

ADMINISTRATIVE PANEL DECISION

Esure Insurance Limited v. Istvan Mayer

Case No. D2019-0681

1. The Parties

The Complainant is Esure Insurance Limited of Reigate, United Kingdom, represented by Keltie LLP, United Kingdom ("UK").

The Respondent is Istvan Mayer of Dublin, Ireland.

2. The Domain Name and Registrar

The disputed domain name <esurego.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 26, 2019. On March 27, 2019, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed domain name. On March 28, 2019, the Registrar transmitted, by email, to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center, in turn, sent an email communication to the Complainant on April 1, 2019 providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 3, 2019.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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"). Hereinafter, the Complaint will refer to the amended Complaint, unless the context specifically indicates otherwise.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint and that this proceeding commenced on April 5, 2019. In accordance with the Rules, paragraph 5, the Center set the due date for a Response to April 25, 2019. The Respondent did not submit any response. Accordingly, on April 26, 2019, the Center notified the parties of the Respondent's default.

On May 8, 2019, the Center appointed Peter L. Michaelson as the sole panelist in this matter. 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

As reflected in the registration record for the disputed domain name in the public Whois database (a copy of that record appears in Annex 1 to the Complaint), the disputed domain name was registered on February 26, 2019 and will expire on February 26, 2020.

A. The Complainant's esure marks (collectively the "esure Marks")

As indicated in the Complaint, the Complainant owns various UK and Community (European) trademark registrations for the term "esure" (and variants) in block letters. The Complainant has provided, in Annex 2 to the Complaint, print-outs of its registration certificates for these registrations. Pertinent details of these registrations are as follows:

1. esure (word)

European Union registration number: 2147890

Filed: March 13, 2001; Registered: July 15, 2002

This mark is registered for use in connection with: "Insurance services; provision of information and consultancy services relating to insurance" in international class 36.

2. esure (word)

European Union registration number: 4470423

Filed: May 19, 2005; Registered: June 20, 2006

This mark is registered for use in connection with: "Financial services; financial affairs; monetary affairs; insurance services; insurance broking and underwriting services; issuance of credit and debit cards; credit, debit and charge card services; discount card services; automated payment services; banking services; credit services; mortgage services; mortgage protection services; loan services; income protection services; information, advisory and consultancy services relating to the aforementioned services"; all in international class 36.

3. ESURE (word), esure (word) and esure (stylized)

UK registration number: 2204410

Filed: July 30, 1999; Registered: January 14, 2000

This mark is registered for use in connection with: "Insurance services; provision of information and consultancy services relating to insurance" in international class 36.

4. esure (word)

UK registration number: 3076709

Filed: October 13, 2014; Registered: January 23, 2015

This mark is registered for use in connection with: "Insurance services; provision of information and consultancy services relating to insurance" in Class 36.

B. The Parties and their activities

The Complainant was founded in 2000. It has become one of the UK's leading insurance companies with over two million customers and over 1,500 employees across the UK with offices in Surrey, Manchester and Glasgow. During the Complainant's early years, it used its esure mark extensively in television and radio advertisements. Since its founding, the Complainant has also used its mark esure continuously on its

website (a copy of web pages as they appeared on December 17, 2018 from its sites at <esure.com>, <esurebroker.com> and <esuregroup.com> are provided in Annex 4 to the Complaint). For the years 2014, 2015 and 2016, the Complainant's website at <esure.com> respectively experienced 2,030,187; 3,689,859 and 6,381,308 annual visitors

Since 2000 and continuing to the present, the Complainant annually expends millions of UK pounds in advertising its services under its esure mark across many forms of media and other outlets including television, radio, national newspapers and other publications, advertising on third-party Internet websites including display and pay-per-click, poster campaigns, sponsorship, direct mail and door drop, brand licensing, affiliates, printing and stationery, and promotional events. From 2010 through 2016, these expenditures have annually increased from approximately UKP 2.5 Million in 2010 to UKP 7.7 Million in 2016. During that time, the Complainant's annual sales from 2010 through 2016 have risen from approximately UKP 100 Million for 2010 to UKP 302 Million for 2016. See Witness Statement of Nigel Gosden, Retail Director of the Complainant (a copy of which appears in Annex 7 to the Complaint) dated May 12, 2017 which includes a detailed delineation of the Complainant's promotional and marketing activities involving its esure mark from 2000 through 2016.

As of the date of the Complaint, the Respondent is not using the domain name in conjunction with an operative website. The name merely resolves to a parking page provided by the Registrar through which the name is offered for sale. That page contains several pay-per-click links to third-party websites offering insurance services, such as for automobile coverage, that directly compete with insurance services offered by the Complainant. A copy of this parking page is provided in Annex 10 to the Complaint with, in Annex 11, a copy of a web page that results from clicking on the link "Cheap Car Insurance Quotes" appearing on the parking page. That web page takes an Internet user to a page listing four insurance businesses including "Be Wiser", the latter being an insurance broker and competitor of the Complainant.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its mark esure.

Specifically, the name contains this mark, in its entirety, to which the common word "go" has been appended, the latter being insufficient to adequately distinguish the resulting name from the mark to prevent confusion of Internet users.

Thus, the Claimant 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 paragraphs 4(a)(ii) and 4(c) of the Policy.

First, the Respondent does not own any trademark registrations where a corresponding mark comprises part or all of the name. A "worldwide" search, which the Complainant conducted on the Saegis database on March 26, 2019 for the terms "esure go", "esurego" and "esurego.com", failed to uncover any results, thus indicating that no third-party, including the Respondent, has a trade mark registration for any of these terms. A copy of the page from the Saegis database showing the results of this search appears in Annex 9 to the Complaint. Consequently, the Respondent is not commonly known by the disputed domain name.

Moreover, the Complainant has not provided its consent to the Respondent to use any of the esure Marks in a domain name.

Additionally, no evidence exists that the Respondent, in connection with a *bona fide* offering of goods or services, either has made demonstrable preparations to so use the name or is currently so using the name. Use of the name to resolve to a parking page providing links to third-parties competitors of the Complainant does not constitute such a *bona fide* use.

(iii) Registered and Used in Bad Faith

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

Specifically, as to bad faith registration, it is inconceivable that the Respondent was unaware of the Complainant and its reputation when, in spite of that knowledge, the Respondent intentionally registered the name. The Complainant's mark esure is neither a generic nor descriptive. It is devoid of any dictionary meaning. Through the Complainant's continuous and extensive marketing and promotion of its services under its mark esure since 2000 with its exclusive trademark rights dating back to 1999, the Complainant has acquired a substantial reputation in its industry through that mark and widespread visibility and public recognition in the mark. Given the Respondent's prior knowledge of the Complainant and its mark, the only purpose which the Respondent had in registering the disputed domain name was to deliberately create a misimpression in the minds of Internet users that an association of some sort existed between the Parties, when no such association exists at all, and thereby mislead and likely confuse those users.

The Respondent's use of the domain name to address a parking page containing pay-per-click links to businesses offering insurance services directly competing with those provided by the Complainant constitutes bad faith use.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

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

From a simple comparison of the disputed domain name to the Complainant's mark esure, no doubt exists that the disputed domain name is confusingly similar to it. The disputed domain name consists of the mark to which the common word "go" has been added to form a composite term and then to which the gTLD ".com" has been appended, with the addition of the ".com" being irrelevant in this case in assessing confusing similarity under paragraph 4(a)(i) of the Policy and thus ignored. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), sections 1.7, 1.8 and 1.11.

It is now very well-established in prior UDRP cases, including numerous decisions previously rendered by this Panel, that a minor variation to a mark, including a minor addition to it, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to prevent confusing similarity. The Respondent's addition of the word "go" to the Complainant's mark to form the disputed domain name unquestionably constitutes such a minor variation. See, e.g., *Praxis Capital, Inc. v. John C. Martinez, The Praxeology Group LLC*, WIPO Case No. D2019-0254; *Kumfs Brand Limited v. George*,

WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *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; and *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148.

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 of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's mark esure in either a domain name or any other use and has no relationship, affiliation or connection whatsoever with the Respondent.

Further, in view of the Respondent's default, the Panel accepts as uncontested the Complainant's assertions that the Respondent has never actually used the disputed domain name in connection with a *bona fide* offering of goods or services or made any prior demonstrable preparations to do so but rather only uses the name to resolve to a parking page containing links to third-party sites offering services directly competitive with those of the Complainant. Using a domain name that intentionally infringes the exclusive trademark rights of another, let alone as a vehicle through which directly competitive third-party services are offered, fails to qualify as a *bona fide* use. Nor does such a use constitute either a legitimate non-commercial or fair use of the name.

Given the Complainant's exclusive rights in its esure mark, which predate, by approximately 20 years, the date (February 26, 2019) on which the Respondent registered the disputed domain name, and the substantial recognition, reputation and good-will which the Complainant developed in its esure Marks since then, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to those of the Complainant — at least for the insurance and related services provided by the Complainant under any of these marks — without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Praxis Capital, Inc. (cited supra)*; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; and *Chicago Mercantile Exchange Inc., Cummins Inc. and Staatliche Porzellan-Manufaktur*, all cited *supra*. Consequently, the Respondent is not commonly known by the disputed domain name or the Complainant's mark.

Hence, the Respondent does not fall within any of paragraphs 4(c)(i) to 4(c)(iii) 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.

The Panel infers, from the lack of any Response, that it is quite likely, given the renown of the Complainant, that the Respondent was well aware of the Complainant, its reputation and goodwill in its mark esure, and

the exclusive rights which the Complainant then had in that mark when the Respondent registered the disputed domain name. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally registered the name for its potential to cause confusion with the Complainant's mark.

In that regard, the Respondent doubtlessly believed that Internet users, who sought the Complainant's website and were familiar with the Complainant's mark esure would be confused, upon entering the disputed domain name into their browsers, by the similarity between the name and that mark -- inasmuch as the name incorporated the mark in its entirety followed by the common word "go" -- and would consequently assume that a relationship of some sort exists between the parties, possibly a sponsorship, affiliation or endorsement of the Respondent's website by the Complainant, when in fact no such relationship exists at all.

As the Respondent is currently offering the name for sale, the Panel also infers the Respondent's likely intention in doing so is to eventually sell the name to a third-party purchaser -- at price clearly in excess of its costs of registration to yield a sufficient profit. The purchaser, fully cognizant of its inability to legitimately use the name due to an absence of any authorization from the Complainant to use its esure mark, may well purchase the name with a specific intent of benefiting from deliberately exploiting the name's marked potential to produce user confusion. Such confusion would cause Internet traffic destined to the Complainant's website (or one affiliated with or related to the Complainant) to be diverted to the purchaser's website (or one affiliated or related to the purchaser) through which insurance services could be offered that directly compete with those then provided by the Complainant. That, in turn, would deprive the Complainant of resulting business and quite possibly injure its reputation to the Complainant's ultimate detriment.

Alternatively, that purchaser, rather than using the name itself to cause and exploit ensuing confusion, might hold the name for ransom by eventually offering to sell it to the Complainant at an even higher price than that at which the purchaser acquired it, so that the Complainant could forestall any confusion and injury to its own reputation that might otherwise arise from any unauthorized use of the name.

In the meantime pending any such sale of the name to the purchaser, the Respondent is using the name to resolve to a parking page which itself offers third-party insurance services directly competitive with those offered by the Complainant. By doing so, the Respondent is causing confusion of Internet users who mistakenly enter that name into their browsers, expecting to reach the Complainant's website but in actuality do not and instead reach the parking page. Through pay-per-click links to such third-party insurance providers incorporated into the parking page, the Respondent is currently benefiting from click-through revenue generated each time a user, mistakenly thinking s/he would reach the Complainant's website or one affiliated with the Complainant through which that person could purchase insurance, clicks on any such link and instead reaches any of the third-party insurance providers. This diversion routes business away from the Complainant which, in the absence of confusion, it would otherwise legitimately receive.

The Respondent's conduct patently violates paragraphs 4(b)(i), (iii) and (iv) of the Policy and consequently reflects bad faith use.

Thus, the Panel concludes that the Complainant has provided sufficient evidence 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 <esurego.com> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: May 15, 2019