

DISPUTE RESOLUTION SERVICE

D00022198

Decision of Independent Expert

The Royal Bank of Scotland Group plc

and

Tulip Trading Company Limited

1. The Parties

Complainant: The Royal Bank of Scotland Group plc
Edinburgh
United Kingdom

Respondent: Tulip Trading Company Limited
Nevis
Saint Kitts and Nevis

2. The Domain Name

<businessbankingswitchrbs.co.uk>

3. Procedural History

07 January 2020 05:55 Dispute received
07 January 2020 12:55 Complaint validated
07 January 2020 13:02 Notification of complaint sent to parties
24 January 2020 01:30 Response reminder sent
29 January 2020 17:48 No Response Received
31 January 2020 14:13 Notification of no response sent to parties

03 February 2020 13:27 Expert decision payment received

The Expert has confirmed that he is independent of each of the parties. 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.

The Complaint in this case falls to be determined under the terms of the Nominet.UK Dispute Resolution Service Policy (“the Policy”).

4. Factual Background

The Complainant is a United Kingdom (“UK”) public limited company which provides banking and financial services in various countries worldwide.

The Complainant is the owner of several registrations for the trade mark RBS, including UK trade mark number 2004617 for the word mark RBS, registered on 23 November 1994 for goods and services including banking and financial services in numerous classes.

The Complainant offers a business banking switching service, which it has promoted since February 2019 from a website at “www.businessbankingswitch.rbs.co.uk”.

The Domain Name was registered on 1 May 2019.

The Domain Name has resolved to a “parking page” website at “businessbankingswitchrbs.co.uk” which appears to offer links to bank and bank account switching services.

5. Parties’ Contentions

The Complainant

The Complainant states that it was founded in Edinburgh in 1727 and is one of the oldest banks in the UK. It currently employs approximately 70,000 individuals serving 18.9 million customers around the world and reported an operating profit of GBP 3.4 billion in 2018.

The Complainant provides evidence of various UK trade mark registrations for RBS and of its activities from a number of websites whose URLs include the term “rbs”, including “www.rbs.com”, “www.personal.rbs.co.uk” as well as the site at “www.businessbankingswitch.rbs.co.uk” referred to above.

The Complainant submits that, as a result of the above activities and otherwise, its trade mark RBS is both distinctive and widely known.

The Complainant submits that it has Rights (as defined in the Policy) in respect of a name or mark which is identical or similar to the Domain Name. It contends in particular that the Domain Name includes the mark RBS as its distinctive element and that the terms “business”, “banking” and “switch” are generic and do not negate the confusing similarity between the trade mark and the Domain Name. The Complainant contends that the fact that these terms refer to banking services similar to those offered by the Complainant further increase the likelihood of confusion.

The Complainant submits that the Domain Name in the hands of the Respondent is an Abusive Registration (as also defined in the Policy). It states that it has not permitted the Respondent to use its RBS trade mark, that the Respondent has no rights in and has not commonly been known by that mark, and that the Respondent could not make any legitimate use of the Domain Name. On the contrary, the Complainant contends that it is obvious that the Respondent was aware of the Complainant’s “businessbankingswitch.rbs” sub-domain and deliberately registered the Domain Name in order to trade off the Complainant’s goodwill.

The Complainant contends that the Respondent’s use of the Domain Name for a “parking page” is not legitimate use in circumstances where it is seeking to take unfair advantage of the Complainant’s goodwill. It further submits that the Domain Name, containing as it does the Complainant’s RBS mark, is bound to cause “initial interest confusion” to Internet users: in particular, Internet users are liable to be drawn to the Respondent’s revenue-generating website as a result of an assumed association with the Complainant’s trademark.

The Complainant further submits, for the purpose of paragraph 5.3 of the Policy, that the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the two years before the Complaint was filed and there should therefore be a presumption of Abusive Registration in this case. Those cases are:

- *Carsmart Oxford v. Tulip Trading Company Limited*, DRS Case No. D21325, Summary Decision in favour of the complainant decided 29 May 2019
- *Lovisa UK v. Tulip Trading Company Limited*, DRS Case No. D21433, Summary Decision in favour of the complainant dated 9 July 2019
- *Websters of Stoke on Trent Limited v. Tulip Trading Company Limited*, Summary Decision in favour of the complainant dated 24 October 2019

The Complainant requests a transfer of the Domain Name.

Respondent

The Respondent has not filed a Response in this case or otherwise replied to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 2 of the Policy:

"2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration

2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities."

Under paragraph 1 of the Policy the term "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."

Also under paragraph 1 of the Policy, the term "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 was unfairly detrimental to the Complainant's Rights."

Paragraph 5 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has established that it is the owner of UK trade mark registrations for the mark RBS for banking and financial services. The Domain Name is <businessbankingswitchrbs.co.uk>. The Expert finds that the Complainant's mark RBS is discernible within the Domain Name and that it is a distinctive element of that name, being used in conjunction with dictionary terms relating to business banking.

The Expert therefore finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

Abusive Registration

The Expert accepts the Complainant's submission that the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the two years before the Complaint was filed and there should therefore be a presumption of Abusive Registration in this case.

While the Respondent may rebut the presumption of Abusive Registration, the Respondent has made no reply to the Complainant's submissions and the Expert can see no basis upon which the presumption should not be upheld in this case.

On the contrary, the Expert notes in particular the similarity between the Complainant's URL "www.businessbankingswitch.rbs.co.uk" and the Respondent's website to which the Domain Name resolves at "www.businessbankingswitchrbs.co.uk", which differs from the Complainant's URL only by the dot before the term "rbs". In the view of the Expert, it is inconceivable that this similarity is coincidental and the Expert readily infers that the Respondent registered and has used the Domain Name in the knowledge of the Complainant's trade mark and URL and with the intention of taking unfair advantage of the Complainant's goodwill. The Expert finds in particular that that the Domain Name constitutes an impersonation of the Complainant and that the Respondent is using 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 (paragraph 5.1.2 of the Policy).

The Expert therefore finds that the Domain Name in the hands of the Respondent is an Abusive Registration.

7. Decision

The Expert has concluded 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. The Complaint therefore

succeeds and the Expert directs that the Domain Name,
<businessbankingswitchrbs.co.uk >, be transferred to the Complainant.

Steven A. Maier
Independent Expert

7 February 2020