

DISPUTE RESOLUTION SERVICE

D00008581

Decision of Independent Expert

Goldmoney Network Limited

and

Mr Peter Cosgrove

1. The Parties:

Lead Complainant: Goldmoney Network Limited
Falcon Cliff
Palace Road
Douglas
Isle of Man
IM2 4LB
Isle Of Man

Respondent: Mr Peter Cosgrove
Thornlea Villas
Holme House Road
Todmorden
Lancs
OL14 8LD
United Kingdom

2. The Domain Name:

goldmoney.co.uk

3. Procedural History:

The Complaint was lodged with Nominet on 27 May 2010. Nominet validated the Complaint and informed the Respondent that the Dispute Resolution Service (“DRS”) had been invoked and that the Respondent had 15 working days to submit a Response. The Respondent lodged a Response on 22 June 2010. The Complainant lodged a Reply on 30 June 2010. The parties entered into informal mediation but that process did not achieve a resolution of the dispute. On 23 August

2010 the Complainant paid Nominet the appropriate fee for a decision of an expert pursuant to paragraph 7 of the Nominet DRS Policy ("the Policy"). On 3 September 2010 Nominet appointed Andrew Clinton ("the Expert") as the Independent Expert.

The Expert has confirmed to Nominet that he knows of no reason why he could not properly accept the invitation to act as Expert in this case, and has further confirmed that he knows of no matters which ought to be drawn to the attention of the parties which might appear to call into question his independence.

4. Factual Background

The Complainant is a company based in Jersey that has traded under the name Goldmoney for many years. It is in the business of selling gold, silver and platinum, primarily through its web site at www.goldmoney.com. It has a UK registered trade mark for the mark GOLDMONEY.

The Respondent is a private gold investor who has a financial interest in goldmadesimple.com, which is an on-line business that competes with the Complainant in the sale of gold.

The Domain Name was registered on 1 July 2005. The WHOIS result states that the Respondent, Peter Cosgrove, is a non-trading individual who has opted to have his address omitted from the WHOIS service.

The Domain Name points to a web site that contains links to various other web sites including the web site operated by goldmadesimple.com and the Complainant's web site.

5. Parties' Contentions

Complainant

The Complaint, so far as is material, is summarised below:-

Complainant's rights

The Complainant has, through its subsidiary Net Transactions Limited, used the trading name GOLDMONEY since 1996.

The Complainant registered the domain name goldmoney.com in 1996 and it has used the name GOLDMONEY commercially as its core business with a payment system since February 2001.

The Complainant conducts business over the Internet with customers based in the UK and elsewhere.

The Complainant is the proprietor of the United Kingdom registered trade mark no. 2284122 for the mark GOLDMONEY in class 36 which was registered on 14 March 2003.

The Complainant is the proprietor of the United States registered trade mark no. 2,532,331 for the mark GOLDMONEY which was registered on 22 January 2002 and is deemed to be effective from the filing date of 28 January 1997.

The Complainant is well known in the on-line gold investment business through its frequent and repeated use of the trade mark GOLDMONEY.

Abusive Registration

The Domain Name contains the trade mark of the Complainant and is strikingly similar to the trading name of the Complainant.

The domain name goldmadesimple.com is controlled, acquired and held on behalf of Goldmadesimple.com Limited. The Complainant asserts that Goldmadesimple.com Limited is the Respondent.

The Complainant has not given its consent for the use of its trade mark GOLDMONEY by the Respondent.

The Domain Name has been used as a feeder site to the web site at www.goldmadesimple.com which is in direct competition with the Complainant as it operates in the same business by the same methods, namely the sale of gold bullion through on-line transactions and the storage of gold in vaults on behalf of the on-line investor. As the nature of the businesses of the Complainant and Respondent is the same, there is a real likelihood of confusion among potential clients.

The Domain Name is being used to intentionally divert Internet users that are searching for the Complainant's trade mark to the web site at www.goldmadesimple.co.uk.

The Domain Name is used for a web site that contains 10 links to the web site of goldmadesimple.co.uk and only one link to the Complainant's web site. The references on the web site to goldmadesimple.co.uk are in positive, laudatory terms and promote its business. The reference to the Complainant's web site is in a negative context expressing caution to the Internet user that using the Complainant's services (the sale of "pooled" gold) is not the preferred method of purchasing gold. This warning is defamatory of the Complainant and does not accurately reflect its business.

The Complaint refers to actual confusion as a potential client informed the Complainant that when he opened an account with the Complainant on or about 21 May 2010 he received a "welcome to Goldmadesimple.com – the easy way to buy gold online" message by return. The potential client informed the Complainant that he was certain that he visited the Complainant's web site but this cannot be correct as the Complainant sends a validation message to its new account holders before they can purchase gold on-line, and the Complainant would not be able to give its customers an account with goldmadesimple.com. The conclusion is therefore inevitable: that the client was misled, the client believed he was doing business with the Complainant as he wished to do, but had been lured to the goldmadesimple.com web site instead where he now holds an account against his wishes.

The web site at www.goldmadesimple.com contains material that is in breach of copyright, the content of the web site is not in any way approved by the Complainant, indeed the site is detrimental to the business of the Complainant.

The response from Jason Cozens, the Chief Executive of Goldmadesimple.com Limited to a cease and desist demand, was that the web site at the Domain Name was not a trading web site and that it exists for information purposes to promote gold in banking and personal finance. The multiple and unavoidable hyperlinks in the infringing domain web site to the goldmadesimple.com website which trades in direct competition to the Complainant illustrate that this is not true and that the site with the infringing Domain Name exists merely as a diversion from the Complainant and a

doorway to Respondent. The Domain Name has been registered to take away business that should have been with the Complainant and then to feed it to its competitor goldmadesimple.com.

Following the Complainant's expressed concerns with the Respondent's registration of the web site with the infringing Domain Name and use of the Complainant's name, the Respondent made superficial, cosmetic changes to the appearance of the goldmoney.co.uk web site. These changes serve only to illustrate that the goldmoney.co.uk domain was registered by the Respondent to create confusion and to take business from the Complainant. The changes in the appearance of the web site do not make it less damaging to the Complainant, but they indicate that the registration was made with an abusive intent.

Whilst the CEO of Goldmadesimple.com justifies the goldmoney.co.uk web site as existing for informative purposes, and while at first blush this appears to be an informative website, the goldmoney.co.uk web site misleads the Internet visitor by pretending to express views as an impartial observer of the gold trade industry whereas it is no more than another web site of, or advertisement for, Goldmadesimple.com.

The Internet visitor receives no useful information about the gold industry or about any members of the industry other than the Respondent. The web site with the infringing Domain Name acts simply as a disguised doorway to the Respondent's business, to the detriment of the Complainant and other members of the industry.

The information contained in the web site with the infringing Domain Name could have been comfortably and logically placed in the trading web site of the Respondent, namely www.Goldmadesimple.com, to which all the hyperlinks on the goldmoney.co.uk web site lead. It has no plausible reason to justify its independent existence other than to divert traffic away from the Complainant.

The name Goldmoney is not a generic term. It is a word that was "coined" by the Complainant. Whilst gold has a value, and is a form of money, "money" in common parlance denotes currency such as notes or coins, and normally not gold coins. Just as one does not refer to "pound money" or "dollar money", so too one does not refer to "gold money" unless one is referring to the trademark or the business of the

Complainant, or in some way attempting to create confusion in the market place or derive some benefit from the Complainant's good reputation and marketing efforts.

Placing the two words "gold" and "money" together is the trade mark of the Complainant, and using the two words "gold money" is unnecessary in the web site www.goldmoney.co.uk. In each instance, the use of the word "gold" by itself would have been grammatically correct, and the use of the words "gold money" instead are an attempt to optimise search results and create confusion when an Internet visitor keys in the word or words "goldmoney" or "gold money".

The Domain Name is used as an instrument of deception by Respondent, by attracting Internet visitors that search for the Complainant's trade mark, then alleging copyright in the contents of the web site in the name of the Complainant's trade mark, and, notwithstanding a small reference to the Complainant, immediately issuing a warning about the Complainant itself and sending the visitor, with the use of many hyperlinks, to its own web site from which it trades.

The Domain Name exists for no other reason than to take advantage of goodwill attaching to the Complainant's trade mark.

The Respondent has registered or acquired the Domain Name in order to prevent the Complainant, which is the holder of the trade mark, from using the name or registering it.

The Respondent has registered or acquired the Domain Name for the purpose of disrupting the business of the Complainant and benefiting its own business.

The Respondent attracts, for commercial gain, Internet users to its web site www.goldmadesimple.com, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website or products or services on the Respondent's web site or location and capitalising unfairly on Complainant's trade mark, goodwill and reputation.

The frequent and unnecessary use of the words "gold money" and the trade mark "goldmoney" indicates abuse on the part of the Respondent.

The Complainant seeks a transfer of the Domain Name.

Respondent

The Response, so far as is material, is summarised below:-

Before being aware of the Complainant's complaint, the Respondent made genuine use of the Domain Name, to provide advice and service to potential gold investors, which is demonstrated clearly by the web site which is in existence at www.goldmoney.co.uk. As a private gold investor, the Respondent has a keen interest in helping to de-mystify the often confusing array of options to consider when deciding how best to invest money in gold. This has been the primary reason why the domain was registered and the existing web site has been constructed at considerable cost (both in time and money) and is the first stage of a long term plan, to include independent journalists and gold experts, to create goldmoney.co.uk as the UK's most informative website for private gold investors.

In addition to being a private gold investor, who has purchased gold and silver from a number of suppliers including GoldMoney, Baird, Bullion Vault etc., the Respondent also has a financial interest in goldmadesimple.com (along with 4 other non gold related Internet companies). Goldmadesimple.com is a new company, offering mainly individual gold bars and coins, unlike goldmoney.com which does not list any prices of individual bars or coins and deals mainly in goldgrams - ie a share of a larger gold bars. Goldmoney.co.uk has links to several companies that the Respondent has bought gold from including goldmadesimple.com, goldmoney.com and bullionvault.com and as the site is developed further, there will be more links to companies in this sector and extracts from a market comparison survey of over 10 other suppliers (which has been commissioned from a national Independent Financial Adviser - Kellands).

Goldmadesimple.com has a higher number of links than the other companies, as the Respondent believes that it offers a superior range of products than the other two companies and it has contributed some resources to setting up the content. A similar offer has been made to GoldMoney.com in an email to Geoff Turk from Jason Cozens on 21/4/10, to contribute to the costs and have more control over the content of the site and links to their website.

The web site at www.goldmoney.co.uk contains in red text the following note: "This website has no connection whatsoever with goldmoney.com which is the registered business name of Net Transactions Limited, a separate company regulated by the Jersey Financial Services Commission."

The Domain Name is generic both 'gold' and 'money' being widely used in precious metals investment terminology. Indeed gold has been used for centuries as the primary type of money, with gold sovereign coins still being legal tender today, within the UK. Up until relatively recently, the only intrinsic value of paper money, was the gold reserves held by the issuing bank and many experts believe that a return to gold backed paper money is going to happen, which is one of the key messages of the goldmoney.co.uk website. This is evidenced by a search for 'gold money' in Google which returns 246,000,000 results. It is also evidenced by a wide number of communities using 'gold' and 'money' within domains such as <http://goldismoney2.com/forum.php>

The registration of goldmoney.co.uk is not part of a wider pattern of registrations similar to the Complainant. [Goldmoney.com](http://goldmoney.com)'s Internet exposure appears to be predominantly outside the UK, with a large exposure in the US and the fact that they have chosen not to register goldmoney.co.uk at any time over the past few years, demonstrates that it is not significant to their business. The Respondent simply chose this domain because of his primary argument that gold is money and it is the only form of money that has intrinsic value (as opposed to paper money which any government can print more of).

The Respondent is the only person who has funded the promotion of Goldmoney.co.uk and therefore the small numbers of visitors to the site are as a direct response to the marketing efforts the Respondent has made no interference whatsoever with GoldMoney's business. There is also no disruption whatsoever to GoldMoney's business as goldmoney.co.uk clearly states that it has no connection to goldmoney.com and even links to goldmoney.com so anyone who was in fact looking for Goldmoney.com can easily find their site.

GoldMoney.com appears to be a company with a turnover of several hundred million pounds per year and should not be able to prevent individuals with a financial interest in the gold market from launching a new website, on a domain which contains terms

as general as 'gold' and 'money', when they have chosen to ignore this domain for years.

The only way to register for goldmadesimple.com is to visit the goldmadesimple.com website. It is totally unreasonable to suggest that anyone visiting goldmoney.co.uk might be misled into thinking that they are on goldmoney.com - especially as there are prominent notices stating that goldmoney.co.uk has no connection with goldmoney.com - the branding is totally different and goldmoney.co.uk does not sell any products. It is even more unreasonable to suggest that someone could ignore these clear notices, click on a link to goldmadesimple.com - click on the 'register' button on the goldmadesimple.com website, go through the entire registration process and be under the impression that they were registering on the GoldMoney.com website. It seems extremely 'convenient' that the Complainant's alleged 'potential customer' (Paul Camara) who apparently ignored these clear statements and Goldmadesimple.com branding and thought he was in fact on the goldmoney.com site, is based in Jersey - where GoldMoney.com is based. Even more 'convenient' that he is an investment manager at a firm of accountants! The Respondent wonders if GoldMoney would be willing to sign an affidavit to state that Paul Camara has had no other previous communication with any Goldmoney staff, other than his communication in May 2010, as a potential investor.

At no time has the Respondent or any colleague at GoldMadeSimple.com had any intention of selling traffic from goldmoney.co.uk or selling the domain. The web site has been set up to facilitate the Respondent's long term goal of demystifying the confusing gold investment market. The Respondent considers that Goldmoney.com has a valid offering within the commodities market (which is substantially different from the offering from Goldmadesimple.com) and Jason Cozens has invited them to have a more prominent listing on the site, in return for contributing to the costs of the site.

GoldMoney.com is not a UK company and its offices are outside the UK. The Respondent is a UK resident private gold investor who has invested in a UK based gold supplier.

Goldmoney.com has chosen never to register goldmoney.co.uk and has not promoted this domain, therefore there is no loss of business by myself choosing to register it and promote it.

The Respondent has no intention of trying to 'pass off' the goldmoney.co.uk information site, as the GoldMoney.com gold trading site and have already made many changes to goldmoney.co.uk in line with suggestions from goldmoney.com in order to avoid any possible confusion between the sites. The Respondent is open to discussing any other reasonable changes that are suggested by the Claimant.

There are statements in red on the home page and about us page stating clearly that the web site has no connection whatsoever with Goldmoney.com and three hyperlinks throughout the site enabling users to visit www.goldmoney.com if that is what they require

There is absolutely no intention to confuse visitors as to what site they are on. The web site offers information on the gold market to private investors. There are links to several other gold suppliers other than Goldmadesimple.com and it clearly stated on the home page that Goldmadesimple.com is the 'featured company' and on the About us page - that the Respondent is a founding director of Goldmadesimple.com.

In answer to the Claimant's suggestion that the reference to 'pooled gold' was negative, the wording very clearly points out the cost saving of this method and is in no way derogatory

Reply

The Reply, so far as is material, is summarised below:-

The Complainant became aware of the Registrant's web site on about 15 April 2010. After initial contact with Jason Cozens of GMS, changes were made to the infringing domain website, and also to that of Goldmadesimple.com, in particular to the terms of business of Goldmadesimple.com. These were insufficient but the mere fact that they were made indicate acceptance of the infringement of copyright by the Registrant.

Since the Complaint has been filed, the Registrant has made further changes to goldmoney.co.uk in an attempt to avoid a finding of abusive registration. These changes serve to indicate that the Registrant acknowledges the similarities and that the Complainant should have control of the Domain Name.

The changes to the infringing Domain Name and to the web site of Goldmadesimple.com mean that Registrant has placed extensive new material before Nominet.

When determining the dispute Complainant requests that the Expert should refer to screenshots of the infringing Domain Name as at the date of filing the Complaint.

Three e-mail enquiries were sent on behalf of Complainant by third parties to Goldmoney.co.uk via its "Contact us" page. The first was sent in April, and two further queries were sent on Thursday 24th June. None of these received a response or acknowledgment from Registrant. It is therefore questionable that it is a site of which genuine use has been made by the Registrant.

There is very little advice on the site that would be of use to a potential gold investor. The statement "This website is dedicated to promoting gold backed money and companies working to this end" is untrue and misleading as the most prominently promoted business on the site is Goldmadesimple.com, which is not involved in gold backed money. The site simply serves as a search engine optimisation strategy for the Registrant's business.

The Registrant is not a private investor, he is an industry player. This is indicated by his own admission that he is a founding director and founding investor of Goldmadesimple.com. He is therefore a gold trader and is not impartial.

The use of the words "our clients" in the infringing Domain Name indicate that it is a trading web site, albeit that its trade is carried on through Goldmadesimple.com.

At the date of the Complaint the only apparently independent entry was that of one Jeff Jones, not a known expert or journalist. This was dated 20 January, 2010, the date when work on the infringing Domain Name was last done. It therefore seems that this was not an independent entry but part of the construction of the infringing Domain Name. On 21 June 2010, in preparation for this dispute before Nominet,

two further entries were posted neither of which reflect the opinion of an independent expert or journalist. The reference is in fact to someone who says he does not understand gold.

The changes made by the Registrant to the infringing Domain Name following this dispute before Nominet is an implicit acceptance of wrongdoing, the natural consequence of which is that the Complainant should have full control over the infringing Domain Name.

At the date of filing the Complaint with Nominet the latest news story was a link to a BBC entry of 2008. Recent entries have been posted in response to the Nominet dispute and are not newsworthy. In total there are three articles for 2010.

The words GOLD and MONEY together are the Complainant's trade mark and business name. Search results are reduced from 234 million to three million when the two words "gold" and "money" are joined as in the trade mark. The fact that the difference is so great when joined as opposed to when separate, indicates the distinctiveness of the Complainant's trade mark.

Approximately 15% of the Complainant's client base is from the United Kingdom.

Presently there are the following hyperlinks:

- eight working to www.Goldmadesimple.com, and one which does not work;
- one to www.Goldmoney.com which works, and one which does not;
- one to each of www.Goldline.co.uk, www.Mayfairandgrant.co.uk, and www.Bullionvault but they do not work (previously there were none);

It is noteworthy that the Registrant accepts responsibility for and attempts to justify the terms of business of Goldmadesimple.com and that the Registrant and Jason Cozens of Goldmadesimple.com speak with one voice in this dispute, whilst in the infringing domain website goldmadesimple.com is presented as an unconnected business. This is misleading.

6. Discussions and Findings

General

Under paragraph 2 of the Policy the Complainant has to prove on the balance of probabilities: firstly, that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

This aspect of the dispute is straightforward. Rights are defined in the Policy as meaning rights enforceable by the Complainant, whether under English law or otherwise. The Complainant is the proprietor of the United Kingdom registered trade mark no. 2284122 for the mark GOLDMONEY in class 36 which was filed on 26 October 2001 and registered on 14 March 2003. The Respondent has not challenged the Complainant's assertion that it has rights in the mark GOLDMONEY, although he points out that the Complainant is not a UK company and its offices are based outside the UK. The Complainant says that approximately 15% of its client base is from the UK.

It is clear, on the evidence before the Expert, that the Complainant has rights in the mark GOLDMONEY. The mark GOLDMONEY is identical to the Domain Name as, at the third level (i.e. disregarding the .co.uk suffix), they are the same. The Expert finds that the Complainant has rights in the mark GOLDMONEY which is identical to the Domain Name.

Abusive Registration

Abusive Registration is defined in paragraph 1 of the Policy to mean 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.

Factors pointing to Abusive Registration – paragraph 3 of Policy

A non-exhaustive list of factors which may be evidence of an Abusive Registration is set out in paragraph 3 of the Policy. The factors that are relevant to this dispute are:

- (i) Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant;
- (ii) Circumstances indicating 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;

It is clear from the wording of the Policy that the list of factors at paragraph 3 is non-exhaustive and that a Complainant can succeed in proving Abusive Registration without necessarily being required to prove any of those factors. However, in order to do so it is necessary to prove that the definition of Abusive Registration, as set out in paragraph 1 of the Policy, has been satisfied.

Factors pointing against Abusive Registration – paragraph 4 of Policy

There is a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration at paragraph 4 of the Policy. Paragraph 4(a) is of relevance to the facts in this case. It provides that:-

- “i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:
 - A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
 - B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
 - C. made legitimate non-commercial or fair use of the Domain Name; or
- ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it.”

Discussion and findings regarding Abusive Registration

This dispute raises issues of confusion (under paragraph 3(a)(ii) of the Policy) and fair use (under paragraph 4(a) of the Policy). The primary issue for consideration is whether, and in what circumstances, it can be regarded as fair to use a domain name that is identical to a registered trade mark when there is a likelihood of confusion. The Respondent's case is that he has set up a web site that simply informs investors and does not sell products and he rejects the idea that he has used the Domain Name in order to attract gold investors to www.goldmadesimple.com. The Complainant says that the Respondent has taken unfair advantage of the goodwill that attaches to the phrase GOLDMONEY for the commercial advantage of goldmadesimple.com.

Confusion

The Complainant argues that the Domain Name is likely to create confusion because it is identical to its trade mark and the confusion will be to the Complainant's detriment as the Domain Name points to a web site which contains a number of links to the web site at www.goldmadesimple.com, which is a competitor to the Complainant in the sale of gold on-line. The Complainant cites one example of actual confusion although the Respondent rejects this example as “convenient”.

The Respondent says it is unreasonable to suggest that an Internet user might be misled given the disclaimer stating that Domain Name has no connection to the Complainant, the fact that the web site at www.goldmoney.co.uk does not sell any products and the different branding that has been adopted for the web site at www.goldmadesimple.com. The Respondent's case is that the web site provides advice and services to potential gold investors and he has no intention of confusing Internet users.

The fact remains that the Respondent has used a Domain Name which is identical to the Complainant's mark and there is, at the very least, a risk of "initial interest confusion". There is a helpful analysis of the concept of "initial interest confusion" in the Experts' Overview which is published on Nominet's web site. The Experts' Overview says:-

"Commonly, Internet users will visit websites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the website connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's website will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's website will be visiting it in the hope and expectation that the website is a website "operated or authorised by, or otherwise connected with the Complainant." 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 website that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial website, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk). The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration."

Fair use

The Expert's view is that there is a risk of "initial interest confusion" in this case but, before reaching a conclusion on the issue of Abusive Registration, it is necessary to consider whether there are factors that might be relied upon by the Respondent as evidence that the Domain Name is not an Abusive Registration. This involves consideration of the Respondent's explanation for the choice of the Domain Name and the use of the Domain Name. There are various explanations, in the papers before the Expert, for the choice of the Domain Name, including:-

"As a private gold investor, I have a keen interest in helping to de-mystify the often confusing array of options to consider when deciding how best to invest money in gold. This has been the primary reason why the domain was registered and the existing web site has been constructed at considerable cost (both in time and money) and is the first stage of a long term plan, to include independent journalists and gold experts, to create goldmoney.co.uk as the UK's most informative website for private gold investors" – set out in paragraph 1 of the Response.

"I simply chose this domain because of my primary argument that gold is money and it is the only form of money that has intrinsic value (as opposed to paper money which any government can print more of" – set out in paragraph 3 of the Response.

"The web site has been set up to facilitate my long term goal of demystifying the confusing gold investment market" – set out in paragraph 7 of the Response.

The Complainant says that Internet users receive no useful information about the gold industry from the web site at www.goldmoney.co.uk which is, in reality, no more

than a “disguised doorway” or a “feeder site” to the web site at www.goldmadesimple.com. The Complainant asks the Expert to consider the material that appeared on the web site prior to the Complaint on the basis that much of the material relied upon by the Respondent post-dates the Complaint. By way of example, the Respondent says that there is a statement on the web site that there is no connection to the Complainant but, according to the Complainant, that statement was only added in April 2010.

The Complainant says that it coined the phrase GOLDMONEY which is distinctive of its services. It contends that the use by the Respondent of the words “gold” and “money” is an attempt to optimise its search results. There is some support for that argument in the evidence. On 15 April 2010 Geoff Turk, the Chief Executive Officer of the Complainant, sent an e-mail to Jason Cozens (“Mr Cozens”), the Chief Executive Officer of goldmadesimple.com, complaining that the Domain Name incorporated the registered trade mark GOLDMONEY without permission. Mr Cozens e-mail reply dated 21 April 2010 stated:-

“We chose this domain because it contained generic phrases relevant to our core business: Gold and Money. This means that it will benefit our search engine optimisation efforts. It is difficult to find such domains these days and we had to pay a premium for it.”

The e-mail from Mr Cozens, on behalf of goldmadesimple.com, also says that “we” have made changes to the web site at www.goldmoney.co.uk to better differentiate it from the Complainant’s web site, which demonstrates that goldmadesimple.com has some element of control over the content that appears on the web site of the Domain Name.

It is common ground between the parties that there is a connection between the Respondent and goldmadesimple.com. The Respondent is open about the fact that he has a financial interest in goldmadesimple.com and he refers to himself as the founding director. There is an inherent tension between the Respondent’s stated desire to create the most informative web site for private gold investors and his interest as an investor in one of the businesses that competes in that market.

It is necessary to consider paragraph 4(a) of the Policy which sets out a number of factors which may be evidence that the Domain Name is not an Abusive Registration.

The Experts' Overview says that the circumstances set out in paragraph 4(a)(i) of the Policy are only likely to constitute satisfactory answers to the Complaint if they were commenced before the Respondent was aware of the Complainant's name. The Respondent does not say that his plans for the web site were arrived at wholly without reference to the rights of the Complainant. He says his use of the Domain Name pre-dates the Complainant's complaint but, as is clear from the Experts' Overview, that is not conclusive. It seems extremely unlikely that the Respondent, as a private gold investor wishing to set up a web site providing information to those interested in investing in gold, would be unaware of the Complainant's name. The Respondent has produced no evidence to show that, before becoming aware of the Complainant's name, he either used or made demonstrable preparations to use the Domain Name in connection with either a genuine offering of goods or services (paragraph 4(a)(i)A) or he made legitimate non-commercial or fair use of the Domain Name (paragraph 4(a)(i)C).

The Respondent does not say that he arrived at the Domain Name independently; he says, in effect, that the phrase GOLDMONEY is fair game as it contains generic terms and the Complainant did not register the Domain Name. The latter point does not assist the Respondent as, whilst Nominet operates a first come first served allocation policy, a registrant accepts that the registration and use of a domain name is open to subsequent challenge under the DRS system. There would be no need for the DRS system if the Respondent could succeed simply by arguing that the Complainant had failed to register the disputed domain name.

The Respondent may be able to avail himself of paragraph 4(a)(ii) if he can demonstrate that the Domain Name is generic or descriptive and the Respondent is making fair use of it. The words "gold" and "money" are ordinary dictionary words and when considered individually they are descriptive. However, the combination of those two words is unusual and, based on the evidence before the Expert, it has acquired a meaning that is distinctive of the Complainant's services though the use of that phrase by the Complainant for the purposes of promoting its business.

The circumstances in which it is possible to make fair use of a domain name where (i) the domain name is identical to the registered trade mark of a Complainant (ii) the use of the Domain Name is likely to cause confusion and (iii) the use takes place after the date of acquisition of the Complainant's rights must be somewhat limited. The Expert finds, on the balance of probabilities, that the use of the Domain Name

has “taken unfair advantage of or has been unfairly detrimental to the Complainant’s rights” within the definition of Abusive Registration. In arriving at that finding the Expert has had regard to the points set out below.

The Respondent decided to register a domain name that was identical to the trade mark of the Complainant; he did not add any other characters that might serve to distance the Domain Name from the Complainant. There is no compelling reason why a web site that offers information to private investors on the gold market has to use the combination of the words “gold” and “money”.

The Respondent has not advanced a case that the Domain Name was arrived at wholly without reference to the rights of the Complainant and that seems most unlikely, given the stated purpose of the web site.

Goldmadesimple.com and the Complainant are competitors in the sale of gold on-line. The business models of both companies depend, at least to some extent, on the ability to attract potential investors in gold to their web sites. The Respondent has a financial interest in goldmadesimple.com.

There is clearly a likelihood of “initial interest confusion” even if an Internet user subsequently realises that the web site is not connected to the Complainant. The disclaimer on the web site making it clear that there is no connection to the Complainant was added in April 2010 and, in any event, it does not avoid the problem of “initial interest confusion”. The fact that Internet users may no longer be confused once they reach the web site is irrelevant, as the damage will have already been done. The Domain Name is likely to create initial interest confusion to the detriment of the Complainant.

The Complainant has adduced evidence of actual confusion in the form of an e-mail from someone who believed they had signed up to the Complainant’s web site and, rather than receiving a validation e-mail from the Complainant, they received a welcome e-mail from goldmadesimple.com.

The Respondent says the web site offers information on the gold market to private investors and that his long term plan is to create the UK’s most informative web site for private gold investors, which will include independent journalists and gold experts. In explaining why there are more links to the web site at www.goldmadesimple.com

than any other web site the Respondent says that this is because he believes that goldmadesimple.com (in which he has a financial interest) offers a superior range of products and it has contributed resources to setting up the content. This is hardly in the nature of impartial advice to potential gold investors; it is more in the nature of a sponsored advertisement for the services of goldmadesimple.com. This point is re-enforced by the fact that the Respondent has invited the Complainant to contribute towards the costs of the web site and, effectively, to buy more control over the content of the web site and the number of links to their web site.

The Expert believes that the use of the Domain Name takes unfair advantage of the Complainant's rights as it attracts Internet users to the web site and then invites them - on the pretext of providing information - to follow links to the web site at www.goldmadesimple.com. One of the screenshots provided by the Complainant contains a statement that:-

“One of the easiest ways to buying gold is to buy gold bars. They are easily sold when you want to exchange your gold assets for cash. There are only a few companies who actually sell physical gold bars.”

There is then a link to www.goldmadesimple.com but there is no mention of, nor are there any links to, any other companies that also sell gold bars in that section of the web site. The Complainant sells gold bars but there is no mention of this on the web site.

In the view of the Expert, the Respondent is operating in the hope that Internet users, who are looking for the Complainant, will find themselves at the Respondent's web site. The Internet user will only have been drawn to the web site in the first place by use of the Complainant's registered trade mark. Once there the Respondent hopes to derive a commercial gain through the use of links to goldmadesimple.com, a business in which he has a financial stake. The Respondent's actions exploit the goodwill attached to the mark GOLDMONEY for commercial purposes. The statement by the CEO of goldmadesimple.com that they chose the Domain Name because it contains generic phrases relevant to their core business which benefits their search optimisation efforts puts the matter beyond doubt. The intention was to increase the amount of Internet traffic for the benefit of the business of goldmadesimple.com.

If the Respondent had used the Domain Name to point directly to the web site at www.goldmadesimple.com that would have been a straightforward case of Abusive Registration. The Respondent does not avoid that finding by constructing a web site that clearly signposts Internet users to www.goldmadesimple.com. It appears on the evidence that goldmadesimple.com partially funded the web site at www.goldmoney.co.uk and has some control over the content on that web site.

For the reasons stated above, the Expert finds that the Domain Name has been used in a manner which has taken unfair advantage of the Complainant's Rights which amounts to Abusive Registration as defined in paragraph 1 of the Policy.

There are various other matters raised in the papers which do not need to be considered for the purposes of determining this dispute. There are allegations of defamation and infringement of copyright upon which the Expert makes no findings.

7. Decision

The Expert finds, on the balance of probabilities, that the Complainant has Rights in a mark which is identical to the Domain Name and that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that the Domain Name be transferred to the Complainant.

Signed Andrew Clinton

Dated 24 September 2010