Decision for dispute CAC-UDRP-101010

Case number	CAC-UDRP-101010
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Domain names	comparethemarket.email

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	BGL Group Limited

Complainant representative

Organization	TLT LLP

Respondent

Organization	Yoyo Email

OTHER LEGAL PROCEEDINGS

The panel is not aware of any other legal proceedings related to the disputed domain name, which would be pending or decided.

IDENTIFICATION OF RIGHTS

BGL Group Limited is the registered owner of the following UK trademarks:

- COMPARETHEMARKET, No. 2522721, filed on July 23, 2009 and registered on February 5, 2010 in classes 35 and 36,
- COMPARETHEMARKET.COM, No. 2486675 filed on May 2, 2008 and registered on December 19, 2008, in classes 35 and 36.

BISL Ltd, which is a wholly-owned subsidiary of BFSL Ltd, which is itself a wholly-owned subsidiary of BGL Ltd is the registered owner of the domain names:
- <comparethemarket.com> registered on September 21, 2004,
- <comparethemarket.co.uk> registered on September 21, 2004,

The domain name <comparethemeerkat.com> was registered to BGL Ltd on October 3, 2007.

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

FACTUAL BACKGROUND

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FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:
The Complainant, BGL Group Limited (BGL) is a company incorporated in England and Wales with company number 02593690. It was incorporated on March 21, 1991.

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

In 2005, BGL created its COMPARE THE MARKET brand as part of its business as a personal-lines insurance intermediary. As part of the brand, BGL created the website www.comparethemarket.com. This was, and is, a price comparison website for personal-lines insurance products.

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

Reputation

The COMPARE THE MARKET brand is very well-known in the UK, particularly by reference to the Aleksandr the Meerkat character. For example, VCCP, the advertising agency which created the Aleksandr character for BGL, has won awards for its work and BGL won the Marketing Week Engage 2010 Brand of the Year award for their CtM brand.

In 2013, comparethemarket.com was voted the Best Website in the Comparison Sector by websiteoftheyear.co.uk, an online people's choice award.

PARTIES CONTENTIONS

COMPLAINANT:

1. Confusing similarity.

The Complainant asserts that the <comparethemarket.email> domain name fully incorporates Complainant’s COMPARETHEMARKET and COMPARETHEMARKET.COM trademarks, merely adding the extension “email” after COMPARETHEMARKET and substitute “.com” by “.email”. The main part of the disputed domain name is identical to the main part of the BGL trademarks.

As such, the disputed domain name is confusingly similar to the COMPARETHEMARKET and COMPARETHEMARKET.COM trademarks.

2. Rights to or Legitimate Interests.

The disputed domain name was registered on March 30, 2014, almost ten years after the BGL Domains were registered.

BGL considers this to be a case of "cyber-squatting" which seeks (and, at the time of registration, sought) to take unfair advantage of BGL's COMPARETHEMARKET and COMPARETHEMARKET.COM trademarks.

There is no website at the disputed domain name and so the diversion of users looking for BGL's website does not

constitute a legitimate interest.

Accordingly, the Complainant contends that no legitimate interest is pursued through the disputed domain name.

3. Registered and used in Bad Faith.

According to the Complainant, the disputed domain name was registered in bad faith because the Registrant seeks only to take unfair advantage of BGL's COMPARETHEMARKET and COMPARETHEMARKET.COM trademarks by cyber-squatting.

As the Respondent does not operate a website from the disputed domain name, the Complainant infers that the Respondent solely seeks to cyber-squat by taking advantage of BGL's COMPARETHEMARKET and COMPARETHEMARKET.COM trademarks.

In order to protect BGL and the COMPARETHEMARKET and COMPARETHEMARKET.COM trademarks, the Complainant requests that the disputed domain name be transferred to BGL.

RESPONDENT:
Decision of the Panel on the admissibility of the Response sent on July 18, 2015.
The Panel finds that the Respondent is represented by a professional and is aware of the UDRP Rules and Supplemental Rules, the application thereof it strongly criticizes.
The Respondent first sent an email to the Case administrator, on July 8, 2015 with an attachment, which is a Declaratory judgement issued by the United District Court for the District of Arizona between the Respondent and Playinnovation Ltd on November 5, 2014. There is no doubt on the fact that this email was sent by the Repondent.
It further sent a response that exceeds the word limit of 5000 words, since its Section III has 7135 words.
The ADR Center of the Czech Arbitration Court did proceed to the Notification of Respondent’s default, based on the fact that the Response exceeds the word limit according to Sec. 13 (a) of the CAC’s UDRP Supplemental Rules.
According to §10 (a) of the UDRP Rules, the Panel “shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules”, whereas it “shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable” (§ 15(a)).
Given the non-compliance of the Response sent on July 18, 2015 with the Supplemental Rules and the subsequent default notified by the ADR Center of the Czech Arbitration Court, the Panel decides that it relies on the position such as explained in the email sent by the Respondent on July 8, 2015 together with its attachment.
The Panel adds that it will not rely on the notification sent by the Complainant on July 9, 2015, because it’s an unsolicited supplemental filing to the Complaint and the Complainant does not rely on “exceptional circumstances” that may explain this supplemental statement.
Position of the Respondent
In its email dated July 8, 2015, the Respondent criticizes prior decisions rendered on similar cases, explaining that the UDRP system is in favor of trademark owners and that “Yoyo does not recognize any of its authority”. It asserts that “any domain name which are the property of Yoyo, that are hijacked through the UDRP process will become the subject of a federal law suit”.
The Respondent claims reverse domain name hijacking. It refers to Lanham Act and says that “the UDRP starts the legal process, therefore the Complainant may be subject to paying significant legal costs and statutory damages to Yoyo”.
The Respondent declares: “I’m not sure that the Complainant has been transparent in the true reasons why they persecute a new start-up business trying to launch an innovative and useful service that does not pretend to be anything other than what it is”.
The Respondent further explains that “Yoyo when purchasing its domain names does not claim IP trademark rights in the domain names but is claiming legitimate business interest in its property” and it asks the Complainant to “consider this email a notice before legal action”.

The attached exhibit is the Declaratory judgment rendered on November 5, 2014, concerning the domain name <playinnovation.email> registered by the Respondent, which had been suspended on the request of the company

Playinnovation Ltd that had successfully filed a URS procedure against the Respondent.
The Respondent filed a complaint for a Declaratory judgment in the United States District Court for the District of Arizona, seeking to overturn the suspension of the domain name
<playinnovation.email> under the URS.
The parties in this case filed a Consent Motion for Declaratory judgment and the Judge decided that “the Declaratory judgment proposed by the parties is entered, as follows:”
- Plaintiff brought this declaratory judgment action seeking, among other things, a declaration that its business model as detailed in its August 29, 2014 Complaint was lawful and, after discussion, the parties agreed on to the entry of the Declaratory judgment, with no admission of liability by any party.
It has been accordingly ordered, adjudged and decreed that:
- “Plaintiff’s legitimate purpose seeking to certify the sending and receipt of emails as described in the complaint, does not evidence a bad-faith intent to profit from the “registration, use or trafficking” of a domain name.
- (…) Plaintiff’s intended use of <playinnovation.email> as set forth in the Complaint is not trademark use.
- Plaintiff’s intended use of <playinnovation.email> as set forth in the Complaint is not a violation of the Anti-Cybersquatting Consumer protection Act (ACPA), 15 U.S.C. § 1125 (d) et seq. and of the Lanham Act, 15 U.S.C. § 1051 et seq., the ICANN URS and UDRP policy or other law”.
- The domain name <playinnovation.email> shall be moved from suspension and restored to Plaintiff and “Plaintiff shall include a disclaimer in its “Terms of <use” on the website <Yoyo.email> and any home or landing page associated with <playinnovation.email>, which states Yoyo.email is an independent certified email ervice and not affiliated with or approved by Playinnovation, Ltd.
- Plaintiff shall include a disclaimer in the metadata for all emails transmitted through <playinnovation.email> which states “The domain name <playinnovation.email> is part of an independent, certified email service that is not affiliated with or approved by Playinnovation Ltd of London (…)”
- Plaintiff’use of <playinnovation.email> shall be limited to:
a use as a non-public, back end email server used to link multiple email severs.
B use to track, record, document, or verify email communication.
C Us only by an individual or entity whose corporate or trade name is or incorporates “playinnovation””.

RIGHTS

The Complainant has clearly established prior rights in the Trademarks COMPARETHEMARKET and COMPARETHEMARKET.COM by appending evidence of United Kingdom registrations.

The above-mentioned trademarks are notably registered for insurance services and are used to designate such services.

The domain name <comparethemarket.email> is entirely composed with the trademark COMPARETHEMARKET.
Therefore, the Panel finds that the disputed domain name is identical or confusingly similar to the Complainant’s trademarks.

The condition of the paragraph 4(a) (i) of the Policy has been satisfied.

NO RIGHTS OR LEGITIMATE INTERESTS

As set forth by Paragraph 4 (c) of the Policy, 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 the Respondent’s rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to the Respondent of the dispute, its 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) the Respondent, (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) the Respondent is 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 Respondent asserts that it wants to use the disputed domain name as a backend non-public email server used to link multiple email servers, to track, record, document or verify email communication.
It asserts that its business model is lawful.

The Panel is not bound by the American Declaratory judgment.
Submitting that the intended use of the disputed domain name is not a trademark use is not relevant in this procedure.
There is no information on the means and methods the Respondent intends to earn revenue. The provided information is the brief description of a concept.
There is absolutely no evidence of the existence of a business plan that would rely on “an innovative and useful service”, providing information on the technology and on the method to create value using this technology.
The Respondent submits that it “does not claim IP rights in the domain names but it is claiming legitimate business interest in its property”. It does not explain why its business, using <brand.email> domain names, is legitimate.
The Declaratory judgment concerning the domain name <playinnovation.email> rules that the use of the <playinnnovation.email> shall be limited to "use only by an individual or entity whose corporate or trade name is or incorporates playinnovation".
In this prior case, the parties agreed on a disclaimer and on a use limited to parties owning rights on the disputed name. In other words, the Respondent acknowledged that its intended use of its <brand.email>, in this prior case <playinnovation.email>, was confusing and shall be organized and limited, in order to avoid any likelihood of confusion between the Respondent and the right owners.
If the Respondent bases its business model on its innovative technology, why should it need to register these <brand.email> domain names, such as, in this prior case <playinnovation.email>, and in this case, the disputed domain name <comparethemarket.email>?
The Panel finds that the Respondent does not prove that it made preparations to use the disputed domain name in connection with a bona fide offering of services, , as addressed under paragraph 4(c) (i) of the Policy.
There is nothing that indicates that the Respondent is commonly known as Compare the Market, , as addressed under paragraph 4(c) (ii) of the Policy.
The Complainant has not licensed or otherwise permitted Respondent to use its COMPARETHEMARKET and COMPARETHEMARKET.COM trademarks in connection personal-lines insurance services or any other goods or services or to apply for any domain name incorporating the COMPARETHEMARKET and COMPARETHEMARKET.COM trademarks.

Many decisions have been rendered concerning domain names registered by the Respondent. In the <stuartweizman.email> case, a URS decision had suspended the domain name. This suspension was subsequently denied in the URS appeal determination. A UDRP decision was rendered after the URS appeal determination and it ordered the transfer of the disputed domain name (WIPO case D201461537, November 6, 2014, Stuart Weizman IP, LLC v. Giovanni Laporta, Yoyo.Email Ltd). According to the .email Registry database, the domain name <stuartweizman.email> is now available again.

The Panel finds that the Respondent has not provided any evidence or circumstances to establish that it has rights or legitimate interests in the disputed domain name, according to Parapraph 4 (c) of the Policy.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by an Administrative Panel to be evidence of the bad faith registration and use of a domain name. It provides that:

“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 web site 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 web site or location or of a product or service on your web site or location.”

1. Concerning bad faith registration of the domain name <comparethemarket.email>

The trademarks COMPARETHEMARKET and COMPARETHEMARKET.COM are protected and used for designating insurance services.

The Respondent does not contest the trademark protection of the prior trademarks COMPARETHEMARKET and COMPARETHEMARKET.COM.
As already explained, the Respondent contends that it is developing a new email courier service that will record the sending and receipt of emails.
The Respondent’s business model is notably to register domain names that are <brand.email> domain names composed with third parties’ trademarks. Some of them are as well-known as LUFTHANSA.
It does demonstrate a real pattern of conduct that consists of registering domain names composed with third parties trademarks.

If the technology is at the heart of its business model, it can launch its activity using domain names composed with generic names.

All trademark owners face security problems on the internet. Email security is at the heart of the security system that any company has to organize and to control. Emails contain personal data and business information that have to be kept confidential.

Enabling a third party to offer an email service using its trademark as a domain name cannot be tolerated.

The Respondent intentionally creates confusion between its alleged innovating technology and the registration of domain names composed with third parties trademarks.

In reality, the Respondent is capitalizing on the goodwill that has been developed by trademark owners like the Complainant.

Accordingly, the Panel finds that the Respondent's action is in line with paragraph 4(b)(i)(ii) of the Policy and that the disputed domain name <comparethemarket.email> has been registered in bad faith.

Therefore, the condition set out by paragraph 4(a)(ii) of the Policy has been satisfied.

2. Concerning bad faith use of the domain name <comparethemarket.email>

The Respondent explains how it intends to use the disputed domain name.

The fact that the Respondent alleges that its use of the disputed domain name will not be a trademark use does not need to be taken into consideration, under the UDRP Rules.

The UDRP Rules are not meant to be exhaustive of all circumstances that can show bad faith registration and use.

The goal is to fight against abusive registrations.

As explained in the WIPO overview «Panels have found that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith ».

The Panel has to examine the circumstances of the case to decide whether there is bad faith, given the circumstances surrounding registration. In this case, the Panel can also decide on the basis of the intended use, as described by the Respondent itself.

The Complainant’s trademark has a reputation and the Respondent does not contest it.

Taking into account all of the above, the intended use of the disputed domain name cannot be legitimate.

Again, the Respondent’s business model is based on trading upon third parties’ trademarks.

The Panel is of the opinion that there is ample evidence for a finding of bad faith in this case.

The Respondent's action is in line with paragraph 4(b)(iv) of the Policy as the Respondent is intentionally attempting to attract Internet users for commercial gain by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of Respondent's services which are not in any way affiliated with the Complainant.

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

The domain name is composed of the Complainant's trademark and therefore it is identical to trademarks in which the Complainant has rights.

The Respondent alleges to offer a certified email service based on an innovating technology and using <brand.email> domain names.

The business model of the Respondent relies on trading upon third parties’ trademarks.

Therefore the Panel finds that the disputed domain name was registered without right or legitimate interests and was

registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COMPARETHEMARKET.EMAIL**: Transferred

PANELLISTS

Name	**Marie Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2015-08-20

Publish the Decision