

DISPUTE RESOLUTION SERVICE

D00009257

Decision of Independent Expert

Chartered Insurance Institute (CII)

and

Mr Andrew Melder

1. The Parties:

Lead Complainant: Chartered Insurance Institute (CII)
20 Aldermanbury
London
EC2V 7HY
United Kingdom

Respondent: Mr Andrew Melder
23, Eversley Road
Benfleet
Essex
SS7 4JE
United Kingdom

2. The Domain Name(s):

charteredinancialplanner.org.uk

3. Procedural History:

05 November 2010 14:40 Dispute received
08 November 2010 11:44 Complaint validated
08 November 2010 12:07 Notification of complaint sent to parties
30 November 2010 09:56 Response received
30 November 2010 09:56 Notification of response sent to parties
08 December 2010 09:10 Reply received
13 December 2010 11:02 Notification of reply sent to parties

13 December 2010 11:02 Mediator appointed
14 December 2010 14:05 Mediation started
07 February 2011 16:01 Mediation failed
07 February 2011 16:02 Close of mediation documents sent
22 February 2011 11:02 No expert decision payment received
09 March 2011 10:32 Expert decision payment received

I was thereafter contacted by Nominet and asked to confirm that I was able to provide an Expert Decision. I responded to Nominet confirming that I had no conflict preventing me from providing a decision.

The matter was thereafter duly referred to me, Simon Chapman, ("the Expert") for an Expert Decision.

4. Factual Background

The Complainant is a professional body for the financial services profession. It has been granted permission by the Privy Council to award the title of Chartered Financial Planner or Chartered Financial Planners to individuals or organisations that meet the relevant criteria. The objective of the scheme is to enable consumers to know which individuals or organisations offer the highest standards of professional and ethical practice.

The Complainant is the proprietor of the trade marks No 2364461 (UK) and 003868578 (CTM) both for 'CHARTERED FINANCIAL PLANNER', registered in May 2004 and July 2007 respectively.

The Respondent registered the Domain Name in September 2004. The site provides information in respect of those individuals or organisations that have been awarded the status of Chartered Financial Planner(s).

5. Parties' Contentions

Complaint

The Complainant asserts that it has rights in the words 'Chartered Financial Planner' as a result of its trade mark registrations, and the operation of its accreditation scheme under that title.

In support of its assertion that the Respondent's use of the site is Abusive, the Complainant contends that the site, whilst likely set up to assist consumers in identifying those individuals or organisations that have been awarded the status of Chartered Financial Planner(s), has become very out of date and includes organisations that do not employ any individual with Chartered Financial Planner status, and as such the site is misleading. It also contains outdated information concerning the Institute.

Response

The Respondent asserts that the website to which the Domain Name is pointing was set up to assist consumers to identify individuals with the status of Chartered Financial Planner in the UK and the rest of the world. It is a purely non commercial site, with no advertising or paid for links/traffic. The site does not claim to be related to the Chartered Institute and has links to the Institute's website. It would be very hard to confuse the website with the Chartered Institute.

There are a number of other international organisations which award the status of Chartered Financial Planner.

Not all companies listed are still trading, and not all of the links to websites are still live. It is not possible to contact non existent firms.

Reply

By way of reply, the complainant asserts that notwithstanding the Response, the Registrant is using the domain name in a manner that is likely to confuse people into believing that the domain name is registered to, operated or authorised by or otherwise connected to the Complainant.

The fact that other international organisations award the status of Chartered Financial Planner is irrelevant.

The use of inaccurate information on the Respondent's site is damaging to the reputation as the average consumer will believe that the information therein is vetted by the Complainant.

The Complainant has the exclusive right to use the term Chartered Financial Planner in the UK and Europe and consumers recognise the term to be a title awarded by the Complainant. Use by the Respondent will result in a likelihood of confusion including a likelihood of association and will mislead consumers.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Disputed Domain Name; and
- (ii) the Disputed Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

The Complainant must make out its case to the Expert on the balance of probabilities.

Complainant's Rights

The DRS Policy defines Rights as follows -

"Rights includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business"

There would appear to be no case put forward by the Respondent that that the Complainant does not qualify as having the necessary Rights.

The Policy requires such Rights to be in a name or mark identical or similar to the Disputed Domain Name. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one must ignore the .org.uk suffix. The comparison is therefore between 'CHARTERED FINANCIAL PLANNER' on the one hand for which the Complainant has registered trade marks (which are enforceable under English law), and 'CHARTEREDFINICIALPLANNER' on the other. In my opinion, by virtue of the registered marks which the Complainant owns, the Complainant has established that it has Rights in a mark identical to the disputed Domain Name.

Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above.

The Policy defines an 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 was unfairly detrimental to the Complainant's Rights"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration. One such ground is set out paragraph 3(a)(ii) of the Policy which provides as follows –

"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 or operated or authorised by, or connected with the Complainant"

In most circumstances where a Respondent has registered a domain name that is identical or similar to a name or mark in which the Complainant has rights, and the

Complainant and mark were known to the Respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration. However, the Policy provides a number of examples of circumstances where the use of a domain name might not be Abusive. Two such circumstances are set out in paragraph 4 as follows –

“Before being aware of the Complainant’s cause for complaintmade legitimate non-commercial fair use of the Domain Name.” Para 4(a)(i)(C)

“Fair use may include sites operated solely in tribute to or in criticism of a person or business”. (4(b))

I have previously said (*DRS 006642 airfrance-klm.co.uk and airfranceklm.co.uk*) that in my view the terms “tribute” and “criticism” as used in paragraph 4(b) of the Policy are to be construed sufficient widely to encompass activities which might more accurately be described as the provision of an “information” site.

There is therefore an assessment to be made as to whether the use of the Domain Name falls within the circumstances described above, and even if it does, do the grounds contained within Paragraph 4 apply in any event and as such the registration is Abusive.

The Domain Name is identical to the Complainant’s trade mark. It is clear that the Domain name was chosen for this reason and so that consumers could identify individuals with the title of Chartered Financial Planner in the UK and elsewhere.

In the Appeal decision for *scoobydoo.co.uk* (DRS 00389), the panel had to deal with similar issues to those raised herein. It said that –

“...if the Panel comes to the conclusion that the ‘genuine offering’ takes unfair advantage of the Complainant’s rights, this provision cannot assist the Respondent. As to ‘legitimate non-commercial or fair use’ again all depends upon what the Panel regards as fair.”

Dealing with the selection and use of a domain name identical to the mark in respect of which the Complainant had rights, the Panel went on to say –

“Taking the Domain Name in these circumstances arguably amounts to impersonation of the owner of the name or mark. Substantial numbers of people will have visited the Respondent’s website...Notwithstanding the Respondent’s denial of any advantage, the panel is of the view that on the balance of probabilities there must have been an advantage to the Respondent of some kind...Whether or not that ‘advantage’ has led to financial gain is irrelevant....Even if there has been no advantage to the Respondent, the Domain Name can still represent an Abusive Registration if it has been used so as to have been unfairly detrimental to the Complainant’s rights...Impersonation can rarely be fair.”

The Panel also said –

“For the avoidance of doubt, the Panel has not found that, in registering the Domain Name and in using the Domain Name, the Respondent intended to

take unfair advantage of or cause detriment to the Complainant's rights, but honest intentions are not enough.

In Appeal case DRS 06284 (*rayden-engineering.co.uk* and *rayden-engineering.org.uk*) where the domain names in issue were identical to the Complainant's name, the Panel said that –

“In effect the Respondent is posing as the Complainant in order to attract members of the public to the site.”

and went on to say that –

“As reflected in the <scobydoo.co.uk> appeal decision cited above, the majority view amongst Nominet Experts is that where a registrant registers or uses a domain name so as to take advantage of “initial interest confusion”, which causes a user to visit a website expecting it to have some connection with a well-known name comprised in or constituting the domain name, he takes unfair advantage of the Rights in the name.”

In light of the guidance provided by the earlier decisions, with which I agree, and the evidence submitted by the parties, in my opinion the use of the domain name in the present case, which is identical to the mark in which the Complainant has rights, and which was selected by the Respondent for this reason, is likely to lead consumers to believe that the Respondent, or its website, is connected with or authorised by the Complainant. In my view that consequence takes unfair advantage of the Complainant's rights. The possibility that some consumers will unwittingly be diverted away from the Complainant or that the information which they may receive will not be accurate or reliable, is also likely to cause unfair detriment to the Complainant's rights.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name or mark which is identical to the Domain Names *charteredfinancialplanning.org.uk* and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds.

The disputed Domain Name should be transferred to the Complainant.

Signed Simon Chapman

Dated 01April 2011