

DISPUTE RESOLUTION SERVICE

D00022074

Decision of Independent Expert

Pet Plan Limited

and

Scott Pruitt

1. The Parties:

Complainant: Pet Plan Limited
57 Ladymead
Guildford
Surrey
GU1 1DB
United Kingdom

Respondent: Scott Pruitt
14919 Fern Hammock Dr W
Jacksonville
FL
32258
United States

2. The Domain Name(s):

petplans.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 on the basis that 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.

18 November 2019 07:11 Dispute received
19 November 2019 11:05 Complaint validated
19 November 2019 11:08 Notification of complaint sent to parties
06 December 2019 01:30 Response reminder sent
11 December 2019 10:10 Response received
11 December 2019 10:10 Notification of response sent to parties
16 December 2019 01:30 Reply reminder sent
17 December 2019 17:56 Reply received
17 December 2019 17:57 Notification of reply sent to parties
20 December 2019 10:43 Mediator appointed
31 December 2019 09:55 Mediation started
13 January 2020 13:37 Mediation failed
13 January 2020 13:37 Close of mediation documents sent
20 January 2020 10:44 Expert decision payment received

4. Factual Background

Based on the parties' submissions and evidence, I find the following facts as proven and they form the basis of this Decision:

- i. The Complainant was established in 1976 and is in the business of providing insurance for a range of pets, although it is now a subsidiary of Allianz Insurance plc.
- ii. While the Complainant was established in the UK, it provides its services across a number of countries around the world by means of a network of licensees.
- iii. The Complainant is the owner of a range of trade marks around the world for "PETPLAN": in Annex 2 to its Complaint, it has provided examples of such trade marks effective in the UK, the EU and the USA.
- iv. Under the trading name of "PETPLAN", the Complainant has actively marketed its range of services and is recognised as a successful brand by winning various prizes and by appearing high in rankings for its pet insurance services.
- v. In consequence, the "PETPLAN" trading name has achieved a large degree of recognition in the marketplace generally.
- vi. The Respondent is an internet marketer and has some business interest in investing in domain names.
- vii. The Respondent registered the Domain Name on 20 September 2019.

- viii. As at the time of the Complaint and of writing this Decision, the Domain Name resolved to a holding page with a panel in the centre stating, *“CONTACT DOMAIN OWNER For more information about this domain”* followed by a button entitled, *“CONTACT OWNER”*.

5. Parties’ Contentions

The Complainant makes the following submissions:

- i. The Complainant owns numerous trade marks for “PETPLAN” including those of which it includes relevant evidence in Annex 2 of the Complaint.
- ii. The Complainant was established in the UK in 1976 to provide insurance for common pets including cats, dogs, horses, rabbits and others.
- iii. The Complainant is now a subsidiary of Allianz Global Group, a leading financial services business.
- iv. The Complainant has become well known during 40 years of trading under the name “PETPLAN” and has received numerous awards for its various products.
- v. The Complainant also boasts a strong internet presence including on social media such as Facebook.
- vi. It is necessary to look at the essential elements of the Domain Name, so ignoring “.uk” or “.co.uk”, and it will be seen that when comparing the Domain Name with the Complainant’s trade marks the only difference is the “s” making the word a plural.
- vii. The Domain Name is an Abusive Registration because:
 - a. when registered, it took unfair advantage of or was unfairly detrimental to the Complainant’s Rights;
 - b. it has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;
- viii. The Domain Name is also an Abusive Registration under the following paragraphs of the DRS Policy:
 - a. 5.1.1;
 - b. 5.1.1.1;
 - c. 5.1.1.2;
 - d. 5.1.1.3; and
 - e. 5.1.6.
- ix. The Respondent is not commonly known by the Domain Name or legitimately connected with it and does not offer any goods or services using “PETPLAN” or any other similar name, and has no connection with the Complainant.
- x. The webpage to which the Domain Name resolves is an offer for sale of the Domain Name, and the Respondent is seeking to sell it for a sum in excess of his out-of-pocket expenses.
- xi. The registration of the Domain Name took place much later than the Complainant’s registration of the first of its trade marks.

- xii. At the time of registration of the Domain Name, the Respondent knew of the Complainant's trade marks and his addition of the plural "s" shows his familiarity with the Complainant's trade marks.
- xiii. On the Respondent's evidence, it would make no sense to sell the Domain Name while planning to create a website for the purpose of comparing differing pet insurance providers.

The Respondent makes the following submissions:

- i. He works as an internet marketer but has some business interests in investing in domain names, being involved in developing and selling domain names.
- ii. He noticed the Domain Name when viewing recently deleted domain names and saw its potential as a generic and descriptive name applying to a large number of possible markets.
- iii. He has parked the Domain Name and not done anything with it since registration.
- iv. He was not aware of the Complainant's trade marks until this Complaint.
- v. The addition of an "s" has been held sufficient to distinguish a domain name from another trade mark.
- vi. When registering the mark, it had recently expired indicating that some third party had been the owner of the Domain Name previously, so showing that the Complainant did not see it as a threat or that it had allowed the Domain Name to lapse as it was not considered important.
- vii. He originally described his intentions as including funerary arrangements, an area of business in which the Complainant has no interest.
- viii. He did not contact the Complainant prior to its contacting him in order to sell the Domain Name at a profit.
- ix. The Complainant has not produced evidence to suggest that he would block its own registration of the Domain Name or to disrupt its business.
- x. In fact, the Respondent did not know of the Complainant's trade mark at the time of registration and accordingly could not know that his registration was an Abusive Registration.
- xi. He only familiarised himself with the Complainant's trade marks after the latter contacted him.
- xii. It is not correct that the Domain Name is for sale on SEDO, rather petplans.net (not owned by the Respondent) is for sale for \$1,295.
- xiii. In conclusion, "PETPLANS" is a generic search term and the Complaint is an instance of reverse domain name hijacking.

The Complainant replies as follows:

- i. When registering a domain name, it is the Respondent's responsibility to verify that it does not infringe a third party's trade mark rights, as shown by clause 6.3 of Nominet's terms and conditions.
- ii. The Complainant did in fact contact the previous owner of the Domain Name, who let it lapse.

- iii. The costs of registering the Domain Name were £7.55 whereas the Respondent has demanded \$750.

6. Discussions and Findings

Rights

The Complainant must show that it has Rights, which are defined 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”*.

Having reviewed the materials supplied by the Complainant, in particular its trade mark registrations evidenced in Annex 2 to the Complaint, I am satisfied that the Complainant has sufficient Rights in the name or mark “PETPLAN” for the purposes of the DRS Policy.

Those Rights must, by virtue of paragraph 2.1 of the DRS Policy, be *“in respect of a name or mark which is identical or similar to the Domain Name”*. I discount the .co.uk suffix in line with the practice of other Experts.

The Domain Name in this instance is not identical with the Complainant’s Rights as it contains an additional “s”, so making it a plural form. The Respondent seeks to say that this distinction turns it into a separate and much more generic and descriptive term, not necessarily having any reference to the Complainant’s Rights, which could be said to be more specific.

It comes down to a question of judgment on the facts of each individual case and reference to other decisions is of limited value, especially when they are WIPO/UDRP decisions, which are applying a different set of rules from the DRS Policy.

In this case, the difference is so slight, only one letter, that the impression I am left with is that the Domain Name is virtually identical with the Complainant’s Rights and the threshold is only that they have to be “similar”. That being so, I find that the Complainant’s Rights are sufficiently similar to the Domain Name for the purposes of satisfying paragraph 2.1 of the DRS Policy.

Abusive Registration

The Complainant must then show that the Domain Name is an Abusive Registration in the Respondent’s hands. The DRS Policy defines an 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*

Paragraph 5.1 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The Complainant has invoked a number of these and I will examine them in order.

Paragraph 5.1.1

This provides three separate grounds for a finding of Abusive Registration. The complete text of this paragraph of the DRS Policy 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;”

It is relevant that the Respondent is in the business of acquiring domain names for trade - there is nothing illegitimate in this line of business in and of itself as paragraph 8.4 of the DRS Policy provides: indeed, that paragraph directs me to review the facts of each case individually.

The Domain Name, like the Complainant's Rights, is highly descriptive - it describes plans for pets although without expressly stating the type of plans. Common sense would suggest that the plans are for some type of insurance, as it is common to speak of "plans" when speaking of e.g. insurance or pensions. The Respondent suggests that he had in mind plans taking in funerary arrangements but I cannot understand how this can be read into "pet plans", unless the meaning is to refer to funeral arrangements for pets: however, this would not, in my view, be a natural or normal reading.

In addition, I must take account of the fact that the Respondent trades in domain names - not illegitimate in itself - and that he admits to identifying the Domain Name as having potential "for the purpose of development and resale" as he puts it in his Reply. I also note that the webpage to which the Domain Name resolves is, on the face of it, offering the Domain Name for sale, as it invites any visitor to make contact with the Respondent for more information. I accept the Complainant's evidence that the cost of acquiring the Domain Name would have been some £7.55, whereas the

sale price indicated by the Respondent was \$750, not exactly one hundred times the cost, but still far in excess of the Respondent's costs.

However, on balance, I do not accept that the Respondent knew nothing about the Complainant's business trading as "PETPLAN". It may be correct that the Respondent did not know specifically about the registered trade marks on which the Complainant relies to support its case regarding Rights, which I could understand. I note the Complainant's evidence regarding its operations and awards around the world. I also take into account that the Respondent describes himself as a full-time internet marketer and a part-time domain investor. It is inherently unlikely that such a person would have no knowledge whatsoever of the Complainant and its activities: indeed and on the contrary, it is precisely the sort of knowledge I would expect an internet marketer and part-time domain investor to have.

I also take account of the fact that the Respondent's initial response to the Complainant's approach was to offer the Domain Name for \$750, a sum far in excess of what his costs could have been to register it.

I therefore find that the Domain Name is an Abusive Registration under paragraphs 5.1.1.1 and 5.1.1.2 of the DRS Policy.

Furthermore, the Respondent describes how he was looking at recently expired domain names for possible registration, an activity commonly described as "drop-catching". The whole point of acquiring an expired domain name is that it has some value, often for selling back to the person who let the registration lapse, or to some competitor of that person. The images of the website seem to show just that sort of activity, inviting visitors to contact the Respondent for more information. It is not necessary for the Complainant to show that the Respondent proactively sought it or any other third party out for the purpose of making a sale. I therefore conclude that the Respondent recognised the Domain Name as having value precisely because it resembled the Complainant's trading name or mark (although he might well not have known anything about the Complainant's specific trade marks). On balance, his intention in registering the Domain Name was that it would be of value in selling to a competitor of the Complainant, which would then be an unfair disruption to the Complainant's business.

Furthermore, the Respondent says that he was contemplating setting up some sort of comparison website for pet insurance plans: in that case, he would be using a domain name almost identical with the Complainant's Rights in order to compare the Complainant's products with third parties, possibly unfavourably. This again would have the effect of unfairly disrupting the Complainant's business by using a domain name almost identical with its Rights in order to compare it with third party businesses offering rival products.

Finally, a further point is that the Respondent, with an address in Florida, USA, does not seem to have a particular need to have a .uk website providing pet insurance provider comparisons.

For these reasons, I consider that the Domain Name is an Abusive Registration under paragraph 5.1.1.3 of the DRS Policy.

Paragraph 5.1.6

This paragraph states,

“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.”

The requirement is for an exact match - of course paragraph 5.1 as a whole is a non-exhaustive list, not a precise list to be applied like a regulation. However, I find that the intention behind this paragraph is to catch exact correspondence between the Domain Name and the Rights (allowing for differences dictated by the character set), not a close similarity.

I do not find Abusive Registration proved under this paragraph.

Paragraph 8 factors

The Respondent is entitled to point to factors which may evidence that the Domain Name is not an Abusive Registration. This is dealt with in paragraph 8 of the DRS Policy.

I have already referred to paragraph 8.4, which states that simply dealing in domain names is not of itself illegitimate. Equally, paragraph 8.5 provides that simply selling traffic is not necessarily objectionable.

Paragraph 8.1 contains a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. Looking through these,

- i. there is no evidence that the Respondent was making any preparations connected with a genuine offering of goods or services;
- ii. there is no evidence that the Respondent had any connection with a name or mark similar to the Domain Name;
- iii. the Domain Name could be said to be generic or descriptive, but the actual use being made of it is not a fair use, as I have found that the Respondent registered it with a view to selling it for an inflated profit either to the Complainant or to some competitor of the Complainant and any use as a product comparison site would be making unfair use of the Domain Name.

I have concluded therefore that there are no factors indicating that the Domain Name is not in fact an Abusive Registration in the Respondent’s hands.

7. Decision

I find that the Complainant has Rights and that the Domain Name in the Respondent's hands is an Abusive Registration. I order that the Domain Name should be transferred to the Complainant.

Signed Richard Stephens

Dated 12 February 2020