

Dispute Resolution Service

DRS 20986

Decision of an Independent Expert

Citigroup Inc.

and

Jubo Raj

1. Parties

Complainant: Citigroup Inc.
388 Greenwich Street
New York, NY 10013
New York
United States

Respondent: Jubo Raj
Newcastle Road
Sandbach
Cheshire
CW11 2SN
United Kingdom.

2. Domain Name

citiinternationaltradefinance.co.uk (the “Domain Name”)

3. Procedural Background

On 30th January 2019 the Complaint was lodged with Nominet UK Limited (“Nominet”) and was validated. On 30th January 2019 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising the Respondent to log into Nominet’s Online Services to view the details of the Complaint, and giving the Respondent 15 business days within which to lodge a Response on or before 20th February 2019. On 18th February 2019 Nominet sent the Respondent a Response reminder. On 20th February 2019 the Respondent sent a Response. On 20th February 2019 Nominet advised the Complainant that a Response had been received and advised it to log into Nominet’s Online Services to view it. Nominet invited the Complainant to make a Reply on or before 27th February 2019. The Complainant replied on 27th February 2019. Mediation documents were generated in relation to the Complaint, and mediation commenced on 7th March 2019. Mediation was unsuccessfully concluded on 22nd March 2019. On 4th April 2019, the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 10th April 2019 Mr. Niall Lawless (“the Expert”) was appointed to act as Expert in this dispute. He is required to give his Decision by 3rd May 2019.

The Expert has confirmed that he is independent of each of the parties, and that to the best of his 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 his independence in the eyes of one or both of the parties.

4. Outstanding Formal or Procedural Issues

There are no outstanding formal or procedural issues.

5. Factual background

The Complainant, Citigroup Inc. is an American multinational banking and financial services corporation with headquarters in New York, USA. In 2016, the Complainant was the 13th largest bank holding company in the world as measured by assets, and the 7th largest as measured by market capitalisation. In 2017, the Complainant was ranked the 36th, 46th and 62nd most valuable global brand by Brand Finance, Interbrand, and Forbes, respectively.

The Respondent, is Jubo Raj. The status of the Respondent is unknown. In this dispute the Response is provided by Sir Anam Islam a Director of Citi International Trade Finance UK Ltd. Citi International Trade Finance UK Ltd is a Private Limited Company incorporated under the UK Companies Act 2006 on 7th September 2017. The Respondent registered the Domain Name on 7th September 2017, and is currently being used by the Respondent to resolve to a website located at www.citiinternationaltradefinance.co.uk/.

6. The Parties' contentions

The Complainant

The Complainant seeks transfer of the Domain Name. The Complainant says that the Domain Name is an abusive registration under Nominet's DRS Policy because:-

- The Domain Name is confusingly similar to Complainant's distinctive CITI trademark, and is a malicious and dangerous registration which is linked to a website that infringes the Complainant's registered rights.
- The Respondent is using the Domain Name to confuse users into believing that the Respondent is affiliated or associated with the Complainant.
- The Respondent is using the Domain Name for the purpose of directing traffic away from Complainant's business to a competing company purportedly offering financial services identical and/or highly similar to the financial services offered by Complainant.
- The Respondent is using the Domain Name as part of a fraudulent scheme to obtain customer information by trading on the goodwill developed by the Complainant.
- The Respondent has not been authorised, licensed or given permission by the Complainant to use the CITI Marks.
- The Respondent has no rights or legitimate interests in the Domain Name.

The Respondent

The Respondent says that the Domain Name controlled by it is not an Abusive Registration under the Policy because:-

- On 7th September 2017, it incorporated a company called "Citi International Trade Finance UK Ltd" and subsequently bought the Domain Name as it best suited the company name.
- The Domain Name was available for the Respondent to register and use.

- The Complainant and Respondent operate in different sectors, thus they do not engage in direct competitive enterprises.
- The Domain Name is not being used in a way that would cause confusion in the marketplace that the Complainant and the Respondent have any form of connection.
- The Complainant is a larger corporation which is giving unnecessary harassment to a smaller company.

7. Discussions and Findings

7.1 General

The Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities that:-

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

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

7.2 Complainant's Rights

The Complainant has provided evidence that it is one of the world's best well-known and largest corporations providing banking, financial, investment, and related services. The Complainant has numerous European Union and United States service marks incorporating the CITI brand. These include the following European Union trademarks: No. 000112458 CITIBANKING; No. 000143487 CITIBANK DIRECT ACCESS; No. 000179523 CITIBANK PREFERRED; No. 005870027 CITIBANK. LET'S GET IT DONE; No. 012866885 CITIBANK PREMIERMILES; and No. 002966950 CITIBANK GLOBAL TRANSFERS".

The Complainant uses a range of domain names incorporating the CITI brand. For example, the Complainant has registered the domain names <citifinance.com>; <citifinancial.com>; and <cititrade.com>.

Although the Domain Name includes the words terms “international”, “trade”, “finance”, and the “.co.uk” gTLD, the dominant element in the Domain Name is clearly the word "CITI" and the Expert agrees that the additional words fail to distinguish the Domain Name from the Complainant’s name and trade mark.

Accordingly, based on the evaluation of all evidence presented, the Expert decides that, the Complainant has Rights in respect of a name or mark that is similar to the Domain Name.

7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy. Under paragraph 5 “Evidence of Abusive Registration” guidance is given as to what factors may be evidence that the Domain Name is an Abusive Registration.

“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 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.”

The Complainant's trademark

The Complainant says that the Domain Name is confusingly similar to Complainant's distinctive CITI trademark, and is a malicious and dangerous registration which is linked to a website that infringes the Complainant's registered rights.

A Nominet Expert is not under duty to consider whether the Respondent's activities amount to a violation of the Complainant's trademark. Expert Decisions are to be determined by reference to the Policy and not the law in respect of trademark infringement, for example, as decided in *Deutsche Telekom AG v Lammtara Multiserve Limited* Appeal Decision (DRS 05856).

If trademark infringement is a pressing concern, the Complainant has an option of pursuing the matter in court, which it has not done. It is not the role of Nominet's DRS to act as a substitute for litigation in relation to all domain name disputes, but only those falling within the narrow confines of the Policy.

Confusion

The Complainant says the Respondent is using the Disputed Domain to confuse users into believing that the Complainant is affiliated or associated with the Complainant. The Complainant says the Respondent is using the Domain Name for the purpose of directing traffic away from Complainant's business to a competing company purportedly offering financial services identical and/or highly similar to the financial services offered by Complainant.

The Respondent says that the Complainant and Respondent operate in different market sectors. The Respondent says that whereas it is an intermediary offering banking products from different regulated banks and financial institutions, the Complainant is a world leading banking institute that provides different services from what the Respondent provides.

The Respondent says that by virtue of the company name Citi International Trade Finance UK Ltd it has legitimate rights in the Domain Name, and that the Domain Name was available for the Respondent to use.

The Respondent says that, as it heavily reliant on its websites in operating its' business the transfer of the Domain Name to the Complainant would have a negative impact on the business being able to function. Additionally, it would ruin relationships with its customers, which it has worked tirelessly to create via the use of the Domain Name.

Under the Policy paragraph 5, a factor that may be evidence that the Domain Name is an Abusive Registration is *“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 ...”*.

Confusion would arise where the Internet user incorrectly assumes that the website the Domain Names resolves to, and the Complainant’s other official websites, are either both authorised by or belong to the Complainant.

The Respondents’ decision to incorporate Citi International Trade Finance UK Ltd on 7th September 2019, and to register the Domain Name on 7th September 2017, were linked decisions. Given that the Respondent promotes itself as *“a specialized finance company based in United Kingdom, providing purchase order financing, letters of credit, receivable financing and creative short-term transactional financing for importers, exporters, and other short-term borrowers”* it is not conceivable to the Expert that on 7th September 2017 the Respondent was unaware of the Complainant and its business operations. Both the Complainant and the Respondent provide financial services and it is disingenuous for the Respondent to argue that the Complainant and Respondent operate in different market sectors.

The Domain Name incorporates “CITI” a well-known financial services brand and the descriptive nature of the Domain Name incorporating the words “international”, “trade”, “finance”, and the “.co.uk” gTLD, do not differentiate the Respondent’s business from the Complainant’s business. Rather the consequence of the choice of these words links the Respondent’s business activities more closely with the Complainant’s business activities. In the Expert’s view, the Respondent registered the Domain Name irrespective of and reckless as to what confusion its use might result in.

The Domain Name resolves to a website where the Respondent brazenly promotes itself using the term “CITI”, and which is being used to offer financial services. As a result, the Expert is in no doubt that the Domain Name is being used in a way that has confused or is likely to confuse people into believing that the Domain Name is operated by or connected with the Complainant. Having a properly incorporated limited company with the same name as a Domain Name, is not a legitimate defence that would render an abusive registration innocuous.

The Expert decides on the balance of probabilities that even in the absence of evidence of actual confusion, the Respondent is using the Domain Name in a way that will confuse users into believing that the Respondent is affiliated or associated with the Complainant. Therefore, under the test in paragraph 3(a)(ii) of the Policy, in the control of the Respondent the Domain Name is an Abusive Registration.

In light of this finding, it is unnecessary for the Expert to address the Complainant's other contentions.

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name or mark identical or similar to the Domain Name and the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

8. **Decision**

For the reasons set out in detail above, the Expert directs that the Domain Name be transferred to the Complainant.

Niall Lawless, Nominet Expert

10th April 2019