

DISPUTE RESOLUTION SERVICE

D00008756

Decision of Independent Expert

Travellers Exchange Corporation Limited

and

Joe New (t/a FairFX)

1. The Parties:

Lead Complainant: Travellers Exchange Corporation Limited
65 Kingsway
London
WC2B 6TD
United Kingdom

Respondent: Joe New (t/a FairFX)
13-14 Great St. Thomas Apostle
London
Greater London
EC4V 2BB
United Kingdom

2. The Domain Name(s):

- (1) travelexexpensive.co.uk
- (2) travelexpensive.co.uk

3. Procedural History:

The Complaint was received by Nominet on 30 June, 2010. Nominet checked the Complaint and validation was confirmed on 2 July, 2010. Nominet duly sent notifications of the Complaint to the Respondent, by both letter and by e-mail on 6 July, 2010, noting that the Dispute Resolution Service had been invoked and that the Respondent had 15 days (until 27 July, 2010) to submit a Response. A Response was received by Nominet on 28 July, 2010. Nominet notified the parties accordingly on the same day, and invited the Complainant to submit a Reply by 4 August, 2010. No Reply was received. Nominet then invited the parties to consider confidential Mediation with a view to resolving the dispute. A Mediator was appointed on 5 August, 2010; Mediation then commenced on 11 August, 2010 but was ultimately unsuccessful, and the Mediation was closed on 25 August, 2010. Nominet invited the Complainant to pay the fee to obtain a Full Expert Decision pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy (“the Policy”) and Paragraph 21 of the Nominet Dispute Resolution Service Procedure (“the Procedure”). The fee for a Full Decision was duly received by Nominet on 3 September, 2010.

Nominet then invited the undersigned, Keith Gymer (“the Expert”), to provide a decision on this case and, following confirmation to Nominet that the Expert knew of no reason why he could not properly accept the invitation to act in this case and of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality, Nominet duly appointed the undersigned as Expert with effect from 7 September, 2010.

Unfortunately, the Expert subsequently had some difficulties obtaining access to all the relevant documents on the Nominet files and this has delayed the issuance of the final Decision. The Expert apologises to the parties for any inconvenience arising from this delay.

4. Factual Background

The Complainant, Travellers Exchange Corporation Limited, is part of the Travelex group of companies, which has operated a currency exchange business under the TRAVELEX name since the 1970s. It has a familiar public presence through its retail branches, in airports and tourist locations, worldwide.

The Complainant owns a large number of trade mark registrations world-wide for TRAVELEX and related marks.

It also has websites at www.travelex.com and www.travelex.co.uk.

The nominal Respondent, “Joe New (t/a FairFX)” appears to be the name of an individual acting for, or an alias for, FairFX plc, which is located at the registrant’s address and which has operated a currency exchange business in competition with the Complainant in recent years. FairFX operates a website at www.fairfx.com.

The Response has been provided by lawyers representing FairFX plc, and the dispute has proceeded on the basis that FairFX plc are effectively the beneficial owners of the

Domain Names. The references to “the Respondent” in these proceedings therefore includes FairFX plc as well as the nominee “Joe New”.

According to the Nominet WHOIS records, the Domain Names (1) travelexexpensive.co.uk and (2) travelexpensive.co.uk were both registered on 30 April, 2010.

5. Parties’ Contentions

Complainant:

The Complainant has asserted that:

1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name (Policy Paragraph 2a(i)); and
2. The Domain Name, in the hands of the Respondent, is an Abusive Registration (Policy Paragraph 2a(ii)).

In support of its case, the Complainant made extensive assertions and allegations, which are reproduced below in edited form.

The Complainant’s rights

The Complainant is the owner of goodwill, reputation and trade mark rights in the mark TRAVELEX (the “Trade Mark”) internationally. The Complainant is part of the Travelex group of companies (the Travelex Group). The Travelex Group has been operating a currency exchange business under the TRAVELEX name since the 1970s. The Travelex Group is the world’s largest retail foreign exchange specialist operating over 780 branded retail branches, principally in airports and tourist locations, worldwide. The global income of the Travelex Group in the financial year ended 31 December 2008 was £583 million.

The Travelex Group has built up a substantial reputation and goodwill in the mark TRAVELEX and the Complainant owns and has owned for a considerable number of years a large portfolio of trade mark registrations world-wide for TRAVELEX and related marks. The Complainant owns the following trade mark registrations for the mark TRAVELEX in the United Kingdom:

Mark	Country	Classes	App./Reg. No.	Date
TRAVELEX	United Kingdom	9, 35, 43	2382787	25 January 2005
TRAVELEX	United Kingdom	36	1343462	4 May 1988
TRAVELEX	United Kingdom	16	2207981	8 September 1999
TRAVELEX	United Kingdom	9, 35, 36	2520101	3 July 2009

[Print-outs of the case details for these trade marks from the Intellectual Property office website (www.ip.gov.uk) were attached to this Complaint, along with details of the Complainant’s worldwide trade mark portfolio for marks incorporating the word TRAVELEX.]

For the Complainant's registered trade mark "TRAVELEX WORLDWIDE MONEY", a particularly distinctive and identifying factor of this trade mark (see e.g. Community Trade Mark 2,392,322) is the blue, red and white colour combination, which is used in conjunction with the words TRAVELEX WORLDWIDE MONEY. This colour combination is uniquely associated with the Complainant in the field of currency exchange and is used by the Complainant and has been used by the Complainant and the Complainant's group since 2001, in particular to identify each of its retail branches and its ATM machines.

The Travelex Group operates a transactional website at the domain name www.travelex.com. This website allows the visitor to select from a number of global webpages including a page for North America at www.us.travelex.com and for the United Kingdom at www.travelex.co.uk/uk. The Complainant also uses the blue, red and white colour combination (referred to above) in the url bar for the domain name www.travelex.co.uk/uk. The Complainant and its group own numerous domain names consisting of or including "TRAVELEX".

The Domain Names are similar to the names and trade marks in which the Complainant has extensive rights. The Domain Name "travelexpensive.co.uk" consists of the word "TRAVELEX" together with the word "PENSIVE" in an attempt to create a play on words using the Complainant's trade mark TRAVELEX to indicate to English speaking internet users at least that the Complainant's services are expensive.

The Domain Name "travelexpensive.co.uk" consists of the word "TRAVELEX" together with the word "EXPENSIVE" in a direct attempt to indicate to English speaking internet users at least that the Complainant's services are expensive.

It is well-established by previous Nominet Expert decisions that a domain name incorporating a distinctive trade mark (such as the trade mark TRAVELEX in this case) in its entirety creates sufficient similarity between the mark and the domain names.

It has also been held that the addition of a generic denomination or suffix to a trade mark does not prevent a domain name from being similar to a trade mark.

We submit that this reasoning applies in this case: the addition of a non distinctive suffix "PENSIVE" or "EXPENSIVE" does not suffice to avoid similarity, particularly where the word TRAVELEX is the dominant and distinctive element of the Trade Mark and the disputed Domain Names.

It is also long established that when determining whether domain names are identical to a mark the suffix ".co.uk" can be disregarded.

We also note the broader scope of the Nominet Policy which does not require the Complainant to show "confusing" similarity, although we submit that the Domain Names are also confusingly similar to the Trade Mark.

Accordingly, and in light of the above, as a result of the Respondent's use of the Complainant's distinctive TRAVELEX mark in its entirety in conjunction with a non-

distinctive suffix, we submit that the Domain Names are similar to the Complainant's "TRAVELEX" trade marks, in satisfaction of paragraphs 2(a)(i) and 2(b) of the Policy.

Why is the domain name an Abusive Registration?

Contrary to paragraph 3(a)(i)(C) of the Policy, the Respondent has registered the Domain Names primarily for the purpose of unfairly disrupting the business of the Complainant, being a competitor of the Respondent.

Although the WHOIS search results list the Registrant of the Domain Names as Joe New, we submit that this is either a fictional name or is the name of an individual at FairFx PLC (registered UK company number 05539698), a competitor of the Complainant, and to whose website a link is provided at the website of the Domain Names. To the extent that "Joe New" exists, he therefore acts under the authority of FairFx PLC and for the purposes of this Complaint FairFx PLC should be treated as the Respondent. The Respondent has registered and uses the Domain Names to link directly to, and to route traffic to, its own website which promotes and provides products and services which compete directly with those of the Complainant and its group. The Respondent's registration and use of the Domain Names for re-directing Internet users in this way, particularly customers and potential customers of Complainants constitutes bad faith registration and use.

In the case of Apple Computer Inc -v- CyberBritain Group Ltd DRS 02223 [2005] it was held that a domain name, which redirected visitors to a competitor took unfair advantage of the Rights of the complainant in the name and was unfairly detrimental to the Rights of the complainant. In other cases also, a redirection to a competitor of the complainant has been found to be evidence for an Abusive Registration.

Contrary to paragraph 3(a)(ii) of the Policy, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its own website by creating a likelihood of confusion with the Complainant's Trade Mark as to the source, sponsorship, affiliation or endorsement of its website.

In this regard the Complainant relies on the fact that the Respondent has registered Domain Names which are confusingly similar to the Trade Mark and in which it has no legitimate interest, deliberately to attract users to its own website, to which there is a link on the website at the Domain Names. Clearly the Respondent is doing this so that the users then invest in the Respondent's services rather than the Complainant's equivalent and competing services.

The Complainant refers to its many international customers who will not necessarily understand the reference to "PENSIVE" in the first Domain Name or "EXPENSIVE" in the second Domain Name or the attempted play on words. Instead, they will land on the websites at the Domain Names, which feature the Trade Mark in the distinctive blue, red and white colour combination used by the Complainant and its group. Inevitably, they will click on the link to the Respondent's website and, given the manner in which they have been redirected to this website, will be confused into thinking that it is associated with or endorsed by the Complainant. Further, and in the alternative, even if it is obvious to internet users when they land on the website that it

is not in any way connected to the Complainant, the Respondent will have created 'initial interest confusion' which is further evidence of an Abusive Registration.

We refer to the decision of the Nominet appeal panel in *Comité Interprofessionnel du Vin de Champagne v Steven Terence Jackson*, DRS No. 4479, in which the panel stated at page 14:

“it does not assist the Respondent that an Internet user might quickly have realised that the website he had reached had no connection with Champagne or, indeed, with the Complainant. The consensus view amongst Nominet Experts is that where a registrant registers or uses a domain name so as to take advantage of “initial interest confusion”, which causes a user to visit a website expecting it to have some connection with a well-known name comprised in or constituting the Domain Name, he takes unfair advantage of the Rights in the name.”

Contrary to paragraph 3a(iii) of the Policy, the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well known trade names or trade marks in which the Respondent has no apparent rights, and the Domain Names are part of that pattern. The two Domain Names were both registered on 30 April, 2010. On the same date, FairFX PLC (effectively the Respondent in this matter) also registered the domain names www.travelexpensive.com and www.travelexexpensive.com (the “.com Domain Names”), through a company called Domains By Proxy, Inc. An administrative proceeding has been commenced by the Complainant against FairFx PLC in relation to the .com Domain Names pursuant to the Uniform Domain Name Dispute Resolution Policy and is listed as case number Case No. D2010-1056.

Accordingly, the Domain Names are part of a pattern of registrations by the Respondent, which correspond to the well-known Trade Mark of the Complainant in which the Respondent has no rights.

The webpage at both of the Domain Names and the .com Domain Names is identical. www.travelexexpensive.co.uk and both of the .com Domain Names automatically direct to www.travelexpensive.com and www.travelexpensive.co.uk directs to its own url.

The Domain Names have also been used in a way that is likely to dilute the reputation of the Trade Mark and as such is evidence of being unfairly detrimental to the Complainant's rights. The mere registration alone of the Domain Names by the Respondent and not the Complainant has meant that the Trade Mark is not as unique as it was prior to the registration of the Domain Names. This lack of uniqueness and dilution means that the Trade Mark is not acting as a guarantee of origin that the services provided in relation to the Trade Mark are provided uniquely by or with the endorsement of the Complainant and is thereby adding to the dilution of the reputation in the Trade Mark. Given the similarity between the Complainant's Trade Mark and the Domain Names, there can be no doubt that internet users, particularly international users, seeking the Complainant and its services will be drawn to the Respondent's website and the Respondent's use of the Domain Names in offering links to its own website will further dilute the Complainant's Trade Mark.

The Respondent has no legitimate interest in the Domain Names and its registration and use of the Domain Names would give rise to actions under UK and Community trade mark infringement law and would also fall foul of the Business Protection from Misleading Marketing Regulations 2008 in the UK which implemented the Comparative Advertising Directive (Directive 2006/114/EC) (the “Regulations”) and as such is further evidence of taking unfair advantage of and being unfairly detrimental to the Complainant’s rights.

The website at the Domain Names suggests that a customer will save money generally and across the board by choosing the Respondent’s services. This is evident by the line on the website, “Save money. Choose FairFx.com as your travel money provider this summer”. However, the charges for many of the Complainant’s products are cheaper than those of the Respondent and a customer would in fact save more money by using the Complainant’s products. The information on the website at the Domain Names is therefore deceptive to the average consumer in terms of the information provided which is done so deliberately to attract users to the Respondent’s products.

In the case of Lidl Belgium & Co KG v. Etablissements Franz Colruyt NV (Case C-356/04) the ECJ has stated (in respect of comparative advertising) that an advertiser cannot suggest from a selection of products that its whole range is cheaper. The use of the Trade Mark, in a play on words to suggest that the Complainant is expensive, also denigrates and tarnishes the Trade Mark and as such is further evidence of taking unfair advantage of and being detrimental to the Complainant’s rights. This is particularly so where the Respondent has deliberately used the blue, red and white colour code, synonymous with the Complainant, to reinforce its point that it is referring to the Complainant.

In the same way, the use of the Trade Mark by the Respondent takes unfair advantage of the reputation of the Trade Mark. The Respondent’s use of the Trade Mark in this opportunistic and tarnishing way goes well beyond any possible claim that it is using the Trade Mark solely to distinguish between the products of the Respondent and the Complainant and would again give rise to actions under UK and Community trade mark infringement law and would also fall foul of the Regulations.

The Respondent has appropriated the Trade Mark in which the Complainant has significant goodwill and reputation and has unfairly used the Trade Mark to promote the Respondent’s services whilst at the same time deliberately and falsely disparaging and tarnishing the services and trade marks of the Complainant.

The Domain Names were registered more than a decade after the Complainant was incorporated and several decades since the Complainant’s group started trading under the Trade Mark and the Complainant has substantial goodwill and reputation in the Trade Mark. Accordingly, in the absence of any legitimate interest in the Domain Names, the registration of the Domain Names by the Respondent and its subsequent use of them has taken unfair advantage and is detrimental to the Complainant’s rights.

The Respondent has both the requisite knowledge of the Complainant and its brand/rights and the necessary abusive intention to satisfy paragraph 3(a)(i) of the Policy.

Accordingly, the Complainant submits that the Domain Names amount to an Abusive Registration in satisfaction of paragraphs 2(a)(ii) and 2(b) of the Policy.

The Respondent has no rights or legitimate interests in respect of the Domain Names

Like the Complainant, the Respondent also operates a currency exchange business. The Complainant and the Respondent are competitors and have been since 2006. The Respondent was aware of the Complainant when it registered the Domain Names; in fact the existence and competition of the Complainant was the reason why the Respondent registered the Domain Names, as a means to unfairly take advantage of and tarnish the Complainant's rights in the Trade Mark. The Complainant has not licensed or otherwise permitted or authorised the Respondent to use its trade marks or to register a domain name incorporating any such marks.

The website at the Domain Names is comprised of one page. As the Expert will see, the website is headed by the word "travelexpensive" in blue and red colour coding on a white background with the colour coding distinctly identifying two separate words, being "travelex" and "pensive".

As set out above, this is done to create a play on words, suggesting that Travelex is expensive. Below this, and set out in much smaller and non colour coded font is the sentence "Did you know that Travelex [being a reference to the Complainant's group] charges you 5.75% to withdraw leftover cash when you get back home?" Below this is a further sentence reading "Save money. Choose FairFX.com as your travel money provider this summer", with the word "FairFx.com" being a link to the Respondent's website at www.fairfx.com.

The reasoning behind the registration of the Domain Names and the use of the website at the Domain Names in this way is quite evidently to promote the Respondent's business at the expense of its key competitor, being the Complainant and the Complainant's group. The website at the Domain Names is accordingly commercial in nature, and there is no legitimate non-commercial or fair use of the Domain Names, particularly where its intent is to divert customers to its own website for commercial gain and to tarnish the Complainant's reputation in its Trade Mark.

The Respondent cannot successfully argue that its use of the Domain Names is in connection with a genuine offering of services.

Should the Respondent try to claim that its use of the Domain Names is fair since it constitutes comparative advertising or descriptive use, we submit the following:

(a) The Respondent has no legitimate interest in the Domain Names and its registration and use of the Domain Names would give rise to actions under UK and Community trade mark infringement law and would also fall foul of the Regulations. The information at the website at the Domain Names suggests that a customer will save money across the board by choosing the Respondent's services over those of the Complainant. This much is evident by the line on the Website "Save money. Choose FairFx.com as your travel money provider this summer". However, the charges on many of the Complainant's products are cheaper than those of the Respondent and a customer would save money by using the Complainant's products. The information on the website at the Domain Names is therefore deceptive to the average consumer in

terms of the information provided which is done so deliberately to attract users to the Respondent's products. In the case of Lidl Belgium & Co KG v. Etablissements Franz Colruyt NV (Case C-356/04) the ECJ has stated (in respect of comparative advertising) that an advertiser cannot suggest from a selection of products that its whole range is cheaper.

(b) The use of the Trade Mark, in a play on words, to suggest that the Complainant is expensive also denigrates and tarnishes the Trade Mark and as such is further evidence of bad faith and non fair use of the Domain Names. This is particularly so where the Respondent has deliberately used the blue, red and white colour code, synonymous with the Complainant, to reinforce its point that it is referring to the Complainant. The use of the Trade Mark in this way by the Respondent also takes unfair advantage of the reputation of the Trade Mark. The Respondent's use of the Trade Mark in this opportunistic and tarnishing way goes well beyond any possible claim that it is using the Trade Mark solely to distinguish between the products of the Respondent and the Complainant and would again give rise to actions under UK and Community trade mark infringement law and would also fall foul of the Regulations. The Respondent has appropriated the Trade Mark in which the Complainant has significant goodwill and reputation and has unfairly used the Trade Mark to promote the Respondent's services whilst at the same time deliberately and falsely disparaging and tarnishing the services and Trade Mark of the Complainant.

The Complainant has not licensed or otherwise permitted or authorised the Respondent to use its Trade Mark or to apply for a domain name incorporating any such Trade Mark. The Respondent's name does not include "TRAVELEX" or anything similar and the Respondent is not now, nor ever has been known by, the Trade Mark.

For the reasons set out above, it is submitted that the Respondent has no rights or legitimate interests in respect of the Domain Names.

How would you like this complaint to be resolved?

Transfer

Respondent:

Why should the complaint not succeed?

Taking each relevant element of the Policy in turn:

A. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Names: (Policy, para. 2(a)(i))

The Respondent does not dispute the Complainant's rights in the Trade Mark, as defined in the Complaint. The Respondent submits, however, that the domain names are not identical or similar to the Trade Mark. The domain names are self-evidently not identical to the Trade Mark. As regards whether the domain names are similar to the Trade Mark the Respondent makes the following points:

The domain name travelexpensive.com is likely not to be read as incorporating the whole of the Claimant's mark, but as comprising the words TRAVEL +

EXPENSIVE. In fact, the Respondent submits that this is the overwhelmingly likely reading of the domain name in circumstances where there is no accessory information to indicate that the domain name is associated with the Complainant.

Moreover, on the Complainant's case, the combination of TRAVELEX + PENSIVE makes little or no sense: "PENSIVE" is a non-sequitur in this regard. The natural reading of the word travelexpensive could thus relate to a number of possible sites regarding the price of travel and not simply the Complainant's business.

The distinction between the Trade Mark and the domain names is evidenced by the fact that on a search for the Complainant's Trade Mark on both the search engines Google.com and Yahoo.com the Respondent's website is not returned as a hit in at least the first 10 pages of either of the search results.

Accordingly, the Respondent submits that the domain names are not similar to the Complainant's Trade Mark.

B. The Domain Names, in the hands of the Respondent, are Abusive Registrations: (Policy, para. 2(a)(ii))

The Policy at paragraph 3 lists a number of factors, which may be evidence that the domain names are Abusive Registrations. The Respondent contends that none of these factors are present in this case. The Complainant has attempted to rely on paragraphs 3(a)(i)(C), 3(a)(ii) and 3(a)(iii). Taking each of these in turn:

Paragraph 3(a)(i)(C):

The Respondent did not register the domain names for the purpose of unfairly disrupting the business of the Complainant but for the legitimate purpose of comparative advertising in relation to the respective offerings of the Complainant and Respondent's businesses.

The Respondent understands that the overriding purpose of the Policy is to prevent cybersquatting. Cybersquatting is not what the Respondent is engaged in, but rather fair use of the Trade Mark, within domain names not identical/similar to the Trade Mark, for the purpose of criticism and comparative advertising of the Complainant's business. In that regard, the Respondent refers to the following cases (which although WIPO decisions, the Respondent understands are persuasive, if not binding):

In *TMP Worldwide Inc. v. Jennifer L. Potter*, (D2000-0536), the domain names in dispute were being used by the respondent to criticize the complainant. The panel stated that: "As the legislative history surrounding passage of the "Anticybersquatting Consumer Protection Act" indicates, use of a mark in a domain name where the Internet site involves commentary, comparative advertising, criticism, parody, or news reporting is beyond the scope of the law. In the Panel's view, it is also beyond the scope of the Policy."

Further, in *Wal-Mart Stores, Inc. v. walmartcanadasucks.com* and *Kenneth J. Harvey (D2000-1104)* the Panel referred to the case of *Lucent Technologies, Inc. v. LucentSucks.com* where the House of Judiciary commented that the intention was to "balance the interests of trademark owners with the interests of those who would make lawful non-commercial or fair uses of others' marks online, such as in comparative advertising, comment, criticism, parody, news reporting etc..."

The Respondent believes that its use constitutes fair use. The Respondent's purpose in registering the domain names was not to disrupt the Complainant's business but to engage in legitimate comparative advertising. If it is an ancillary result of that advertising that the Respondent attracts customers to its business that might otherwise have used the Complainant's business then that must, in the Respondent's respectful submission, be merely a legitimate consequence of legitimate and fair comparative advertising. The Respondent believes that it cannot properly be the case that the Complainant is protected from legitimate competition by a prohibition on the use of domain names not identical (and we say not similar) to the Complainant's Trade Mark where there exists no likelihood of confusion, as referred to below.

Paragraph 3(a)(ii):

As to the issue of confusion, the Respondent does not believe that it is using the domain names in a way which has confused or is likely to confuse people as to the origin of the domain names or related website.

In so far as the domain names are recognized by sophisticated consumers as a reference to the Complainant's business and the descriptive term 'EXPENSIVE' (which is denied), the Respondent believes there will in any event be no confusion as to the source of the website. Sophisticated consumers who recognize the play on words contained within the domain names will not associate the Complainant with domain names consisting of the Trade Mark and negative commentary on the Complainant's business. In that regard, the Respondent refers to the decisions of *Lockheed Martin Corporation v Dan Parisi (D2000-1015)*, *McLane Company, Inc. v. Fred Craig (D2000-1455)* and *America Online, Inc. v. Johuathan Investments, Inc., and Aollnews.com (D2001-0918)*.

It will be clear to consumers that the domain names relate to a site containing a critique of the Complainant's advertising claims.

Confusion is particularly unlikely in circumstances where, as mentioned above, on a search for the Complainant's Trade Mark on both the search sites Google.com and Yahoo.com the Respondent's website is not returned as a hit in at least the first 10 pages of either of the search results. Speculative searchers for the Complainant's website will not, therefore, be confused into thinking that the Respondent's website is what they were looking for.

Moreover, and critically, the Respondent notes that the Complainant has provided no evidence of actual confusion.

Accordingly, and in summary, the Respondent submits that the domain names are not being used in a way that will confuse consumers as to the origin of the domain names or the related website, given: (i) the domain names are not identical/similar to the Trade Mark; (ii) there are multiple ways to interpret the domain names such that the Trade Mark is not a recognized part; (iii) sophisticated consumers recognizing the play on words will not in any event associate the Complaint with domain names with negative connotations; (iv) a search for the Complainant's Trade Mark on the best known search engines does not return a hit for the Respondent's website; and (v) the Complainant has offered no evidence of actual confusion.

Paragraph 3(a)(iii):

The Respondent is surprised by the Complainant's assertion at paragraph 2(d) of its Complaint that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well known trade names. The Complainant relies in this regard on the Respondent's registration of the domain names *travelexpensive.com* and *travelexexpensive.com*, which are the .com equivalents of the domain names in dispute in these proceedings. The .com domain names resolve to the same website as the .co.uk domain names and are part of the same comparative advertising exercise explained above.

In the Respondent's respectful submission, this is patently not what the Policy was intending to cover in paragraph 3(a)(iii). Paragraph 3(a)(iii) is intended to deal with circumstances where respondents register multiple domain names relating to multiple different well-known trade names or trade marks. The Respondent believes that this submission by the Complainant is hopeless and indicates that the Complainant does not have confidence in its Complaint but is attempting to "throw the kitchen sink" into the mix to bolster its chances.

Other relevant factors to this dispute:

The context to the dispute between the parties is also relevant for the Expert. The parties are commercial rivals in the currency exchange market. The Respondent has repeatedly objected to a variety of the Complainant's advertising claims about both itself and the Respondent, including, in particular: (i) the claim that the Complainant charges "0%" commission on its transactions; and (ii) the claim that the Respondent charges a withdrawal fee on all ATM withdrawals in South Africa.

As a result of the above, the Complainant wrote to the Respondent on 14 May 2010 complaining about the website and domain names at issue in these proceedings. The Respondent responded on 26 May 2010 dismissing the Complainant's claims on legal grounds, and putting the dispute in a proper commercial context and asking for the Complainant to clarify its claims regarding the Respondent.

When looking at this matter, the Expert should note that the parties have engaged in "tit for tat" claims regarding each other's comparative advertising claims. What the Complainant is seeking to do by making this complaint is to muffle legitimate criticism of its advertising claims by dispossessing the Respondent of the legitimate means it is using to make those criticisms and communicate its views to the public.

The Complainant also makes great efforts in its submissions to suggest that the content of the website is deceiving and/or tarnishes the Trade Mark. Neither of these assertions by the Complainant is supported by the law or the facts:

As to the Respondent's alleged intent to tarnish the Trade Mark, there is no such intent. The Respondent's only intention is to pursue legitimate and fair comparative advertising, to draw to consumers' attention the differences between the two parties. The Respondent refers to *Britannia Building Society v. Britannia Fraud Prevention*, (D2001-0505) which states that:

“Tarnishment in this context refers to such unseemly conduct as linking unrelated pornographic, violent or drug-related images or information to an otherwise wholesome mark. See, e.g., *Nicole Kidman v. John Zuccarini d/b/a Cupcake Party*, WIPO Case No. D2000-1415 (January 23, 2001); cf. *Etam, plc v. Alberta Hot Rods*, WIPO Case No. D2000-1654 (January 31, 2001)”.

Patently, that is not the case in this matter.

As to the allegedly deceptive content of the website, the Respondent does not see how the Complainant can sensibly claim that to be the case. The content of the website is extremely limited and concentrates on one rate of interest charged on a particular transaction (namely UK ATM withdrawals). The specific transaction in question is stated clearly in the footnote.

The Complainant also seeks to say that the Respondent's use of the domain names would give rise to actions under UK and Community trade mark law. The respondent respectfully points out that the Complainant has not issued any such actions. The Respondent, of course, specifically denies that the registration and use of the domain names constitutes trade mark infringement. Notwithstanding that fact, the Respondent refers the Expert to the decision in *FirstRungNow Ltd and Paul Holmes (DRS 07175)* in which the Expert stated:

“As... considered in the *Deutsche Telecom AG v Lammtara Multiserve Limited (DRS 05856)* Appeal Decision, Expert Decisions are determined by reference to Nominet's DRS Policy and not the law in respect of trade mark infringement. While the Policy is intended to represent a quick and cost-effective alternative to litigation, the Policy and the law of trademark are not interchangeable. Not all abusive registrations under the Policy will necessarily constitute trademark infringement and not all trademark infringements constitute abusive registration under the Policy.”

The Respondent submits that the Complainant's claims in this regard are therefore wholly irrelevant.

In summary, therefore, the Respondent submits that its registration and use of the domain names do not constitute Abusive Registrations under the Policy. The Respondent is using the domain names fairly for the purposes of comparative advertising and criticism. The Complainant's complaint is simply an attempt to withdraw the means used by the Respondent to put forward its claims in the ongoing “tit for tat” battle. The Respondent seeks to distinguish itself from the Complainant,

not associate itself with them. There is no confusion; there is no intention to mislead and there is no intention to tarnish the Trade Mark.

The Respondent refers again to the decision in FirstRungNow Ltd and Paul Holmes (DRS 07175), in which the expert stated that: "Abusive Registration connotes culpable behaviour akin to deliberate wrongdoing...". There is categorically no intention by the Respondent to do anything other than fairly to use the domain names for the purposes of comparative advertising and criticism and neither the registration nor use of the domain names have taken unfair advantage or been unfairly detrimental to the Complainant's rights.

The Respondent respectfully requests the Expert to deny the remedies requested by the Complainant.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it 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 as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant in this case has asserted that it has Rights in the trademark TRAVELEX, and has provided ample supporting evidence of many trade mark registrations for the mark in various forms. These include plain text and figurative marks and marks with TRAVELEX in combination with other terms, such as WORLDWIDE MONEY.

The Respondent has expressly acknowledged that it does not dispute the Complainant's rights in TRAVELEX as such.

The Domain Names at issue are (1) travelexexpensive.co.uk and (2) travelexpensive.co.uk.

The Complainant does not claim any registered rights in TRAVELEXEXPENSIVE or TRAVELEXPENSIVE as such, but it is perhaps pertinent in this context to note that it does have a Canadian registration for TRAVELEXTRA, details of which were included in the evidence submitted with the Complaint.

In the first case, the unique part of the Domain Name (1) travelexexpensive.co.uk will be straightforwardly read as "TRAVELEX expensive". In the second, (2) travelexpensive.co.uk, the Respondent argues that the natural reading will be as "Travel expensive" and that the alternative reading as "TRAVELEX pensive" supposedly "makes little or no sense" in this regard.

The Expert finds such arguments unconvincing. Both Domain Names contain the whole of the Complainant's familiar TRAVELEX mark in the primary position at the beginning of each Domain Name. The marks are not separated by a hyphen or underscore from the other elements of the Domain Names.

In the Expert's view, the Domain Name (1) `travelexexpensive.co.uk`, will be seen unambiguously to comprise the element "travelex" – identical to the Complainant's mark "TRAVELEX" - with the ordinary descriptive word "expensive". The Domain Name is substantially similar to the name and mark in which the Complainant has Rights and the condition 2(a)(i) of the Policy is plainly satisfied.

With respect to the Domain Name (2) `travelexpensive.co.uk`, the Expert first read this himself as comprising "Travelex+expensive", and only noticed the missing extra "ex" on a second inspection. Where there is no space or other dividing element to separate the words the eye and brain will commonly perceive (or misperceive) the most familiar answer, which matches knowledge and experience, just as when dealing with apparent anomalies in an optical illusion. And that is the case with "travelexpensive". It is precisely because the word "pensive" is uncommon, and looks meaningless, that a reader familiar with the Complainant will also read this Domain Name as a simple concatenation of "Travelex+expensive", as "travel(ex)pensive". (This is, no doubt also what the Complainant itself intended by its mark TRAVELEXTRA", referred to above.)

The Expert acknowledges that it is certainly possible that some readers not actually looking for the Complainant's TRAVELEX business, might well read the second Domain Name as "travel+expensive", but that is not the only reasonable option and, in the Expert's view, it is certainly not the option the Respondent intends or intended. The Respondent's use of "travelexpensive" in this Domain Name is surely a clever illusion and allusion in the context of its expressed competitive intentions toward the Complainant. In that context, and given the nature of the Respondent's own presentation of the wording in different colours on the website as "**travelexpensive**" (i.e. with the "travelex" in dark blue and the "pensive" in red), the Expert finds the Respondent's arguments that this Domain should not be considered similar to TRAVELEX to be somewhat disingenuous.

The Policy only requires a finding of similarity (rather than the "confusing similarity" required for the UDRP).

The Respondent's case is not assisted by the argument that the Domain Names cannot be considered similar because of the apparent low ranking of the associated websites in Google search results. That would seem more likely to indicate a lack of success in Search Engine Optimisation on the part of the Respondent. A failure in such respect is not relevant to a finding of similarity for the purposes of the Policy.

On balance, therefore, the Expert holds that under the Policy, the Domain Name (2) `travelexpensive.co.uk` is also to be considered similar to the name and mark in which the Complainant has Rights and the condition 2(a)(i) of the Policy is satisfied for both Domain Names in this dispute.

Abusive Registration

The Complainant also has to show that the Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines “Abusive Registration” as a Domain Name which either:

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

has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant’s submissions and supporting evidence, the Complainant argues that at least the following examples are potentially applicable in this case:

3a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - ...
 - C. for the purpose of unfairly disrupting the business of the Complainant;
- ii. Circumstances indicating 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;
- iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

...

Paragraph 4 of the Policy conversely provides various examples of factors, which may be evidence that a Domain Name is not an Abusive registration.

The Respondent’s case would appear to be that the following factors may apply:

4a.i.C. [The Respondent has] made legitimate non-commercial or fair use of the Domain Name.

4a.ii The Domain Name is generic or descriptive and the Respondent is making fair use of it.

4.b Fair use may include sites operated solely in tribute to or in criticism of a person or business.

The factors listed in Paragraphs 3 and 4 of the Policy are only intended to be exemplary and indicative. They are not definitive. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

The Respondent claims that its registration and use of the Domain Names was and is “for the legitimate purpose of comparative advertising in relation to the respective offerings of the Complainant and Respondent's businesses”.

The Respondent asserts the belief that “the overriding purpose of the Policy is to prevent cybersquatting”, and that it is not cybersquatting.

The Expert would point out that the Policy is not so limited, and is intended to address “Abusive registration”, in which registration and/or use “took unfair advantage of or was unfairly detrimental to the Complainant’s Rights”.

In the Expert’s opinion, on the evidence of the website accessed via the Domain Names, the Respondent’s use cannot be classified or excused as legitimate “comparative advertising”. There is no objective comparison of each side’s relevant offerings. There is perhaps, as the Respondent also describes it, an implied “critique of the Complainant’s advertising claims”:

travelexpensive

Did you know that Travelex charges you 5.75% to withdraw leftover cash when you get back home?

The Expert considers that manner of use of the Domain Names in this context, may more accurately be characterised as “bait and switch”.

The Respondent is using the Domain Names incorporating the Complainant’s name and mark TRAVELEX to act as a bait to attract web surfers to a website which raises questions about the alleged costs of the Complainant’s services and then invites the surfer to “Choose [FairFX.com](#) as your travel money provider this summer”, with an associated link to the Respondent’s website.

This is not a genuine comparative advertisement. There is no comparison, just an enticement to switch to “FairFX” when a surfer has swallowed the bait provided by means of the use of TRAVELEX in the Domain Names.

The Respondent has made much of selective quotations extracted from several earlier decisions, predominantly under the UDRP, where use of various domain names incorporating other parties’ trademarks was excused, mainly on the grounds of fair use for criticism. Typically, the cases cited by the Respondent related to so-called “sucks” domains and such like. With the possible exception of “fucknetscape.com”, the domains concerned all appeared to be used solely for personal criticisms and

clearly non-commercial purposes. In contrast, the Respondent's use is overtly commercial and not purely for critical purposes. Having reviewed the cited decisions, in any event, the Expert does not accept that they are relevant to the facts of this dispute.

The Respondent also appears to suggest that the registration and use of the Domain Names should be excused as part of "tit-for-tat" exchanges between the parties and that the Complainant is attempting to "muffle legitimate criticism of its advertising claims by dispossessing the Respondent of the legitimate means it is using to make those criticisms and communicate its views". To the Expert, that is a misleading assertion. The Complainant is objecting to misuse of its name and mark, and the use of the Domain Names is not necessary for the purposes of the comparative advertising the Respondent claims to have as its objective.

The Respondent has also argued that there is no abuse because there is no evidence of actual confusion. The Expert notes that confusion *per se* is not a requirement of the Policy.

An "Abusive registration", is one in which registration and/or use "took unfair advantage of or was unfairly detrimental to the Complainant's Rights".

In the Expert's view, the Respondent's conduct, as described above, falls squarely within the Policy's definition of an Abusive Registration (for both Domain Names) by taking unfair advantage of and being unfairly detrimental to the Complainant's Rights.

7. Decision

Having concluded that the Complainant does have Rights in respect of a name or mark, which is similar to each of the Domain Names, and that each of the Domain Names, in the hands of the Respondent, is an Abusive Registration, the Expert determines that the Domain Names (1) travelexexpensive.co.uk; and (2) travelexpensive.co.uk; should be transferred to the Complainant.

Signed
KEITH GYMER

Dated: 13 October, 2010