

DISPUTE RESOLUTION SERVICE

D00009094

Decision of Independent Expert

Future Route Limited

and

Cohen Daniel

1. The Parties:

Complainant: Future Route Limited
Enterprise House
1-2 Hatfields
London
SE1 9PG
United Kingdom

Respondent: Cohen Daniel
PO Box 3667
Palos Verdes Peninsula
CA
90274
United States

2. The Domain Name(s):

creditpal.co.uk (“the Domain Name”)

3. Procedural History:

The Complaint was filed on 24 September 2010. The Response was filed on 19 October 2010. A Reply was filed on 26 October 2010. Mediation closed on 23 November 2010. The Complainant paid for a decision on 24 November 2010.

On 25 November 2010 I, Adam Taylor, the undersigned, confirmed to Nominet that I knew of no reason why I could not properly accept the invitation to act as expert in this case and further confirmed that I knew of no matters that ought to be drawn to the attention of the parties which might appear to call into question my independence and/or impartiality.

On 30 November 2010, the Complainant submitted a request under Paragraph 13(b) of the DRS Procedure for permission to make a non-standard submission based on information from US attorneys concerning the Respondent's US trade mark application, said to have been received after filing of the Complainant's Reply. However, in view of the outcome below, I considered it unnecessary to request the full submission.

4. Factual Background

As dates are important, I have set out the uncontested facts in the form of a chronology.

12 February 2004	The Respondent registered creditpal.com
30 June 2009	Rupert Parson of the Complainant emailed the Respondent from his personal gmail.com email account asking if creditpal.com was for sale.
6 July 2009	The Respondent emailed asking for a best offer
7 July 2009	Mr Parson offered \$2000
13 July 2009	Mr Parson sent a chaser email
14 July 2009	The Complainant filed applications for UK trade marks, later registered as number 2521121A for the word CREDITPAL and 2521121B for the stylised word "CreditPal" plus device, both in classes 9, 35 and 36.
15 July 2009	The Respondent emailed as follows: "... To be honest with you I've invested a lot of money for many years on a number of domain names and I require to get much more to recover at least my investment. So, I'm thinking somewhere around a million. I'd completely understand if this may sound too much to you. However, this would be suitable for a large organization who intends to make millions out of this domain year after year and is willing to invest the initial one-time purchase price..."

28 July 2009	The Complainant filed an application for an International Trade Mark Registration designating the US for the stylised word "CreditPal" plus device in classes 9, 35 and 36
12 August 2009	The Complainant registered creditpal-online.com and thereafter started using it for a website
25 December 2009	The Respondent's US corporation, CreditPal LLC, filed an application for a US trade mark for CREDITPAL in class 36
7 March 2010	The Respondent registered the Domain Name.
4 August 2010	The Complainant's trade mark agents wrote to the Respondent claiming that registration of the Domain Name and its redirection to creditpal.com offering credit solution products and services was an abusive registration and trade mark infringement. They said that by way of settlement the Complainant would agree to pay £3000, equating to \$4,575, for the Domain Name.
12 August 2010	The Respondent's attorney wrote back agreeing to the transfer for that price on condition that the Complainant dropped its US designation of its International Trade Mark application. The attorney asserted that the Respondent had used the Creditpal trade mark in the US since 2004
1 September 2010	The Complainant's trade mark agents wrote to say that that the only use of the mark by the Respondent had been the registration of creditpal.com for sale as a part of a domain dealing business and that this did not constitute use for the purpose of a US trade mark opposition. The agents claimed that the Complainant's International Trade Mark was likely to acquire rights predating the Respondent's US trade mark application and stated that the Complainant's application would not be abandoned.
10 September 2010	The Respondent's attorney reiterated that the Respondent had made genuine use of the mark aside from use of creditpal.com. The attorney repeated the previous offer (acceptance of \$4575 for the Domain Name subject to abandonment Complainant's US application) and offered in the alternative that the Domain Name be sold to the Complainant for \$19,500.
14 September 2010	The Complainant's trade mark agents wrote to ask for evidence of genuine use of the mark in the US since 2004.
21 September 2010	The Domain Name was redirected to a website at creditpal.com, offering personal finance software and services.

5. Parties' Contentions

Complaint

The Complainant has rights in respect of the trade mark Creditpal deriving from its UK trade mark registrations. These earlier trade mark registrations are identical or similar to the domain name.

The distinctive element of the domain name is the word "Creditpal", which is identical to and entirely reproduced in trade mark no. 2521121A and which is the entire phonetic and conceptual matter featured in no. 2521121B.

The Respondent registered or otherwise acquired the domain name primarily with the purposes of selling, renting or otherwise transferring the domain name to 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. In addition or in the alternative the Domain Name is being used to disrupt the Complainant's business and cause confusion in Internet searches.

In the June / July 2009 communications, the Respondent must have been aware that he was communicating with a United Kingdom based entity.

Furthermore, the Complainant attempted negotiations to acquire creditpal.com through Sedo, who contacted the registered proprietor in July and August 2009.

Following the various enquiries and the failure to reach an agreement between the Respondent and the Complainant, the Respondent proceeded to register the Domain Name, having at some stage realised he was dealing with a UK entity and with the intention of selling the domain name for valuable consideration in excess of documented out-of-pocket costs directly associated with acquiring the Domain Name, while having reasonable grounds to believe it was the Complainant's mark or the mark of the persons who had made the enquiries mentioned above.

The Domain Name is an abusive registration because it has been subsequently used to disrupt the Complainant following the failure to obtain a lucrative settlement for the Respondent's existing Domain Name. The Domain Name was registered on 7 March 2010, after the Complainant's UK trade mark registrations.

The Domain Name redirects to www.creditpal.com which has in the last few weeks, been enhanced to provide or promote a wide range of credit and financial service information identical to those for which the trade marks are registered including but not limited to "financial services provided via the Internet; provision of financial information".

Whereas previously creditpal.com was available for sale, it is now used to provide competing services or services confusingly similar to those provided on the Complainant's website at www.creditpal-online.com.

The sudden activity and changes to the site have been implemented to now effectively force the Complainant to acquire the Domain Name as well as the .com version.

The Respondent has alleged that he has made use of the trade mark Creditpal in the United States since creditpal.com was first registered in 2004 but no such evidence has ever been provided. Following an exchange of correspondence between the parties in respect of the Domain Name, on 10 September 2010 the representatives of the Respondent asked for 19,500 US dollars to transfer the Domain Name.

It was following the original negotiations and during the solicitor negotiations in August / September 2010 that the Respondent began using the domain name creditpal.com and redirecting the Domain Name to it in a clear act to disrupt the Complainant's enterprise in that internet searches for "Creditpal" will now feature the Respondent's competing website.

Paragraph 3(a)(i)A or C and/or 3(a)(ii) of the Policy apply. The Respondent is using the Domain Name in a way that effectively forces the Complainant to acquire it or/and is likely to confuse people or businesses in to believing that the domain name is operated or otherwise authorised by the Complainant. A Google search for "Creditpal" on 21 September 2010 identified the Complainant's website at www.creditpal-online.com and, immediately below that, the Respondent's domain name www.creditpal.com. Previously the website www.creditpal.com was inactive in that it did not provide access to any existing services.

According to the Wayback Machine at www.archive.org, on 24 March 2004, ie in the year when the Respondent first registered the domain name creditpal.com, the web page stated: "buy this domain name at CatchyDomains.com.". By 9 February 2005 the web page simply said "this web page is parked free, courtesy of GoDaddy.com" and included various offers for the sale of domain names.

The current website featured at www.creditpal.com was introduced only recently with a view to disrupting searches for the Complainant's services. As part of the ongoing attempt to extract monies from the Complainant, on 25 December 2009 the Respondent filed United States trade mark application no. 77900983 for the word CREDITPAL.

The Complainant is the proprietor of an earlier International Trade Mark Registration No. 1035811 for the stylised word CreditPal plus device designating the United States and claiming priority of 16 July 2009.

The current redirecting of the Domain Name to www.creditpal.com is an infringement of sections 10(1) and (2) of the 1994 Trade Marks Act.

Response

The Respondent is the proprietor of trade name "Creditpal" in accordance with the United Kingdom passing off tort that protects unregistered trade marks due to prior use".

The Respondent started using the trade name Creditpal since early 2004 by starting his Creditpal business, and establishing the Creditpal website presence through creditpal.com domain name registered on 13 February 2004.

The Respondent obtained his California Real Estate Broker License on 6 September 1989 and engaged in the business of real estate, mortgage, and finance business. In the course of this business, he came across many people who were having issues with their credit. Hence, in early 2004 he also started an advisory service business relating to credit and debit control, credit products, software, and services, investment, grants and financing of loans, as well as consumer credit consultation under the trade name "Creditpal". In order to extend his Creditpal business online, since early 2004 he established the Creditpal website presence through the creditpal.com domain name.

The Respondent started using the Creditpal trade name over five years before the Complainant encountered his website on 30 June 2009 and "decided to take it all away in bad faith, and by way of misrepresentation, and fraud". On 30 June 2009 the Respondent received an email from the Mr Rupert Parson of the Complainant inquiring about the creditpal.com domain name. The Respondent refused the Complainant's offer. Shortly afterwards, on 14 July 2009, the Complainant filed its UK trade mark applications and later the Complainant registered the domain name creditpal-online.com on 12 August 2009.

Section 5(4)a of the Trade Marks Act 1994 prevents registration of a mark whereby 'its use in the UK is prevented by virtue of law of passing off'. By virtue of section 47(2) of the Act, a registered trade mark may be declared invalid if such condition applied.

The Complainant's mark is liable to invalidated as the Complainant was fully aware of the Respondent's use of the Creditpal trade name at the time of the UK trade mark registration. The Respondent is in process of "opposing" said trade mark registration. The Complainant was fully aware of the Respondent's use since 2004 of the Creditpal trade name by the Respondent when it first came across creditpal.com and contacted the Respondent on 30 June 2009. However, it nonetheless he decided to apply for Creditpal trade marks, and to register creditpal-online.com using the Creditpal trade name with the intent of taking the Respondent's trade marks and domain names, by filing a domain name complaint. Consequently the Complainant cannot rely on its trade mark registrations for Creditpal.

From the inception of Creditpal in 2004, the Respondent intended to establish the business globally as he had realized that people from all over the world struggle with credit issues. During mid-2009, the Respondent decided that it was time to start taking that step and since the first step in building an online presence for any business is to secure a domain name he started looking into registering the Creditpal domain name in Canada, Mexico, and United Kingdom. The Respondent

successfully registered the Creditpal domain names in Canada, and Mexico. However, the Creditpal domain name for United Kingdom, namely the Domain Name, was not available at the time. So, he back ordered the said domain name through SnapNames, Inc. Finally, almost a year later on 7 March 2010 he received an email from SnapNames, Inc indicating that he had successfully acquired the domain name creditpal.co.uk and that his credit card account had been debited accordingly.

The Complainant's CREDITPAL trade mark registration, and first use of the said trade name, occurred over five years after the Respondent's first use and "some time" after placement of the back order.

The Complainant deliberately started using the Respondent's trade name without any consent and now complains about the Domain Name being used to disrupt his own business and cause confusion. The Complainant started the problem by attempting to bully Respondent into handing over his domain names and trade marks, by means of wrongful accusations and shady business tactics.

The Complainant is guilty of passing off by his registering creditpal-online.com and using the Respondent's Creditpal trade name. The Respondent is in the process of initiating legal action against the Complainant seeking an injunction and damages for passing off.

It is misleading for the Complaint to say that an officer of the Complainant, Mr Rupert Parson, contacted the Respondent "[f]ollowing the filing of British Trade Mark Application ... on 14th July 2009...". Mr Parson first contacted the Respondent on 30 June 2009 before filing of the UK trade mark application, before registering the domain name creditpal-online.com and before his first use of the trade name Creditpal. Furthermore, Mr Parson only inquired about the domain name and that is why only the domain name was discussed. Most business oriented people will entertain an offer on anything in their business including the business itself. If not really motivated to sell, as the Respondent was not, then they would ask for an "off the wall amount" as what the Respondent did by saying that he would only be willing to sell it for somewhere in the region of "a million".

It is a completely false and unfounded assumption that the Respondent registered the Domain Name having realised he was dealing with a UK entity and with the intention of selling to that entity for an excessive price while having reasonable grounds to believe it reflected the Complainant's mark or the mark of the persons who had made the enquiries to buy the Domain Name. The Complainant had absolutely no right whatsoever to use the Respondent's trade name to begin with, let alone to make absurd false accusations.

The Complainant accuses the Respondent of enhancing the look and feel of the website that he has owned since early 2004. Again, the Complainant is the offender in trying to take something that does not belong to it.

The Respondent is in process of developing a tailored configuration for his UK consumers, as well as Canada, and Mexico. It has taken a bit longer than expected and that is just the nature of such website projects.

The Respondent is not forcing the Complainant to acquire the trade name that the Respondent has been using since early 2004. The Complainant should simply stop using the Creditpal trade name, and related domain names which it has started using without the consent or prior permission the Respondent.

The Complainant's expectation that the Respondent produce evidence of use of the Creditpal trade name or creditpal.com domain name is absurd. The Respondent might as well print all his confidential and trade secret information and present it to anybody who claims Creditpal trade name rights. On the other hand there is no evidence of the the Complainant using the Creditpal trade name from 2004 to the first half of 2009.

The Complainant's complaint that the Respondent starting using creditpal.com and redirecting the Domain Name during the negotiations between the solicitors is "unbelievable". The Respondent "has been on the Internet since early 2004". The Complainant was not supposed to hijack the Respondent's trade name to begin with. The Complainant is clearly seeking to disrupt the Respondent's enterprise.

The archive.org printouts are unreliable. The terms and condition from archive.org state that access is granted for scholarship and research purposes only and that Archive.org does not guarantee that its content is accurate, or complete. Indeed it is neither accurate, nor complete. To the best of the Respondent's belief, CatchyDomains.com sells only their own domain names and they do not sell third party domains, unlike say Sedo.com. The domain name creditpal.com used to be one of their domain names before the Respondent purchased it on 13 February 2004. GoDaddy has always been the domain registrar for creditpal.com. This proves that the archive.org information is indeed inaccurate and incomplete. Because once a domain name is registered at GoDaddy, it is no longer active at CatchyDomains.com. As for the GoDaddy parking page, this is normal as when switching to a new hosting server company as it takes from 24 hours to 48 hours for the name servers to get updated and during that period - since no hosting server exists - GoDaddy displays the coming soon parked free page. The Respondent has switched the hosting server many times during the course of over 6 years since early 2004. So, one snapshot of such page during over six years of owning the creditpal.com website does not prove anything,

Reply

Simply registering a domain name does not constitute use of a trade name, nor does it constitute evidence of a common law right to the trade mark Creditpal and it certainly does not constitute evidence of common law rights to the mark Creditpal in the UK. The Respondent was requested to provide some evidence to support the alleged common law right to the mark Creditpal in the US but failed to submit a reply or to provide any evidence.

While the Complainant does not expect the Respondent to provide evidence of a common law right to the use of the mark Creditpal in the UK to the standard required in court, it would nevertheless request at least some evidence to support such an assertion.

If the Respondent were using the trade mark Creditpal then one would have expected him to supply copies of invoices, details of turnover generated under the trade mark, dated samples of advertisements, details of advertising expenditure in promoting the trade mark or at least some or all of such evidence. No such evidence has been provided despite being explicitly challenged to provide this evidence before this Complaint was filed.

While the Complainant contacted the Respondent on 30 June 2009, and it is admitted that the UK trade marks were filed on 14 July 2009, it is denied that this was done in bad faith, or by way of misrepresentation, or by fraud. The choice of the mark Creditpal by the Complainant was a bona fide choice of mark. Furthermore the Complainant was aware that the Respondent had no genuine commercial activity behind the domain creditpal.com at the time of deciding to file the UK trade mark applications.

It is denied that the Respondent has any such common law rights justifying an invalidity application under the Trade Marks Act. The Complainant has not received any notice of opposition or invalidity application.

It is denied that the Respondent intended to establish Creditpal as a business globally. The Respondent is in the business of registering domain names with a view to subsequently selling these on at a profit. While the Complainant makes no objection to such a business model where such domains do not consist of trade marks which the Respondent knows belong to another, the Complainant does submit that where a domain name is registered knowing it to reflect the trade mark of another then such a registration is an abusive registration. The Respondent engaged SnapNames.com, Inc with a view to acquiring the Domain Name and subsequently selling it to the Complainant in a manner which is in breach of the DRS Policy.

The Complaint erred when stating that Dr Parson contacted the Respondent after filing a UK trade mark application on 14 July 2009. The communication of 30 June 2009 was nevertheless mentioned in the same paragraph and the preliminary enquiries into the use of the domain name creditpal.com is in keeping with a bona fide genuine clearance investigation to assess and confirm the availability of a trade mark for both use and registration.

The Respondent alleges that the exchange of email correspondence between himself and Dr Parson was intended to indicate that the domain name creditpal.com was not available for sale. The true context of the email clearly indicates that the Respondent is in the business of prospecting with domain names. This is not a business that the Complainant objects to, merely that following this exchange of correspondence the Respondent then went on to start registering domain names which he knew reflected the Complainant's chosen trade mark.

The Complainant maintains that the Respondent had reasonable grounds to believe that the mark Creditpal was in use in the United Kingdom and he chose to

register the domain name in dispute, being aware of that and for the purposes of exploiting that.

It is admitted by the Respondent that www.creditpal.co.uk is indeed being redirected to the American website www.creditpal.com. While the Respondent alleges that it is initiating legal action against the Complainant on grounds of passing-off, no pre-action correspondence has been received in respect to such a threat by the representatives of the Complainant and it was by means of the Response that for the first time the Respondent has indicated that he intends to sue the Complainant.

The Response illustrates the Respondent's true intention where it states that the Complainant must stop using the Creditpal trade name.

It is proper procedure to make enquiries as to the use of a domain name during trade mark clearance searches. Such enquiries led the Complainant to the conclusion that the domain name was not in use by the Respondent.

The Respondent appears to misinterpret the archive.org terms and conditions. The disclaimers relate to the content of the web pages maintained in the archive. It does not suggest that these web pages themselves never existed. Furthermore, the disclaimer stating that the archive does not guarantee or warrant that the content available in the collection is accurate or complete cannot be interpreted to mean that the web pages which are maintained in the archive are fabricated. The content would be purely dependent on the persons who published the original pages. It may be the case that a web page contains misleading or offensive information. That does not mean that the web page did not exist. Furthermore, the fact that the archive may be incomplete cannot be relied upon to suggest that those web pages that are featured in the archive are false.

A print-out obtained from the website at www.creditpal.com as submitted by the Respondent to the United States Patent and Trademarks Office (USPTO) when attempting to register the word CREDITPAL as a trade mark consists of a specimen dated 25 December 2009 of the website in question stating "WEBSITE UNDER MAINTENANCE". And the USPTO's examination report stated: "The specimen is not acceptable because it does not show the applied-for mark used in connection with any of the services specified in the application."

By the applicable US legal standards the domain name was not in use as a trade mark. The Respondent cannot contest the provenance of this evidence as it was submitted by him to the USPTO.

The evidence of the use of the website submitted by the Complaint must have been probative evidence as there now features on www.creditpal.com a deliberate instruction to block archive.org, namely a .txt document from www.creditpal.com/robots.txt downloaded at 19.02 on 20th October 2010.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of "rights" is clarified and defined in the Policy in the following terms:

"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"

The Complainant has rights in a name identical to the Domain Name by virtue of its UK registered trade mark for CREDITPAL.

The Respondent attacks the Complainant's reliance on its UK registered trade mark. It says that the mark is liable to be invalidated on the basis of the Respondent's alleged prior unregistered trade mark and claims that the Complainant's application was made in full knowledge of the Respondent's prior rights. The Respondent says it is "opposing" the trade mark although the Complainant says it has received no notice of an application to invalidate its mark.

I cannot accept the Respondent's submissions. There is no evidence of any use by the Respondent of the mark "Creditpal" in connection with the UK but, even if there were, the Complainant's registered mark must nonetheless be presumed to be valid unless and until invalidated by the UK Intellectual Property Office or the courts.

Abusive registration – introduction

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS 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."*

The Respondent's use of CREDITPAL before acquisition of the Domain Name

The starting point is to consider the extent to which the Respondent has used the mark CREDITPAL prior to registration of the Domain Name.

The Respondent, who is located in the US, claims that in the course of his real estate business he came across many people with credit issues and, as a result, in early 2004 he started an advisory service business relating to credit and debit control, credit products, software, and services, investment, grants and financing of

loans, as well as consumer credit consultation under the trade name “Creditpal”. He says that, in order to extend the business online, he established the website at www.creditpal.com, also in early 2004.

The Complainant denies that the Respondent has carried out any such business and says he is simply a domain name dealer.

I am sceptical of the Respondent’s claims for the following reasons.

1. The Respondent makes no mention of any Creditpal business in his email of 15 July 2009 in which he sought “around a million” for creditpal.com. The Respondent claims that only the domain name was discussed because Mr Parson inquired only about the domain name and that most business-oriented people will entertain an offer for any part of their business including the business itself. And he says that he asked for an “off the wall” amount because he was not really motivated to sell. Nonetheless, if the Respondent had been actively using creditpal.com for some five years in connection with a business, one might have expected him to mention the fact at this juncture. Whereas instead he talks about wishing to recovering his substantial investment in domain names over many years.
2. In pre-action correspondence concerning the Respondent’s condition for settlement that the Complainant abandon the US designation of its International Trade Mark application, the Complainant requested that the Respondent provide proof of use if its mark since 2004. Yet the Respondent provided no such proof. The Respondent now says that it was absurd to expect him to provide such evidence and asks why he should have to “print all his confidential and trade secret information” and present it to anyone claiming trade mark rights. But this request could easily have been fulfilled – at least in part – by providing publicly available information such as examples of marketing, website printouts etc. Whereas the Respondent in fact provided nothing.
3. Nor has the Respondent provided any evidence with the Response showing actual operation of a business under the name “Creditpal”, despite the issue having been raised squarely in the Complaint. As mentioned, the existence of such a business could easily have been proven by production of (non-confidential) documents.
4. The Complainant has submitted Wayback Machine (archive.org) printouts of the website at creditpal.com as of 24 March 2004 and 9 February 2005. The first is a parking page with generic sponsored links and an invitation: “Buy this domain name at CatchyDomains.com”. The second is a GoDaddy holding page. The Respondent says that archive.org printouts are unreliable. He also argues that the first holding page derives from the previous registrant of creditpal.com, CatchyDomains.com, who in any case sell only their own domain names and not third party domains (implying that they could not therefore have been commissioned by the Respondent to sell that domain name on his behalf). He explains that the GoDaddy page was a temporary page which appeared when the name servers were

being update to change the website hosting. While the Respondent rightly points out that one or two such snapshots of a page during over six years of owning the domain name does not prove much, his position would have been more credible if, in response to the Complainant's evidence, he had produced some documents showing active use of the website.

5. The specimen of use produced by the Respondent in support of his US trade mark application was simply a "website under maintenance" page dated 25 December 2009 - subsequently rejected by the USPTO.

For all of the above reasons, I am unconvinced that the Respondent has used the mark Creditpal or the domain name creditpal.com in any active sense (until recently – see below).

The Respondent's decision to acquire the Domain Name

The Respondent says that in mid-2009, he decided to expand the business "globally" and that he "started looking into registering" the Creditpal domain name in Canada, Mexico and the UK. He states that he successfully registered domain names in Canada and Mexico but that the Domain Name was already taken and so he ordered it through Snapnames Inc. And that finally "almost a year later" on 7 March 2010, he received an email from Snapnames confirming that he had acquired the Domain Name.

The Respondent alleges that he is in the process of developing a "tailored configuration" for his UK consumers, as well as Canada, and Mexico but that it has taken a bit longer than expected as is the nature of such website projects.

In my view, the Respondent's explanation of his purpose in registering the Domain Name is not credible given the absence of any correspondence, plans or other proof concerning his alleged UK offering, not to mention the lack of evidence that any meaningful Creditpal business exists at all.

Rather, the timings suggest that the Respondent's decision to acquire the Domain Name was connected in some way with the Complainant.

The Respondent does not specify, let alone supply evidence as to, the exact date that he placed the backorder for the Domain Name (which is not stated on the Snapnames confirmation email). Nor does the Respondent provide proof of the dates of registration of the Canadian and Mexican domain names, with which he associates his decision to acquire the Domain Name.

But the Respondent does acknowledge that the decision to register the Domain Name was first taken in "mid 2009" ie some five years after he allegedly started using the name Creditpal in the US. It seems unlikely to be a coincidence that the first approach by the Complainant occurred on 30 June 2009.

The Respondent does criticize as "false and unfounded" a statement by the Complainant that the Respondent registered the Domain Name having realised he was dealing with a UK entity and with the intention of selling to that entity for an excessive price while having reasonable grounds to believe it reflected the

Complainant's mark or the mark of the persons who had made the enquiries to buy the Domain Name.

It is true that the emails from Mr Parson in June / July 2009 did not mention the Complainant or its proposed business or give any clue that it emanated from the UK.

Yet nowhere does the Respondent claim that he decided to acquire the Domain Name before he became aware that the Complainant, or at least a UK entity, was interested in the name "Creditpal". If that had been the case, I believe he would have said so.

Respondent's use of the Domain Name

The Complainant says that, "within the last few weeks" (the Complaint was filed on 24 September 2010), the website at creditpal.com was "enhanced" to provide credit-related services similar to those provided by the Complainant and that the Domain Name was redirected to that site. The Complainant says that this was designed to disrupt its business.

The Complainant suggests that this usage started during the representatives' negotiations in August / September 2010 although it had clearly begun by the time of the first letter from the Complainant's agent on 4 August 2010, which makes reference to it.

The Complainant has supplied a printout of the website at creditpal.com as of 21 September 2010, showing that it has indeed been used for personal finance software and services. For example the site offered software entitled "You Need A Budget" and "Financial Tools Delux" (with prices in US dollars) and included articles such as "7 Tips on Putting Your Dollars to Work for U", "Choosing a Credit Counselor" and so on. There were various references to "CreditPalTM".

The Complainant has not provided any proof of redirect of the Domain Name but, on the other hand, the Respondent has not denied that a redirect did occur.

Indeed it is striking is that in the Response the Respondent does not explain its purpose in launching such a website or say when it first started (simply pointing out that it "has been on the Internet since 2004"). Instead it seeks to justify its activity simply by asserting that the Complainant is the "offender" and allegedly out to disrupt the Respondent's enterprise.

It is difficult to reach any conclusion about the exact motives of the Respondent in using the Domain Name in this way. It may have been designed to divert business from the Complainant (although the Respondent's site does appear to be very US-focussed) or as some form of retaliation against the Complainant's US trade mark filing or as a belated attempt to demonstrate use of the Creditpal name for trade mark purposes. Or there may be some other explanation.

All I can say is that the failure of the Respondent to explain itself here casts further doubt on his *bona fides*.

Alleged misconduct by the Complainant

The Respondent devotes a large part of his Response to attacking the motives of the Complainant. Amongst other things, he claims that, by filing its US trade mark application and registering its domain name creditpal-online.com after rejection by the Respondent of its offer, the Complainant is out to “take” the Respondent’s domain names and trade marks. The Respondent also says that the Complainant’s use of its domain name itself constitutes passing off vis a vis the Respondent. The Respondent asserts that the Complainant has been guilty of “misrepresentation and fraud”, that it is bullying the Respondent and so on.

However, none of this is borne out by the evidence which has been presented to me.

I see nothing suggesting that the Complainant is out “take” the Respondent’s domain name creditpal.com.

It is true that the Complainant seeks transfer of the Domain Name but it is entitled to so in accordance with Nominet’s terms and conditions for registration of .uk domains, provided of course that it establishes the conditions set out in the DRS Policy.

Nor is it evident to me that there is anything objectionable about the Complainant’s International Trade Mark application designating the US, notwithstanding that this was filed a few weeks after the Respondent’s rejection of its offer to buy creditpal.com. The US application followed soon after the Complainant’s UK filing and there is no evidence to suggest that it was motivated by anything other than an intention to expand the Complainant’s business to the US. The success or otherwise of such an application, including the issue of the Respondent’s alleged prior rights, is of course a matter for the USPTO.

The Respondent also criticizes the Complainant’s registration and use of creditpal-online.com but the Respondent has provided no evidence to suggest that this was in some way intended to target the Respondent or otherwise in bad faith. The Respondent says it is in the process of initiating legal action against the Complainant seeking an injunction and damages for passing off and no doubt it will raise such issues in the course of that case.

In summary, the Respondent has not provided any evidence of misconduct by the Complainant which is of material relevance in this proceeding or which in any way justifies the activities of the Respondent.

Abusive registration - conclusion

One can think of many plausible and genuine reasons why the registrant of a .com domain might later wish to acquire the .co.uk variation. However, the difficulty for the Respondent is that its Response appears to me to be both evasive and implausible.

Taking into account all the factors mentioned above, including the coincidence in timing between the Complainant’s approach and the Respondent’s decision to acquire the Domain Name, and also the lack of any credible reason for registering

the Domain Name, I conclude on the balance of probabilities that the Respondent registered the Domain Name to target the Complainant inappropriately. In my view it is sufficient if, at the time of its decision to register the Domain Name, the Respondent had in mind a specific UK entity which it knew was interested in using the name "Creditpal" in the UK even if the Respondent did not at this stage know its identity.

The exact motive of the Respondent remains unclear. Possibilities include selling the Domain Name to the Complainant for a significant price (\$19,500 was sought at one point by the Respondent's attorney) or procuring abandonment of the Complainant's US designation of its International Trade Mark application (also proposed by the attorney as part of a settlement) or encouraging the Complainant to offer more for creditpal.com.

In any case, whatever the precise rationale, I conclude that the Domain Name is an abusive registration in that it was acquired and/or used in a manner which took unfair advantage of, or was unfairly detrimental to, the Complainant's rights. (It is not necessary for me to make a specific finding under any of the non-exhaustive factors in paragraph 3(a) of the DRS Policy.)

7. Decision

The domain name creditpal.co.uk should be transferred to the Complainant.

Signed: Adam Taylor

Dated: 21 December 2010