

DISPUTE RESOLUTION SERVICE

D00011028

Decision of Independent Expert

Microsoft Corporation

and

UK International Trading

1 The Parties

Complainant: Microsoft Corporation
One Microsoft Way
Redmond
Washington
98052
United States

Respondent: UK International Trading
10 Padside Row Hamilton
Leicester
Leicestershire
LE5 1WA
United Kingdom

2 The Domain Names

bingauto.co.uk, bingcar.co.uk, bingcars.co.uk, binghome.co.uk and binghomes.co.uk
(together “the Domain Names”)

3 Procedural History

- 3.1 On 8 March 2012 the complaint was received. On 9 March 2012 the complaint was validated and notification of it sent to the Respondent. On 30 March 2012 the response was received and notification of it sent to the Complainant. No reply was received from the Complainant. On 11 April 2012 the mediation started and on 24 April 2012 the mediation failed. On 25 April 2012 the expert decision payment was received.
- 3.2 On 26 April 2012 Patricia Jones (“the Expert”) confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in D00011028 and further confirmed that she knew of no matters which ought to be drawn to the attention of the parties which might call into question her independence and/or impartiality.

4 Factual Background

- 4.1 The Complainant is a well-known software and services company which was founded in 1975. The Complainant provides online search, news, travel, shopping and other information services under the mark BING in the US, UK and elsewhere.

- 4.2 The Complainant announced the launch of its BING search engine and information services on 28 May 2009. The launch was reported by the press worldwide, including in the UK by 'The Independent' and 'BBC News' online. The BING services became available to the public in early June 2009, with a localised UK version launched in November 2009.
- 4.3 The Complainant provides the BING services from bing.com. It registered this domain name on 28 January 1996. The Complainant also owns the domain name bing.co.uk which was registered on 19 May 1999.
- 4.4 The Complainant is the owner of trade marks for BING including: a US trade mark in Classes 9, 35, 38, 41 and 42 (registered on 7 June 2011); a US trade mark in class 39 (registered on 30 November 2010); an International Madrid Trade Mark which was granted protection in the European Union and other countries on 2 March 2009 in class 39; and various other national trade mark registrations.
- 4.5 The Respondent has registered a number of domain names which incorporate 'bing', including the Domain Names, after launch of the Complainant's BING services. These are or have been the subject of a complaint by the Complainant as set out below.

Domain Name	Registration Date	Forum of Complaint	Decision
bingauto.co.uk binghome.co.uk binghomes.co.uk	1 June 2010	Nominet	The subject of this decision
binghome.us	1 June 2010	National Arbitration Forum	Transfer
bingauto.us	21 June 2010	National Arbitration Forum	Transfer
bingcar.us bingcars.us	25 June 2010	National Arbitration Forum	Transfer
bingcar.co.uk bingcars.co.uk	12 May 2011	Nominet	The subject of this decision
bingcars.net, bingauto.net and binghomes.net	2010/2011 (exact dates unknown)	National Arbitration Forum	Transfer

- 4.6 On 1 March 2012 (after the National Arbitration Forum ("NAF") decisions set out above and detailed at paragraph 5.4) the Respondent sent an e-mail to the Complainant's lawyer enquiring whether the Complainant would be interested in the Domain Names. On 2 March 2012 the Complainant's lawyer asked whether the Respondent would be willing to voluntarily transfer the Domain Names to the Complainant to avoid a Nominet complaint and also asked if the Respondent had any other domain names which used the Complainant's trademarks. On 2 March 2012 the Respondent replied that it had no other domains with 'bing' and that for transfer it wanted compensation to cover the cost of registration. On 3 March 2012 (US time) the Complainant's lawyer asked for a total cost and whether the Respondent had other domains that include any other Microsoft related domains. On 2 March 2012 (UK time) the Respondent gave the figure of \$1300 to cover the cost of the Domain Names and the .us and .net domains. On 3 March the Complainant's lawyer asked for documents to establish \$1300 as the Respondent's actual costs. On the same day the Respondent replied enquiring how

much the Complainant was willing to pay in compensation. The Complainant subsequently offered \$100 for the Domain Names with no compensation payable for the domain names awarded to the Complainant by the NAF. On 6 March 2012 the Respondent replied that the Domain Names were not for sale but if the Complainant was willing to pay \$1300 compensation then it would be willing to transfer them.

4.7 The Domain Names resolve to pages which contain links to third party sites, some of which offer similar or competing services to those of the Complainant. On 6 March 2012 the use of the Domain Names was as follows:

- (a) The page at bingauto.co.uk contained links to sites selling cars and goods and services relating to cars.
- (b) The page at bingcar.co.uk contained links to games and trivia sites, a nursing program and a Google engage program.
- (c) The page at bingcars.co.uk contained links to sites selling cars.
- (d) The page at binghome.co.uk contained links to sites for games and trivia, car insurance, a nursing program and the Google engage program.
- (e) The page at binghomes.co.uk contained links to addiction treatment, hospice care, medical and other products, adoption, freight brokers, jobs and degrees and consultation services.

5 Parties' Contentions

5.1 The contentions of the parties are set out below. I have found the Respondent's response difficult to follow and I have summarised below my understanding of it.

The Complainant's complaint

5.2 The Complainant says that prior to registration of the Domain Names the BING mark had become famous and acquired secondary meaning through unprecedented global press coverage. The Complainant relies on the following decisions of the NAF:

- (a) FA 1271165 dated 30 July 2009 (not involving the Respondent) recognizing the *"global scale of the launch of the BING services"* and noting *"this Panel is satisfied that the word BING had acquired secondary meaning through Complainant's use of it on May 28, 2009, the launch date of Complainant's search engine, sufficient to establish rights to satisfy the requirements of Policy 4(a)(i)"*.
- (b) FA 1297333 dated December 29, 2009 (not involving the Respondent) *"the evidence shows that the press began speculating as to Complainant's likely adoption of the BING trademark as early as August 1, 2008"* and that by March, 2009 *"Complainant's [BING] trademark would have been known to a significant section of the public"*.
- (c) FA1201001423606 dated Feb 17, 2012 between the Complainant and the Respondent noting that *"the Panel must conclude that Respondent had actual notice of Complainant's mark. It is just too famous"*.

5.3 The Complainant contends that the Domain Names are confusingly similar to the BING mark. The Complainant argues that the addition of the generic terms 'auto', 'car', 'cars', 'home' and 'homes' are not sufficient to distinguish the Domain Names, especially when they relate to the Complainant's BING services. The Complainant says that there are research tools for autos, cars and homes on BING and affiliated sites such as msn.co.uk and ciao.co.uk which were available prior to registration of the Domain

Names. The Complainant also says that the term 'home' is commonly used to refer to a web site's 'home' page and that BING Maps are used to locate homes on a map.

- 5.4 The Complainant contends that 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 trademarks in which the Respondent has no apparent rights, and the Domain Names are part of that pattern. The Complainant relies on the previous NAF proceedings between the Complainant and the Respondent detailed below and argues that the registration and use of the Domain Names is no different to these cases.
 - (a) NAF Decision (No FA1201001423606) dated 17 February 2012 which transferred to the Complainant bingauto.us, bingcar.us, bingcars.us and binghome.us. The Panellist found the BING mark to be famous and very well known. The Panellist also found that the Respondent's registration of these domain names was for the purpose of either resale to the Complainant or to attract BING users searching for common consumer products and to then link to web sites selling such products to generate income.
 - (b) NAF Decision (FA1201001423605) dated 15 February 2012 which transferred to the Complainant bingcars.net, bingauto.net and binghomes.net.
- 5.5 The Complainant contends that the Respondent registered the Domain Names for the purposes of selling, renting or otherwise transferring the Domain Names 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 Names. The Complainant refers to the NAF cases involving the Respondent where bad faith was established, in part, through the Respondent's offers to sell one or more of the domain names in excess of its out-of-pocket expenses. The Complainant also relies on the Respondent's demand of \$1300 for the Domain Names which the Complainant says is more than the Respondent's documented costs.
- 5.6 The Complainant contends that the Respondent registered the Domain Names as blocking registrations against a name or mark in which the Complainant has Rights. The Complainant says that taking into consideration the 'bing' .us and .net domain names it is clear that the Respondent has sought to block the Complainant from registering domain names specific to its services.
- 5.7 The Complainant contends that the Respondent registered the Domain Names for the purpose of unfairly disrupting the business of the Complainant, and is using them in a way which is likely to confuse people or businesses into believing that the Domain Names are connected with the Complainant. The Complainant states that the pages at the Domain Names contain links to third party sites which in some cases offer similar or competing services to the Complainant. The Complainant argues that the Respondent is unfairly disrupting the Complainant's business by redirecting consumers seeking BING auto, car or home tools to third party services.
- 5.8 The Complainant says that none of the factors which may be evidence that a domain name is not an abusive registration apply as set out below.
 - (a) The Complainant argues that the Respondent has not used or made demonstrable preparations to use the Domain Names in connection with goods or services. The Complainant says the sites at the Domain Names contain links to unrelated third parties which in some cases offer similar or competing services to those of the Complainant.

- (b) The Complainant asserts that the Respondent's name has no relation to BING and the Respondent is not commonly known by the name BING.
- (c) The Complainant states that the Respondent is not licensed by the Complainant to use the Complainant's trademarks and is not an authorised vendor, supplier, or distributor of the Complainant's goods and services.

The Respondent's response

- 5.9 The Respondent contends that there is no confusion to internet users because:
- (a) It has never used the Complainant's logos or content in the Domain Names. The Respondent says the Complainant wishes to monopolise the use of the Internet.
 - (b) It has never used the Complainant's logos or any content to tell users the Domain Names are for the Complainant. The 'who is' information for the Domain Names, which any user can check, has the Respondent's details.
 - (c) The Domain Names are completely different words to BING. Users who reach these Domain Names will type them into their browser address bar.
 - (d) BING is used by the Complainant for a search engine. The Domain Names are not being used to provide the same or a similar service to the Complainant's.
- 5.10 Before it registered the Domain Names, the Respondent says it looked on the internet for the meaning of the word 'bing, that it has different meanings worldwide in different languages and is also a name for babies.
- 5.11 The Respondent says that if the Complainant had an interest in the Domain Names it should have bought them when they were available.
- 5.12 The Respondent says that the Domain Names themselves show that they are for a different business rather than for the Complainant's search engine. The Respondent states that it has never used words which would lead customers or show them the Domain Names provide the Complainant's services or similar services or offer cheaper products than the Complainant's and there is no link at all to the Complainant's business.
- 5.13 The Respondent says that whilst it respects the Complainants trade marks for BING, the Domain Names are different words to the trade mark with eight characters rather than four.
- 5.14 The Respondent states that it bought the Domain Names when they were available for registration and that it would be harmful to lose them. The Respondent also states that if the Domain Names were not available for sale then they should not have been sold to it.

6 Discussions and Findings

- 6.1 Paragraph 2 of the Nominet Dispute Resolution Policy ("the Policy") sets out that for a Complainant's complaint to succeed it must prove to the Expert 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.
- 6.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities. In this respect, the Complainant has drawn my attention to NAF decisions involving the Respondent and has sought to rely on the

comments and findings of the Panellist in those decisions. However, those decisions are not binding on me and I have not seen the evidence that was submitted by the parties in those proceedings. Accordingly, in making this decision, I will have regard to whether the Complainant has proved to me the required elements on the balance of probabilities taking into account the complaint and supporting annexes and the response.

The Complainant's Rights

- 6.3 Under Paragraph 1 of the Policy, Rights is defined as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.” It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.
- 6.4 In this case, the Complainant has established that it owns worldwide trade marks for BING. On that basis I am satisfied that the Complainant owns Rights in the mark BING.
- 6.5 The Complainant has submitted much evidence in relation to the launch of the BING service. One press report suggests that the launch was supported by an \$80 to \$100 million advertising campaign. Certainly, the launch attracted worldwide publicity, with the Complainant having submitted a range of press articles from around the world. The press articles indicate that BING was launched to rival other search engines such as Google and Yahoo, with a view to competing with them and capturing market share. Indeed a press report in the Telegraph in November 2009 compared the year’s top searches on Google and Bing. I find on the basis of the worldwide launch of the BING services supported by a substantial advertising campaign and of BING being a comparator search engine to Google that the Complainant also has unregistered Rights through use in the mark BING.
- 6.6 I regard the mark BING to be similar to the Domain Names (disregarding the .co.uk suffix). In this respect, the Domain Names all have the common element ‘bing’. In my view, the addition of ‘auto’, ‘car’, ‘cars’, ‘home’ and ‘homes’ does not make any significant difference and does not distinguish the Domain Names from the mark BING. These terms are all descriptive of parts of the Complainant’s business in relation to searches and information on cars and homes.
- 6.7 I therefore find that the Complainant has Rights in a name or mark, BING, which is similar to the Domain Names.

Abusive Registration

- 6.8 It now has to be considered whether the Domain Names, in the hands of the Respondent, are 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.9 It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.

Abusive Registration under Paragraph 1(i) of the Policy

- 6.10 Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Names are an Abusive Registration under Paragraph 1(i) of the Policy as follows:
- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Names primarily:
 - A. for the purposes of selling, renting or otherwise transferring the Domain Names 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 Names;
 - 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.
- 6.11 In its complaint the Complainant relies on all of the circumstances set out in paragraph 3(a)(i) of the Policy in support of the Domain Names being an Abusive Registration. This paragraph of the Policy relates to the Respondent's motives at the time of registration of the Domain Names. Accordingly, it must be established, for there to be an Abusive Registration under paragraph 1(i) of the Policy, that the Respondent had knowledge of the Complainant and/or its Rights at the time of registration of the Domain Names.
- 6.12 The domain names bingauto.co.uk, binghome.co.uk and binghomes.co.uk were registered on 1 June 2010. The domain names bingcar.co.uk and bingcars.co.uk were registered on 12 May 2011. I will therefore consider the Respondent's knowledge of the Complainant and/or its Rights at the earliest date, 1 June 2010.
- 6.13 As set out at paragraph 6.5 above, the Complainant has adduced evidence of the large scale launch of the BING services which was widely publicised, including in the United Kingdom where the Respondent is based. A localised UK version of the BING services was launched in November 2009. Accordingly, I consider there is substantial evidence to suggest that the Respondent was aware of the BING services by 1 June 2010. I consider it noteworthy that the Respondent has not provided any explanation as to why it registered the Domain Names. Instead the Respondent says that before registering the Domain Names it looked on the Internet for the meaning of 'bing'. I consider that such a search would have revealed the Complainant's BING services. Accordingly, I find that the Respondent was aware of the Complainant when it registered the Domain Names.
- 6.14 The Complainant contends that the Respondent registered the Domain Names for the purposes of selling, renting or otherwise transferring the Domain Names 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 Names. The Complainant relies on the NAF cases where bad faith was established, in part, through the Respondent's offers to sell the domain names in issue in those cases for more than the Respondent's documented costs. The Complainant also relies on the Respondent's offer to sell the Domain Names for \$1300. For the reasons set out at paragraph 6.2 I shall not take into account the NAF cases. In relation to the Respondent's offer to sell the Domain Names for \$1300 this was made after the NAF decisions against the Respondent and when the Respondent was no doubt

anticipating action by the Complainant to recover the Domain Names. In these circumstances I regard the Respondent's offer to sell the Domain Names at this time as an attempt to realise some value from the Domain Names rather than risk losing them in an action by the Complainant. In my view the Respondent's offer to sell the Domain Names at this time does not mean that the Respondent's primary purpose when it registered the Domain Names was to sell, rent or otherwise transfer the Domain Names to the Complainant for in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Names.

- 6.15 However, there may be an Abusive Registration under paragraph 1(i) of the Policy if the Respondent registered the Domain Names for the purpose of unfairly disrupting the business of the Complainant by attracting users to the Respondent's sites who were looking for the Complainant and once there potentially diverting users to third party sites in respect of which the Respondent earns click through revenue.
- 6.16 The Complainant provides its search engine and information services under BING. Further, the Complainant has shown that it provides search and information services relating to cars with the results displayed on a page headed 'bing Autos'. Accordingly I consider that there is a real risk that Internet users guessing the URL of the Complainant's services relating to cars will use bingauto.co.uk, bingcar.co.uk and bingcars.co.uk. I also expect 'bing auto', 'bing car' and 'bing cars' to be common search terms in other search engines to reach the Complainant's services on cars. Similarly, I consider that there is a real risk that Internet users guessing the URL of the Complainant's services relating to homes or trying to reach the Complainant's home page will use binghome.co.uk or binghomes.co.uk. I also expect 'bing home' and 'bing homes' to be common search terms in other search engines to reach the Complainant's services on homes or to reach the Complainant's home page. Accordingly, I consider there is a real risk of users visiting the Respondent's sites when they are looking for the Complainant.
- 6.17 The Complainant's evidence establishes that on 6 March 2012 the Respondent's sites at the Domain Names contained links to third party websites, including for services which are similar or competitive to those of the Complainant. These links are generated by Sedo's domain name parking service with the Respondent earning click through revenue on them. The Respondent has not suggested that the Domain Names have been used in any other way but to resolve to pages containing links to third party sites. Accordingly, there is a risk that users who find the Respondent's sites when looking for the Complainant will be diverted to such third party sites and the Respondent will thereby earn click through revenue.
- 6.18 Paragraph 4e of the Policy states that the sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy but that the Expert will take into account the nature of the domain name, the nature of any advertising links on any parking page associated with the domain name and that the use of the domain name is ultimately the Respondent's responsibility. In this case the Respondent knew of the Complainant when it registered the Domain Names; the Domain Names are clearly associated with the Complainant's services; the Respondent has provided no explanation for registering the Domain Names and in my view the Respondent had no legitimate reason for registering the Domain Names; some of the links at the Domain Names are for similar or competing services to those of the Complainant; and the Respondent is seeking to take advantage of those Internet users looking for the Complainant to earn click through revenue. In such circumstances I regard the registration and use of the Domain Names to be objectionable under the Policy.

6.19 In my view, the Respondent registered the Domain Names, with knowledge of the Complainant, for the purpose of unfairly disrupting the business of the Complainant by unfairly taking advantage of the likely confusion of Internet users to divert traffic to third party services to earn click through revenue. I therefore find that the Domain Names, in the hands of the Respondent, are an Abusive Registration under paragraph 1(i) of the Policy.

Abusive Registration under Paragraph 1(ii) of the Policy

6.20 I also find that the Domain Names, in the hands of the Respondent, are an Abusive Registration under paragraph 1(ii) of the Policy. Paragraph 3(a)(ii) of the Policy sets out one of the factors which may be evidence that the Domain Names are an Abusive Registration, namely circumstances indicating that the Respondent is using or threatening to use the Domain Names in a way which has confused or is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by or otherwise connected with the Complainant. As I have set out at paragraph 6.16 above I consider that there is a likelihood of Internet users being initially confused into visiting the Respondent's websites in the expectation of finding the Complainant and of potentially being diverted to third party websites in respect of which the Respondent earns click through revenue. Even if users appreciate that they have not found the Complainant when they reach the Respondent's sites, the Respondent has still used the Domain Names in a way to cause initial interest confusion that the Domain Names are registered to, operated or authorised by or otherwise connected with the Complainant. I therefore find that the Domain Names, in the hands of the Respondent, are an Abusive Registration under paragraph 1(ii) of the Policy.

7 Decision

7.1 I find that the Complainant has Rights in a name or mark which is similar to the Domain Names.

7.2 For the reasons set out above I find that the Domain Names, in the hands of the Respondent, are an Abusive Registration.

7.3 I direct that the Domain Names be transferred to the Complainant.

Dr Patricia Jones

23 May 2012