Decision for dispute CAC-UDRP-100527

Case number	CAC-UDRP-100527
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Domain names	COMPARETHEMARKETHOLIDAYS.ORG

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	BGL Group Limited

Complainant representative

Organization	TLT LLP

Respondent

Name	Ian Hart

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

In particular the Complainant has trade mark rights in the term COMPARETHEMARKET (UK trade mark Number 2522721).

FACTUAL BACKGROUND

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

1 This Complaint is submitted by TLT LLP (TLT), a firm of solicitors regulated in the United Kingdom by the Solicitors' Regulation Authority, on behalf of BGL Group Limited (BGL). The Czech Arbitration Court (CAC) is requested to submit this Complaint for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (UDRP), the Rules for the UDRP, and CAC's UDRP Supplemental rules of the Czech Arbitration Court.

2 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 through its wholly-owned subsidiaries BFSL Ltd and BISL Ltd. From 1997, BGL has operated (through those subsidiaries) 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 (including travel insurance).

5 The domain comparethemarket.com was registered on 21 September 2004. It is 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 and controls the domain comparethemarket.com through its subsidiary companies.

6 In early 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 very well-known in the UK, 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/news/2009/06/vccp-win-double-at-nma-awards.
8.2 BGL won the Marketing Week Engage 2010 Brand of the Year award for their CtM brand: http://www.marketingweek.co.uk/news/congratulations-to-the-winners-of-the-marketing-week-engage-awards/3013601.article
8.3 VCCP maintain a webpage on their work for BGL here: http://www.vccp.com/work/comparethemarketcom/comparethemarketcom

9 BGL owns a number of trademarks (please see attached portfolio). All of which are registered in classes 35 and 36. We would like you to pay particular attention to the following trademarks:
9.1.1 UK Trademark 2456693A;
9.1.2 UK Trademark 2456693B;
9.1.3 UK Trademark 2456693C;
9.1.4 UK Trademark 2456693D;
9.1.5 UK Trademark 2522721; and
9.1.6 UK Trademark 2486675.

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

11 To give an indication of the popularity of the CtM brand, BGL's website at "comparethemarket.com" receives over 3 million visitors each month.

Comparethemarketholidays.org

12 The Respondent is the registrant of the domain comparethemarketholidays.org (the Domain). The Domain was registered on 22 September 2011, some 7 years after BGL registered the domain "comparethemarket.com".

13 Apart from the addition of the innominate term "holidays" (and the top level domain being ".org"), the Domain is identical to BGL’s domain name comparethemarket.com and UK Trademark 2486675 for "comparethemarket.com”. As such, the Domain is confusingly similar to BGL’s domain name and trademark.

14 The sole purpose of the Domain registration was (and is) to take unfair advantage of BGL's CtM brand. For example, users who are aware of BGL's CtM brand may add their required service to "comparethemarket" believing they will end up at a comparison site, for a particular service, which is run by BGL. Unlike the phrase "compare holidays", the phrase "compare the market holidays" does not make sense unless it is understood as a reference to BGL’s CtM brand.

15 This is further demonstrated at the head of the website at the Domain, which contains the text “COMPARE THE MARKET HOLIDAYS”, the last word of which is in a different colour to the first three words. By highlighting the innominate term "holidays" in a different color, this again leads users to believe that the brand is "compare the market", with "holidays" being just one particular section or sub-brand. Since BGL is known as “compare the market”, this leads users to believe that the Domain is connected with BGL's CtM brand / site.

16 At first glace it may appear as though the Registrant is hosting a legitimate holiday comparison site from the Domain. However, this is not the case. The Domain is not being used to host a legitimate site as the site is solely used to host links to other websites, including BGL's site and links to BGL's competitors' sites. For example, there is no real content on the site, it is purely designed to trick search engines but not to be useful or entertaining for users. The Registrant has no rights or legitimate interest in the Domain. The Registrant simply wants to attract as many visitors to the site as possible, on the false premise that the Domain is connected to BGL, so as to be paid per visit (or some other similar method such as pay per click).

17 The site at the Domain not only refers, on a number of occasions, to "Compare the Market" it also has a specific drop down tab named "Compare the Market". By frequently referring to "Compare the Market", users will assume that this is a service provided by BGL and it is referring to BGL's CtM brand. Giving users the impression that the website at the Domain is run by or associated with BGL is detrimental to BGL's reputation.

18 In addition, by using "Compare the Market" on the website, the site has a better chance of obtaining a high ranking in a Google search. This is because BGL's CtM brand has become so popular and so well known, users regularly search for "Compare the Market". If the Domain is ranked highly in a Google search, users are more likely to click on the Domain and think that they have arrived at BGL's site (and the Registrant will receive money as more users have viewed / clicked on a link at the site).

19 The website at the Domain uses a similar font and colour scheme to that at BGL's website, compounding the impression given to users that the Domain is connected with BGL.

20 In addition, as can be seen from the attached screenshot, a link to BGL's website is prominently displayed on the webpage at the Domain, further compounding the impression that the Domain is linked to BGL.

21 The Domain was registered in bad faith because the Registrant seeks only to take unfair advantage of BGL’s CtM brand in order to attract more users to its site and have a higher ranking in a Google search and earn money. It is obvious that the Registrant was aware of the CtM brand when registering this Domain as he has chosen to use the same name (Compare the Market) and similar colours to those used at BGL's site. In addition, it is clear that the Registrant was aware of BGL's CtM brand as there are numerous sponsored links to BGL's site from the Domain.

22 The Registrant is not using the site at the Domain other than to earn money from users who are looking for BGL's site. The Registrant is taking advantage of errors made by users seeking a service they believe is provided by BGL. This does not constitute a legitimate interest.

23 The Registrant has another website at the domain www.ianhartdesign.com. Within this site, the Registrant describes himself as a "SEO expert" (a search engine optimisation expert). The Registrant also states "I guarantee Page 1 Google search results for my clients". This supports the other evidence that the Registrant's sole motivation in registering the Domain was and is to unfairly take advantage of BGL’s “compare the market” brand. Being an SEO "expert" the Registrant will be aware that our client's CtM brand, when used, will create a high ranking in a Google search. This is the sole reason as to why the Registrant registered the Domain.

24. Links to webpages in support of this complaint:

- www.comparethemarket.com
- www.comparethemarket.co.uk
- www.comparethemarketholidays.org

- www.ianhartdesign.com

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 trade mark 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

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, 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

Paragraph 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, the Rules, the Panel shall draw such inferences therefrom at it considers appropriate. In this case the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel is therefore obliged to make its decision on the basis of the factual statements contained in the Complaint and the documents made available by the Complainant to support its contentions.

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

(i) the domain name registered by Respondent is identical or confusingly similar to a trade mark or service mark in which Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has trade mark rights in the term COMPARETHEMARKET (UK trade mark Number 2522721).

The disputed domain name contains the additional word "holidays" after the Complainant's trade mark. However the Panel is of the opinion that this is a descriptive term and its addition is not sufficient to dissociate the disputed domain name from

the trade mark in the mind of internet users. Numerous decisions under the Policy have held that incorporating a trade mark in its entirety in a domain name can be sufficient to establish that a domain name is identical or confusingly similar to a trade mark, and the Panel would agree with that assertion in this particular case.

Furthermore, the Panel considers that, as previously held in numerous Panel decisions, the generic top level domain suffix .ORG is without legal significance and has no effect on the issue of similarity. Neither does the fact that the trade mark is in upper case letters whilst the disputed domain name is only in lower case.

On the basis of these considerations, the Panel finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The second element that the Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the disputed domain name (Policy, paragraph 4(a)(ii)).

The Policy (paragraph 4(c)) sets out various ways in which a Respondent may demonstrate rights or legitimate interests in the domain name, as follows:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel has considered the evidence put forward by the Complainant and considers that the Complainant has presented a clear prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name. As a result of its default, the Respondent has failed to rebut that showing.

In particular the Panel is of the view that redirecting internet users to a website offering various hyperlinks linking to services that are competitive with the Complainant's services using a domain name that is confusingly similar to the Complainant's trade mark cannot be considered to be a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy referred to above. The Panel accepts the Complainant's assertion that there is no real content on the website to which the disputed domain name is pointing, even though at first glance this may not appear to be the case, and that this has more than likely been done deliberately for Search Engine Optimisation purposes. Nor can such use be said to be a legitimate non-commercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii), as, in the Panel's opinion, the Respondent is undoubtedly earning revenue via "click-through" links.

The Panel therefore finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The third element that the Complainant must prove is that the disputed domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy sets out various circumstances which may be treated by the Panel as evidence of the registration and use of a domain name in bad faith, as follows:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

On the basis of the evidence put forward by the Complainant, the Panel is satisfied that the Respondent’s conduct falls within paragraph 4(b)(iv) of the Policy. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to his website, by creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation, or endorsement of his website.

Furthermore the Panel is of the view that the Respondent was aware of the Complainant when he registered the disputed domain name on 22 September 2011 and intended to take advantage of the Complainant's existing goodwill and reputation (the Complainant was already well known at that time). The Panel agrees with the Complainant that, unlike the phrase "compare holidays", the phrase "compare the market holidays" does not make sense unless understood as a reference to the Complainant's corresponding brand.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name COMPARETHEMARKETHOLIDAYS.ORG be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COMPARETHEMARKETHOLIDAYS.ORG**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2012-12-17

Publish the Decision