



DISPUTE RESOLUTION SERVICE

DRS 20037

Decision of Independent Expert

Pre-Paid Legal Services, Inc.

Complainant

and

Justin Petszaft

Respondent

1 The Parties

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|--------------|--|
| Complainant: | Pre-Paid Legal Services, Inc. |
| Address: | One Pre-Paid Way Ada Oklahoma 74820 United States of America |

| | |
|-------------|--|
| Respondent: | Justin Petszaft |
| Address: | 2 Leylands Manor Tubwell Lane Crowborough TN6 3RH United Kingdom |

2 The Domain Name

idshield.co.uk (the "Domain Name").

3 Procedural History

I 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, which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

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|----------------|---|
| 12 April 2018 | Dispute received |
| 16 April 2018 | Complaint validated |
| 16 April 2018 | Notification of complaint sent to parties |
| 04 May 2018 | Response reminder sent |
| 09 May 2018 | Response received |
| 09 May 2018 | Notification of response sent to parties |
| 14 May 2018 | Reply reminder sent |
| 16 May 2018 | Reply received |
| 16 May 2018 | Notification of reply sent to parties |
| 16 May 2018 | Mediator appointed |
| 21 May 2018 | Mediation started |
| 24 July 2018 | Mediation failed |
| 30 July 2018 | Close of mediation documents sent |
| 09 August 2018 | Complainant full fee reminder sent |
| 13 August 2018 | Expert decision payment received |

4 Factual Background

- 4.1 The Domain Name was registered by the Respondent on 11 February 2007.
- 4.2 The Complainant is a US based provider of insurance products. The Respondent's status is unclear. He is based in south east England.
- 4.3 The Domain Name does not appear currently to be in use.

5 Parties' Contentions

Complaint

- 5.1 The Complainant asserts that it owns a UK registered trade mark number 3194730 in IDSHIELD and provides a copy registration certificate demonstrating that registration is effective as of 3 November 2016. It refers to a website at www.idshield.com and to screen shots from that website which it says are attached to the Complaint, though in fact they have been omitted. However, on enquiry, it appears that the website advertises insurance policies against the risk of identity theft, under the name IDSHIELD.
- 5.2 The Complainant says that it has been at the forefront of innovative insurance products for the legal services sector for 45 years. It says that since 2011 it has operated "principally under their LegalShield trade mark", and has diversified "to additionally offer insurance products in relation to theft and identity protection". It says that "IDShield was born on 18 May 2015 in United States", which presumably is the date on which it started to trade by reference to the IDSHIELD name.
- 5.3 As to Abusive Registration, the Complainant contends, in the first place, that the Respondent "has no obvious connection with the Domain Name". It says that Companies House records

disclose that the Respondent is the managing director of six UK companies, none of which has any connection with the Domain Name.

- 5.4 Further, it says that "it is not clear" how the Respondent came to register the Domain Name or what his intentions were in registering a domain name "which wholly incorporates the Complainant's registered trade mark". Accordingly, the Complainant contends that "there is no obvious legitimate basis for registration".
- 5.5 The Complainant asserts that the "existence and use of the Domain Name" will "invariably" cause confusion "where the Complainant owns earlier registered trade mark rights and unregistered trade mark rights as a result of the considerable trading goodwill and reputation under the trade mark IDShield in United Kingdom". No details, let alone any evidence, of such purported trading goodwill are or is provided.
- 5.6 The Complainant also asserts that the Domain Name constitutes a blocking registration in the United Kingdom which is unfairly disrupting its business, the position being aggravated by the fact that "the Respondent has no reasonable justification for having registered the Domain Name".
- 5.7 That is the sum total of a very brief and vague complaint, supported by only two items of evidence, a copy registration certificate in respect of the IDSHIELD UK trade mark and a print out from the IPO website evidencing the same thing.

Response

- 5.8 The Respondent says that he plans to use the Domain Name to "host the interface for an anonymisation service which would allow the public to interact with companies without the company involved knowing the identity of the individual purchasing or interacting with their service. Data about the users generated through their interactions would belong to the users, and the platform would allow them to monetise it by letting 3rd parties run anonymised queries against it".
- 5.9 The Respondent points out that "at the moment companies have all the power – collecting data and using it for (virtually) whatever they want. This initiative seeks to balance the scales, putting people back in control of their personal data, and limiting the data taken by companies interacted with using the service to the minimum required in order to operate". The Respondent explains that this proposed service "would also act as a source of trusted answers, enabling a company selling age restricted products to answer whether the customer was over a certain age and receive an authoritative answer – 'is a customer over 18?', response: 'Yes'. All this without having to know the user's age or even date of birth".
- 5.10 The Respondent concedes that he registered the Domain Name "a long time ago", but says that he has been "waiting for the right time to build and launch the service". He says that "with the recent revelations about how personal data has been harvested from Facebook, the time is now right to launch this service and there will be significant demand for it".
- 5.11 The Respondent refutes the suggestion that his registration of the Domain Name was abusive, asserting that it was "made in good faith". In support of this contention, he says that his proposed service is neither similar to nor likely to be confused with the Complainant's service "as the services are in no way alike".
- 5.12 Further, he points out that the Complainant's *idshield.com* domain name has not been in use until relatively recently and that his registration of the Domain Name "significantly predates the Complainant's use of either the term 'ID Shield' or the domain idshield.com".

- 5.13 He points out that, according to the Wayback Machine archive, no website is shown on the idshield.com domain before 1 August 2015.
- 5.14 In addition, he makes the point that the registered trade mark relied upon by the Complainant was not registered until 2017 "almost a decade after I registered idsheld.co.uk".
- 5.15 He asserts that the Complainant appears from its website only to operate in the United States and Canada and has no presence in the UK. Accordingly, he contends that "rather than seeking to have my domain name transferred to them to prevent confusion, they are in fact seeking to have it transferred to them so that they can use it to launch an as yet non-existent service".
- 5.16 The Respondent says that the Complainant is "a huge company with vast resources", which must therefore have been aware of the existence of the Domain Name for a number of years but chose neither to register a UK trade mark nor contact him about the Domain Name, which "suggests that the Complainant did not consider idshield.co.uk to be an issue during that substantial period, and has only recently decided that they would like to have my domain name". He says that it was the Complainant's choice to build a business in the knowledge that the Domain Name existed and without any reasonable expectation that it would be able to obtain it.
- 5.17 The Respondent describes as "manifestly false" the Complainant's claim to prior registered and unregistered trade mark rights in the UK, pointing out that it has failed to provide any evidence of trading goodwill and reputation in the UK. The Respondent believes that the UK trade mark itself may have been registered "simply as a means of attempting to force the transfer" of the Domain Name.
- 5.18 Finally, the Respondent relies on the fact that the Complainant "has made no effort to contact me regarding this issue before making this complaint", which he describes as "very telling".

Reply

- 5.19 The Reply is, like the Complaint, very brief. No further evidence is provided.
- 5.20 The Complainant doubts the credibility of the Respondent's assertion of a plan to use the Domain Name in the absence of any "credible or cogent evidence". In those circumstances, it asserts that the Respondent is not entitled to seek to distinguish such planned activity from the Complainant's use of the trade mark in the course of trade. The Complainant asserts that the Respondent's contentions "simply aggravates through legitimising the basis for the complaint".
- 5.21 In essence, the Complainant appears to be saying that the Respondent's assertions as to his plans to use the Domain Name lack credibility and therefore support its contention that it constitutes an abusive registration.

6 Discussions and Findings

General

- 6.1 To succeed under the DRS Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"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) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's rights

- 6.3 Paragraph 2.1.1 of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". "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*" (paragraph 1).
- 6.4 The Complainant relies on its UK registered trade mark IDSHIELD.
- 6.5 While the Complainant has not troubled to argue that the IDSHIELD mark (the "Mark") is identical or similar to the Domain Name, it clearly satisfies that test, it now being well settled under the Policy that the *.co.uk* suffix may be ignored for these purposes.
- 6.6 Accordingly, the Complainant has demonstrated that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.

Abusive registration

- 6.7 As to Abusive Registration, it is common ground between the parties that the Complainant had no rights in the IDShield name or mark at the time the Domain Name was registered. Accordingly there can be no basis for a finding of Abusive Registration under the first limb of the definition set out at 6.2 above, which considers the circumstances obtaining "*at the time when the registration or acquisition took place*".
- 6.8 The question, therefore, under the second limb of the definition, is whether, at some point since the Complainant began to use the IDShield name in the US in 2015, the Domain Name "*is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights*".
- 6.9 That timing issue is pretty much fatal for a complaint based on any of the circumstances in paragraph 5.1.1 of the Policy, because they all relate to the Respondent's motivation at the time of registration. In this case, that therefore knocks out two of the three grounds (see 6.10 below) advanced by the Complainant.
- 6.10 While it is not entirely clear from the very cursory Complaint, the Complainant appears to be arguing that this is a case of Abusive Registration on the following grounds:
- 6.10.1 registration primarily to block Complainant's use of mark (Policy 5.1.1.2);
- 6.10.2 registration primarily unfairly to disrupt Complainant's business (Policy 5.1.1.3); and/or
- 6.10.3 use or threatened use causing confusion or likelihood thereof (Policy 5.1.2).
- 6.11 Paragraph 5.1.1.2 of the Policy includes as a factor which may be evidence that the Domain Name is an Abusive Registration circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights.

- 6.12 The Complainant makes no substantive case in this regard. However, it is difficult to see how the Domain Name could have been registered as a blocking registration against the IDShield name, let alone primarily for that purpose, at least eight years before the Complainant, even on its own case, began to use that name.
- 6.13 Paragraph 5.1.1.3 of the Policy includes as a factor which may be evidence that the Domain Name is an Abusive Registration circumstances indicating that the Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the Complainant's business.
- 6.14 Again, the Complainant does not explain, let alone evidence, how the Respondent could have registered the Domain Name primarily for that purpose at a time when the Complainant was not trading by reference to the IDShield name or mark, and indeed would not do so for a further eight years.
- 6.15 Paragraph 5.1.2 of the Policy includes as a factor which may be evidence that a Domain Name is an Abusive Registration circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which is confusing 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.
- 6.16 This ground of complaint at least does not suffer from the chronological problems of the first two. It is in theory possible for a respondent who has acted blamelessly in registering a domain name nonetheless to fall foul of the Policy as a result of a subsequent use (or threatened use) of a domain name which takes unfair advantage of or is unfairly detrimental to a complainant's rights in the name or mark. There have been a number of cases where a registrant has sought subsequently to profit from his good fortune in registering a domain name which later turns out to have been valuable, for example, in the case of *itunes.co.uk* (DRS 02223), threatening to sell it to a competitor of the complainant, or by using it to divert traffic intended for the complainant's business.
- 6.17 The DRS Expert Overview (3rd Ed) at paragraph 4.7 summarises the effect of the *itunes.co.uk* decision and other similar decisions, inter alia, in the following terms (with emphasis added):
- "1. Where the domain name registration pre-dates the coming into existence of the Complainant's rights, the act of registration is unlikely to lead to a finding of Abusive Registration. It is not possible to be categoric on this point, because it is not inconceivable that a finding of Abusive Registration could result in circumstances where the Respondent effected the registration in breach of an obligation of confidence and with knowledge of the Complainant's plans.***
- 2. Ordinarily, provided that the Respondent has done nothing new following the coming into existence of the Complainant's rights to take advantage of those rights, the Respondent's use of the domain name is unlikely to lead to a finding of Abusive Registration."***
- 6.18 In this case, the Complainant argues that the very existence and use of the Domain Name is confusing people into believing it is connected with the Complainant. It asserts that the "existence and use of the Domain Name will invariably give rise to third party confusion" where it owns "earlier registered trade mark rights and unregistered trade mark rights". It asserts that such unregistered rights arise from its "considerable trading goodwill and reputation under the trade mark IDShield in the United Kingdom".
- 6.19 There are a number of problems with this contention. In the first place, there has been no change of use of the Domain Name. Indeed, it is not being used at all. Further, there have

been no communications between Respondent and Complainant. In those circumstances, it is hard to see how the Respondent could be "using or threatening to use the Domain Name" in any way at all, including in a way which is confusing.

- 6.20 Secondly, no evidence whatsoever is provided of the alleged confusion, or likelihood thereof, to which it is said that the existence and use of the Domain Name "invariably" gives rise.
- 6.21 Thirdly, the Complainant relies on "earlier" registered and unregistered trade mark rights. However, even on its own case, its registered trade mark is effective from 3 November 2016, whereas the Domain Name was registered on 11 February 2007, i.e. almost 10 years earlier. Likewise, even if the Complainant had any unregistered rights, they could not have arisen any earlier than 18 May 2015, according to the Complainant the date on which "IDShield was born".
- 6.22 The Complainant has therefore failed to demonstrate – on the 'more likely than not' basis required under the DRS – that the Respondent is using or threatening to use the Domain Name in a way which is confusing 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.
- 6.23 Finally, the Complainant complains of the fact that the Respondent had "no obvious legitimate basis", alternatively "no reasonable justification", for registering the Domain Name (in 2007), and that it is "not clear how the Registrant came to create the Domain Name". These cavils are unconvincing in circumstances where such registration of the Domain Name by a UK based registrant predated the Complainant's use of the IDShield name, in North America, by more than eight years.
- 6.24 The Complainant having failed to demonstrate Abusive Registration, any explanation or justification advanced in the Response is therefore moot. A number of obvious holes in the Complainant's case are pointed out by the Respondent (see paragraphs 5.12 to 5.17 above).
- 6.25 The Respondent's purported plans to use the Domain Name are not particularly convincing and have the whiff of an ex post facto justification about them. However, in the present circumstances, that is of no assistance to the Complainant.
- 6.26 For these reasons, the Complainant has, on the balance of probabilities failed to demonstrate Abusive Registration pursuant to paragraph 2.1.2 of the Policy.

7 Decision

- 7.1 The Expert accordingly finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name, but that the Domain Name is not, in the hands of the Respondent, an Abusive Registration.
- 7.2 It is therefore determined that there be no action.

David Engel

Signed

Dated 17 September 2018