

DISPUTE RESOLUTION SERVICE**D00021793****Decision of Independent Expert**

FIL Limited

and

Siglerbay inc

1. The Parties

Complainant: FIL Limited
Pembroke Hall
42 Crow Lane
Pembroke HM 19
P.O. Box HM 670
Hamilton, HMCX
Hamilton
Pembroke
Bermuda

Respondent: Siglerbay inc
21 BELVIEW AVENUE
TEXAS
TEXAS
77002
Nigeria

2. The Domain Name

fidelityinvestmentsgroup.uk

3. Procedural History

- 3.1 I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.
- 3.2 On 5 September 2019 the dispute was received and on 9 September 2019 the complaint was validated and notification of it sent to the parties. On 26 September 2019 a response reminder was sent. On 1 October 2019 a notification of no response was sent to the parties. On 11 October 2019 a summary/full fee reminder was sent and on 14 October 2019 the Expert decision payment was received.
- 3.3 I am satisfied that the complaint was served upon the Respondent in accordance with paragraphs 3 and 6 of the Nominet Dispute Resolution Service Policy ("the Policy").

4. Factual Background

- 4.1 The Complainant is an investment fund manager which was formerly known as Fidelity International Limited and which trades under the name Fidelity International. The Complainant and its subsidiaries provide a range of financial investment services worldwide to private and corporate investors. It is the UK's largest ISA provider and in recent years has been in the top 10 for mutual fund providers.

- 4.2 The Complainant is the registered proprietor of the following trade mark registrations:
- (a) EUTM no. 3844925 for FIDELITY registered in classes 16 and 36 on 21 September 2005;
 - (b) EUTM no. 14937395 for an 'F' device mark registered in classes 35, 36, 38, 41 and 42 on 24 August 2016;
 - (c) EUTM no. 3844727 for FIDELITY INVESTMENTS registered in classes 16 and 36 on 1 September 2005;
 - (d) EUTM no. 12691432 for FIDELITY WORLDWIDE INVESTMENT registered in Classes 35, 36 and 42 on 23 July 2014;
 - (e) EUTM no. 14770598 for FIDELITY INTERNATIONAL registered in Classes 35 and 36 on 22 March 2016;
 - (f) EUTM no. 14937361 for F FIDELITY INTERNATIONAL device mark registered in classes 35, 36, 38, 41 and 42 on 24 August 2016;
 - (g) EUTM no. 14939854 for F FIDELITY INTERNATIONAL device mark registered in classes 35, 36, 38, 41 and 42 on 24 August 2016 (the "Fidelity Logo Mark");
 - (h) EUTM no. 10054377 for FIDELITY WORLDWIDE INVESTMENT device mark registered in classes 35, 36 and 42 on 2 August 2012;
 - (i) EUTM no. 10054393 for FIDELITY WORLDWIDE INVESTMENT device mark registered in classes 35, 36 and 42 on 13 July 2012; and
 - (j) EUTM no. 4579009 for FIDELITY INTERNATIONAL registered in classes 16, 35 and 36 on 7 July 2006.
- 4.3 The Domain Name was registered on 23 March 2019. On 28 August 2019 it was used for a financial services web site. On 4 September 2019 the site at the Domain Name displayed a notice that the Domain Name had been seized pursuant to an order issued by a US District Court and that a federal jury had "indicted" several individuals and entities involved in the operation of the Domain Name and related web sites charging them for federal crimes.

Parties' Contentions

- 5.1 I set out below a summary of what I consider to be the Complainant's main contentions in the complaint.
- 5.2 The Complainant asserts the following Rights:
- (a) The Complainant says it is one of the largest and best known investment fund managers in the world and has provided its services under the FIDELITY mark and marks which include FIDELITY (collectively the "FIDELITY Marks") for over 40 years. The Complainant says that it, its subsidiaries and related companies have built up considerable reputation and goodwill internationally in the FIDELITY Marks in relation to financial services, including in the UK. The Complainant states it has nearly 1,200,000 customers in the UK and looks after assets worth over £149.3 billion.
 - (b) The Complainant says it has invested substantially in advertising and promoting its services under the FIDELITY Marks including broadsheet advertising in the UK and advertising in trade magazines. The Complainant states that it and its subsidiaries regularly place banners and sponsored content on around 35 third party financial and corporate web sites targeting international investors and financial advisors and have invested in sponsored ads in response to key word search terms such as 'personal pensions'.
 - (c) The Complainant says that for at least 20 years it and its subsidiaries have promoted services provided under the FIDELITY Marks on the site at fidelity.co.uk and they have invested over the years in web site optimisation to ensure the maximum visibility for this site to Internet users searching for common investment terms.

- (d) The Complainant states that it, its subsidiaries and related companies have used other domain names for sites promoting services provided under the FIDELITY Marks including fidelityinvestment.com registered on 21 January 1998 and fidelityinvestments.com registered on 16 May 2000 both of which link to the sites of the Complainant's US sister company; fidelityinvestment.co.uk registered on 14 July 2005; and fidelityinvestments.co.uk registered on 9 December 1999 which redirects to fidelity.co.uk. The Complainant says its US sister company uses fidelity.com to promote its FIDELITY branded financial services business and this site attracts substantial numbers of visitors.
 - (e) The Complainant relies on its registered trade marks as set out at paragraph 4.2.
- 5.3 The Complainant asserts that the Domain Name is an Abusive Registration for the following reasons:
- (a) The Complainant says FIDELITY is the distinctive element in the Domain Name, that 'investments' and 'group' are descriptive terms in the financial services field and do not distinguish the Domain Name from the FIDELITY Marks. It contends that 'investments' in the Domain Name reinforces the impression that there is a connection between the Domain Name and the Complainant and its investment business. The Complainant argues that the average consumer is likely to assume the Domain Name links to the Complainant's site or a site connected to it and that such confusion is unfairly detrimental to the Complainant's Rights as it has and will divert traffic away from the Complainant's sites.
 - (b) The Complainant says the Respondent has no rights or legitimate interests in the Domain Name; that it has not authorised or permitted the Respondent to use the FIDELITY Marks; the Respondent is not making any legitimate non-commercial or fair use of the Domain Name; and the Respondent is not using the Domain Name or a name corresponding to it in connection with a bona fide offering of goods or services.
 - (c) The Complainant says the Respondent's site at the Domain Name has made unauthorised use of the FIDELITY and FIDELITY INTERNATIONAL trade marks in order to masquerade as the Complainant. It argues that the registration and use of the Domain Name infringes its intellectual property rights in breach of clause 6.1.3 of Nominet's Terms and Conditions and therefore takes unfair advantage of and is unfairly detrimental to the Complainant's Rights.
 - (d) The Complainant contends that the Domain Name is being used in connection with fraud or phishing activity as indicated by the following factors:
 - (i) The use of the Complainant's registered trade marks on the site at the Domain Name.
 - (ii) The Complainant says the contact details on the site at the Domain Name are those of its UK company, Fidelity International, and when a user clicks on the 'Contact Support' tab on the Respondent's site an error message appears.
 - (iii) The Complainant states the social media icons on the Respondent's site do not link to any content.
 - (iv) The Complainant says the Respondent's site refers to unrealistic financial returns and benefits, uses poor English and contains spelling and other errors and statements which would not be expected from a legitimate company offering services to UK consumers. The Complainant contends these are well known hallmarks of a phishing site.
 - (e) The Complainant contends that the Respondent is making unauthorised use of a mark similar to the FIDELITY Marks in an attempt to masquerade as the Complainant to Internet users and to lure them to the Respondent's site under the false impression that they are dealing with the Complainant and/or to take advantage of the Complainant's Rights as an Abusive Registration.

- (f) The Complainant says the Respondent is trading under the name Fidelity International on the site at the Domain Name which is identical to its trading name and several of its registered trade marks. The Complainant argues that taking into account its reputation and the use of FIDELITY in the Domain Name and on the site at the Domain Name it is inconceivable the Respondent did not know of the Complainant or its FIDELITY Marks when it registered the Domain Name. The Complainant says the Respondent is targeting UK consumers and registered and used the Domain Name with the intent to divert Internet users looking for the Complainant by creating a likelihood of confusion with the FIDELITY Marks for the Respondent's illicit gain. The Complainant contends that the Respondent is using the Domain Name for unlawful purposes in breach of clause 6.1.5 of Nominet's Terms and Conditions.
- (g) The Complainant says the notice that the Domain Name has been seized by the FBI contains spelling errors and the graphics appear stretched. It states that Nominet informed its representatives that the notice was added by the Registrar and to proceed with the filing of the complaint. The Complainant says it is unclear whether this notice is genuine or has been placed by the Respondent, but it indicates that the Domain Name is being used for unlawful purposes and is an Abusive Registration.

5.4 The Respondent has not submitted a response.

6. Discussions and Findings

6.1 The Complainant asserts in its complaint that there has been a breach of Nominet's Terms and Conditions. However, it is the Policy which governs Nominet's Dispute Resolution Service.

6.2 Paragraph 2.2 of the Policy sets out that the Complainant is required to prove to the Expert that both of the following elements are present on the balance of probabilities:

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

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

6.3 In this case no response has been submitted but the Complainant is still required to prove to the Expert that both the above elements are present on the balance of probabilities.

The Complainant's Rights

6.4 Under paragraph 1 of the Policy, Rights means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.*" It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.

6.5 In this case I am satisfied on the basis of the Complainant's registered trade marks set out in paragraph 4.2 that the Complainant has Rights in the FIDELITY and FIDELITY INVESTMENTS marks. I am also satisfied, on the basis of the Complainant's evidence, that it has unregistered passing off rights by virtue of use of the FIDELITY mark in association with investment and other financial services.

6.6 I consider that the FIDELITY and FIDELITY INVESTMENTS marks are similar to the Domain Name (disregarding the .uk suffix which it is common to ignore when making a comparison between the mark and the Domain Name). The additional terms in the Domain Name, being respectively 'investments' and 'group' and 'group' alone, are generic or descriptive in nature and do not distinguish the Domain Name from the Complainant's marks. I am therefore satisfied that the Complainant has Rights in names or marks, FIDELITY and FIDELITY INVESTMENTS, which are similar to the Domain Name.

Abusive Registration

- 6.7 Under paragraph 1 of the Policy, Abusive Registration means a Domain Name which either:
- i. *was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
 - ii. *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.

- 6.8 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration are set out at paragraph 5 of the Policy including:

5.1.1 *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

5.1.1.3 *for the purpose of unfairly disrupting the business of the Complainant.*

5.1.2 *Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.*

- 6.9 Paragraph 5.1.1 relates to the Respondent's motives at the time of registration of the Domain Name. For there to be an Abusive Registration under paragraph 1.i. of the Policy it must be established that the Respondent knew of the Complainant and/or its Rights at the time of registration of the Domain Name.
- 6.10 In this case the Complainant has adduced evidence, which I accept, that it has built up significant goodwill in the FIDELITY mark. The Respondent's site at the Domain Name promotes financial services. The site prominently features the FIDELITY Logo Mark, which includes a stylised form of 'Fidelity', including in the top left hand corner of the first page of the site, the same location as this mark is used on the Complainant's site. The Respondent's site uses 'Fidelity', 'Fidelity International' and 'Fidelity Investments' and the contact address given is that of the Complainant's associated UK company. In my view the site at the Domain Name gives every impression that it is operated by the Complainant or one of its subsidiary or related companies.
- 6.11 The Respondent has not responded to the complaint or given any explanation as to why it registered the Domain Name. In the circumstances I am satisfied that the Respondent knew of the Complainant when it registered the Domain Name. I consider that the Respondent registered the Domain Name for the purpose of setting up a site which would give the impression to Internet users that they had reached the Complainant's site or that of a subsidiary or related company.
- 6.12 The Complainant and its subsidiary companies use FIDELITY for their businesses and domain names which are similar to the Domain Name including fidelity.co.uk, fidelity.com, fidelityinvestment.com, fidelityinvestments.com and fidelityinvestments.co.uk. Accordingly I consider there is a real risk that Internet users looking for the Complainant who guess the Complainant's URL will visit the Respondent's site. I also consider there is a real risk that Internet users will visit the Respondent's site in response to a search engine request looking for the Complainant. Once at the Respondent's site, given its contents, Internet users may be diverted into doing business or investing money with the Respondent believing that they are dealing with the Complainant or a subsidiary or related company.
- 6.13 I consider that the Respondent registered the Domain Name, with knowledge of the Complainant, for the purpose of unfairly disrupting the business of the Complainant by unfairly taking advantage of the likely confusion of Internet users to divert them into doing business or investing money with it. This is evidence that the Domain Name is an Abusive Registration under paragraph 1.i. of the Policy.

- 6.14 I also consider that there is evidence of an Abusive Registration under paragraph 5.1.2 of the Policy. As set out above there is a likelihood of Internet users being initially confused into visiting the Respondent's site in the expectation of finding the Complainant (or a subsidiary or related company) and of potentially being diverted into doing business with or investing money with the Respondent. Even if users appreciate that they have not found the Complainant (or a subsidiary or related business) when they reach the Respondent's site (which I regard as highly unlikely) the Respondent has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant. This is evidence that the Domain Name is an Abusive Registration under paragraph 1.ii. of the Policy.
- 6.15 I do not consider that any of the factors which may be evidence that the Domain Name is not an Abusive Registration under paragraph 8 of the Policy apply.
- 6.16 Accordingly I conclude that the Domain Name is an Abusive Registration under paragraphs 1.i. and 1.ii. of the Policy.
- 6.17 Finally under paragraph 25 of the Policy, if it is brought to Nominet's attention that legal proceedings relating to the Domain Name are issued in a court of competent jurisdiction and have been served, Nominet will suspend the DRS dispute pending the outcome of those proceedings. I note that Nominet informed the Complainant's representatives that the FBI notice was added by the Registrar and to proceed with the filing of this complaint and that no action has been taken by Nominet to suspend this dispute.

7. Decision

- 7.1 I find that the Complainant has Rights in a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I direct that the Domain Name be transferred to the Complainant.

Signed: Patricia Jones

Dated: 11 November 2019