

Dispute Resolution Service

DRS 19798

Decision of an Independent Expert

The PNC Financial Services Group, Inc.

and

AIB Pacific

1. Parties

Complainant: The PNC Financial Services Group, Inc.
One PNC Plaza
249 Fifth Avenue
Pittsburgh
PA
15222
United States

Respondent: AIB Pacific
51 Embry Way
Stanmore
Greater London
HA7 3AY
United Kingdom

2. Domain Name

pnccrypto.uk (the "Domain Name")

3. Procedural Background

On 29th January 2018 the Complaint was lodged with Nominet UK Limited (“Nominet”) and it was validated on 30th January 2018. On 30th January 2018 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising it to log into its account to view the details of the Complaint, and giving it 15 business days within which to lodge a Response on or before 20th February 2018. On 16th February 2018 Nominet sent the Respondent a Response reminder. No Response was received by 21st February 2018. On 21st February 2018 Nominet sent the notification of no response to the parties. On 21st February 2018, the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 23rd February 2018 Mr. Niall Lawless (“the Expert”) was appointed to act as Expert in this dispute. He is required to give his Decision by 21st March 2018. The Expert has confirmed that he knows of no reason why he could not properly accept the appointment, and knows of no matters which ought to be drawn to the attention of the parties which might appear to call in to question his impartiality and -/- or independence.

4. Outstanding Formal or Procedural Issues

There are no outstanding formal or procedural issues.

5. Factual background

The Complainant, the PNC Financial Services Group, Inc. is a Pennsylvania corporation, with its principal place of business located at Fifth Avenue and Wood Street in Pittsburgh, Pennsylvania, USA. The Complainant is one of the largest diversified financial services institutions in the USA providing retail and business banking, residential mortgage banking, corporate banking, asset management and wealth management services.

The Respondent registered the Domain Name on 2nd October 2017.

6. The Parties’ contentions

The Complainant

The Complainant seeks transfer of the Domain Name. The Complainant says that the Respondent is not affiliated with it in any way, and that the Domain Name is an abusive registration under Nominet’s DRS Policy because the:-

- Domain Name is confusingly similar to the Complainant's registered and common-law PNC trademarks;
- Website that the Domain Name resolves to deceptively and falsely misappropriates the Complainant's identity, slavishly counterfeiting the Complainant's PNC service and trademarks;
- Respondent uses the Domain Name to divert Internet users away from the Complainant's websites to a fraudulent website that offers cryptocurrency products and services under the PNC trademark and logo;
- Complainant currently does not trade in cryptocurrency, and that the Respondent's use of the Domain Name to offer cryptocurrency unfairly damages and disrupts the Complainant's business and reputation;
- Only reasonable explanation for the Respondent copying the Complainant in this way is that the Respondent intended to confuse people into believing that its' business was the Complainant's or connected with it;
- Respondent falsely represents itself as affiliated with the Complainant through the use of the Domain Name and website;
- Respondent attempts to capitalise on the fame and substantial goodwill the Complainant has established in the PNC marks in order to deceive consumers into frequenting its website for Respondent's commercial benefit.

The Respondent

The Respondent has not responded to the Complaint.

7. Discussions and Findings

7.1 General

Nominet's DRS Policy requires that for a Complaint to succeed the Complainant must 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

7.2 Complainant's Rights

The Complainant is the registered proprietor of a variety of United States registered Service Marks containing or consisting of the terms "PNC"; for example "PNC", "PNC BANK", and "PNC CAPITAL MARKETS". The Complainant is the registered proprietor of a European Union trademark containing or consisting of the terms "PNC". The Complainant has registered and operates an expansive range of websites across the world using the PNC trademark, for example, <PNC.com>, <PncCapital.com>, <PncCapitalAdvisors.com> and <PncBank.com>.

The first and dominant element of the Domain Name is "PNC", which is the same as the distinctive component of the Complainant's name, and the same as the Complainant's PNC service and trademarks. The addition of the generic term "crypto" does not detract from the obvious similarity with the distinctive element PNC. Because of this, based on the evaluation of all evidence presented, the Expert decides that, ignoring the ".co.uk" suffix for this purpose, the Complainant has Rights in respect of a name or mark that is very similar to the Domain Name.

7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy. Under paragraph 5 - Evidence of Abusive Registration - guidance is given as to what factors may be evidence that the Domain Name is an Abusive Registration.

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

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the

Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

*5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or
5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;*

5.1.2 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.”

Confusion

The Complainant says that the website that the Domain Name resolves to deceptively and falsely misappropriates the Complainant's identity, slavishly counterfeiting the Complainant's PNC service and trademarks. It says that the Respondent uses the Domain Name to divert Internet users away from the Complainant's websites to a fraudulent website that offers cryptocurrency products and services under the PNC mark and logo. The Complainant says that the only reasonable explanation for the Respondent copying the Complainant in this way is that the Respondent intended to confuse people into believing that its' business was the Complainant's or connected with it.

The Respondent has not responded to the Complaint.

The Complainant is the registered proprietor of a variety of United States registered service marks containing or consisting of the terms "PNC"; for example "PNC" Registration No. 1,416,898, "PNC BANK" Registration No. 1,863,311, and "PNC CAPITAL MARKETS" Registration No. 2,162,648. The Complainant is the registered proprietor of a European Union trademark containing or consisting of the terms "PNC" Reg. No. 001713585.

In addition to the above the Complainant is the registered proprietor of a United States registered "PNC (Design Only) Mark" Registration No. 2,665,477. This PNC (Design Only) Mark, was filed on 6th February 2001, issued on 24th December 2002, covering a range of financial and banking services in International Class 36.

On the date of this Expert Decision the Domain Name is not resolving to a website. However, in the Complainant's bundle of documents at Exhibit 11 the Complainant includes undated screenshots of webpages promoting a PNC Foundation "Financial, Technology & Next Generation Cryptocurrency".

One of the screenshots states that *“The PNC Foundation is endorsed by an international network, compiled of a wealth of experience in IT, entrepreneurship, business processes, trading, property and asset development, international management and academia. We responsibly provide blockchain services that enable growth and economic progress.”*

The webpages published by the Respondent are adorned with the term “PNC” as well the “PNC (Design Only) Mark” Registration No. 2,665,477. The Respondent has used the PNC logos to fashion a faux gold gilded coin which is promoted as cryptocurrency.

Under the Policy paragraph 5, one factor that may be evidence that the Domain Name is an Abusive Registration is *“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 ...”*.

Confusion would arise where the Internet user incorrectly assumes that the website the Domain Names resolves to, and the Complainant’s other official websites are either both authorised by or belong to the Complainant.

The Respondent has brazenly used the term PNC, and prominently displayed a faux gold gilded coin fashioned from the PNC logos in the webpages it published. The Expert therefore considers that it is very likely that an internet user arriving at the website linked to the Domain Name would assume that it relates to goods or services provided by the Complainant, and be confused into believing that it is a domain and site owned and provided by the Complainant.

Accordingly, the Expert concludes that the Respondent’s use of the Domain Name is abusive under paragraph 5.1.2 of the Policy.

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name identical or similar to the Domain Name and the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

8. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name be transferred to the Complainant.

Niall Lawless, Nominet Expert

28th February 2018