COMPLAINANT
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vs.

RESPONDENT
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Before Edward C. Chiasson, Q.C., Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR on June 12, 2001 and, after review for administrative compliance, served on the Respondent on June 15, 2001. The Respondent did file a Response on or before July 3, 2001. I was appointed Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and Rules promulgated by the Internet Corporation for Domain Names and Numbers (“ICANN”).

BACKGROUND

The following information is derived from the Complaint.

The Complainant is a focused house builder operating in the United Kingdom (under the trading brands of Wimpey Homes and McLean Homes) and in the United States of America (under the trading brand of Morrison Homes). Several trade marks under the name "Wimpey" have been registered. Copies of the registrations have been filed in this proceeding. The company has been in existence since the 1880’s and entered the house building industry in the 1920’s. It now has a turn-over in excess of £1.7 billion (pounds sterling) and delivers approximately 13,500 units per year.
The subject domain name in dispute was registered by the Complainant in June 1996 and remained with the company until June 2000. The Registrar contends that notices of renewal were sent to the Complainant, but it has no record of the renewal invoices arriving. In the result, the subject domain name was released back as an available domain name in July 2000. Unknown to the Complainant, the subject domain name was acquired by Easily Limited, Tower 42, 25 Old Broad Street, London, England. It now is being advertised for sale through the internet site at www.easy4all.com. The subject domain name links directly to the Domain Names For Sale page at this site.

Contact with the Respondent has been through Mickey Wong. Mr. Wong has set up an e-mail redirection facility. This redirects all mail to himself. Anyone who uses wimpey.com in an e-mail does not get the e-mail rejected, instead it is gathered by Mr. Wong.

Mr. Wong contacted the Complainant on January 18, 2001 stating that he now owned the subject domain name and was receiving confidential e-mail including internal meeting notes. This last claim was untrue because all internal e-mail cannot get onto the internet. It stays on the Complainant's private system. The letter also offered to discuss the possibility of transferring the domain name back to the Complainant.

After a request from the Complainant to send examples of this “misdirected” e-mail it was informed on February 7, 2001 that all misdirected e-mail had been deleted. After referring to the fact that "...Wimpey [is] such a well-known name...", he stated also:

"...[domain names] have become something of a commodity, especially good dot com's being in extremely short supply. As with all commodities in short supply, there is the inevitable cost of acquiring them attached.

...if we can agree on a suitable price, then I'd be happy to have the domain name Wimpey transferred to George Wimpey."

Mr. Wong followed-up with an e-mail on February 14, 2001 asking whether the Complainant had decided what to do. On February 26, 2001, the parties conferred by telephone. Mr. Wong promised to discuss the subject internally in his organisation and said that he would write with a proposal in due course.

An e-mail was received on February 28, 2001 from Mr. Wong asking for £1.2 million to reregister the domain name, which was refused.

The following information is derived from the Response.

This is the second time the Complainant has brought this complaint. On the first occasion, it was not successful.

The Respondent concedes that the Complainant has registered trademarks for the word "WIMPEY", but notes that they are not exhaustive in connection with all classes of goods and services.
It is asserted that the "...Respondent has in fact never heard of Complainant's business" and that the Respondent "registered the name in order to provide email services to persons who share the common surname, Wimpey".

Upon the written submitted record including the Complaint and its attachments and the Response, I find as follows:

**FINDINGS**

Respondent’s registered domain name, wimpey.com, was registered with Globix (ISP) on June 12, 2000. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

(i) Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and  

(ii) Respondent has no rights or legitimate interests in respect of the domain name; and  

(iii) Respondent’s domain name has been registered and is being used in bad faith.

Paragraph 4(b) provides for the implication of evidence of bad faith in a number of circumstances:

(i) circumstances that indicate that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name;  

(ii) registration of the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct;  

(iii) registration of the domain name primarily for the purpose of disrupting the business of a competitor;  

(iv) by using the domain name, intentionally attempting to attract, for commercial gain, Internet users to the Respondent’s web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the web site or location or of a product or service on it or a location.
These are illustrative and do not represent the only circumstances from which may arise evidence of bad faith.

Reference is made to determinations by other ICANN administrative panels. The decisions of other administrative panels are neither binding on this administrative panel nor determinative of the issues that it must decide, but reference to them can be of assistance.

The resolution of this dispute takes place in the context of a consideration of the requirements of Paragraph 4(a) of the Policy.

IDENTITY/CONFUSING SIMILARITY: The Complainant asserts that it has rights to the word "Wimpey" and that the subject domain name is identical to it. The Respondent contends that the registrations are limited to certain classes and the name is a common surname.

The Respondent relies on the decision in the first case involving these parties (CPR0103-010515). At the outset it must be noted that the dismissal of the claim was expressly without prejudice to the Complainant's right to bring another complaint on better material. The Respondent does not take the position that the results of the previous proceeding bar the Complainant from bringing this case and I make no finding on its effect, if any, on the rights of the parties.

I do not know what information was provided to the previous panel. In this case, the Complainant has filed copies of registrations and has described its activities. I am satisfied that it has rights that meet the threshold requirement of Paragraph 4(a)(i).

Apart from the addition of dot com, the subject domain name is identical to the Complainant's mark.

Consideration of the scope of the classes covered and whether Wimpey is a surname are not relevant to a determination whether a subject domain name is identical. They might play a part in considering whether a domain name is confusingly similar, but that is not a matter that I need to review in this case.

I conclude that the registered subject domain name is identical to the Complainant’s protected mark.

RIGHTS AND LEGITIMATE INTERESTS: Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain name at issue.

UDRP Paragraph 4(c) provides that Respondent’s rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (b) Respondent has been commonly known by the domain name; or (c) Respondent is making legitimate noncommercial or fair use of the domain name, without intent for
commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent asserts that it registered the subject domain name to provide e-mail services to persons who share the surname, Wimpey. The assertion is not consonant with the contemporaneous communications between the parties. No such position then was advanced. The subject domain name resolves to a for-sale page at the Respondent's website. There is no information before me that supports the Respondent's contention.

Consideration of the Respondent's initial communication to the Complainant is instructive. Mr. Wong stated on January 18, 2001:

"You may be wondering how I came into such a position? [owning the subject domain name] Well, I recently saw this name on a list of expired and unclaimed domain names.

If your intention is to re-acquire [the subject domain name] and have it transferred into your ownership, then kindly let me know as soon as possible."

Neither in this communication nor in any other did the Respondent suggest that it wanted the subject domain name for the purpose it now asserts.

Concluding that the Respondent's contention is without merit does not fully satisfy the burden on the Complainant. I must consider whether the Respondent has a legitimate interest in the subject domain name based on the information overall.

There is no connection between the Respondent's business activities and the subject domain name other than listing it for sale. There is no connection between the Respondent's name and the subject domain name. It is clear to me on the information overall and I so find, that the Respondent acquired the subject domain name to sell it for "...valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name". That is not a legitimate interest.

I conclude that Respondent does not have rights or legitimate interests with respect to the subject domain name.

**BAD FAITH:**

The Complainant relies on the series of communications between it and the Respondent as establishing bad faith in the registration and use of the subject domain name. The Respondent points to the legitimate use of surnames, to the fact that it contacted the Complainant to advise that it was erroneously receiving e-mail and asserts that the information provided to the panel does not support a bad faith finding.

A finding that a Respondent has registered a domain name which is confusingly similar to the rights of a Complainant and that the Respondent does not have a legitimate interest in the domain name, does not lead automatically to a conclusion that the domain name was registered and used
in bad faith. Bad faith is a separate ingredient that a Complainant must establish, but it can do so relying on the evidence overall and on inferences that derive from that information and legitimately from other conclusions in the case.

The Respondent states that it has never heard of the Complainant's business. Not only is this contrary to the contemporaneous correspondence, it is inconsistent with the fact of life in the United Kingdom. I am entitled to take "judicial notice" of the fact that in that country at least, Wimpey is extremely well known and the Respondent resides there.

Acquiring a domain name for the purpose of selling it to an owner of trade mark rights for more than the legitimate costs of acquiring the domain name prima facie is information on which an inference of bad faith can be drawn. In this case, the evidence is overwhelming that this was the intention of the Respondent and it acted on it.

The Respondent contends that this is a case of "reverse domain name hijacking". I reject that assertion. The Respondent knew that Wimpey was a "well-known name". It found the subject domain name on a list of expired domain names. It then listed the name for sale, making no other evident use of it. Mr. Wong proffered advice to the Complainant on how it could protect itself in the future while he attempted to extract a very large sum of money from it.

I conclude that the Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy.

CONCLUSION

In light of my findings above that (a) the registered domain name is identical to the Complainant’s protected mark; (b) the Respondent does not have rights or legitimate interests with respect to the subject domain name; and (c) Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy, I find in favor of the Complainant.

REMEDY

Complainant’s request to transfer the domain name wimpey.com is hereby granted. The subject domain name shall be transferred to the Complainant, George Wimpey Plc.

Signature of Arbitrator

August 2, 2001