

Nominet UK Dispute Resolution Service

DRS 05362

The Royal Bank of Scotland Group Plc v Brainfire Group

Decision of Independent Expert

1. Parties

Complainant: The Royal Bank of Scotland Group Plc
Address: Business House F
Gogarburn
Post Office Box 1000
Edinburgh

Postcode: EH12 1HQ
Country: GB

Respondent: Brainfire Group
Address: Post Office Box 68229
28 Crowfoot Terrace NW
Calgary Alberta

Postcode: T3G 3N8
Country: Canada

2. Domain Name

rbsonlinebanking.co.uk

3. Procedural Background

The Complaint was lodged with Nominet on 9 January 2008. Nominet validated the Complaint and notified the Respondent of the Complaint on 10 January 2008 and informed the Respondent that it had until 1 February 2008 to lodge a Response. No Response was received from the Respondent and, on 4 February 2008, Nominet informed the parties that, in the circumstances, Nominet could not provide mediation and invited the Complainant to pay the fee to obtain an Expert Decision by 18 February 2008. On 8 February 2008 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

On 11 February 2008 the undersigned David King ("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. Nominet appointed the Expert in this matter on 15 February 2008.

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 Nominet's Dispute Resolution Procedure ("the Procedure").

Nominet has written to the Respondent at the above postal address, which is shown in the Register Entry in the WHOIS query result provided by Nominet to the Expert and to postmaster@natwestonlineb.co.uk. One of the e-mails to the postmaster address resulted in a Delivery Failure Report but, as far as the Expert is aware, the letters, which were sent by Air Mail were delivered to the Respondent.

The Expert is satisfied that the Complaint was properly delivered to the Respondent within the terms of the Procedure and that, in the absence of a response from the Respondent, there are no exceptional circumstances present to prevent the Expert from proceeding with the Decision of this Complaint.

5. The Facts

The Complainant is a major financial services provider in the UK and elsewhere in the world.

The Complainant has been registered at Companies House since 1968.

A significant part of the Complainant's business revolves around its online banking services.

The Complainant has numerous registrations for its RBS family of marks, including with the UK Intellectual Property Office ("UKPO") and with the EU Office for Harmonization in the Internal Market ("OHIM").

The Complainant owns domain name registrations featuring the RBS mark, including rbs.co.uk, (registered prior to August 1996) and rbs.com (registered 6 September 2004)

The Respondent registered the Domain Name on 24 February 2005.

6. The Parties' Contentions

Complainant

The Complainant has made detailed submissions which can be summarised as follows:

The Complainant has rights in respect of names and marks that are similar to the disputed Domain Name.

RBS is one of the world's leading financial services providers and one of the oldest banks in the UK. In addition to its strong UK presence, RBS has offices elsewhere in Europe, and in the United States and Asia.

RBS operates a number of brands worldwide and offers a wide range of financial products and services, including online banking services, to both individual and institutional investors.

The Complainant has been registered at Companies House since 1968.

A significant part of the Complainant's business today revolves around its online banking services, through which customers can, among other things, pay bills, effect transfers of funds, organise debts and assets, view account histories, and access multiple accounts.

The Complainant has rights in respect of the RBS name and mark, on which this complaint is based.

The Complainant has numerous registrations for its RBS family of marks, including with UKPO and with OHIM.

The Complainant owns domain name registrations featuring the well-known RBS mark, including rbs.co.uk (registered prior to August 1996) and rbs.com (registered on 6 September 1994), which it uses to promote and operate its financial services business.

The Domain Name is similar to the Complainant's RBS name and mark, to which the Respondent has simply added the generic term "onlinebanking".

The Respondent registered the Domain Name on 24 February 2005, almost 10 years after the Complainant acquired rights in its RBS marks.

The Respondent appears to have no legitimate rights to the Domain Name.

The Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the Complainants' business. Internet users seeking the Complainant's online banking services are diverted to the Respondent's web-site which the Respondent uses to promote online banking services, quotes for loans and direct links to competing financial services.

The Respondent has used the Domain Name to benefit commercially from its unauthorised and illegitimate use of the Complainant's mark and associated goodwill.

The Respondent is using the Domain Name in a way that has confused people, and has potential to confuse people into believing, that the Domain Name is registered to the Complainant, is operated or authorised by the Complainant, or otherwise is connected with the Complainant.

In the preceding 2 years, the Respondent has demonstrated a clear pattern of similar abusive registrations.

The Complainant requests that the Domain Name be transferred to the Complainant.

The Expert has perused the extensive documentation, which the Complainant has supplied in support of its contentions.

Respondent

The Respondent has not responded to the Complaint.

7. Discussion and Findings:

General

Paragraph 2 of Nominet's Dispute Resolution Policy ("the Policy") requires that, to succeed, the Complainant must prove to the Expert, on the balance of probabilities, both 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 as defined in paragraph 1 of the Policy.

Complainants' Rights

Under paragraph 1 of the Policy, "Rights" includes, but is not limited to, rights enforceable under English law.

The Complainant has provided full details of its various trademark registrations for the RBS mark, its incorporation at Companies House and its domain name registrations. The Complainant has referred to earlier DRS decisions in support of its submissions.

The distinctive part of the Domain Name is "rbs". The additional wording "onlinebanking" is generic. The Complainant has referred to the case of *The Royal Bank of Scotland Group v Laverio* (DRS 3953) regarding "onlinerbs.co.uk", in which the then Expert found that the word "online" was generic and did not make the domain name distinct from the RBS mark. The Expert is aware that there have been a number of similar cases in which generic wording has been added to well-known marks, including the Complainant's marks. In all these cases, the generic wording has been discounted and the domain names have been found to be similar to the complainant's marks.

The Expert is satisfied that the Complainant has demonstrated that it has Rights in respect of the RBS mark.

The Expert finds that, for the purposes of the Policy, the Complainant has Rights in respect of a name or mark which is similar to the Domain Name.

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 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.

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.

Under paragraph 3 a iii it may be evidence of Abusive Registration if "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." Paragraph 3 c of the Policy provides that "There shall be a presumption of Abusive Registration if the Complainant proves that Respondent has been found to have made an Abusive Registration in three (3) or more Dispute Resolution Service cases in the two (2) years before the Complaint was filed. This presumption can be rebutted (see paragraph 4 (c))."

In the Complaint, the Complainant has referred to five DRS cases in the preceding two years in which Abusive Registration was found, namely DRS 2908, DRS 3386, DRS 3817, DRS 4001, DRS 4551, DRS 4575 and DRS 5063. The Expert has perused the four most recent of these cases – DRS 4001 re "generaldynamics.co.uk" decided on 3 November 2006, DRS 4551 re "banburyandcake.co.uk" decided on 14 May 2007, DRS 4575 re "joulesestateagents.co.uk" decided on 13 May 2007 and DRS 5063 re "kiddicar.co.uk" decided on 2 November 2007. In each of these cases the Respondent was Brainfire Group of the same address as the address shown in the heading to this decision.

The Respondent has not responded to the Complaint and the Expert has not seen any evidence whereby the presumption in paragraph 3 a iii might be rebutted. The Expert finds the registration of the Domain Name to be abusive on this ground alone. It is therefore not necessary to consider the other grounds of the Complaint.

8. Decision

In light of the above findings, namely that the Complainant has Rights in respect of 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, the Expert directs that the Domain Name www.rbsonlinebanking.co.uk be transferred to the Complainant.