

Nominet UK Dispute Resolution Service

DRS 14176

Royal Bank of Scotland Group PLC

and

Graham Kenny

Decision of Independent Expert

1 Parties

Complainant: Royal Bank of Scotland Group PLC

Address: 36 St. Andrew Square
Edinburgh

Postcode: EH2 2YB

Country: United Kingdom

Respondent: Graham Kenny

Address: 8 St. Pauls Road
Torquay

Postcode: TQ1 3QF

Country: United Kingdom

2 Domain name

<rbs-ppi-reclaim.co.uk>

3 Procedural History

- 3.1 On 7 May 2014 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent on the same day. The respondent’s response was received on 28 May 2014, and the complainant’s reply on 2 June 2014. The matter was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 1 July 2014 paid the applicable fee. On 9 July 2014 the respondent sent a non-standard submission, which I decided on 30 July to see.
- 3.2 I was appointed as expert on 22 July 2014. I have made the necessary declaration of impartiality and independence.

4 Factual background

- 4.1 The complainant is a well known bank and financial services provider.
- 4.2 The respondent registered the domain name on 18 July 2012.

5 Parties’ Contentions

Complainant

- 5.1 The complainant says it is the proprietor of the trade mark “RBS”, under which it offers financial services worldwide. It also operates websites at <rbs.com> and <rbs.co.uk>.
- 5.2 It argues that the dominant element of the domain name is “rbs”, which is identical to its trade mark. The remainder of the domain name consists of strings which it says can easily be related to the complainant and its payment protection insurance (“PPI”) services. The domain name is clearly similar to its trade mark, it argues.
- 5.3 The complainant says that because it offers its own direct PPI reclaim service, consumers may think the domain name is operated or endorsed by it. Indeed it says anyone who sees the domain name is bound to think it is related to the complainant.
- 5.4 It also argues that the past and present appearance of the respondent’s website may give rise to confusion.
- 5.5 By using the trademark as a dominant part of the domain name, the complainant argues that the respondent exploits the complainant’s goodwill and image. It says this may result in damage to its trade mark and business.
- 5.6 The complainant says it does not oppose the service offered by the respondent, but that any confusion between the complainant and the respondent must be avoided.

Respondent

- 5.7 The respondent says he is the director of a company offering PPI refund and compensation services to clients who have been mis-sold PPI by financial institutions.
- 5.8 He says the complaint is an attempt to strangle a legitimate business. His website simply allows people who have suffered at the hands of the complainant to make a claim whilst making it clear that there is no connection to the complainant.
- 5.9 The respondent argues that elements of the layout of the website connected to the domain name prevent confusion between the domain name and the complainant. These include the use of different colours for the letters "RBS", the lack of any RBS logo, and the use of a different font.
- 5.10 The respondent says he has put a prominent disclaimer on the website making clear it offers an independent claims service, unconnected to the complainant.
- 5.11 He says the complainant has produced no proof that there has in fact been any customer confusion, or that it has actually suffered damage or loss.
- 5.12 The respondent argues that the domain name and website simply attracts members of the public who wish to claim against the complainant. It says it did not take unfair advantage when it registered the domain name, and has not used it in a manner which has taken unfair advantage of them.
- 5.13 The respondent essentially repeats many of these points in his non-standard submission. He again says he has made changes to the website.
- 5.14 In his non-standard submission the respondent argues that any detriment to the complainant from his use of the domain name would not be unfair because, he says, the complainant has made serious failings in relation to the mis-selling of PPI.
- 5.15 The respondent argues that the presumption under paragraph 3(c) of the Policy is not absolute, and can be rebutted.
- 5.16 He also argues that the complainant's use of the DRS is unfair since, he says, he has complied with all the requirements it had made, and which it said in correspondence it would accept.

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities that:
- it has rights in respect of a name or mark which is identical or similar to the domain name, and that

- the domain name, in the hands of the respondent, is an abusive registration.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has produced documentary evidence from the UK Intellectual Property Office and from the Office for Harmonization in the Internal Market of its UK and Community trade mark registrations for the mark "RBS". There is no dispute that it owns the domains <rbs.com> and <rbs.co.uk>.
- 6.4 At the third level (i.e. disregarding "co.uk"), the first and arguably dominant element of the domain name is the three letter string "rbs", which corresponds to the complainant's trade mark. The inclusion of the complainant's mark at the beginning of the domain name means that similarity to the complainant's mark is built in to it.
- 6.5 The inclusion of additional characters does not make the domain name dissimilar to the mark. They are naturally read (because divided from each other, and from the string "rbs", by hyphens) as consisting of the strings "ppi" and "reclaim", both of which make up words with a clear conceptual connection to the complainant's PPI business or PPI claim service.
- 6.6 In those circumstances, I am satisfied that the complainant has rights in respect of a mark which is similar to the domain name.

Abusive Registration

- 6.7 Under paragraph 1 of the Policy, abusive registration means a domain name which either:
 - 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
 - has been used in a manner which took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.8 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using a domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.9 Given that the domain name includes the complainant's name together with additional words which may support an inference that the domain name is connected to the complainant, in my view some initial interest confusion is likely between the domain name and the complainant.
- 6.10 My view is not affected by what the respondent says about the appearance of the website connected to the domain name, or by the changes he has made to it.

Firstly, initial interest confusion seems to me to have been and to be likely before any actual visit to the website. Secondly, even to the extent that initial interest confusion may be “cured” on arrival at the website, in my view that has not been clearly achieved in this case. The respondent seems not to dispute that a disclaimer on the website has not always been present. Even the disclaimer shown in the latest screenshot produced by the respondent in his non-standard submission does not seem to me to be “prominent”. And the respondent in his non-standard submission admits, as screenshots produced by the complainant show, that the website did at one time prominently display the letters “RBS”.

6.11 Furthermore, in relation to the question of abusive registration, the appeal panel in *Toshiba Corporation v Power Battery Inc* (DRS 07991, <*toshiba-laptop-battery.co.uk*>) analysed the principles to be applied when assessing the legitimacy of a reseller’s incorporation, within a domain, of the complainant’s trade mark.

6.12 This case does not involve reselling of the complainant’s goods, of course. However it does involve a respondent carrying on a business which relates to the complainant’s products or services, and whose potential clients already are or have been customers of the complainant. So the principles laid down by the *Toshiba* appeal panel do seem to me potentially of assistance.

6.13 The appeal panel’s decision in that case is not binding on me, but does have persuasive force.

6.14 The appeal panel summarised the applicable principles 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 the result of “initial interest confusion” and is not dictated only by the content 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 is unfair. One such reason is the offering of competitive goods on the respondent’s website.

6.15 The appeal panel went on to explain further its approach to the fourth principle:

The further issue, however, is whether the fact of the offering of competitive products on the Respondent’s website is sufficient to render the registration abusive, even in the absence of “initial interest confusion”. On this question, the Panel unanimously considers that, if and insofar as it is fair for a retailer to incorporate a trade mark into its domain name without the trade mark owner’s consent, to accord with the principles stated above that fairness is likely to be dependent upon the retailer only selling the trade mark owner’s genuine products. To do otherwise is likely to take unfair advantage of the Complainant’s rights by “riding on its coat-tails” for the benefit of the Respondent. This element of unfair advantage remains, even where little or no detriment to the Complainant has been demonstrated.

- 6.16 I have already explained at paragraphs 6.8-10 my view that some initial interest confusion is likely in this case. Applying the second and third principles set out by the *Toshiba* appeal panel, this is suggestive of abusive registration.
- 6.17 But even if I am wrong about initial interest confusion, applying the fourth *Toshiba* principle there is another reason why the respondent's use of the domain name is unfair – namely, the offering of competitive services on the respondent's website.
- 6.18 The complainant has produced evidence in the form of a screenshot showing that it offers its own direct PPI reclaim service. The respondent's service competes with this, since from a potential claimant's point of view, each service is directly substitutable for the other.
- 6.19 In my view this would be so even if one of the competing reclaim services were said to offer higher quality or added value at greater cost than the other, and regardless of whether either of the services were offered free. I make no findings on any of those matters, about which I have no evidence.
- 6.20 It might conceivably be argued that for the purpose of the fourth *Toshiba* principle, what the respondent has done is analogous to reselling only a manufacturer's own goods, which typically involves some profit to the reseller. But I would reject that argument. A reseller of a manufacturer's own goods offers precisely those goods, and nothing more, without repackaging. The respondent could only replicate that commercial activity through a website connected to the domain name by linking to the complainant's own reclaim service, without more. In contrast, the respondent here is offering his firm's own PPI reclaim service.
- 6.21 It might conceivably be argued that the “competition” aspect of the fourth *Toshiba* principle is inapt to be applied in a case like this because retail goods and services markets have different characteristics. While it is possible for a reseller (the argument would run) to sell only the complainant's genuine goods, that is impossible in the PPI claims market. A legitimate PPI claims firm like the respondent cannot (unlike a reseller of goods) itself offer a financial services institution's own claim service. It should not therefore be treated under the Policy like a reseller which chooses to offer “competitive” goods.
- 6.22 But the argument would be flawed. Just because the particular characteristics of a retail goods market may give rise to particular facts, to which the Policy may apply in a particular way, it does not follow that the Policy must apply differently to goods and services markets where actually they throw up similar facts. It cannot be fair under the Policy for a PPI claims company to compete against a complainant using a domain name incorporating its trade mark without consent where (all other relevant circumstances being equal) it would be unfair for a goods reseller to do the same. To the extent that such competition does in fact occur in each type of market, there is no reason why the Policy should not apply in the same way. Beyond that, parties must take the characteristics of their particular markets as they find them.
- 6.23 Although *Toshiba* is not binding on me, in my view it is right to apply the same principles. Doing so in my view achieves a substantively fair outcome, bearing in

mind the overriding definition of “abusive registration” in the Policy, and that the question of unfair advantage from or unfair detriment to the complainant's rights is key.

- 6.24 I say that because, although not a “reseller” case, this is an analogous situation in which the respondent has incorporated a trade mark into its domain name without the trade mark owner's consent, and by doing so has taken advantage of the complainant by “riding on its coat-tails” to offer his own firm's service.
- 6.25 The respondent in his non-standard submission has made three arguments which I will now address in turn.
- 6.26 The respondent has argued that any detriment to the complainant is not unfair because of what he says are the complainant's serious failings in relation to the mis-selling of PPI. I doubt that making any judgment on the complainant's conduct towards its PPI customers (about which I make no findings) is within the scope of the DRS, or really relevant to this case. Even if I am wrong about that, the respondent has produced nothing like the kind of evidence that would be required to justify causing what would otherwise be an unfair detriment to the complainant's rights.
- 6.27 The respondent has made submissions about paragraph 3(c) of the Policy. But the complainant has not tried to prove that the respondent has been found to have made an abusive registration in three or more DRS cases in the last two years. Paragraph 3(c) of the Policy does not apply in this case, and I make no such presumption.
- 6.28 The respondent has argued that the complainant's use of the DRS is unfair since he has made all the changes to his website that the complainant has required, and said in correspondence that it would accept. But (assuming what he says is correct) the expert's function is not to hold the parties to everything they say in correspondence, but to apply the Policy. Nothing the respondent has said makes me think a decision upholding the complaint would be unfair or unconscionable.
- 6.29 To summarise my conclusions, there is probably initial interest confusion between the domain name and the complainant, which is evidence of abusive registration. In addition, applying the *Toshiba* principles, the respondent's use of the domain name is in any event unfair because he has used it to offer services competing with those of the complainant.
- 6.30 In my view therefore, 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.
- 6.31 In those circumstances I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

7 Decision

- 7.1 I find that the complainant has rights in a mark which is similar to the domain name; and that the domain name, in the hands of the respondent, is an abusive

registration.

- 7.2 The complaint is upheld. I direct that the domain name be transferred to the complainant.

Carl Gardner

14 August 2014