

# NOMINET UK DISPUTE RESOLUTION SERVICE

## DRS 4700

London Scottish Bank plc v Web Design Services

Decision of Independent Expert

### **1. Parties:**

Complainant: London Scottish Bank PLC  
Address: London Scottish House  
24 Mount Street  
Manchester  
Postcode: M2 3LS  
Country: GB

Respondent: WebDesignServices  
Address: POB 10364  
Aurora  
Colorado  
Country: US

### **Disputed Domain Name**

scottishbankplc.co.uk ("the Domain Name")

### **2. Procedural Background:**

The Complaint was lodged with Nominet in full on 21 May 2007. A non-standard Response was filed on 4 June 2007. A reply was received on 22 June 2007. On 26 June 2007, 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").

Cerryg Jones, the undersigned, ("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 drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

### **3. Outstanding Formal/Procedural Issues (if any):**

There are no other outstanding procedural issues that arise.

### **4. The Background and the parties submissions**

The Complainant provides banking and financial services including secured loans, mortgages and reinsurance under the trading name London Scottish Bank PLC (the "Trading Name"). It has been trading since 1987. The Complainant has over 200,000 customers and 103 branches in the United Kingdom and made a group profit of over £15.7 million pounds during the financial year ending 31 October 2006.

Since 1991 it has used an eagle device as part of its trade dress. The Complainant is the registered proprietor of United Kingdom trade mark LONDON SCOTTISH no.1377802 registered in class 36 for banking and related services which was filed on 22 March 1989.

The evidence filed with the Complaint indicates that the Respondent at some stage used the Domain Name for the purposes of operating a website at [www.scottishbankplc.co.uk](http://www.scottishbankplc.co.uk). The homepage of this website reproduced the Trading Name (in the same font) as well as the eagle device, as well as text taken from the Complainant's website at [www.london-scottish.com](http://www.london-scottish.com). It described itself as a specialist financial services company under the Trading Name, and appeared to offer various types of account, some of which required a minimum deposit of £2,500.00. In order to register for a new account, users were asked to enter personal information. The Domain Name now resolves to a page which simply offers the Domain Name for sale.

The Complainant says that the Respondent has no right to use its Trading Name, eagle device or its registered trade mark, and says that the Respondent is impersonating the Complainant by including copyright works obtained from the Complainant's website, which include details of the Complainant's services, number of employees and history. By using the Complainant's registered trade mark, Trading Name, eagle device and copyright works, the Complainant alleges that (a) the website associated with the Domain Name has confused people into believing that the Domain Name is registered to the Complainant, operated or authorised by the Complainant, or is otherwise connected with the Complainant; (b) that consumers have been confused; and (c) that the Domain

Name is being used fraudulently, as demonstrated by the email evidence attached to the Complaint. This evidence indicates that individuals have unwittingly transferred money through the website associated with the Domain Name believing they were making deposits with the Complainant. This demonstrates, according to the Complainant, that the Domain Name has been used, and continues to be used, in a manner which takes unfair advantage of or is unfairly detrimental to, the Complainant's rights. The Complainant further alleges that the Respondent's use of the Domain Name has caused, and continues to cause significant damage to the Complainant's reputation and goodwill. It is alleged that the evidence points to the Domain Name being used as an instrument of fraud.

The Respondent says that it was contacted by an unnamed corporate entity to provide it with an internet presence and that the Domain Name was registered for that purpose. The Respondent does not address any of the Complainant's allegations or provide any explanation as to why the Domain Name was used for some time to resolve to a website which sought to impersonate the Complainant. The Respondent says that the trade mark LONDON SCOTTISH does not give the Complainant exclusive rights to use the name "scottishbankplc" which, in any event, does not "depict" the trade mark.

In the Reply, the Complainant says that the Respondent has failed to address its allegations.

## **5 Discussion and findings**

But for one issue – namely, whether the complainant has "rights," (as defined by the DRS Policy), in respect of a name or mark which is similar to the Domain Name – this would be a very straightforward case, as I have formed the clear view that the Respondent has at the very least permitted the Domain Name to be used to impersonate the Complainant, with a concomitant deleterious effect on the Complainant's business and reputation. This is manifestly conduct which constitutes an abusive registration.

However, the Complainant is also required to prove on a balance of probabilities that it has rights in a name which are similar to the Domain Name. Here the comparison is between London Scottish Bank on the one hand and Scottish Bank on the other. There is no doubt that the Complainant has rights in the name

“London Scottish” but does the inclusion of “London” make any difference to the comparison I am required to make?

In deciding this issue I have used the case law which has developed under the Trade Marks Directive, which requires an analysis of the aural, conceptual and visual impact of the conflicting marks, bearing in mind that ultimately one has to have in mind their overall impression, given their distinctive and dominant components. Clearly the addition of “London” does make an aural, visual and conceptual difference to the overall impression created by the two conflicting signs. However, I do not think this difference is sufficient to allow me to conclude that the two conflicting marks are not similar. In addition to the visual, aural and conceptual similarities between the conflicting marks (which are inevitable to some degree where there is a common element - here “Scottish”), the services offered under the conflicting marks were identical at one time (which can affect, according to the case law of the ECJ, how an average consumer perceives the conflicting marks). However, most importantly, the evidence indicates that the Respondent - for a period at least - sought to impersonate the Complainant. He who seeks to impersonate another’s business on the internet, including by its choice of domain name, cannot expect to be given the benefit of the doubt in any decision under the DRS which involves a comparison between a disputed domain name and the name embodied within the right relied upon.

## **6 Decision:**

In the light of the foregoing findings, I direct that the Domain Name should be transferred.

Cerryg Jones

9 August 2007