

## DISPUTE RESOLUTION SERVICE

D00011142

### Decision of Independent Expert

HCA International Limited

and

Mr Simon Smith

#### 1. The Parties:

Complainant: HCA International Limited  
242 Marylebone Road  
London  
NW1 6JL  
United Kingdom

Respondent: Mr Simon Smith  
29 Harley Street  
London  
W1G 9QR  
United Kingdom

#### 2. The Domain Name(s):

theportlandhospital.co.uk (“the Domain Name”)

#### 3. Procedural History:

02 April 2012 16:57 Dispute received  
03 April 2012 09:47 Complaint validated  
03 April 2012 09:47 Notification of complaint sent to parties  
24 April 2012 02:30 Response reminder sent  
27 April 2012 08:52 No Response Received  
27 April 2012 08:53 Notification of no response sent to parties

10 May 2012 02:30 Summary/full fee reminder sent  
14 May 2012 11:21 Expert decision payment received

#### **4. Factual Background**

The Complainant operates private hospitals and treatment centres in London including a well-known maternity hospital, founded in 1983, whose full name is “The Portland Hospital for Women and Children”. This is commonly abbreviated to “(The) Portland Hospital”. Over 32,000 babies have been born at the hospital.

The Complainant owns UK trade mark no. 2247276 for the term “PORTLAND HOSPITAL” dated 2 October 2000 in class 44.

The Complainant operates a website for the hospital at [www.theportlandhospital.com](http://www.theportlandhospital.com).

The Respondent registered the Domain Name on 13 December 2010.

The Respondent has redirected the Domain Name to a website promoting cosmetic dentistry treatments.

#### **5. Parties’ Contentions**

##### Complaint

As a result of the longstanding use of the names “The Portland Hospital” and “Portland Hospital” in the UK, the Complainant has built up considerable goodwill for those terms within the medical and healthcare sector.

The Domain Name is very similar to the Complainant’s registered trade mark for “PORTLAND HOSPITAL”. The only differences are the generic domain suffix “.co.uk” and the additional prefix word “the” in the Domain Name. The dominant and distinctive part of the Domain Name is the conjoined words “portlandhospital”, which are identical to the Complainant’s registered trade mark.

The Complainant first contacted the Respondent on 6 December 2011 alerting him to the Complainant’s concerns. The letter was returned with “not known” written on the envelope.

Neither the Respondent, nor the proprietor of the website to which the Domain Name resolve, have any known connection or commercial relationship with the Complainant. Nor do they have the permission of the Complainant to use its trade mark.

In view of the Complainant’s longstanding use and registered rights to the mark “Portland Hospital”, it is inconceivable that consumers would not expect the Domain Name to be directly connected to the Complainant’s hospital. The

Respondent is using the domain name in a way which is likely to confuse people or businesses into believing that the domain name is registered to, or operated or authorized by, or otherwise connected with, the Complainant. The fact that the Domain Name automatically redirects to a website relating to healthcare-related services suggests that consumers would be misled into believing there is a connection between the parties which does not exist. This is initial interest confusion.

There can be no legitimate reason for the Respondent to register a domain name so similar to "Portland Hospital". Furthermore, the repute of The Portland Hospital strongly suggests that the Respondent knew of the Complainant and its rights in Portland Hospital when the Domain Name was registered.

### Response

The Respondent has not filed a Response.

## **6. Discussions and Findings**

### General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Names and, second, that the Domain Names, in the hands of the Respondent, are abusive registrations (as defined in paragraph 1 of the DRS Policy).

### Complainant's rights

The meaning of "rights" is clarified and defined in the Policy in the following terms:

*"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"*

The Complainant has a registered trade mark for "PORTLAND HOSPITAL" as well as unregistered rights in the names "Portland Hospital" / "The Portland Hospital" arising from their longstanding use over a period of some 30 years.

I conclude that the Complainant has established rights in a name or mark which is identical or similar to the Domain Name.

### Abusive registration

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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 was unfairly detrimental to the Complainant's Rights.”*

Paragraph 3a(ii) of the Policy identifies the following as one of the non-exhaustive factors which may be evidence that a domain name is an abusive registration:

*“ii. [c]ircumstances 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”*

The Respondent has redirected the Domain Name to a website promoting cosmetic dentistry services. In fact, the domain name used for the cosmetic dentistry website is not registered in the name of the Respondent and the Respondent's relationship with that business / website is unclear. While I think it likely that the Respondent is deriving some sort of financial benefit from its activity, whether affiliate commission or otherwise, paragraph 3a(ii) of the Policy does not require financial gain on the part of the Respondent. The key issue is whether the Respondent has used the Domain Name in way which has caused, or is likely to cause, confusion.

While it is arguable as to whether internet users are likely to be confused into thinking that a cosmetic dentistry site is in some way connected with the Complainant's maternity hospital, the point is academic as there has undoubtedly been “initial interest confusion” in this case. This concept is explained in paragraph 3.3 of the DRS Experts' Overview as follows:

*“Commonly, Internet users will visit web sites 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 web site 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 web site will use the domain name for that purpose.*

*In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site “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 web site 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 web site, 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)..."*

In this case, the Domain Name is identical (or virtually identical) to the name of the Complainant, without any adornment other than the generic domain suffix. Indeed the Domain Name is uniquely referable to the Complainant's trade mark. It is likely, therefore, that internet users are assuming that the Complainant's website is located at the Domain Name. Such users will have been sucked in / deceived by the Domain Name, as explained in the Expert's Overview.

## **7. Decision**

I find that the Complainant has rights in a mark which is identical or similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name be transferred to the Complainant.

Signed: Adam Taylor

Dated: 7 June 2012