

DISPUTE RESOLUTION SERVICE

DRS 8323

Decision of Independent Expert

The Prudential Assurance Company Limited

and

Domain Governance, Inc

1. The Parties:

Complainant: The Prudential Assurance Company Limited
Address: 6 avenue Kleber
Paris
Postcode 75116
Country: France

Respondent: Domain Governance, Inc
Address: 3 Winchester Street
Nassau
Bahamas
Postcode: BH004
Country: Bahamas

2. The Domain Name:

pruhealth.co.uk

3. Procedural History:

The Complaint was lodged with Nominet on 26 February 2010. Nominet validated the Complaint and informed the Respondent that the Dispute Resolution Service (“DRS”) had been invoked and that the Respondent had 15 working days to submit a Response. The Respondent lodged a Response on 2 March 2010. The Complainant lodged a Reply to the Response on 3 March 2010. On 22 March 2010

the Complainant paid Nominet the appropriate fee for a decision of an expert pursuant to paragraph 7 of the Nominet DRS Policy ("the Policy"). On 30 March 2010 Nominet appointed Andrew Clinton ("the Expert") as the Independent Expert.

The Expert has confirmed to Nominet that he knows of no reason why he could not properly accept the invitation to act as Expert in this case, and has further confirmed that he knows of no matters which ought to be drawn to the attention of the parties which might appear to call into question his independence.

4. Factual Background

The Complainant is a well known company in the provision of financial and insurance products and one of its brands is Pruhealth, which it launched in October 2004. The Domain Name - which is a misspelled version of that brand name - was registered on 27 October 2008. The documents do not disclose much information about the Respondent other than it has a portfolio of domain names, some of which comprise well known brands or misspelled versions thereof.

This case is somewhat unusual in that the Respondent 'accepted' the Complaint (subject to a denial of 'bad faith' and of awareness of the Complainant's Rights) and offered to transfer the Domain Name to the Complainant (which is the remedy sought in the Complaint), but the Complainant decided not to accept that offer and to proceed instead to a full decision. In circumstances where a Complaint is accepted, it may not always be necessary to give full reasons for a Decision. Nevertheless in this case I accept the invitation of the Complainant to give full reasons for my Decision.

5. Parties' Contentions

Complainant

The Complaint, so far as is material, is summarised below.

The Complainant is a wholly-owned subsidiary of Prudential plc, a company registered in England and Wales under the number 1397169 (both companies together with their subsidiaries and associated companies are referred to collectively in the Complaint as "Prudential").

Prudential is a worldwide leader in the provision of financial and insurance products and services and was founded in the United Kingdom over 160 years ago. Prudential has more than 21 million customers, policyholders and unit holders worldwide. Worldwide it employs over 27,000 people and its shareholders number 75,438. Prudential have £249 billion of funds under management and, at 30 June 2009, it had an estimated capital surplus of £2.5 billion, before any allowance for the interim dividend.

In October 2004, Prudential launched a new business venture, PruHealth. PruHealth offers private medical insurance policies linking the cost of premiums to the efforts clients make to look after their health. PruHealth is a very distinctive, unique product in the United Kingdom.

With more than 21 million customers worldwide and such a large global footprint in the provision of financial and insurance products and services, the Complainant has developed a substantial worldwide reputation and goodwill in the PRUDENTIAL, PRU and PRUHEALTH brands. In the United Kingdom, Europe and Asia, Prudential extensively uses the brands PRUDENTIAL, PRU and PRUHEALTH.

Prudential is the registrant of the domain names <pruhealth.com>, <pruhealth.co.uk>, <prudentialhealth.com>, <prudentialhealth.co.uk> and <pruhealth.co.uk>

The Complainant holds exclusive rights over numerous trade marks in the terms PRU and PRUHEALTH, including the following:-

- Community Trade Marks: PRUHEALTH n°4059011 registered on 25 April 2006 for classes 35, 36 and 42 and PRU HEALTH n°4059044 registered on 26 April 2006 for classes 35, 36 and 42
- UK Trade Mark: PRU n° 2126507 registered on 12 March 1997 for classes 35, 36 and 42
- International Trade Mark: PRU n° 708233 registered on 5 February 1999 for class 36 and extended to the following countries: Hungary, Monaco, Poland, Turkey and Russia.

The Domain Name points to a website that offers sponsored results providing links to websites that promote the services of Complainant's competitors, such as www.swisscare-intl.com and www.allianzworldwidecare.com.

But for the addition of the letter "l", the term "pruhealth" is identical to the registered trade marks owned by the Complainant. Consumers are likely to misspell the term "pruhealth" when seeking to visit the website www.pruhealth.co.uk and thus to be directed to the Respondent's website providing sponsored links, including links to competitors of the Complainant.

When the URL www.pruhealth.co.uk is typed into an internet browser, it points to a website that offers sponsored results providing links to websites, including websites promoting the services of competitors of the Complainant.

The Respondent, Domain Governance, Inc. (if it exists), is not affiliated in any way with the Complainant or its parent, Prudential plc. In any event, no company of that name is registered in the Bahamas or in any other country. Indeed, the Complainant has found no references to these entities at BvD Orbis (worldwide database of company registrations) which would suggest that it is entirely fictitious.

The name PRUHEALTH is highly distinctive and very-well known in the context of health insurance products and services. It would therefore be inconceivable for the Respondent to argue that it was unaware of the Complainant and its PRUHEALTH trade marks at the time the Disputed Domain Name was registered, some four years after the PruHealth products and services were launched.

In the present case (1) the Disputed Domain Name is virtually identical to the PRUHEALTH name in which the Complainant has rights; (2) the name PRUHEALTH is highly distinctive in the context of health insurance products and services; (3) there is no obvious justification for the Respondent's registration of the Disputed Domain Name, other than to earn revenues by providing sponsored links; and (4) given the fact that the Disputed Domain Name appears to have been used to provide sponsored links to websites that promote the services of Complainant's competitors, the Respondent could not reasonably provide any explanation for having selected the Disputed Domain Name.

Furthermore, the Complainant can demonstrate that "the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .co.uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern. The Respondent has registered more than 2,000 .co.uk domain names, including more than 300 numerous domain names corresponding to well known names or trade marks (or misspellings thereof), in which the Respondent has no apparent rights.

The Respondent is the proprietor of other domain names featuring the well known trade marks of others and a pattern is established, even if there is no obvious link between such domain names and the domain name in question. It is irrelevant that the domain names were all registered at different times and that there is no obvious link between them, other than the fact that they all represent the famous trade marks of third parties.

The Complainant is well aware that trading in domain names for a profit, and holding a large portfolio of domain names, are of themselves lawful activities. However, this can only be said to be the case when the portfolio consists of generic domain names, not large numbers of domain names that specifically target third party trade marks and cannot have been registered innocently, as is the case here. Indeed, such registrations demonstrate that at least part of the Respondent's business activity relates to the gaining of undue benefit from the goodwill and reputation of legitimate businesses.

An Internet user entering www.pruhealth.co.uk into its Internet browser will reach a website containing numerous links to other businesses, including competitors of the Complainant. It is highly likely that some users may not pursue their search for the Complainant's website, thus affecting the traffic to the Complainant's website and consequently its business. The fact that Internet users may no longer be confused once they reach the website in question (or lack of it) is irrelevant, as the damage will have already been done. The Domain Name is therefore likely to create initial interest confusion to the detriment of the Complainant.

The Respondent is unable to rely on any of the circumstances listed in Paragraph 4 of the Policy, which sets out a non-exhaustive list of factors which may evidence that the Domain Name is not an Abusive Registration.

The Domain Name is a misspelling of the PRUHEALTH trade marks and points to a website providing links to websites that promote the services of Complainant's competitors. It is therefore clear that the Respondent has neither used the Disputed Domain Name in connection with a genuine offering of goods and services nor made a legitimate non-commercial or fair use of the Domain Name.

Furthermore, upon verification on the SAEGIS trade mark search engine, the Complainant can confirm that the Respondent does not hold any trade marks in a term corresponding to the Domain Name. In addition, there is nothing to suggest that the Respondent is commonly known by either the name PRUHEALTH or the name PRUHEALLTH.

The Respondent is also unable to argue that the Domain Name is generic or descriptive and the Respondent is making fair use of it. This can be demonstrated by the fact that a search on www.google.co.uk for the term PRUHEALTH generates results which refer exclusively to the Complainant or its services.

The Complainant submits that the Respondent cannot argue that the Domain Name is not part of a pattern.

The Complainant seeks a transfer of the Domain Name.

Respondent

The Response to the Complaint takes the form of an e-mail dated 2 March 2010 from Patrick Thibault on behalf of the Namefarm Team, which reads as follows:-

"Dear Sir or Madam,

thank you for your letter.

We didnt register the domain in bad faith and were not aware of TM rights on this domain.

Therefore, we accept the complaint and would like to transfer the domain pruheallth.co.uk instantly.

Please advice, how to do so.

Thank you for your help,

Namefarm Team”

Reply

The Reply to the Response confirmed that the Complainant wanted to proceed to a decision notwithstanding the Respondent’s offer to transfer the Domain Name. The Response explained that the Complainant wanted to deter the Respondent from filing any further domain names incorporating its brand.

6. Discussions and Findings

General

Under paragraph 2 of the Policy the Complainant has to prove on the balance of probabilities: firstly, that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant’s Rights

Rights are defined in the Policy as meaning rights enforceable by the Complainant, whether under English law or otherwise. The Complainant has produced a considerable volume of evidence which shows that it has developed a substantial reputation and goodwill in the PRUDENTIAL, PRU and PRUHEALTH brands. The Complainant is the owner of a number of registered trade marks for the marks PRU and PRUHEALTH. The Complainant has also produced evidence which shows that it has unregistered rights in the mark PRUHEALTH by reason of the use of that brand since October 2004. It is clear, on the evidence before the Expert, that the mark PRUHEALTH is recognised by the public as indicating the products and services of the Complainant.

The Domain Name is clearly similar to the mark in which the Complainant has established rights. The Domain Name is a misspelled version of the mark

PRUHEALTH; the only difference being the addition of the letter “I” in the Domain Name. The Complainant asserts that consumers are likely to misspell the term “pruhealth” when seeking to visit the website www.pruhealth.co.uk and thus be directed to the Respondent’s website providing sponsored links, including links to competitors of the Complainant. However, issues of confusion are best addressed under the second hurdle of Abusive Registration. The objective of the Rights test is simply to demonstrate that the Complainant has a bona fide basis for making the complaint and it clearly does in this case.

The Expert finds that the Complainant has Rights in the mark PRUHEALTH which is similar to the Domain Name. The Complainant has therefore succeeded in proving the first element required under paragraph 2(a)(i) of the Policy.

Abusive Registration

Abusive Registration is defined in paragraph 1 of the Policy to mean 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.

Factors pointing to Abusive Registration – paragraph 3 of Policy

A non-exhaustive list of factors which may be evidence of an Abusive Registration is set out in paragraph 3 of the Policy. The factors that are potentially relevant to this dispute are:

- a(i) Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

- A. [not relevant];
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant;
- (ii) Circumstances indicating that the Respondent is using 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;
 - (iii) The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under.uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

It is clear from the wording of the Policy that the list of factors at paragraph 3 is non-exhaustive and that a Complainant can succeed in proving Abusive Registration without necessarily being required to prove any of those factors. However, in order to do so it is necessary to prove that the definition of Abusive Registration, as set out in paragraph 1 of the Policy, has been satisfied.

Factors pointing against Abusive Registration – paragraph 4 of Policy

There is a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration at paragraph 4 of the Policy. The Respondent has not referred to any of those factors.

Discussion and findings regarding Abusive Registration

The Complainant makes a number of points on Abusive Registration, which can be summarised as follows:-

1. It is reasonable for the Expert to infer that the Respondent registered the Domain Name for an abusive purpose in light of the distinctiveness of the Complainant's brand and the fact that there is no obvious justification for the Respondent's decision to incorporate a misspelled version of that brand in the Domain Name (see the section below headed "Unfair Registration").
2. The Domain Name is likely to create "initial interest confusion" to the detriment of the Complainant (see the section below headed "Unfair Use").
3. The Respondent is engaged in a pattern of registrations where the Respondent is the registrant of a number of domain names which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern (see the section below headed "Pattern of Registrations").
4. The Respondent is unable to rely on any of the factors set out in paragraph 4(a) of the Policy which may be evidence that the Domain Name is not an Abusive Registration (see the section below "Paragraph 4 Factors").

The Respondent's case is that it did not register the Domain Name in bad faith and that it was not aware of any trade mark rights in the Domain Name. Of course, the concept of bad faith has no place in the DRS and, although the Complainant does not have a registered trade mark for the mark PRUHEALTH, that is not the test for establishing rights under the DRS. Accordingly, neither point raised in the Response assists the Respondent in this DRS dispute. In any event, the Respondent 'accepted' the Complaint and requested a transfer of the Domain Name to the Complainant. The Complainant could have accepted that request and the matter would have been at an end. Instead, the Complainant has requested a reasoned decision from an Expert appointed under the DRS Policy.

Unfair Registration

The first part of the definition of Abusive Registration, as set out in paragraph 1(i) of the Policy, is concerned with the Respondent's motivation at the time of registration

or acquisition of the Domain Name. The Domain Name was registered on 27 October 2008. The Complainant launched its PRUHEALTH business some 4 years earlier. The Complainant asserts that it is almost inconceivable that the Respondent did not know of the Complainant and its PRUHEALTH brand at the time of registration. The Respondent says it was not aware of any trade mark rights in the Domain Name. In light of the fact that (i) the brand PRUHEALTH is (and was at the time of registration) distinctive in the context of health insurance and services (ii) the Domain Name and the brand are extremely close and (iii) the Respondent has failed to offer any explanation for its choice of the word PRUHEALTH, the Expert is prepared to infer that the Respondent was well aware of the Complainant and its brand PRUHEALTH at the time registration and it deliberately selected that term because of its connection to the Complainant. The fact that the Respondent had by 27 October 2008 registered a number of other domain names which incorporate misspelled versions of third party brand names (as to which see the section headed "Pattern of Registrations" below) puts the matter beyond any doubt. On this basis, the Expert finds that the first part of the definition of Abusive Registration is satisfied.

Unfair Use

The second part of the definition of Abusive Registration, as set out in paragraph 1(ii) of the Policy, is concerned with the use of the Domain Name and the Complainant contends that the Domain Name has been used in an abusive manner. The Complainant says that the Domain Name is likely to create "initial interest confusion" because it is a misspelled version of its brand and that the confusion will be to the Complainant's detriment as the Domain Name points to a web site that contains a number of sponsored links which promote the services of competitors of the Complainant in the provision of health services and health insurance.

There is a helpful analysis of the concept of "initial interest confusion" in the Experts' Overview which is published on Nominet's web site. The Experts' Overview says:-

"Commonly, Internet users will visit websites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the website connected to the domain name in issue. Similarly, there is bound to be

a severe risk that an Internet user guessing the URL for the Complainant's website will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's website will be visiting it in the hope and expectation that the website is a website "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the website that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial website, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privilege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decision in DRS 00248 (seiko-shop.co.uk)."

Applying that reasoning to the facts in this case one is drawn irresistibly to the conclusion that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The particular features of this case are as follows:-

- The Domain Name is very close to the Complainant's mark; the only distinguishing feature being the addition of the letter "l".

- Pruhealth is a distinctive term – it is not a word or combination of words that has an ordinary English meaning and it cannot sensibly refer to anyone other than the Complainant.
- There is no obvious justification for the Respondent having adopted the term Pruhealth for the Domain Name.
- The Respondent has not offered any explanation for doing so, despite having filed a Response.
- The Domain Name points to a web site that contains sponsored links to the Complainant's competitors in the field of health insurance.

The only plausible explanation for the choice of the term Pruhealth is that the Respondent was operating in the hope and expectation that Internet users, who were looking for the Complainant, would misspell the term Pruhealth and find themselves at the Respondent's web site. Once there the Respondent hopes to derive a commercial gain through the use of sponsored links. The Respondent's intention was to exploit the goodwill attached to the mark Pruhealth for its own commercial purposes.

Even, if at that some point, an Internet user realises the web site is not connected to the Complainant that does not detract from the fact that the only reason the Internet user arrived at the web site in the first place was because of the initial interest confusion – the visitor has still been deceived. The Expert finds that the Domain Name has been used in a manner which has taken unfair advantage of the Complainant's Rights which amounts to Abusive Registration as defined in paragraph 1 of the Policy.

Pattern of Registrations

The Complainant claims that the Respondent has registered more than 2,000 .co.uk domain names, including more than 300 that correspond to well known names or trade marks, or misspellings thereof, in which the Respondent has no apparent rights. The Complaint has produced WHOIS reports for the following specific examples:-

1. <adobereader.co.uk>
2. <amaericanexpress.co.uk>
3. <amywinehous.co.uk>
4. <appleistore.co.uk>
5. <applestor.co.uk>
6. <bank-barclays.co.uk>
7. <bankofscotland-halifax.co.uk>
8. <barcaleys.co.uk>
9. <bbcnews-children7-11.co.uk>
10. <bodyshp.co.uk>
11. <cadburysword.co.uk>
12. <calvineklein.co.uk>
13. <dellsupport.co.uk>
16. <dominoepizza.co.uk>
17. <ebaymortors.co.uk>
18. <expressholidayinns.co.uk>
19. <googgl.co.uk>
20. <hewlettpackerd.co.uk>
21. <ho5tmail.co.uk>
22. <holidayjnn.co.uk>
23. <jaegger.co.uk>
25. <marksandspenceer.co.uk>
26. <mecerdes.co.uk>
27. <mitsubishi-retails.co.uk>
28. <plastation.co.uk>
29. <samnsung.co.uk>
30. <songericsson.co.uk>
31. <swarkoski.co.uk>
32. <symatec.co.uk>
33. <taxfreevolkswagen.co.uk>
34. <toyoya.co.uk>
35. <virgin-atlanic.co.uk>
36. <wwhsbc.co.uk>
37. <wwwlloydsb.co.uk>
38. <wwwrolexwatches.co.uk>

The Complaint picks up on the fact that there is a divergence of views among Experts as to what constitutes a pattern for the purposes of paragraph 3(a)(iii) of the Policy. This is explained in paragraph 3.5 of the Experts' Overview in the following terms:-

“What is meant by “pattern” in paragraph 3(a)(iii) of the Policy? What is meant by “and the domain name is part of that pattern” in the same subparagraph? The purpose behind this paragraph is to simplify matters for a Complainant, where the only available evidence against the registrant is that he is a habitual registrant of domain names featuring the names or marks of others. However, there is a divergence of view among Experts as to what constitutes a pattern for this purpose.

One view, as expressed by the Appeal Panel in DRS 04884 (maestro.co.uk), is that the mere fact that a registrant has some objectionable domain names in his portfolio cannot of itself be enough to render the domain name in issue an Abusive Registration. To get the benefit of this provision, the Complainant must show that the domain name in issue is part of a conscious policy on the part of the registrant. There must be evidence to justify the linking of the domain name in issue to the other objectionable domain names. The link may be found in the names themselves and/or in the dates of registration, for example.

The contrary view is that the pattern does not need to result from any conscious policy on the part of the Respondent. If the domain name in issue is a well-known name or mark of the Complainant and the Respondent is the proprietor of other domain names featuring the well-known names or marks of others, the pattern is likely to be established, even if there is no obvious link between the names or the manner or their dates of registration.

In practice it is unlikely that this difference of view is likely to have much of an impact. If the domain name in issue is a well-known trade mark of the Complainant and there is no obvious justification for the Respondent being in possession of the domain name, it is probable that the Complaint will succeed on other grounds.”

It is not for this Expert in this decision to attempt to resolve the divergence of views among Experts as to paragraph 3(a)(iii) of the Policy. The function of an Expert is to

decide a particular complaint on the basis of the parties' submissions, the Policy and the Procedure.

The Expert has reviewed a number of previous DRS decisions that relate to paragraph 3(a)(iii) of the Policy and there are decisions that go either way, which is not surprising bearing in mind that each case is decided on its particular facts. The Appeal Panel in DRS 04884 (maestro.co.uk) said that the 12 identified domain names (relied upon as constituting a pattern in that case) did indeed represent a pattern but the domain name in dispute was not part of that pattern. They came to this view on the basis that (i) the word "maestro" was at least as well known for its ordinary English meaning as anything else whereas the 12 identified domain names were so well known that their ordinary meaning was overwhelmed by their fame as trade marks, (ii) the 12 identified domain names were registered over an extended time period and (iii) the 12 identified domain names represented only a small proportion of the Respondent's portfolio.

The Expert in DRS 6828 (countryproperties.co.uk) agreed with the Respondent in that case that one previous adverse finding under the Policy was not indicative of a pattern, nor was an isolated registration with no apparent connection to the Respondent. The Expert said in that case "the mere fact that a registrant has some objectionable domain names in his portfolio cannot of itself be enough to render the Domain Name an Abusive Registration." The Expert referred to the Appeal Panel's decision in DRS 04884 and said it suggested that the Complainant must provide evidence to justify linking the Domain Name to the other objectionable domains. The Expert's view, in that case, was that such evidence had not been provided.

The evidence that has been adduced by the Complainant in this case - which has not been challenged by the Respondent - clearly demonstrates that the Respondent is the registrant of 38 domain names which are either identical to, or misspelled versions of, well known brand names or marks. The first part of paragraph 3(a)(iii) of the Policy is clearly satisfied and the only real issue is whether the Complainant has demonstrated that the Domain Name is part of that pattern. The Expert's view is that the Complainant has established, on the evidence in this case, that the Domain Name is part of that pattern. The Domain Name is a misspelled version of a well known brand as are almost all of the 38 identified domain names. The WHOIS print-outs show that in an 8 day period the Respondent registered bodyshp.co.uk (on 20 October 2008), bankofscotland-halifax.co.uk (on 21 October 2008), googgl.co.uk and

virgin-atlantic.co.uk (both on 23 October 2008), mercedes.co.uk and swarkoski.co.uk (both on 24 October 2008), dominoepizza.co.uk, wwwrolexwatches.co.uk and the Domain Name (all on 27 October 2008). The Respondent registered a further 8 of the identified domain names during November 2008.

In DRS 04884 the Appeal Panel felt that maestro.co.uk was in a different category to the 12 identified domain names as “maestro”, as a term, was at least as well known for its ordinary English meaning as anything else. That distinguishing feature - between the domain name in dispute and the other identified domain names - is not present in this case. The concluding words of paragraph 3(a)(iii) must have some meaning and, in this case, there is clear evidence that the Domain Name is part of the pattern. The Complainant invites the Expert to rule that, as a matter of principle, paragraph 3(a)(iii) is satisfied even if there is no obvious link between the identified domain names and the Domain Name other than the fact that they all represent the famous trade marks of third parties. The Expert declines that invitation as it is not necessary to express a view on that point in order to determine this case – there very clearly are links in this case both in terms of the nature of the domain names and the dates of registration. Whether the outcome of this dispute would be the same if those links were not present is not a matter for this Expert. The Complaint says that the identified domain names were all registered at different times but, as illustrated above, two of them were registered on the same day as the Domain Name and many others within a matter of weeks. There is a link whether the Complainant seeks to rely on it or not.

Paragraph 4 Factors

The Complainant also says that the Respondent is unable to rely on any of the factors listed in paragraph 4 of the Policy which sets out a non-exhaustive list of factors which may evidence that the Domain Name is not an Abusive Registration. Paragraph 5(c)(ii) of the DRS Procedure says that the Response shall include any relevant factors set out in paragraph 4 of the Policy. The Respondent did not refer to any of the paragraph 4 factors. In any event, there is no evidence of any of those factors being present in this case.

7. Decision

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

Signed: **Andrew Clinton**

Dated 30 April 2010