



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Beachcroft LLP v. Moniker Privacy Services / Role, Manage Technical

Case No. D2008-1530

1. The Parties

The Complainant is Beachcroft LLP, of London, United Kingdom, appearing *pro se*.

The Respondent is Moniker Privacy Services of Pompano Beach, Florida, United States of America and Role, Manage Technical, of Hong Kong, SAR of China.

2. The Disputed Domain Name and Registrar

The disputed domain name <beachcroft.com> is registered with Moniker Online Services, LLC.

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”), which was adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 24, 1999, and the World Intellectual Property Organization (“WIPO”) Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the “Supplemental Rules”).

The Complaint, with accompanying Annexes 1-6, was filed with the WIPO Arbitration and Mediation Center (the “Center”) by email on October 7, 2008 and by hardcopy on October 16, 2008. In response to a email request from the Center dated October 17, 2008, the Complainant filed, by email, an Amended Complaint with the Center on October 22, 2008. The original complaint named “Moniker Privacy Services” as the Respondent; the amended complaint added “Role, Manage Technical manage_tech@yahoo.com” as a second Respondent. For simplicity, the Panel will refer hereinafter to the Complaint as that which stands as amended, and with the term

“Respondent” collectively referring to both respondents, unless the specific context specifically refers to a specific Respondent.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on October 8, 2008, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify, for the domain name: (a) whether the Policy applies to the name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the name, (c) the language of the registration agreement, and (d) whether the name will remain “locked” during the proceeding.

Subsequently, on October 8, 2008, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain name to the extent, as it then existed, in its WhoIs database. Specifically, it stated that the Respondent “Role, Manage Technical manage_tech@yahoo.com” was listed as the registrant for the name. The response also indicated that: (a) the Registrar received a copy of the Complaint, (b) the Policy applies to the name, (c) Moniker Online, LLC is the registrar, (d) the Registrant submitted to the jurisdiction of the courts at the location of the principal office of the Registrar, (e) the registration agreement is in English, and (f) the name will remain locked during the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On October 23, 2008, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to that Respondent, together with all its exhibits, by post or courier and by email, and without the annexes by facsimile. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on October 23, 2008, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on November 12, 2008, to file its Response with the Center.

As of November 12, 2008, the Center had not received any Response to the Complaint from the Respondent; hence, the Center, in an email letter dated November 13, 2008, notified the Respondent of its default.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated November 17, 2008, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a Sole Panelist for this dispute. Subsequently, on the same date, Mr. Michaelson accepted and returned, by email attachment to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated November 19, 2008, notified the Parties of the appointment of Mr. Michaelson as sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before December 3, 2008.

This dispute concerns one domain name, specifically <beachcroft.com>.

The language of this proceeding is English.

4. Factual Background

As indicated in the WhoIs registration record provided in Annex 1 to the Complaint, the disputed domain name was registered on March 14, 2001.

A. The Complainant's BEACHCROFT Marks

The Complainant owns various Community (European) and United Kingdom of Great Britain and Northern Ireland ("UK") trademark registrations, all in block letters, for the term BEACHCROFT, either by itself or in conjunction with, for example, other terms or letters. In that regard, the Complainant has provided copies, in Annex 5 to the Complaint, of database entries from the OHIM CTM-online and UK Intellectual Property Office trademark databases. Pertinent details of two of those registrations are as follows:

1. BEACH-CROFT, BEACH CROFT, BEACHCROFT'S, BEACHCROFT
(all in block letters)
UK registration no: 2168156
Filed: May 29, 1998
Registered: May 28, 1999

This mark is registered for use in connection with "Printed publications, manuals; handbooks; loose-leaf binders; booklets; bookmarks; calendars; coasters of paper; fountain pens; note books; stationery pads; pamphlets; paperweights; pencils; pens, prospectuses; folders", all in international class 16; "Accountancy services; accountancy advisory and consultancy services; accountancy investigation services; business research surveys and investigations; business management advices; appraisals of business; compilation and provision of business information and business reports; consultancy and advisory services relating to business and to business restructuring, rescuing, asset and share sales and purchases" all in international class 35; "Financial advice; research, investigations, and appraisals; financial management and planning; compilation and provision of financial information and financial reports; advisory and consultancy services related to raising finances, financial restructuring

businesses, corporate transactions, buying and selling shares, securities and business assets; insurance services; corporate financial services; corporate financial advisory and consultancy services relating to mergers and acquisitions, joint ventures, listings and new issues, funding and development arrangements, investments, buy-ins, buy-outs, and capital restructuring; tax and trust planning; employment, health and medical tax and trust planning; preparation of tax and trust planning; preparation of tax returns for individuals and corporations” all in international class 36; “Arranging and conducting of conferences; publication of texts (non-publicity)” in international class 41; and “Legal services; legal research; legal advisory and consultancy services; compilation and provision of legal information and legal reports” in international class 42.

2. BEACHCROFT WANSBROUGHES (block letters)
CTM registration no: 001151281
Filed: April 26, 1999
Registered: January 31, 2001

This mark is registered for use in connection with “Printed publications, manuals; handbooks; loose-leaf binders; booklets; bookmarks; calendars; coasters of paper; fountain pens; note books; stationery pads; pamphlets; paperweights; pencils; pens, prospectuses; folders”, all in international class 16; “Accountancy services; accountancy advisory and consultancy services; accountancy investigation services; business research surveys and investigations; business management advices; appraisals of business; compilation and provision of business information and business reports; consultancy and advisory services relating to business and to business restructuring, rescuing, asset and share sales and purchases” all in international class 35; “Financial advice; research, investigations, and appraisals; financial management and planning; compilation and provision of financial information and financial reports; advisory and consultancy services related to raising finances, financial restructuring businesses, corporate transactions, buying and selling shares, securities and business assets; insurance services; corporate financial services; corporate financial advisory and consultancy services relating to mergers and acquisitions, joint ventures, listings and new issues, funding and development arrangements, investments, buy-ins, buy-outs, and capital restructuring; tax and trust planning; employment, health and medical tax and trust planning; preparation of tax returns for individuals and corporations” all in international class 36; “Arranging and conducting of conferences; information and instructions services; publication of texts (non-publicity); training services” in international class 41; and “Legal services; legal research; legal advisory and consultancy services; compilation and provision of legal information and legal reports” in international class 42.

B. The Complainant

The Complainant is a major commercial UK law firm, specifically the 13th largest, which provides legal advice and services to clients in the private and public sector and operates under the name “Beachcroft LLP”. The Complainant operates from eight offices and employs over eight hundred lawyers. The firm traces its roots to Richard Beachcroft. The firm and its predecessor practices have been using the term BEACHCROFT as its mark since 1828. Further, the Complainant is the incorporated practice formally known as “Beachcroft Wansbroughs” and is the legal and beneficial owner of all intellectual property rights formally owned by Beachcroft Wansbroughs.

C. The Respondent

A privacy service operated by the Registrar, i.e., Moniker Privacy Services, shielded the identity of the actual registrant, on its WhoIs database, from the public and as of September 18, 2008 identified itself on that database as the registrant. This privacy service is one of the Respondents.

On September 23, 2008, the Complainant sent the Respondent Moniker Privacy Services an email letter (Annex 2 to the Complaint) through which the former demanded that the latter cease use of the BEACHCROFT mark. Later on the same date, the Respondent Moniker Privacy Services forwarded that email letter to the actual registrant which Moniker Privacy Services identified as “Role, Manage Technical manage_tech@yahoo.com” located at “Administraion [sic] Local PO BOX 33180 Hong Kong”. Also, on the same date, the Respondent Moniker Privacy Services apparently modified its WhoIs database to so identify the registrant.

The Respondent registrant operates a website which contains various links to other commercial websites, some being to other UK law firms which offer legal services in direct competition with the Complainant and others being to third-party sites that offer legal-related services in the UK. An example of the latter is the website for the College of Law which is a renowned English legal education provider. (Annex 6 to the Complaint). The registrant’s website contains terms such as “Solicitor”, “The Law Society”, “The College of Law”, “Conveyancing”, “National accident helpline”, “UK injury lawyer”, “Legal advice from experienced solicitor @ £1.50 per minute”, and “UK government law”. The Panel, given that the Respondent has not filed any Response, infers that the Respondent generates click-through revenue through user activation of any of the links displayed on its website resolvable through the disputed domain name.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical to the Complainant’s BEACHCROFT mark.

Specifically, the Complainant alleges that the name, apart from its generic top level domain (here being “.com”), consists of the term “beachcroft”.

Hence, the Complainant concludes 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 the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Complainant states that the Respondent is not authorized to use the BEACHCROFT mark as a domain name. Moreover, the Respondent’s website at <beachcroft.com> is neither connected to nor endorsed by the Complainant.

Second, the Complainant contends that its BEACHCROFT mark does not describe the provision of legal services and its only relationship with legal services is as the name of the Complainant, Beachcroft LLP. As such, the Respondent is not commonly known by the mark and owing to the Complainant's registration and its use of the mark dating back to 1828 could not be so known. Hence, the Complainant implicitly concludes that the Respondent's use of the name violates paragraph 4(c)(ii) of the Policy.

Third, the Complainant contends that inasmuch as the Respondent is using the name to divert Internet users to its website which, in turn, provides those users with links to websites of organizations competitive with the Complainant or to other legal-related websites unrelated to the Complainant, then the Respondent is not making a legitimate noncommercial or fair use of the name and particularly without an intent for commercial gain to misleadingly divert customers. Hence, the Respondent's use of the name violates paragraph 4(c)(iii) of the Policy.

(iii) Registered and Used in Bad Faith

Lastly, the Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Specifically, the Complainant asserts that the Respondent, by using the name that contains the BEACHCROFT mark, is diverting Internet users, particularly in the UK, to the latter's website which contains various links to commercial websites of other UK law firms, which directly compete with the Complainant, and also to commercial websites which provide other legal-related services. In so doing and obtaining click-through revenue as a result, the Respondent is exploiting the goodwill in the Complainant's marks to the Respondent's own pecuniary benefit.

Along those lines, the Complainant argues that a high degree of probability exists that an unsophisticated purchaser of legal services, once having heard of the national reputation of the Complainant, would access the Respondent's website and then, being somewhat confused, follow links provided thereon to other law firms or legal service providers. Furthermore, astute costumers or indeed the Complainant's own clients - might well access that website and assume that the Complainant itself had chosen to set up that site as an inexpensive portal to promote a wide variety of potential legal services beyond the Complainant's commercial base.

Hence, the Respondent's actions constitute bad faith under paragraph 4(b)(iv) of the Policy.

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. Consequently, 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. Moniker Privacy Services as a respondent

The Complainant has named Moniker Privacy Services as well as the registrant itself as separate Respondents in this action. Given that neither Respondent has filed a Response, let alone one from Moniker Privacy Services objecting to its inclusion as a named Respondent, then the Panel sees no justifiable reason why Moniker Privacy Services should not remain as a named Respondent.

B. Identical or Confusingly Similar

The Panel finds that the disputed domain name is identical to the Complainant's BEACHCROFT marks.

From a simple comparison of the name and the BEACHCROFT mark, no doubt exists that the disputed domain name is, for all practical purposes, identical to that mark. The only difference between the name and that mark are merely the appending of a gTLD (generic top level domain) ".com" to the mark. Well-established UDRP precedent holds that the addition of a gTLD (generic top level domain) is completely irrelevant in assessing identity/confusing similarity and thus totally ignored. Even other changes of slightly more substance, such as adding a short letter or number group or even a generic word, to a mark are, in the vast majority of instances, each 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 name to avoid user confusion. See, e.g., *Eldorado Stone Operations, LLC v. Abadaba S.A., Domain Admin*, WIPO Case No. D2007-1580 (January 4, 2008); *Christian Dior Couture v. Alex Roché*, WIPO Case No. DTV2007-0004 (June 15, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Jennifer Burns*, NAF Case No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); and *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); and *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003).

Therefore, the Panel finds that the disputed domain name <beachcroft.com> sufficiently resembles the Complainant's BEACHCROFT marks as to cause confusion. Hence, the Complainant has shown identity between the Complainant's marks and the disputed domain name under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

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

The Complainant has never authorized the Respondent to utilize any of its BEACHCROFT marks or any mark confusingly similar thereto in conjunction with the services with which the Complainant uses that mark or for similar services, 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 any of the Complainant's BEACHCROFT marks or one confusingly similar thereto in connection with the identical or even similar services to those currently provided by the Complainant, as recited in its trademark registrations, would violate the exclusive trademark rights now residing with the Complainant. See, e.g., *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072 (September 4, 2008); *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505 (May 28, 2008); *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878 (March 12, 2008); *Blackrock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627 (January 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (December 18, 2000); and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000). Consequently, the Respondent could not legally acquire any public association between it and any of the BEACHCROFT marks or one similar thereto, at least for the services rendered by the Complainant, or, broadly speaking, any service likely perceived by its users to be so similar and/or to emanate from or be related, in any fashion, to those then offered by the Complainant.

Further, there is absolutely no evidence on record that the Respondent has ever been commonly known by the disputed domain name or more generally any of the BEACHCROFT marks. Nor could the Respondent in this case ever become so known, in light of the Complainant's exclusive trademark rights, with first use of the mark BEACHCROFT dating back to 1828 which is some 173 years prior to the date, March 14, 2001, on which the Respondent registered the disputed domain name and the reputation and notoriety which the Complainant has gained in the use of its marks at least in the UK during that time, without infringing on the exclusive trademark rights of the Complainant. Moreover, the Complainant's UK and CTM registrations of its BEACHCROFT marks issued in May 28, 1999 and January 31, 2001, respectively, also occurred prior to the March 14, 2001 registration date of the name. See, e.g., *MySpace* and *Treeforms, Inc.*, both 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 Respondent's use of the disputed domain name to cause and opportunistically exploit user confusion by diverting Internet users to both competing and third-party websites for pecuniary gain, which in this Panel's view infringes the Complainant's trademark rights, cannot constitute a *bona fide* offering of services and is unquestionably commercial in nature. Hence, the Respondent's conduct does not fall within paragraph 4(c)(i) or 4(c)(iii) of the Policy either.

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.

D. Registered and Used in Bad Faith

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

The Panel believes that the Respondent was well aware of the Complainant and its BEACHCROFT marks when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the name to opportunistically exploit its potential to generate user confusion for the Respondent's eventual financial benefit.

Given the notoriety and reputation which the Complainant and its BEACHCROFT marks had garnered by March 2001 particularly since that the Complainant operating under the name BEACHCROFT has grown over the preceding 170+ years to become the 13th largest law firm in the UK since it commenced operation in 1828, it is simply inconceivable to the Panel that the Respondent had no such prior knowledge of any of those marks.

This view is further supported by the facts and the Panel's findings that: (a) once an Internet user reached the Respondent's website, nothing existed on that site which would lead that user to reasonably infer other than that a connection, affiliation or relationship of some sort likely exists between the Respondent's website and the Complainant when, in actuality, none exists; (b) the Respondent intentionally placed, on its website, content in the form of sponsored links to websites of other UK law firms which directly competed with the Complainant; and (c) the Respondent derived pecuniary benefit from each such user who chose, as a result of having been diverted to the Respondent's website rather than reaching the Complainant's website, to click on any of the links provided on the Respondent's website.

Given the lack of any response, the Panel infers that generating such benefit predicated on such confusion and which the Respondent would not otherwise attain was the Respondent's ultimate goal when it registered and subsequently used the name as it did.

It is precisely that exploitation resulting from the confusion which, at its roots, trades on, leverages from and injures the goodwill of the Complainant's marks to the Complainant's detriment and the Respondent's benefit, that constitutes bad faith. See *HRB Innovations Inc.*, cited *supra*.

Consequently, the Panel concludes that the Respondent's conduct with respect to the disputed domain name constitutes bad faith use and registration under

paragraph 4(b)(iv) and hence also under paragraph 4(a)(iii) of the Policy.

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, <beachcroft.com>, is ordered transferred to the Complainant.

Peter L. Michaelson, Esq.
Sole Panelist

Dated: December 3, 2008