



## NATIONAL ARBITRATION FORUM

### DECISION

Norton Finance (UK) Limited v. WTI  
Claim Number: FA0711001109538

#### PARTIES

Complainant is **Norton Finance (UK) Limited** ("Complainant"), represented by **Adam Taylor**, of **Adlex Solicitors**, 76A Belsize Lane, London NW3 5BJ, United Kingdom. Respondent is **WTI** ("Respondent"), 5F, 720-31 JisanDong DongGu, Gwangju 501150, KR.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**norton-finance.com**>, registered with **Bizcn.com, Inc.**

#### PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

#### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on November 15, 2007; the National Arbitration Forum received a hard copy of the Complaint on November 16, 2007.

On November 27, 2007, Bizcn.com, Inc. confirmed by e-mail to the National Arbitration Forum that the <**norton-finance.com**> domain name is registered with Bizcn.com, Inc. and that Respondent is the current registrant of the name. Bizcn.com, Inc. has verified that Respondent is bound by the Bizcn.com, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On December 4, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of December 26, 2007 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@norton-finance.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On December 29, 2007, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

### **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

### **PARTIES' CONTENTIONS**

A. Complainant makes the following assertions:

#### **[a.] *Factual background:***

##### *(i.) Complainant*

1. The Complainant was incorporated on 4 January 1988 and commenced carrying on the business of finance broker in the UK under the name "Norton Finance" in approximately 1988.
2. The Complainant owns the registered trade mark specified above.
3. The Complainant operates its main websites at nortonfinance.com and nortonfinance.co.uk. Between 15 September 2006 and 31 December 2006 there were 1,129,918 unique visits to nortonfinance.co.uk. In this year, to date, 4,007,112 unique visits and 54,394,821 page impressions have been recorded.
4. The Complainant is registered with the Finance Industry Standards Association and is a member of the Association of Finance Brokers. In an average month it receives approximately 9000 customer applications for loans totaling over £200 million and arranges loans totaling over £21 million for over 1000 customers.
5. The Complainant's turnover over for the years ending 2003, 2004 and 2005 was £10,731,806 (approximately \$22,000,000), £9,372,350 (approximately \$20,000,000) and £12,069,000 (approximately \$24,000,000) respectively.

6. During the period 2004 to 2006 over £50,000,000 (\$100,000,000) was spent marketing the “Norton Finance” name.
7. The marketing of the “Norton” and “Norton Finance” trade mark has included advertising in national and trade newspapers, magazines and directories, TV campaigns and internet advertising.
8. For further background information about the Complainant’s business, see its websites mentioned above.

*(ii.) Respondent*

9. The Domain was registered on 1 September 2005.
10. As of 21 February 2006, there was a website available at the Domain comprising a directory of affiliate links, the most prominent of which were to financial service websites offering loans competing with the Complainant as well as a link to the Complainant’s own website (nortonfinance.co.uk). The Domain also appears prominently in the heading of the website.
11. The Complainant’s solicitor sent a cease and desist communication by email on 21 February 2006 to which no response was received.
12. A printout as of 22 February 2006 shows that the format of the website at the Domain had changed but still comprised a directory of affiliate links as mentioned above.
13. The Complainant’s solicitor sent a second cease and desist chaser letter (dated 7 March 2006) by recorded delivery to the physical address of the Respondent. The letter was returned as undeliverable.

**[b.] *The manner in which the domain names are confusingly similar to a trademark or service mark in which the Complainant has rights. ICANN Rule 3(b)(ix)(1); ICANN Policy ¶4(a)(i).***

*(i.) Rights*

14. The Complainant relies on its registered trade mark referred to in paragraph [4] [c] above.
15. The Complainant also relies on common law rights by virtue of the extensive trading and marketing activities relating to the “NORTON” and “NORTON FINANCE” brand mentioned above.

*(ii.) Identical or Confusing Similarity*

16. The Domain is confusingly similar to the Complainants' NORTON FINANCE and NORTON trade mark, disregarding the domain suffix.
17. The Domain differs from "NORTON FINANCE" only by addition of a hyphen between the words NORTON and FINANCE, which does not significantly distinguish the domain name from the trade mark. See *Nintendo Of Am. Inc. v. This Domain Is For Sale*, D2000-1197 (WIPO Nov. 1, 2000) finding <game-boy.com> identical and confusingly similar Complainant's GAME BOY mark.
18. The Domain differs from "NORTON" only by the addition of a hyphen and the addition of the word "FINANCE" which does not significantly distinguish the domain name from the trade mark. See *Nintendo Of Am. Inc. v. This Domain Is For Sale*, D2000-1197 (WIPO Nov. 1, 2000) finding <game-boy.com> identical and confusingly similar Complainant's GAME BOY mark

**[c.] *The Respondent has no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint. ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).***

19. The Complainant asserts that, for the reasons stated below, it has made a *prima facie* case that the Respondent should be considered as having no rights or legitimate interests in the Domain and that the burden now shifts to the Respondent. See *G.D. Searle v. Martin Mktg.*, 118277 (Nat. Arb. Forum, Oct. 23, 2002) (where complainant has asserted that respondent has no rights or legitimate interests it was incumbent on respondent to come forward with concrete evidence rebutting this assertion because this information is "uniquely within the knowledge and control of the respondent").
20. Dealing with each of the subparagraphs of paragraph 4 (c) of the ICANN policy in turn:
  - (i.) *Whether, before any notice to the Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name is in connection with a bona fide offering of goods or services.*
21. The Complainant has no association with the Respondent and has never authorized or licensed the Respondent to use its trade marks.
22. The Respondent has clearly used the Domain and the Complainant's trade marks to attract, confuse and profit from internet users seeking the Complainant – see the submissions in relation to bad faith below. Such use of the Domain could not be said to be "bona fide".

23. See also *Am. Online, Inc. v. Fu*, D2000-1374 (WIPO Dec. 11, 2000) (finding that “[I]t would be unconscionable to find a bona fide offering of services in a respondent’s operation of web-site using a domain name which is confusingly similar to the Complainant’s mark and for the same business”). The Complainant submits that that applies here as the website has been used to link to similar services to those offered by the Complainant.

*(ii.) Whether Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if Respondent has not acquired trademark or service mark rights*

24. There is no evidence that the Respondent has been commonly known by the name comprised in the Domain.

*(iii.) Whether Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.*

25. It is clear that the Respondent was out for commercial gain. See the Complainant’s submissions below in relation to 4b(iv) of the Policy

**[d.] *The domain name(s) should be considered as having been registered and being used in bad faith. ICANN Rule 3(b)(ix)(3); ICANN Policy ¶4(a)(iii).***

26. The Complainant relies on 4b (iii) and (iv) of the Policy.

*(iii.) 4b(iii): registration of the domain name primarily for the purpose of disrupting the business of a competitor*

27. The Respondent registered the Domain for the purpose of unfairly disrupting the business of the Complainant by diverting business intended for the Complainant. The Respondent is a competitor in that its website features links to other sites offering services similar to those of the Complainant.

28. As explained below, the Respondent was clearly aware of the Complainant and its business when it registered the Domain.

29. It is inconceivable that the Respondent intended to operate a genuine business with (or had any other genuine reason to use) a domain name which comprised a competitor’s trade mark.

*(iv.) 4b(iv): By using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.*

30. The website at the Domain is essentially a scheme adopted by the Respondent to confuse, attract and profit from internet users who are searching for the Complainant's business in search engines, web browsers and otherwise on the internet. This has not been denied by the Respondent.
31. It is clear from the following that the Respondent had the Complainant and its business in mind when registering and using the Domain:
  - a. the Respondent has not denied this assertion by the Complainant;
  - b. the Domain comprises the Complainant's distinctive trade mark – it is inconceivable that the Respondent registered the Domain independently of that trade mark;
  - c. the purpose in registering / using a Domain comprising the word NORTON in relation to financial services can have only have been to target the Complainant's business; and
  - d. the website at the Domain includes links to the Complainant's own website.
32. The use of the Domain which comprises the Complainant's trade mark is intended by the Respondent to create a likelihood of confusion in the minds of the public as to an association between the Respondent and the Complainant.
33. Furthermore, the name of the Domain appears prominently on the top of the home page, thereby adding to likely confusion on the part of internet users. The trade mark also appears in the meta title of the website.
34. It is obvious that the Respondent was intent upon commercial gain by means of affiliate / sponsored links and advertising. Indeed it is difficult to conceive that the Respondent would engage in a scheme such as this for a non commercial purpose. It is well known that many directory websites generate revenue by directing traffic to other websites (see *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.* Case No. D2002-0787 (WIPO, 8 October 2002) in relation to <bmwdealer.com>)). It is evident that at least one of the Respondent's purposes was to attract and profit from internet users seeking the Complainant's website.

*(v.) Other factors*

35. The Complainant also relies on the fact that the Respondent has not responded to, let alone denied, the assertions of bad faith in the pre-action communications by the Complainant.

36. The Complainant invokes as further evidence of bad faith the use by the Respondent of a false registrant address as indicated by the return of the envelope referred to above. This was clearly an attempt to evade responsibility for its bad faith registration/use of the Domain.

B. Respondent failed to submit a Response in this proceeding.

## **FINDINGS**

Complainant's NORTON FINANCE mark was registered with the United Kingdom Intellectual Property Office ("UKIPO") (formerly known as the United Kingdom Patent Office) (Reg. No. 2,374,663, issued March 11, 2005). The mark is used in connection with various financial products and services.

Respondent's <norton-finance.com> domain name was registered on September 1, 2005. It resolves to a directory of links to various third-parties, many of which operate in the finance industry and offer products and services in direct competition with those offered under Complainant's mark.

## **DISCUSSION**

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

Complainant has sufficiently established its rights in the NORTON FINANCE mark through registration with the UKIPO pursuant to Policy ¶4(a)(i). *See KCTS Television Inc. v. Get-on-the-Web Ltd.*, D2001-0154 (WIPO Apr. 20, 2001) (holding that it does not matter for the purpose of paragraph 4(a)(i) of the Policy whether the complainant's mark is registered in a country other than that of the respondent's place of business); *see also Koninklijke KPN N.V. v. Telepathy Inc.*, D2001-0217 (WIPO May 7, 2001) (finding that the Policy does not require that the mark be registered in the country in which the respondent operates; therefore it is sufficient that the complainant can demonstrate a mark in some jurisdiction).

The <norton-finance.com> domain name contains Complainant's NORTON FINANCE mark in its entirety, separating the words "NORTON" and "FINANCE" with a hyphen. Moreover, the disputed domain name includes the generic top-level domain ("gTLD") ".com." It is well established that the inclusion of a gTLD and a hyphen do not distinguish a disputed domain name. Therefore, the Panel finds the <norton-finance.com> domain name is confusingly similar to Complainant's NORTON FINANCE mark pursuant to Policy ¶4(a)(i). *See Chernow Commc'ns, Inc. v. Kimball*, D2000-0119 (WIPO May 18, 2000) (holding "that the use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark"); *see also Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) (finding that hyphens and top-level domains are irrelevant for purposes of the Policy).

The Panel concludes Complainant has satisfied Policy ¶4(a)(i).

### **Rights or Legitimate Interests**

Under Policy ¶4(a)(ii), Complainant must first establish a *prima facie* case Respondent has no rights or legitimate interests in the disputed domain name. *See VeriSign Inc. v. VeneSign C.A.*, D2000-0303 (WIPO June 28, 2000) ("Respondent's default, however, does not lead to an automatic ruling for Complainant. Complainant still must establish a *prima facie* case showing that under the Uniform Domain Name Dispute Resolution Policy it is entitled to a transfer of the domain name."). The Panel finds Complainant has established a *prima facie* case and that the burden is thus shifted to Respondent to show it does have rights or a legitimate interest in the disputed domain name. *See Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that, where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name, it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is "uniquely within the knowledge and control of the respondent"); *see also Woolworths plc. v. Anderson*, D2000-1113 (WIPO Oct. 10, 2000) (finding that, absent evidence of preparation to use the domain name for a legitimate purpose, the burden of proof lies with the respondent to demonstrate that it has rights or legitimate interests).

No response has been filed in this case. Consequently, the Panel presumes Respondent has no rights or legitimate interests in the <norton-finance.com> domain name, but will nonetheless examine the record in consideration of the factors listed under Policy ¶4(c). *See Am. Express Co. v. Fang Suhendro*, FA 129120 (Nat. Arb. Forum Dec. 30, 2002) (“[B]ased on Respondent's failure to respond, it is presumed that Respondent lacks all rights and legitimate interests in the disputed domain name.”); *see also Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding it appropriate for the panel to draw adverse inferences from the respondent’s failure to reply to the complaint).

Nowhere in Respondent’s WHOIS information or elsewhere in the record does it indicate that Respondent is, or ever was, commonly known by the disputed domain name. Additionally, Complainant has not granted Respondent permission or authorization to use the NORTON FINANCE mark in any way. As a result, the Panel finds Respondent is not commonly known by the disputed domain name pursuant to Policy ¶4(c)(ii). *See Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating “nothing in Respondent’s WHOIS information implies that Respondent is ‘commonly known by’ the disputed domain name” as one factor in determining that Policy ¶4(c)(ii) does not apply); *see also Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name).

The <norton-finance.com> domain name resolves to a directory of links to third-parties, many of whom operate in the finance industry and offer products and services in direct competition with those offered under Complainant’s mark. The Panel finds this to be neither a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). *See Ameritrade Holdings Corp. v. Polanski*, FA 102715 (Nat. Arb. Forum Jan. 11, 2002) (finding that the respondent’s use of the disputed domain name to redirect Internet users to a financial services website, which competed with the complainant, was not a *bona fide* offering of goods or services); *see also Glaxo Group Ltd. v. WWW Zban*, FA 203164 (Nat. Arb. Forum Dec. 1, 2003) (finding that the respondent was not using the domain name within the parameters of Policy ¶4(c)(i) or (iii) because the respondent used the domain name to take advantage of the complainant's mark by diverting Internet users to a competing commercial site).

The Panel concludes Complainant has satisfied Policy ¶4(a)(ii).

### **Registration and Use in Bad Faith**

The <norton-finance.com> domain name resolves to a directory of a variety of links related to the finance industry and many of which offer products and services in direct competition with those offered under Complainant’s mark. The Panel finds this to demonstrate Respondent’s intent to disrupt Complainant’s business and consequently to

establish Respondent's bad faith registration and use of the <norton-finance.com> domain name pursuant to Policy ¶4(b)(iii). *See Puckett, Individually v. Miller*, D2000-0297 (WIPO June 12, 2000) (finding that the respondent has diverted business from the complainant to a competitor's website in violation of Policy ¶4(b)(iii)); *see also Disney Enters., Inc. v. Noel*, FA 198805 (Nat. Arb. Forum Nov. 11, 2003) ("Respondent registered a domain name confusingly similar to Complainant's mark to divert Internet users to a competitor's website. It is a reasonable inference that Respondent's purpose of registration and use was to either disrupt or create confusion for Complainant's business in bad faith pursuant to Policy ¶¶4(b)(iii) [and] (iv).").

Moreover, the Panel presumes Respondent is commercially benefiting from the use of such links, through "click-through fees." The Panel finds this to be additional evidence of Respondent trying to commercially benefit from Internet users searching for information and services offered under Complainant's NORTON FINANCE mark that are redirected to competitors of Complainant. As a result, the Panel considers this to be additional evidence of Respondent's bad faith registration and use of the <norton-finance.com> domain name pursuant to Policy ¶4(b)(iv). *See Associated Newspapers Ltd. v. Domain Manager*, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) ("Respondent's prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to Policy ¶4(b)(iv) because the domain name provided links to Complainant's competitors and Respondent presumably commercially benefited from the misleading domain name by receiving 'click-through-fees.'"); *see also Kmart v. Khan*, FA 127708 (Nat. Arb. Forum Nov. 22, 2002) (finding that if the respondent profits from its diversionary use of the complainant's mark when the domain name resolves to commercial websites and the respondent fails to contest the complaint, it may be concluded that the respondent is using the domain name in bad faith pursuant to Policy ¶4(b)(iv)).

The Panel concludes Complainant has satisfied Policy ¶4(a)(iii).

## DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <norton-finance.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist

Dated: Sunday, January 14, 2008

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