

**DISPUTE RESOLUTION SERVICE**

**D00013983**

**Decision of Independent Expert**

FIL Limited

and

Fidelity Offshore Limited

**The Parties**

Lead Complainant: FIL Limited

Pembroke Hall

42 Crow Lane

PO Box HM 670

Hamilton

HMCX

Bermuda

Respondent: Fidelity Offshore Limited  
73 King Street  
Manchester  
Manchester (City of)  
M60 8AR  
United Kingdom

## **The Domain Name**

fidelityoffshore.co.uk

## **Procedural History**

1. I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.
  
2. The following is a summary of the procedural steps in this case.

17 March 2014	Dispute received, Complaint validated and notification of the Complaint sent to the Respondent.
03 April 2014	Response reminder sent.
08 April 2014	No Response Received and notification of no response sent to the parties.
23 April 2014	Expert decision payment received.
  
3. There has been compliance with the service provisions of paragraph 2 of the DRS Procedure ('the Procedure') and it is appropriate to make this Decision.

## **Factual Background**

4. The Complainant is FIL Limited ('FIL'), a Bermudan company. The Respondent is Fidelity Offshore Limited. Its address registered with NOMINET is 73 King Street, Manchester, Manchester (City of), M60 8AR, United Kingdom. FIL and its subsidiaries and related companies are international investment fund managers trading under the brand 'FIDELITY' and associated trademarks.
5. The Domain Name was first registered on 1 November 2013. It resolves to a one page website stating, '**Forbidden**. You don't have permission to access / on this server.'

## **Parties' Contentions**

6. As indicated in paragraph 2 above, there has been no Response. The following is a summary of the Complaint: -
  - 6.1 FIL is one of the largest and best-known investment fund managers in the world, providing a full range of financial investment services to private and corporate investors.
  - 6.2 The company was founded over 40 years ago and was formerly named, and traded as, Fidelity International Ltd. FIL and its subsidiaries and related companies offer a range of financial investment services in many countries throughout the world, including the USA and the UK.
  - 6.3 FIL owns a number of UK and Community trade marks consisting of, and incorporating, the word 'FIDELITY', the brand name under which its services and those of its subsidiaries and related companies have been offered during that 40 year period. The trade marks include, but are not limited to, the following, -

- UK trade mark registration no. 2100049 for FIDELITY in Class 36 (investment services, financial management and advice), registered on 6 December 1996;
- UK trade mark registration no. 1310766 for FIDELITY INVESTMENTS in Class 36 registered on 24 May 1991;
- Community trade mark No. 003844925 for FIDELITY in Classes 16 (printed matter) and 36 (financial and investment services) registered on 21 September 2005.

6.4 FIL has a subsidiary, FIL Investment Services (UK) Ltd. ('FIL Investment'), an English company, which is one of the largest investment fund managers in the UK. Since 1979 this subsidiary, and its related companies and predecessors in business have traded in the field of financial services under the brand names FIDELITY and FIDELITY INVESTMENTS as well as other sub-brands preceded by the core name, FIDELITY. By 30 September 2012, FIL Investment had over 660,000 customers in the UK and was responsible for managing assets worth approximately US\$232.8 billion.

6.5 For over 40 years, FIL and its subsidiaries and related companies have advertised their services prominently and regularly under the FIDELITY brand and associated brands and trade marks in national and international print media, including The Financial Times and The Economist.

6.6 For the last 20 years FIL, its subsidiaries and related companies have promoted the services provided under those brands and trade marks on the website [fidelity.co.uk](http://fidelity.co.uk). FIL and those companies have made a substantial financial investment in that period to optimise the visibility of this website. Visitor statistics indicate that FIL has more than a quarter of a million visitors to the website each month. The services

offered on fidelity.co.uk include, but are not limited to, the provision of offshore investment funds and related services.

- 6.7 The Domain Name is an Abusive Registration for the following reasons.
- 6.8 The only distinctive element within the Domain Name, namely the word 'fidelity', is identical to the trade mark 'FIDELITY'. The suffix 'offshore' is descriptive of an aspect of FIL's business, namely offshore fund services. This will only strengthen the perception that the Domain Name refers to FIL's branded financial services business.
- 6.9 The Domain Name was registered on 1 November 2013. It resolves to a website stating that access is 'Forbidden' due to lack of 'permission to access / on this server' (sic).
- 6.10 The Respondent is not previously known to FIL and FIL has not authorised the Respondent to register or use a domain name incorporating any of the FIDELITY trademarks.
- 6.11 In view of the name chosen for the Domain Name and the investment and financial services business operated by FIL and its subsidiaries and related companies under the various FIDELITY brands and trade marks, a typical consumer encountering the website linked to the Domain Name is likely to conclude that it is a website of, or is in some way connected to, FIL.
- 6.12 Therefore, the Domain Name is inherently likely to attract people or businesses searching for a website offering FIL's FIDELITY branded services and those persons encountering the website associated with the Domain Name are likely to assume that it is registered to, operated or authorised by, or is otherwise connected with FIL, in contravention of paragraph 3 of the DRS Policy ('the Policy').

- 6.13 The proper inference to be drawn is that the Respondent registered the Domain Name primarily as a blocking registration and/or for the purpose of unfairly disrupting FIL's business, in further breach of paragraph 3 of the Policy. The registration is prima facie evidence that the Respondent knew of FIL and its financial services business operating under the FIDELITY brand at the time when it registered the Domain Name and that such knowledge prompted the registration.
- 6.14 The Respondent is not known or even commonly known by the Domain Name or words incorporated within it and there is no conceivable legitimate purpose to which the Domain Name could be put.
- 6.15 By letter dated 4 February 2014 FIL's trade mark attorneys wrote to the Respondent at 73 King St, Manchester, M60 8AR, being the address registered with NOMINET for the Respondent, demanding that the Respondent transfer the Domain Name to FIL. The letter was returned by the postal service, because there was no such address and no such person as the Respondent was known there.
- 6.16 Further investigations showed that no English company is registered or has ever been registered, or even has a pending registration, in the name of the Respondent. In other words, the Respondent does not exist. Investigations have also established that the address given for the Respondent is not a postcode in current use, Dun and Bradstreet have no record of the Respondent as existing in any part of the world and discussions with those responsible for operating and managing the premises at that address have confirmed that the Respondent is not known there.
- 6.17 Therefore, the Respondent has given a false name and contact details, which is evidence of bad faith under paragraph 3 of the Policy.

6.18 In all the circumstances, it is overwhelmingly likely that whoever is behind the Respondent was aware of, and sought to benefit from, the inevitable confusion with FIL's FIDELITY brand and trade marks at the time of registration of the Domain Name.

## **Discussion and Findings**

7. The Complainant is required under subparagraphs 2a. and 2b. of the Policy to prove to the Expert on the balance of probabilities that: -

7.1 he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

7.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.

I refer to the matters set out in paragraphs 4 and 5 above and adopt them as findings of fact.

### Rights

8. By paragraph 1 of the Policy, -

*'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.'*

I find that FIL owns the following trade marks, namely –

- UK trade mark registration no. 2100049 for FIDELITY in Class 36 (investment services, financial management and advice), registered on 6 December 1996;

- Community trade mark No. 003844925 for FIDELITY in Classes 16 (printed matter) and 36 (financial and investment services) registered on 21 September 2005;
  - UK trade mark registration no. 1310766 for FIDELITY INVESTMENTS in Class 36 registered on 24 May 1991.
9. In view of FIL's ownership of these trade marks, it is not necessary to make findings in respect of unregistered rights under the law of passing off. The Domain Name has incorporated a word, namely 'fidelity', as the dominant part of the Domain Name, which is the same word as that of one of FIL's UK trademarks and the same as its Community trade mark, FIDELITY. The Domain Name incorporates the dominant part of FIL's UK trade mark FIDELITY INVESTMENTS. Each of those marks are similar to the Domain Name.<sup>1</sup>
10. Therefore, I conclude that the Complainant owns Rights in a mark, namely 'FIDELITY', which is similar to the Domain Name. Thus, the Complainant has established that it has Rights.

#### Abusive Registration

11. By paragraph 1 of the Policy, -

*'Abusive Registration means 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.'*

By paragraph 3 of the Policy, -

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<sup>1</sup> Under the DRS the .co.uk suffix is ignored for the purposes of the comparison.



***‘3. Evidence of Abusive Registration***

*a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*

*i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*C. for the purpose of unfairly disrupting the business of the Complainant;*

*ii. 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 to, operated or authorised by, or otherwise connected with the Complainant;*

*iii. ....*

*iv. It is independently verified that the Respondent has given false contact details to us;*

*v. ....*

*b. Failure on the Respondent’s part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.*

*.....’*

12. The Appeal Panel in DRS 04331 *verbatim.co.uk* determined that, for a complaint to succeed, -

*“the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name.”*

I adopt that approach, which is appropriate to this type of case.

13. FIL is a very substantial and well known investment fund management business, providing a wide range of financial investment services to private and corporate investors throughout the world. The company was founded over 40 years ago and was formerly named, and traded as, Fidelity International Ltd. FIL and its subsidiaries offer a range of financial investment services in many countries throughout the world, including the USA and the UK. FIL's UK trading subsidiary is Fidelity Investment and as at 30 September 2012, this subsidiary was responsible for looking after assets worth in the region of US\$232.8 billion and had more than 660,000 customers. Since 1979 Fidelity Investment and its related companies and predecessors in business have traded in the field of financial services under the brand names FIDELITY and FIDELITY INVESTMENTS as well as other sub-brands preceded by the core name, FIDELITY.
14. Throughout the 40 years of its operations, FIL and its subsidiaries and related companies have advertised their services prominently and regularly under FIDELITY and associated brands and trade marks in national and international print media, including The Financial Times and The Economist. For the last 20 years, FIL and FIL Investment in particular have promoted the services provided under those brands and trade marks on the website fidelity.co.uk. FIL and those companies have made a substantial financial investment in that period to optimise the visibility of this website, which has more than a quarter of a million visitors each month. The services offered on fidelity.co.uk include, but are not limited to, the provision of offshore investment funds and related services.
15. Therefore, the business operated under the FIDELITY brands and trademarks was in existence for many years before the date of first registration of the Domain Name. No explanation has been put forward by or on behalf of the Respondent at any stage for the reason why a domain name which contained the word 'fidelity' was chosen, let alone one to which was added an appendage appropriate to the Complainant's field of activity, i.e. the word 'offshore', which is descriptive of offshore fund services, an important part of the business carried on under the FIDELITY brands and trade marks.

16. The extracts from the register held at Companies House show that there is no English company registered in the name of the Respondent, Fidelity Offshore Ltd, nor any pending registration nor a dissolved company, by that name.
17. It is possible that the Respondent exists, albeit not as an English company. However, in view of the contents of the investigators' report commissioned by the Complainant, this is unlikely. The investigators went to the premises and interviewed the receptionist/caretaker who has worked for 4 years at the 73 King Street premises, a ten floor multi-tenanted office block. He said that no company by the name Fidelity Offshore Ltd. has had a presence in the building at any time during that period.<sup>2</sup> The managing agents have also confirmed to the investigators that no company bearing the Respondent's name has a presence within the building. Dun & Bradstreet also hold no record of a company by that name as existing in any part of the world. The report also found that there were no online references to the Respondent, with the exception of the website linked to the Domain Name. As indicated, that website contains a single page refusing 'permission to access.'
18. In the light of these matters, I find that the person or persons behind the registration of the name 'fidelityoffshore.co.uk' were not only aware of the Complainant's brand when the Domain Name was first registered but also deliberately targeted the Complainant's brand name FIDELITY by registering the Domain Name. There is no other sensible explanation on the evidence for the choice of Domain Name, itself highly suggestive of the (offshore) investment business carried on under FIL's brand names, and registered in the name of a non-existent company, which itself copies the main brand name, coupled with an appendage, i.e. 'offshore', implying a connection with the investment business carried on under the FIDELITY brands and trade marks.
19. I accept FIL's case on confusion and its case on Abusive Registration under paragraph 3a.ii. of the Policy. The Domain Name is inherently likely to attract consumers or businesses looking for a website relating to FIDELITY branded

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<sup>2</sup> Although the post-code for the registered address is incorrect because it is 'out of date' as the report states, it is not clear when it changed, and it may have once been a legitimate postcode for that address.

services by searching online using Google or another search engine. Consumers and businesses searching for the offshore business carried on under the FIDELITY brands and trade marks are also likely to guess the URL of the website operating the FIDELITY branded offshore investment business. Those persons visiting the website linked to the Domain Name would do so in the hope and expectation that this website is a website of, or is in some way connected with, FIL. As a result, such a visitor will have suffered 'initial interest confusion' from the search and that confusion is sufficient for the purposes of paragraph 3a.ii. of the Policy.

20. On encountering the website linked to the Domain Name, the confusion is unlikely to be dispelled for a significant number of the visitors who have been 'sucked in' by the Domain Name and they would be likely to conclude that the website operated by the business trading under the FIDELITY brands is 'down' or there is some other temporary technical problem with it.
21. The Respondent is not previously known to FIL and FIL has not authorised the Respondent to register or use a domain name incorporating any of the FIDELITY trademarks.
22. Therefore, in view of the findings set out in paragraphs 13-21 above, there are circumstances indicating 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, operated or authorised by, or otherwise connected with, the Complainant within the meaning of paragraph 3a.ii. of the Policy.
23. I have already concluded that the person or persons behind the Respondent deliberately targeted the business associated with the FIDELITY brand by choosing the name 'fidelityoffshore.co.uk' as the Domain Name. It would have been obvious to them that confusion would result from that choice of name among consumers or businesses searching for the business carried on under the brand. There is no evidence that the website was being prepared for the operation of any business that was not designed to trade off the back of the Complainant's brand. The clear inference from the matters set out in this

paragraph and in paragraphs 13-19 and 21 above is that the targeting of the business carried on under the Complainant's brand was done with a view to deceiving consumers or businesses into believing that the Domain Name was the domain name of the business carried on under the FIDELITY brands. The obvious purpose of registering the Domain Name was to cause that confusion.

24. In those circumstances, the Domain Name was registered primarily for the purpose of unfairly disrupting the business of the Complainant, within the meaning of paragraph 3a.i.C. of the Policy.
25. No circumstances falling within paragraph 4 of the Policy (grounds on which a registration may not be abusive) have been put forward in support of the continued registration of the Domain Name. It follows from the conclusions I have reached, that any such grounds would not be made out.
26. Therefore, I find that the Complainant has established each of the grounds under paragraphs 3a.i.C and 3a.ii. of the Policy and that in all the circumstances, the registration is an Abusive Registration within paragraph 1.i and 1.ii of the Policy.

## **Decision**

27. The Complainant has Rights in a name or mark, which is similar to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore determines that the Domain Name 'fidelityoffshore.co.uk' be transferred to the Complainant.

**Signed .....**

**Dated 13.05.14**

**STEPHEN BATE**