

DISPUTE RESOLUTION SERVICE

D00022533

Decision of Independent Expert

Nando's Chickenland Limited

and

Tulip Trading Company Limited

1. The Parties:

First Complainant:

Nando's Chickenland Limited

St Mary's House

42 Vicarage Crescent

London

SW11 3LD

United Kingdom

Second Complainant:

Nando's Limited

St Mary's House

42 Vicarage Crescent

London

SW11 3LD

United Kingdom

Respondent:

Tulip Trading Company Limited

Dixcart House, Fort Charles

Charlestown

Nevis

012345

Saint Kitts and Nevis

2. The Domain Name:

getnandos.co.uk

3. Procedural History:

3.1 I can 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

3.2 Timeline

07 April 2020 15:34 Dispute received
08 April 2020 12:56 Complaint validated
08 April 2020 13:13 Notification of complaint sent to parties
29 April 2020 02:30 Response reminder sent
04 May 2020 12:27 No Response Received
04 May 2020 12:27 Notification of no response sent to parties
05 May 2020 09:44 Expert decision payment received

4. Factual Background

4.1 The First and Second Complainants (collectively, the “Complainants”), are part of the Nando’s Group of Companies and share the same registered office address in the UK.

4.2 The Complainants own and operate a restaurant chain trading under the mark “NANDO’S”.

4.3 The First Complainant is the owner of various UK trade mark registrations incorporating the NANDO’S mark and the Second Complainant is the owner of various trade mark registrations incorporating the NANDO’S mark outside of the UK, including the European Union. These include the following:

- UK trade mark registration UK00001467109 for the word mark NANDO’S in Classes 29, 30 and 43 dated 10 June 1991;
- European trade mark registration no. 000419432 for the word mark NANDO’S in Classes 29, 30, 43 dated 6 December 1996;
- European trade mark registration no. 15940381 for the word mark NANDO’S in Classes 9, 29, 30, 35, 39 and 43 dated 18 October 2016;

- US trade mark registration no. 87632627 for the word mark NANDO'S in Class 43 dated 3 October 2017;
 - US trade mark registration no. 87686683 for the word mark NANDO'S in Class 30 dated 15 November 2017; and
 - US trade mark registration no. 87720129 for the word mark NANDO'S in Class 39 dated 13 December 2017.
- 4.4 Between the Complainants, they also own a number of other trade mark registrations and applications for the NANDO'S mark in various other countries, including Australia, Canada, South Africa, Pakistan, Malaysia, Saudi Arabia and Sri Lanka. The vast majority of these registrations and applications pre-date the date of registration of the Domain Name.
- 4.5 The Complainants have registered numerous domain names that are identical to or incorporate the NANDO'S mark. These include the domain names nandos.co.uk (registered on 13 February 1998), nandos.com (registered on 12 January 1999) and nandos.app (registered on 8 May 2018).
- 4.6 The First Complainant operates several websites, each customised for its targeted location. These include the websites located at <www.nandos.com> and <www.nandos.co.uk>.
- 4.7 The Domain Name was registered on 19 June 2019. As at the date of the Complaint, the website to which the Domain Name resolved featured advertising links to food and restaurant entities not associated with the Complainants.

5. Parties' Contentions

- 5.1 A summary of the Complainants' contentions is set out below.

Rights

- 5.2 The First and Second Complainants own, between them, numerous trade mark registrations and applications which incorporate the NANDO'S mark (as referred to in Section 4 above).
- 5.3 In addition, the Complainants assert that they have extensive common law (or unregistered) rights in the mark 'NANDO'S' by virtue of their extensive trading and marketing activities, and accordingly they have acquired a substantial reputation and goodwill in the 'NANDO'S' mark such that it is recognised by the public as being distinctive of the Complainants' restaurant and food products and related services.
- 5.4 To support this assertion, the Complainants contend that:

- the restaurant chain that they own and operate trades under the 'NANDO'S' mark and has, since 1987, grown to become well-known with over 1000 restaurants worldwide (including over 400 branches in the UK and Ireland) which specialise in Portuguese food;
- they distribute sauces, marinades and snacks in its stores and through major retailers (including more than 4000 supermarkets) under the NANDO'S mark;
- their business operations extend to over 100 countries;
- the website located at <www.nandos.co.uk> has generated a large number of visits each year from around the world (in 2019, the total number of visits at the homepage of this website was over 19million);
- a search for the terms "NANDO'S" and "NANDOS" on the search engine Google.co.uk ranks the First Complainant's website as the first unsponsored result, and all of the organic results on the first page of this search relate to the Complainants' business;
- they have promoted their 'NANDO'S' goods and services and have generated extensive media coverage, including previously being named as one of the world's top 30 "hottest brands" by Advertising Age in 2010 and the "best big company to work for in the UK" by The Sunday Times.

Abusive Registration

- 5.5 The Complainants contend that shortly after registration of the Domain Name, there was a website available at the Domain Name which featured affiliate advertising links to other food and restaurant entities that compete with the Complainants. By doing so, the Complainants presume that the Respondent has received pay-per-click fees from those linked websites.
- 5.6 In addition, the Complainants assert that the Respondent has registered numerous domain names that are confusingly similar to well-known trade marks some of which are known in the restaurant and food sectors, such as "Burger King" and "Pizza Hut" (with two of the corresponding domain names owned by the Respondent being <burgerkingdeliveries.co.uk> and <careeratpizzahut.co.uk>).
- 5.7 The Complainants presume that the purpose of such actions by the Respondent is to trade off the goodwill and reputation of the corresponding brand owners, to potentially commit some kind of fraud, or to financially profit from the sale of the domain name(s) to the corresponding brand owner(s).
- 5.8 The Complainants also assert that the Respondent has had numerous previous Nominet DRS cases decided against it, five of which were in the last two years. Specific examples include:
- DRS 22198 <businessbankingswitchrbs.co.uk> (7 February 2020);
 - DRS 22032 <freepetplan.co.uk> (30 December 2019); and

- DRS 21719 <webstersmotorcycles.co.uk> (29 October 2019).

- 5.9 The Complainants say that since 2018 they are in the process of expanding their services in the UK and USA, specifically to include food delivery services via Apps as well as online, in view of the trend of ordering food in. The Complainants go on to say that a typical extension of ordering food for delivery / take-away is to “Get Nando’s” and it is for this reason that the phrase “Get Nando’s” is of importance to the Complainants. The Complainants have been using the terms in the subdomain <get.nandos.co.uk> for their delivery services since July 2019.
- 5.10 In light of the above, the Complainants argue (i) that the Respondent’s registration of the Domain Name is part of a wider pattern of abusive registrations and any argument to the contrary is contrived, (ii) it is highly likely that the Respondent would have been aware of the Complainants’ trade marks when it registered the Domain Name, (iii) that the Respondent’s registration of the Domain Name was a deliberate attempt to profit from the goodwill and reputation the Complainants enjoy in the ‘NANDO’S’ brand, and (iv) that there can be no possible legitimate basis for the Respondent registering and/or using the Domain Name which incorporates the Complainants’ ‘NANDO’S’ trade marks.
- 5.11 As far as the Complainants are aware, the Respondent has no trade mark or other rights that correspond to the Domain Name.
- 5.12 The Complainants also rely on paragraph 5.3 of Nominet’s Dispute Resolution Policy (the ‘Policy’) which states that:

“There shall be a presumption of Abusive Registration if the Complainant proves the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the complaint was filed.”

The Respondent

- 5.13 The Respondent did not file a response to the Complaint.

6. Discussions and Findings

General

- 6.1 For the Complainants to succeed with their Complaint they are required under paragraph 2.2 of the Policy to prove to the Expert, on the balance of probabilities, that:

- I. the Complainant (which in this case would refer to one or both of the Complainants) 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.

Complainants' Rights

- 6.2 Paragraph 1 of the Policy provides that 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*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.3 Further, it is well accepted that the question of whether the Complainant(s) has Rights falls to be considered at the time that such Complainant(s) makes its/their Complaint and is a test with a low threshold to overcome.
- 6.4 Each of the First and Second Complainants owns a number of trade mark registrations which incorporate the term 'NANDO'S', and a number of these, including those specified above in Section 4 of this decision, are for the 'NANDO'S' word mark. Further, the vast majority of these trade mark registrations pre-date the date of registration of the Domain Name.
- 6.5 In addition, the Complainants have made unchallenged submissions, supported by some evidence, to show that they have been using the mark 'NANDO'S' extensively in the UK and in a number of other countries, in connection with restaurant services and food-related products and services for a number of years. The Complainants have actively promoted their business under the 'NANDO'S' mark and it has received acclaim from well-known publications. The Expert is therefore satisfied that the Complainants have established goodwill and associated common law or unregistered rights in the 'NANDO'S' brand.
- 6.6 Excluding the generic suffix 'co.uk' and the apostrophe between the 'O' and the 'S' in the Complainants' mark (which it is not possible to include in a .uk domain name), the Domain Name differs from the Complainants' Rights in the 'NANDO'S' mark only by the addition of the descriptive word 'get' at the beginning of the Domain Name. The distinctive and dominant element of the Domain Name is the term 'NANDOS' which is identical to the Complainants' mark and the addition of the word 'get' as a prefix to the Complainants' mark does not distinguish the Domain Name from such mark.
- 6.7 The Expert consequently finds that the Complainants have Rights in respect of a mark which is similar to the Domain Name.

Abusive Registration

- 6.8 Paragraph 1 of the Policy defines “Abusive Registration” 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 took unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.*
- 6.9 Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Examples from paragraph 5 which the Complainants’ expressly or implicitly rely on are:
- “5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*
-*
- 5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or*
- 5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;*
- 5.1.2 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;*
- 5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*
-*
- 5.3 There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the complaint was filed. This presumption can be rebutted (see paragraphs 8.1.4 and 8.3).”*

6.10 Paragraph 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. With reference to the above and specifically paragraph 5.3 of the Policy, paragraphs 8.1.4 and 8.3 state:

“8.1.4 In relation to paragraphs 5.1.3 and/or 5.3; that the Domain Name is not part of a wider pattern or series of registrations because the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent.

8.3 If paragraph 5.3 applies, to succeed the Respondent must rebut the presumption by proving in the Response that the registration of the Domain Name is not an Abusive Registration.”

6.11 As noted above, the Respondent has not provided a response in this case.

6.12 Given the submissions of the Complainants regarding the renown of their ‘NANDO’S’ brand, both in the UK and internationally, and the evidence they have provided regarding the Respondent’s registrations of other domain names corresponding to well known brand names in the food and restaurant sectors, the Expert is satisfied, on the balance of probabilities, that the Respondent would have been aware of the ‘NANDO’S’ mark and the Complainants’ Rights in it at the time that it registered the Domain Name, and that it specifically chose to register the Domain Name with the intention of benefitting from the Complainants’ ‘NANDO’S’ mark and general reputation and goodwill.

6.13 Shortly after registering the Domain Name, the Respondent has made use of the Domain Name by allowing it to redirect to a website that contains links to competing food and restaurant related sites. However, the Expert has not seen anything to suggest that the Respondent is or has previously been known by the name ‘getnandos’ or that it has any legitimate interest in it.

6.14 Further, the Expert is not persuaded by any argument that the Respondent, or the parking links provider, has no control over or responsibility for the links that are provided by virtue of a parked page, and therefore cannot be held to account for the content of those links. As referenced in the DRS Experts’ Overview (a document available on Nominet’s website which is designed to assist parties to, and provide helpful guidance on, DRS disputes), where the domain name is connected to a parking page operated on behalf of the Respondent by a third party, the Respondent is *“unlikely to be able to escape responsibility for the behaviour of that third party.”*

6.15 In addition, given the fact that the Domain Name incorporates the mark in which the Complainants have Rights (‘NANDO’S’) in its entirety and it only differs from this mark by the inclusion of the word ‘get’ as a prefix to the mark, the Expert is satisfied that consumers searching online for the

Complainants and their products and/or services offered under the 'NANDO'S' brand name are likely to expect there to be some connection between any website operated under the Domain Name and the Complainants, even before they arrive at that website (regardless of the state of that website). This is particularly evident in this case given the Complainants' use of the subdomain <get.nandos.co.uk> for their delivery services since July 2019.

6.16 As stated in paragraph 3.3 of the DRS Experts' Overview:

"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."

6.17 Finally, the Expert has regard to fact that the Respondent has been found to have made an Abusive Registration in five DRS cases in the two years prior to the filing of their Complaint in this case. This, of itself, creates under paragraph 5.3 of the Policy a presumption of Abusive Registration in the present case. The Complainants have provided evidence that the Respondent is the registrant of a number of domain names which correspond to other well known names or trade marks in which it has no apparent rights, and the Domain Name is consistent with that pattern. In addition, there is no evidence from the Respondent in this case that allows the Expert to rebut the application of the presumption under paragraph 5.3 of the Policy.

6.18 The Expert consequently finds that the Domain Name (i) was registered in a manner which, at the time when the relevant registration took place, took unfair advantage of or was unfairly detrimental to the Complainants' Rights, and (ii) has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainants' Rights.

7. Decision

7.1 The Expert finds that the Complainants have proved that they have Rights in a mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.2 The Expert therefore directs that the Domain Name be transferred to the First Complainant as requested by the Complainants.

Signed

Ravi Mohindra

Dated

18 May 2020