

J A • K E M P

BY EMAIL ONLY (abuse@scip.es, info@scip.es)

SOLUCIONES CORPORATIVAS IP, SL
C / Menestrals 14
07500
Manacor (Illes Balears), Spain

19 September 2019

This correspondence has legal implications and requires your urgent attention to the domain name www.whatfreewords.com which infringes intellectual property rights owned by What3words Ltd.

This correspondence requires that you disable and terminate your services in respect of the website at www.whatfreewords.com.

If you do not, you are likely to be jointly liable for the infringements complained of and could face legal action by the owner of the relevant rights.

Dear Sirs,

European E-Commerce Directive Notification to Cancel / Disable
www.whatfreewords.com (“the Offending Domain Name”)
Our Ref: Z401736XX

Background

1. We act for What3Words Ltd (“W3W”), a geolocation business based in the United Kingdom. Amongst numerous other accolades, in 2015 W3W won the Grand Prix for Innovation at Cannes Lions. Increasingly, W3W is being used by national governments and emergency response services as a leading, user-friendly geolocation service to assist in emergency response situations. One of the key features of W3W’s activities is its creation of unique three-word addresses (“3WAs”) for three-metre by three-metre “squares” of the Earth’s surface, thereby creating a precise and easy-to-use alternative to GPS coordinates and traditional zip code and postal code systems. These are generated through the use of software code and a wordlist compiled by and proprietary to W3W.
2. We are writing to you as we have identified SOLUCIONES CORPORATIVAS IP, SL (“SCIP”) as the host for a website that infringes W3W’s intellectual property rights. We outline these infringements below and provide you with an opportunity to assist our client in dealing with them, rather than face joint liability for them.

PATENT ATTORNEYS • TRADE MARK ATTORNEYS
LONDON • OXFORD • MUNICH

14 South Square, Gray’s Inn, London WC1R 5JJ
T +44 20 3077 8600 F +44 20 7430 1000
mail@jakemp.com www.jakemp.com

A list of our partners is available at our principal place of business at the address above. Regulated by IPREG

Our Client's Rights and How They are Infringed

3. Our client relies on numerous types of IP right as the basis for this correspondence including its copyright and its registered trade marks. Its rights are outlined below.

Copyright

4. Our client provides geolocation services by ascribing three-word addresses (“3WAs”) to three metre by three metre squares of the Earth’s surface. A 3WA for your office at 14 Carrer Menestrals is windows.indicate.bliss. See attached Annex 1.
5. W3W uses approx.. 57,000,000,000 combinations of words taken from a word list of 40,000 individual words that has been carefully compiled and organised in a specific way in order to facilitate ease of use across numerous countries, geographies and communication methods.
6. The software code by which it provides its geolocation services, the wordlist itself, and each 3WA formed by a combination of words on the wordlist are proprietary to W3W and protected by copyright which vests in W3W.
7. The Offending Site infringes this copyright in the following ways:
 - a. it replicates and reproduces part of the W3W code and also contains derivative works made from this code;
 - b. it operates by using and deploying a direct copy of the proprietary W3W wordlist;
 - c. it operates by using and deploying direct copies of the proprietary W3W 3WAs (see Annex 2 for an example of the functionality enabled by the Offending Site);
 - d. it makes the code, the wordlist and all 3WAs available for use and implementation by third parties without W3W’s license or authorisation and does this by offering all of the copyright material for use contained in Javascript, Go and Python libraries that are downloadable by visitors to the site.
8. The Offending Site therefore infringes W3W’s copyright as, inter alia, it contains and distributes exact copies and derivate works based on W3W’s copyright.

Registered Trade Mark Rights

9. W3W is the owner of the following registered trade mark rights, among others:

- a. UK Trade Mark Registration no 2656721 WHATTHREEWORDS filed 15 March 2013 and registered 5 July 2013 in classes 9, 25, 38, 39, 42, 45 (“**the UK Registration**”, Annex 3)
- b. EUTM 013529111 WHAT3WORDS filed 4 December 2014 and registered 8 April 2015 and covering classes 9, 25, 38, 39, 42, 45 (“**the EUTM**”, Annex 4).

(together, “**the Registrations**”)

- 10. The Offending Site uses the domain name WHATFREEWORDS.COM and is titled WHATFREEWORDS. Clearly the name WHATFREEWORDS was chosen for the Offending Site for its inherent reference our client and its activities. WHATFREEWORDS is obviously confusingly similar to the Registrations and likely to mislead, confuse or deceive internet users into the mistaken belief that the Offending Site is somehow affiliated with, authorised by, provided by or endorsed by our client. By way of example, it is clear how consumers might think that the Offending Site offers or provides a “free” authentic version of the W3W service, particularly given the extensive use of our client’s copyright material as detailed above.
- 11. In addition to the obvious risk of confusion and deception, it is also clear that that if the Offending Site proves to be unreliable (ie due to modifications of our client’s code or other variation in our client’s work) this will, given our client’s reputation and the importance of accurate geolocation services (particularly in emergency situations), have significant potential to cause harm to our client as well as the public at large.
- 12. Article 9 of the European Trade Mark Regulation (EU) 2017/1001 states that the proprietor of an EU trade mark shall be entitled to prevent all third parties from using a trade mark or sign where that sign is:
 - i) *similar* to the EU trade mark and used in relation to goods and/or services which are identical or similar to those for which the EUTM is registered; and
 - ii) similar to the EU trade mark and used for any goods and/or services where the EU trade mark has a reputation in the EU and where use of the offending trade mark or sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the EU trade mark.
- 13. In terms of the first basis for infringement, it is clear that the Offending Site deploys a similar sign (WHATFREEWORDS) in respect of services which are identical to W3W’s services and services for which its EUTM are registered including, but not limited to *mapping, navigation, creation of GPS maps* and similar.
- 14. In terms of the second basis, that same sign is being used to proliferate W3W’s software, code, wordlist and 3WAs and this clearly takes unfair

advantage of and will harm the reputation and distinctiveness of W3W's WHAT3WORDS name, especially in the (not unlikely) event that the pirated code proves to have faults or otherwise compromise our client's reputation for reliable software.

15. Accordingly the Offending Site infringes W3W's trade mark rights.

Consumer Protection Provisions

16. Finally, in certain Member States of the European Community, criminal provisions may apply to advertising and other conduct that is misleading to consumers. The Offending Site may give rise to an offence under these provisions, including the UK Consumer Protection from Unfair Trading Regulations 2008.

Next Steps

17. It is clear that the sole purpose of the Offending Site and the Offending Domain Name is to infringe our client's copyright by disseminating our client's otherwise-unpublished copyright works to the general public without its authorisation, and, further that this is done with an eye to harm our client's business. The "About" section of the Offending Site states:

Please do not use What3Words if you can avoid it...If you are already married to What3Words, then peruse the JavaScript library, Go library and command-line tool, Python library.

18. In other words, the Offending Site is encouraging customers to cease using our client's products or, alternatively, to use the pirated and infringing variations made available on the Offending Site.
19. On this and the above basis, your support and hosting of the Offending Domain Name and the Offending Site constitutes maintenance of an illegal website. You are now on notice of this fact.
20. Accordingly please take this letter as notice under Article 14 of Directive 2000/31/EC of the European Parliament (the "**E-Commerce Directive**") of "illegal activity" (as defined in that Directive) for which our client is entitled to hold you responsible unless you now act expeditiously to remove or disable, or procure the removal or disabling of, the Offending Site.
21. Any defence that you are acting merely as a conduit, cache or host of the information under the E-Commerce Directive may not be available as you now have notice and actual knowledge of the "illegal activity" complained of.
22. Further, we hereby require that you preserve all communications between you and the owner/party instructing your company and provide us with the contact details for the individuals that you know are involved with the Offending Site.

23. This is an urgent matter. In the absence of your compliance with our request within the next 48 hours we expressly reserve our client's rights to pursue this matter with any proceedings that may be available to our client so that it can protect the substantial investment that it has made in its business.
24. All of our client's rights are reserved. Should you have any queries or require any further information, please write to anewell@jakemp.com or contact the writer on +44 7795642669.

Yours faithfully,



J A KEMP
Signed by Aaron Newell, Partner