

## **ADMINISTRATIVE PANEL DECISION**

Tesco Stores Limited v. Domain Administrator, DVLPMNT  
MARKETING, INC.

Case No. D2024-0891

### **1. The Parties**

The Complainant is Tesco Stores Limited, United Kingdom, represented by Haseltine Lake Kempner LLP, United Kingdom.

The Respondent is Domain Administrator, DVLPMNT MARKETING, INC., Saint Kitts and Nevis.

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

The disputed domain name <tescoinsurance.com> is registered with DNC Holdings, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 29, 2024. On February 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 4, 2024, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 6, 2024, 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 March 6, 2024.

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" 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 2, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on April 8, 2024. 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**

The Complainant is a leading supermarket retailer with a global presence under the mark TESCO. It provides its main website under the domain name <tesco.com>, registered December 20, 1994 (Annex 5, 7, 8 and 9 to the Complaint).

The Complainant owns various trademark registrations containing the mark TESCO (Annex 6 to the Complaint), inter alia,

- UK Trade Mark (word), Registration No. UK00002116694, registered on March, 27 1998, for a range of goods/services, including “insurance services”;
- UK Trade Mark (figurative), Registration No UK00002058853, registered March 24, 2000, for a range of goods/services including “insurance services”; and
- UK Trade Mark (word), Registration No UK00002258927, registered July 6, 2001, for a range of goods/services, including “insurance services”

The Complainant also licenses its mark TESCO, e.g., to Tesco Personal Finance PLC, which provides inter alia insurance services and offers these under the domain name <tescobank.com> (Annex 4 to the Complaint).

The disputed domain name was registered August 14, 2002 (Annex 1 to the Complaint). At the time of filing the Complaint, the disputed domain name resolved to a website where the disputed domain name was offered for sale (Annex 10 to the Complaint).

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the TESCO trademark is highly distinctive and well-known and notes that the disputed domain name contains the TESCO trademark in its entirety, simply adding the descriptive term “insurance”. The Complainant submits that it is therefore inconceivable that the Respondent would not have been aware of the Complainant’s trademark when registering the disputed domain name, or that there would be any legitimate use for the disputed domain name.

The Complainant notes that the disputed domain name is not used for a bona fide offering of goods or services; the disputed domain name only redirected users to a website where the disputed domain name was offered for sale. Therefore, the Respondent may have registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the disputed domain name.

Finally, the Complainant contends that the Respondent has a history of adverse findings of bad faith in other UDRP proceedings and therefore has engaged in a pattern of abusive registrations, conduct and/or business dealings.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

On April 10, 2024, an email was received from the Registrar, informing the Center that the Respondent has expressed its willingness to voluntarily release the disputed domain name to the Complainant and hence, further administrative proceedings may not be necessary in this case. On April 25, 2024, the Complainant sent a communication to the Center requesting the proceedings to continue and for a decision to be issued.

Since the above-mentioned email was not sent and/or authorized by the Respondent and the Respondent did not reply to the Complainant's allegations at all, as well as there is no information from the Respondent about a settlement in this case, and considering the Complainant's request for the proceedings to continue and for a decision to be issued, the Panel finds it appropriate to proceed to a substantive decision on the merits in this case.

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the mark TESCO for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

In the present case, the disputed domain name is confusingly similar to the TESCO mark in which the Complainant has rights since it incorporates the entirety of the mark TESCO and only adds the term "insurance" as suffix.

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms does not prevent a finding of confusing similarity under the first element of the Policy ([WIPO Overview 3.0](#), section 1.8). This is the case at present.

Finally, it has also long been held that generic Top-level Domains ("gTLDs") (in this case ".com") are generally disregarded when evaluating the confusing similarity of a disputed domain name. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant focuses on the fact that its trademark is highly distinctive and well known and provides suitable evidence of its reputation, adding that it is inconceivable that the Respondent would not have been aware of this when registering the disputed domain name. The Complainant also notes that the disputed domain name is not being used for a bona fide offering of goods or services.

The Respondent did not reply to the Complainant’s contentions and hence has not rebutted the Complainant’s prima facie showing.

The Panel further notes that the composition of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

As stated in paragraph 4(a)(iii) of the Policy, the Complainant must show registration and use of the disputed domain name in bad faith. These are concurrent requirements.

The Panel notes that paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In regard to the registration of the disputed domain name, the Panel notes that the Complainant has rights and is the owner of the registered trademark TESCO, which is registered and used in business long before the disputed domain name was registered. Moreover, the Complainant registered and is using the domain name <tesco.com> to address its main website, for many years and long before the registration of the disputed domain name.

It is inconceivable for this Panel that the Respondent registered the disputed domain name without knowledge of the Complainant’s rights, which leads to the necessary inference of bad faith. [WIPO Overview 3.0](#), section 3.2.2.

This finding is supported by the fact that the disputed domain name incorporates the Complainant’s trademark TESCO entirely together with the term “insurance”, which indicates that the Respondent was aware of the Complainant and its TESCO mark at the time of registration of the disputed domain name, since “insurance” is a relevant business of the Complainant.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

The disputed domain name is also being used in bad faith, putting emphasis on the following:

- the disputed domain name incorporates the Complainant’s trademark in its entirety, and is thus suited to

divert or mislead potential Internet users from the website they are actually trying to visit (the Complainant's site);

- the disputed domain name resolves to a website, where it is offered for sale;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain name; and

The Panel further notes that the respondent has failed to file a response in the current proceedings or to provide any explanation for the registration and use of the disputed domain name.

Moreover, the fact that the Respondent has had multiple UDRP complaints filed against it, which have resolved in mostly transfer decisions, supports a pattern of bad faith by the Respondent.

Based on the available record, the Panel finds the third element of the Policy has been established.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <tescoinsurance.com> be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: April 26, 2024