Decision for dispute CAC-UDRP-100421

Case number	CAC-UDRP-100421
Time of filing	2012-04-02 11:11:09
Domain names	comparethemarket.xxx

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	BGL Group Limited

Complainant representative

Organization	TLT LLP

Respondent

Name	Jon Watkins

OTHER LEGAL PROCEEDINGS

None the Panellist is aware of.

IDENTIFICATION OF RIGHTS

UK trademark rights in “comparethemarket”

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

1 This Complaint is submitted by TLT LLP, a firm of solicitors regulated in the United Kingdom by the Solicitors Regulation Authority, on behalf of BGL Group Limited. The ADR Center of the Czech Arbitration Court is requested to consider this Complaint for decision in accordance with the Uniform Dispute Resolution Policy and Rules.

2 The Complainant, BGL Group Limited ("BGL"), is a company incorporated in England and Wales with company number 02593690. It was incorporated on 21 March 1991.

3 BGL originally operated as an insurance underwriter. From 1997, BGL has operated as an intermediary for UK personal-lines insurance.

4 In 2005, BGL created its “Compare the Market” ("CtM") brand as part of its business as a personal-lines insurance intermediary. As part of the CtM brand, BGL created the website www.comparethemarket.com. This was, and is, a price-comparison website for personal-lines insurance products.

5 The domain comparethemarket.com and the domain comparethemarket.co.uk were both registered on 21 September 2004. They are registered to BISL Ltd, which is a wholly owned subsidiary of BFSL Ltd. BFSL Ltd is in turn a wholly-owned subsidiary of BGL. In effect BGL owns the domains comparethemarket.com and comparethemarket.co.uk.

6 In January 2009, the CtM brand was re-launched. The re-launch included television adverts featuring Aleksandr the Meerkat, an anthropomorphized meerkat character. A companion website was also created at www.comparethemeerkat.com.

7 The domain comparethemeerkat.com was registered on 3 October 2007. It is registered to BGL.

8 The CtM brand is extremely well-known, particularly by reference to the Aleksandr the Meerkat character. For example:

8.1 VCCP, the advertising agency which created the Aleksandr character for BGL, has won awards for its work: see for example http://www.vccp.com/

8.2 BGL won the Marketing Week Engage 2010 Brand of the Year award for their CtM brand: http://www.marketingweek.co.uk/

8.3 VCCP maintain a webpage on their work for BGL here: http://www.vccp.com/

9 BGL owns the following trademarks (together, the Trademarks), all registered in classes 35 and 36:

UK Trademark 2456693A which incorporates the text "comparethemarket.com".

UK Trademark 2456693B which incorporates the text "comparethemarket.com".

UK Trademark 2456693C which incorporates the text "comparethemarket".

UK Trademark 2456693D which incorporates the text "comparethemarket".

UK Trademark 2522721 for "comparethemarket";

UK Trademark 2486675 for "comparethemarket.com";

10 BGL also owns the goodwill in the CtM brand, and in associated marketing such as the character of Aleksandr the Meerkat.

11 The Respondent is the registrant of the domain comparethemarket.xxx (the Domain). The Domain was registered on 07 December 2011, more than 7 years after BGL registered comparethemarket.com and comparethemarket.co.uk.

12 Apart from the different top level domain, the Domain is identical to BGL’s domain name comparethemarket.co.uk and

comparethemarket.com. The Domain also contains BGL's Trademark "comparethemarket" and is very similar to the other Trademarks above. As such, the Domain is confusingly similar to BGL's domain name and trademark.

13 As BGL's CtM brand is so well known, the registration of the Domain is a clear attempt to take unfair advantage of the reputation which has been developed by BGL.

14 The Registrant has no rights or legitimate interest in the Domain as the Domain is not being used to host any legitimate site as it is completely inactive. It is also of note that the Registrant has chosen to hide behind a privacy service. In all the circumstances, it is clear that the sole purpose of the Domain registration was (and is) to take unfair advantage of BGL's well founded reputation.

15 The Domain was registered in bad faith because the Registrant seeks only to take unfair advantage of BGL's CtM brand. No legitimate interest is being pursued through the Domain. The sole motivation is to benefit from BGL's established brand.

16 Accordingly, we request that the Domain be transferred from the Respondent to BGL.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Respondent offers no countervailing argument to show legitimate interest, despite Complainant's claim to the contrary. However the panel notes the inherent descriptive/generic nature of the phrase "compare the market", which could legitimately have myriad uses.

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant shows prior trademark rights at least in the UK where Respondent appears resident. Respondent offers no countervailing argument to show legitimate interest, despite Complainant's claim to the contrary.

But Complainant fails to prove bad faith registration or use of the domain. Complainant states that the domain is "completely inactive". Complainant does not show that Respondent tried to sell the domain to Complainant, has registered other infringing names, or otherwise has tried to profit from the domain or cause any other harm to Complainant. Respondent is not shown to have had prior UDRP cases in which he has been an unsuccessful Defendant. Clearly, "compare the market" could relate to myriad different types of markets and myriad different comparisons within each one, as demonstrated by a simple web search.

Trademark rights are defined in scope, and do not give rise to transfer of generic or descriptive domains via the UDRP unless bad faith use of the domain is proved. Inactive non-use is clearly an insufficient indicator of bad faith; there must be something more. Therefore the complaint must be denied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **COMPARETHEMARKET.XXX**: Remaining with the Respondent

PANELLISTS

Name	**Mike Rodenbaugh**

DATE OF PANEL DECISION 2012-05-15

Publish the Decision