

Nominet UK Dispute Resolution Service

DRS 7578

DECISION OF THE INDEPENDENT EXPERT

F-Secure Corporation (PLC) v Global Publications Ltd

1 Parties

Complainant's Details

Complainant Type: Business
Complainant: F-Secure Corporation (PLC)
Address: F-Secure Oyj
PL 24 FIN-002231
Espoo
Country: Finland

Respondent's Details

Respondent: Global Publications Ltd
Address: Chancery Pavilion
Boycott Avenue
Oldbrook
Milton Keynes
Buckinghamshire
Postcode: MK6 2TA
Country: GB

2 Disputed Domain Names

fsecure.co.uk ('the Domain Name')

3 Procedural Background

3.1 The Complainant lodged the complaint with Nominet on 28 July 2009. Nominet contacted the Registrant and the Complainant's representative advising that a complaint had been received and requesting the Registrant to respond.

- 3.2 A response to the complaint from the Respondent was received by Nominet on or before 18 August 2009.
- 3.3 A reply to the response from the Complainant was received by Nominet on or before 25 August 2009.
- 3.4 The Complainant paid the fee for expert determination and on 5 October 2009 following a conflict check Margaret Briffa was appointed from the panel of experts.
- 3.5 To the best of my knowledge, there is no outstanding formal procedure in this dispute.

4 Factual Background

- 4.1 The Complainant is a company publicly traded on the Helsinki Stock Exchange chiefly concerned with developing anti-virus and security software for computers. The Complainant was established in 1988 and has operated an office in England (F-Secure (UK) Ltd) since 1999.
- 4.2 The Respondent is a UK company which owns a large portfolio of domain names. The Respondent registered the Domain Name on 6 June 2004. The Respondent did not have any licence or authorization from the Complainant to register the Domain Name either on the date of registration or otherwise.
- 4.3 The Complainant is the owner of trade marks which incorporate the word "F-SECURE". These include Community Trade Marks 3764041 (priority date: 26 April 2004) and 000731950 (priority date: 16 January 1998) for the word only mark "F-SECURE" (the "Word Marks"); Community Trade Mark 003765138 (priority date 26 April 2004) for the mark "F-Secure" with a logo (the "Logo Mark"); and a series of word-only marks filed through the Madrid Protocol comprising the word "F-SECURE" with designations in Australia, Switzerland, China, Korea, Russia, Singapore and Turkey with a priority date of 7 March 2006.
- 4.4 The Complainant has also registered numerous domain names and in asserting its rights in this matter has referred to fsecure.com.au, fsecure.co.at, fsecure.be, fsecure.com, fsecure.net, fsecure.co.il, fsecure.ie, fsecure.it, fsecure.no, fsecure.pl, fsecure.ro, fsecure.ru, fsecure.es, fsecure.ch, fsecure.us, fsecure.eu, fsecure.cn, fsecure.hk, fsecure.in, fsecure.mobi, fsecure.asia and fsecure.tel. The evidence provided suggests that such domains were first registered on various dates, with only fsecure.com (creation date 05-Aug-1997), fsecure.asia (IPR Applied: 2006-04-26) and fsecure.no (created 2001-06-28) appearing to have history preceding the registration of the Domain Name on 6 June 2004.
- 4.5 The Complainant has provided a screen-capture which it says reflects the website as it appeared at the Domain Name on 3 July 2009. As the Complainant states in its reply to the Respondent's response, the website related to computer products including Internet security and anti-virus software, including McAfee Antivirus software. The Respondent claims that this

screen-capture is not a true representation of the website, and came as a result of the Complainant generating the page itself by searching for a specific keyword or phrase relating to computer software or security systems. The Respondent attached to its response screenshots it says were taken from the website at the Domain Name, and states that the content shown on the website is of a generic nature relating to “loans, poker, shopping, travel, music, insurance, sport, jobs, gambling, hotels, properties, dating, social networks, celebrities, debt, music, free music downloads, mp3 players, music videos, mobile ringtones, music, CDs, shopping, mobile phones, computers, food shopping, jewellery, clothes, gambling, poker, casino, slot machines, blackjack, online betting, finance, loans, mortgages, debt management, home loans, credit cards, insurance, life insurance, health insurance, home insurance, travel insurance, pet insurance, travel, cheap holidays, travel insurance, short breaks, cheap flights and hotels”.

- 4.6 The Complainant denies the assertion in this regard by the Respondent, stating that the website at the Domain Name “clearly had computer security and antivirus software listed down the left hand side of the domain name home page”, and that because the website was constructed so that clicking a link on the left hand side of the screen would lead to text being automatically being placed in the search bar, there was no need to physically enter the material needed to generate the links contained in the screen-capture of 3 July 2009. The Complainant also alleges that the Respondent has changed the website since having notice of the complaint in an attempt to prevent a finding of bad faith.
- 4.7 Although there is some dispute as to the content which has appeared on the website at the Domain Name, the Complainant’s assertion that the website is a pay-per click website provided by DomainParking.co.uk has not been challenged by the Respondent.
- 4.8 The Complainant has also referred to a pattern of domain name registrations obtained by the Respondent corresponding to well known names and trade marks to which the Respondent “has no apparent rights”, enclosing at Exhibit 11 of its submission copies of Whois database results for these domains, screen grabs taken from websites at these domains and information relating to third party rights. Ownership of such domain names has not been denied by the Respondent, although the Respondent does make reference to other domain names it owns such as “Affiliates.co.uk” and “Market.co.uk”.
- 4.9 Finally, the Complainant makes reference to previous Nominet disputes in which the Respondent has been involved, namely *Bertelsmann AG v. Global Publications Ltd* (DRS 5815), *Lloyds TSB Bank plc v. Global Publications Ltd* (DRS 06550) and *Wagamama Limited v. Global Publications Limited* (DRS 3840). As the Complainant points out, the Respondent was unsuccessful in each of these claims.

5 The Parties’ Contentions

Complainant’s Submissions

- 5.1 The Complainant seeks transfer of the Domain Name under the Nominet Dispute Resolution Service Policy (the “Policy”). The Complainant claims that it

is the owner of Rights as defined in the Policy, referring to the Word Marks, the Logo Marks and the marks filed through the Madrid Protocol (as more particularly set out in paragraph 4.3 above) and by reference to its reputation as shown through its portfolio of domain names and its trading history (going back to 1988 and operating in England since 1999. The Claimant makes reference to numerous awards it has won (including in 2004) as further evidence of its goodwill in the name “F-SECURE”.

- 5.2 The Complainant asserts that the Domain Name is an Abusive Registration as defined by the Policy. In making this assertion, the Complainant relies on:
 - 5.2.1 The fact that the Respondent was not authorised or licensed to use the Complainant’s Rights in registering the Domain Name, and nor was there any relationship that would give rise to such permission;
 - 5.2.2 The fact that the Respondent is not known as “F-Secure” in the manner described in paragraph 4.a.i.B of the Policy;– a fact which is not disputed by the Respondent,
 - 5.2.3 An argument that the registration of the Domain Name for the purposes of generating income from a pay-per-click website cannot constitute a bona fide use or genuine offering of goods as set out in paragraph 4.a.i.A of the Policy, citing *Mattel, Inc. v. Domain Administration Limited* (DRS) 04298 in support of this contention;
 - 5.2.4 An argument that the registration of the Domain by the Respondent may be characterized as cyber squatting and as such is a “blocking registration” for the purposes of paragraph 3.a.i.B of the Policy;
 - 5.2.5 An argument that the use of the Domain Name: i. to provide links to PC repair, security software and other organizations would lead customers visiting the website at the Domain Name to wrongly believe that the Complainant is associated with, affiliated with or endorses these companies and products when this is not so; and ii. to display links to products in competition with those of the Complainant disrupts the business of the Complainant contrary to paragraph 3.a.i.C of the Policy;
 - 5.2.6 An argument that the pattern of behaviour employed by the Respondent in registering various domain names to which it does not own rights (as more particularly set out in paragraph 4.8 above) comes within the scope of paragraph 3.a.iii of the Policy; and
 - 5.2.7 An argument that the previous Nominet disputes in which the Respondent was unsuccessful as owner of the relevant domain names, whilst not of themselves being sufficient to raise a presumption of an Abusive Registration in this case (due to the date of the decision in DRS 3840 being more than three years prior to the date of the complaint in the present matter) should be given weight as evidence of an abusive registration.

Respondent

5.3 In its response, the Respondent asserts that the Domain Name was registered in good faith some 5 years ago when it was engaged in a program of purchasing domain names relating to finance such as creditloan.co.uk (registered in December 2003), crediting.co.uk (registered in January 2004) and pricedirect.co.uk (registered in January 2004). The Respondent states that it had wanted to acquire the domain financiallysecure.co.uk but that as this was already taken it opted for a shortened version in the form of fsecure.co.uk. The Respondent would argue that it follows that the Domain Name in its hands does not amount to an Abusive Registration. In particular, the Respondent relies on:

5.3.1 The use of a hyphen in the Complainant's "F-SECURE" mark in contrast to the Domain Name which includes the name "fsecure" without a hyphen;

5.3.2 An argument that the Respondent is not using the Domain Name in relation to goods and services covered by the specifications for the Complainant's trade marks, citing a conversation with an unnamed representative of the UK Intellectual Property Office in support of this contention;

5.3.3 An argument that the Complainant, having not challenged the Respondent's registration of the Domain Name for over five years, has lost rights to challenge such registration;

5.3.4 An argument that the Complainant is simply using its size to challenge the Respondent's ownership of the Domain Name, and that the word "FSECURE" could be used to denote a number of things, including "financially secure, financial security, family security, free security, fire security, film security, flight security [and] food security";

5.3.5 An argument that the registration of the domains fsecure.org, fsecure.de, fsecure.at and fsecure.dk by persons not controlled by the Complainant should prevent the Complainant from successfully obtaining the transfer of the Domain Name; and

5.3.6 An argument that a comparison of screenshots taken from home pages at the Domain Name and at the Complainant's page at f-secure.com is sufficient to decide that there is no risk of confusing the goods and services of the Complainant with those sold through the website of the Domain Name.

Complainant's Reply to the Response

5.4 In its reply to the response, the Complainant re-asserts that the ownership of the Domain Name by the Respondent amounts to an Abusive Registration. In particular, the Complainant:

5.4.1 Denies that the Domain Name was registered by the Respondent in good faith. The Complainant cites the fact that it has been trading since 1988 and that it set up its UK office in 1999, along with its contention that the Domain Name was registered as part of a pattern

of registrations corresponding to well known names and trade marks, in support of this point;

- 5.4.2 Argues that even if the Domain Name is being used for goods and services different from those covered by its trade marks, the ownership of the Domain Name by the Respondent still amounts to an Abusive Registration and that, as the Complainant is able to establish its Rights, it is entitled to the transfer of the Domain Name. In support of this assertion, the Complainant further asserts that the UK Intellectual Property Office does not have jurisdiction over this dispute;
- 5.4.3 Argues that the original homepage shown at the Domain Name showed similar goods and services to those claimed in the specification of the Complainant's trade marks and that, in any event, the issue is whether an Internet user may believe that the Complainant is associated with, affiliated with, promotes or endorses the companies linked to through the website at the Domain Name when this is not so;
- 5.4.4 Counters the argument of the Respondent that the word "FSECURE" is generic (the argument in which the Respondent alleges that the prefix "F" could be taken as reference to a variety of different words starting with the letter F) and that this was the reason for the registration of the Domain Name by the Respondent by referring to its reputation in relation to its products and to awards it has won in this regard. The Complainant also points to other Domains registered by the Respondent in 2004 such as benaffleck.co.uk, bairstowevesrecruitment.co.uk, nokia3220.co.uk, Bertelsmann.co.uk, barclaysloan.co.uk, barclaycapital.co.uk and barclaybank.co.uk as evidence that the Respondent was engaged in a pattern of registering domain names to take advantage of the intellectual property rights of third parties during 2004 and that the real reason for registering the Domain Name was to take advantage of the Complainant's goodwill rather than to purchase a financial services related domain name as alleged by the Respondent;
- 5.4.5 Argues that, despite the inclusion of a hyphen in the mark in which the Rights are claimed by the Complainant ("F-SECURE") and the lack of the hyphen in the Domain Name, the marks are identical for the purposes of the Policy and that in any event because the Complainant, as owner of a worldwide portfolio of marks without the hyphen and a reputation in the mark "FSECURE" without the hyphen as shown from a Google search for "fsecure", the Complainant is entitled to transfer of the Domain Name;
- 5.4.6 Argues that there is no doctrine of laches or estoppel for delay in Nominet disputes and that as such the Complainant is entitled to bring Nominet proceedings at any time it sees fit following its discovery of an Abusive Registration; and

5.4.7 Argues that its decision to pursue or to not pursue owners of other domain names including the word “fsecure”, including those listed in the Respondent’s response, has no impact on this dispute.

6 Discussion and Findings

6.1 In order to be entitled to the transfer of the Domain Name, the first thing the Complainant must establish is the ownership of rights. The Complainant has referred to numerous trade marks it owns, its trading history and to awards it has won in order to establish its ownership of rights. Such Rights mainly subsist in the mark “F-SECURE” (with a hyphen), and the rights subsisting in the hyphenated word mark do not appear to be challenged by the Respondent.

6.2 The Respondent has alleged that the Domain Name cannot be an Abusive Registration having regard to the Complainant’s Rights because of the inclusion of the hyphen in the marks in which the Complainant has largely claimed Rights. I do not have sympathy with the Respondent’s argument on this point. The difference between the marks and the Domain Name as embodied in hyphen (a mark of punctuation) would, in my view, be disregarded by Internet users accessing the website at the Domain Name. Accordingly, it is my view that the Domain Name can be seen as identical to the marks in which rights are claimed. If I am incorrect in this finding, the marks in which Rights are claimed are clearly similar to the Domain Name at the very least.

6.3 Having established ownership of Rights in elements included in the Domain Name, it must be established that the ownership of the Domain Name by the Respondent amounts to an abusive registration. In the present case, the Complainant has gone to great lengths to show that the Respondent is engaged in a pattern of registrations which take advantage of the intellectual property rights of third parties. Such activity may be seen as evidence of an Abusive Registration under paragraph 3.a.iii of the Policy. In this respect, I agree with the Complainant that the Respondent has been engaged in a pattern of registrations as described in paragraph 3.a.iii, having regard to the previous decisions against the Respondent and to the registration of domains highlighted by the Complainant.

6.4 Is the finding that the Respondent has been engaged in a pattern of abusive registrations enough to show that the registration of the Domain Name is an abusive registration? The Respondent counters this inference (along with the rest of the Complainant’s arguments) by reference to its motives for registering the Domain Name. The Respondent argues that it registered the domain in good faith as part of a program of registering domains relating to financial services. To this end, the Respondent cites numerous domains relating to financial services which it owns. The Respondent also cites other possible meanings for the “F” element in “FSECURE” in support of the argument that it registered the Domain Name in good faith.

6.5 I am not satisfied by the Respondent’s claim to have registered the Domain Name in good faith. The mark “FSECURE” has no ordinary meaning. Whilst the Respondent alleges that the “F” element can correspond with a number of possible meanings, I am not satisfied that the combination of the element “F” with the word “SECURE” has been used other than in relation to the goods and

services of the Complainant. In addition, the Complainant has clearly demonstrated that the Respondent habitually registers Domain Names corresponding with well known names and trade marks where it has no entitlement to do so. Accordingly, it is my finding that the Domain Name was not registered in good faith as alleged by the Respondent, but that it was registered as part of a program of registrations corresponding to well known names or trade marks in which the Respondent has no apparent rights as defined by paragraph 3.a.iii of the Policy.

- 6.6 The Complainant has also claimed that the registration of the Domain Name by the Respondent is a blocking registration as defined by 3.a.i.B of the Policy and that the ownership of the Domain Name by the Respondent disrupts the business of the Complainant contrary to paragraph 3.a.i.C of the Policy. The Complainant cites the case of Mattel, Inc. v. Domain Administration Limited (DRS) 04298 in support of the contention that the Respondent is not using the Domain Name as a bona fide offering of goods and services.
- 6.7 Following Mattel, Inc. v. Domain Administration Limited, I find that the ownership of the Domain Name by the Respondent is not a bona fide offering of goods and services. There is a factual dispute as to whether the website at the Domain Name automatically linked to goods and services of the Complainant, with the Respondent alleging that the Complainant had manipulated the website to raise the inference that the website did in fact link to such goods and services. As I am able to find for the Complainant on the argument that the registration of the Domain Name was part of a program of registrations designed to take advantage of third party rights, my finding on this point will not have a great impact on this decision. Further, as the Complainant rightly asserts, the offering of identical or similar goods on the website at the Domain Name does not exclude a Complainant's right to a transfer (although it may be relevant to the question as to whether the Domain Name is being used to disrupt the business of the Complainant).
- 6.8 On the factual dispute, it is my finding that it has been at all relevant times possible for Internet users to use the website at the Domain Name to find goods and services in competition with those of the Complainant. I further find that the ownership of the Domain Name by the Respondent may be seen as a blocking registration for the purposes of the Policy. Accordingly, I find that the ownership of the Domain Name by the Respondent amounts to an Abusive Registration under paragraphs 3.a.i.A, 3.a.i.B and 3.a.iii of the Policy.
- 6.9 In making my decision, I have read the arguments of the Respondent that the Complainant does not own certain domain names including the element "fsecure" in other jurisdictions and that the Complainant took four years to challenge the Respondent's ownership of the Domain Name. However, in the present case I can agree with the Complainant's argument that laches and estoppels may not apply (although the decision as to whether a Domain Name, if used over a long period of time, may not be an Abusive Registration even if Rights can be established if the website is used as a bona fide offering of goods and services may be different. I also agree with the Complainant that the fact that some domains in other jurisdictions are not owned by the Complainant does not impact on the present case. The Complainant has

clearly established Rights for the purposes of the Policy. It is not my view that the ownership of other domains as raised by the Respondent renders the marks in which Rights are claimed non-distinctive, and as such I do not agree with the Respondent that the Complainant should be denied the transfer of the Domain Name as sought.

- 6.10 Finally, I have considered the argument raised by the Respondent that the Complainant is using its size and reputation to wrongly obtain the Domain Name using the Policy. For my part, I am comfortable that the Complainant is not, in this case, engaging in reverse domain name hijacking. The Complainant clearly has rights in the Domain Name and has good reason for using the Nominet DRS. Accordingly, I do not take the view that there has been any bad faith in the Complainant using the Nominet DRS.

7 Decision

- 7.1 Having found that the Complainant owns Rights and that the ownership of the Domain Name by the Respondent amounts to an Abusive Registration, the Expert directs that the Domain Name is transferred to the Complainant.

Margaret Briffa

20 October 2009