

DISPUTE RESOLUTION SERVICE

DRS 7178

Decision of Independent Expert

Gocompare.com Ltd

and

Arthur Maxfield

1. The Parties:

Complainant: Gocompare.com Ltd
Address: 1st Floor, Unit 1, Imperial Courtyard
Imperial Park
Newport
Gwent
Postcode: NP10 8UL
Country: GB

Respondent: Arthur Maxfield
Address: Unit 21 Woods Way,
Goring by Sea
Postcode: BN12 4QYC
Country: GB

**2. The Domain Name:
gocompareloans.co.uk**

3. Procedural History:

Nominet was notified of the Complaint on 24 April 2009 and validated it on 27 April. The Respondent was notified on the same date in accordance with the provisions of Paragraph 2 of the DRS Procedure. The Respondent emailed

Nominet on 14 May seeking an extension to the deadline for submitting a Response. On 29 May a Response was received from the Respondent. The Complainant submitted a Reply on 5 June. Payment for an Expert Decision was received by Nominet on 17 September. On 18 September the undersigned, Peter Davies confirmed that he was independent of the Parties and knew of no reason why he could not provide a Full Decision in this matter and the appointment as Expert was confirmed on 23 September.

There are no outstanding procedural matters.

4. Factual Background

The Complainant is a company incorporated in the UK in April 2006. It is the proprietor of a price comparison website at gocompare.com for a range of financial services. The Complainant began advertising its services online in January 2007.

The Complainant is the proprietor of registered UK and Community trademarks including

UK trademark registration number 2455723C for the word mark GOCOMPARE.CO.UK (series of 2) with a filing date of 16 May 2007;

UK trademark registration number 2455723D for the word mark GOCOMPARE (series of 2), with a filing date of 16 May 2007;

UK trademark registration number 2455723B for the word mark GO COMPARE (series of 4), with a filing date of 16 May 2007;

UK trademark registration number 2435021 for the mark GOCOMPARE.COM plus device (series of 2), with a filing date of 10 October 2006;

Community Trade Mark registration no. 005368402 for the mark GOCOMPARE.COM plus device with a filing date of 9 October 2006;

UK trade mark registration no. 2472771A for the mark GOCOMPARELOANS (series of 7), with a filing date of 20 November 2007;

UK trademark registration no. 2472771B for the mark GOCOMPARELOANS.COM / GOCOMPARELOANS.CO.UK (series of 2) with a filing date of 20 November 2007;

The Domain Name was registered by the Respondent on 4 September 2007. It currently resolves to a page “under construction”.

The Complainant’s solicitors wrote to the Respondent on 1 February 2008 requesting that the Domain Name be transferred to the Complainant. Apart from a request from Respondent’s solicitors for time to take instructions from their

client, and a later communication to the effect that such instructions were still not in the hands of the Respondent's solicitors, no substantive response was received.

5. Parties' Contentions

Complaint

The Complainant contends that it has rights in a name similar or identical to the Domain Name and that the Registration in the hands of the Respondent is an Abusive Registration as defined in the DRS Policy.

In support of its claim to rights in a name which is identical or similar to the Domain Name, the Complainant submits that:

- a. Between 1 April 2008 and 31 March 2009 over 30 million customers visited the Complainant's website. The Complainant is the one of the most popular aggregation and comparison websites in the UK, independently rated as one of the top two such websites.
- b. It is the owner of the trademark rights set out in paragraph 4 above.
- c. By reason of its promotion and advertising of its business in connection with the website at www.gocompare.com, the name Gocompare is well known in the UK and elsewhere as the Complainant's trading name and the Complainant enjoys substantial goodwill in the name Gocompare in the field of loan aggregation and comparison services.
- d. The most distinctive element of the Domain Name is the conjoined words "gocompare", such words being identical to the Complainant's UK trademark registration number 2455723D, the Complainant's well known and highly distinctive name GOCOMPARE and the Complainant's trading name. The conjoined words "gocompare" have no ordinary meaning in the English language.
- e. The Domain Name differs from the trademark GOCOMPARE only by the addition of the generic and descriptive suffix 'loans'. Earlier DRS cases have determined that use in a domain name of a descriptive part of a complainant's business is insufficient to avoid a finding of similarity under paragraph 2(a)(i) of the Policy, (DRS 6318), and that a domain name that includes a complainant's name is (when taken as a whole) arguably neither generic nor descriptive (DRS 5818). The addition of the generic and descriptive word 'loans', which is an element of the Complainant's business in any event, is insufficient to avoid a conclusion that the Domain Name is similar to a name or mark in which the Complainant has rights.

The Complainant makes the following submissions in support of its contention that the Registration is an Abusive Registration in the hands of the Respondent:

- a. The Domain Name was registered by the Respondent on 4 September 2007, less than 6 months after the Complainant commenced its high profile UK

television advertising campaign and 6 months after the Complainant first offered loan aggregation services. By the date on which the Domain Name was registered, the Complainant had been trading for over 10 months. Between 1 November 2006 and 4 September 2007, the Complainant spent £20 million on advertising and marketing its services and approximately 12 million unique visitors had visited the Complainant's website. It is inconceivable that the Respondent was not aware of the Complainant and the nature of the Complainant's business (including loan aggregation services) on, and before, the date on which the Domain Name was registered. The Respondent registered the Domain Name with the intention of preventing the Complainant from registering it and/or with the intention of benefiting from the goodwill associated with the name GOCOMPARE and the Complainant's prominent presence on the Internet.

b. The Domain Name contains the Complainant's highly distinctive trade mark GOCOMPARE which, by itself, is very likely to lead internet users to associate the Domain Name with the Complainant and lead internet users to believe that the Domain Name is associated with, endorsed by, or otherwise affiliated to, the Complainant in some way. The Website (and indeed, the website to which the Domain Name currently resolves) made no suggestion that that it was distinct from, or unaffiliated with, the Complainant. The Complainant relies on the decision in DRS 5818 (Honda Motor Co Ltd -v- Liam Kelly).

c. The Domain Name was used to direct visitors to the Website which featured pay-per-click links offering loan services and links to competitors of the Complainant. The Domain Name was used to misdirect those potentially seeking the Complainant's website (and, in particular, information about the loan comparison services offered by the Complainant) to the Website. The Website contained links which, if followed, were very likely to generate income for the Respondent. Even if the Website did not generate income for the Respondent, it is very likely that the Website would have taken potential customers (and therefore possible business) away from the Complainant, amounting to an unfair disruption of the Complainant's business. The Complainant relies on DRS 5844 (McCarthy & Stone plc-v-John Tziviskos).

d. By choosing, or by allowing to be chosen, links containing services identical to those offered by the Complainant, the Respondent intended that users accessing the Website would assume that the links were endorsed by the Complainant. The Respondent has therefore used the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

e. Since the date on which Complainant's solicitors first contacted the Respondent, the Website has been disabled. Since then, the Respondent has made no attempt to use the Domain Name in connection with a genuine offering of goods and services. The Respondent has also failed to respond substantively to the Complainant's solicitors' letters.

f. The Respondent is not employed by the Complainant, or associated with, or otherwise affiliated to, the Complainant in any way and the Complainant has not

authorised, licensed or otherwise consented to the Respondent's registration or use of the Domain Name in connection with loan services or at all.

g. The Respondent is not nor has not commonly been known by the name "Gocompare". The WHOIS information associated with the Domain Name provides no indication that the Respondent is known, or has ever been known, by the name "gocompare".

Response

In response to Nominet's notification of the Complaint, Respondent issued a Response on 29 May 2009 making the following points:

a. Examination of the Complainant's website as at October 2007 shows that the Complainant is engaged in a defined range of services, specifically related to motor vehicles insurance. No other fields of business activity were offered or inferred.

b. The Respondent is engaged in wide-ranging online commercial activity. In March 2007 he registered "gocomparebooks" and later in the same year he registered the Domain Name, along with many others relevant to price comparison services, employing an algorithm using the search term "compare" which automatically listed names of possible relevance to his business activities. The Respondent acquired these registrations "with a view to developing applications".

c. The Respondent was contacted by the Complainant's solicitors in February 2008 with a request from the Complainant to relinquish the Domain Name. This arises from a decision by the Complainant to broaden its services into other areas. It is an aggressive and unethical attempt to acquire registered domain names relevant to these areas.

d. In reaction to the approach from the Complainant's solicitors to relinquish the Domain Name, the Respondent has suspended plans to develop applications relevant to the Domain Name and his other registrations. He intends to focus on other aspects of his online business.

Reply

The Reply made the following points:

a. The Respondent relies upon an archived webpage dated October 2007 to support a contention that the Complainant was engaged in offering a limited range of services related to motor vehicles. However, a link on the archived webpage leads to a page offering other services from the Complainant, including a loan comparison service.

b. Contrary to the Respondent's suggestion, the Complainant began offering a loan aggregation service in March 2007. Between 1 March 2007 and 4 September 2007 (the date on which the Respondent registered the Domain Name), the Complainant received over 12,000 enquiries generated by users accessing the Complainant's loan aggregation service. The Complainant offered an uninterrupted loan aggregation service to its customers between 1 March 2007 and the date on which the Respondent registered the Domain Name (4 September 2007). Indeed, the Complainant continues to offer a loan aggregation service today and it has built up a substantial reputation in relation to that service in this time.

c. The Respondent asserts that the Domain Name was "generated" by 1 & 1 Internet AG (the registrar) after the Respondent attempted to register various domain names containing the word "compare". Many registrars, including 1 & 1 Internet AG, use a keyword pattern matching algorithm to propose alternative (and unregistered) domain names which contain the same or similar words to that inputted by the user (in the event that the user's chosen domain name is already registered). The Complainant understands that this algorithm can propose keywords (such as "gocompare") even if they appear in other registered domain names and regardless of any rights owned by third parties in those suggested names or trademarks (the Complainant understands that the rationale for a registrar utilising such an algorithm is to increase its prospects of selling a domain name to a user). The Domain Name would have been listed in conjunction with a long list of alternatives. The Respondent would still have been required actively to choose to register the Domain Name.

d. Given the Complainant's prominent presence on the Internet at that time, the Complainant's advertising spend between 1 November 2006 and 4 September 2007, and the fact that the Complainant commenced its most concentrated and high profile UK television advertising campaign in March 2007 (6 months prior to the Respondent's registration of the Domain Name), it is inconceivable that the Respondent was not aware of the Complainant and the nature of the its business on, and before, the date on which he registered the Domain Name, particularly as the Respondent is resident in the UK (where the Complainant's television advertising campaigns were, and are, broadcast). Indeed, during a telephone conversation between the Complainant's solicitors and the Respondent on 28 May 2009, the Respondent confirmed that he was aware of the Complainant when he registered the Domain Name. The Complainant therefore asserts that the Respondent's arguments in relation to the automatic generation of the Domain Name by 1 & 1 Internet AG are insufficient to avoid a positive finding under paragraph 2(a)(ii) of the Policy.

e. Attention is drawn to conversations between the Respondent and solicitors for the Complainant relating to the possibility of negotiating the purchase of the Domain Name and other domain names incorporating the element "gocompare" at a "fair market value". The Complainant points to these discussions as further evidence that the Registration is an Abusive Registration. It is suggested that the Respondent acquired the Domain Name for the purpose of selling it to the Complainant at a price in excess of the Respondent's documented out-of-pocket costs directly associated

with acquiring or using the Domain Name, as contemplated by Paragraphs 3.a.i.A of the Policy. Additionally, the Respondent's acquisition of the other related domain names is put forward as evidence that, in the words of Paragraph 3.a.iii of the DRS Policy:

“the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern”.

6. Discussions and Findings

In order to succeed in these proceedings, paragraph 2.b of the Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that:

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Rights

The Complainant correctly states that in order to determine whether the Domain Name is identical or similar to a name or mark in which the Complainant has rights, a comparison must be made between the Complainant's rights and the second-level portion of the Domain Name only, as the .co.uk suffix is “simply a generic feature of the Nominet registry” (Honda Motor Co Ltd -v- Liam Kelly, DRS 05818).

There is no dispute as to the Complainant's ownership of registered trademarks which clearly establish rights in the name GOCOMPARE. The Complainant also claims rights of reputation and goodwill in this name and has provided evidence in support of this claim which is not disputed by the Respondent and which I accept.

The Complainant must show that the name in which it has rights is identical or similar to the Domain Name. The addition of the generic “loans” does not compromise the clear similarity between GOCOMPARE and GOCOMPARELOANS and I therefore find that the Complainant has established rights in accordance with Paragraph 2.a.i of the DRS Policy,

Abusive Registration

Paragraph 3 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Registration is an Abusive Registration in the hands of the Respondent. Paragraph 3. a. i refers to registrations made

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;

The Respondent registered the Domain Name less than six months after the launch of the Complainant's UK marketing campaign. The Complainant emphasizes the fact that a marketing and publicity campaign of such magnitude could not have escaped the attention of the Respondent, who is, so far as is known, a UK resident. I accept the Complainant's argument that the Respondent is likely to have known of the Complainant, its name and the services it offered at the time of the Registration. Further consideration will be given to the Respondent's awareness of the Complainant and its business below, but I find no evidence that Respondent intended a blocking registration under Paragraph 3.a.i.B of the Policy. However it does seem to me, on the balance of probabilities, that there was an intention unfairly to disrupt the business of the Complainant as envisaged by Paragraph 3.a.i.C of the Policy.

Evidence of an Abusive Registration may also be found, according to Paragraph 3.a.ii of the Policy in

“Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;”

The Complainant submits an archived version of the website as at 1 February, 2008 in support of its contention that the Domain Name was used to misdirect those potentially seeking the Complainant's website. Such initial interest confusion may or may not have resulted in financial gain for the Respondent, but the probability that potential customers would have been directed away from the Complainant's site amounts in my view to an unfair disruption of Complainant's business under Paragraph 3.a.i.C of the Policy.

The Complainant further relies upon Paragraph 3.a.ii of the Policy which states that evidence of an Abusive Registration may be found in

Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

The Complainant further argues that the nature of the links presented on the website, leading to comparison services of exactly the same kind as its own, is such that there was a risk, of which the Respondent would have been aware, that the website would give the appearance of endorsement by, or association with the Complainant. The evidence submitted does not throw much light upon the

Respondent's intentions in this regard and I do not view this part of the Complaint as central to the Complainant's case.

Paragraph 4 of the DRS Policy sets out a non-exhaustive list of means by which a Respondent may demonstrate that the Domain Name is not an Abusive Registration. The Respondent's case appears to rely for the most part on Paragraph 4.a.i.A of the Policy which provides that:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

The Respondent asserts that, as of October 2007, the month before he registered the Domain Name, Gocompare.com was offering a strictly defined range of price comparison services, associated exclusively with motor vehicles. The intended inference is either that the Complainant was not offering a broader range of services at this time or that the Respondent was, not unreasonably, unaware of them. However the supporting material supplied by the Respondent contains references to loans and other financial services and does not support these arguments.

The Respondent provides information on his decision to register the Domain Name, as part of his established business activities. The account provided by the Respondent suggests that the Registration of the Domain Name was part of the preparations for a genuine offering of goods or services related to price comparisons across many different areas. The Domain Name was one of a large number identified during this process. Apart from the argument summarised in the previous paragraph, suggesting that, so far as the Respondent was aware, the Complainant was not yet in the field of comparison services for loans, the Respondent does not address the issue of the Complainant's possible rights in a name which is similar to the Domain Name.

The nearest the Respondent comes to clarifying his position in this regard is his statement in his Response that

"Having been contacted by the complainant in February 2008 threatening proceedings unless I relinquished the domain registration and demanding their legal costs which was unreasonable and aggressive I suspended all development on this project to concentrate on other web based applications.

It appears Gocompare.com have recently decided to expand their operation into other areas and are using unethical tactics to acquire domain registrations. "

The second paragraph of this extract from the Response suggests that Respondent believes that the Complainant planned to launch services related to loans and loan aggregation services only subsequent to the date of the Registration of the Domain Name. As the Complainant has demonstrated that service offerings in these areas were in existence some six months prior to the date of Registration, there does not appear to be any basis for the Respondent's view. Any defence

under Paragraph 4.a.i.A of the Policy must include some indication that the Respondent was unaware of the Complainant's "cause for complaint". On the basis of the other evidence made available to me in this matter, I find it difficult to accept that the Respondent did not have knowledge of the Complainant's existence and was not alive to the risks inherent in the use of "gocompare" as an element in the Domain Name.

The Complaint uses the Reply to refer to conversations between the Respondent and solicitors for the Complainant relating to the possibility of negotiating the purchase of the Domain Name and other domain names incorporating the element "gocompare" at a "fair market value". The Complainant points to these discussions as further evidence that the Registration is an Abusive Registration. The suggestion is that the Respondent acquired the Domain Name for the purpose of selling it to the Complainant at a price in excess of Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name, as contemplated by Paragraphs 3.a.i.A of the Policy. The Respondent's acquisition of the other related domain names is offered as evidence that, in the words of Paragraph 3.a.iii of the DRS Policy:

"the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern".

I do not believe these assertions particularly strengthen the Complaint. They turn upon the intentions of the Respondent, about which, even on the balance of probabilities, it would be very difficult to take a clear view. I find that the rest of the Complainant's case has sufficient merit, without the necessity of analysing these additional allegations.

7. Decision

I find that the Complainant has Rights in a name which is identical or similar to the Domain Name, and that the Registration is an Abusive Registration in the hands of the Respondent. I accordingly direct that the Domain Name be transferred to the Complainant.

Signed

Peter Davies

Dated

18 October 2009