

DISPUTE RESOLUTION SERVICE

D00021885

Decision of Independent Expert

Capital One Financial Corporation

and

Rainmaker Investments GmbH im Kundenauftrag

1. The Parties:

Lead Complainant: Capital One Financial Corporation
15000 Capital One Drive
Richmond
Henrico
23238
United States

Respondent: Rainmaker Investments GmbH im Kundenauftrag
Waltherstrasse 23
Muenchen
80337
Germany

2. The Domain Name(s):

<capitakone.co.uk>

3. Procedural History:

- 3.1 I have confirmed to Nominet that I am independent of each of the parties and that 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

3.2 The procedural chronology of this dispute is as follows:

25 September 2019 15:35 Dispute received
26 September 2019 09:27 Complaint validated
26 September 2019 09:29 Notification of complaint sent to parties
15 October 2019 02:30 Response reminder sent
18 October 2019 14:48 No Response Received
18 October 2019 14:49 Notification of no response sent to parties
22 October 2019 11:35 Expert decision payment received

4. Factual Background

4.1 The Complainant, Capital One Financial Corporation, is a financial institution that was founded in 1988 and is headquartered in McLean, Virginia, in the United States of America. The Complainant offers a broad spectrum of financial products and services to consumers, small businesses and commercial clients.

4.2 The Complainant is the owner of numerous trade marks in numerous jurisdictions around the world that comprise or incorporate the term “Capital One”. The marks relied upon are addressed in greater detail in the “Parties' Contentions” section of this decision, but they include United Kingdom registered trade mark no 3081649 in classes 9, 35 and 36, filed on 14 November 2014 and which takes the following form:



4.3 The Domain Name was first registered on 6 March 2016. As at May 2017 the Domain Name was held in the name of “Tulip Trading Company Limited”, which also held the domain names <capitalonline.co.uk>, <capitolone.co.uk> and <capitalonecard.co.uk>.

4.4 On 30 May 2017, the Complainant’s US lawyers sent a letter addressed to Tulip Trading Company Limited demanding the transfer of all four of these domain names to the Complainant, and threatening litigation if it did not comply with that demand. That letter also observed that Tulip Trading Company had been an unsuccessful respondent in a large number of domain name cases under the UDRP and identified one case where it had been the respondent in proceedings under the Nominet DRS.

4.5 In email correspondence that then followed, an anonymous person at “Tulip Trading Company” appeared to agree to transfer all these domain names to the

Complainant. However, only the domain name <capitalonline.co.uk> was actually transferred.

- 4.6 In June 2019 the Complainant's US lawyers noticed that the registrar of the Domain Name had changed and as a result sent a letter of complaint to that new registrar. No response as received to that letter but Nominet have confirmed that on 19 July 2019, the Domain Name was "detagged" by the registrar. As a consequence, from that date no registrar has been identified for the Domain Name on the publicly available WhoIs records. Nominet have also confirmed that (a) detagging would result in any services running from the Domain Name, such as emails or websites, no longer working; but (b) the registrant would still be able to log into Nominet's online services in order to initiate the process of getting the Domain Name tagged with a new registrar.
- 4.7 The present registrant of the Domain Name is Rainmaker Investments GmbH im Kundenauftrag.

5. Parties' Contentions

The Complaint

- 5.1 In the Complaint, the Complainant describes its business and claims it helped pioneer the mass marketing of credit cards in the early 1990s. Although it describes itself as a "major" financial institution, no attempt is made to describe the size of the business or the extent to which that business is conducted outside of the United States.
- 5.2 The Complainant also provide an annex that lists a large number of trade marks in multiple jurisdictions that the Complainant claims either it or its subsidiaries own. Unfortunately, this is presented in a somewhat unhelpful way. No attempt is made to identify or distinguish word and device marks, or provide the date of application or registration. A casual review for example of the UK IPO database would also suggest that the list of marks provided is incomplete and omits a number of marks that one would have thought the Complainant would have wanted to rely upon (for example, United Kingdom registered trade mark 2009942). However, among the list of marks provided is the combined device and stylised text mark identified in the Factual Background section of this decision.
- 5.3 The Complainant contends that the Domain Name "is confusingly similar to [the] Complainant's CAPITAL ONE trademark" because the Domain Name involves a simple misspelling or typographical error.
- 5.4 The Complainant claims that the registration of the Domain Name was without the Complainant's permission, and that this demonstrates the Respondent's lack of rights in the Domain Name.

- 5.5 The Complainant sets out its dealings with the previous registrant and the most recent registrar of the Domain Name; i.e Key-Systems GmbH. It therefore claims to have brought these proceedings against Key-Systems.
- 5.6 The Complainant also claims that the recent transfer of the Domain Name into the hands of another registrant is evidence of abusive registration.
- 5.7 The Complainant contends that the Domain Name is being used to divert internet users to the Respondent's website, but it then somewhat inconsistently (in the context of a claim of "lack of rights or legitimate interests") asserts that the Domain Name is not being used to display any website content notwithstanding that it was initially registered 3 ½ years ago. This is said to indicate that the Domain Name was registered as a "blocking registration".

The Response

- 5.8 No Response has been filed.

6. Discussions and Findings

- 6.1 As no Response was filed in these proceedings, the Complainant could have sought a summary decision. However, as it was entitled to do, the Complainant has sought and paid for a full decision (paragraph 12.1 of Nominet's Dispute Resolution Service Policy).
- 6.2 To succeed under Nominet's Dispute Resolution Service Policy (the "Policy"), the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy) and second, that the Domain Name is an Abusive Registrations in the hands of the Respondent (paragraph 2.1.2 of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy), and this is so even if a Response has not been filed. The Expert may nonetheless draw appropriate inferences from the fact that the Respondent has failed to file a Response (paragraph 24.8 of the Policy).
- 6.3 Abusive Registration is defined in paragraph 1 of the Policy as follows:

"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 took unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's Rights

- 6.4 As has already been observed earlier in this decision, the way in which the Complainant identified the rights relied upon in this case was unhelpful and the fact that it has relied upon some trade marks and not others is somewhat puzzling.
- 6.5 Nevertheless, the Complainant has demonstrated that it is the owner of UK registered trade mark no 3081649, which comprises the text "Capital One" in stylised form together with a device element. The text "Capital One" comprises the dominant element of that mark. There is also no suggestion that "Capital One" is purely descriptive of the relevant goods and services in respect of which it has been registered.
- 6.6 Further, I accept that the most sensible (and probably the only sensible) reading of the Domain Name is as a misspelling of the term "capital one" in combined with the ".co.uk" suffix. Given this it follows that the Complainant has demonstrated that it has Rights in respect of a name or mark that is similar to the Domain Name. The Complainant has thereby satisfied the requirements of paragraph 2.1.1 of the Policy.

Abusive Registration

- 6.7 There are elements of the Complaint that are somewhat confused. Contrary to what it claims, this Complaint is not brought against the *registrar* of the Domain Name, but against the *registrant*. The Complainant refers to "rights and legitimate interests" but that is a term that is used in the UDRP and not the DRS. There is also the fact that the Complainant seems to be simultaneously asserting in one part of the Complaint that the Domain Name has been used to divert internet users to a website and then in another part to be claiming that the Domain Name is not being used for a website at all.
- 6.8 Nevertheless, ultimately, I do not think any of this really matters. The reason why is that I am persuaded that this is a case of "typosquatting" where the Domain Name has been registered and held because it involves a deliberate misspelling or (more likely in this case given the proximity of the letters "l" and "k" on a keyboard) mistyping of the term "Capital One", and that this was done with a knowledge of the Complainant's business and marks. The reasons for this are as follows:
- (i) The initial registrant of the Domain Name, Tulip Trading Company Limited, had also registered the domain names <capitalonline.co.uk>, <capitilone.co.uk> and <capitalonecard.co.uk>. The first two of these domains appear to involve misspelling of the term "Capital One". The third of these domains can only be sensibly read and a combination of the term "Capital One" and "card" and the use of the word "card" appears to involve a reference to the Complainant's credit card services.
 - (ii) There is no obvious sensible reading of the Domain Name other than as a misspelling or mistyping of the term "Capital One". Further, although

“capital” and “one” are each ordinary English words, in combination they have no obvious meaning other than one that is directed to the Complainant’s business.

- 6.9 The Complainant has brought forward no evidence that the Domain Name has actually been used to misdirect Internet users. I am also unconvinced that the Domain Name can be characterised as a blocking registration where there is no evidence before me that suggests that the Complainant would have wanted to register and use a misspelling of its marks.
- 6.10 However, where, as here, the most and perhaps only sensible reading of a domain name is that it involves intentional typosquatting, it is difficult to see how that domain name might be registered and held legitimately by anyone but the right holder. As is recorded in paragraph 3.3 of the Nominet DRS Expert Overview: *"the activities of typosquatters are generally condemned - see for example DRS 03806 (privalege.co.uk)"*. In such circumstances the domain name alone carries with it a threat that it will be used in a way that 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 relevant rights holder. That alone is likely to fall within the scope of the example of evidence indicating abusive registration set out at paragraph 5.1.2 of the Policy. Further regardless of whether it strictly falls within paragraph 5.1.2. of the Policy, it is prima facie evidence of an intention to take unfair advantage of the mark that is being typosquatted. Absent evidence to the contrary, this will usually be sufficient for a finding of Abusive Registration under the Policy.
- 6.11 There is a slight complication here in that the Domain Name has been recently transferred out of the name of Tulip Trading Company Limited, into the name of Rainmaker Investments GmbH im Kundenauftrag. However, the timing here is highly suspicious given that the transfer occurred shortly after the Complainant had notified the previous registrant of its rights and that registrant had indicated that it was prepared to transfer the Domain Name to the Complainant. This is prima facie a case of “cyberflight” where it is reasonable to infer (absent any evidence to the contrary) that the transfer was to a connected person, or at least to an entity that was aware of the Complainant’s notification. Further, even if that inference is wrong, there remains the nature of the Domain Name itself. The fact that the registrant is now Rainmaker Investments GmbH im Kundenauftrag rather than Tulip Trading Company Limited”, does not change the inherent assessment of the Domain Name as one that involves typosquatting on the Complainant’s rights.
- 6.12 Lastly there are the facts that (a) in response to the Complainant’s attorney’s letter in July 2019, the then registrar of the Domain Name appears to have disassociated itself from that registration by “detagging” it; and (b) the current registrant has not then sought to “retag” the Domain Name with a new registrar. This also tends to support a finding that the Domain Name is abusive.

6.13 Given this I hold that the Complainant has demonstrated that the Domain Name is an abusive registration and that it has thereby made out the requirements of paragraph 2.1.2 of the Policy.

7. Decision

7.1 I find that the Complainant has Rights in a name, which is similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed Matthew Harris

Dated 4 November 2019