

## DISPUTE RESOLUTION SERVICE

D00011828

### Decision of Independent Expert

The Royal Bank of Scotland Group plc

and

admin webmaster

#### 1. The Parties:

Complainant: The Royal Bank of Scotland Group plc  
36 St. Andrew Square  
Edinburgh  
Scotland  
EH2 2YB  
United Kingdom

Respondent: admin webmaster  
483 Green Lanes  
London  
Greater London  
N13 4BS  
United Kingdom

#### 2. The Domain Name:

rbsppl.org.uk

#### 3. Procedural History:

25 August 2012 16:23 Dispute received  
28 August 2012 11:19 Complaint validated  
28 August 2012 11:23 Notification of Complaint sent to parties  
14 September 2012 02:30 Response reminder sent

19 September 2012 10:29 No Response received  
19 September 2012 10:30 Notification of no response sent to parties  
27 September 2012 10:31 Expert decision payment received

Ravi Mohindra was appointed as Independent Expert as of 3 October 2012 and confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances that might call into question his independence in the eyes of the parties.

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

- 4.1 The Complainant is one of oldest banks in the UK, with its origins dating back to 1727. It was incorporated as a public limited company in the UK in 1968.
- 4.2 The Complainant offers its financial services worldwide under the mark “RBS” and has spent a significant amount of money promoting and developing this mark.
- 4.3 The Complainant owns an international portfolio of registered trade marks for the word mark “RBS”, including a UK trade mark dated 23 November 1994 and a CTM dated 1 April 1996, both in classes 9, 16, 35, 36 and 42.
- 4.4 The Complainant operates websites, including at rbs.com and rbsinternational.com, and owns an international portfolio of domain names incorporating the mark “RBS”.
- 4.5 The Domain Name was registered on 28 February 2012. The Domain Name currently resolves to a website which provides information on payment protection insurance and allows members of the public to check whether they are eligible for reclaim of the same.

#### **5. Parties’ Contentions**

- 5.1 A summary of the parties’ contentions is set out below:

##### The Complainant

##### Rights

- 5.2 The Complainant has Rights in the name or mark RBS by virtue of its trading history under this mark, the significant amount of money it has spent promoting and developing this mark and the large number of trade marks and domain names which it has registered around the world and which incorporate or consist of the mark RBS.
- 5.3 The RBS mark is in possession of substantial inherent and acquired distinctiveness, and has a high level of awareness.

- 5.4 The dominant and distinctive part of the Domain Name comprises the term “rbs”, which is identical to the Complainant’s registered trade mark RBS. The remainder of the Domain Name consists of the generic term “ppi”, short for “payment protection insurance”, and can easily be related to the Complainant and its services and only really explains what the website contains.
- 5.5 The Domain Name is confusingly similar to the Complainant’s world famous trade mark RBS. The Complainant has succeeded in numerous decisions under both the UDRP and DRS before WIPO, NAF and Nominet. The addition of the ccTLD “org.uk” to a trade mark is disregarded for purposes of determining the similarity between the Domain Name and the trade mark.

### Abusive Registration

- 5.6 Anyone who sees the Domain Name is bound to mistake it for a name related to the Complainant. The likelihood of confusion includes an obvious association with the Complainant’s trade mark. In light of the reputation of the trade mark RBS there is a considerable risk that the public will perceive the Domain Name either as a domain name owned by the Complainant or that there is some kind of commercial relationship between the Respondent and the Complainant.
- 5.7 By using the trade mark as a dominant part of the Domain Name, the Respondent is exploiting the goodwill and the image of the trade mark, which may result in dilution and other damage to the Complainant’s trade mark. Anyone seeing the Domain Name is likely to think that it is in some way connected to the Complainant and as a result initial interest confusion will arise. Further, customers of the Complainant may access the corresponding website only to be confused and aggravated by what they perceive as an official site when it in fact is not. This has an obvious detrimental effect on the Complainant’s business, including the potential loss of customers.
- 5.8 The Respondent has no legitimate rights in the name RBS and there is nothing to suggest that the Respondent is commonly known by the Domain Name. The Complainant has not given the Respondent permission to use its mark and accordingly there is no legitimate purpose to which the Respondent could put the Domain Name to use.
- 5.9 The Complainant sent a cease and desist letter to the Respondent on 1 May 2012, advising the Respondent that the unauthorised use of the RBS trade mark within the Domain Name violated the Complainant’s rights in the said trade mark, and requesting a voluntary transfer of the Domain Name. Despite reminders, no response to this letter was received.
- 5.10 Given the fame of the RBS trade mark, it is obvious that at the point of registration of the Domain Name the Respondent was aware of the rights the Complainant has in the trade mark and the value of the mark. The

Respondent has used the Domain Name in a manner that takes unfair advantage of and is unfairly detrimental to the Complainant's rights.

### The Respondent

5.11 The Respondent did not file a Response.

## **6. Discussions and Findings**

### General

6.1 The Complainant is required under paragraph 2b. of the Policy to prove to the Expert, on the balance of probabilities, 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.

6.2 Where no Response has been received, as is the case with this Complaint, it is still necessary for the Expert to be satisfied that the elements necessary to establish the Complainant's Rights and to make a finding of Abusive Registration are present in order for the Complainant's case to succeed.

### Complainant's Rights

6.3 Paragraph 1 of the Policy provides that 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*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

6.4 The Complainant is the owner of a number of trade mark registrations for the mark RBS, including in the UK. It also has a long standing trading history under this mark. Accordingly the Expert is satisfied that the Complainant has Rights in the mark RBS.

### Similarity

6.5 Having established that the Complainant has Rights in respect of the mark RBS, the Expert is required to decide whether this mark is identical or similar to the Domain Name.

6.6 Ignoring the generic "org.uk" suffix, the Domain Name comprises the Complainant's distinctive mark RBS in its entirety. The addition of the letters or word "ppi", which the Expert accepts can be taken as being an acronym for payment protection insurance, are more descriptive in nature

and do nothing to distinguish the Domain Name from the Complainant's Rights.

- 6.7 The Expert therefore finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

#### Abusive Registration

- 6.8 Paragraph 1 of the 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 has been unfairly detrimental to the Complainant's Rights.

- 6.9 A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration, is set out in paragraph 3a. of the Policy. The Complainant's case is based on one of these factors, namely paragraph 3a.ii which states:

"Circumstances indicating that the Respondent is using or is 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;"

- 6.10 Taking the following factors into account, the Expert finds that use of the Domain Name by the Respondent will be likely to lead to confusion as anticipated under paragraph 3a.ii:
- The Complainant has invested heavily in its RBS name and mark, such that the mark is distinctive of the Complainant and its business in the financial services industry.
  - The Domain Name is confusingly similar to the Complainant's RBS mark. The only distinctive element in the Domain Name is the Complainant's RBS name and mark and the Respondent has combined this with the generic term "ppi" which, given the contents of the website to which the Domain Name resolves, clearly denotes payment protection insurance. In light of the well profiled issues surrounding payment protection insurance, by combining the acronym "ppi" with the Complainant's distinctive trade mark in the Domain Name, members of the public searching online for the Complainant and/or information about PPI and potential reclaim of the same may well visit the Respondent's website believing it to be in some way connected to

the Complainant. This is known as “initial interest confusion” and as stated in Paragraph 3.3 of the Expert’s Overview<sup>1</sup>:

*“the overwhelming majority of Experts view it [initial interest confusion] 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.”*

- 6.11 Further, on reaching the website to which the Domain Name resolves, Internet users are presented with the Complainant’s RBS mark in a prominent position at the top left hand corner of the home page, followed by a space and then the term “PPI”.
- 6.12 It is clear from the evidence contained in the Complaint that the Complainant has established and continues to enjoy significant reputation in its RBS mark. By combining the Complainant’s mark RBS with the acronym for payment protection insurance (“ppi”), the Expert is satisfied that use of the Domain Name in the manner described has been unfairly detrimental to the Complainant’s Rights.
- 6.13 The Respondent has not submitted any Response to the Complaint, and accordingly there is no explanation from the Respondent as to why it chose the Domain Name and used it in the manner described. Further, the Respondent has not put forward any arguments as to why the Domain Name is not an Abusive Registration.
- 6.14 The Expert is therefore satisfied that the Domain Name is an Abusive Registration.

## **7. Decision**

- 7.1 The Expert finds that the Complainant has Rights in the mark RBS which is identical or similar to the Domain Name, and further that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name should be transferred to the Complainant.

**Signed      Ravi Mohindra                      Dated      19 October 2012**

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<sup>1</sup> The Experts’ overview is a document put together by Nominet’s panel of Experts which deals with a range of issues that come up in DRS disputes. It is published on Nominet’s website at: [http://www.nominet.org.uk/digitalAssets/39192\\_DRS\\_Expert\\_Overview.pdf](http://www.nominet.org.uk/digitalAssets/39192_DRS_Expert_Overview.pdf).