

# **DISPUTE RESOLUTION SERVICE**

**D00023035**

## **Decision of Independent Expert**

**Direct Wines Ltd T/A Laithwaites Wine**

and

**Gavin Newman**

### **1. The Parties**

Complainant: Direct Wines Ltd T/A Laithwaites Wine  
One Waterside Drive  
Arlington Business Park  
Theale, Reading  
Berkshire RG7 4SW  
United Kingdom

Respondent: Gavin Newman  
Blackwater  
Isle of Wight  
United Kingdom

### **2. The Domain Name**

<laithwaiteswine.uk>

### **3. Procedural History**

The Complaint was filed with Nominet on 26 September 2020. Nominet validated the Complaint and notified the Respondent of the Complaint by post and by email on 28 September 2020, informing the Respondent that the due date for submission of a Response was 19 October 2020.

The Response was filed on 1 October 2020. Nominet informed the Complainant that the due date for submission of a Reply was 8 October 2020. The Complainant filed a Reply on 8 October 2020.

The mediator was appointed on 8 October 2020. The informal mediation process started on 12 October 2020, but failed to produce an acceptable solution for the Parties, and so on 22 October 2020, Nominet informed the Complainant that it had until 5 November 2020 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Policy (the "Policy"). On 2 November 2020, the Complainant paid Nominet the required fee.

On 5 November 2020, the undersigned, Jane Seager (the "Expert"), confirmed to Nominet that she was independent of each of the Parties and that, to the best of her knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed which might be of such a nature as to call in to question her independence in the eyes of one or both of the Parties.

#### **4. Factual Background**

Incorporated on 8 February 1973, the Complainant is a mail-order and online retailer of wines and other alcoholic beverages in the United Kingdom. For use in connection with its wine-sales business operations, the Complainant has registered, *inter alia*, the following trade marks:

- United Kingdom Trade Mark No. UK00002237240, LAITHWAITES, registered on 1 December 2000;
- European Union Trade Mark No. 002032969, LAITHWAITES, registered on 3 February 2003; and
- United Kingdom Trade Mark No. UK00003240552, LAITHWAITES WINE REWARDS, registered on 22 September 2017.

The Complainant is also the registrant of a number of domain names comprising its LAITHWAITES trade mark, including <laithwaites.co.uk>, which resolves to an online store titled "Laithwaite's Wine", offering wine and other products.

The Domain Name was registered on 7 June 2020. The Domain Name resolves to a website titled "Laithwaites Wine" (the "Respondent's website"). The Respondent's website purports to offer wine and wine-related products for sale via the Internet. The footer of the Respondent's website reads "Laithwaites Wine Copyright © 2020. All rights reserved."

#### **5. Parties' Contentions**

##### **5.1. The Complaint**

The Complainant asserts rights in the LAITHWAITES and LAITHWAITES WINE REWARD trade marks. The Complainant argues that the Domain Name violates the Complainant's trade mark rights.

The Complainant asserts that the Domain Name resolves to what appears to be an Amazon Affiliate website, featuring a range of the Complainant's products, several of which benefit from trade mark protection themselves. The Complainant submits that

substantial efforts have been made to make the Respondent's website appear genuine, including a link to a privacy policy, as well as a link to sign up to a "Laithwaites Wine Newsletter".

The Complainant submits that the Respondent registered the Domain Name in bad faith and without any legitimate interests in the Domain Name, with the intention of fraudulently misrepresenting himself as the Complainant or as being connected to the Complainant.

The Complainant argues that the Respondent's use of the Domain Name shows that the Respondent took unfair advantage of the Complainant's rights in order to deprive the Complainant of income and to defraud consumers. The Complainant submits that the Respondent is fraudulently representing to consumers that the Respondent's website is connected to the Complainant.

The Complainant requests transfer of the Domain Name.

## **5.2. The Response**

The Respondent asserts that the Domain Name was registered legitimately on 7 June 2020, and notes that the registrant of the domain name <laithwaiteswine.co.uk> chose not to or neglected to register the Domain Name during the reservation period for ".uk" domain names.

The Respondent argues that the Complainant does not hold any trade mark registrations for "Laithwaites wine", and that there is no evidence of other trade mark violation or intent to mislead consumers.

The Respondent claims that, as an Amazon Affiliate, he is permitted to sell any products that Amazon sells. The Respondent asserts that all information for products, trade mark-protected or otherwise, including text, images, and prices, comes from Amazon.

The Respondent submits that the name of the website is "Laithwaites Wine" as the Domain Name is <laithwaiteswine.uk>, and that the copyright notice is inserted automatically by the web-design software.

The Respondent asserts that his website does not state or imply that it has anything to do with the Complainant's business. The Respondent argues that the website appears to be genuine because it is.

The Respondent argues that there is no evidence of fraud or misrepresentation on his part, and that the Respondent's purpose is not to deprive the Complainant of income. Rather, the Respondent asserts that his use of the Domain Name represents market opportunity and competition.

The Respondent further claims that the Complainant is trying to obtain the Domain Name without paying for it, thereby depriving the Respondent of income, and that the Complainant never made any attempt to contact him prior to the present proceeding, despite the inclusion of a link to a contact email form on the Respondent's website.

## **5.3. The Reply**

The Complainant asserts that it spent time searching for contact information for the Respondent while preparing the Complaint, but found no contact information, including on the Respondent's website, as the email icon on the Respondent's website was obscured. The Complainant claims to have raised a complaint with Amazon regarding the lack of contact information on the Respondent's website.

The Complainant submits that it has registered a substantial number of domain names comprising the names "Laithwaites" and "Laithwaites Wine", including various misspellings, under a number of generic Top-Level Domain Names ("gTLDs"), as well as country code Top-Level Domains ("ccTLDs"), so as to prevent cybersquatting or misuse of the Complainant's trade marks.

The Complainant argues that the word "wine" in the Domain Name is descriptive, the distinctive part of the Domain Name being "Laithwaites", which has been registered by the Complainant as a trade mark in nine countries, including the United Kingdom.

The Complainant submits that failing to register a particular domain name does not give a third party the right to use the trade mark of another or to register a corresponding domain name.

The Complainant asserts that it has established enormous goodwill and reputation in the name "Laithwaites" over the last 50 years.

The Complainant reiterates that the Respondent's registration of the Domain Name amounts to an Abusive Registration, first because the Respondent has registered a domain name which contains the Complainant's LAITHWAITES trade mark, together with the word "wine", being the product for which the Complainant's trade mark is registered. In addition, the Respondent's use of the Domain Name to sell wines which are produced and sold by the Complainant may confuse consumers into believing that the Respondent's website is endorsed by the Complainant, when it is not.

The Complainant further submits that the Respondent's use of the Domain Name violates Amazon's terms of service.

## **6. Discussions and Findings**

Under paragraph 2.1 of the Policy, for the Expert to order transfer of the Domain Name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration."

### **6.1. The Complainant's Rights**

The Expert finds that the Complainant has established "Rights" in the LAITHWAITES and LAITHWAITES WINE REWARDS trade marks in light of their registration and use, the details of which are provided in the factual-background section above.

The Domain Name incorporates the Complainant's LAITHWAITES trade mark in its entirety as the leading element of the Domain Name, together with the descriptive term "wine", under the ccTLD ".uk". The Expert finds that the addition of the term "wine" does not prevent a finding of similarity between the Domain Name and the Complainant's trade mark, which remains immediately recognisable in the Domain Name. The Expert notes in this regard that the Complainant's LAITHWAITES trade mark is registered in the United Kingdom in respect of "[a]lcoholic beverages (except beers" (in Class 33), as well as "[w]ine tastings and courses" (in Class 41).

The Expert finds the Domain Name to be similar to the Complainant's LAITHWAITES trade mark. Accordingly, the Complainant has satisfied the requirements of paragraph 2.1.1 of the Policy.

## **6.2. Abusive Registration**

An "Abusive Registration" is defined in 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

The Expert notes that the Complainant's rights in the LAITHWAITES trade mark predate the Respondent's registration of the Domain Name by at least 20 years.

The Respondent has not produced evidence of independent rights in the "Laithwaites" name, such as having the surname "Laithwaite", or having registered trade mark rights in the same, or any variation thereof, as reflected in the Domain Name.

The Expert accepts the Complainant's submission that the failure to register a domain name comprising one's trade mark does not give rise to any rights on the part of a third party to register a corresponding domain name; see DRS 15788: (<starwars.co.uk>). The same can be said in the present case, where the Respondent has registered the Domain Name comprising the Complainant's trade mark in its entirety, together with a descriptive term that describes the primary product for which the Complainant has registered its trade mark.

As set out above, the Domain Name resolves to a website that purports to sell wine and wine-related products via the Internet. Rather than providing any comprehensive information about the owner of the website, the Respondent's website simply states "Laithwaites Wine Copyright © 2020. All rights reserved."

The Expert infers from the Respondent's use of the Domain Name that the Respondent registered the Domain Name with the Complainant's rights in the LAITHWAITES trade mark in mind, with a view to capitalising on the goodwill and reputation attached to the Complainant's trade mark, thereby taking unfair advantage of the Complainant's Rights within the meaning of the Policy.

While the Expert is unable, on the basis of the evidence provided, to conclude that the Respondent's use of the Domain Name is fraudulent in nature, the Expert

nevertheless finds that the Respondent is using 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, as contemplated by paragraph 5.1.2 of the Policy. Indeed, having duly noted the Respondent's arguments, the Expert concludes that the Respondent's use of the Domain Name amounts to the exact kind of abusive activity that the Policy was designed to address. As such, the Respondent's misleading use of the Domain Name is not of a nature to bring the Respondent within the safe harbour of paragraph 8.1.1.1 of the Policy.

The Expert therefore concludes that the Domain Name is an Abusive Registration within the meaning of paragraph 2.1.2 of the Policy.

## **7. Decision**

The Complainant has Rights in a name or mark which is similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name should therefore be transferred to the Complainant.

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Jane Seager  
26 November 2020