

Norton Finance (UK) Limited -v- James Robinson

Nominet UK Dispute Resolution Service

DRS 05265

Norton Finance (UK) Limited -v- James Robinson

Decision of Independent Expert

1. Parties:

Complainant: Norton Finance (UK) Limited
145 Wellgate
Rotherham
South Yorkshire
S60 2NN

Respondent: James Robinson
17 Alastair Crescent
Prenton
Wirral
CH43 0UR

2. Domain Name:

wwwnortonfinance.co.uk ("the Domain Name")

3. Procedural Background:

The Complaint was received by Nominet on 22 November 2007. Nominet validated the Complaint and sent a copy to the Respondent.

No Response was received by Nominet.

On 28 December 2007 the Complainant paid Nominet the required fee for a decision of an Expert pursuant to the Nominet UK Dispute Resolution Service Policy ("the Policy").

Nominet invited the undersigned, Jason Rawkins ("the Expert"), to provide a decision on this case and duly appointed the undersigned as the Expert with effect from 11 January 2008.

4. The Parties' Contentions:

Complainant:

The Complainant's submissions can be summarised as follows:

1. The Complainant has rights in trade marks/names which are identical or similar to the Domain Name:

- (1) The Complainant owns UK trade mark registration number 2374663, filed on 2 October 2004, for the word marks NORTON FINANCE and NORTON (in series).

- (2) The Complainant was incorporated on 4 January 1988 and commenced carrying on the business of finance brokerage in the UK under the name "Norton Finance" around that time.
- (3) The Complainant operates its main websites at *www.nortonfinance.com* and *www.nortonfinance.co.uk*. Between 15 September 2006 and 31 December 2006 there were 1,129,918 visits to the latter website. In 2007, up to the date when the Complaint was filed (21 November 2007), there were 4,007,112 visits and 54,394,821 page impressions recorded.
- (4) The Complainant is registered with the Finance Industry Standards Association and is a member of the Association of Finance Brokers. In an average month it receives approximately 9,000 customer applications for loans totalling over £200 million and arranges loans totalling over £21 million for over 1,000 customers.
- (5) The Complainant's turnover for the years ending 2003, 2004 and 2005 was £10,731,806, £9,372,350 and £12,069,000 respectively.
- (6) During the period between 2004 and 2006, over £50 million was spent marketing the "Norton Finance" name. The marketing has included advertising in national and trade newspapers, magazines and directories, television campaigns and internet advertising.
- (7) In light of the above, the Complainant relies on its trade mark registration. It also relies on common law rights, having acquired substantial reputation and goodwill relating to the "Norton Finance" and "Norton" names by virtue of its extensive trading and marketing activities.
- (8) The Domain Name is similar to the Complainant's Norton Finance and Norton trade marks, disregarding the *.co.uk* suffix. The Domain Name differs only by the inclusion of the generic abbreviation "www" for the world wide web. It is also similar to the Complainant's Norton name as the only further difference is the descriptive word "finance".

2. The Domain Name is an Abusive Registration in the hands of the Respondent:

- (1) As at 18 January 2006, there was a website available at the Domain Name comprising a directory of affiliate links to financial service websites, including websites offering loans competing with the Complainant, as well as a link to the Complainant's own website *www.nortonfinance.co.uk*.
- (2) The Complainant's solicitors sent a cease and desist letter to the Respondent's address on 25 January 2006. No response was received. A reminder letter was sent by post on 6 February 2006, and again no response was received.
- (3) The Respondent has been found guilty of abusive registration in at least one previous Nominet DRS case: National Westminster Bank plc -v- James Robinson (DRS 03377) in relation to the domain name *natwestcreditcards.co.uk*.
- (4) The Respondent also owns numerous other domain names reflecting well-known trade marks, including *halifax.co.uk*, *halyfax.co.uk*, *mbna-cards.co.uk*, *mbna-creditcards.co.uk*, *eegg.co.uk* and *sainsburys-bank.co.uk* (a print-out of the website at *www.halyfax.co.uk* being exhibited to the Complaint, as well as a list of the Respondent's other financial services-related domain names mentioned in the decision in DRS 03377).

- (5) The Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its trade marks.
- (6) The Respondent registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant (see paragraph 3aiC of the Policy).
- (7) The Respondent was clearly aware of the Complainant and its business when it registered the Domain Name. It is clear from the following that the Respondent had the Complainant and its business in mind when registering and using the Domain Name:
 - (a) the Respondent has not denied this assertion by the Complainant;
 - (b) the Domain Name comprises the Complainant's distinctive trade mark and it is inconceivable that the Respondent registered the Domain Name independently of that trade mark;
 - (c) the Domain Name is explicable only as a deliberate misspelling of the address of the Complainant's website;
 - (d) the purpose in registering and using the Domain Name in relation to financial services can only have been to target the Complainant's business; and
 - (e) the website at the Domain Name includes links to the Complainant's own website.
- (8) The Respondent has also engaged in a pattern of similar behaviour relating to Domain Names (see paragraph 3aiii of the Policy). The Respondent has been found to have acted abusively in at least one previous DRS complaint concerning a domain name reflecting another well-known trade mark (DRS 03377). The Respondent also owns (or owned) numerous other domain names reflecting well-known trade marks and in which the Respondent has no apparent rights (see above). The Domain Name is part of this pattern because the Respondent's domain names are similar to (including misspellings of) well-known businesses which have a substantial internet presence including many in the financial services sector. In addition, the domain names resolve to the same "Pocket Lolly" affiliate website as the Domain Name does. In DRS 03377, the Respondent's financial services-related domain names were held to have been an abusive pattern.
- (9) In using the Domain Name the Respondent has intended to confuse the public into believing that the Domain Name was connected with the Complainant. Such use should suffice for the purposes of paragraph 3aii of the Policy, whether or not there is evidence of actual confusion. In any event, such intention is a factor evidencing an abusive registration independently of paragraph 3aii. The website at the Domain Name is essentially a scheme adopted by the Respondent to confuse, attract and profit from internet users who omit the dot after "www" when typing the Complainant's trade mark into search engines, web browsers and otherwise on the internet. This has not been denied by the Respondent. Furthermore, the Domain Name appears prominently at the top of the website home page, thereby adding to likely confusion on the part of internet users.
- (10) The Respondent had a motive to attract the Complainant's business. The Respondent was clearly intent upon commercial gain by means of affiliate/

sponsored links and advertising. It is difficult to conceive that the Respondent would engage in a scheme such as this for a non-commercial purpose.

- (11) The Complainant also relies on the fact that the Respondent has not responded to, let alone denied, the assertions of abusive registration in the pre-action communications by the Complainant. It is reasonable to assume that, if the Respondent did have legitimate purposes in registering and using the Domain Name, he would have said so.

Respondent:

No Response has been filed by the Respondent.

5. **The Facts:**

The Nominet Records show that the Domain Name was registered on 9 June 2004.

Based on the Complainant's submissions and a review of the materials annexed to the Complaint, set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- (1) The Complainant owns a UK trade mark registration for the word marks NORTON FINANCE and NORTON.
- (2) The Complainant has traded on a significant scale under the "Norton Finance" name for several years, and has spent a substantial amount on promoting itself under that name. As a consequence, the Complainant has established goodwill, and therefore unregistered trade mark rights, in the "Norton Finance" name.
- (3) The Domain Name directs to a website consisting of links to various financial services websites, including websites of business which compete with the Complainant.
- (4) The Respondent owns numerous other domain names which incorporate well-known third party trade marks.

6. **Discussion and Findings:**

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).*

Complainant's Rights

Based on the above, it is clear that the Complainant has rights in the "Norton Finance" name. Disregarding the generic .co.uk suffix, the Domain Name is very similar to the Norton Finance name, the only difference being the "www" prefix.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the 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 has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The factors under paragraph 3a on which the Complainant relies in this case are 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 the Domain Name in a way which has confused 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;"*

The Domain Name directs to a website containing links to financial services-related websites directly competing with the Complainant. Paragraph 3a(ii) of the Policy (set out above) refers to actual confusion having occurred, namely people or businesses having believed that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. Nevertheless paragraph 3 is a non-exhaustive list of factors. It has been held in previous Nominet decisions that a likelihood of such confusion arising in the future is also relevant, and I agree with this.

The question is whether the Respondent's use of the Domain Name has caused such confusion, or is likely to do so in the future. The fact that the Respondent is using the Complainant's name to direct visitors to competing websites means, on the balance of probabilities, that it will already have caused confusion to occur and/or that it will occur in the future, whether just "initial interest confusion" or also confusion of a more long-lasting nature. As a consequence, paragraph 3a(ii) of the Policy applies.

The Complainant also relies on paragraph 3a(iii). The Respondent has registered a significant number of .co.uk domain names and several of these are very similar to well-known third party trade marks (including several in the financial services field). The Respondent has no apparent rights in such marks and has not availed himself of the opportunity to make any submissions to the contrary. The Respondent has also had at least one decision made against him under the Nominet dispute resolution service (DRS 03377). Taking all of this into account, I find that the Respondent is engaged in a pattern of registrations of the nature described under paragraph 3a(iii) of the Policy, and

that the Domain Name is part of that pattern. I note that the expert reached the same view in the DRS 03377 case.

Because of the findings which I have made, it is clear to me that the Domain Name was registered, and has been used, in a manner which took unfair advantage of, and/was unfairly detrimental to, the Complainant's Rights; and that it is therefore an Abusive Registration.

7. Decision:

Having found that the Complainant has rights in respect of names which are identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *wwwnortonfinance.co.uk* be transferred to the Complainant.

Jason Rawkins

15 January 2008