Decision for dispute CAC-UDRP-100600

Case number	CAC-UDRP-100600
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Domain names	comparethemarketcarinsuranceuk.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	BGL Group Limited

Complainant representative

Organization	TLT LLP

Respondent

Name	Freddie Clark

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceedings related to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

1. The Complainant claims the following Rights.

1.1. Rights as the owner of registered trademarks:

1.1.1. a UK national Trade Mark #2456693A&B for the device or figurative mark comprised of 3 elements, a graphic element being two £ signs facing each other, one light and one dark, with the words below "comparethemarket.com" followed by the slogan or strap line, "for cheaper insurance, no one else compares" registered on 11 January 2008, in classes 35 and 36 as a series of two, one black and white and the other in green and blue.

1.1.2. a UK national Trade Mark #2456693C&D for the device or figurative mark comprised of 2 elements, a graphic element being two £ signs facing each other, one light and one dark, with the words below "comparethemarket.com" registered on 11 January 2008 in classes 35 and 36 as a series of two, one black and white and the other in green and blue.

1.1.3. a UK national Trade Mark #2486675 for the word mark "COMPARETHEMARKET.COM" registered on 19 December 2008 in classes 35 and 36 in a series of four with varied capitalization.

1.1.4. the UK national Trade Mark #2522721 for the word mark "COMPARETHEMARKET," in capitalized case only, registered on 05 February 2010 in classes 35 and 36.

1.2. Rights arising from use in the UK being goodwill and reputation.

1.3. The Complainant submits that its marks are a very well known brand in the UK.

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 Czech Arbitration Court is requested to submit this Complaint for decision in accordance with the Uniform Domain Name Dispute Resolution Policy, the Rules for Uniform Domain Name Dispute Resolution Policy, and CAC's UDRP Supplemental rules of the Czech Arbitration Court.

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. Since 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 (including car insurance).

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 (BGL's Domains).

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 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 the following trademarks (together, the Trademarks), all registered in classes 35 and 36 (which covers motor insurance):
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 for "comparethemarket";

9.1.6 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.

Why is the domain name an Abusive Registration?

11 The Respondent is the registrant of the domain comparethemarketcarinsuranceuk.com (the Domain). The Domain was registered on 24 December 2012, more than 8 years after BGL registered comparethemarket.com. The Respondent lives in the UK and at the time the Domain was registered, CtM had already established itself as a very well-known brand in the UK, particularly in relation to car insurance comparison services.

12 BGL considers this to be a case of 'cybersquatting', which seeks (and at the time of registration, sought) to take unfair advantage of BGL's CtM brand.

13 The Respondent has taken BGL's trademark "comparethemarket" and simply added the descriptive term "carinsurance" and the geographical location of the target market i.e. "uk". Adding "uk" shows that the Respondent intends the UK market to access this site and directly compete with BGL. This would confuse the average user into thinking that the Domain is in someway related to BGL.

14 Apart from the addition of "carinsuranceuk", the Domain is identical to BGL’s domain name comparethemarket.com and UK Trademark 2486675. The Domain uses BGL's UK Trademark 2522721 "comparethemarket" and is also very similar to the other Trademarks above. As such, the Domain is confusingly similar to BGL’s domain name and trademark.

15 If a user clicks on any link on the website at the Domain, the user is taken to QuoteZone.co.uk. Quote Zone is a direct competitor of BGL as it provides the same type of comparison services.

16 As the site at the Domain provides links to BGL's competitors, there is a real risk that BGL will lose business as a result.

17 The principal purpose of the Respondent's website is to take unfair advantage of BGL's well known brand and redirect users to a competitor which results in BGL missing the opportunity to interact with users looking for its site.

18 A screenshot of the Website at the Domain is provided. The sole purpose of the Domain registration was (and is) to take advantage of users looking for BGL's car insurance comparison service, but not realising that all of BGL's services are provided via the same site i.e. comparethemarket.com / comparethemarket.co.uk (rather than, for example, comparethemarketcarinsurance.com or comparethemarkethouseinsurance.com).

19 The Domain was registered in bad faith because the Respondent seeks only to take unfair advantage of BGL’s CtM brand. The sole motivation is to benefit from errors made by users seeking BGL’s car insurance comparison service.

These web pages support this dispute.

- comparethemarket.com
- comparethemarket.co.uk
- comparethemarketcarinsuranceuk.com

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

The Complainant has not 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 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. However it notes that there are no default decisions under the UDRP and even where no response is filed, in order to succeed, the Complainant must establish all three elements required in §4a of the UDRP, namely:

(i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and

(iii) the Disputed Domain Name has been registered and is being used in bad faith.

PRINCIPAL REASONS FOR THE DECISION

Rights

1. The words 'compare' and 'market' are common descriptive English words and lack any inherent distinctiveness even together. Where descriptive elements are added together, the overall mark will be descriptive unless the combination creates an entirely new impression which bestows a distinctive character on the whole which is not descriptive.

2. Trade marks are badges of origin and must indicate the undertaking/business responsible for the quality of the goods or services. Therefore marks cannot lack either inherent or acquired distinctiveness or be descriptive of the goods and services. Marks must signal commercial origin. Acquired distinctiveness (or secondary meaning) is a question of fact and market share, extent of use, investment and promotion and the relevant public must be proved. There is also a public interest value underlying these rules, as no trader should be able to acquire exclusive rights to words other traders might wish to use, such as terms with purely informational values or the names of products or services.

3. Here, although the Complainant's word marks have been registered, they are extremely descriptive. In this regard, it is notable that in 2010 the word mark #2522721 was granted only in the capitalized version --this reflects a very significant limit to the Complainant's rights in those words and reflects descriptiveness. The other word mark with the added .com (#2486675) is granted in various cases and due to the addition of the .com is more likely to indicate commercial origin. The device marks do not add to the analysis.

4. Even once registered, owners of highly descriptive marks must be able to establish acquired distinctiveness. The UDRP

also recognizes this and that rights may in some cases subsist in descriptive registered terms--only if they have acquired a secondary meaning and that a similar showing for these registered marks may be required as for unregistered marks--see the WIPO overview at 1.7 "..a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required. Some panels have also noted that in cases involving claimed common law or unregistered trademarks that are comprised of descriptive or dictionary words, and therefore not inherently distinctive, there may be a greater onus on the complainant to present compelling evidence of secondary meaning or distinctiveness(emphasis added)." The following evidence is required, "Relevant evidence of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition."

5. Both parties in this case are UK resident and offer competing services to the UK public. Under §15(a) of the UDRP Rules, a panel is to “decide a complaint on the basis of . . . any rules and principles of law that it deems applicable.” This is the choice of law provision and it is therefore possible to apply English law in this case.

6. English law of passing off (protecting common law or unregistered marks) tolerates confusingly similar marks where the marks are descriptive and discourages the monopolization of descriptive words, see Office Cleaning Services v Westminster Window [1946] 63 RPC 39, (the differences between Office Cleaning Services Ltd and Office Cleaning Association were sufficient to prevent passing-off). This remains good law. The Trade Marks Act 1994 §11(2)(b) based on Art. 6 of the Trade Marks Directive (2008/95) also protects descriptive and informational uses, subject to the important proviso that such use must be in accordance with honest practices. Some recent cases apply the passing-off analysis first and find it also determinative of the issues in relation to registered marks, see See A & E Television Networks LLC & Anor v Discovery Communications Europe Ltd [2013] EWHC 109 (Ch) (Discovery History did not infringe History marks based on the authority in Office Cleaning Services(above)).

7. No evidence was submitted in this case going to secondary meaning or acquired distinctiveness. We have only mere assertion and the fact of the registered marks. That is, no evidence whatsoever was submitted as to turnover, revenue, marketing and advertising spend, industry position and activities or indeed any of the sort of evidence that one would expect in a DRS case. While the Panel has personal recall of the Complainant's television advertisements, the evidential showing is entirely unsatisfactory.

8. While the Complainant has registered rights these are not strong due to the highly descriptive nature of the marks.

Legitimate rights and interests

9. Turning now to legitimate interests, in relation to the burden of proof, even in cases of default, this remains with the Complainant which is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the Respondent. The panel then weighs all the evidence, with the burden of proof always remaining on the Complainant.

10. Under 4(c) of the UDRP the following are enumerated grounds that may evidence legitimate rights and interests, although this list is not exhaustive:

"(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 noncommercial 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."

11. The Respondent has offered no evidence here but the Respondent registered the Disputed Domain Name on 24 December 2012. The Respondent has a UK address, as above, but nothing further is known about him. The Disputed Domain Name no longer resolves--no doubt due to a Takedown Notice from the Complainant. However, www.archive.org shows 9 snapshots of the Disputed Domain Name in 2013, the first on 10 April 2013, and the last on 23 April 2013, offering quotes for car insurance and advertising various insurance services including for pets, health and life. Links on the site resolve to www.quotezone.co.uk which says this about itself "Quotezone's UK car insurance quote technology allows you to compare car insurance from leading motor insurance companies and brokers in real time, so you only have to fill in one form to compare over 40 reputable UK insurers! Our insurance comparison systems now compare UK home insurance (House buildings and/or household contents cover) and van/commercial vehicle insurance."

12. It is clear that the Respondent offers price comparison services in the insurance industry in connection with the Disputed Domain Name so on the face of it 4(c) (i) applies. It's common to use generic domains and keywords or adwords to drive traffic to sites offering the relevant services and the fact the Respondent is not known by the name does not impact factor (i)--although it would be relevant to factor (ii). Many panels also consider descriptive use as legitimate or fair under factor (iii), even where used in commercial contexts. See for example CAC Case 100421 (dealt with further below). However, as the Complainant has not made submissions on this issue, this is considered as part of the analysis of bad faith below.

13. The Complainant has not made its prima facie case here and merely asserts that the factors are not met without adequately addressing them.

Bad Faith

14. As to bad faith, of the non-exhaustive factors in §4(b) of the UDRP, the Complainant relies on the following grounds:

"(iii) the domain was registered primarily to disrupt the business of a competitor; or

(iv) by using the domain, the registrant has intentionally attempted to attract users for commercial gain by creating a likelihood of confusion as to source or affiliation."

15. The Disputed Domain Name was used for advertising comparison services in the insurance industry offered by www.quotezone.co.uk. The Complainant says this shows its reputation is being leveraged unfairly by a competitor.

16. The mere fact the parties are competitors is not determinative and merely illustrates that many traders will want to use highly descriptive terms relevant to their industry --thus the rule against allowing any one trader to monopolize them. The fact is that both are in the same market and want to use the same descriptive terms to describe their comparison services.

17. The Complainant says that the use of the additional descriptive terms 'car insurance uk' with its mark does not change the fact that its mark is being used and its reputation leveraged. This does not address the fact that the whole is descriptive, including the mark.

18. The central question here is whether the Respondent is using the Disputed Domain Name in the descriptive language sense or in the Complainant's trade mark sense? I find the former but note it is very difficult to find where the UDRP draws the line between honest competition and unfair advantage.

19. The Complainant has made complaints against other third parties before and those panels have found both ways based on the descriptiveness of the marks and legitimate use/bad faith. I refer to the following decisions:

(a)100324 <comperthemarket.com > Transfer
(b)100421 <comparethemarket.xxx> Complaint Rejected
(c)100458 <comparethemarket.xxx> Rejected (re-filed)

(d)100599 <compare-the-market-car-insurance.com> Transfer

This contributes to the complexity of this case and influenced the need for a full decision this time. The Panel in 100421 found the descriptiveness of the mark meant it could legitimately have many uses and also found a lack of bad faith in an inactive domain noting "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".

20. This is a difficult case and finely balanced. However, on balance, I find that the Complainant has not shown bad faith. It selected highly descriptive marks and the fact is that others are entitled to make legitimate use of descriptive terms --even competitors. This negates bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **COMPARETHEMARKETCARINSURANCEUK.COM**: Remaining with the Respondent

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2013-06-25

Publish the Decision