

Cheltenham & Gloucester plc -v- James Ryder

Nominet UK Dispute Resolution Service

DRS 00203

Cheltenham & Gloucester plc -v- James Ryder

Decision of Independent Expert

1. **Parties:**

Complainant: Cheltenham & Gloucester plc
Address: Barnett Way
Gloucester
Postcode: GL4 3RL
Country: GB

Respondent: Mr James Edward Ryder
Address: 112A High Street
Knaresborough
North Yorkshire
Postcode: HG5 0HN
Country: GB

2. **Domain Name:**

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

3. **Procedural Background:**

The complaint was received by Nominet on 18 January 2002. Nominet validated the complaint and sent a copy to the Respondent on 21 January 2002, informing the Respondent that he had 15 working days to lodge a Response. A Response was lodged on 22 January 2002 and forwarded to the Complainant on 24 January 2002 with an invitation to the Complainant to lodge any Reply by 31 January 2002. The Complainant lodged a Reply on 29 January 2002 stating that it had nothing further to add. A copy of the Reply was sent to the Respondent on 31 January 2002.

The Informal Mediation failed to produce an agreed resolution. On 19 February 2002 the Complainant paid Nominet the required fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Policy ("the Policy").

On 19 February 2002 Nominet invited the undersigned, Jason Rawkins ("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 the Expert with effect from 26 February 2002.

4. The Facts:

The Complainant is a well-known financial institution. It also has a UK trade mark registration for the mark CHELTENHAM & GLOUCESTER with an effective registration date of 1 October 1986.

On 7 July 2000 the Respondent registered the Domain Name.

The Domain Name currently links to the site of moneyextra.com which belongs to an unconnected third party.

5. The Parties' Contentions:

Complainant:

The Complainant's submissions are as follows:

1. The Complainant has rights in a trade mark which is identical or similar to the domain name:
 - (1) The Complainant is the proprietor of UK trade mark registration 1272904 for the mark Cheltenham & Gloucester. The registration certificate detailing the products/services for which the mark is registered is at Annex A.
 - (2) The Complainant is a well-known and highly regarded financial institution based in the United Kingdom, providing banking, financial and related services and products under the mark Cheltenham & Gloucester.
 - (3) Cheltenham & Gloucester has existed as a building society since 1850 and became a bank on 1st August, 1995. During that time Cheltenham & Gloucester has used the trade mark Cheltenham & Gloucester extensively to indicate Cheltenham & Gloucester's provision of banking, financial and related services and products.
 - (4) In 2000, the Complainant's profits before tax were approximately £476.6 million. It has approximately 1.58 million customers.
 - (5) By reason of the above, the Complainant has acquired a very substantial and extensive goodwill and reputation in the United Kingdom in the name and trade mark Cheltenham & Gloucester.
 - (6) In addition, the Complainant has a large number of domain name registrations including cheltenhamandgloucester.co.uk, cheltenham-and-gloucester.co.uk, cheltenhamandgloucester.com, cheltglos.co.uk and cheltglouc.co.uk.

- (7) The domain name in dispute is virtually identical to the Complainant's registered mark Cheltenham & Gloucester.
 - (8) In any event, the domain name in dispute is confusingly similar to the Complainant's trade mark, incorporating all the distinctive elements of the Complainant's registered mark Cheltenham & Gloucester.
 - (9) The Complainant notified Nominet UK of its trade mark registration rights, and of the Respondent's registration of the domain name in spite of these rights, in a letter dated 14th March, 2001. A copy of this letter is attached as Annex B.
 - (10) The Complainant has not licensed or otherwise permitted the Respondent to use its registered trade mark, or any other trade mark consisting of or incorporating the Cheltenham & Gloucester trade mark or to apply for or use any domain name incorporating any of its trade marks.
2. The domain name is an abusive registration in the hands of the Respondent:
- (1) The Respondent is an individual with an address in the United Kingdom. He is the proprietor of the domain name "cheltenhamgloucester.co.uk" that incorporates all the distinctive elements of the registered trade mark of the Complainant. He registered the domain name on 7th July, 2000. A print out of the "whois.co.uk" database search for this domain name is attached as Annex C. Accordingly, the Complainant's rights in the words Cheltenham & Gloucester predate any rights that the Respondent may claim by virtue of his domain name registration.
 - (2) On the website appearing under the domain name, the Respondent at first displayed a hypertext link to the Complainant's website, "cheltglos.co.uk". The Respondent then removed this link and instead displayed links to websites wholly unconnected with the Complainant, first "leedsholbeck.co.uk", the website of the Leeds & Holbeck Building Society, then the "moneyextra.com" website. The Respondent duplicated this pattern of redirection with "leedsholbeck.co.uk", another domain name which he owns.
 - (3) These facts were brought to the attention of Nominet when the Complainant submitted to Nominet the letter at Annex B.
 - (4) In the Respondent's letter of reply to Nominet dated 20th March, 2001 (attached as Annex D), the Respondent claimed that the domain was directed away from the Complainant's site by accident. Therefore, in response to the complaint, the Respondent redirected Internet traffic to the Complainant's "official" site. In his response, the Respondent admits to offering the domain name for sale to Cheltenham & Gloucester three times for £1,000. This sum was then reduced to £750, and, more recently, to £500.

- (5) The matter was not resolved by negotiation. Nominet therefore made a decision regarding cancellation of the domain name under its previous policy. In its decision (attached as Annex E), at paragraph 17(b), Nominet noted that the Respondent admitted that he bought the domain name with the intention of selling it to the Complainant because the Respondent saw an opportunity.
- (6) Accordingly, it is clear from the Respondent's use of the domain name in dispute that the Respondent is aware of the Complainant's rights in the trade mark, Cheltenham & Gloucester, and has deliberately registered the domain name with a view to selling it to the Complainant.
- (7) Under its old policy, Nominet decided to take no action as, in Nominet's view, there was no confusion to Internet users because the domain name was, at the time of Nominet's decision, transferring Internet users to the Complainant's "official" site.
- (8) Subsequently, the Respondent has redirected the domain name so that it again sends Internet traffic to the moneyextra.com website, with a narrow band beneath the UK2.Net "frame" providing a link to the Complainant's site. A print out of the current website displayed under the domain name is at Annex F.
- (9) The redirection of Internet traffic is intended to put pressure on the Complainant to purchase the domain name for more than the Respondent's out-of-pocket costs. In addition, the Respondent's use of the website under the domain name to display the "moneyextra.com" site, with the UK2.Net Internet service provider "frame" and a link to the Complainant's website, confuses people or businesses into believing that the moneyextra.com site and the internet service provider are endorsed by or otherwise connected with the Complainant. Although there may be a narrow band containing a link to the Complainant's site, the display of the "moneyextra.com" site under the domain name is unfairly detrimental to the Complainant's trade mark and associated goodwill as customers or potential customers of the Complainant are directed to a financial website that has no connection with the Complainant.
- (10) By virtue of the above and considering Paragraph 3(a) of the Nominet UK Dispute Resolution Service Policy (the "Policy"):
 - (i) the Respondent has registered the domain name primarily for the purpose of selling the domain name to the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly associated with acquiring or using the domain name; and
 - (ii) the Respondent is using the domain name in a way which has confused people or businesses into believing that the domain is registered to, operated or authorised by, or otherwise connected with the Complainant.
- (11) Considering Paragraph 4(a) of the Policy, there is no evidence that:
 - (i) before being informed of the Complainant's dispute, the

Respondent has: A. used or made demonstrable preparations to use the domain name "cheltenhamgloucester.co.uk" or a similar domain name in connection with a genuine offering of goods or services; B. been commonly known by any of the names "Cheltenham", "Gloucester", "Cheltenham & Gloucester", "Cheltenhamgloucester", or any similar name, or legitimately connected with a mark which is identical or similar to "cheltenhamgloucester.co.uk"; or C. made legitimate non-commercial or fair use of the domain name "cheltenhamgloucester.co.uk", including any operation of the site solely in tribute to or criticism of a person or business; and (ii) the domain name "cheltenhamgloucester.co.uk" is not generic or descriptive and the Respondent is not making fair use of it, including by any operation of the site solely in tribute to or criticism of a person or business.

- (12) The Complainant therefore requests that the domain name in dispute be transferred to it.

Respondent:

In Response, the Respondent's submissions are as follows:

The Respondent refers to the previous complaint made by Cheltenham & Gloucester with reference to the domain cheltenhamgloucester.co.uk. (and states that he will not be resubmitting copies of correspondence from that dispute).

The Respondent is making no profit or gain from the domain. The page is divided into two frames, the top frame allowing the user to jump to the domain cheltglos.co.uk (in a new window) and the second frame to an unrelated site (moneyextra.com).

Any pop ups relating to UK2.net (who host the domain) are completely beyond his control.

The top frame clearly allows the user to go to the Complainant's site if they wish. The Respondent is making no claims that moneyextra.com is connected with the Complainant.

Moneyextra.com is in no way connected with the Respondent.

In addition the Respondent refutes claims that users will be confused by the web page - as most people read from top to bottom they will see the link clearly indicating that they can go to the Complainant's site if they choose.

The Complainant makes the point that the domain was available for sale for £1000, then £750 and later £500. This offer is still open, which the Respondent hopes demonstrates his willingness to reach a negotiated settlement.

In the Complaint the issue regarding redirection of the site to leedsholbeck.co.uk some time ago is raised again. Again, the Respondent gives his assurance that this was done by mistake, and was rectified as soon as he was made aware. This

point is therefore irrelevant to the current dispute (having been dismissed in the previous dispute.)

The domain cheltenhamgloucester.co.uk was registered by the Respondent on 7th July 2000. Cheltglos.co.uk (the Complainant's main domain) was registered as far back as 20th October 1998 (if not before). Therefore one can only assume that the Complainant did not wish to register cheltenhamgloucester.co.uk as they clearly had time to do so.

The Respondent has at no time attempted to hold Cheltenham & Gloucester to 'ransom' and has been entirely honourable in his dealing with them.

To summarise, the Respondent freely admits that the domain was registered with a view to coming to an agreement with Cheltenham & Gloucester; he had never deliberately misled anybody visiting the domain in question; he is asking for reasonable reimbursement of costs (£500 is not excessive and represents all costs involved, including his commercial enterprise in securing the domain sometime after Cheltenham & Gloucester had the opportunity to do so – this is clearly not excessive.)

It is disappointing that Cheltenham & Gloucester are not prepared to follow a more reasonable approach to this whole matter.

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

The Complainant has registered trade mark rights in the name or mark CHELTENHAM & GLOUCESTER. There is also no doubting that the Complainant is a well-known financial institution and therefore also has common law rights in the name CHELTENHAM & GLOUCESTER.

In comparing the name or mark of the Complainant with the Domain Name, one has to disregard the generic domain suffix. Having done so, it is clear that the Domain Name is in all material respects identical with the Claimant's name or mark CHELTENHAM & GLOUCESTER. The only immaterial difference is that the Domain Name does not have an ampersand in the middle of it, an element which in any case it is impossible to include in a .uk domain name.

The Expert therefore finds that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name. (Even if the ampersand

element were to be considered sufficient to render the Domain Name non-identical, the Expert finds that it is similar.)

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 3a of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The factors of greatest potential relevance (and those on which the Complainant relies) are the following:

- i Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:
 - A 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;
 -
- 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;"

The Respondent admits in his submissions that the Domain Name was registered with a view to coming to an agreement with the Complainant. The Respondent's letter to Nominet of 20 March 2001 admits to having offered the Domain Name to the Complainant for £1,000, a figure which was subsequently reduced to £750 and then £500. These facts are essentially confirmed in the Response.

A figure of £1,000 is considerably in excess of the out-of-pocket costs which one would expect to be directly associated with acquiring a domain name. The Respondent has not submitted any evidence to suggest otherwise with regard to his acquisition of the Domain Name. The use which the Respondent has made of the Domain Name is also very unlikely to have caused him to incur any significant, directly associated out-of-pocket costs. Again, the Respondent has not put in any evidence which contradicts such a conclusion. Moreover, he asserts that the amount he has sought includes compensation for "commercial

enterprise in securing the domain", something which clearly falls outside out-of-pocket costs directly associated with acquiring or using the Domain Name.

It is also pertinent to consider the use which the Respondent is making, and has made, of the Domain Name. It is clear from the parties' submissions (including those filed in the complaint proceedings brought under Nominet's old Dispute Resolution Service, copies of which are annexed to the Complaint in this case) that the Respondent has not made any use of the Domain Name in connection with any business of his own. Originally the Domain Name appears to have linked to the Complainant's website. At a later point in time, the Domain Name took one to the website of Leeds & Holbeck building society. Subsequent to that, it led to the moneyextra.com website. In his letter of 20 March 2001 the Respondent claimed that the second two re-directions were accidental and in the Response he reiterates this with regard to the Leeds & Holbeck website. The Expert is not convinced by these claims.

The Expert's scepticism is reinforced by the fact that, having re-directed the Domain Name to the Claimant's cheltglos.co.uk website at the time when Nominet made a decision in the earlier proceedings under its old Dispute Resolution Service, by the time when the Complaint was lodged in this case the Domain Name again took one to the moneyextra.com website.

In any case, the Domain Name currently takes one to the moneyextra.com website, which the Respondent states is in no way connected with him. moneyextra.com is a financial advice website offering a variety of financial advice services including services relating to house-buying and mortgages and savings and investing. There is a narrow band at the top of each page of the website which provides a link to the Complainant's website with the wording "Click [here](#) to go to the Cheltenham & Gloucester site". There is nothing which makes it clear that the moneyextra.com website has no connection with the Complainant and, given the nature of the website, the Expert finds that the website is likely to confuse people accessing it into believing that it is in some way authorised by or connected with the Complainant.

No evidence has been submitted of people having actually been confused by the use of the Domain Name into believing that it is authorised by or otherwise connected with the Complainant. That being the case, the factor set out in paragraph 3 a ii of the Policy does not apply as such. However, the factors listed in paragraph 3 are expressly non-exhaustive and, for the purposes of this case, the Expert considers the likelihood of confusion to be relevant.

It is clear to the Expert that the Respondent is not using the Domain Name in a bona fide manner. The fact that the Domain Name currently leads one to the moneyextra.com website, and for a period of time previously led one to the leedsholbeck.co.uk site, neither of which has any connection with the Respondent, demonstrates this. Rather, the use which the Respondent has made of the Domain Name is consistent with his admitted intention of persuading the Complainant to purchase the Domain Name from him.

Paragraph 4 of the Policy sets out a non-exclusive list of factors which may be evidence that a Domain Name is not an Abusive Registration. The only factors which might potentially apply to this case are as follows:

- "i Before being informed of the Complainant's dispute, the Respondent has:
- A used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;
 - B been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
 - C made legitimate non-commercial or fair use of the Domain Name;"

It is the Expert's finding that none of the above factors apply to this case. Apart from a period when the Respondent directed the Domain Name to the Complainant's website, the only use which he has made of the Domain Name has been to direct it to the website of the Leeds & Holbeck building society and to the moneyextra.com site, neither of which are in any way connected with the Respondent. The Respondent has therefore not used the Domain Name in connection with goods or services offered by him or any business connected with him, which must be an implicit requirement for the factor set out in paragraph 4aiA of the Policy to apply. Similarly the use which the Respondent has made of the Domain Name cannot be characterised as legitimate non-commercial or fair use. Finally, it is obvious that the factor set out under paragraph 4aiB does not apply.

Taking all of the above into account, including those of the non-exhaustive factors listed in the Policy which have been found to apply or not apply, the Expert finds that the manner in which the Domain Name was registered took unfair advantage of the Complainant's Rights; and that the manner in which it has subsequently been used by the Respondent has been unfairly detrimental to the Complainant's Rights.

The Expert accordingly finds that the Domain Name is an Abusive Registration under the definition of that term set out in paragraph 1 of the Policy.

7. Decision:

Having found that the Complainant 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, the Expert directs that the Domain Name, cheltenhamgloucester.co.uk, be transferred to the Complainant.

Jason Rawkins

1 March 2002