

ADMINISTRATIVE PANEL DECISION

Tesco Stores Limited v. Admin, DNS
Case No. D2023-3206

1. The Parties

The Complainant is Tesco Stores Limited, United Kingdom ("UK"), represented by Haseltine Lake Kempner LLP, United Kingdom.

The Respondent is Admin, DNS, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <tescounderwriting.com> (the "Disputed Domain Name") is registered with Network Solutions, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 25, 2023. On July 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 28, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 25, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on September 18, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a British multinational company that operates a retail group with more than 4,000 stores globally. The Complainant's licensees include Personal Finance PLC trading as Tesco Bank ("Tesco Bank") and an underwriting company established in 2010 owned by Tesco Bank with services that include underwriting Tesco bank's insurance policies. In 2022, Tesco Underwriting's gross written premiums exceeded GBP 261 million. The Complainant holds a number of registrations for the trademark TESCO including, for example: United Kingdom registration no. 2116694 registered on March 27, 1998, for the word mark TESCO, United Kingdom registration no. 2058853 registered on March 24, 2000, for the figurative mark TESCO, and United Kingdom registration no. 2258927 registered on July 6, 2001 for the word mark TESCO in class 36 covering various financial services.

The Complainant has owned the domain name <tesco.com> since 1994, and Tesco Underwriting hosts its website at <tescounderwriting.net>.

The Respondent registered the Disputed Domain Name <tescounderwriting.com> on October 30, 2010. The Disputed Domain Name resolves to a pay-per-click ("PPC") parking page that displays links such as "Car Policy", "Claims", and "Insurance Policy".

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations for the mark TESCO as *prima facie* evidence of ownership. The Complainant submits that its rights in the mark TESCO predates the Respondent's registration of the Disputed Domain Name. It submits that "the Disputed Domain Name, ...contains an identical reproduction of [its trademark] 'TESCO', being confusingly similar to the TESCO Mark" and that this "will inevitably lead consumers to associate the Disputed Domain Name with the Complainant". It also submits that the use of the "word 'UNDERWRITING' [in the Disputed Domain Name] is both descriptive and generic of the financial services being provided on the website associated with the Disputed Domain Name" and that "[s]uch similarity increases the risk of confusion of consumers in associating the Disputed Domain Name with the Complainant's TESCO Mark".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name as it "is not aware of any other party/parties [other than Tesco bank and Tesco Underwriting] having any rights or legitimate interest in the mark 'TESCO'". It also contends that "the secondary word 'UNDERWRITING' is highly descriptive and generic of the financial services supplied through the associated website, and consumers would not consider this secondary word to denote an origin of the financial services supplied, and may assume that it indicates sponsorship or endorsement by the owner of the TESCO Mark, the Complainant" and that "the services supplied from the website associated with the Disputed Domain Name are identical/confusingly similar to those supplied by Tesco Bank and Tesco Underwriting, under license from the Complainant, under the TESCO Mark", increasing the likelihood of confusion amongst consumers and affiliation being falsely suggested between the Disputed Domain Name and the Complainant, including its TESCO Mark.

Finally, the Complainant alleges that the Respondent registered and is using the Disputed Domain Name in bad faith and that "it can be inferred that the Respondent acquired the Disputed Domain Name in with full knowledge, or should have known, that the Disputed Domain Name was previously incorporated into the website of Tesco Underwriting" and that "the Disputed Domain Name was acquired and is being used in bad faith, to take unfair advantage of the goodwill and reputation enjoyed by the Complainant in the TESCO Mark".

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark TESCO. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the TESCO trademark, the Panel observes that the Disputed Domain Name comprises: (a) the Complainant's trademark TESCO; (b) followed by the word "underwriting"; (c) followed by the gTLD ".com".

It is well established that the gTLD used as technical part of a domain name may be disregarded. The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "tescounderwriting" (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In this case, the Disputed Domain Name identically incorporates the entirety of the Complainant's trademark. It is also well-established that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends, in effect, that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because (i) the Disputed Domain Name is used to host a PPC parking page with links likely to confuse consumers; (ii) the Respondent has not acquired or owned any trademark or service mark rights in the name TESCO, and has not been commonly known by the name TESCO; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain.

The Panel accepts the Complainant's uncontested submission that use to direct Internet traffic to a PPC webpage is not a use in connection with a *bona fide* offering of goods or services pursuant to the Policy or a legitimate noncommercial or fair use.

The composition of the Disputed Domain Name, which consists of the Complainant's trademark does, in this Panel's view, creates a risk of implied affiliation to the Complainant, particularly in light of the Complainant's identically named licensee, but also due to the descriptive nature of the added term "underwriting" with regards the Complainant's services. Accordingly, such composition cannot constitute fair use and the commercialization of the disputed domain name via the PPC parking page takes unfair advantage of the Complainant's trademarks, and does not support a finding of any rights or legitimate interests.

The Panel finds for the Complainant on this element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy requires that the Complainant must also demonstrate that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, given the composition of the Disputed Domain Name, the Panel is satisfied that the Respondent targeted the Complainant's well-known and distinctive TESCO trademark when it registered the Disputed Domain Name and the Panel is prepared to infer that the Respondent knew, or should have known, that its registration would be identical or confusingly similar to the Complainant's trademark (see [WIPO Overview 3.0](#), section 3.2.2).

In addition, the gap of several years between registration of the Complainant's trademark and the Respondent's registration of the Disputed Domain Name, along with the composition of the Disputed Domain Name (containing an exact reproduction of the Complainant's well-known trademark) in the circumstances of this case is a further indicator of bad faith. In this case, the Complainant's rights in its trademark predate any rights that could possibly flow from the Respondent's registration of the Trademark TESCO by approximately 25 years.

On the issue of use, the Complainant's evidence is that some of the Disputed Domain Names resolved to a PPC landing page displaying links that redirect Internet traffic to third-party competitor websites unaffiliated with the Complainant or its licensee Tesco Underwriting. This Panel accepts the Complainant's uncontested evidence as evidence of bad faith use. Targeting of this nature is a common example of bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP decisions (see [WIPO Overview 3.0](#), sections 3.1.4 and 3.2.1).

In the absence of countervailing evidence, this Panel accepts the Complainant's evidence and finds that the Respondent has registered and used the Complainant's TESCO trademark in the Disputed Domain Name, without the Complainant's consent or authorization, for the likely purpose of capitalizing on the reputation of the trademark to infringe upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <tescounderwriting.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: September 21, 2023