

DISPUTE RESOLUTION SERVICE

D00012271

Decision of Independent Expert

FIL Limited

and

Ms Kathleen Gillespie

1. The Parties:

Complainant: FIL Limited
 Pembroke Hall
 42 Crow Lane
 Pembroke HM 19, P.O. Box HM 670
 Hamilton
 HMCX
 Bermuda

Respondent: Ms Kathleen Gillespie
 125 Barn Hill Rd
 Monroe
 CT
 06468
 United States

2. The Domain Name:

<fidelity-finance.co.uk>

3. Procedural History:

10 December 2012 15:31 Dispute received
11 December 2012 13:28 Complaint validated
12 December 2012 11:14 Notification of complaint sent to parties
03 January 2013 01:30 Response reminder sent
08 January 2013 09:35 No Response Received
08 January 2013 09:35 Notification of no response sent to parties
18 January 2013 01:30 Summary/full fee reminder sent
21 January 2013 16:21 Expert decision payment received

4. Factual Background

The unchallenged evidence of the Complainant, supported in large part by relevant documentary evidence and accepted as fact by the Expert, is as follows:

1. The Complainant is one of the largest and best-known investment fund managers in the world. It has been providing a wide range of financial services under and by reference to the FIDELITY name for around 40 years. It was formerly named and traded as Fidelity International Limited, but on 1 February 2008 changed its name to FIL Limited.
2. The Complainant has a United Kingdom subsidiary, FIL Investment Services (UK) Limited, an English company, which is itself one of the largest investment fund managers in the United Kingdom. Since 1979 the Complainant (through its associated companies and predecessors in business) has traded in the field of financial services in the United Kingdom under a variety of brand names including FIDELITY, FIDELITY INTERNATIONAL and FIDELITY INVESTMENTS.
3. The Complainant is the registered proprietor of numerous registered trade marks comprising or including the FIDELITY name including:
Community Trademark registration no. 3844925 for FIDELITY in Classes 16 and 36, filed on 21 May 2004 and United Kingdom registration no. 2100049 for FIDELITY in Class 36, filed on 13 May 1996.
4. The Complainant learned of the Domain Name in August 2012 through its domain name watching service. The Domain Name is connected to a cgi-bin folder to which public access is denied.
5. On 28 September 2012, the Complainant's trademark attorneys wrote to the Respondent notifying her of the Complainant's trademark rights and seeking transfer of the Domain Name to the Complainant. No response to this letter was ever received.

5. Parties' Contentions

The Complainant contends that it has rights in respect of its FIDELITY trade mark, which is similar to the Domain Name. The Complainant's trade mark registrations cover a wide range of financial services. The Complainant further contends that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complainant seeks transfer of the Domain Name.

The Respondent has not responded to the Complaint.

6. Discussions and Findings

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

The Domain Name (absent the domain suffix, which the Expert may ignore for the purposes of assessing identity and confusing similarity under this element of the Policy) comprises the Complainant's FIDELITY trade mark, a hyphen and the word "finance". "Finance" is a descriptive dictionary word apt to describe the area of business for which the Complainant is famed.

The Expert finds that the Complainant has rights in a name or mark, which is similar to the Domain Name.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "*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 contains a non-exhaustive list of what may constitute an Abusive Registration for these purposes. Paragraph 4 of the Policy contains a non-exhaustive list of what a Respondent may show to demonstrate rights or legitimate interests in respect of the Domain Name.

The Complainant contends that the circumstances warrant a finding of Abusive Registration on the basis that the name FIDELITY in the world of finance means the Complainant, the Complainant has not granted the Respondent any permission to use its registered trade mark, the Respondent failed to respond to the Complainant's representative's letter of 28 September 2012 (see section 4 above) and the Respondent has not challenged any of the Complainant's allegations set out in the Complaint; nor has she provided an explanation for her choice of domain name.

Given that no explanation has been forthcoming from the Respondent and that her use of the Domain Name to date (connection to a cgi-bin folder to which public access is denied) provides no hint of what her true intentions are, one is left to speculate.

From her choice of domain, the '.uk' domain, one can reasonably infer that she has the UK in mind and from her use of the word "finance" one can reasonably infer that she has some knowledge of that area of activity. The Expert finds on the balance of probabilities that she has familiarity with the world of finance in the UK and that, given the prominence of the Complainant in that arena, she was aware of the Complainant when she registered the Domain Name.

What her purpose was in registering the Domain Name, one cannot be certain. However, it is to be noted that she has twice been given the opportunity of providing an explanation, first by the Complainant's representative's letter of 28 September, 2012 and now by this Complaint. The fact that she has rejected both those opportunities is not encouraging. Had there been an innocent explanation, it should have been very easy to provide it.

This Expert came across a similar situation some years ago in DRS 0658 *Chivas Brothers Limited v David William Plenderleith* (<chivasbrothers.co.uk>) and came to the following conclusion:

While it may be possible (at least theoretically) that the Respondent registered the Domain Name for no purpose at all, the Expert regards that as most improbable. What could the Respondent's purpose have been? It could have been with a view to making a use of it, or it could have been with a view to selling it, or simply to block the Complainant. We are left to speculate because the Respondent has not responded, nor has the Respondent made any use at all of the Domain Name.

Where a Respondent registers a Domain Name:-

- 1. which is identical to a name in respect of which the Complainant has rights; and*
- 2. where that name is exclusively referable to the Complainant; and*
- 3. where there is no obvious justification for the Respondent having adopted that name for the Domain Name; and*
- 4. where the Respondent has come forward with no explanation for having selected the Domain Name,*

it will ordinarily be reasonable for an expert to infer first that the Respondent registered the Domain Name for a purpose and secondly that that purpose was abusive. In this case the Expert draws those inferences.

This case differs in that the Domain Name is not identical to the Complainant's name/mark and there might perhaps be some way in which the Respondent could use the word "fidelity" descriptively in relation to matters financial. Nonetheless, the Expert is of the view that the circumstances surrounding the Respondent's registration of the Domain Name and subsequent behaviour in the face of the Complainant's contentions (i.e. silence), justify the Expert coming to the conclusion that the Respondent's registration of the Domain Name represents an abusive threat hanging over the head of the Complainant, a threat which should be removed.

Accordingly, the Expert finds on the balance of probabilities that the Respondent registered the Domain Name for one or more of the purposes contained in the non-exhaustive list set out in paragraph 3(a)(i) of the Policy or for some other abusive purpose. Thus the Expert finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is 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, <fidelity-finance.co.uk>, be transferred to the Complainant.

Signed Tony Willoughby

Dated 1 March, 2013