

Nominet UK Dispute Resolution Service

DRS Number 4610

(1) American Express Company
(2) American Express Marketing & Development Corp

v

CHC Internet t/a This domain name is FOR SALE Sales@TheCHC.com

Decision of Independent Expert

1. Parties

Complainants: (1) American Express Company
(2) American Express Marketing & Development Corp

Address: 200 VBesey Street
New York

Postcode: 10285

Country: United States of America

Respondent CHC Internet t/a This domain name is FOR SALE
Sales@TheCHC.com; or CHC Internet

Address: 20 Welbeck Road
Worsley
Manchester

Postcode: M28 2SL

Country: United Kingdom

2. Domain Name

Americaexpress.co.uk – Registered 7 May 2006

3. Procedural Background

The Complaint was lodged with Nominet on 12 April 2007. Nominet validated the Complaint and notified the Respondent of the relevant Complaint on 16 April 2007 and informed the Respondent that it had 15 days within which to lodge a Response.

No response was received from the Respondent.

No mediation having been possible, on 31 May 2007 the dispute was referred for a decision by an Independent Expert following payment by the Complainant of the required fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

David Flint, the undersigned, ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Outstanding Formal/Procedural Issues (if any)

On 30 May 2007, the Complainants agents advised Nominet that although the Respondent had initiated the registration transfer process they would like to pay for an Expert's decision.

The Expert notes that, until that time, the Respondent had not communicated with Nominet and accordingly sees no reason in terms of the Procedure and Rules not to proceed with this Decision.

At some time in the dispute process, between the lodging of the Complaint and today's date the designation of the Respondent changed to "CHC Internet" and dropped the "t/a This domain name is FOR SALE Sales@TheCHC.com" description.

5. The Facts

American Express Marketing & Development Corp. is a holding company for all AMERICAN EXPRESS trademarks. Ultimately it is wholly-owned by American Express Company (hereinafter American Express), the ultimate beneficial owner of the relevant rights. This Complaint is based on the Complainants' company name, trade name and over 1100 trademark applications and registrations for AMERICAN EXPRESS in 137 countries around the world, including the United Kingdom, where the Respondent is located. Full details of the Complainants' rights have been provided

Respondent registered the Domain Name www.americaexpress.co.uk on 7 May 2006. The Complainants' trade mark attorneys wrote to the Respondent on 16 October 2006 requesting cooperation in transferring the domain name to American Express but to date no response has been forthcoming.

There is no relationship between the Respondent and the Complainants but CHC Internet is known to the Complainant and to the DRS. It is the trading name of one Christopher Holland, possibly in partnership with one Ronald Davies, also trading as inter alia Dropcatcher TRADING AS: Domain for Sale. Messrs Holland and Davies have also registered the domain name www.american-express.co.uk which domain is to be the subject of separate proceedings. Copies of relevant previous DRS decisions are produced. From the available evidence, and from the conclusions of past DRS decisions, Complainants infer the person effectively behind the Respondent is Christopher Holland and that Mr Holland's activities and those of his associates include registering abusive domains for gain.

The domain name links to a website "parked" with sedoparking.com. Printouts produced comprise sample screen shots from the website linked to americaexpress.co.uk and of pages linked to that site. Note: a) the "link" to AMERICAN EXPRESS CARD UK which is in fact a link to unauthorised site, www.amex-online.co.uk; b) A link to "American Express Cards" at www.amex-credit-card.co.uk, another unauthorised site c) other links to the complainant's products, again unauthorised; d) there are links to pornographic material ; e) via the links to "America express" and "Americaexpress" there are unauthorised connections to legitimate websites of the Complainant; f) There are repeated statements to the effect the domain may be for sale.

6. The Parties' Contentions

Complainant

It is self-evident that AMERICAEXPRESS is virtually identical, and is therefore confusingly similar to, the Complainants' AMERICAN EXPRESS trade mark. On the principles enunciated in the "One in a million" case and others, the adoption of this domain name clearly amounts to trade mark infringement/passing off. In view of the Complainants' reputation and goodwill symbolised by its AMERICAN EXPRESS marks, from past contacts with Mr Holland, and from the fact the domain links to sites of the lead Complainant, the Respondent must have been aware of the Complainants' rights when the Domain was registered. The Respondent is obviously using or intending to use the Domain in a way likely to confuse people into believing it is connected to the Complainants.

Alternatively, the only possible reason for registering this domain was to sell it back to the Complainants or to a third party similarly wishing to misuse it at Complainants' expense in breach of Para 3(i)(A) of the Policy. The Respondent's trading name and the statements on the website are clear offers of sale.

Alternatively, the Domain is so close to the Complainants' trade mark it is one of the variants on the mark that the Complainants would legitimately wish to register themselves to prevent intrusions of this kind. The Respondent has no reason for registering the Domain other than to block the possibility of the Complainants doing so with a view to then selling the Domain to the Complainants, in breach of Para 3(i)(B) of the Policy.

On the evidence of the links via the site to both authorised and unauthorised sites regarding the Complainants, the website is clearly intended, or at the very least is highly likely, to attract and confuse persons seeking legitimate websites of the Complainants into thinking the americaexpress.co.uk website is a genuine, authorised website of the Complainants, in breach of Para. 3(ii) of the Policy.

The links to pornographic material are entirely inconsistent and at odds with the Complainants' Values Statement and persons mistaking the Domain for the Complainants' Domain name will be deceived into assuming there is a link to the Complainants' business, with a correspondingly detrimental effect on the reputation and integrity of the Complainants' business within the general definition of an abusive registration. The Respondent's activities: a) risk misleading/offending Complainants' customers to the Complainants' detriment; b) risk diverting business from the Complainants by unlawful use of the Complainants' trade marks to link to third-party financial sites. It is not possible to obtain evidence of direct confusion. However, the circumstances indicate clearly that the Respondent is using the Domain Name in a way which is reasonably likely to confuse persons into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants. Such acts amount to both trade mark infringement and acts of passing off.

The Respondent and its associates are clearly engaged in registering Domain names consisting of or confusingly similar to the trade marks of third parties, notwithstanding that there may have been attempts to camouflage this activity. This is in breach of Para 3(iii) of the Policy.

Para. 3 (c) of the Policy raises a presumption of Abusive Registration if the Complainants prove that Respondent has been found to have made an Abusive Registration in three or more cases in the two (2) years before the Complaint. Although the Respondent has not been so found it is clear on the evidence that the Respondent is involved in a pattern of Abusive Registrations with common links to Christopher Holland. It is submitted the presumption should be raised against the Respondent within the general discretion afforded by the definition of an Abusive Registration.

In any event the list under Para 3 of the policy is non-exhaustive. It is submitted the evidence establishes clearly that the unauthorised nature of Respondent's activities creates a presumption the use takes unfair advantage of the Domain name and Complainants' rights and is therefore abusive.

The Complainants request transfer to American Express Marketing & Development Corp.

Respondent

No response was received from the Respondent

7. Discussion and Findings:

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

In this case the first limb of that task is straightforward. The Complainant has produced evidence of worldwide trademark registrations for its corporate name "American Express". The Domain Name comprises said corporate name but with a single letter typographical change. In those circumstances the Expert is satisfied that the Complainant does have Rights in respect of a name or mark which is identical or similar to each Domain Name.

Abusive Registration

This leaves the second limb. Is each Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "Abusive Registration" as:-

"a Domain Name which either:

- i. was registered or otherwise acquired in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR
- ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy.

It appears to the Expert that the Respondent (or an entity controlled by or associated with the Respondent) has been the respondent in numerous other cases (DRS 1840, DRS 1717 DRS 3214, DRS 3716, DRS 2269, DRS 1869) in which the registration of the name in question has been found to be abusive. In terms of paragraph 3 c of the Policy, there is a presumption of Abusive Registration in respect of CHC Internet and each of those associated with it if it had been found to have made three abusive registrations in the two years prior to the Complaint. In the circumstances of this case, it appears that only two of the said cases fall within that two year period and therefore this may explain the attempt by the Respondent, mentioned in paragraph 4 above, to transfer the Domain Name to avoid such a finding.

In the cases immediately before this Expert relevant 'factors' in paragraph 3 are to be found in subparagraphs i and ii, which read as follows:

- i "Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the

Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

- B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant;"
- ii "Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;"

The Expert interprets "as" in sub-paragraph i. B as being synonymous with "for the purpose of". Were it to be interpreted otherwise all domain name registrations would inevitably constitute "blocking registrations" for any later arrival wishing to use the name in question.

The Expert considers that the clear similarity of the Domain Name to names in which the Complainants have rights indicate an attempt at "typosquatting" which would fall within (i)B, (i)(C) and/or (ii) above.

The Expert also considers that (i)(A) is satisfied.

The Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy on the basis that it was registered in a manner which, at the time when the registration took place, took unfair advantage of the Complainant's rights.

8. Decision

In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name americaexpress.co.uk be transferred to American Express Marketing & Development Corp..

The Expert finds that as a result of this Decision (if not otherwise), CHC Internet, Chris Holland and other entities controlled by or associated with the said parties or under which they may carry on business are persons to whom paragraph 4(c) of the Policy shall henceforth apply.

David Flint

11 June 2007