co.uk>, <unbiasedfinance.com>, <unbiasedfinancialplanning.co.uk> and <unbiasedfinanciable.co.uk> registered by competitors.

The Respondent contends that his company’s website is entirely different from that of the Complainant. He points to the fact that his company’s “UFA” logo is entirely different, that the look and feel of the two sites are very different and that the two companies operate very differently. A visitor to his company’s website receives a specific recommendation for a local Independent Financial Adviser, whereas a visitor to the Complainant’s website is faced with a list from which the visitor is left to make a selection. Moreover, the list of advisers on the Complainant’s website include mortgage brokers, lawyers and accountants many of whom will not be unbiased in the sense that they will not meet the requirements required of Independent Financial Advisers.

The Respondent contends that nobody will be confused.

For completeness I should add that the Response contains allegations that the manner in which the Complainant is using its domain name contravenes certain regulatory provisions, but he does not expand on the topic in any detail. In any event the allegations are irrelevant to the matters that I have to decide under the Policy.

6. Discussions and Findings

General

Pursuant to paragraph 2.a.i of the Policy to succeed in this Complaint the Complainant must prove to the Expert on the balance of probabilities that:

- I. it 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

“Abusive Registration” is defined in paragraph 1 of the Policy as 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. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Preliminary matters

The Complaint names Accountant Brokers Limited as the Respondent, it being the entity appearing as the registrant of the Domain Name on the Nominet Whois database and the user of the Domain Name. However, the Response has been filed by a Mr Anthony Foulger who is a director of and the moving force behind the Respondent company. Mr Anthony Foulger names himself as the Respondent. In substance it matters not whether I treat Mr Foulger or his company as the Respondent. For all practical purposes they are one and the same. Since Mr Foulger takes personal responsibility for the Response and the actions of his company I treat him as the Respondent, but in so doing all references herein to “the Respondent” include the company where appropriate.

It is also to be noted that the Nominet Whois database record has not been kept up-to-date as Accountant Brokers Limited underwent a name change in early May this year and is now named Unbiased Professional Advisors Limited, but nothing turns on this.

Rights

The Respondent does not dispute that the Complainant has registered trade mark rights in respect of the Complainant’s domain name, <unbiased.co.uk>. Accordingly, the sole issue under this element of paragraph 2.a.i of the Policy is as to whether or not the Complainant’s unbiased.co.uk trade mark is identical or similar to the Domain Name.

The only difference between the Complainant’s trade mark and the Domain Name is the addition of the words “financial” and “advisors” at the third level of the latter. Given that these words describe an important element of the Complainant’s business which it conducts *via* its <unbiased.co.uk> domain name, the Expert has no hesitation in finding that the Complainant’s trade mark is similar to the Domain Name.

Abusive Registration

Paragraph 3 of the Policy features a non-exhaustive list of factors, which may be evidence that a domain name is an Abusive Registration.

Those factors include at paragraph 3.a.ii of the Policy:

“ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;”

The Domain Name is the Complainant’s domain name, <unbiased.co.uk>, which is registered as a trade mark in the UK, with the addition of a description of the principal area to which the Complainant’s business is directed, namely “professional advisers”. The risk of confusion is obvious, at any rate for people who are aware of the Complainant’s business and the name under which and the domain name through which it trades.

The Respondent contends that such people are few and far between. Indeed, he puts it at “maybe 1 in ten thousand of the UK population may have just about heard of them”. In my view, that is an unrealistic approach. The correct approach is to look at the Complainant’s position in the much smaller, specialist marketplace in which the parties’ compete. For completeness, I should add that there is no dispute between the parties that they are in competition with each other.

The evidence submitted by the Complainant demonstrates to my satisfaction that it is very well-known in that marketplace, featuring as it does on the websites of a large number of reputable, high profile organisations (including charities) operating in the financial services industry as a recommended destination for people looking for independent advisers. Examples provided in the annexes to the Complaint are The Pensions Regulator, the Pensions Advisory Service, the Money Advice Service, Age UK, Shelter, Citizens Advice Bureau, Standard Life, Aviva, Legal & General, Scottish Widows and Prudential. In addition, the Complainant has produced numerous examples of press references to research that the Complainant has undertaken, particularly in the field of pensions.

I am satisfied that the Complainant has a very high profile in the field in which the parties compete and that the inevitable confusion resulting from the similarity of the parties’ domain names will be substantial; in other words not at a level to be ignored.

Defences

Paragraph 4 of the Policy sets out a non-exhaustive list of factors, which may be evidence that the Domain Name is not an Abusive Registration. Those potentially applicable here are that before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), (a) the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services; (b) the Respondent has been commonly known by the name or legitimately

connected with a mark which is identical or similar to the Domain Name; (c) the Domain Name is generic or descriptive and the Respondent is making fair use of it.

The Respondent contends that in pursuing this Complaint and seeking to monopolise an ordinary dictionary word, apt for use in the business area in which the parties operate, the Complainant is “blatantly trying to stop all fair competition”.

The Respondent contends that all three of the ‘defences’ cited above from paragraph 4 of the Policy are applicable in this case. He states that he adopted the word “unbiased” for use in his company name and the Domain Name for a legitimate reason (following the change in the law in 2013 the word “independent” is insufficient to get across to the public that Independent Financial Advisers must be unbiased) and that he is using the Domain Name in connection with a genuine offering of services. He points out that the Domain Name reflects his company name, Unbiased Financial Advisors Limited (formerly Accountant Brokers Limited). He also argues that the Domain Name is descriptive and that he is making fair use of it.

My conclusions

The Respondent registered the Domain Name on 4 January, 2012. A week later on 11 January, 2012 the Respondent registered the domain name <unbiased.com.uk>. In January 2012 the Respondent was aware that one of his principal competitors was the Complainant, Unbiased Limited, and that that company traded *via* its <unbiased.co.uk> website. To my mind it is inconceivable that in registering <unbiased.com.uk> the Respondent was not deliberately targeting the Complainant and must have known that the use of that domain name would lead to substantial confusion. In my view, the Domain Name, registered one week earlier falls into the same category.

I am also of the view that in adopting the company name, Unbiased Professional Advisors Limited in May this year, the Respondent’s eyes were wide open to the risk of consumer confusion. The risk must have been obvious to him but, by then, if he needed it, he had the benefit of the panelist’s decision in the National Arbitration Forum case involving the <unbiased.uk.com> domain name (see section 4 above) in which the panelist made very clear his views that the registration and use of that domain name by the Respondent was in bad faith. Interestingly, while the case is referred to in the Complaint, the Respondent makes no mention of it.

The Respondent seeks to take the benefit of paragraph 4.a.i.B of the Policy, a defence based on his company having been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name. However, that defence is only applicable where the name by which the respondent is commonly known predates his becoming aware of the complainant’s cause for complaint, which manifestly is not the case here.

To my mind the adoption of a highly confusingly similar domain name for use in competition with another trader operating in precisely the same field is, on its face, an

abusive act. For it to constitute a use in connection with a genuine offering of services, there would have to be a reason why in practice confusion would be unlikely; alternatively, the other trader would have to be found to be the author of his own misfortune by the selection of a name calculated to lead to confusion in the future.

I have already stated that I cannot see how confusion could not occur. The Complainant's name is well-known in the field and Internet users directed to the Complainant's website might well on seeing the Respondent's URL mistake it for the Complainant's on the basis of imperfect recollection. If they are first time visitors, the fact that the parties' websites are dissimilar will not alert visitors to the error.

It is true that it is difficult for a trader to monopolise the use of descriptive dictionary words, but it can be done. Bank of Scotland, British Gas, Vanish are all examples. In this case I have concluded that the Complainant had done enough by 2015 (the Domain Name was registered on 4 January 2015) and certainly by 6 May 2016, the date that he changed the name of his company to Unbiased Financial Advisors Limited, to have acquired a secondary meaning in respect of the word "unbiased" in its field of operation and particularly in the context of a domain name in the ".co.uk" domain. In other words, by the time that the Respondent adopted the word for the Domain Name and subsequently for his company name the descriptive value of the word in the field in which the parties operate had been displaced. It had become distinctive of the Complainant.

I note that the panelist in the National Arbitration Forum case referred to above came to the same conclusion as did the Expert in DRS 16735 *Unbiased Limited v. Sidstone Financial Services* (8 March, 2016) who put it thus:

"In this regard, the Expert is satisfied that the Complainant has built up a substantial reputation in the UK in the area of personal finance using the trade mark UNBIASED.CO.UK (and thus this term has become a distinctive identifier associated with the Complainant and its services and has acquired the necessary secondary meaning, even though the main word element, "unbiased", is also an ordinary English word)."

I also have to say that I find the Respondent's justification for having selected the word "unbiased" unconvincing. He says that it stems from a change in the law introduced in 2012 and which came into effect on 1 January, 2013. He does not exhibit the law or any section of it, nor does he expressly state that the law makes any mention of the word "unbiased". Moreover, in registering the Domain Name and the domain name <unbiased.com.uk> in early January 2012, he either anticipated the law "introduced in 2012" or was exceptionally quick off the mark, yet he left it for another 4 years before he adopted his current company name. I have to say that for me his registration of <unbiased.com.uk> at the same time that he registered the Domain Name exposes his real motive. If it were otherwise I would have expected him to have dealt properly in his Response with the National Arbitration Forum

decision and the circumstances leading up to the registration of both those domain names. The silence was deafening.

In further support of this justification for having adopted the “unbiased” name he states in the Response: *“Many of our competitors took the same approach as a result of this new law”* and cites several examples of other domain names featuring “unbiased”. He does not say who the registrants of those names are, nor how those names are being used. I have checked the list supplied by the Respondent and their dates of registration range from 2003 to 2014 and only one of them was registered post-2012 when the new law was first introduced. At all events, they do not support the Respondent’s argument.

I conclude on the evidence before me that the Respondent registered the Domain Name and has been using it *“in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant”* and find that the Domain Name in the hands of the Respondent is an Abusive Registration.

7. Decision

I direct that the Domain Name, <unbiasedfinancialadvisors.co.uk> be transferred to the Complainant.

Signed: Tony Willoughby

Dated 2 August 2016