

DISPUTE RESOLUTION SERVICE

D00011144

Decision of Independent Expert

HCA International Limited

and

balata.com ltd

1. The Parties:

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

Respondent: balata.com ltd
Address: 12 Harcourt Road
Central
Country: Hong Kong

2. The Domain Name(s):

portlandhospital.co.uk (“Domain Name”)

3. Procedural History:

2 April 2012	Dispute received
3 April 2012	Complaint validated
3 April 2012	Notification of complaint sent to parties
24 April 2012	Response reminder sent
27 April 2012	No response received
27 April 2012	Notification of no response sent to parties
21 May 2012	Steve Ormand appointed as Expert

It is the registrant’s responsibility to ensure that its contact details remain current. Nevertheless, Nominet received email delivery failure messages for emails sent to

postmaster@portlandhospital.co.uk notifying the Respondent of the complaint, of no response received and of the appointment of the Expert. The complaint notification sent by recorded delivery to the contact address provided by the Respondent was also returned undelivered. However, there are no delivery failure messages noted for emails sent to the contact email address provided by the Respondent.

I am satisfied that Nominet has notified the Respondent at all stages of the complaint in accordance with §2a of the Procedure.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

4. Factual Background

The Complainant is a company incorporated in the United Kingdom on 10 February 1995 with Companies House registration No. 3020522. The Complainant is a subsidiary of HCA Inc. which is also known as Hospital Corporation of America.

The Complainant operates private hospitals and treatment centres in London at:

- The Portland Hospital
- The Harley Street Clinic
- London Bridge Hospital
- Lister Hospital
- The Princess Grace Hospital
- The Wellington Hospital
- Harley Street at UCH (University College Hospital NHS Trust)

The Complainant has established Centres of Excellence in areas of medical practice across each of its private hospitals in London in areas such as Paediatrics (children and babies), Obstetrics (maternity), Fertility Treatments, Cancer Cardiology/Heart Care, Neurosciences (brain and spine injuries) and Intensive Care. Each centre focuses on specific conditions and offers some of the most advanced treatment options in the UK.

The Complainant has a registered UK trade mark (No. 2247276) for the mark PORTLAND HOSPITAL, which is registered in respect of “medical, hospital, clinical and healthcare services; therapeutic and medical diagnostic services; all being provided for women and children” in Class 44. The application for registration was filed on 2 October 2000 with registration being obtained on 1 November 2002.

The Respondent registered the Domain Name on 11 February 2005.

The Respondent is established in Hong Kong.

The Respondent has been found to have made an Abusive Registration in 3 DRS cases in the 2 years before this complaint was filed.

5. Parties' Contentions

The Complaint

The Complainant contends that it has Rights in the name 'The Portland Hospital' because:

1. The hospitals in the UK operated by the Complainant, including The Portland Hospital, are listed on the website at hcahealthcare.com which is operated by HCA Inc.
2. The HCA business, through HCA Information Technology Services, which is a related company to the Complainant, is the registrant of the domain name registration theportlandhospital.com as shown in the extract from the Whois online database provided.
3. The Complainant uses the domain name theportlandhospital.com in respect of its healthcare services offered at the hospital known as The Portland Hospital.
4. The Complainant operates a business known as The Portland Hospital for Women and Children, which is usually referred to as The Portland Hospital. The hospital was founded in 1983 and is one of the most prestigious private hospitals in the UK. It is London's only private hospital which is entirely dedicated to the treatment of women and children.
5. The hospital's specialties reflect expertise in obstetrics (maternity), women's health and paediatrics. The Complainant offers other clinical services within outpatient departments for adults and children, in particular for physiotherapy, audiology imaging (x-ray, ultrasound and MRI scanning), pharmacy and a surgical theatre suite. The printouts from the website at www.theportlandhospital.com provided give details of the maternity, women's health and paediatric services provided by the Complainant.
6. The Portland Hospital is very well-known and since 1983 over 32,000 babies have been born in the hospital. The hospital has been the choice for various well-known personalities which have used its maternity services. For example, Princesses Beatrice and Eugenie were born in the hospital, as well as children of Jennifer Saunders, Victoria and David Beckham, Emma Bunton, Geri Halliwell, Noel Gallagher, Katie Price, Gillian Anderson, Boris Becker and Claudia Schiffer.
7. A search of the internet using the GOOGLE search engine for The Portland Hospital or Portland Hospital picks up various references to the Complainant's business. In fact, all references to Portland Hospital or The Portland Hospital are to the Complainant's business.
8. The Portland Hospital is registered with the Care Quality Commission. This is an independent body that checks all hospitals in England to ensure they are meeting Government standards. A copy of the latest inspection report issued by the Commission from 2009/2010 for The Portland Hospital for Woman and Children is provided.
9. The brochure provided showcases the maternity care services offered by The Portland Hospital. This outlines the high-quality standard of care provided by the Complainant in the maternity field.
10. The extract from the website femail.co.uk (operated by the Daily Mail newspaper group) regarding Portland Hospital states that "celebrities from Posh Spice to Zoe Ball and Patsy Kensit have given birth at London's plush Portland hospital".
11. As a result of the longstanding use of the name The Portland Hospital and Portland Hospital in the UK, the Complainant has built up considerable goodwill under common law in the medical and healthcare sector.
12. The Respondent has no known connection or commercial relationship with the Complainant and does not have the permission of the Complainant to use the mark PORTLANDHOSPITAL or variations thereof.

13. The Domain Name is identical to or very similar to the registered trade mark rights of the Complainant for the mark PORTLAND HOSPITAL, which differs only in respect of the generic domain suffix “.co.uk”. The Domain Name registration contains as its distinctive component portlandhospital, which is the subject of the Complainant’s registered trade mark rights.

The Complainant contends that the Respondent’s registration and/or use of the Domain Name is an Abusive Registration because:

1. The extracts from Respondent’s website provided show that it connects to a directory of sponsored links, many of which concern healthcare. Further, the related searches connect to a variety of healthcare related links.
2. Further extracts provided from the Respondent’s website indicates that the Domain Name “could be for sale” and when users click through on the “for sale” link a fresh browser window opens with the URL <http://www.domainlandscape.com/domains/portlandhospital.co.uk/>, which indicates a purchase price of \$5,959.20. The Complainant submitted an online offer of GBP100 for transfer of the domain on 2 December 2011. No response was received.
3. Further, the fact that the Respondent has not responded to the offer to purchase the Domain Name for GBP100, which would cover its out of pocket expenses in respect of the Domain Name registration, and that the website indicates a purchase price of \$5,959.20, indicates that this is an attempt to obtain more than out of pocket expenses in respect of the acquisition of the Domain Name registration.
4. In paragraph 3.3 of the Expert’s Overview, Nominet has provided guidance as to what may constitute an Abusive Registration in respect of initial interest confusion:

“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.”

5. 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 and its provision of healthcare services at the facility known as the Portland Hospital.
6. Consumers looking for the Complainant’s business may enter portlandhospital.co.uk into an internet browser with the realistic expectation that it would connect to the Complainant’s business. It does not. Such use indicates that 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 authorised by, or otherwise connected with, the Complainant. The fact that the Domain Name connects to sponsored links in the healthcare sector suggests that consumers would be misled into believing there being a connection between the parties which does not exist. This is initial interest confusion.

7. In this regard, the Complainant refers to the decision of the Independent Expert in the Dispute Resolution Service Case No. DRS 07187 (Procter & Gamble Business Services Canada Company versus Gregory Bine) page 6, and in particular to the following arguments concerning the adoption of a distinctive, well-known name:

“The prominence of the Complainant’s brand, its market presence and its protection via trade mark registrations strongly suggest that the Respondent knew of the Complainant and of its rights in the ... name when the Domain Name was registered.

The site to which the Domain Name refers is clearly related to activity associated with the Complainant’s business. It is likely, on the balance of probabilities, that potential customers connecting to the Domain Name would do so expecting to find reference to the Complainant and its branded products... The Expert sees no grounds, on the balance of probabilities, for disagreeing with this assertion.”

8. This dispute is analogous to the above-mentioned case. The Complainant’s registered rights contain a highly distinctive name, Portland Hospital. There can be no legitimate reason for the Respondent to register the Domain Name so similar/identical to Portland Hospital. Furthermore, the repute of the Portland Hospital strongly suggests that the Respondent knew of the Complainant and its rights in the name Portland Hospital when the Domain Name was registered.
9. The leading UK case concerning domain name registrations is British Telecoms Plc and others v One In A Million Limited and others (1999), ETMR 61. The Courts stated: “placing on a register of a distinctive name...makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill and the name”. This is clearly pertinent to the registration of the Domain Name which concerns as a dominant element a mark which is subject of registered rights and which is identical to the name in which the complainant has goodwill and reputation in connection with medical services.
10. The Respondent has no connection to the Complainant’s business. There can be no legitimate reason for the Respondent to have adopted the Domain Name. The business known as the Portland Hospital is well-known and there can be no explanation of the Respondent’s actions other than to suggest that they are taking unfair advantage of the reputation and goodwill established by the Complainant in connection with the Portland Hospital business, as well as taking unfair advantage of the registered rights of the mark PORTLAND HOSPITAL. In effect, the Respondent has been “riding on the coat tails” of the Complainant by seeking to divert parties seeking the Complainant’s business to a website containing sponsored links.
11. The Domain Name is not a descriptive term and instead only refers in the UK to the Complainant’s business. The use of the Domain Name by the Respondent whereby the user is directed to a directory of largely healthcare sponsored links and healthcare searches suggests that the Respondent has made financial gains, perhaps through pay per click arrangements through the sponsored link sites. Such activity does not qualify as a non-commercial or fair use of a domain containing a third party owned trade mark. The Domain Name has been intentionally registered and used in an attempt to attract for financial gain internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of the Respondent’s website.

12. By adopting a domain name registration and trading style confusingly similar to that of the Complainant, the Respondent has sought to associate the prestige and expertise of a leading healthcare provider with its own services. Further, the listings, whether sponsored or otherwise, in the healthcare sector may suggest that there is a connection between the Complainant and these parties, not least due to many of these links being in connection with private healthcare, i.e. the exact sector in which the Complainant operates.
13. The Respondent is likely to generate pay per click revenue every time one of the sponsored links is selected by an internet user. The Respondent must therefore be benefitting financially from use of the Complainant's trade mark, which use is therefore commercial.
14. The Respondent must have been aware that he was misappropriating the Intellectual Property rights of the Complainant. Consumers entering the Domain Name into a URL would suffer initial interest confusion, legitimately expecting to find the business of the Complainant.
15. On the basis of the ownership by the Complainant of trade mark rights by registration under common law to PORTLAND HOSPITAL and THE PORTLAND HOSPITAL, and in light of the foregoing reasons, the Domain Name is an Abusive Registration.

The Response

The Respondent did not provide a response to the Complaint.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

1. *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
2. *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Complainant's Rights

Rights is defined in §1 of the Policy as 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 wholly generic suffix ".co.uk" is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

I am satisfied on the papers before me that the Complainant has evidenced registered and unregistered rights in the mark "Portland Hospital" which pre-date the registration of the Domain Name.

Accordingly, I find that the Complainant has Rights in a mark which is identical to the Domain Name, save for the addition of the generic suffix.

Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

- 1. 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*
- 2. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3 of the Policy.

The Respondent advertising the Domain Name for sale at \$5,959.20 and a failure to respond to the Complainant's offer to buy the Domain Name for £100 are not sufficient to evidence an Abusive Registration. Trading in domain names for profit is not by itself objectionable and there is no evidence in the papers before me that the Respondent registered or otherwise acquired the Domain Name primarily for the purposes of selling it to the Complainant or a competitor of the Complainant for valuable consideration in excess of the Respondent's out of pocket expenses in acquiring or using the Domain Name.

However, I agree entirely with the Complainant's assertions (set out almost verbatim in section 5 above) that it is highly likely that the Respondent's use of the Domain Name has caused initial interest confusion in visitors who have been deceived by the Domain Name and been drawn into the Respondent's website. Furthermore, visitors drawn into the website are then faced with advertisements and/or sponsored links for competing services and related goods to those offered by the Complainant and the Respondent is likely to have earned pay per click revenue as a result.

It is noted in the procedural information provided to me by Nominet that the Respondent has been found to have made an Abusive Registration in 3 or more DRS cases in the 2 years before this complaint was filed. Under §3c of the Policy there is a presumption of Abusive Registration in such circumstances unless the Respondent rebuts the presumption. The Respondent has not rebutted this presumption.

Accordingly I find that the Respondent has used the Domain Name in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights and furthermore there is a presumption of Abusive Registration that the Respondent has failed to rebut.

7. Decision

The Complainant requested that in the event of a decision to transfer the Domain Name that its registration be transferred to HCA International Limited.

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name, portlandhospital.co.uk, be transferred to HCA International Limited.

Signed: Steve Ormand

Dated: 12th June 2012