



## DISPUTE RESOLUTION SERVICE

**D00022032**

### Decision of Independent Expert

PET PLAN LTD

and

Tulip Trading Company Limited

**1. The Parties:**

Complainant: **PET PLAN LTD**  
57 Ladymead  
Guildford  
Surrey  
GU1 1DB  
United Kingdom

Respondent: **Tulip Trading Company Limited**  
Dixcart House, Fort Charles  
Charlestown  
Nevis  
012345  
Saint Kitts and Nevis

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

*freepetplan.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.

05 November 2019, the Dispute was received.

05 November 2019, the Complaint was validated.

05 November 2019, the Notification of the Complaint was sent to the Parties.

22 November 2019, a Response reminder was sent to the Respondent.

27 November 2019, no Response was received.

27 November 2019, the Notification of No Response was sent to the Parties.

28 November 2019, an Expert decision payment was received from the Complainant.

### 4. Factual Background

4.1 The Complainant trades under the name “PET PLAN” (the ‘Name’) and provides pet insurance for domestic and exotic pets in the United Kingdom and other countries. It is a subsidiary of the Allianz Global Group.

4.2 The Complainant has registered the domain names [petplan.co.uk](http://petplan.co.uk) (registered before August 1996) and [petplan.com](http://petplan.com) (in 1996), which it uses to advertise and provide its services.

4.3 The Respondent registered the Domain Name on 6 June 2019.

4.4 The Complainant is the registered proprietor of various UK (e.g. UK Registration No. UK00002052294, 1997), European (EUTM Filing No. 011470465, 2013) and US (US No. 3161569, 2006) trade marks for the name “PETPLAN” and various logos (the ‘Marks’).

### 5. Parties’ Contentions

#### The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons below:

### **The Complainant's Rights**

- It has Rights in the Domain Name based on its Marks, and the goodwill and reputation it holds in the Name.
- In support of it having goodwill and reputation in the Name, the Complainant explained that it was founded in 1976, provides pet insurance for domestic and exotic pets in the United Kingdom and in other countries (including the US and Canada), and offers insurance to pet care professionals and a pet finding service.
- The Complainant submitted that it has *“continually operated under the PET PLAN name”, “has used the PET PLAN mark in connection with its pet insurance products”,* and has won various awards for the work it does (e.g. World Branding Awards – Brand of the Year 2017 – 2018).
- It explained that it has *“a strong Internet presence through its websites”,* noting that according to the Complainant’s DNS provider its website at *www.petplan.co.uk* receives almost *“400,000 hits each month and www.petplan.com receives an additional 21,000 hits per month.”*
- The Complainant submitted that it has *“undeniably acquired sufficient secondary meaning and common law trademark rights to the PETPLAN trademarks”* and that the *“distinctiveness and non-generic nature of the PETPLAN trademarks in the field of pet insurance has led internet users and the broader public to immediately associate the PETPLAN brands with Complainant and its services.”*
- In registering the Domain Name, the Respondent has added the generic, descriptive term *“FREE”* as a prefix to the Complainant’s *“PETPLAN”* Name/Marks, thereby making the Domain Name confusingly similar to the Complainant’s Name/Marks.

### **Abusive Registration**

- The Complainant submitted that the Respondent does not and could not offer goods and services using the Name/Marks, as there is no connection or co-operation agreement between the Complainant and the Respondent, noting that the Complainant has neither licensed, nor otherwise authorised, the Respondent to use the Name/Marks.
- By using the Name/Marks in the Domain Name, the Respondent has exploited the *“goodwill and the image of the Complainant’s [Marks], which may result in dilution and other damages for said [Marks].”*

- Given the similarities between the Complainant's Name/Marks and the Domain Name, there is a "*considerable risk*" that the public will perceive the Domain Name either as owned by the Complainant, or that the Complainant has "*some kind of commercial relation*" with the Respondent.
- Further, the Complainant noted that the Respondent registered the Domain Name mid-2019, which was "*significantly after*" the Name was first registered in the United Kingdom, and the Complainant's registration of its *petplan.co.uk* domain name.
- Therefore, the Complainant submitted that the Respondent would have been fully aware of Complainant's rights in the Name/Marks as well as the Complainant's *petplan.co.uk* domain name at the time of the registration of the Domain Name.
- The Complainant further submitted that the Respondent had specifically registered the Domain Name to "*ride on*" the Complainant's Rights by trading on the goodwill and reputation of the Marks, taking undue advantage of the Complainant and causing it detriment by doing so.
- The Respondent is using the Domain Name to redirect Internet users to a website featuring links to third-party (i.e. not the Complainant's) websites, and by doing so the Respondent is presumed to receive pay-per-click fees from those linked websites.
- Noting the above, the Complainant submitted that the Respondent is not using the Domain Name to provide a *bona fide* offering of goods or services, a legitimate non-commercial or fair use as allowed under the Policy.
- Previous Nominet DRS decisions have found that evidence of prior DRS decisions in which domain names have been transferred away from the Respondent to complaining parties support a finding that the Respondent has engaged in a bad faith pattern of "*cybersquatting*".
- The Complainant noted in this regard that the Respondent has previously been found to have made Abusive Registrations in stated Nominet DRS cases (e.g. D00021433 (2019), D00021325 (2019), D00018981 (2017)) which, in its view, provides evidence of the pattern of "*cybersquatting*" in which the Respondent is engaging.

### The Respondent's Response

5.2 The Respondent did not submit a response to the Complaint.

## 6. Discussions and Findings

### General

6.1 To succeed in the Complaint, the Complainant has to prove that, pursuant to paragraph 2 of the Policy, on the balance of probabilities:

- i. *[it] 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.*

6.2 Addressing each of these limbs in turn:

#### **i Rights in respect of a name or mark which is identical or similar to the Domain Name**

6.3 The Expert considers that, for the reasons below, the requirement set out in paragraph 2 i of the Policy is met.

6.4 Paragraph 1 of the Policy defines 'Rights' 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;*

6.5 Given the Complainant's Marks, and noting the evidence presented as to the Complainant's goodwill and reputation in the Name, the Expert considers that, at the time of the Complaint, the Complainant had Rights in respect of the Name/Marks which is at least similar, and is identical if you disregard the "FREE" prefix, to the Domain Name.

6.6 In concluding the above, the Expert does not consider that the addition of the prefix "FREE" to the Name distinguishes the Domain Name from the Name/Marks, and has disregarded the Domain Name suffix "co.uk".

#### **ii Abusive Registration**

6.7 For the reasons set out below, the Expert considers that the requirement set out in paragraph 2 ii of the Policy is met.

6.8 Paragraph 1 of the Policy defines "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;*

- 6.9 In relation to the definition of Abusive Registration in sub paragraph (i), the Policy, at paragraph 5, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration.
- 6.10 Specifically, the Expert considers that the factor set out at paragraph 5.1.1.3 of the Policy (*registered for the purpose of unfairly disrupting the business of the Complainant*) is relevant.
- 6.11 Noting the Complainant's evidence as to the length of its service provision and its goodwill and reputation, a simple Internet search prior to registration of the Domain Name would have pointed the Respondent to the Complainant.
- 6.12 Therefore, the Expert considers that the Respondent would have been well aware of the Complainant, and the Name, prior to registering the Domain Name.
- 6.13 Indeed, on the balance of probabilities, the Expert is satisfied that the Respondent specifically chose to register the Domain Name at that time with the intention of benefitting from the Complainant's Name/Marks and general reputation and goodwill.
- 6.14 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 6.15 So far as the definition of Abusive Registration in sub paragraph (ii) is concerned, the Expert considers that the Domain Name was and is an Abusive Registration as a result of its manner of use by the Respondent, for the reasons explained below.
- 6.16 Specifically, the Expert considers that the factor set out at paragraph 5.1.2, 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*) is relevant.
- 6.17 As evidenced by the Complainant, the homepage of the website attached to the Domain Name (the '**Website**') contains advertising links to companies purporting to provide "*Dog Medicine Online, Pet Food Online, Cat Food Online*" services. The Expert examined the homepage, and from a cursory inspection of the linked Privacy Policy page it seems that these links are provided by *Team Internet AG*.
- 6.18 The use of the Domain Name by the Respondent in this way is referred to as domain name parking. In such cases, the domain name registrant is usually paid based on how

many users click through the provided links to the other companies' websites (referred to by the Complainant as "*pay-per-click fees*").

- 6.19 Paragraph 8.5 of the Policy sets out that the sale of such "*pay-per-click*" traffic is not of itself objectionable under the Policy. However, in such circumstances, the Expert when deciding whether there has been an Abusive Registration will take into account:
- a) the nature of the Domain Name;
  - b) the nature of the advertising links on any parking page associated with the Domain Name; and
  - c) that the use of the Domain Name is ultimately the Respondent's responsibility.
- 6.20 As considered by the Expert, the homepage of the Website includes links to services in the similar subject area as the Complainant (i.e. pet related). Given this, the Expert considers that anyone accessing the Website would likely be confused, at least initially (see paragraph 3.3 of the DRS Experts' Overview (version 3)), into thinking that the Website and the '*parked*' services offered therein are the Complainant's or are somehow connected with the Complainant, with the Complainant potentially losing business opportunities by such confusion.
- 6.21 The Expert is not persuaded by the argument that a person accessing the Website would soon realise their mistake that the Website is not linked to the Complainant (e.g. because the look of the Website is different to that of the Complainant's), the damage to the Complainant's business would already have been done. Indeed, the Expert considers that it is likely that at least some persons accessing the Website would have done so only because of the Complainant's general goodwill and reputation in the Name and/or Mark.
- 6.22 Further, the Expert is not persuaded by the argument that the Respondent, or the parking links provider, has no control over or responsibility for the links that are provided by virtue of a parked page, and therefore cannot be held to account for the content of those links. As referenced in the DRS Experts' Overview (version 3), where the domain name is connected to a parking page operated on behalf of the Respondent by a third party, the Respondent is "*unlikely to be able to escape responsibility for the behaviour of that third party.*"
- 6.23 The Expert also notes para 5.3 of the Policy which states that there shall be a presumption of an Abusive Registration where the Respondent has made an Abusive Registration in three DRS cases in the two years before the Complaint was filed (5 November 2019), which is the case here (in 2019, prior to the filing date, the Respondent was the respondent in DRS 21719 (*webstersmotorcycles.co.uk*), 21433 (*lovisa.co.uk*), and 21325 (*carsmartoxford.co.uk*) where each expert directed the relevant domain name be transferred to the complainant).

- 6.24 The Expert has considered whether there is any other evidence before him to demonstrate that the Domain Name is not an Abusive Registration (and rebut the previously mentioned presumption of an Abusive Registration), including whether the Respondent is making fair use of the Domain Name, but does not consider there is.
- 6.25 In particular, the Expert notes that the Domain Name is in fact identical to the Complainant's Name/Mark other than the prefix of the descriptive word "FREE", registration of the Domain Name by the Respondent post-dates the Complainant's reputation, and the Respondent uses the Website as a parking page which has links to advertising services some of which provide services in the similar subject-area as the Complainant.
- 6.26 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

## **7. Decision**

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of a name or mark which is at least similar to the Domain Name and the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

**Signed: Dr Russell Richardson**

**Dated: 28 December 2019**