

DISPUTE RESOLUTION SERVICE

DRS 07470

Decision of Independent Expert

The Prudential Assurance Company Limited

and

Mrs D A Cripps

1. The Parties:

Complainant: The Prudential Assurance Company Limited
Address: David Taylor
Laurence Pountney Hill
London
Postcode EC4R 0HH
Country United Kingdom

Respondent: Mrs. D A Cripps
Address: ATTN prudentialserv.co.uk, care of Network Solutions, PO Box
447
Herndon, VA.
Postcode: 20172
Country: United States

2. The Domain Name:

The domain name in dispute is prudentialserv.co.uk (the "Domain Name").

3. Procedural History:

Capitalized terms used in this decision have the meaning given to them in the Nominet Dispute Resolution Service (“DRS”) Policy and Procedure, Version 3 of July 2008 (“the Policy” and “the Procedure” respectively)

Nominet served the Respondent with the Complaint on 29 July 2009:

- (a) by email to postmaster@prudentialserv.co.uk;
- (b) by email to qp58y79y26j@networksolutionsprivateregistration.com;
- (c) by registered post to the Respondent’s address, as above; and

advised the Respondent it had until 19 August 2009, to respond. No response was received by then or at all.

Both parties were notified of the default on 20 August 2009, and the Complainant was advised that to appoint an independent expert it could pay the relevant fee by 4 September 2009. The Complainant duly paid the fee.

Confirming there was no reason why the appointment could not be accepted, and on providing a declaration of impartiality and independence, I was appointed as the independent expert in this dispute on 7 September 2009.

4. Procedural Issues

4.1 Service

The DRS derives its jurisdiction from the terms and conditions of the contract of registration between the Respondent and Nominet (“the Contract”).

Clause 14 of the Contract incorporates the Policy and Procedure by reference. Clause 4.1 requires a Registrant’s details to be entered in the Register and the Registrant agrees to ensure that Nominet has its correct postal address, telephone and fax number and email address. Certain details are also posted on the public WHOIS database. Failure to provide correct details, or keep them current, may be grounds for cancellation or suspension of a domain name, per clause 17.2.

The relevance of this is that §2(a) of the Procedure provides a Respondent will be served with a Complaint, at Nominet’s discretion by any of: first class post, fax or email to the contact details in the Register; by email to postmaster@<the domain name in dispute>; or any email addresses shown on any active web pages to which the domain name resolves.

The Respondent’s Network Solutions WHOIS entry, provided at Annex 8 to the Complaint, gives the postal address above and the Respondent’s email address as qp58y79y26j@ networksolutions privateregistration.com. The Contract clearly

renders the Respondent responsible for any failure to notify Nominet of changes to its details. The Complaint is therefore deemed validly served.

4.2 Default

Although the Respondent has failed to submit a Response, or make any other submission, the Procedure does not provide for a default decision in favour of the Complainant. The Complainant must still prove its case to the requisite standard, see §15(b) of the Procedure. However, an expert may draw such inferences from a party's default as appropriate.

5. Factual Background

The Complainant is a wholly-owned subsidiary of Prudential plc, the insurance company. Founded in 1848, by 2007, Prudential had over 21 million customers, policyholders and unit holders worldwide, and employed over 80,000 people and a network of agents. The Prudential Group's 2007 operating profit before tax from continuing operations was some £2.5 billion.

According to the WHOIS search, the Domain Name was registered on 27 February 2008, using a WHOIS privacy service to protect the Respondent's contact details. In July 2009, the Domain Name pointed to a password protected webpage, as demonstrated by a screen print submitted at Annex 9 to the Complaint, ----it resolved to the same page on 7 September 2009.

The Complainant apparently became aware of the Domain Name in June 2009, when a potential victim of an advance fee fraud brought it to its attention. The Domain Name and related email addresses were provided to the potential victim by the perpetrators to open an account with the fictitious Prudential Offshore Services and deposit over £5,000 –all in order to share in a legacy of some 11 million dollars. The account opening form of Prudential Offshore Services employed the Complainant's logo. The email chain and other documents were exhibited to the Complaint at Annex 10.

The Complainant has contacted the relevant authorities in the UK and has sought this decision to fight fraud and protect its reputation and brand.

6. Parties' Contentions

The Complainant says it has Rights in the name Prudential and relies on its registered UK mark, No. 2025359 in class 36 (insurance and banking services etc.), and its Community Mark, No. 000158600 for classes 35 (accounting and business services etc.), 36 (as above) and 42 (computer, consultation and advisory services etc.). The Complainant provided screenshots from the UKIPO¹ and OHIM² of the registrations at Annex 4 to the Complaint.

¹ UK Intellectual Property Office: www.ipo.gov

² Office for Harmonisation of the Internal Market:
http://oami.europa.eu/CTMOnline/RequestManager/en_SearchBasic#

It says these registered marks are well known for the purposes of Article 6bis of the Paris Convention³ and relies on findings in three WIPO as to their strong reputation, see WIPO Cases No. D2005-0934, D2006-0426 and D2008-09 Complainant 77 respectively.

It also relies upon its unregistered rights arising from its international reputation and goodwill, evidenced by Corporate Reports and Accounts at Annex 1 to the Complaint and its various websites such as Prudential.eu, Prudential.co.uk and Pru.co.uk.

The Complainant says the Domain Name is similar to its name and marks and the addition of the word 'Serv' does not distinguish the Domain Name as Prudential is the distinctive and dominant element of the marks, reproduced in its entirety. It relies on *Miles-Bramwell Executive Services Ltd. v. Shaw*, DRS 06361 (<slimming-world-guide.co.uk> was similar to slimming world).

The Complainant says the Domain Name is an Abusive Registration in the hands of the Respondent. It has been used to defraud and deceive the potential victim—and no doubt others. Posts on an internet forum assuming a connection to the Complainant were relied on as further evidence of confusion. It says the Respondent was aware of the Complainant and its reputation, as demonstrated by use of its logo. It notes the Respondent has failed to come forward with any other explanation or justification for its registration. It cites *Royal Bank of Scotland Group Plc v Bent Williams*, DRS 04123 and *Chivas Brothers Limited v. Plenderleith*, DRS 00658.

7. Discussions and Findings

The DRS is designed as a fast, simple alternative to litigation.

Domain names are registered on a first come, first served, basis and a registration will only be disturbed if an Abusive Registration, as defined in the Policy. Paragraph 2(a) of the Policy requires the Complainant prove 2 elements:

“i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

³ Art. 6bis provides: “(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith. (2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested. (3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.”

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

The Complainant bears the onus of proof and must prove both elements on the balance of probabilities. As mentioned above, even where no Response is submitted, the Complainant must meet this burden.

The DRS’s jurisdiction under the Contract is limited to these issues and the remedies of cancellation, suspension, transfer or amendment of the Domain Name. The Policy does not provide for the determination of allegations of trade mark infringement or passing-off proper.

7.1 Rights

Rights under the Policy include rights to registered and unregistered trade marks and names and contractual rights to the same. The Complainant clearly has Rights in the name and mark Prudential by virtue of its registered marks and its goodwill arising through its 160 year use. It is a well known mark with a reputation in the United Kingdom.

Paragraph 2(a)(i) of the Policy requires that the name or mark in which a Complainant has Rights “is identical or similar to the Domain Name.” The addition of a generic and nominative term such as Serv, an abbreviation for Service, does not alter the overall impression and the distinctive or dominant component is the word Prudential, which conveys authorisation or connection with the Complainant.

I am satisfied the Complainant has Rights in a mark and name similar to the Domain Name.

7.2 Abusive Registration

The second element the Complainant must prove under §2(a) of the Policy, is the Domain Name is an Abusive Registration, defined in §1 thereof. §3 of the Policy provides a non-exhaustive, illustrative, list of factors, which may evidence an Abusive Registration. Conversely, §4a of the Policy provides a non-exhaustive list of factors which may evidence that a registration is not an Abusive Registration.

The Appeal Panel in *Verbatim* DRS 4331 noted that some knowledge of the Complainant and its rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details) and knowledge and intention are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy.

I have no doubt this Respondent knew the Complainant and selected it deliberately and calculatedly in order to leverage its reputation for prudence and respectability and searched the WHOIS databases for a variation to register –to facilitate its fraudulent scheme.

The evidence clearly establishes the Domain Name had been used for an actual fraud. It is clear that mere registration may create an instrument of fraud and

deception/confusion, as in *BT v One in a Million* [1999] 1 WLR 903, but in this case the Respondent had actually put the instrument into effect and we have documentary evidence of the fraud against one potential victim ---no doubt there were many others. This is clearly an Abusive Registration on all counts. Prudential is to be commended for seeking a full rather than a summary decision and thereby publicising the fraud and, hopefully, minimising its effects.

8. Decision

I find that the Complainant has Rights in a mark similar to the Domain Name, which is an Abusive Registration in the hands of the Respondent. Accordingly, the Domain Name should be transferred to the Complainant.

Signed: Victoria McEvedy

Dated: 11 September 2009