

DISPUTE RESOLUTION SERVICE

D00022408

Decision of Independent Expert

Pet Plan Limited

and

PRIVACY SERVICES INC.

1. The Parties:

Complainant: Pet Plan Limited
57 Ladymead, Guildford,
Surrey, EN
GU1 1DB
United Kingdom

Respondent: PRIVACY SERVICES INC.
#1 Map Street
Belize City
NRW
00000
Belize

2. The Domain Name(s):

emailpetplan.co.uk

3. Procedural History:

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.

02 March 2020 01:54 Dispute received

02 March 2020 14:31 Complaint validated

02 March 2020 14:37 Notification of complaint sent to parties

19 March 2020 01:30 Response reminder sent

24 March 2020 08:32 No Response Received

24 March 2020 08:32 Notification of no response sent to parties

25 March 2020 10:17 Expert decision payment received

4. Factual Background

The Complainant was founded in 1976. It is a subsidiary of Allianz Insurance plc, one of the largest general insurers in the UK and part of the Allianz Global Group, one of the world's leading financial services providers. The Complainant provides a wide range of pet insurance for domestic and exotic pets in the UK and also around the world through licensees, including the USA. It also offers insurance to pet care professionals and a pet finding service.

Since its formation the Complainant has continuously operated under the Pet Plan name and has used the PETPLAN mark in connection with its insurance products. The Complainant has won numerous awards including the World Branding Awards Brand of the Year 2017-2018 and 2019-2020 and the Consumer Moneywise Awards Most Trusted Pet Insurance Provider in 2017.

The Complainant owns numerous trade mark registrations. These include the following registration in respect of products and services related to the provision of pet insurance in the UK and European Union:

Petplan (UK TM Reg. No. UK00002052294), registered since 1997;

Petplan (UK TM Reg. No. UK00002222270), registered since 2001;

Petplan Device (UK TM Reg. No. UK00002645992), registered since 2013;

Petplan (EUTM Reg. No. 001511054), registered since 2001 and

Petplan (EUTM Reg. No. 000328492), registered since 2000.

The Complainant has a strong digital presence. It registered the petplan.co.uk domain name on 1 August 1996. Its primary domain names are petplan.co.uk and petplan.com which was registered in 2004. Petplan.com redirects to gopetplan.com. which is owned and operated by a licensee of the Complainant and is used for policyholders in the US and Canada. The Complainant offers its customers the convenience of using email to contact support services for any questions, concerns, complaints and other general inquiries.

The Domain Name was registered on 6 November 2019. The Respondent appears to be a privacy service provider. The identity of the party for whom the registration is held is unknown. In this Decision “Respondent” refers to both the underlying party and the registrant.

The Respondent had made active use of the Domain Name.

At the time that the Complaint was submitted on 2 March the Domain Name was being used by the Respondent to redirect to the authentic Petplan website at www.gopetplan.com.

The Domain Name was also offered for sale at Sedo’s marketplace for a minimum offer of \$899 USD.

A check by the Expert on 19 April 2020 established that the redirection of the Domain Name had changed since the submission of the Complaint. The Domain Name was now being linked to a landing page listing business categories linked to pet insurance, including “Pet Insurance Policies” and “Best Rated Pet Insurance”. In each case the link clicked through to a page showing a list of links to price comparison services for pet insurance (e.g. Compare The Market Pet) and other pet insurance providers (e.g. Sainsbury’s Bank which was listed under the “Pet Insurance Policies tab).

5. Parties’ Contentions

Complainant

Rights

The Complainant asserts rights in the PETPLAN mark which predate the registration of the Domain Name. It relies on its trade mark registrations. It also asserts unregistered rights through its significant investment in, and longstanding use of, the PETPLAN mark. It refers the Expert to a previous decision under the Nominet Dispute Resolution Policy which found that the Complainant had Rights in the PETPLAN mark and that it was distinctive of the Complainant in the field of pet insurance (Pet Plan Limited v Leszek Tomczakowski Ltd (DRS 00017902)).

The Complainant contends that the Domain Name is similar to its PETPLAN mark. It is well established that the suffix “.co.uk” may be disregarded. Additionally, the

prefix “email” is a generic, descriptive phrase which does not dilute the similarity between the Domain Name and the PETPLAN mark.

Abusive Registration

The Complainant contends that the Domain Name is an Abusive Registration for the reasons set out below.

- The Respondent had no legitimate reason to register the Domain Name. Whilst its precise motives are unclear, on the balance of probabilities its motivation and use of the Domain Name cannot be for motives other than to disadvantage the Complainant.
- The PETPLAN mark is well known and has a widespread international reputation. The Domain Name postdates the registration of petplan.co.uk and petplan.com by a considerable margin. It is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant’s PETPLAN mark at the time when the Domain Name was registered on 6 November 2019. The Respondent’s redirection of the Domain Name to the Petplan site at gopetplan.com shows that the Respondent is aware of, and familiar with, the Complainant’s brand and business.
- The Domain Name is a blocking registration.
- The Domain Name takes unfair advantage of the Complainant’s Rights and causes unfair detriment and unfair disruption to the Complainant’s business.
- Anyone who sees the Domain Name is bound to mistake it for a name related to the Complainant. There is considerable risk that the public will perceive the disputed Domain Name as owned by the Complainant or otherwise legitimately linked to it
- Because the Domain Name redirected to the Complainant’s website, a casual visitor would be unaware that the Domain Name does not belong to the Complainant or to a business legitimately associated with the Complainant. This is essentially a scheme to confuse, attract and profit from internet users who are searching for the Complainant. The impression given would cause consumers to believe that the Respondent is associated with the Complainant creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Domain Name and the Respondent is therefore using the well-known nature of the Complainant’s mark to improperly increase traffic for the Respondent’s commercial gain.
- The offer for sale of the Domain Name in the Sedo marketplace for offers exceeding \$899 USD, indicates that the Respondent registered the Domain Name primarily to sell it to the Complainant or one of its competitors.

Respondent

The Respondent has not submitted a Response.

6. Discussions and Findings

Under Paragraph 2 of the Nominet Dispute Resolution Policy (the Policy) the Complainant must establish 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, (Paragraph 2.1.1 of the Policy) and

the Domain Name, in the hands of the Respondent, is an Abusive Registration (Paragraph 2.1.2 of the Policy).

Rights

Rights are defined in Paragraph 1 of the Policy as follows.

"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."

The Complainant has established that it has Rights in the PETPLAN mark. These are conferred by its UK and EUTM trade mark registrations.

It is also clear that the extensive use of the PETPLAN mark has generated significant goodwill for the Complainant and this confers unregistered Rights in the mark. This finding is also supported by the evidence of the Complainant's award winning status as a trusted brand and aligns with the previous DRS decision finding that the mark is distinctive of the Complainant in the field of pet insurance (Pet Plan Limited v Leszek Tomczakowski Ltd (DRS 00017902)).

Similarity

When assessing whether a name or mark is identical or similar to the Domain Name it is well established that the ".uk" suffix can be ignored.

Leaving that point aside, the Domain Name incorporates the Complainant's PETPLAN mark with the addition of the prefix "email". It is the Expert's view that this addition prevents the Domain Name being classed as identical to the PETPLAN mark on a strict assessment. But it obviously meets the threshold of similarity. The dominant component of the Domain Name is the Complainant's mark. The prefix "email" is a commonly used term. Its inclusion does not detract from the impact of the PETPLAN mark nor does it alter its significance as a mark associated with the Complainant. In fact, "emailpetplan" is likely to be associated with sending an email to the Complainant i.e. as an administrative adjunct to the Complainant's business, which has the effect of amplifying the association with the Complainant's mark.

The Complainant has therefore clearly established that it has Rights in respect of a name or mark which is similar to the Domain Name.

Abusive Registration

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

"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".

Paragraph 5 of the Policy gives a list of factors which may be evidence that the Domain Name is an Abusive Registration. The Complainant's contentions are based on the following:

1. Circumstances indicating that the Respondent registered the Domain Name primarily:
 - a. For the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or 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 (5.1.1.1 of the Policy);
 - b. as a blocking registration against a name of mark in which the Complainant has Rights (paragraph 5.1.1.2 of the Policy).
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 (paragraph 5.1.2 of the Policy).
3. Circumstances indicating that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the Complainant's business (paragraph 5.1.1.3 of the Policy).

The Expert accepts that the PETPLAN mark, and its connection to the Complainant, were well established when the Domain Name was registered in November 2019. The redirection to the Complainant's website is proof that the Respondent's knew about the PETPLAN mark. There is no evidence before the Expert to suggest that the Respondent had a legitimate reason or reasonable justification for registering the Domain Name.

The Complainant has established circumstances indicating that the Respondent is using 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 under paragraph 5.1.2 of the Policy.

The similarity between the Domain Name and the Complainant's mark, coupled with the well-known nature of the mark would cause an Internet user to believe the Domain Name is owned by or connected to the Complainant. The addition of the "email" prefix increases the likelihood of confusion as it gives the impression that the domain name is a conduit for contacting the Complainant by email.

On the balance of probabilities this mistaken belief will have been reinforced by the redirection of the Domain Name to the authentic Petplan site. Users would have no reason to doubt the apparent connection to the Complainant.

This is damaging for the Complainant because it deprives it of the exclusive control of its brand. It is particularly important that a business such as the Complainant, with its leading reputation as a trusted provider of pet insurance, maintains its reputation. The Complainant cannot be confident about how the Respondent will use the Domain Name in future and this creates a real risk of unfair detriment in the future.

The redirection to the Complainant's website is sufficient to establish an Abusive Registration.

The more recent redirection of the Domain Name to a landing page linked to pet insurance products and services is abusive in a different way. Although any initial confusion linking the Domain Name to the Complainant is likely to be dispelled on reaching the landing page, the user looking for information about pet insurance is presented with access to information about competitors of the Complainant. The Respondent is therefore taking advantage of the well-known nature of the Pet Plan mark to potentially divert business away from the Complainant. This use is unfair because it is parasitical on the goodwill in the PETPLAN mark.

The Expert is mindful that this new use postdates the Complaint and is not referred to by the Complainant. As stated above, the finding of an Abusive Registration is based on the primary finding that the redirection to the Complainant's website as set out in the Complaint.

The Expert also holds that the November 2019 registration of the Domain Name was abusive under paragraph 5.1.1.2 and 5.1.1.3 of the Policy. It has been established that the Respondent would have been aware of the PETPLAN mark when it registered the Domain Name and there was no legitimate reason for it doing so. These factors create a clear inference on the balance of probabilities that the Respondent registered the Domain Name primarily to exploit the brand recognition

in the PETPLAN mark by obtaining a blocking registration and by unfairly disrupting the Complainant's business.

The offer for sale on the Sedo marketplace establishes that the Respondent is seeking to sell the Domain Name. There is no evidence about the Respondent's out of pocket expenses but on the balance of probabilities legitimate expenses would be unlikely to amount to the baseline offer price. Whilst no direct approach has been made to the Complainant and there is no evidence of an approach to a competitor, the redirection of the Domain Name to the Complainant's website suggests that the Respondent wished to bring the Domain Name to the Complainant's attention. In conjunction with the other factors set out above this supports a finding of Abusive Registration on the balance of probabilities.

It follows that the Complainant has established that the registration and use of the Domain Name constitute an Abusive Registration under the Policy.

7. Decision

The Expert finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name is an Abusive Registration. The Expert orders that the Domain Name be transferred to the Complainant.

Signed

Dated 27 April 2020