

DISPUTE RESOLUTION SERVICE

D00018407

Decision of Independent Expert

Remitly U.K., Ltd.

and

Hofer Jan

1. The Parties

Complainant: Remitly U.K., Ltd.
Ten Bishops Square, Eighth Floor
London
E1 6EG
United Kingdom

Respondent: Hofer Jan
Arcisstrasse 21
München
Bayern
80333
Germany

2. The Domain Name

remitly.co.uk

3. Procedural History

- 3.1 I have confirmed to Nominet 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.
- 3.2 On 18 January 2017 the complaint was received. On 19 January 2017 the complaint was validated and notification of it sent to the parties. On 7 February 2017 a response reminder was sent to the Respondent. On 10 February 2017 a notification of no response was sent to the parties. On 20 February 2017 the Expert decision payment was received from the Complainant.
- 3.3 The Respondent has not filed a response. I am satisfied that the complaint was served upon the Respondent in accordance with paragraphs 3 and 6 of the Nominet Dispute Resolution Service Policy (“the Policy”).

- 3.4 The named complainant is Remitly U.K., Ltd. However, the complaint states it is brought by Remitly, Inc. which forms part of a group of companies trading under the Remitly name. The other group companies are said to be Remitly U.K., Ltd. and Remitly Canada, Inc. This is supported by an exhibited group organisation chart. I have therefore made this decision on the basis that Remitly, Inc. is the Complainant and references to the Complainant in my decision are to this company.

4. Factual Background

- 4.1 The Complainant is a US corporation incorporated on 13 October 2011. It changed its name from Beमित, Inc. to Remitly, Inc. on 13 December 2012. It provides an online and mobile payment service that enables consumers resident in the US, Canada or the UK to make international money transfers. The Complainant's web site is at remitly.com. It registered this domain name on 9 March 2012 and has used it since April 2012.
- 4.2 The Complainant is the owner of registered trade marks including:
- (a) International registration number 1283040 for REMITLY protected in the EU registered on 6 October 2015 in classes 9, 36 and 42.
 - (b) US trade mark no 4,293,444 for REMITLY registered on 19 February 2013 in class 36.
- 4.3 The Domain Name was registered on 8 January 2013. It resolves to a parking page with links relating to money transfers and "Buy this domain" at the top of the page.

5. Parties' Contentions

The Complainant's complaint

- 5.1 The Complainant submits that it has Rights in the REMITLY mark which it says is identical to the Domain Name:
- (a) The Complainant relies on its registered trade marks as set out at paragraph 4.2 above.
 - (b) The Complainant also relies on its ownership of remitly.com prior to registration of the Domain Name. It says that, according to web site analysis tools, remitly.com attracts an average of over 40,000 visitors per day and had over 1 million visitors in the past 30 days. It also says that from 16 November 2015 to 15 December 2016 its web site attracted over 15,000 visitors directly from the UK. The Complainant states its web site is used to conduct thousands of transactions per day and has hundreds of thousands of active members/subscribers making transactions on a regular basis.
 - (c) The Complainant asserts it has common law rights and a global reputation in the REMITLY mark which is highly recognised and well-known. It claims substantial goodwill has been built up in the REMITLY mark through extensive advertising, marketing, promotion and investment by the Remitly group of companies.
 - (i) The Complainant says it has carried out extensive advertising using the REMITLY mark in media, including television and online marketing and that it has invested millions of dollars in TV advertising and digital marketing.
 - (ii) The Complainant presented at the Money 20/20 conference in Copenhagen in April 2016 and the Brexit & Global Expansion Summit in October 2016.
 - (iii) The Complainant says it has had extensive UK and EU press coverage and has exhibited articles in support.

- (iv) The Complainant was a finalist in the Innovation in Money Transfer category of the Fintech Innovation Awards and its CEO won EY Entrepreneur of the Year 2016 Pacific Northwest.
 - (d) The Complainant says the Respondent has no rights in the REMITLY mark; that he has not used this mark for a bona fide offering of goods or services; and the Remitly group companies have not consented, licensed or authorised him to use the REMITLY mark.
- 5.2 The Complainant contends the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- (a) The Complainant says it is no co-incidence that the Domain Name was registered 6 days after a press release announcing the Complainant had raised a \$2.6 million investment.
 - (b) The Complainant submits that the Domain Name was registered and is being used to take advantage of the Complainant's Rights. The Complainant says its business is being damaged by the adverts at the Domain Name promoting rival remittance services; that the Domain Name is being used to divert business away from it; and the Respondent is benefitting from the advertising revenue generated from the competing links.
 - (c) The Complainant relies on paragraph 5.1.6 of the Policy. It says the Domain Name is an exact match of the REMITLY mark and that when the Domain Name was registered the Remitly Group was a successful and well-known venture backed company and the Complainant had significant rights in the REMITLY mark of which the Respondent was aware. The Complainant contends that at the time of registration of the Domain Name the Respondent had no rights in the REMITLY mark and since registration he has made no legitimate use of the Domain Name.
 - (d) The Complainant relies on paragraph 5.1.1 of the Policy:
 - (i) The Complainant says the Domain Name was registered with the intention of selling or renting it to the Complainant, at some point in the future, or a competitor for more than the Respondent paid for it. It states the Respondent's use of the Domain Name shows that a traditional model for providing goods/services was not the intention behind registration of the Domain Name.
 - (ii) The Complainant says the Domain Name was registered with the purpose of stopping the Complainant using it or disrupting the Complainant's business. The Complainant states it has experienced business disruption as its customers are confused by the Domain Name which advertises competing money transfer services.
 - (iii) The Complainant submits that the timing of the Domain Name registration soon after its press release on investment shows that the Domain Name was acquired as part of a speculation by the Respondent to attempt to sell it at a later date or alternatively to disrupt the Complainant's business.
 - (e) The Complainant relies on paragraph 5.1.3 of the Policy. The Complainant says 21 domain names have been registered by the Respondent; that he is engaged in a pattern of registrations in which he has no apparent rights; and the Domain Name is part of that pattern.
 - (f) The Complainant submits that the Domain Name has been and is being used in a manner which takes unfair advantage of the Complainant's Rights and that if the

Domain Name remains in the Respondent's hands this will lead to further abuse of the Complainant's Rights.

The Respondent's response

5.3 The Respondent has not submitted a Response.

6. Discussions and Findings

6.1 Paragraph 2.2 of the Policy sets out that the Complainant is required to prove to the Expert that both of the following elements are present on the balance of probabilities:

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.*

6.2 In this case the Respondent has not submitted a response. Nevertheless the Complainant is still required to prove to the Expert that both the above elements are present on the balance of probabilities.

The Complainant's Rights

6.3 Under Paragraph 1 of the Policy, 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.*" 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 I am satisfied on the basis of the Complainant's registered trade marks set out at paragraph 4.2 that the Complainant has Rights in the REMITLY mark. I consider the REMITLY mark to be identical to the Domain Name (disregarding the .co.uk suffix which it is usual to ignore when making the comparison).

6.5 Accordingly, I find that the Complainant has Rights in the name or mark REMITLY which is identical to the Domain Name.

Abusive Registration

6.6 Under Paragraph 1 of the Policy Abusive Registration means 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.*

It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.

6.7 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration are set out at paragraph 5 of the Policy including:

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 or mark in which the Complainant has Rights; or*

5.1.1.3 *for the purpose of unfairly disrupting the business of the Complainant.*

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

5.1.3 *The Complainant can demonstrate that the Respondent is engaged in a pattern of registration 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 Name is part of that pattern;*

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.*

6.8 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration are set out at paragraph 8 of the Policy including:

8.5 *Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:*

8.5.1 *the nature of the Domain Name;*

8.5.2 *the nature of the advertising links on any parking page associated with the Domain Name; and*

8.5.3 *that the use of the Domain Name is ultimately the Respondent's responsibility.*

6.9 Paragraph 5.1.1 relates to the Respondent's motives at the time of registration of the Domain Name. For there to be an Abusive Registration under paragraph 1.i. of the Policy it must be established that the Respondent had knowledge of the Complainant and/or its Rights at the time of registration of the Domain Name.

6.10 In this case the Complainant had relatively recently changed its corporate name, had filed its US trade mark registration (which gives the first use and in commerce as April 2012) and was using remitly.com when the Domain Name was registered. The Complainant says it was successful and well-known and had significant rights in the REMITLY mark at this time. However, the only evidence the Complainant has adduced on the extent of its business at this time is a press release dated 2 January 2013. This describes the Complainant as "the emerging online money transfer service that allows immigrants in the U.S. to send money home....." and announces its expansion into 16 states as a licensed money transmitter. The release states the Complainant has closed \$2.6 million in capital; it was in the 2011 Seattle TechStars incubator program; in early 2012 it received \$2.5 million in financing; its online remittance service is currently available in 16 states with several applications pending approval; the product is

currently focused on customers sending money from the USA to the Philippines; it will use the new capital to lay the foundation for global expansion; and that according to the World Bank over \$350 billion is transferred from developed to developing countries each year.

- 6.11 The Respondent is based in Germany. On first consideration it is not immediately apparent how the Respondent would have become aware of the Complainant by 8 January 2013 given the Complainant was at this time an emerging money transfer service operating in the US making money transfers to the Philippines. However, I consider it significant that the Domain Name was registered only 6 days after this press release which refers to the Complainant's plans for global expansion in a potentially large market. This suggests the press release prompted the Respondent to register the Domain Name. The Respondent has not responded to the complaint. He has therefore not given any explanation why he registered the Domain Name. In such circumstances, I consider the Complainant has established, on the balance of probabilities, that the Respondent was aware of the Complainant and/or its Rights at the time of the Domain Name registration.
- 6.12 The Complainant relies on paragraphs 5.1.1.1 and 5.1.1.2 of the Policy. However, I do not consider that the Respondent registered the Domain Name primarily for the purposes set out in these paragraphs. Whilst the Respondent indicates on his site at the Domain Name a willingness to sell the Domain Name I do not consider this establishes that the Domain Name was registered primarily for the purpose of selling it 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.
- 6.13 The Complainant also relies on paragraph 5.1.1.3 of the Policy. The Complainant uses the REMITLY mark and remitly.com for its business. Accordingly, I consider there is a real risk that Internet users, particularly those based in the UK, guessing the Complainant's URL will use the Domain Name and thereby visit the Respondent's site. I also consider there is a real risk that Internet users will visit the Respondent's site in response to a search engine request looking for the Complainant. The Complainant's evidence shows that the Domain Name has been used for a parking site containing links to competing money transfer services. There is therefore a risk that users who find the Respondent's site when looking for the Complainant will be diverted to these third party sites earning the Respondent click through revenue.
- 6.14 In my view, the Respondent registered the Domain Name, 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 the Respondent click through revenue. This is evidence that the Domain Name is an Abusive Registration under paragraph 1.i. of the Policy.
- 6.15 The Complainant also relies on paragraph 5.1.2 of the Policy. As set out above I consider there is a likelihood of Internet users being initially confused into visiting the Respondent's web site in the expectation of finding the Complainant and of potentially being diverted to third party web sites 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 site, he has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant. This is evidence that the Domain Name is an Abusive Registration under paragraph 1.ii. of the Policy.

- 6.16 The Complainant relies on paragraph 5.1.3 of the Policy. However, the Complainant has not identified the other domain names owned by the Respondent (the exhibited Reverse WHOIS search only shows some of the characters of each domain name) and there is no evidence that these correspond to well known names or trademarks in which the Respondent has no apparent rights.
- 6.17 The Complainant also relies on paragraph 5.1.6 of the Policy. I consider the Domain Name is an exact match for the REMITLY mark in which the Complainant has Rights and the Respondent has no reasonable justification for having registered the Domain Name. The Complainant has to establish the REMITLY mark has a reputation. My view is that this needs to be established at the time of registration of the Domain Name given that this paragraph of the Policy is concerned with the Respondent's reasonable justification or not for registration. In this case I do not consider the Complainant has established a reputation in the REMITLY mark at the time of the Domain Name registration. The press release alone, without any further evidence of the extent of the Complainant's business at this time (such as turnover), is, in my view, insufficient to evidence such reputation.
- 6.18 As set out I have found paragraphs 5.1.1.3 and 5.1.2 of the Policy to be established. However, before I make a finding of an Abusive Registration I must bear in mind paragraph 8.5 of the Policy. In this case there is a disclaimer at the bottom of the web page which states the displayed sponsored listings are "served automatically by a third party"; that neither the service provider or the domain owner maintain any relationship with the advertisers; and in case of trademark issues to contact the domain owner directly. I consider it unlikely this disclaimer would be noticed by an Internet user. Further, as is made clear in paragraph 8.5.3, even if the advertising links are generated automatically the use of the Domain Name is ultimately the Respondent's responsibility. In this case I have found that the Respondent knew of the Complainant when he registered the Domain Name; he has not provided any explanation for registering the Domain Name; the Domain Name is identical to the Complainant's REMITLY mark; the advertising links are for competing or similar 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 Name to be objectionable under the Policy.
- 6.19 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraphs 1.i. and 1.ii. of the Policy.

7 Decision

- 7.1 I find that the Complainant has Rights in a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I direct that the Domain Name be transferred to the Complainant, Remitly, Inc.

Patricia Jones

Dated 8 March 2017