

ADMINISTRATIVE PANEL DECISION

FIL Limited v. Privacy Service Provided by Witheld for Privacy ehf / Nancy Stubbs

Case No. DIO2022-0011

1. The Parties

The Complainant is FIL Limited, Bermuda, United Kingdom, represented by Maucher Jenkins, United Kingdom.

The Respondent is Privacy Service Provided by Witheld for Privacy ehf, Iceland / Nancy Stubbs, Nigeria.

2. The Domain Name and Registrar

The Disputed Domain Name <fidelityfinance.io> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 10, 2022. On March 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 10, 2022, 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 sent an email communication to the Complainant on March 23, 2022, 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 24, 2022.

The Center verified that the Complaint, together with the amended Complaint, satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the "Policy"), the Rules for .IO Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .IO 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 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 10, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on May 13, 2022. 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 company organized under the laws of Bermuda that operates a globally known investment business with nearly 1,200,000 customers in the United Kingdom alone and assets under management worth more than GBP 149.3 billion. The Complainant holds a portfolio of registrations for the trademark FIDELITY, and variations of it, in several countries, including European Union trademark FIDELITY Reg. No. 3844925, registered on September 21, 2005.

The Complainant owns numerous domain names that comprise or contain the trademark FIDELITY, including the domain name <fidelity.co.uk>, <fidelityinvestments.com>, and <fidelityinvestment.com>.

The Respondent registered the Disputed Domain Name <fidelityfinance.io> on December 11, 2021. The Disputed Domain Name resolves to a crypto currency trading website.

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations including United Kingdom registration no. 903844925 for the mark FIDELITY in Classes 16 and 36, registered on September 21, 2005, and other registrations in numerous countries for the mark FIDELITY as *prima facie* evidence of ownership.

The Complainant submits that the mark FIDELITY is well known and that its rights in that mark predate the Respondent's registration of the Disputed Domain Name <fidelityfinance.io>. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the FIDELITY trademark and that the similarity is not removed by the addition of the generic word "finance" or the Top Level Domain ("TLD") ".io".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because "(t)he Disputed Domain Name is inherently confusingly similar to the Complainant's FIDELITY trademarks and the reference to "FINANCE" within it will be understood by Internet users as referring to the Complainant's sizeable and well-known investment business."

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules having regard to the prior use, and well-known nature of the Complainant's trademarks, and the use to which the Disputed Domain Name has been put to divert to a crypto trading platform while, according to the Complainant, "attempting to mislead Internet users into believing that it is a legitimate business by giving the impression that it is a legitimate, authorized and regulated, financial services establishment".

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

(i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) that the Disputed Domain Name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark FIDELITY in numerous countries including the United Kingdom. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).¹

Turning to whether the Disputed Domain Name is identical or confusingly similar to the FIDELITY trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant's trademark FIDELITY; (b) followed by the word "finance"; (c) followed by the TLD ".io".

It is well established that the TLD used as part of a domain name is generally disregarded. The TLD chosen appears to have no special significance in this proceeding. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: "fidelityfinance".

It is also well established that where, on a side-by-side comparison of the Disputed Domain Name and the textual components of the relevant trademark (to assess whether the mark is recognizable within the Disputed Domain Name) if at least a dominant feature of the relevant mark is recognizable in the Disputed Domain Name, then the Disputed Domain Name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see: [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's FIDELITY trademark. Accordingly, the Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see: [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it is misleadingly directing Internet users a web page hosting a crypto-trading platform that is not "a legitimate, authorized and regulated, financial services establishment", thereby illegitimately passing off the owner's goodwill and reputation for its own benefit. The Complainant also has not licensed, permitted or authorized the Respondent to use the Complainant's trademark.

On any objective view, the Respondent is not commonly known by the Disputed Domain Name and the Disputed Domain Name consists of the Complainant's trademark together with the word "finance", carrying a high risk of implied affiliation that cannot constitute fair use given the suggested sponsorship or endorsement by the Complainant (see: [WIPO Overview 3.0](#), section 2.5.1).

This Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name and, in the absence of a Response by the Respondent, the Panel finds for the Complainant on the second element of the Policy.

¹ Given the similarities between the .IO Policy and the Uniform Domain Name Dispute Resolution Policy ("UDRP"), the Panel finds UDRP precedent to be relevant to this case.

C. Registered or Used in Bad Faith

The third element of the Policy that the Complainant must also demonstrate is that the Disputed Domain Name has been registered or used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence for this requirement.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the content of the website it resolves to, the Panel is satisfied that the Respondent knew of the Complainant's well-known trademark FIDELITY when it registered the Disputed Domain Name (see *FIL Limited v. Charles Van Renynghe, Fidelity Finance GmbH*, WIPO Case No. [D2015-1269](#) ("The Panel accepts that it is likely the Respondent was aware of the Complainant's FIDELITY mark at the time of registration of the Disputed Domain Names, as the Complainant is well-known worldwide and has been in operation for many years. It also cannot be mere coincidence that the Respondent has used the word "finance" in the Disputed Domain Names, which is the same industry in which the Complainant operates."); [WIPO Overview 3.0](#), section 3.2.2).

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name other than to trade off the reputation and goodwill of the Complainant's well-known trademark (see: *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#) (which held that the domain name in question was "so obviously connected with the Complainant and its products that its very use by someone with no connection with the Complainant suggests opportunistic bad faith"))).

The diversion of Internet users is also a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP decisions (see *L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unasi, Inc.*, WIPO Case No. [D2005-0623](#); *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) and *Hoffmann-La Roche Inc. v. Samuel Teodorek*, WIPO Case No. [D2007-1814](#)).

Further, a gap of several years between registration of a complainant's trademark and respondent's registration of a disputed domain name (containing the trademark) can indicate bad faith registration (see *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Respondent registered the Disputed Domain Name at least 16 years after the Complainant established trademark rights in the FIDELITY mark.

On the issue of use, the evidence is that the Disputed Domain Name resolves to a crypto-trading webpage unconnected with any *bona fide* supply of goods or services by the Respondent. In the absence of any evidence to the contrary, this Panel finds that the Respondent has taken the Complainant's trademark FIDELITY and incorporated it in the Disputed Domain Name without the Complainant's consent or authorization, for the very purpose of capitalizing on the reputation of the trademark by diverting Internet users to a crypto trading webpage for commercial gain.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

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 <fidelityfinance.io> be transferred to the Complainant.

/Nicholas Weston/
Nicholas Weston
Sole Panelist
Date: May 27, 2022