# Decision for dispute CAC-UDRP-101009

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| Case number | **CAC-UDRP-101009** |
| Time of filing | **2015-06-22 14:57:32** |
| Domain names | **comparethemarket.website** |

## Case administrator

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| Name | **Lada Válková (Case admin)** |

## Complainant

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| Organization | **BGL Group Limited** |

## Complainant representative

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| Organization | **TLT LLP** |

## Respondent

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| Organization | **Michelle Dean** |

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered holder of the following trademarks:

(i) COMPARETHEMARKET (word), UK national trademark, filing date 23 July 2009, registration date 05 February 2010, trademark no. UK00002522721, registered for services in classes 35 and 36, and

(ii) COMPARETHEMARKET.COM (word), UK national trademark, filing date 02 May 2008, registration date 19 December 2008, trademark no. UK00002486675, registered for services in classes 35 and 36.

Moreover, the Complainant operates under the domain names COMPARETHEMARKET.COM and COMPARETHEMARKET.CO.UK car and van insurance, home insurance, bike insurance, and money products comparison website. Both these domain names are also owned by the Complainant.

FACTUAL BACKGROUND

The Complainant is a company incorporated under laws of England and Wales with a company number 02593690, incorporation date 21 March 1991.

In 2005, the Complainant created its COMPARETHEMARKET brand as part of its business as a personal-lines insurance intermediary. Subsequently, the Complainant created the website www.comparethemarket.com. This was, and is, a price comparison website for personal-lines insurance products.

The Complainant is a holder of various registered UK national trademarks that consist of the denomination COMPARETHEMARKET, as described in more detail above.

The disputed domain name was registered on 19 February 2015.

The disputed domain name is used in a connection with a website containing computer generated content only, as, for example, a list of links to various websites, including the ones promoting business directly competing with the business of the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims that the disputed domain name is confusingly similar to its trademarks (as listed above), since it incorporates COMPARETHEMARKET denomination which forms the dominant part of the said trademarks. The Complainant namely asserts that inclusion of the non-distinctive element “website” into the disputed domain name (after the distinct element “COMPARETHEMARKET”) cannot prevent confusing similarity between the disputed domain name and the said trademarks.

The Complainant claims that its trademarks enjoy well-known status in the UK, particularly by reference to the Aleksandr the Meerkat character and related advertisement.

The Complainant further contends that, as a result, the disputed domain name alone as well as any website which may be under it creates an overall impression that they are connected to the Complainant’s trademarks and its business.

The Complainant also presents facts and evidence to show that the disputed domain name has been registered and used in bad faith and that the Respondent has no rights or legitimate interest to the disputed domain name, in particular because it does not use the disputed name in in any legitimate manner.

In this respect, the Complainant has presented to the Panel the following evidence, which has been assessed by the Panel:

- Printout of details of the trademarks “COMPARETHEMARKET”;
- Printout of the screenshot of the website available under the disputed domain name (dated 16 June 2015).

RESPONDENT:

The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Uniform Dispute Resolution Policy (“UDRP” or “Policy”).

For details, see "Principal Reasons for the Decision".

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).

For details, see "Principal Reasons for the Decision".

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).

For details, see "Principal Reasons for the Decision".

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

IDENTITY WITH COMPLAINANT'S RIGHTS

The threshold test for identity or confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual or aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the “COMPARETHEMARKET” element of Complainant’s trademarks into the disputed domain name constitute (i) identity between the disputed domain name and the COMPARETHEMARKET trademark (no. UK00002522721), and (ii) at least confusing similarity between COMPARETHEMARKET.COM trademark (no. UK00002486675) and such domain name.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".website") must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity as well as confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the UDRP.

BAD FAITH

It is clear from the terms of paragraph 4(a)(iii) of the UDRP as well as confirmed by numerous decisions under it that the two elements of this third requirement are cumulative; both registration and use in bad faith must be proved for a complaint to succeed. See, for example, World Wrestling Federation Entertainment, Inc. v. Michael Bosman, WIPO D1999-0001, Telstra Computers Ltd v. Nuclear Marshmallows, WIPO D2000-0003 and A. Nattermann & Cie. GmbH and Sanofi-aventis v. Watson Pharmaceuticals, Inc., WIPO D2010-0800.

The Complainant asserts that “… given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks The Respondent lives in the UK and at the time the Domain was registered, COMPARETHEMARKET had already established itself

as a very well-known brand in the UK".

The Panel contends that the bad faith element in this particular case is closely connected with the "confusing similarity" and "false association" concepts. In the Panel's view, the Complainant's trademarks consisting of the "COMPARETHEMARKET" denomination are prima facie rather non-distinctive.

It is possible that the Respondent has been aware of Complainant's trademarks, domain names and business in general; however, this does not automatically mean that it has registered its domain name in bad faith in order to "free ride" on the Complainant's or its trademarks' reputation, since the domain name is descriptive of the services that the Complainant has been offering.

The Complainant claims that through extended use, promotion and advertising spent by the Complainant, its trademarks have become so well known as to acquire the requisite degree of distinctiveness taking them out of their original generic nature. However, the evidence presented by the Complainant in this regard was very limited and the Complainant should have invested more time and effort for proving the same.

The Panel researched that the Complainant has been running a TV marketing campaign for several years using meerkat characters, which has been particularly popular. Panel therefore concludes that the "COMPARETHEMARKET" brand and trademarks enjoy high level of notoriety in the UK and that they have both acquired enhanced distinctiveness and a reputation in the UK.

With comparative reference to the circumstances set out in paragraph 4(b) of the UDRP deemed to establish bad faith registration and use, 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. Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use (e.g. a mere "parking") of the disputed domain name by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business (ii) there is no real use of the dispute domain name, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith.

Thus, the Panel has taken a view that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

NO RIGHTS OR LEGITIMATE INTEREST

The Complainant's assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

For the reasons as set out above, the Complaint is accepted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COMPARETHEMARKET.WEBSITE**: Transferred

## PANELLISTS

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| Name | **JUDr. Jiří Čermák** |

DATE OF PANEL DECISION 2015-07-30

Publish the Decision