

B E T W E E N:

NORTON FINANCE (UK) LIMITED

Complainant

- and -

4 NAMES LIMITED

Respondent

Domain Names:

<nortonloan.co.uk>

<norton-loan.co.uk>

<nortoncredit.co.uk>

<norton-credit.co.uk>

<norton-financial.co.uk>

<nortonloans.co.uk>

<norton-loans.co.uk>

DECISION OF INDEPENDENT EXPERT

1. The Parties

The Complainant

- 1.1 The Complainant is Norton Finance (UK) Limited of 145 Wellgate, Rotherham, South Yorkshire, S60 2NN, UK.

The Respondent

- 1.2 The Respondent is 4Names Limited of Electra House, Electra Way, Crewe Business Park, Crewe, Cheshire, CW1 6GL, UK.

2. The Domain Name

2.1 The disputed domain names ("the Domain Name") are:

<nortonloan.co.uk>

<norton-loan.co.uk>

<nortoncredit.co.uk>

<norton-credit.co.uk>

<norton-financial.co.uk>

<nortonloans.co.uk>

<norton-loans.co.uk>

3. Procedural Background

3.1 This Complaint falls to be determined under the Nominet UK Dispute Resolution Service Procedure ("the Procedure") and the Nominet UK Dispute Resolution Service Policy ("the Policy").

3.2 The Complaint entered Nominet's system on 21 November 2007. It was validated on 26 November 2007 and Complaint documents were generated the following day. A Response was filed on 20 December 2007 and a Reply on 27 December 2007. Mediation not being possible and the Complainant having paid the relevant fee on 28 January 2008, the matter was referred to me for a Decision on 29 January 2008. I have confirmed that I am independent of the parties and that I am not aware of any matters that might call my impartiality or independence into question.

4. Outstanding Formal/Procedural Issues

4.1 There are no such issues in this case.

5. The Facts

5.1 The Respondent registered the first five of the seven Domain Names listed above on 25 March 2004. It registered the last two such names on 2 August 2004.

6. The Parties' Submissions

The Complaint

- 6.1 The Complainant makes submissions in its Complaint that may be summarised as follows:
- 6.1.1 The Complainant has carried on business as a finance broker under the name 'Norton Finance' since 1988. It owns the UK registered trade marks NORTON FINANCE and NORTON, registered on 11 March 2005 for financial services in Class 36. It operates websites at: www.nortonfinance.com and www.nortonfinance.co.uk. In 2007 there were 4,007,112 unique visits to the latter website and over 54 million hits in total.
- 6.1.2 The Complainant is registered with the Finance Industry Standards Association and is a member of the Association of Finance Brokers. It receives approximately 9,000 customer applications per months for loans totalling over £200 million. Its turnover in 2005 was over £12 million and in the period 2004 to 2006 it spent over £50 million marketing the 'Norton Finance' name. This has included national press and TV advertising.
- 6.1.3 The Respondent is using all of the Domain Names to resolve to identical websites. These are in the form of directory sites offering links to financial services websites that offer mortgages, loans and other services competitive with those of the Complainant, as well as a link to the Complainant's own website. They include the words 'This website is for sale!'.
- 6.1.4 The Respondent failed to respond to a 'cease and desist' letter from the Complainant's solicitor.
- 6.1.5 The Complainant relies on both registered and unregistered trade mark rights in the names 'Norton Finance' and 'Norton'. By reason of the distinctive name 'Norton' its marks are not wholly descriptive. The Domain Names are similar to the Complainant's marks, including the distinctive name 'Norton' together with generic terms that relate to financial services.
- 6.1.6 The Complainant has no association with the Respondent and has never authorised it to use its marks. It was clearly aware of the Complainant when it registered the Domain Names.

- 6.1.7 By offering the websites linked to the Domain Names for sale, the Respondent is seeking to elicit an offer from the Complainant to buy the Domain Names for a sum in excess of its out-of-pocket costs (paragraph 3(a)(i)(A) of the Policy).
- 6.1.8 The Respondent also registered the Domain Names for the purpose of disrupting the Complainant's business (paragraph 3(a)(i)(C) of the Policy) by attracting its customers and diverting them to websites offering competing products.
- 6.1.9 The Respondent's registration of the Domain Names was intended to confuse internet users into believing that the names were connected with the Complainant (paragraph 3(a)(ii) of the Policy). In particular, the Respondent has sought to take advantage of 'initial interest confusion' on the part of internet users looking for the Complainant's own website.
- 6.1.10 The Respondent has also engaged in a pattern of similar behaviour. It has been found guilty of abusive registration under the Policy on at least one other occasion (domain name <faral.co.uk>) and is the registrant of numerous other domain names reflecting well-known finance companies, including <virgin-credit.co.uk> and <ocean-loan.co.uk>.
- 6.1.11 The Complainant seeks a transfer of the Domain Name.

The Response

- 6.2 The Respondent's submissions in opposition to the Complainant's claims may be summarised as follows:
- 6.2.1 The Complainant has quoted an incorrect number in respect of its trade mark registration. In any event, all of the Domain Names were registered at least six months before the Complainant's trade marks were registered.
- 6.2.2 The Complainant does not have registered trade marks for any of the names 'Norton Loan', 'Norton Loans', 'Norton Credit' or 'Norton Financial' and the Complainant has provided no evidence that it has traded under any of these names. None of the Domain Names includes the term 'Norton Finance'.

- 6.2.3 The Domain Names were registered over three and a half years ago when they were freely available through Nominet. Had the Complainant wished to register them first it could have done so.
- 6.2.4 The name 'Norton' is a surname derived from a town in Yorkshire and means 'north town'. There are over 587 UK domain names that include the term 'Norton'. The Complainant cannot claim the rights to all such names.

The Reply

- 6.3 The Complainant has filed a reply to the Response in which it disputes each of the Respondent's arguments. It admits that the Domain Names predate the registration of its registered trade marks but submits that the relevant date for assessment of the Respondent's conduct is the date of filing of the Complaint. The Complainant also relies on its unregistered rights going back to 1988. It points out that the Respondent has not denied that it was aware of the Complainant at the time it registered the Domain Names, nor that it has specifically targeted the Complainant's customers.

7. Discussion and Findings

Relevant Provisions of the Policy

- 7.1 Under paragraph 2 of the Policy:

"(a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, that:

- (i) the Complainant 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.*

(b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."

- 7.2 Under paragraph 1 of the Policy the term "Rights":

"includes, but is not limited to, rights enforceable under English law..."

7.3 Also under paragraph 1 of the Policy, the term "Abusive Registration" means 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 was unfairly detrimental to the Complainant's Rights."*

7.4 Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 sets out a non-exhaustive list of factors that may be evidence that it is not. However, all these factors are merely indicative of, and subject to, the overriding test of an Abusive Registration as set out above.

Rights

7.5 I am satisfied on the evidence submitted by the Complainant that the Complainant is the owner of the UK registered trade marks NORTON FINANCE and NORTON for financial services. I am also satisfied that its has unregistered trade mark rights in the names 'Norton Finance' and 'Norton' in the field of financial services, based on substantial trade in the UK in that sector over a number of years.

7.6 I am also satisfied that the marks 'Norton Finance' and 'Norton' are similar to each of the Domain Names. Each such name includes a distinctive term, 'Norton', and also a descriptive term relating to loans, credit or finance which reflects the term 'Financial' as used by the Complainant. In the circumstances, the Complainant has established its case on Rights for the purposes of the Policy.

Abusive Registration

7.7 The Respondent is correct to say that the Complainant does not have a monopoly in the name 'Norton'. However, the Complainant's rights in that name, even if not exclusive, are sufficient to entitle it to the protection against abusive registration afforded by the Policy.

7.8 Because the name 'Norton' is distinctive and not merely a generic or 'dictionary' term, the Respondent's choice of that name for domain names relating to financial services gives rise to a case to answer. It is not sufficient for the Respondent simply to explain the derivation of the name 'Norton', as that fact neither detracts from the Complainant's acquired rights in the name nor explains the Respondent's choice of it. There is no suggestion, for example, that the Respondent has ever been known by the name 'Norton' or, for example, that it has registered a whole series of domain names based on towns of which 'Norton' is only one. Nor is it an answer that the Complainant could have registered the names itself but chose not to do so: that fact is not a licence to others to make abusive registrations.

7.9 In the circumstances, I infer that the Respondent chose each of the Domain Names in the knowledge of the Complainant and its services and with the intention of unfairly taking advantage of its goodwill. I also find on the balance of probabilities that the Respondent registered the Domain Names primarily for the purpose of:

7.9.1 selling them to the Complainant for a sum in excess of its documented out-of-pocket expenses (paragraph 3(a)(i)(A) of the Policy), as evidenced by the statement "This website is for sale!"; and/or

7.9.2 unfairly disrupting the business of the Complainant by diverting customers intending to find the Complainant's website and directing them to websites offering competing services (paragraph 3(a)(i)(C) of the Policy); and/or

7.9.3 using the Domain Names in a way which has confused internet users into believing they are connected with the Complainant (paragraph 3(a)(ii) of the Policy). The nature of each of the Domain Names is such as clearly to give rise to 'initial interest confusion' on the part of internet users looking for the Complainant's website and services.

7.10 I therefore conclude that each of the Domain Names was registered and/or has been used in a manner that took unfair advantage of, or was unfairly detrimental to, the Complainant's rights and that each of the registrations is abusive.

8. Decision

8.1 The Complainant has established on the balance of probabilities that it has Rights in respect of names or marks which are similar to each of the Domain Names. It has also established that each of the Domain Names in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds and I direct that each of the Domain Names be transferred to the Complainant.

Steven A. Maier
11 February 2008