

DISPUTE RESOLUTION SERVICE

D00011829

Decision of Independent Expert

The Royal Bank of Scotland Group plc

and

Ultimate Money Claims

1. The Parties:

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

Respondent: Ultimate Money Claims
1494 Pershore Road
Birmingham
B30 2NT
United Kingdom

2. The Domain Name:

rbspicclaimsuk.co.uk

3. Procedural History:

25 August 2012 21:21 Dispute received
28 August 2012 11:27 Complaint validated
28 August 2012 11:37 Notification of complaint sent to parties
14 September 2012 02:30 Response reminder sent
19 September 2012 10:31 No Response Received

19 September 2012 10:32 Notification of no response sent to parties

27 September 2012 10:33 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is The Royal Bank of Scotland Group Plc, founded in 1727 and incorporated as a public limited company in the UK in 1968;
- 4.2 The Respondent is an unknown individual who trades as Ultimate Money Claims;
- 4.3 The Complainant offers its financial services worldwide under the mark RBS. It has spent a significant amount of money promoting and developing this mark;
- 4.4 The Complainant owns an international portfolio of registered trade marks which consist of or include the mark RBS. The Complainant also owns a large portfolio of domain names which include or consist of the mark RBS;
- 4.5 The Domain Name was registered by the Respondent on 28 March 2012 and is used by the Respondent to direct traffic to a site where you can fill out your details and get in touch with its client services team in respect of claiming compensation and reclaiming premiums for mis-sold payment protection insurance by the Complainant and other financial institutions;
- 4.6 The Complainant sent the Respondent a cease and desist letter on 11 June 2012. There has been no response to that letter.

5. Parties' Contentions

Complainant

- 5.1 In summary the Complainant makes the following submissions:
 - 5.1.1 The Complainant has Rights in the name or mark RBS by virtue of its substantial and widespread 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 incorporates or consists of the word RBS;
 - 5.1.2 The Domain Name was registered by the Respondent decades after the Complainant had registered its UK trade

marks and .co.uk domain names for the name RBS;

- 5.1.3 The RBS mark has substantial inherent and acquired distinctiveness, and this is recognised across the whole of the Community;
- 5.1.4 The dominant and distinctive part of the Domain Name comprises the word rbs, which is identical to the Complainant's trade mark RBS which has been registered by the Complainant as trade marks and domain names in numerous countries all over the world. The remainder of the domain name consists of the generic term "ppiclaimsuk". PPI is short for "payment protection insurance" and can easily be related to the Complainant and its services. To support its case the Complainant refers to DRS case D0005761 where the panellist found that the name or mark Natwest was the distinctive component of the domain name natwest-ibank.co.uk. The addition of the words ibank was found to be of no significance;
- 5.1.5 The Domain Name is confusingly similar to the Complainant's world famous trade mark RBS and the fame of this trade mark has been confirmed in numerous decisions under both the UDRP and DRS before WIPO, NAF and Nominet;
- 5.1.6 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 trade marks of the Complainant;
- 5.1.7 By using the trade mark RBS as a dominant part of the Domain Name, the Respondent is unfairly exploiting the goodwill and the image of the RBS trade mark which may result in dilution and other damage to the Complainant's trade mark;
- 5.1.8 There is considerable risk that a member of public will perceive the Respondent's Domain Name either as a domain name owned by the Complainant or infer some kind of commercial relation between the Respondent and the Complainant and therefore there will initial interest confusion;
- 5.1.9 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;
- 5.1.10 By utilising the Complainant's registered trade marks, both in the Domain Name and on the website, the Respondent is using the Domain Name to deceive the Complainant's customers into believing the website is managed by the

Complainant and this has an obvious detrimental effect on Complainant's business, including the potential loss of customers. The Complainant refers to DRS case No. 08216 where it was found that because of the distinctive nature of the mark DULUX, where a member of the public sees a domain name that uses the mark DULUX, it will initially associate it with the complainant in that case;

5.1.11 The Complainant has tried to contact the Respondent and has sent it a cease and desist letter on 11 June 2012. No response was received to this cease and desist letter and a further reminder was sent.

Respondent

5.2 The Respondent has not filed a Response. There are therefore no submissions to consider.

6. Discussions and Findings

6.1 Under paragraph 2 of Nominet's Dispute Resolution Service Policy (the "Policy") the Complainant is required to show on the balance of probabilities, that:

- i. it has Rights in a name or mark that is identical or similar to the Domain Name; and
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

i. Complainant's Rights

6.2 As a first step I must therefore decide whether the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

6.3 The Policy defines Rights as including, but not limited to... "rights enforceable under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning". This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.4 The Complainant has had a long established trading history under the mark RBS and owns a number of registered trade marks and domain names consisting of or incorporating the name RBS. There can be no serious doubt that the Complainant has Rights in the word or mark RBS and I am therefore satisfied that the Complainant has provided sufficient evidence of its use of the name and mark

RBS.

- 6.5 I must now decide whether the Domain Name is identical or similar to the name and mark RBS in which the Complainant has Rights. The Domain Name includes the word in which the Complainant has Rights, i.e. the name or mark “rbs” in its entirety. It also includes the words, “ppiclaimsuk” which follow immediately after “rbs”. The question therefore is whether the Domain Name is similar or identical to the name or mark in which the Complainant has Rights, i.e. the name or mark RBS.
- 6.6 It seems to me that the name or mark RBS is the dominant or distinctive part of the Domain Name with the words, “ppiclaimsuk” being more descriptive of the services that the Respondent is offering. I therefore conclude that on the balance of probabilities that the Complainant has rights in a name or mark which is identical or similar to the Domain Name.

ii. Abusive Registration

- 6.7 Abusive Registration is defined in Paragraph 1 of the Policy 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.
- 6.8 This definition allows me to consider whether the Domain Name constitutes an Abusive Registration at any time and not, for example, just the time of the registration/acquisition.
- 6.9 Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may evidence the fact that a domain name is an Abusive Registration and Paragraph 4 of the Policy sets out a non-exhaustive list of the factors which may evidence that the Domain Name is not an Abusive Registration.
- 6.10 The Policy provides for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive registration. The burden of proof is therefore firmly on the Complainant.
- 6.11 The Complainant’s case is, inter alia, that the Respondent has registered and uses the Domain Name taking unfair advantage of the Complainant’s name or mark. The Complainant says that when

a member of the public sees the Domain Name, they will automatically assume there is some kind of commercial relationship between the Respondent and the Complainant due to the incorporation of the Complainant's mark within the Domain Name. In other words, there will be initial interest confusion which has been consistently held by Experts under Nominet's DRS to be enough for a finding of an Abusive Registration.

6.12 I am aware of a number of recent decisions under Nominet's DRS which have involved disputes between major financial institutions such as the Complainant in this case and organisations or individuals offering services connected to the reclaiming of mis-sold PPI policies, such as the Respondent. These cases include DRS11478 *barclays-ppi-reclaim.co.uk*, DRS11828 *rbsppi.org.uk* and DRS 11286 *natwest-ppi-reclaim.co.uk*. The last of those decisions was a decision that I gave as an Expert in July 2012 and without in any way pre-judging the outcome of this Complaint, I think it may be helpful for me to set out the analysis which I set out in this previous case, albeit remembering that the facts of this previous case are not exactly the same as the facts in this case.

"6.15 The central question is therefore whether the Respondent is taking unfair advantage of the Complainant's Rights or is unfairly detrimental to those Rights or is he simply using the Domain Name fairly in relation to his legitimate business to indicate the nature of his services.

6.16 *It is helpful to look at some of the previous decisions under Nominet's DRS. It seems to me that there are three broad categories of case which could be of assistance here. These are all cases where the domain name in issue included the name or mark in which the complainant had Rights and where that mark is well known. These are as follows:*

1. *Cases where the respondent was using the name or mark in which the complainant had Rights without addition or with only the addition of some fairly descriptive words which relate to the complainant's own business – a feature of these cases is that the respondents are usually up to no good and have registered the domain names either to divert customers to their own trading websites or use the domain names as parking pages in order to generate pay per click revenue. One such example of a case that falls into this category is DRS case D00005761 *natwest-ibank.co.uk* which is cited by the Complainant in its Complaint. These cases are usually relatively easy and it is clear that the domain name is being used to create an unfair advantage for the respondent*

and this in turn causes unfair detriment to the complainant's name or mark.

- 2. Reseller cases – these are cases where the respondent operates an online shop which resells the genuine goods of the complainant. These cases are more difficult, although for a number of reasons they have generally been decided in favour of the complainants. I will discuss the relevant tests set out in these cases below;*
- 3. Tribute or Criticism Sites – these cases can be decided either way, but as a rule of thumb the domain names in issue stand a much better chance of being regarded as fair use if the domain name flags up what the visitor is likely to find at the site rather than use the mark without addition. This is set out in the expert's overview as follows:*

A criticism site linked to a domain name such as <ihateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant.

6.17 Returning now to the reseller sites which I described as category 2 above, these were considered by the Appeal Panel in DRS07991 toshiba-laptop-battery.co.uk. In this case the respondent was using the domain name to run a site which sold both Toshiba laptop batteries, other Toshiba accessories as well as other accessories from other manufacturers. The Appeal Panel summarised the principles to be applied as follows:

- 1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case;*
- 2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant;*
- 3. Such an implication may be as a result of "initial interest confusion" and is not dictated only by the contents of the website;*
- 4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's*

incorporation of the domain name was unfair. One such reason is the offering of competitive goods on the respondent's website".

- 6.18 *The present case does not fit squarely into any of these categories although it has some similarities with all three, particularly, in my view, the reseller cases.*
- 6.19 *From the Toshiba laptop battery case, it can be seen that the test is really whether the respondent's use of the domain name is such so as to falsely to imply a commercial connection with the complainant. This implication can be drawn because of, "initial interest confusion", i.e. because the public see the domain name and assume it is connected with the complainant, or it can be for another reason – for example because the public visit the website and assume it is something to do with the complainant.*
- 6.20 *The Respondent says that his registration and use cannot be an Abusive Registration because, inter alia, the Complainant does not provide the same services and therefore the Complainant's mark is only used to identify the nature of the services that the Respondent is providing. I am not sure whether what the Respondent says is completely correct as a matter of fact. Neither side has provided any evidence about it, but I am aware that claims for PPI mis-selling can be made directly to the institutions involved as well as through claims handling services, such as the one run by the Respondent and indeed there has been quite a lot about this in the press in the last few months.*
- 6.21 *In any event and whether or not what the Respondent says about the Complainant offering these services is correct it seems to me to be entirely feasible that a member of the public who is looking to reclaim their premiums or make a claim in relation to mis-sold PPI may well visit the Respondent's website believing it is in some way connected to the Complainant and that it therefore provides a way of claiming or reclaiming these monies directly from the Complainant.*
- 6.22 *One could argue that this is only analogous with the tribute or criticism site point and that the Domain Name is simply flagging up what one can expect to find at the Respondent's website. I do not think however that this analogy holds good. With the tribute or criticism sites, if you go to a site which is linked to the domain names, "IhateNatWest.co.uk" or "IloveNatWest.co.uk", you know what you are going to get, i.e. a site either criticising or praising NatWest. It is very unlikely to be run by NatWest. The Domain Name is however subtly different. It is suggestive of a service that the*

Complainant may well feasibly offer (even if in actual fact it does not) as it is so closely related to the Complainant's business. In my view and on the balance of probabilities this makes it all the more likely that the public will believe that the Domain Name is something to do with the Complainant, regardless of the fact that the Domain Name describes what is to be found at the site."

- 6.13 In this Complaint, the Domain Name resolves to another website at www.ppiclaimtoday.com. This website appears to be organised into a number of sections and the Domain Name resolves to a section which deals specifically with PPI claims related to the Complainant. There are other pages for PPI claims against a large number of other financial institutions such as Abbey National, Alliance & Leicester, Bank of Scotland, etc. All of these sections are subtly different but all give essentially the same kind of information about making PPI claims. This website is operated by an English limited company called Hamiltons Marketing Limited which is regulated by the Ministry of Justice in respect of Claims Management.
- 6.14 In DRS11286 the Respondent argued that he was simply offering a service aimed at assisting the public to reclaim monies that they may be entitled to as a result of the mis-selling of PPI by the Complainant. As this service related specifically to the Complainant, its use of the Complainant's mark in the domain name was only serving to identify its services as such. In this case the Respondent has not filed a Response, but this is clearly an argument that would equally be open to the Respondent here just as it was to the Respondent in DRS11286.
- 6.15 In DRS11286 one of the factors that swayed me in the Complainant's direction was that the website which the domain name linked to included a logo which looked very much like the Complainant's logo and indeed it seemed to me that attempts had been made to make the whole site look like it may be something to do with the Complainant. This is not the case here.
- 6.16 In this case there is however the added factor that the website which the Domain Name ultimately resolves to offers services in relation to PPI claims against a range of financial organisations and not just the Complainant. As discussed above in the line of "re-seller" cases the fact that the Respondent offers the goods of other traders as well as the Complainant's goods is usually indicative of an Abusive Registration and I think in this case it must certainly weigh heavily in favour of the Complainant. It certainly makes it far more difficult to accept that the Respondent is simply using the Domain Name to identify the nature of his services i.e. making claims against the Complainant for the mis-selling of PPI.

- 6.17 My view therefore, and very much on the balance of probabilities, is that the Respondent's use of the Domain Name takes unfair advantage of the Complainant's Rights. Either, members of the public will mistakenly use the Domain Name thinking that it is something to do with the Complainant and will arrive at the website www.ppclaimtoday.com and realise that they are in fact mistaken, or they will arrive at this website and continue to use it still believing that it is something to do with the Complainant (the second of these seems to be more unlikely to me). In either scenario the Respondent has succeeded in attracting traffic to the website at www.ppclaimtoday.com by use of the name or mark RBS which it would not have had without that use. It has therefore taken unfair advantage of the Complainant's Rights.
- 6.18 By way of conclusion therefore, I do think that on the balance of probabilities that the Respondent has registered and/or used the Domain Name in order to take unfair advantage of the Complainant's Rights. I therefore find that on the balance of probabilities that this Domain Name is in the hands of the Respondent an Abusive Registration.

7. Decision

I find that the Complainant has proved, on the balance of probabilities, that it has rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent. I therefore direct that the Domain Name be transferred to the Complainant.

Signed Nick Phillips

Dated 25 October 2012