

ADMINISTRATIVE PANEL DECISION

National Westminster Bank plc v. Steve Mart
Case No. D2012-1711

1. The Parties

The Complainant is National Westminster Bank plc of London, United Kingdom of Great Britain and Northern Ireland, represented by Melbourne IT Digital Brand Services, United Kingdom of Great Britain and Northern.

The Respondent is Steve Mart of Lagos, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <natwest-web.com> is registered with OnlineNic, Inc. d/b/a China-Channel.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 25, 2012. On August 27, 2012, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 28, 2012, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 29, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response was September 18, 2012. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 19, 2012.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on October 8, 2012. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

According to an extract of the public Whois database appearing in Annex 3 to the Complaint, confirmed by the Registrar in its verification response, the disputed domain name was registered to the Respondent on April 11, 2012 and is set to expire on April 11, 2013.

A. Complainant's NATWEST Marks

The Complainant owns a substantial number of United States of America and foreign trademark registrations, throughout many countries of the world, for the term "Natwest" in block letters, by itself and also in conjunction with additional terms. The marks are registered in conjunction with financial services. The Complainant has provided a listing of all those registrations, including country, registration number and mark, in Annex 7 to the Complaint. These illustratively include the United States, United Kingdom and the European Community.

B. Complainant and its actions

The Complainant is a public limited company incorporated during 1982 in London and acquired by the Royal Bank of Scotland Group in 2000. In 1968, the National Provincial Bank (est.1833) and the Westminster Bank (est.1836), merged as National Westminster Bank, which began trading under that name in 1970. Together these banks trace their history through a lineage of predecessor organizations dating back to the 1650s.

The Complainant offers its financial services worldwide under the mark NATWEST and has spent a significant amount of money promoting and developing this mark. The Complainant currently has 7.5 million personal customers and 850,000 small business accounts.

The Complainant operates websites at, e.g., the domain names <natwest.com> and <natwest.co.uk>, copies of the homepages of which appear in Annex 8 to the Complaint.

The Complainant tried to contact the Respondent, through email, on April 18, 2012 through a cease and desist letter (a copy of which appears in Annex 11 to the Complaint). The Complainant advised the Respondent that the unauthorized use of the NATWEST mark within the disputed domain name violated the Complainant's rights in that mark and requested that the Respondent voluntarily transfer the disputed domain name to the Complainant. At first, the Respondent agreed and stated that he would provide an "authentication code" apparently as part of a process to effectuate the transfer. However, no authentication code was ever sent though the Respondent ceased use of the disputed domain name. Consequently, the Complainant filed the present Complaint to seek administrative relief through the Policy.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark NATWEST because the name contains the formative term "natwest" to which the term "-web" has been appended. Addition of the term "-web" fails to provide any distinctiveness to the disputed domain name that would sufficiently abate confusion of Internet users from associating the disputed domain name with the Complainant.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent has no registered trademarks or trade names corresponding to the disputed domain name, hence negating any suggestion that the Respondent has been using the term “Natwest” in any way that would give him legitimate rights in the disputed domain name under common law based use. Further, the Respondent is not commonly known by the name and moreover the Complainant did not authorize the Respondent to register a domain name containing the Complainant’s NATWEST mark.

Second, the Respondent has used the disputed domain name to pass himself off as the Complainant in order to defraud the Complainant’s customers through a fraudulent website (a copy of the home page of that site appears in Annex 10 to the Complaint) identical to the Complainant’s site. Specifically, the Respondent used the name to “phish” for financial information in an attempt to defraud the Complainant’s customers. The Respondent’s attempt to pass himself off as the Complainant and “phish” for customers’ financial information is neither a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use under the Policy.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

As noted above, the Respondent used the disputed domain name to engage in a phishing scam. By utilizing the Complainant’s mark, the Respondent was using the disputed domain name to deceive and manipulate the Complainant’s customers into divulging their sensitive financial information. The Respondent has absolutely no connection with the Complainant. Nevertheless, the Respondent was obviously aware of the rights the Complainant has in its NATWEST marks and the substantial reputation, goodwill and value of those marks, and yet in spite of that knowledge and his lack of any connection whatsoever with the Complainant, intentionally registered the disputed domain name. The Respondent’s scam constitutes criminally actionable fraud and, with respect to the Policy, bad faith registration and use.

Further, even though the Respondent’s website is currently inactive, passive holding here could constitute bad faith use particularly since any future realistic use by the Respondent of the disputed domain name would likely involve some degree of “passing off” and/or trademark infringement, if not a repetition of his “phishing” scam.

B. Respondent

The Respondent failed to file any Response to the contentions raised in the Complaint.

6. Discussion and Findings

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant’s undisputed factual representations.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark NATWEST.

From a simple comparison of the disputed domain name to the Complainant’s mark NATWEST, no doubt

exists that the disputed domain name is confusingly similar to the Complainant's marks. The primary difference between the disputed domain name and the mark NATWEST is the addition of the term "-web" to form a separate corresponding composite term "natwest-web" along with, secondarily, appending the gTLD (generic top level domain) ".com" to that term to form the disputed domain name, with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that domain name to avoid user confusion. Here, adding a generic term, that being the term "-web", in the manner which the Respondent specifically did, to the mark NATWEST clearly resulted in such a minor variation. See, particularly, *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. RonsPorta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. FA 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. FA 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. FA 155896; and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. FA 117876.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's NATWEST marks as to cause confusion.

Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the NATWEST marks nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's mark NATWEST or one confusingly similar thereto in connection with the identical or even similar services to those currently provided by the Complainant, in circumstances as are present here, may violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Amy Stran v. EzDomainSearch.com*, *Juan Curtis*, WIPO Case No. D2011-1710; *Tommy Bahama*, *Space Needle*, *Oakley*, *Burberry*, *HRB Innovations Inc.*, *Dreamworks*, *MySpace*, *Blackrock*, *F. Hoffmann-La Roche AG*, *National Football League*, *Toilets.com, Inc.*, and

Associated Bank, all cited *supra*; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc., supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. FA 173362; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. FA 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. FA 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in this Panel's view, the Respondent could not legitimately acquire any public association between himself and the mark NATWEST or even any mark similar thereto, at least for the services provided by the Complainant under its marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark NATWEST. Nor could the Respondent likely ever become commonly known by either the disputed domain name or the mark without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back to approximately 1970 - at least some forty years prior to when the Respondent registered the disputed domain name, and the widespread and substantial reputation and notoriety which the Complainant has gained in its NATWEST marks ever since. See, e.g., *Tommy Bahama, Amy Stran, Space Needle, Oakley, Burberry, Starline Publications, HRB Innovations Inc., MySpace and Treeforms, Inc.*, all cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy. Moreover, the facts of record do not indicate that the Respondent's actions qualify under either paragraph 4(c)(i) or 4(c)(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

Given the Respondent's apparent use of the disputed domain name as the vehicle through which he attempted to extract, i.e. "phish", confidential personal banking information from the Complainant's customers, there can be no doubt that the Respondent, at the time he registered the disputed domain name, was well aware of the Complainant, its reputation and its trademark rights and had already formed an intention to perpetrate a fraud on the Complainant's customers ultimately for the Respondent's own financial benefit. Based on the facts of record, the Panel sees no other reason why the Respondent, which has absolutely no connection with the Respondent, would have chosen to register and use the disputed domain name if he did not intend to use it as he has.

Such use, which likely carries criminal liability, clearly constitutes bad faith use under the Policy.

Furthermore, though, for the time being, the Respondent has ceased using the disputed domain name, the Panel infers, particularly from the facts of record and the absence of any response, that should the Respondent retain the disputed domain name and recommence his use at some point in the future, that new use, given the Respondent's intentions as reflected in his prior use, may very likely be directed at injuring the Complainant through some scheme or artifice aimed at opportunistically exploiting and infringing the Complainant's NATWEST marks to cause confusion and possible deceit or fraud of its customers ultimately to the detriment of the Complainant and the benefit of the Respondent.

A finding of bad faith use arising from just passive holding may ordinarily require an interval of more than just a few months to elapse during which a respondent merely holds a domain name and does not use it to resolve to an operational website. Here, the passive holding period now amounts to approximately 6 months (from at least April 18, 2012 to the present). Nevertheless, the prior actions of a respondent in actually using the domain name in bad faith may taint the ensuing passive holding period and label that period as simply a continuation of the prior bad faith use. This is particularly so here where the Respondent's prior use of the disputed domain name is so egregious and injurious to the Complainant and to its customers as to likely incur criminal liability - let alone where a good likelihood exists that should the Respondent retain the disputed domain name then, at some point in the near future, he will either repeat his prior illicit use of the disputed domain name or use it in a similar fashion to his ultimate benefit and to the detriment of the Complainant.

Hence, the Panel concludes that the Respondent violated the general bad faith provision of paragraphs 4(a)(iii) and 4(b) of the Policy as well as specific bad faith provisions 4(b)(iii) and 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <natwest-web.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Dated: October 22, 2012