



**NOMINET**

## **DISPUTE RESOLUTION SERVICE**

**D00018042**

### **Decision of Independent Expert**

**TTT Moneycorp Limited**

and

**Andrew Karim**

#### **1. The Parties:**

Lead Complainant: TTT Moneycorp Limited  
Floor 5, Zig Zag Building, 70 Victoria Street  
London  
SW1E 6SQ  
United Kingdom

Respondent: Andrew Karim  
58 Lower Range Road  
Gravesend  
DA12 2QL  
United Kingdom

#### **2. The Domain Name(s):**

www.moneycorp.co.uk

#### **3. Procedural History:**

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

The history of the proceedings to date is as follows:

06 October 2016 11:37 Dispute received  
06 October 2016 11:47 Complaint validated  
06 October 2016 12:32 Notification of complaint sent to parties  
25 October 2016 02:30 Response reminder sent

01 November 2016 10:39 No Response Received  
01 November 2016 10:40 Notification of no response sent to parties  
11 November 2016 01:30 Summary/full fee reminder sent  
16 November 2016 16:01 Dispute opened  
16 November 2016 16:02 Expert decision payment received

#### **4. Factual Background**

- 4.1 The Complainant has been trading under its current name since at least 13 April 1993. His gross profit in 2012 was £65.2million, growing to £97.2million in 2013 and £147million in 2014. He provides services in the financial services industry. He has three major types of services being Bureaux de Change, commercial foreign exchange and wholesale bank notes. He registered the domain moneycorp.com on 14 April 1998 which is his official website. He has had a web presence since 2000. Its website is available in many different languages to cater for its global customer base.
- 4.2 The Complainant has used and promoted its brand “Moneycorp” / “Money Corp” (‘the Brand’) worldwide since at least 1993. He has numerous registered trade marks for the Brand (and variations of it including the words “Moneycorp” and “Money Corp”), including in the EU, UK and US, with its earliest trade mark registrations being in 1998. These registered trade marks cover a variety of classes including class 36.
- 4.3 The Respondent has had an active website at the Domain Name since 2012 on which appears text adverts targeted based on the user’s search history. His website shows the words “For sale? Could be!”. There are no links on that part of the website but there is a contact form.
- 4.4 The Respondent has registered the Domain Name using the name Andrew Karim as Registrant. He has chosen to use Nominet’s privacy services, which are intended for non trading individuals who are permitted to have their address omitted from the Nominet WHOIS services. He holds a variety of other domain names including some of which are identical to well-known names and trade marks (or combinations of these) such as androidgoogle.co.uk, eurostar.co.uk, eurodisneydeals.co.uk, and virgineurostar.co.uk.

#### **5. Parties’ Contentions**

##### **The Complaint**

- 5.1 The Complainant relies on the above facts and the following assertions. Since 1979 it has made a niche space for itself in financial services, as it offers competitive pricing and products compared with Banks. It incorporated in 1962 and rebranded and changed its name to TTT Moneycorp Limited on 13 April 1993. It grew rapidly in 2013 with total business growth EBITDA (earnings before interest, taxes, depreciation and amortization) up 59% year on year. Its international payments business had a revenue of £31.3million in

2013 and there was significant growth of 48 per cent in online channel sales with its retail business growth being 58 per cent of its revenue. Its international payments business unit accounts for over 90 per cent of its income.

- 5.2 It has acquired common law rights in the Brand. It also produces a number of trade mark registration certificates at Annex 4 to the Complaint. It has used the Brand extensively and prominently, in respect of *inter alia* financial services, prior to the registration date of the Domain Name, and it was at that date (and continues to be) highly distinctive and famous as a brand that symbolises substantial goodwill.
- 5.3 The Complainant has a strong social media presence and is actively involved in writing about latest news and updates on its official website regarding the Financial Services industry. Some examples of these are produced at Annex 6 to the Complaint.
- 5.4 The Complainant asserts that it has Rights in regard to a name or mark which is identical to the Domain Name, being “Money Corp”. It relies on its use of the name “Money Corp” (since 1979) and acquired common law rights and registered trade mark rights. It asserts that the Domain Name is identical to its registered trade marks for “Money Corp”.
- 5.5 It claims that the only differences between its trade mark “Money Corp” and the Domain Name are the top level suffix “co.uk” and the prefix “www”. It asserts that the former would usually be disregarded under the confusing similarity test (as a technical requirement of registration), except in certain cases where the applicable top level suffix may itself form part of the relevant trade mark. It refers to the WIPO overview of the WIPO Panel Views on selected UDRP questions, (second edition – WIPO overview 2.0) to support this. It points out that in registering the Domain Name the Respondent has incorporated its trade mark “Money Corp” verbatim. Also most of its registered trade marks pre-date the date of the registration of the Domain Name.
- 5.6 The Complainant refers to the Nominet Dispute Resolution Service – Experts Overview Version 2 which states at paragraph 2.3 that *“For the purposes of the first hurdle, nothing turns on the distinction between “identical” and “similar”, but a name or mark will ordinarily be regarded as identical to the domain name if, at the third level, and ignoring the presence of hyphens and the absence of spaces and ampersands, they are the same. However, because nothing turns on the distinction, experts will usually not bother to draw a distinction and will merely find that the Complainant’s name or mark is “identical or similar to the domain name in issue”.*
- 5.7 The Claimant also refers to the VKR Holding A/S and Sardara Beins (DRS No. 06973) decision where the expert commented, *“the domain name – Veluxblind.co.uk consists of the Complainant’s distinctive trade mark and the trade mark and the descriptive word “blind” which does nothing to distinguish the domain name from the mark, since the mark is associated in the public mind with the complainant’s blinds...”*

- 5.8 In addition the Complainant argues that the letters “www” as a prefix to the words “moneycorp” fail to distinguish it from the Brand as the letters are an abbreviation for the worldwide web. The Complainant further asserts that the Respondent has intentionally used this prefix to take advantage of internet users where they will not insert a dot after the “www” and therefore drive traffic to the Respondent’s website. The letters “www” do not significantly change the identical parts of the Domain Name and in fact they play on the internet user’s unintentional typographical error.
- 5.9 The Complainant also asserts that the Domain Name is an Abusive Registration. It refers to Paragraph 5 of the DRS Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration and sets these out.
- 5.10 It refers to the Respondent’s registration of the Domain Name on 26 February 2007. This is nine years after the date of the Complainant’s website www.moneycorp.com (i.e. 14 April 1998) and approximately three decades after the Complainant started using the Brand. It states that the Domain Name is an active website which has targeted text advertising based on the user’s search history. This is demonstrated by screenshots at Annex 8 to the Complaint. The Respondent seems not to have any other content on its website other than the targeted adverts.
- 5.11 The Domain Name, whilst it has been registered since 26 February 2007, has only been active since 2012. The Complainant alleges that the Domain Name website has been used for the same purpose i.e. targeted advertising since 2012. It asserts that the Respondent has therefore registered the Domain Name only for the purposes of profiting commercially by driving traffic to its website through use of the Brand. It further asserts that the Respondent has registered the Domain Name to block the Complainant from registering the same one.
- 5.12 It considers that the Domain Name website at the home page on the right hand corner which states “For Sale? Could be!” clearly indicates that the Domain Name could be for sale. The Respondent has also made available a contact form on the website. Those 2 factors together suggest an invitation to users and visitors who are potentially interested to make an offer to purchase the Domain Name. The Complainant states that precedent and well established principles of domain name disputes have not settled whether “an indirect offer to sell” is within the ambit and scope of the Policy. However, it submits that such types of offers to sell must be treated the same as circumstances where a Domain Name has been directly and boldly offered for sale through various platforms.
- 5.13 The Complainant further submits that the Domain Name is misleading and has the potential of confusing the Complainant’s customers to believe that it might be operated by and connected to the Complainant. It states that commonly internet users will visit websites either by way of search engines or by guessing the relevant URL. It claims that the Domain Name cannot sensibly refer to anyone else as it is identical to the Brand. In those circumstances there is bound to be a severe risk that a search engine, which is being asked for the

Complainant, will produce high up on its list the URL for the website connected to the Domain Name.

- 5.14 Also an internet user in seeking the URL for the Complainant's website may well use the Domain Name for that purpose. In these cases the speculative visitor doing research for the complainant will visit the registrant's website in the hope and expectation that it is one "*operated or authorised by or otherwise connected with the Complainant.*" It states that this is what is known as "initial interest confusion". It refers to the overwhelming majority of Experts viewing it as a possible basis for a finding of Abusive Registration as the vice is that even if not immediately apparent to the website visitor the site is not in any way connected with the Complainant and so, the visitor has been deceived. It refers to the DRS Expert's Overview Version 2 to support this.
- 5.15 The Complainant asserts that it has a huge customer base worldwide and its website plays a significant role in its business growth. All of its outlets are branded as "Money Corp". It produces some pictures accessed from the internet of its outlets at Annex 10. It also produces news articles at Annex 11 which demonstrate that it is reported on in the news media.
- 5.16 It states that it is well-known for its services and reputation in the Financial Services industry and has been using the Brand since 1979 and registered it as a trade mark as early as 1999. It asserts that the Respondent had knowledge and noticed the success of the "Money Corp" brand before registering the Domain Name. Indeed it claims that the Respondent registered the Domain Name because of the Complainant's worldwide reputation and goodwill. It claims that its trade mark is a word put together by the Complainant and is not generic or descriptive. Its use of the Brand has made it famous and well known.
- 5.17 To its knowledge the Respondent has made no demonstrable preparations for use of the Domain Name as a business or trade. Also to the best of its knowledge the Respondent is not known by a name consisting in whole or in part of the Brand. The Respondent is not an agent or licensee of the Complainant.
- 5.18 The Complainant submits that the Respondent has registered using the name Andrew Karim and relies on a Whois search of the Nominet database which is produced as Annex 12. It has done a search for the named Respondent which revealed its Domain Name Portfolio which it produced at Annex 13. Whilst the Respondent chose to use privacy services for the Domain Name, the Complainant was able through the other TLD domains and the Respondent's profile to find the Respondent's contact details for the purposes of this Complaint. As above it refers to the Respondent holding a varied domain portfolio many of which are identical to well-known names and trade marks. It lists some of these and asserts that this demonstrates a pattern of registering well-known names and famous brands/trade marks by the Respondent. It produces screenshots of some of these domain names at Annex 14. It requests that the Domain Name should be transferred.

## **The Response**

- 5.19 The Respondent has not filed a Response. The Complainant has paid for a full decision.

## 6. Discussions and Findings

### Rights

- 6.1. Paragraph 2 of the Nominet Dispute Resolution Service Policy (“the Policy”) sets out that:
- “2.1 *A Respondent must submit to proceedings under the DRS if a Complainant asserts to [Nominet], according to the Policy, that:*
- 2.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- 2.1.2 *The Domain Name in the hands of the Respondent is an Abusive Registration.*
- 2.2 *The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*
- 6.2 In the absence of any Response from the Respondent, under paragraph 24.8 of the Policy, since there are no exceptional circumstances here to justify this lack of Response the Expert is entitled to draw such inferences from this as she considers appropriate.
- 6.3 Rights are defined in the Policy at Paragraph 1 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*”. This definition includes UK and EU Trade Mark registrations and unregistered rights such as goodwill upon which to found a passing off action.
- 6.4 The Complainant has numerous registered trade marks around the world for the Brand. Most of these were registered before the Respondent registered and used the Domain Name. The Complainant has stated that it has also used the Brand extensively since 1972 and has a significant annual turnover and profit. It uses the Brand in global trading particularly in the financial sector and evidences this in various Annexes to the Complaint, including Annexes 2, 3, 5, 6, 10 and 11.
- 6.5 The Complainant clearly sets its contentions in its Complaint as regards its use of the Brand, which are unchallenged. The Expert accepts the Complainant’s assertion that the Brand is well known at least for its services in the financial services sector. In view of this and the available extensive evidence of prior use of it by the Complainant the Expert considers that the Complainant has established common law rights in the Brand. It also has many registered trade mark rights in it around the world as referred to above.

6.6 The additional features of the Domain Name are only the suffix and prefix, being “.co.uk” and “www” respectively. The Expert refers to the Nominet Dispute Resolution Service – Expert’s Overview version 2 at paragraph 2.3, which is also relied upon by the Complainant as narrated above. The Expert is required to ignore the “.co.uk” suffix. As regards the “www” prefix, this is simply the acronym for the worldwide web and is an extremely common prefix for a domain name, albeit with a full stop in between. As such it is not a distinguishing feature of a domain name. Accordingly in the Expert’s view, the Domain Name is identical or similar to the Brand (disregarding the “.co.uk” suffix and the “www” prefix). The Expert thus finds without any doubt that the Complainant has Rights in the Brand which is identical or similar to the Domain Name.

### **Abusive Registration**

6.7 The Expert is then required to consider whether the Domain Name in the hands of the Respondent is an Abusive Registration.

6.8 The Policy defines an 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) *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.”*

6.7 Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration.

6.9 Paragraph 5.1 of the Policy states as follows:

5.1 *“A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*

5.1.1 *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

5.1.1.1 *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out of pocket costs directly associated with acquiring or using the Domain Name;*

5.1.1.2 *as a blocking registration against a name and mark in which the Complainant has Rights; or*

*5.1.1.3 for the purposes of unfairly disrupting the business of the Complainant;*

*5.1.2 Circumstances indicating that the Respondent is using or threatened 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;*

*5.1.3 The Complainant can demonstrate 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 trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*

*5.1.4 It is independently verified that the Respondent has given false contact details to us;*

*5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:*

*5.1.5.1 has been using the Domain Name registration exclusively; and*

*5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;*

*5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."*

6.10 The Expert accepts, given the Complainant's unchallenged assertions of its considerable use over a long period of time (prior to the registration of the Domain Name) and the evidence by way of Annexes to the Complaint that the Brand is well-known as denoting it and its services. In addition, the Brand is not directly descriptive of the Complainant's business and services.

6.11 Furthermore the rest of the Respondent's domain name portfolio and its nature makes such prior knowledge even more likely as it seems that it is well used to registering domain names for well-known brands. Thus it seems highly likely to the Expert that the Respondent registered the Domain Name with full prior knowledge of the Brand.

6.12 Indeed in the absence of any explanation to the contrary from the Respondent it seems almost self-evident that the only reason that the Respondent registered the Domain Name was to take advantage of customers trying to



reach the Complainant's website and mistyping the address. Thus the Expert considers that this amounts to taking unfair advantage of the Complainant's Rights by registration. This satisfies the test of an Abusive Registration under the first limb of the Policy definition.

- 6.13 Although the Expert does not need to go further in view of this conclusion she will also consider whether the requirements of the second limb of the Policy definition of an Abusive Registration are met.
- 6.15 The Respondent is using the Domain Name as an active website which uses targeted advertising and has done so since 2012 some nine years after the Complainant launched its website under the Brand. Based on the Complainant's unchallenged assertions this was also some three decades after the Complainant started using the Brand and at a time when the Brand was very well known. It is the Expert's view on the balance of probabilities that in these circumstances the Respondent has registered the Domain Name for *inter alia* the purposes of profiting from its use as a result of the commercial gains. He will make these through advertising revenue from payments by internet users who mistakenly type in www.moneycorp.co.uk and land at the Respondent's site as opposed to that of the Complainant. In the Expert's view this is taking unfair advantage of the Complainant's Rights by generating earnings from its unauthorised use of these.
- 6.16 Also the Expert considers that the use that the Respondent is making of the Domain Name is such that confusion or at least initial interest confusion is likely in terms of paragraph 3.3 of the Nominet Experts Overview.
- 6.17 Lastly, the Expert also finds that the requirements of sub-paragraphs 5.1.3 and 5.1.6 of the Policy (set out above) are met.
- 6.18 Accordingly in all the circumstances the Expert finds on the balance of probabilities that the Domain Name has both been registered and been used in a manner which has taken unfair advantage and has been unfairly detrimental to the Complainant's Rights and is an Abusive Registration in accordance with both limbs of its Policy definition. Accordingly the Expert finds that the Domain Name is an Abusive Registration.

## 7. Decision

- 7.1 Having found that the Complainant has Rights in respect of a 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 the Expert orders that the Domain Name is transferred to the Complainant.

Signed .....

Dated 19/12/2016

UNSIGNED  
GILL GRASSIE

