

Nominet UK Dispute Resolution Service

DRS 00186

GE Capital Corporation (Holdings)-v-Richard Perry

Decision of Independent Expert

1. **Parties:**

Complainant: GE Capital Corporation (Holdings)

Address: 3<sup>rd</sup> Floor, 1 Trevelyan Square  
Boar Lane  
Leeds

Postcode: LS1 6HP

Country: GB

Respondent: Mr Richard Perry

Address: 192 Redland Road  
Redland  
Bristol

Postcode: BS6 6YH

Country: GB

2. **Domain Name:**

gecapitalfinance.co.uk

3. **Procedural Background:**

The Complaint was lodged with Nominet on 9 January 2002. Nominet validated the Complaint and notified the Respondent of the Complaint on 11 January 2002 and informed the Respondent that he had 15 days within to lodge a Response. The Respondent failed to respond. Mediation not being possible in those circumstances, Nominet so informed the Complainant and on 5 February 2002 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

On 18 February 2002, David King, the undersigned, ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be brought to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. **Outstanding Formal/Procedural Issues (if any):**

The Respondent has not submitted a Response to Nominet in time (or at all) in compliance with Paragraph 5a of the Procedure for the conduct of proceedings under the Nominet UK Dispute Resolution Service (“the Procedure”).

Paragraph 15b of the Procedure provides, inter alia, that “if in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint.”

Paragraph 15c of the Procedure provides that “if in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure....., the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate.”

Are there exceptional circumstances present in this case? One of the Complainant’s contentions is that the Respondent has provided contact details which are different from those provided to Nominet and that both sets of contact details appear to be false or misleading. The Expert deals with this contention in detail in Paragraph 7 of this Decision. At this point in the Decision, the Expert wishes to consider whether the complaint has been properly addressed to the Respondent. Under Paragraph 2a of the Procedure, Nominet will send a complaint to the Respondent using, in its discretion, one of the following means:

- i sending the complaint by first class post, fax or e-mail to the Respondent at the contact details shown as the registrant or other contacts in Nominet’s Domain Name register database entry for the Domain Name in dispute;
- ii sending the complaint in electronic form (including attachments to the extent available in that form) by e-mail to:
  - A** `postmaster@<the domain name in dispute>`: or
  - B** if the Domain Name resolves to an active web page (other than a genuine page which Nominet concludes is maintained by an ISP for the parking of Domain Names), to any e-mail address shown or e-mail links on that web page so far as this is practicable; or
- iii sending the complaint to any addresses provided to it by the Complainant under Paragraph 3 (b) (iii) of the Procedure so far as this is practicable.

Under Paragraph 2 of Nominet’s current Terms and Conditions the registrant must inform Nominet promptly of any change in his registered details, and those of his Agent if applicable. It will be the registrant’s responsibility to maintain and update any details he submits to Nominet and to ensure that his details are up to date and accurate. In particular, it is the registrant’s responsibility directly or by his agent to ensure that Nominet has his full and current postal address.

The Expert has seen copies of Nominet's letter of 11 January 2002 forwarding the complaint to the Respondent at the address shown in the Register Entry for the Domain Name and its e-mail of the same date sent to him at postmaster@gecapitalfinance.co.uk. The Expert has confirmed with Nominet that the letter has not been returned undelivered by the Post Office. Although Nominet has not attempted to contact the Respondent at the address referred to by the Complainant in its contentions in Paragraph 6 of this Decision, the Expert has no reason to conclude that the Respondent has not received details of the complaint. The Expert, therefore, does not consider that there are exceptional circumstances present in this case, which prevent him from proceeding to a Decision of this complaint. The Expert is satisfied that the probable facts asserted by the Complainant (if not all the contentions founded on those facts) set out in Paragraph 5 of this Decision are indeed facts.

## 5. **The Facts**

The Complainant is the parent company of GE Capital Commercial Finance Limited, GE Capital Finance and GE Capital Limited. It is part of a well-known non-bank institution with offices in numerous countries around the world including the UK.

The proprietor of all the UK and Community registered trade marks cited in the complaint is General Electric Company. The Company is a member of the General Electric Company corporate group and is bringing the complaint both for itself and on behalf of General Electric Company and all the other companies in the General Electric Company group, which includes GE Capital Finance.

On 27 February 2000 the Respondent registered the Domain Name.

## 6. **The Parties Contentions**

### *Complainant:*

The Complainant is represented by solicitors, who have made detailed submissions on behalf of the Complainant, which read as follows:

### **"GROUNDS OF COMPLAINT**

#### **1.1 Rights in respect of a name or mark**

Complainant is GE Capital Corporation (Holdings), the parent company of GE Capital Commercial Finance Limited, GE Capital Finance and GE Capital Limited. Complainant is part of the largest non-bank financial institution in the world with offices in numerous countries around the world including the U.K. Significant reputation and goodwill attaches to the GE Capital name and corresponding trade marks.

The proprietor of all the UK and Community registered trade marks cited in this Complaint is General Electric Company. The Complainant is a member of the General Electric Company corporate group (a chart showing the corporate group structure can be found at Attachment 1) and is bringing this Complaint both for itself and on behalf of General Electric Company and all other

companies in the General Electric Company group (hereinafter all these entities combined will be referred to as "Complainant").

Complainant is relying on both registered and unregistered rights in this Complaint. Not only does Complainant have significant and long-standing goodwill in the name "GE Capital Finance" (a direct match for the Domain Name), it also has both registered and unregistered trade mark rights in respect of a number of similar names and marks.

(a) Registered Trade Marks

Complainant is the registered proprietor of UK and European Community trade marks in a number of classes including UK registrations for GE CAPITAL and GE CAPITAL BANK and a European Community trade mark for GE CAPITAL all in class 36 for insurance and financial services. Further details relating to Complainant's trade mark registrations are set out in Attachment 2.

Complainant has used the "GE CAPITAL" mark since 1987 and since then has built up a substantial goodwill in the financial services sector in this mark and also in registered and unregistered marks derived from it, including GE CAPITAL FINANCE. Complainant has made substantial use of these registered trade marks, (detail and examples of which are annexed at Attachment 3).

(b) Unregistered Trade Mark Rights

Complainant has also acquired rights enforceable under the English law of passing off by virtue of the substantial goodwill and reputation it has acquired in the name "GE CAPITAL FINANCE". Full details of Complainant's relevant companies, domain name registrations and examples of Complainant's use of the mark "GE CAPITAL FINANCE" are at Attachments 4, 5 and 6 respectively.

Complainant owns the following domain names:

- [www.gecapital.com](http://www.gecapital.com)
- [www.gecommercialfinance.com](http://www.gecommercialfinance.com)
- [www.gecapitalfinance.com](http://www.gecapitalfinance.com)
- [www.gecapitalfinance.net](http://www.gecapitalfinance.net)
- [www.gecapitalfinance.org](http://www.gecapitalfinance.org)

WHOIS searches showing Complainant's proprietorship of these domain names (and the dates on which they were registered), together with print-outs of the home pages of these web-sites demonstrating extensive use of the "GE CAPITAL" and "GE CAPITAL FINANCE" marks, are at Attachment 5. All of the [www.gecapitalfinance](http://www.gecapitalfinance) addresses contain a link to Complainant's home page.

## 1.2 Identical or similar to the Domain Name

Complainant submits that:

- (a) The Domain Name is **identical** to the unregistered trade mark "GE CAPITAL FINANCE" (as used in both the company name GE Capital Finance Limited and the domain name www.gecapitalfinance in its .com, .net, and .org forms;
- (b) The first part of the Domain Name is **identical** to the UK and Community trade mark registrations for "GE CAPITAL";
- (c) The Domain Name is **similar** to all other registered trade marks cited in Section 1.1, the common and crucial factor being the use of the name "GE Capital";
- (d) The Domain Name is **similar** to all other unregistered trade marks cited in Section 1.1, the common and crucial factor being the use of the name "GE Capital;" and
- (e) The name "GE Capital" is the dominant and distinctive element common to all of Complainant's registered and unregistered trade mark rights, and present throughout its business (as evidenced by the widespread use shown in the various Attachments to this Complaint). The term "finance" is indicative of, and indelibly associated with, Complainant's financial services business, and use of a name or mark incorporating "GE Capital" with the word "Finance" -such as the Domain Name - will inevitably imply a connection with Complainant's business.

## 1.3 Evidence of Abusive Registration

Complainant submits that Respondent's registration of the Domain Name is an Abusive Registration for the following reasons:

- (a) Under Paragraph 3(a)(i)(A) of the Policy, Respondent has registered the Domain Name primarily for the purposes of selling it to Complainant, for valuable consideration, in excess of Respondent's out-of-pocket costs directly associated with acquiring it, in that:
  - (i) On 27 February 2001, Respondent contacted Complainant, offering the Domain Name for sale (Attachment 7). In so doing, Respondent made the following statement:

*"We are receiving huge amounts of e-mails relating to the domain name www.gecapitalfinance.co.uk we originally registered the name for a company that are were [sic] in business as a capital financier for business start-ups (George-Edward Capital Finance). They have reached financial difficulties and therefore we intend to sell the name and wondered if you were interested. We have undergone [sic] web-development for this company which has not yet been paid for hence the domain now belongs to us outright. The company [he] used to register the domain name is holding the tag on their server. The domain currently generates approx 60 hits per week and is not yet*

*registered with any search engines. Please e-mail me if this is of any interest."*

Complainant submits that this explanation for Respondent's registration of the Domain Name is false and was fabricated by Respondent, as there is no record of George Edward Capital Finance at Companies House, whether as a current or dissolved company (Attachment 8). A search of an on-line business directory also produced no reference to this alleged business. (Attachment 9).

Accordingly, Complainant submits that Respondent has no legitimate rights or interests in the Domain Name and cannot rely on any provisions of Paragraph 4 of the Policy.

- (ii) Respondent states in his e-mail of 27 February 2001, to Complainant that "we intend to sell the name and wondered if you are interested". The Domain Name is in fact currently offered for auction on the UK2 website for £20,000, a sum substantially in excess of the costs of registration of a .co.uk domain name, (Attachment 10). The Complainant submits that the offering of the Domain Name for sale, for a substantial sum, with full knowledge of Complainant's rights in it, coupled with the giving of a false reason for the registration of the Domain Name (and giving false contact details, as described below), is compelling evidence that not only did Respondent have no bona fide reason for such registration but also that the real reason for the registration was to seek to sell the Domain Name to Complainant for a profit.
- (b) Under Paragraph 3(a)(i)(B) of the Policy, Respondent has registered the Domain Name as a blocking registration against the relevant marks of Complainant, in that:
  - (i) In light of the existing registered and unregistered trade marks of Complainant, and in particular the number of "GE Capital"-derived domain names registered by Complainant, Complainant has a legitimate interest in registering the Domain Name – and it was (or should have been) foreseeable to Respondent that Complainant would wish to do so; and
  - (ii) In the absence of any other reason for or genuine interest in registering the Domain Name, Respondent registered the Domain Name knowing (and, with regard to 1.3(a) above, intending) that it would prevent Complainant from doing so.
- (c) Under Paragraph 3(a)(i)(C) of the Policy, Respondent has registered said Domain Name primarily for the purpose of unfairly disrupting the business of Complainant, in that:
  - (i) As at the date of this submission, the Domain Name when entered as a URL accesses a holding page on the website of the ISP UK2NET.com (Attachment 11). The contents of this web page are an invitation to send pornographic materials for inclusion in a website to be set up at [www.hardcorepornshots.com](http://www.hardcorepornshots.com). The address given for the

receipt of nude photographs is the same address as one of those given for Respondent (see 1.3(e)(ii) below). Further, there is a real danger that Respondent will set up a website with pornographic content which may be accessed through the Domain Name. The Domain Name is being used for indecent and illicit purposes and as such denigrates the business and reputation of Complainant; and

- (ii) Respondent by stating in his e-mail of 27 February 2001 that "we are receiving huge amounts of e-mails relating to the domain www.gecapitalfinance.co.uk" and "The domain currently generates approx 60 hits per week and is not yet registered with any search engines" implies that Respondent was and is fully aware of the disruptive effect of his registration and that Complainant's business will suffer if Complainant does not purchase the Domain Name from Respondent. Neither Complainant (nor its subsidiary companies trading under the name GE Capital Finance) have received any of the misdirected e-mails Respondent claims to have received. There are two possible reasons for this: one, that Respondent is deliberately not forwarding e-mails intended for Complainant or its businesses, using them as a "bargaining chip" or, two, that Respondent has not, in fact, received any e-mails sent to the Domain Name and has made this false statement simply to induce Complainant to purchase the Domain Name for a substantial sum.
- (d) Under Paragraph 3(a)(iii) of the Policy, Respondent is engaged in a pattern of making Abusive Registrations in that he has registered domain names which incorporate the registered trade marks and/or trading styles of third parties, including:

**RBSNATWESTBANK.COM**

**MBNACARDAPPLICATIONS.COM**

**VISACARDAPPLICATIONS.COM**

**MBNACREDITCARDS.NET**

**MBNACREDITCARDS.COM.**

Attachment 12 gives details of these registrations and the corresponding registered trademarks. All these trade marks relate to, and are registered for, financial services.

- (e) Under Paragraph 3(a)(iv) of the Policy, Respondent has provided contact details to Complainant which are different to those provided to Nominet (Attachment 13). Both sets of contact details appear to be false or misleading.
  - (i) Mary Bagnall, a solicitor at Rowe & Maw, the firm representing Complainant, telephoned "Directory Enquiries" and asked for Richard Perry at the address given to Nominet, and was

informed that there was no-one of that name listed at that address.

- (ii) Respondent's e-mail of 27 February 2001 to Complainant appeared to have been sent on behalf of a company called X-Zotic Worldwide and provided the following contact e-mail address: "*customerservice@blueyonder.co.uk*". Respondent's e-mail also gave a contact telephone number, 0117 904 2390. The above phone number is the listed number of X-Zotic Worldwide, an online pet store with an address at 174 Bedminster Road, Bristol, Avon B53 6LH. This telephone number was not in service at the date of this submission.

#### **1.4 Conclusion**

Complainant has demonstrated that it has substantial and significant goodwill in the names "GE Capital" and "GE Capital Finance," as evidenced by its portfolio of registered trade marks, company names and domain names and their widespread and long-standing use as trading names in relation to financial services.

As demonstrated above, Respondent's registration of the Domain Name, at the time of such registration, took unfair advantage of and was unfairly detrimental to Complainant's rights. The registration was intended as a means of making a profit from selling the Domain Name to Complainant, and/or as a means of blocking Complainant from registering the Domain Name when it was foreseeable that it would wish to do so, and/or as a means of unfairly disrupting Complainant's business. Respondent is engaged in a pattern of such activity. Respondent has failed to respond to any of Complainant's communications sent to the address submitted by Respondent to Nominet, in all likelihood because this information is false. When Respondent failed to convince Complainant to buy the Domain Name for a significant amount it proceeded to post it for sale on the Internet for £20,000. The Domain Name is now being used in connection with pornographic content. Respondent has no legitimate rights in the Domain Name. The registration should therefore be deemed Abusive."

The Expert confirms that he has read all the Attachments referred to in the Complainant's Grounds of Complaint.

*Respondent:*

The Respondent has not responded

#### **7 Discussion 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*

On the basis of the evidence submitted, it is clear that the Complainant has substantial rights in the words GE CAPITAL and GE CAPITAL FINANCE. Indeed the Domain Name comprises the name GECAPITALFINANCE, which is identical to the name of one of the companies in the General Electric Company group. In assessing whether or not a name or mark is identical or similar to a domain name, it is appropriate to discount the domain suffix <co.uk> which is of no relevant significance and wholly generic. The Complainant is also the proprietor of a number of domain names including www.gecapitalfinance.com (the Complainant's WHOIS search confirms it was registered on 12 November 1998 i.e. over 20 months before the registration of the Domain Name by the Respondent), www.gecapitalfinance.net and www.gecapitalfinance.org (the Complainant's WHOIS searches confirm that these two domain names were registered on 2 March 2001).

The Expert finds that, for the purposes of the Policy, the Complainant does have Rights in respect of a name of mark which is identical to the Domain Name.

### *Abusive Registration*

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 detrimental to the Complainant's Rights."

A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration, is set out in Paragraph 3 of the Policy. All of these factors (except Paragraph 3 a ii ) are relevant in this case.

Paragraph 3 a i reads as follows:

- "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:
  - B** as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C** primarily for the purpose of unfairly disrupting the business of the Complainant;"

The Complainant has referred to the e-mail which the Respondent sent to the Complainant on 27 February 2001 offering the Domain Name for sale. In the e-mail the Respondent said, inter alia, that he originally registered the Domain Name for a company in business as a capital financier for business start-ups (George-Edward Capital Finance), which had reached financial difficulties and that he was intending to sell the Domain Name. Attachment 10, referred to in the Complainant's Grounds of Complaint, does show that, at the time of submission of the complaint to Nominet, the Domain Name was offered for auction on the UK2 website for £20,000. The Expert has read the searches carried out by the Complainant and notes that they do not reveal any record of George-Edward Capital Finance as a current or dissolved company or any reference to a business of that name. In the absence of any evidence to the contrary, the Expert concludes that the Respondent did register the Domain Name primarily for the purpose of selling the Domain Name for valuable consideration in excess of the Respondent's documented out-of-pocket costs. The Expert also concludes that, on the balance of probabilities, the Respondent would have been aware of the domain name [www.gecapitalfinance.com](http://www.gecapitalfinance.com) owned by the Complainant at the time of his registration of the Domain Name, that the Complainant would also wish to register the Domain Name and that he knew that his registration would prevent the Complainant from doing so.

The Complainant has also alleged that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. Attachment 11 referred to in the Complainant's Grounds of Complaint is a copy of a holding page on the website of the ISPUK2 NET.com and reads "We need your naked body!! We are about to launch our new website "hardcorepornshots.com". We will pay you £10 for every nude photo set you send in that we use on our website". In his e-mail dated 27 February 2001, the Respondent also says "We are receiving huge amounts of e-mails relating to the domain name [www.gecapitalfinance.co.uk](http://www.gecapitalfinance.co.uk) and "The domain currently generates approx 60 hits per week and is not yet registered with any search engines". Whilst the Complainant has not produced any direct evidence that its business has been disrupted, the Expert is satisfied that the use of the Domain Name in this way could offend anyone accessing it by mistake or anyone seeking information on financial services and could potentially disrupt the Complainant's business and harm their reputation.

Paragraph 3 a iii reads:

"In combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations;"

The Complainant has also alleged that the Respondent is engaged in a pattern of Abusive Registrations in that he has registered domain names which incorporate the registered trade marks and/or trading styles of third parties including [RBSNATWESTBANK.COM](http://RBSNATWESTBANK.COM), [MBNACARDAPPLICATIONS.COM](http://MBNACARDAPPLICATIONS.COM), [VISACARDAPPLICATIONS.COM](http://VISACARDAPPLICATIONS.COM), [MBNACREDITCARDS.NET](http://MBNACREDITCARDS.NET) and [MBNACREDITCARDS.COM](http://MBNACREDITCARDS.COM). The Expert has read Attachment 12 referred to in the Complainant's Grounds of Complaint, which gives details of the registrations and the corresponding registered trade marks. The Expert can think of no legitimate reason for the Respondent to have registered these domain names. The evidence supports

the view that the Respondent is indeed engaged in a pattern of making Abusive Registrations.

Paragraph 3 a iv of the Policy reads:

“It is independently verified that the Respondent has given false contact details to us”

Finally, the Complainant has alleged that the Respondent has given false or misleading contact details. The fact that the Complainant has been unable to obtain a telephone number for the Respondent listed at the address given to Nominet does not necessarily mean that the contact address is false. There may also be good reasons (such as convenience) for the Respondent to have used another e-mail address when contacting the Complainant on 27 February 2001. As mentioned in Paragraph 4 of this Decision, there appears to be no reason to conclude that the Respondent has not received communications sent to him by post and e-mail. On the evidence available, the Expert does not consider that this particular aspect of the complaint is proved.

The Expert has also considered Paragraph 4 of the Policy headed “How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration”. The Respondent has not responded to the complaint. On the evidence available, the Expert cannot suggest any reasonable response which the Respondent could make under Paragraph 4 of the Policy in this case. Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in Paragraph 1 of the Policy.

## **8 Decision**

In light of the above findings, namely that the Complainant has Rights in respect of a name or mark which is identical 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 [www.gecapitalfinance.co.uk](http://www.gecapitalfinance.co.uk) be transferred to the Complainant.



David King

22 February 2002