

DISPUTE RESOLUTION SERVICE

D00019304

Decision of Independent Expert

AXA

and

Mr Giovanni Pompilio

1. The Parties:

Complainant: AXA
25 Avenue Matignon
Paris
75008
France

Respondent: Mr Giovanni Pompilio
38 Discovery Walk
London
Greater London
E1W 2JG
United Kingdom

2. The Domain Name:

axaservice.co.uk

3. Procedural History:

I can 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.

04 September 2017 15:53	Dispute received
05 September 2017 08:47	Complaint validated
05 September 2017 08:54	Notification of complaint sent to parties
12 September 2017 09:55	Response received
12 September 2017 09:55	Notification of response sent to parties
14 September 2017 10:15	Reply received
14 September 2017 10:16	Notification of reply sent to parties
14 September 2017 10:20	Mediator appointed
19 September 2017 13:36	Mediation started
05 October 2017 12:29	Mediation failed
05 October 2017 12:30	Close of mediation documents sent
17 October 2017 02:30	Complainant full fee reminder sent
17 October 2017 10:29	Expert decision payment received

4. Factual Background

I have taken the following summary of the factual background from the parties' submissions:

- The Complainant is a very well-known global business involved in insurance and financial services and has traded in a very significant way under the AXA name since 1985.
- Between 2001 and 2003 the Respondent worked in Italy for an information technology company called Axaservice Srl, which has ceased trading.
- The Respondent subsequently registered the Domain Name on 10 October 2009 and then incorporated a UK company, Axaservice Consulting Limited, on 27 January 2010. That company was dissolved on 6 September 2011.
- The Respondent says he has kept the registration of the Domain Name so that he has the option of re-opening his consulting company and using a website and email address with a matching name.
- The Domain Name now resolves to a parking page which has displayed links to other websites under various headings including 'finance' and 'insurance'.
- The Respondent says the parking page is the responsibility of Fasthosts, the registrar company who manage the Domain Name for him, and it is nothing to do with him.

5. Parties' Contentions

In summary, in its complaint, which was supported by various exhibits, the Complainant stated as follows:

- The Complainant is registered at French Companies House under the name AXA. AXA SA is the holding company of AXA Group, whose main business is in the field of insurances and financial services.
- The AXA Group has a strong, long-standing history and its roots go back to the 18th century. After a succession of mergers, acquisitions and name changes involving some of the biggest insurance companies around the world, the trade name AXA was introduced in 1985.
- Since 1988, AXA has been traded on the Paris Stock Exchange and in 1996 it became listed on the New York Stock Exchange. It now employs 165,000 people worldwide serving 107 million customers and has a presence in 64 countries in diversified geographic regions and markets, in particular across Europe, North America and Asia-Pacific.
- In the UK, AXA:
 - operates through AXA Insurance Ltd and AXA PPP Healthcare Ltd;
 - has over 10 million customers;
 - employs approximately 10,000 people; and
 - was ranked 19th in the 2015 survey by The Sunday Times of the 'Top 25 Best Big Companies' to work for.
- The Complainant is the owner of well-known trade marks all over the world. In particular, it owns the following registered trade marks:
 - EU trade mark "AXA" (+ design) n°373 894 filed on August 28, 1996 in classes 35 and 36 in particular for "insurance; savings banks; financial, monetary affairs".
 - EU trade mark "AXA" n°008 772 766 filed on December 21, 2009 in classes 35 and 36 in particular for "insurance and finance; banking services".
 - UK trade mark "AXA" n°1 272 911, filed on October 1, 1986 in classes 35 & 36 notably for "insurance services; financial banking services".
- The Domain Name is confusingly similar to the trade marks and company name in which the Complainant has prior rights and reproduces identically the AXA trade mark and company name.
- The trade mark "AXA" itself has no particular meaning and is therefore highly distinctive. AXA is a well-known trade mark around the world in the field of insurance and financial services.
- When a disputed domain name incorporates the entirety of a complainant's trade mark, being a notorious and famous trade mark, it is difficult, if not impossible, regardless of added terms, to distinguish adequately the mark from the disputed domain name.

- The adjunction of the term “service” to the trade mark AXA in the Domain Name does not diminish the confusing similarity. The distinctive part of the Domain Name is the term AXA and the term “service” is descriptive.
- Domain names that combine a descriptive term with a trade mark have been held to be confusingly similar to the trade mark. In the Nominet DRS decision Portakabin Limited and Mr Sean Westwood (DRS 00017379) regarding the domain name <portaloservices.co.uk>, the Expert held that:

“While the Expert notes that the Domain Name also includes the word “services” after the Name, in agreement with the Complainant, such a word is merely descriptive and does not sufficiently distinguish the Domain Name from the Name/Marks. In addition, that the Domain Name includes the “.co.uk” suffix does not sufficiently distinguish the Domain Name from the Name/Marks.”

- In the present case, taken in combination with the AXA trade mark, the word “service” can make internet users believe that the corresponding website is an official website presenting the different insurance and financial services offered by the Complainant when actually it is not.
- The Respondent has no rights or legitimate interests in respect of the Domain Name.
- The Domain Name bears no similarity to the Respondent’s name, ‘e-net ltd’.
- The Complainant has not granted the Respondent any license or other authorization to use its trade marks. There is no relationship between the parties.
- The Respondent has registered the Domain Name in bad faith. There is no valid reason why the Respondent would choose the Domain Name other than to take advantage of the reputation and goodwill established in the Complainant’s AXA trade marks.
- The Respondent is not seriously interested in actively using the Domain Name. The corresponding website is inactive and the Respondent has no intention of providing any legitimate service from his website. On this point, in the WIPO Case No. D2000 0003, Telstra Corporation Limited v Nuclear Marshmallows (<http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0003.html>), the panel held that:

“The significance of the distinction is that the concept of a domain name “being used in bad faith” is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith. [...]”

The question that then arises is what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith? This question cannot be answered in the abstract; the question can only be answered in respect of the particular facts of a specific case. That is to say, in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must

give close attention to all the circumstances of the Respondent's behaviour. A remedy can be obtained under the Uniform Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith".

- In the present case, the Respondent is using the Domain Name in a way which will have confused people or businesses into believing that the Domain Name is registered to, operated or authorized by or otherwise connected with the Complainant within the scope of paragraph 3(a)(ii) of the DRS Policy.
- The Domain Name has been registered since October 2009 and has been resolving to a parking website. This kind of website typically offers domain name holders the ability to earn money through a pay-per-click system which redirects Internet users to competing websites.
- Although there is no evidence that the Respondent gains financially from these click-throughs, given the Complainant's Rights (in its trade marks and reputation), Internet users accessing the website to which the Domain Name resolves ("Website") can be confused into thinking that the website and links are associated in some way with the Complainant.
- Further, the Website displays links entitled 'finance', 'bank', and 'insurance'. By choosing links of a similar business nature to the Complainant, the Respondent intends that these links are assumed to be associated with the Complainant by a user accessing the Website.
- In doing so, and regardless of whether the Respondent receives money for any additional Internet traffic generated by providing such links, the Website is likely to take possible business away from the Complainant. In this way, the use of the Domain Name to link to the Website unfairly disrupts the Complainant's business. (See the Nominet decision, Ryanair, DRS 3655.)
- It is difficult to be sure that "e-net Ltd" is the Respondent's real identity. On the results of a 'Whois' search it is specified that the registrant is a non-trading individual. This statement is not compatible with the registrant being stated to be a limited company ("e-net Ltd").
- Further, the Respondent opted to have its address omitted from the Whois databases to avoid disclosing its location and thus its identity. This behaviour is also consistent with an inference of bad faith in registering and using the Domain Name.
- Therefore, by reference to paragraph 3(a)(ii) of the DRS Policy, the Respondent has been using the Domain Name in a way which has, or is likely to have, confused people or businesses into believing that the Domain Name is registered to the Complainant.
- Under these circumstances, the Domain Name is being used in a manner which takes unfair advantage of, and is unfairly detrimental to, the Complainant's Rights. It is an Abusive Registration in the hands of the Respondent.

Respondent's Response

In summary, in his response the Respondent stated as follows:

- The Respondent registered the Domain Name for the following reasons:
 - The Respondent used to work in Italy as a Desktop Engineer for a company called Axaservice Srl, which operated in the Information Technology area from two offices in the cities of Bari and Andria.
 - That company is now dissolved but it gave the Respondent the idea for the registration of the Domain Name.
 - In London, the Respondent had a limited company, now dissolved, called "Axaservice Consulting Ltd" so the Respondent thought he would buy the Domain Name to go with it.
 - None of the other domain names that are similar to the Domain Name (axaservice.net, axaservice.com, axaservice.org, or axaservice.it for example) refer to the Complainant, which let the Respondent think that the 'axaservice' domain is widely available to a series of businesses.
 - There is a website at www.axaservice.ro relating to a business that has nothing to do with the Complainant.
- The Respondent has kept the registration of the Domain Name by paying an annual fee so that he has the option of re-opening his consulting company using a website and email address with a matching name.
- At the moment the Domain Name is not in use by the Respondent, but he believes that the company which sold it to him, Fasthosts, uses it as a "parking domain" pointing it to a page that is not managed by the Respondent and with which he has no connection or interest in any way.
- A quick search of domain providers shows that the 'axaservice' domain is still available to buy for a very large number of top-level domains.

Complainant's Reply

In its reply, the Complainant stated as follows:

- In his response, the Respondent has not put forward a convincing case that the Domain Name is not an Abusive Registration.
- The Respondent alleges that he registered the Domain Name in October 2009 for use with the company Axaservice Consulting Ltd that he set up in January 2010. That company was dissolved in September 2011 but the Respondent has not given any information about his company and its activity.
- Above all, the Respondent does not show that he used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services at that time or at any later stage.
- The Respondent chose to keep the Domain Name after the dissolution of his company. However, since September 2011, the Respondent has not been making fair use of the Domain Name. The Domain Name is resolving to a parking website.

The Respondent says that at the moment the Domain Name is not used by him. Actually, the Domain Name is managed by the reseller, Fasthosts.

- The Respondent also owns the registration of the domain name <axaservice.com> which is resolving to the same parking website.
- The Respondent does not demonstrate that he intends to rebuild a business under the trade name or company name Axaservice Consulting and to use the Domain Name for that purpose. He does not prove that he has been making demonstrable preparations to that effect.
- The Respondent has not been commonly known by the Domain Name. His former company, Axaservice Consulting Limited, does not exist anymore.
- The Respondent chose to remain anonymous and he has opted to have his address omitted from the Whois service.
- The Respondent is not connected with a mark or a trade name which is identical or similar to the Domain Name.
- Given the above, the Respondent does not need the Domain Name for his activity. On the contrary, he is using the Domain Name as a blocking registration against the AXA trade mark in which the Complainant has Rights.

6. Discussions and Findings

Preliminary Matter

Before dealing with the details of the dispute I will deal with the identity of the Respondent. In its complaint, the Complainant referred to the Respondent as a company called “e-net ltd” even though the ‘registrant type’ when the Domain Name was registered was said to be a UK individual. That is because the results of a search for the Domain Name it undertook on 1 September 2017 using Nominet’s ‘WHOIS Lookup Tool’, which the Complainant exhibited to its complaint filed on 4 September 2017, stated as follows:

“Registrant: e-net ltd

Registrant type: UK Individual

Registrant’s address: The registrant is a non-trading individual who has opted to have their address omitted from the WHOIS service

Data Validation: Nominet was able to match the registrant’s name and address against a 3rd party source on 10-Dec-2012”

The same WHOIS search now shows:

“Registrant: Name withheld. This Registrant is using a privacy service.

Registrant's address: Address withheld. This Registrant is using a privacy service.

...

Data Validation: Nominet was not able to match the registrant's name and/or address against a 3rd party source on 10-Sep-2017."

However, the contact details for the registrant held by Nominet when the complaint was received named Mr Giovanni Pompilio, and it is he who has responded to the complaint and submitted the response. Mr Pompilio has therefore been treated and named as the Respondent in these DRS proceedings.

General

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, i.e. that:

1. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

These terms are defined in the Nominet DRS Policy as follows:

- **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.
- **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. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Does the Complainant have Rights?

The Complainant is a very well-known global business involved in insurance and financial services and has traded in a very significant way under the AXA name since 1985. It also owns various trade mark registrations for the AXA trade mark and it could be considered a 'household name' in the UK. In the circumstances, the Complainant clearly has Rights in the AXA name for the purposes of the DRS.

Is the Domain Name identical or similar to the AXA name?

In assessing whether a domain name is identical or similar to a name or mark the “.co.uk” suffix can be ignored, unless perhaps the name or mark concerned itself includes a particular top-level domain suffix, which is not the case here.

The Complainant points out that “AXA” itself has no particular meaning and is therefore highly distinctive and the Domain Name merely adds the descriptive word “service” to it. The Complainant refers to the previous DRS decision in Portakabin Limited and Mr Sean Westwood (DRS 00017379) in which the domain name in issue solely comprised the addition of the word “services” to the complainant’s well-known PORTALOO trade mark. The Expert in that case agreed with Portakabin’s assertion that *“such a word is merely descriptive and does not sufficiently distinguish the Domain Name from the Name/Marks.”*

I agree with that view, but I should point out that I was in fact the lawyer acting for Portakabin Limited in that DRS case when putting forward that assertion in the first place.

In the circumstances, I find that the Domain Name is similar to the AXA name or mark in which the Complainant has Rights.

Is the Domain Name an Abusive Registration by virtue of the fact that, at the time when the registration took place, it took unfair advantage of or was unfairly detrimental to the Complainant's Rights?

The Domain Name was registered by the Respondent on 10 October 2009, long after the Complainant had established its Rights and its reputation in its AXA name. The Respondent has explained why he chose to register this particular Domain Name by saying that he had previously been employed in Italy by an information technology company called Axaservice Srl and sometime after it ceased trading he then moved to London and set up his own UK company, Axaservice Consulting Limited, on 27 January 2010. He says the registration of the Domain Name was part of his plans to set up his consulting business. The Respondent provided a copy of his CV, although he did not refer to it in his response. The CV is a Word document entitled “cv-update” and includes a reference to the Respondent having worked as a Desktop Engineer for a company called Axaservice s.r.l. in Bari, Italy between June 2001 and June 2003. I note from the metadata associated with this document that it was last modified on 22 June 2008.

I therefore accept the Respondent’s claim that he did previously work for an Italian company called Axaservice s.r.l.

But does that provide the Respondent with a valid defence to the allegation that when he registered the Domain Name he took unfair advantage of or was unfairly detrimental to the Complainant's Rights? I do not believe it does.

The Respondent might have pointed to paragraph 8 of the DRS Policy, which sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

Paragraph 8.1.1.1 and 8.1.1.2 state as follows:

“Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has:

8.1.1.1 used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.”

The DRS Experts’ Overview is published on the Nominet website to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet’s panel of independent adjudicators, have dealt with those issues to date and identifying any areas where Experts’ views differ.

The DRS Experts’ Overview at sections 4.2 to 4.4 states as follows:

4.2 “What is meant by “before being aware of the Complainant’s cause for complaint” in paragraph 8.1.1 of the Policy?

The circumstances set out in paragraph 8.1.1 of the Policy are only likely to constitute satisfactory answers to the Complaint if they commenced when the Respondent was unaware of the Complainant’s name or mark forming the basis for the Complaint. Matters which only arise after the Respondent has become aware of the Complainant’s name or mark forming the basis for the Complaint are more likely to have been contrived for the purpose of defending an apprehended Complaint or legal action.

Relevant cases:

DRS 06222: my-life.co.uk (no response) DRS 08735: n21online.co.uk (no action)”

4.3 “What is required in the way of evidence to demonstrate “preparations to use” in paragraph 8.1.1.1 of the Policy?

Most abusive registrants do not respond to complaints, but those who do will commonly assert the existence of plans, which are designed to defeat the complaint. Experts will generally view purported ‘plans’ which are totally unsupported by any contemporaneous evidence with a heavy measure of scepticism. Accordingly, if the registrant has genuine plans for the domain name, arrived at wholly without reference to the rights of the Complainant, it makes sense for the registrant to produce evidence to show that they are genuine and were not dreamt up simply to defeat the complaint. The more straightforward the registrant’s case, the less that the Expert is likely to need in the way of supporting evidence. However, any evidence produced should sensibly include evidence predating the registrant’s awareness of the Complainant’s rights. Failing that, the evidence may not be worth a lot, but a credible explanation for the absence of any

*such evidence may assist. The usual evidence will comprise correspondence with third parties (banks, lawyers, partners etc) in which the plans are identified.
Relevant cases: DRS 06365 (appeal): oasis.co.uk (no action)”*

4.4 “When is an “offering of goods or services” NOT “genuine” [paragraph 8.1.1.1 of the Policy]?”

When it is fictitious and/or ‘created’ to defeat the complaint and/or designed to take unfair advantage of or damage the Complainant’s rights/business.”

Even if it is accepted that the Respondent registered the Domain Name on 10 October 2009 as part of his preparations to set up his consultancy business under the “Axaservice Consulting” name, it is notable that the Respondent does not deny being aware of the Complainant’s existence at the time he did so. Given the long and widespread use of the AXA name by the Complainant it is almost inconceivable that the Respondent would not have been aware of the AXA name when then working and living in London.

In addition, the fact that the Respondent was employed for two years between 2001 and 2003 by a now dissolved Italian company called Axaservice s.r.l does not give the Respondent himself any claim to have been commonly known by that name, even if the successors of the Italian company might have such a claim (and I make no comment or finding in that regard).

Further, merely being an employee of a company that had been trading under a particular mark does not mean that the Respondent was “legitimately connected” with that mark for the purposes of paragraph 8.1.1.2 of the DRS Policy. In my view, such a connection has to be with the rights to use the mark rather than merely a third party employer’s use of it.

But the Respondent also says that one of the reasons why he registered the Domain Name was because there were other domain names that are similar to the Domain Name and none of them refer to the Complainant, which let the Respondent think that the ‘axaservice’ domain is widely available to a series of businesses. He gave as examples axaservice.net, axaservice.com, axaservice.org, and axaservice.it and also pointed out that there is a website at www.axaservice.ro relating to a business that has nothing to do with the Complainant.

In making this point, the Respondent may have had in mind paragraph 8.1.2 of the Policy in support of his position that the Domain Name is not an Abusive Registration. That paragraph, being one of the non-exhaustive list of factors which may provide such evidence, states as follows:

“8.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it”

However, the Complainant pointed out in its reply that the axaservice.com domain name is in fact registered by the Respondent himself and resolves to the same parking

page as the Domain Name. I note that the axaservice.com domain name was registered by the Respondent on 10 October 2009, the same day he registered the Domain Name. The Respondent cannot rely on the fact that he simultaneously registered the .com domain as any form of justification for registering the .co.uk domain.

I also note that the axaservice.it domain name was registered on 5 July 2011 and both the equivalent .net and .org domains were registered on 5 November 2016. Both these dates are long after the Respondent registered the Domain Name so cannot have influenced his decision to do so.

The fact that there is what appears to be an established third party Romanian business involved in the crane industry that is using the AXA SERVICE name does not provide the Respondent with any justification for also using it. Providing one example of third party use is very far from showing that the name is generic or descriptive and available generally for anyone else to use.

In the circumstances, it is highly likely that when registering the Domain Name the Respondent was well aware of the existence of the Complainant and its Rights in the AXA name as a result of its previous widespread use of it. In addition, it is likely that when registering the Domain Name the Respondent will have known that its existence and subsequent use would be able to ride on the coat tails of the Complainant's goodwill and reputation and that his previous job some years earlier with an Italian company called Axaservice srl was merely fortuitous coincidence.

I therefore find that at the time the Respondent registered the Domain Name he did so in a manner that took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Is the Domain Name an Abusive Registration also by virtue of the fact that it has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights?

The Respondent says that "at the moment" the Domain Name is not being used by him but he has kept it so that he has the option to "re-open" his consulting company.

The Respondent's previous UK company called Axaservice Consulting Limited was incorporated on 27 January 2010 and dissolved on 6 September 2011. In his response, the Respondent referred to a link to the Companies House website showing details of the company. Those details showed that the company was dissolved by compulsory strike-off action taken by the Registrar of Companies pursuant to section 1000 of the Companies Act 2006. That section gives the Registrar power to strike off a company that is "not carrying on business or in operation". It would therefore appear that the Respondent's company did not trade, whether using the Domain Name or not.

However, the Domain Name has been used to resolve to a parking page. The Respondent denies any involvement in this and seeks to wash his hands of any

responsibility for it saying it is entirely the doing of the registrar company who manage the domain name, Fasthosts. As paragraph 8.5 of the DRS Policy makes clear, connecting a domain name to a parking page and earning 'click-through' revenue from it via links to other websites is not in itself objectionable. But it goes on to confirm that:

"However, the Expert will take into account:

8.5.1 the nature of the Domain Name;

8.5.2 the nature of the advertising links on any parking page associated with the Domain Name; and

8.5.3 that the use of the Domain Name is ultimately the Respondent's responsibility"

This makes it clear that even if the Respondent has ceded day to day control of the current use of the Domain Name to a third party such as Fasthosts, he cannot simply wash his hands of any responsibility for what they then do with it as it still remains his domain name.

The Complainant points out that the parking page has displayed various links to other websites under headings that include 'finance' and 'insurance' i.e. websites directly relevant to and competing with the Complainant's core business. The Complainant relies on paragraph 5.1.2 of the DRS Policy (although it incorrectly referred to the equivalent paragraph 3(a)(ii) of the previous version of the Policy that was superseded by the present Policy with effect from 1 October 2016).

Paragraph 5 of the Policy is a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration and 5.1.2 states as follows:

"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;"

I have set out below what it says in section 3.3 of the DRS Experts' Overview relating to paragraph 5.1.2 and the application of the concept of 'initial interest confusion':

"Paragraph 5.1.2 concerns confusing use of the domain name. What is meant by confusing use?"

The 'confusion' referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that "the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant"?

In the case of BT v One In A Million [1999] 1 WLR 903, the Court of Appeal cited, as one example of how confusion of this kind could occur, the making of a Whois search of

the registry/registrar database. The enquirer conducts such a search and because of the similarity of the domain name to the well-known trade mark (the case was concerned solely with well-known trade marks), assumes that the registrant is in some way associated with the trade mark owner. Whether or not this is still (if it ever was) a likely scenario, the English Courts have clearly held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name. The prevailing approach under the DRS is consistent with this.

Commonly, Internet users will visit web sites 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 web site 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 web site will use the domain name for that purpose.

*In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "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 web site 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 web site, 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. In the High Court decision *Och-Ziff Management Europe Ltd v Och Capital LLP* [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being "a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant's conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase". In that case the court held that initial interest confusion is legally actionable under European trade mark legislation.*

In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.

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 (privalege.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 decisions in DRS 00248 (seiko-shop.co.uk) and DRS 07991 (toshiba-laptop-battery.co.uk).

Subsequent to the Och-Ziff case (supra) the Court of Appeal in Interflora v Marks and Spencer [2014] EWCA Civ 1403 criticised the use of "initial interest confusion" as a concept relevant to English trade mark law. This case was discussed by the Appeal Panel in DRS 15788 (starwars.co.uk) who concluded that initial interest confusion remained an applicable principle in determining whether or not a domain name registration was abusive.

Another potential for confusion (frequently overlooked) is the use of a domain name for the purposes of email. There are many examples of registrants of domain names receiving email traffic intended for the Complainant. See for example Global Projects Management Ltd v Citigroup Inc. (citigroup.co.uk) [2005] EWHC 2663 Ch., and DRS 00114 (penquin.co.uk). Whether evidence of this occurring will lead to a finding of Abusive Registration will, of course, depend to a large extent on the nature of the domain name and the circumstances of its use. If, at the third level, it is a name which is lawfully in use by a number of people (e.g. a surname), the resultant confusion may just be a hazard which the Complainant will have to accept."

The Overview says that, where the names are identical and cannot sensibly refer to anyone other than the Complainant, there is bound to be a severe risk that a search engine will return the URL for the website connected to the Domain Name. The Overview does not say that such a situation is the only time there will be a severe risk of initial interest confusion, just that such a risk is bound to happen in that situation. Clearly, there can be situations where the names are merely very similar and there will still be a real risk that when an Internet user searches for the Complainant's name, the search engine will also return the URL for the website connected to the Domain Name and that may lead a substantial proportion of such Internet users to become victims of initial interest confusion. That is particularly so as search engines like Google are programmed to pick up common variations to the term being searched and website addresses that comprise the term being searched along with additional descriptive words. In this case, the Domain Name is not identical to the Complainant's name and mark, but it is very similar, merely having the descriptive word "service" added to the well-known AXA name.

The risk of initial interest confusion is therefore a real one. If an Internet user looking for one of the Complainant's websites arrives by mistake at the parking page website to which the Domain Name resolves, the user has then been offered links to websites providing directly competing services. That is a classic 'bait and switch' situation.

In my view, such use of the Domain Name took unfair advantage of and was unfairly detrimental to the Complainant's Rights in its AXA name. The Respondent, as registrant of the Domain Name, is ultimately responsible for that use.

7. Decision

For the reasons outlined above I find that the Complainant has proved, on the balance of probabilities, 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.

In the circumstances I order that the Domain Name be transferred to the Complainant.

Signed

Dated 13 November 2017

Chris Tulley