

DISPUTE RESOLUTION SERVICE**D00019621****Decision of Independent Expert**

Clydesdale Bank Plc

and

Eric Cheng

1. The Parties

Complainant: Clydesdale Bank Plc
40 St Vincent Place
Glasgow
Lanarkshire
G1 2HL
United Kingdom

Respondent: Eric Cheng
No. 18 PICC Plaza
North Street, Chaoyangmen
Dongcheng District
Beijing
100006
China

2. The Domain Name(s)*cybfx.co.uk*

3. Procedural History

- 3.1 I can confirm that I am independent of each of the Parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the Parties.

30 November 2017, the Dispute was received.

05 December 2017, the Complaint was validated.

05 December 2017, the notification of the Complaint was sent to the Parties.

26 December 2017, the Response reminder was sent.

02 January 2018, no Response was received.

02 January 2018, notification of no Response was sent to the Parties.

12 January 2018, the summary/full fee reminder was sent.

17 January 2018, no decision payment was received.

18 January 2018, the Expert decision payment was received.

18 January 2018, a Dispute was opened.

4. Factual Background

- 4.1 The Respondent registered the Domain Name on **30 September 2017**.
- 4.2 The Complainant is a long-established UK company, incorporated in 1882, which provides banking related services.
- 4.3 The Complainant is the proprietor of a number of UK and Community trade mark registrations including for CLYDESDALE (e.g. UK trade mark number 1378934, Community Trade Mark number 96610) and CYBG (e.g. UK trade mark number 3131096, Community Trade Mark number 14814198), such trade marks having been registered prior to the registration of the Domain Name.

5. Parties' Contentions

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the '**Policy**').

- 5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons below.

The Complainant's Rights

- The Complainant submitted that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- The Complainant submitted that it has Rights in the Domain Name based on the trademark application, filed on 29 September 2017, for "CYBFX" and more generally for the Complainant's CYB brand ("*CYB is a brand name which is widely used by [the Complainant] and recognisable as pertaining to [its] business*").

Abusive Registration

- The Complainant asserted that the Domain Name was registered the day after the "CYBFX" trademark application had been filed to the Intellectual Property Office, and that the Respondent has "*seemingly no affiliation to the CYB (Clydesdale and Yorkshire Bank) group of companies [the Complainant].*"
- The Complainant stated that it had made "*several attempts*" to "*obtain*" the Domain Name, including offering payment, and such attempts were rejected by the Respondent.
- The Complainant stated that the Respondent has "*indicated to*" the Complainant that "*in order to purchase the cybfx.co.uk domain and the cybfx.com domain*" which are both registered by the Respondent, "*the registrant is looking for an offer of £95,000.*"
- The Complainant submitted that, as the Domain Name "*clearly relates to our business [...], and the fact that the cybfx.co.uk domain was purchased the following day after our firm filed the trademark examination for cybfx*", the registration of the Domain Name was a deliberate attempt on the part of the Respondent to seek private gain from the Complainant's business by "*precluding [the Complainant] from owning the domain [...] unless we are willing to pay an extortionate sum of money.*"
- The Complainant submitted that the registration of the Domain Name is an Abusive Registration as it falls "*in line*" with Nominet's DRS guidance, which states that a definition of Abusive Registration includes where a domain name is "*registered with the primary purpose of selling or renting it specifically to the Complainant (or a competitor) for more than the Respondent paid for it.*"

The Respondent's Response

5.2 The Respondent did not submit a response to the Complaint.

6. Outstanding formal/procedural issues

- 6.1 Although Nominet sent the Complaint to the Respondent, as mentioned in section 3 above, no response has been provided by the Respondent to the Complaint. As no exceptional circumstances have been raised by the Respondent as to why no response has been received, the Expert has proceeded to a decision.
- 6.2 While noting paragraph 24.8 of the Policy (which states that, in such circumstances, where a Party does not comply with any provision in this Policy, “the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate” as he considers appropriate), the Expert has drawn no inferences from the Respondent’s failure to respond in this case, and has based his Decision on the facts and evidence before him.
- 6.3 It is important to note that the Complainant does not automatically receive the remedy it has requested merely because the Respondent has not responded to the Complaint (see, for example, Nominet DRS *equazen.co.uk* (DRS 02735) decision).

7. Discussions and Findings

General

- 7.1 To succeed in the Complaint, the Complainant has to prove that, pursuant to paragraph 2 of the Policy, on the balance of probabilities:

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

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

- 7.2 Addressing each of these limbs in turn:

Rights in respect of a name or mark which is identical or similar to the Domain Name

- 7.3 The Expert considers that, for the reasons set out below, the Complainant has shown it has Rights in a mark which is similar to the Domain Name.
- 7.4 Paragraph 1 of the Policy defines ‘Rights’ as:

[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;

- 7.5 The Complainant submitted that, based on its “CYBFX” UK trade mark application, it has rights in the “CYBFX trade mark [...].”
- 7.6 In relation to that trade mark application, as referenced in the Nominet Expert’s Overview (the ‘**Overview**’), version 3, the majority view of Experts is that the mere fact of there being a trade mark application does not of itself establish Rights; noting that the validity of a trade mark application has not yet been determined and ordinarily it affords the proprietor no legal right to prevent others from using the mark.
- 7.7 That said, the Overview does recognise that, in some cases an applicant for a trade mark will also have separate parallel rights in the mark in question and may be able to show Rights in this way.
- 7.8 In relation to the CYB brand more generally as referenced by the Complainant, the Expert notes that, as summarised at paragraph 4.3 above, the Complainant is the proprietor of a number of trade mark registrations in respect of CYBG (the ‘**Mark**’).
- 7.9 The Expert considers that the Mark is sufficiently similar to CYBFX, considering that the dominant part of that Mark is the first three letters “CYB”. While the Expert notes that the Domain Name also includes the letters “FX” after the “CYB”, the Expert considers that such letters are merely descriptive for services a Bank, such as the Complainant, would provide (noting that FX is short for Forex, being the market on which currencies are traded) and do not sufficiently distinguish the Domain Name from the Mark.
- 7.10 Given those factors, and noting that the requirement to demonstrate ‘Rights’ is not a particularly high threshold (Nominet appeal panel decision *Seiko-shop* DRS 00248), the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Mark which is similar to the Domain Name. In concluding the above, the Expert has disregarded the Domain Name suffix “co.uk”.
- 7.11 Therefore, the Expert considers that, at the time of the Complaint, the Complainant did have Rights in a mark which is similar to the Domain Name.

Abusive Registration

- 7.12 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.
- 7.13 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

7.14 In relation to the definition of Abusive Registration in sub paragraph (i), the Expert notes that the Respondent registered the Domain Name the day after the Complainant had made its "CYBFX" trade mark application. Further, the Expert notes that, as submitted by the Complainant, the Respondent subsequently offered to sell the Domain Name to the Complainant for £95,000.

7.15 The Policy sets out at paragraph 5.1 a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration and includes at paragraph 5.1.1.1 where the Respondent has registered the Domain Name primarily:

for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

7.16 Based on the above, and on the balance of probabilities, the Expert agrees with the Complainant: that the Respondent noted the Complainant's trade mark application and purposely registered the Domain Name in order to then sell the Domain Name to the Respondent at a later date for more than the Respondent paid for it. Therefore, the Expert considers that the factor in paragraph 5.1.1.1 of the Policy as set out above is met.

7.17 So far as the definition of Abusive Registration sub paragraph (ii) is concerned, the Expert considers that the Domain Name was and is an Abusive Registration as a result of its manner of use by the Respondent.

7.18 The Expert considers that paragraph 5.1.2 of the Policy is relevant, whereby a factor which may be evidence that the Domain Name is an Abusive Registration is:

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;

7.19 As evidenced by a search of the website attached to the Domain Name (the 'Website'), the Respondent has used the Website as a parking site controlled by a third party - which is where a person allows a third party to use the URL to 'park' links in that webpage to other websites and the person then earns revenue when a user clicks on those parked links.

7.20 The Expert considers that, as referenced at paragraph 8.5 of the Policy, while the sale of web traffic "*is not of itself objectionable under this Policy*", the Expert will take into account when making his decision as to whether or not the Domain Name's use is an Abusive Registration - the nature of the Domain Name, the nature of the advertising links on any parking page associated with the Domain Name, and that the use of the Domain Name is "*ultimately the Respondent's responsibility.*"

7.21 In this regard, and noting that:

(a) the Website references on its homepage a link to "Oanda Forex" along with other links which start with "FX" followed by Chinese writing, and

(b) FX services are services appropriate to the Complainant's field of activity,

the Expert considers that those users accessing the Website would likely be confused that the FX services for sale via the parked links are either the Complainant's or are at least endorsed by the Complainant.

7.22 The Expert considers that the use of the Domain Name as described, for the reasons referenced above, has taken unfair advantage of the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the Mark to generate web traffic to the Website, and to the 'parked' websites promoted on the Website, that was meant for the Complainant.

7.23 The registration of the particular wording of the Domain Name is also unfairly detrimental to the Complainant as web users are likely to conclude that the Complainant has registered the Domain Name for the provision of services in relation to the Complainant's banking currency exchange products, which is not the case.

7.24 Further, the Expert is not persuaded by an argument that a person accessing the Website on the assumption it was the Complainant's website would soon realise his or her mistake, as the damage to the Complainant's business would already have been done.

7.25 The Expert has considered whether there is evidence before him to demonstrate that the Domain Name is not an Abusive Registration but does

not consider there is. Indeed, the Expert considers that there is no obvious justification for the Respondent having registered the Domain Name.

7.26 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

8. Decision

8.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of a mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: Dr Russell Richardson

Dated: 14 February 2018