

## **DISPUTE RESOLUTION SERVICE**

**D00020802**

### **Decision of Independent Expert**

Payoneer Inc.

and

QUINV SA

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

Complainant: Payoneer Inc.  
150 West 30th Street  
New York  
10001  
United States

Respondent: QUINV SA  
6 rue Henri M. Schnadt  
Luxembourg  
LU  
L-2530  
Luxembourg

#### **2. The Domain Name:**

payoneer.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.

09 November 2018 14:53 Dispute received  
09 November 2018 15:06 Complaint validated  
09 November 2018 15:10 Notification of complaint sent to parties  
28 November 2018 01:30 Response reminder sent  
03 December 2018 10:21 No Response Received  
03 December 2018 10:21 Notification of no response sent to parties  
04 December 2018 09:47 Expert decision payment received

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

I have taken the following summary from the contents of the Complaint and its supporting documents, to which the Respondent did not respond.

- The Complainant has been established since 2005 and is engaged in providing online money transfer and digital payment services. It is headquartered in the USA but now has 14 offices around the world and operates a global business under its PAYONEER name and trademark.
- The Domain Name was registered by the Respondent in July 2007, by which time the Complainant already had an established international business with a presence in several countries.
- The Domain Name has only been used to resolve to a website page where the Domain Name is offered generally for sale and/or which contains 'pay per click' links that relate to the Complainant and its competitors.

#### **5. Parties' Contentions**

In summary, in its Complaint, which was supported by various documentary annexures, the Complainant made the following points:

- The Complainant is a financial services company which specialises in providing online money transfer and digital payment services. It was founded in the United States in 2005 and its principal place of business is 410 Park Avenue, 15th Floor, New York, NY 10022, United States of America.
- The Complainant has grown substantially since its incorporation in 2005 and it works with well-known brands such as Amazon, Airbnb and Google. The Complainant processes cross-border payments in over 200 countries, deals with over 150 local currencies, currently has over four million users and supports over 35 languages. The Complainant currently has 14 established physical locations around the world including the United States, Europe, China, Japan, South Korea, Philippines, Bangladesh and India. Going forward, by 2020, the Complainant wishes to expand further and have 50 physical locations around the world.
- Since its formation in 2005, the Complainant has also been the recipient of many awards and accolades, such as featuring as a top 100 winner in 2017 Red Herring North America and receiving gold in PYMNTS 2017 Innovator Awards. It is now listed in 'Inc. 5000's'

fastest growing companies in America – being ranked at #1912 in 2017. Furthermore, the Complainant has featured for a sixth consecutive year in Deloitte’s Technology Fast 500 ranking table – the 2017 publication saw the Complainant ranked at #399.

- The Complainant is one of the leaders in its industry and is recognised for continuously implementing innovative methods. CNBC have recognised this and have listed the Complainant for a second year in a row in CNBC’s Disruptor 50 list. Most recently, in May 2018, the Complainant ranked as #13, moving up 27 spots from their 2017 ranking.
- The Complainant uses their brand name, ‘PAYONEER’ as part of their brand logo, to distinguish their services from their competitors. The Complainant further uses the PAYONEER term in domain names. Specifically, the Complainant registered the domain name <payoneer.com> during 2005 and it has been in active use ever since.
- The Complainant also uses their PAYONEER brand to establish a social media presence with which to promote their services under the name, for example:
  - Facebook - <https://www.facebook.com/Payoneer;>
  - Twitter - <https://twitter.com/Payoneer;> and
  - LinkedIn - <https://www.linkedin.com/company/payoneer>
- Due to the national and international reputation of the brand, the Complainant is listed as one of the first hits on popular search engines, such as Google, when you enter ‘PAYONEER’.
- The Complainant has protected the brand name PAYONEER by way of trademark registrations in numerous jurisdictions, including but not limited to the following trademarks:
  - PAYONEER U.S. Trademark (Registration No.3380029, registered on the 12th February 2008).
  - PAYONEER U.S. Trademark (Registration No.3380030, registered on the 12th February 2008).
  - PAYONEER International Trademark which covers the European Union (Registration No.1303506, registered on the 9th May 2016),
  - PAYONEER International Trademark (Figurative) which covers the European Union (Registration No.1314134, registered on the 9th May 2016);
- Even though the Complainant did not acquire any registered trademark rights until 2008, its earliest trademark was filed on 19th September 2006. It is widely known that when a trademark is registered, the rights conferred to the trademark owner are effectively back-dated to the filing date. This enables the owner of a trademark to take action in respect of any infringing acts occurring in the period between filing and registration.
- The “PAYONEER” term is not generic or commonly understood by any other meaning, other than its association with the Complainant’s services.
- In view of the use of the PAYONEER brand and the registered trademarks outlined above, the Complainant has Rights for the purposes of the DRS Policy.

- With regards to the confusing similarity test, the Domain Name incorporates the term “PAYONEER” in its entirety, without adornment or word addition. The .co.uk suffix should be ignored in making the comparison (as in prior Expert decisions such as Ferrero S.p.A. v. Peter Ross, DRS Case No. D00009187 and Heald Solicitors LLP v. Mr. Philip Martin, DRS Case No. D00015029).
- As such, the Domain Name is identical, or at the very least, confusingly similar to that of the Complainant’s “PAYONEER” trademark in which the Complainant has Rights, thus satisfying the first limb of the DRS Policy.
- The Complainant has been the sole operator of the “PAYONEER” brand for several years and was established in 2005, before the registration of the Domain Name by the Respondent on 5th July 2007 by which time the Complainant already had a presence in several countries. Moreover, the Complainant’s services are mainly operated online, which were available in Europe and in the United Kingdom by the time of registration of the Domain Name. Between 2006 and 2008, the Complainant had attracted to their official website over 20,000 new users coming from the United Kingdom alone. In addition, the Complainant’s earliest registered trademark rights date from 19th September 2006.
- Archive records show that the website to which the Domain Name previously resolved, www.payoneer.co.uk, has never been used in connection with a legitimate business or purpose. As of 5th November 2012, the Domain Name was already listed for sale on the website. Currently, the website redirects to a ‘Pay Per Click’ page, with links that are connected with the Complainant or its competitors.
- The term “PAYONEER” is purely inventive and does not hold any meaning in any language. The Respondent can have had no legitimate reason to register the Domain Name except to prevent the Complainant from having it.
- In view of the circumstances outlined above, the Respondent has registered the Domain Name as a blocking registration against the mark “PAYONEER” in which the Complainant has Rights, as per Paragraph 5.1.1.2 of the DRS Policy. In the case Thomas Cook (UK) Limited v. Whitley Bay, DRS Case No. 00583, the Expert defined what is required for a blocking registration:

*“It seems to be that there are two critical features of a “Blocking Registration”. The first is that it must be against the name or mark in which the Complainant has rights. The second one is one of motivation. Where the registration is alleged to be a “Blocking Registration”, a Complainant, if it is to succeed must prove on the balance of probabilities that a Respondent’s principal objective in the registering or retaining of the disputed domain name was to prevent the Complainant from doing so. The absence of any use of the site by the Respondent for a legitimate business and other purpose of its own may assist in establishing the motivation, but the absence of any such use does not necessarily rule out legitimate interest”.*

- The Complainant also relies on Paragraph 5.1.2 of the DRS Policy as 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”. The Expert’s

Overview refers to “confusion” as to the identity of the person/entity behind the Domain Name. In other words, will an Internet user seeing the Domain Name to which a website is connected believe or be likely to believe that it *“is registered to, operated or authorised by, or otherwise connected with the Complainant”*? In this case, the average Internet user will be visiting the website to which the Domain Name resolves with the expectation that the website is operated, authorised, or connected with the Complainant. This is known as “initial interest confusion”, and Experts have previously found that it is a possible basis for finding an abusive registration. Moreover, in the case *Chivas Brothers Limited v. David William Plenderleith*, DRS Case No. 00658, the Expert found that a finding of abusive registration in such a context is most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment other than the generic domain suffix.

- The question is whether the use of the Domain Name by the Respondent causes initial interest confusion. As stated in the case *Joie de Vivre Holidays v. Sandi Sabloff*, DRS Case No. 05122, initial interest confusion is described as *“the phenomenon whereby visitors to the domain name, in the moment before they actually reach the website, believe that the domain name is in some way connected to the Complainant”*. To illustrate “PAYONEER” recognition in the United Kingdom, between 2006 and 2008, over 42,000 users located in the United Kingdom visited the Complainant’s services that can be found on [www.payoneer.com](http://www.payoneer.com). More generally, 247,000 users used the Complainant’s services online in the European Union and over 633,000 people located in the European Union visited the Complainant’s website between 2006 and 2008.
- Therefore, it is inevitable that an average Internet user that comes across the Domain Name would be misled into thinking that is related to the Complainant’s brand and users will understand only after landing on the webpage that it does not in fact belong to the Complainant’s brand. Therefore, the Respondent’s registration and use of the Domain Name causes initial interest confusion in the eyes of an average user. The Respondent tries to free ride on the reputation and goodwill of the Complainant, and commercially profit from the Domain Name. The Respondent set up a Pay Per Click (PPC) page and offered the Domain Name for sale since at least November 2012. It is widely known that the use of PPC is not in itself evidence of bad faith. Indeed, if a domain name is comprised of a generic term, a registrant can generate revenue through PPC links if those are related to the generic or dictionary word. But where the Domain Name is made up of the non-generic term “PAYONEER”, the links on the PPC landing page are based on the trademark value of the Domain Name, and this constitutes abusive cybersquatting. The Respondent’s intention is to derive advantage from user confusion with links to third-party services and competitors of the Complainant and to increase the sale value of the Domain Name.
- The Respondent is also engaged in a pattern of abusive conduct as per Paragraph 5.1.3 of the DRS Policy. Indeed, the Respondent has a portfolio of over 4,000 domain names, containing several well-known third-party trademarks. Examples of which include but are not limited to:
  - <[addidasusa.com](http://addidasusa.com)>;
  - <[adidastenis.com](http://adidastenis.com)>;
  - <[anaheimmarriot.com](http://anaheimmarriot.com)>;
  - <[bankofamrca.com](http://bankofamrca.com)>;
  - <[celinevogue.com](http://celinevogue.com)>;

- <dellpayment.com>;
- <disneyiland.com>.

- The Respondent's domain name portfolio contains many well-known brands, such as "DELL", "ADDIDAS" and "DISNEY". The fact that the Respondent has registered several domain names corresponding to third-party brands further affirms that the Respondent intentionally registers domain names to profit from the brand value of trademarked terms. Such use is consistently held to amount to cybersquatting, as applied in the dispute between Viacloud WLL v. Inshallah Ltd, DRS Case No. 97490 where the Expert held that: *"The Respondent is a cybersquatter engaged in a pattern of registrations for domain name corresponding to trading names or trade marks in which the Respondent has no apparent legitimate rights"*.
- Therefore, the Respondent has engaged in a pattern of abusive conduct, by registering well-known trademarks as part of their domain name portfolios, such as the Complainant's brand "PAYONEER".
- Finally, the Complainant relies on Paragraph 5.1.6 of the DRS Policy as the Domain Name is an exact match of the Complainant's brand "PAYONEER", in which the Complainant has Rights. The Respondent has no reasonable justification for having registered the Domain Name, other than to free ride on the reputation of the Complainant.
- Moreover, the Complainant, prior to this dispute, sent out a cease and desist letter to the Respondent on the 29th March 2018, as well as a follow-up email on the 9th April 2018, but the Respondent chose to ignore it. The fact that the Respondent was given a chance to defend their case but chose not to is further evidence that the Domain Name is an abusive registration (see Accor SA v. Mr Sven Gall, DRS Case No. 20172).
- The Respondent has no rights or legitimate interest in respect of the Domain Name under Paragraph 8 of the DRS Policy.
- The Complainant submits that to the best of their knowledge the Respondent has not used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods and services. Indeed, the Domain Name currently resolves to a PPC page, with links to some of the Complainant's competitors. It is a well-established principle that the use of a domain to offer PPC links, can be legitimate, as long as the links do not take advantage of any third-party rights. This principle is commonly applied in DRS disputes (see LivingSocial, Inc. v. Mr Roy Vivasi, DRS Case No. 10401, where the Expert held that *"the sponsored links generated on the website clearly indicate that this is not a "non-commercial" use."*). In this case, the term "PAYONEER" has no other meaning than the one associated with the Complainant's services. Therefore, the use of PPC links in relation to the Complainant's services or its competitors is evidence that the Respondent lacks a legitimate interest in the Domain Name.
- Furthermore, to the best of the Complainant's knowledge, the Respondent has not been *"commonly known by the name or legitimately connected with [the] mark which is identical or similar to the Domain Name"* (DRS Paragraph 8.1.1.2). The Complainant maintains that the Respondent has never been known by the Domain Name.
- Finally, the Respondent has not made a legitimate non-commercial or fair use of the Domain Name for the purposes of Paragraph 8.1.1.3 of the DRS Policy. It is widely known

that the use of PPC links generate revenue either directly or indirectly for the Respondent. Each time an Internet user clicks on one of the links, the Respondent is commercially benefitting from it. Moreover, the Respondent offered the Domain Name for sale to the general public, which further reinforces the idea that the Respondent tries to gain profit from the Domain Name. Therefore, the use of the Domain Name is for commercial gain and thus the Respondent cannot rely upon this defence.

The Respondent did not respond to the Complaint. Nevertheless, the Complainant exercised its option of paying for a full Expert decision rather than a summary one.

## 6. Discussions and Findings

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, namely that:

1. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

These terms are defined in the Nominet DRS Policy as follows:

- **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.
- **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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

### Does the Complainant have Rights?

The Complainant has provided ample evidence of substantial use of its PAYONEER name and trade mark since 2005, along with details of various trade mark registrations for the name. In the circumstances, the Complainant clearly has Rights for the purposes of the DRS Policy in respect of its PAYONEER name and trade mark.

### Are those Rights in respect of a name or mark which is identical or similar to the Domain Name?

I agree with the Complainant's submission that in this case it is right to ignore the .co.uk suffix when comparing the Domain Name with the name and mark in which the Complainant has Rights. The only time it may not be right to do so is if the name or mark itself expressly includes a particular domain name suffix, but that does not apply in this case.

In the circumstances, I find that the Complainant's PAYONEER name and mark in which it has Rights is identical to the Domain Name.

Is the Domain Name, in the hands of the Respondent, an Abusive Registration?

There are two limbs to the definition of an Abusive Registration. The first considers the circumstances at the time the Domain Name was registered or acquired and whether or not, at that time, doing so took unfair advantage of or was unfairly detrimental to the Complainant's Rights. The second limb of the definition considers the use the Domain Name has been put to at any time after its initial registration and whether or not that use took unfair advantage of or was unfairly detrimental to the Complainant's Rights. In order to succeed, the Complainant just needs to get home on either rather than both of those limbs.

The Domain Name was registered on 5 July 2007. At that time, the Complainant had only been in business for about two years and it was not until 2008 that the Complainant secured the first of its registered trademark Rights. This was after the Domain Name was registered. The Complainant points out that its earliest trademark application was filed on 19th September 2006, before the Domain Name was registered, and that under trademark law, when a trademark has been registered, the rights conferred to the trademark owner are back-dated to the filing date to enable action to be taken in respect of any infringing acts occurring in the period between filing and registration. But that only applies once the trademark has actually been registered. At the time the Domain Name was registered in July 2007 the Complainant only had a pending application which did not, at that time, give it any generally enforceable rights in respect of it. However, pending its registration, the application does provide the applicant with a right to file a timely opposition to a third party's subsequent application to register the same or a similar trademark.

The Experts' Overview is published on the Nominet website and is there to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how the DRS Experts have dealt with those issues to date and to draw attention to areas where Experts' views differ. In paragraph 1.9 it states as follows:

*"1.9 Can the mere existence of a trade mark application give rise to a right within the definition of Rights?"*

*No. The validity of a trade mark application has not yet been determined and ordinarily it affords the proprietor no legal right to prevent others from using the mark. In and of itself an application will not constitute 'Rights' under the Policy."*

The Experts overview does not expressly consider the right to use a pending trade mark application as a basis for filing an opposition to a third party's subsequent application to register the same or a similar trademark. But in any event, registering the same or a similar domain name does not impede on or in any way relate to that very particular right.

In the circumstances, I find that the Complainant cannot rely upon any of its registered trademark rights in respect of the first limb of the definition of an Abusive Registration.

The Complainant was obviously aware of that issue when preparing its Complaint because it made express representations as to the extent of its use of the PAYONEER name and mark in the two-year period between it having commenced business in 2005 and the registration of the Domain Name in July 2007. In particular, the Complainant pointed out that, by time the



Respondent registered the Domain Name on 5th July 2007, the Complainant already had a presence in several countries and its online services had also been available in Europe and in the United Kingdom. The Complainant annexed supporting evidence showing the number of unique visitors and visits to its website from the UK and other countries in and around Europe. But it chose to give such details for the total period from 1 April 2006 to 31 December 2008, for example, between those dates it says there had been over 20,000 new visitors coming from the United Kingdom alone. However, the Domain Name was registered in the middle of that period and the Complainant did not provide such details just up to 5 July 2007, which is when the issue needs to be considered under the first limb of the definition of an Abusive Registration.

It is apparent from the combined graph that accompanied the detailed country by country table that the total number of visitors to the website from all of the listed countries combined was relatively very small before July 2007 and began to ramp up significantly immediately after that date. But in my view, the use of the PAYONEER name and mark before 5 July 2007, in particular its physical presence in several countries and online offering, will likely still have been sufficient to give the Complainant enforceable rights, such as passing off rights in the UK and unfair competition rights in other jurisdictions.

The issue under the first limb of the definition of an Abusive Registration therefore falls to be decided on whether or not the original registration of the Domain Name in July 2007 took advantage of or was unfairly detrimental to those Rights.

The Complainant has considered Paragraph 5 of the DRS Policy, which sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. In particular, it relies on Paragraph 5.1.1.2 of the DRS Policy, which states as follows:

*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 trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*

The Complainant relies upon the fact that the Respondent has a portfolio of over 4,000 domain names which include several well known third party trademarks. It gave just six examples of domain names relating to the household names of Adidas, Dell, Disney, Marriott and Bank of America and also one relating to the Celine fashion brand. Having a large domain name portfolio is not of itself any evidence of any type of abusive or objectionable behaviour and, whilst it says this was not an exhaustive list of examples, I assume it has highlighted those it felt were most appropriate for the purposes of Paragraph 5.1.3 of the DRS Policy. However, the Complainant did not go on to explain why it believed that the registration of the Domain Name in July 2007 was part of any pattern with those particular domain names.

With due respect to the extent of the Complainant's international business, I do not accept that the PAYONEER name was anywhere near being in the same bracket as the household name brands it gave as examples, and certainly not back in July 2007 when the Complainant had only been in business for two years. I also note that five of the seven examples relied upon by the Complainant involve misspellings and at least five also comprise additional adornment to the relevant brand name, whereas the Domain Name comprises only the relevant brand name and it is not misspelt. In the circumstances, on the evidence before me, I am not prepared to hold that the Domain Name was likely to be part of any pattern of registrations of well known third party names or trademarks.

The Complainant also relies on Paragraph 5.1.1.2 of the DRS Policy, which states as follows:

*“Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily .... as a blocking registration against a name or mark in which the Complainant has Rights;”*

The Complainant further relied upon a previous DRS case (Thomas Cook (UK) Limited v. Whitley Bay, DRS Case No. 00583) in which the Expert said that a complainant must prove that a respondent’s principal objective in the registering or retaining of the disputed domain name was to prevent the Complainant from doing so. The Complainant points out that PAYONEER is an entirely made up name with no known meaning in any language and asserts that, in those circumstances, the Respondent could have had no legitimate reason to register the Domain Name except to prevent the Complainant from having it.

That would require the Respondent to at least have some knowledge of the Complainant’s existence when registering the Domain Name in July 2007. Whilst the Complainant’s use of and reputation in its name was much less then than it is now, as the name was invented by the Complainant and had no other meaning when the Domain Name was registered, I find that, on the balance of probabilities, it is likely that the Respondent knew of and had the Complainant in mind when registering the Domain Name and this will have been done to prevent the Complainant from registering the .co.uk variant of its name alongside its existing .com domain name online presence. Such action by the Respondent took unfair advantage of and was unfairly detrimental to the Complainant’s Rights.

That is sufficient for the Complainant to get home under the first limb of the definition of an Abusive Registration. The Complainant also relied upon the second limb and I will deal with that also for the sake of completeness. This deals with the use that the Domain Name has been put to subsequent to its registration, which has been limited to resolving to a website page where it was offered generally for sale and which also contained various ‘pay per click’ links. For the avoidance of doubt, the Complainant can rely upon its registered trademark rights in respect of the second limb of the definition of an Abusive Registration because the use of the Domain Name complained of post-dated both the application date and the registration date of the relevant trademarks.

The Complainant points to Paragraph 5.1.2 of the DRS Policy which states as follows:

*“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;”*

The Complainant relies on the concept of “initial interest confusion”. Paragraph 3.3 of the Experts’ Overview explains this as follows:

*“Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, 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 web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose.*

*In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name. In the High Court decision Och-Ziff Management Europe Ltd v Och Capital LLP [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being "a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant's conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase". In that case the court held that initial interest confusion is legally actionable under European trade mark legislation.*

*In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.*

*Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).*

*The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privalege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decisions in DRS 00248 (seiko-shop.co.uk) and DRS 07991 (toshiba-laptop-battery.co.uk).*

*Subsequent to the Och-Ziff case (supra) the Court of Appeal in Interflora v Marks and Spencer [2014] EWCA Civ 1403 criticised the use of "initial interest confusion" as a concept relevant to English trade mark law. This case was discussed by the Appeal Panel in DRS 15788 (starwars.co.uk) who concluded that initial interest confusion remained an applicable principle in determining whether or not a domain name registration was abusive."*

In this case, the Domain Name is identical to the Complainant's name in which it has Rights. That name was invented by the Complainant and it has no meaning other than as a reference to the Complainant and its business. In those circumstances, the risk of the type of initial interest confusion outlined in the Experts' Overview happening in this case is readily apparent. Any such visitor to the website to which the Domain Name resolved would have been met with a page containing 'pay per click' links to the websites of third party competitors of the Complainant. Such use of the Domain Name takes unfair advantage of and was unfairly detrimental to the Complainant's Rights.

## **7. Decision**

For the reasons outlined above, I find that the Complainant has proved, on the balance of probabilities, that the Complainant 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.

In the circumstances I order that the Domain Name be transferred to the Complainant.

**Signed**

**Dated** 21 December 2018

Chris Tulley