

## **ADMINISTRATIVE PANEL DECISION**

National Westminster Bank plc v. natrest bkss

Case No. D2012-1708

### **1. The Parties**

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

The Respondent is natrest bkss of Uganda.

### **2. The Domain Name and Registrar**

The disputed domain name <natwestbbnk.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 28, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response was September 17, 2012. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 8, 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 October 3, 2011 and is set to expire on October 3, 2012.

##### **A. The Complainant's NATWEST Marks**

The Complainant owns a substantial number of US 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 countries illustratively include the United States of America ("US"), UK and the European Community.

##### **B. The 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., <natwest.com> and <natwest.co.uk>, hardcopies of the homepages of which appear in Annex 8 to the Complaint.

The Complainant tried to contact the Respondent, through email, on October 11, 2011 through a cease and desist letter. 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. The Respondent's email address was inoperative with the result that the email bounced back to the Complainant. The Complainant then contacted the Registrar and informed it of the invalid Whois information. As a consequence, the Registrar suspended the disputed domain name. After inquiring as to whether the Registrar would transfer the domain name to the Complainant or at least delete it in its entirety and then receiving no further response, 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 domain name contains the formative term "natwest" to which the term "bbnk" has been appended. The addition of the term "bbnk" 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 name, hence negating any suggestion that the Respondent has been using the term NATWEST in any way that would give it legitimate rights in the name under common law based use. Further, as the Respondent identified itself, apparently falsely and as evident in the Whois record, as "natrest bkss", it is certainly not commonly known by the name.

Second, the Respondent has used the disputed domain name to pass itself off as the Complainant in order to defraud the Complainant's customers through a fraudulent website 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 itself 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, according to the Complainant, the Respondent used the domain name to engage in a phishing scam. By utilizing the Complainant's mark, the Respondent was using the 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 its 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.

**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 in this Panel's view 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 "bbnk" to form a separate corresponding composite term "natwestbbnk" 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) 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 name to avoid user confusion. Here, adding a short letter group, that being the term “bbnk”, 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. Rons Porta 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.

Further, the term “bbnk” contains a well-known abbreviation “bnk” for the term “bank”. Thus, it is rather evident to this Panel that the Respondent is intentionally exploiting, for its own gain, an Internet user’s inadvertent tendency, while typing, to erroneously spell a domain name, *i.e.*, “typosquatting”. In that regard, it is quite conceivable that an Internet user, who seeks information on the Complainant, and given well-known naming conventions in use on the Internet, could well form a domain name by typing the Complainant’s mark NATWEST followed by the abbreviation “bnk” into its browser but inadvertently misspelled as “bbnk” (along with adding the standard “.com” gTLD to the name) . That user would have a reasonable expectation that doing so would direct that browser to either the Complainant’s website or a site authorized by the Complainant. However, unbeknownst to that user, he or she would be diverted to the Respondent’s website through which the Respondent would then attempt through a “phishing” scam to fraudulently extract confidential banking information from that user to that user’s ultimate detriment. Hence, incorporating the term “bbnk” to the disputed domain name only heightens the likelihood of that the Respondent would cause fraud-induced injury to the Complainant’s customers ultimately to the benefit of the Respondent and the detriment of Complainant. See *Tommy Bahama, Nat’l Assn. of Realtors, Space Needle, Burberry, Krispy Kreme, Dreamworks* and *MySpace*, all cited *supra*.

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.

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 Panel notes that the website to which the disputed domain name resolves is inactive at the time of this Decision.

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. JapanNippon*, 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 it 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 paragraphs 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 use of the domain name as the vehicle through which it 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 it 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 it did not intend to use it as it has.

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

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 *prima facie* 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 <natwestbbnk.com> is ordered to be transferred to the Complainant.

**Peter L. Michaelson**

Sole Panelist

Dated: October 22, 2012