

DISPUTE RESOLUTION SERVICE

D00012339

Decision of Independent Expert

Brightside Group plc

and

Peter A Riding

1. The Parties

Complainant: Brightside Group plc
MMT Centre
Severn Bridge
Aust
Bristol
BS35 4BL
United Kingdom

Respondent: Peter A Riding
30 Castle Street
Saffron Walden
Essex
CB10 1BJ
United Kingdom

2. The Domain Name

ecar.co.uk ('the Domain Name')

3. Procedural History

Nominet checked that the complaint dated and received on 11 January 2013 complied with its UK Dispute Resolution Service ('DRS') Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint, inviting him to file a response. That response was received on 31 January. Nominet forwarded the response to the Complainant the same day, inviting it to reply by 7 February. No reply was received. When informal mediation failed to resolve the dispute, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. That fee was received on 14 March.

On 15 March 2013 I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

4. Factual Background

The small amount of material before me consists, simply, of

- a short complaint, supported by evidence of UK and EU trademark registrations and by a screenshot of the web page to which the Domain Name resolved at 19 December 2012
- a shorter response, with no supporting evidence.

There is no reply.

I have visited the web page at the Domain Name and the Complainant's website at ecarinsurance.co.uk. From the complaint, the response, those visits and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant is a UK-based insurance broking and financial services business. It was incorporated in September 2006 and began trading that year. It established the first website allowing people both to get an insurance quote and to buy the policy online. The company was listed on the Alternative Investment Market in January 2007. In 2011 the group as a whole sold some 440,000 insurance policies, generating turnover of around £80m.

The Complainant has a UK trademark registration, dated September 2007, for 'e car insurance' – as well as for other 'e...insurance' marks (including 'e bike insurance', 'e van insurance' and 'e travel insurance') and a distinctive series of logos. The logos comprise a large, yellow, lower case 'e' with the particular kind of insurance (car, bike, van, travel etc) in smaller, white, lower case letters next to it and, under that particular reference, the word 'insurance' in small, white capitals – all on a blue background.

The Complainant also has an equivalent EU trademark registration, dated July 2007, for 'e car insurance'.

The Complainant has used the domain name ecarinsurance.co.uk since it started trading. The text on the web page to which that domain name resolves begins:

Welcome to eCar

eCar is an online car insurance solution that lets you manage your car insurance - 24 hours a day, 7 days a week.

The Complainant refers to having advertised 'eCar insurance' and the domain name ecarinsurance.co.uk in a variety of online and offline publications, including Google AdWords, Auto Trader and a range of insurance aggregator websites, since 2006.

The Respondent is an individual. He registered the Domain Name on 23 February 1999. There is no information before me on whether the Domain Name was used at all initially and, if so, for what. But in recent years, by agreement between the Complainant and the Respondent, it has been used to promote the Complainant's insurance business, by banner adverts on the web page at the Domain Name, incorporating links to the Complainant's website. The Complainant paid the Respondent commission for 'click-through' referrals. Over the last four years for which they were paid, starting with the earliest year, referral fees amounted to £83,000, £39,000, £28,000 and £21,000.

That agreement between the Respondent and the Complainant evidently came to an end towards the end of 2012. In October of that year, the Respondent decided to sell the Domain Name and the Complainant considered buying it. It is not clear who approached whom (the Respondent says the Complainant approached him; the Complainant says that it was approached) but, in any event, a price could not be agreed. Shortly afterwards, text on the web page at ecar.co.uk indicated that the Domain Name was for sale, and banner advertisements appeared on the same page, with links to AA Insurance – one of the Complainant's competitors.

The Respondent says that, since the complaint has been made, he has removed any links from web pages at the Domain Name to car insurance related products.

At the time of writing the Domain Name resolves to a web page that says:

CAUTION
CLOSED
FOR
MAINTENANCE

eCar temporarily down, please check back shortly

The Complainant would like to go back to the original agreement for the redirection of web traffic from the Respondent to the Complainant, or to have the chance to buy the Domain Name for a 'reasonable' price, or for the Respondent to stop using the Domain Name for insurance-related products. In its complaint, it requests the transfer of the Domain Name.

The Respondent would like the Complainant to buy the Domain Name for market value, which he says would be a 'reasonable' outcome.

5. Parties' Contentions

Complaint

The Complainant says that it has rights in a name that is identical or similar to the Domain Name and that the Respondent's use of the Domain Name

- (1) is taking unfair advantage of rights it possesses in the 'eCar' brand
- (2) risks confusing people who might be drawn to the website thinking it is connected with the Complainant, only for that traffic to be diverted to one of the Complainant's competitors.

Response

The Respondent says he brought the referral arrangement to an end because he had reason to believe that he was not receiving the correct amount of commission - referrals having stayed constant but referral fees having dropped steadily over four years. He argues that this is not an abusive registration because

- (3) ecar.co.uk was registered over five years before the Complainant registered its ecarinsurance.co.uk domain name
- (4) while the Complainant has rights in the name 'ecarinsurance', it does not own the 'eCar' brand.

Reply

There has been no reply.

6. Discussion and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it has rights in respect of a name or mark which is identical or similar to the Domain Name; and that
- the Domain Name, in the hands of the Respondent, is an abusive registration.

Rights

The Complainant has been trading using the name 'ecarinsurance' for several years and appears to have been developing the 'e...insurance' brand over the same period. It has UK trademark registrations for 'ecarinsurance' and a range of other 'e...insurance' names. It also has an equivalent EU trademark registration for 'ecarinsurance'.

Business is significant: the group sold approaching half a million insurance policies in 2011, turning over £80m. There is no information before me on the how much of that £80m relates to insurance policies sold through the website at the Domain Name or directly at ecarinsurance.co.uk. But the Complainant has established registered rights in 'ecarinsurance' and it seems reasonable to conclude that it has also established unregistered rights in that name.

The Complainant does not claim registered rights in the name 'eCar' and, while the text on the web page at ecarinsurance.co.uk does make reference to 'eCar' as an 'online insurance solution', it is not clear that the Complainant has established material unregistered rights in the 'eCar' name either. That makes little difference on the question of whether the Complainant has established rights for the purposes of the first of the two tests that apply here, but, as will be seen under *Registration* below, it is more significant in connection with the second test.

Ignoring the .co.uk suffix as merely a generic feature of Nominet's registry, the Domain Name is identical to the first part of the name in which the Complainant clearly has rights. The presence of a second part of that name – the 'insurance' ending – does not seem to me to render the two names wholly different. I conclude that the Complainant has rights in respect of a name or mark which is at least similar to the Domain Name.

Registration

As defined by the Policy, an abusive registration is a domain name which:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is, or is not, an abusive registration. That list includes circumstances where

- people may be confused into believing that the Domain Name is connected with the Complainant - which may be an indication that the registration is abusive; and where
- the Domain Name is generic or descriptive and the Respondent is making fair use of it - which may be an indication that the registration is not abusive.

These are fundamentally the parties' contentions here. The Complainant's two arguments essentially constitute an assertion that the Domain Name is an abusive registration conflicting with its 'eCar' brand and a claim that confusion is a factor in establishing the character of the registration: people will be confused into thinking they are going to a website connected with the Complainant, only to be diverted to one of the Complainant's competitors.

The Respondent's arguments are that the Complainant does not have rights to an 'eCar' brand and that the Domain Name was registered several years before the Complainant began establishing rights in the 'ecarinsurance' name. Despite taking that position, the Respondent has committed, while the dispute is being settled, to not providing a link from a web page at the Domain Name to suppliers of insurance-related products – and in fact at the time of writing has arranged for a holding page at the website at the Domain Name.

I can review these arguments under three headings.

Complainant's rights in 'eCar' as a brand

The Complainant evidently has rights in 'ecarinsurance' and in 'e...insurance'. As discussed under *Rights* above, it is less clear that it has rights in 'eCar' alone. That name consists of two generic elements: 'e' and 'car'. 'e' is used in front of all kinds of internet offerings – denoting simply 'electronic' and frequently simply referring to something 'online'. 'Car' needs no further commentary.

The complaint refers to 'eCar insurance' having been advertised in a variety of online and offline media but, beyond the names of a handful of publications,

there is no detail of that before me. It is true there are some references to 'eCar' on the web page at the Complainant's website at ecarinsurance.co.uk, to which for several years the web page at the Domain Name provided a link. But they are sparse and appear on a web page that is headed 'eCar insurance'. I can of course only reach conclusions based on the evidence put to me and the complaint contains very little. I note, too, that the Complainant has not taken the opportunity, afforded by the reply stage of the complaint procedure, to address the Respondent's contention that it does not have rights – or at least does not have exclusive rights – to the name 'eCar'.

Given that limited factual background to the complaint, the generic potential of 'e' and 'car' as elements in a name and that there is no other evidence in support of the Complainant's position that it has rights in an eCar brand, I am not persuaded – on balance – that the name in which the Complainant has rights is identical to the Domain Name.

risk of confusion

I accept that, for a short period, internet users could have gone to the Domain Name expecting to find the Complainant and then been diverted elsewhere – not least because, for several years, that was one route to contacting the Complainant that was sanctioned by the Complainant. The potential for that appears to me to be low, however, given my conclusion that the Complainant has not established significant rights in an 'eCar' brand. It seems to me more likely that referral traffic was not looking for the Complainant in particular, but merely for something online and car-related.

Complainant's rights at time of Domain Name registration

The Respondent is right to point out that, when the Domain Name was registered, the Complainant had not begun building a business around its website at ecarinsurance.co.uk. Such situations have arisen before in cases within the DRS. The *Experts' Overview* acknowledges (paragraph 4.7) that it is possible for a respondent to make fair use of a domain name even where the name is also the complainant's trademark and the respondent's use of the domain name is causing confusion. The kind of situation the *Overview* envisages is where the respondent's registration of the domain name predates the complainant's rights and there is no change of use to take advantage of the complainant's rights.

Evidently, these are not quite the circumstances here. On the one hand, the Domain Name is not the Complainant's trademark and the potential for confusion appears low. On the other, there are two changes of use: one, taking advantage of the Complainant's rights but with the Complainant's agreement (so, almost by definition, not unfairly); and another, briefly, involving a redirection where the scope for taking unfair advantage of the Complainant's rights is arguably limited - either because the Domain Name is not identical to those rights, or because the redirection was only for a short period.

The precedents, which might be of persuasive value, are therefore of only limited use. The underlying question remains whether the Domain Name was registered or has been used in a manner which has taken unfair advantage of the Complainant's rights. In deciding that question, the essential facts seem to me to be that:

- the Domain Name is similar but not identical to the name in which the Complainant has rights
- the Domain Name consists of two generic elements: 'e' and 'car'
- the Domain Name was registered before the Complainant or its business existed
- for several years, the Domain Name was used with the Complainant's agreement – effectively in support of the Complainant's development and exploitation of its rights in the name 'ecarinsurance'
- there was then a brief period when the Domain Name was used without the Complainant's agreement – to point to a competitor.

The Respondent's registration of the Domain Name cannot have taken unfair advantage of the Complainant's rights because there were no rights at that point.

That leaves use of the Domain Name. As far as I can tell, there was no use initially. For much of the time up to the complaint, the Domain Name was used with the agreement of the Complainant, so that cannot have taken unfair advantage of the Complainant's rights. There was then some different use – linking to a competitor's website. The fact that the Domain Name consists of two generic elements is not conclusive here, because even generic names must be used fairly. Arguably, the redirection of traffic to an AA insurance site took unfair advantage of the Complainant's rights.

There are two possibilities in relation to that point. Either the Complainant's rights extend only as far as the name 'ecarinsurance', or they go further to embrace the name 'eCar' too. I have already explained that, on balance, given the limited evidence before me, I am not persuaded by that second possibility. As to the first, given that the Domain Name is not identical to the name in which the Complainant has rights, and there is no evidence of actual confusion, the extent of any unfairness is not clear. The Complainant makes no attempt to quantify any damage. In any event, this use of the Domain Name lasted only a short time and has now ceased.

In summary, the Domain Name was established before any rights existed. It is a generic name. A business then created some value in a similar name – indeed a name that partly incorporated the Domain Name. But the name in which it developed rights did not coincide precisely with the Domain Name. The Respondent has done little beyond co-operating with the Complainant in the establishing of its brand. The one exception, when the Respondent diverted internet traffic for a short time, is an example either of the Respondent's doing what he was entitled to do or of his taking short-term, unquantified advantage of the Complainant's rights. That seems to me to be either not unfair at all or at least not materially unfair – and certainly not clearly enough or sufficiently unfair to deprive the Respondent of a domain name comprising two such common, generic elements.

On balance, based on the limited information before me, I conclude that the Respondent has not taken unfair advantage of the Complainant's rights.

7. Decision

I find that the Complainant has rights in respect of a name which is similar to the Domain Name but that the Domain Name, in the hands of the Respondent, is not an abusive registration.

In the light of that, I direct that the domain name be left undisturbed.

Mark de Brunner

9 April 2013