

## **.nz Dispute Resolution Service**

**DRS Reference: 443**

### **Insure & Go Insurance Services Limited v 1 cover NZ Limited**

Key words – Domain Name – insureandgo.co.nz (“the Domain Name) – identical or similar trade mark or name – registered mark – unregistered mark – mark principally known overseas – whether descriptive – unfair use – likely to confuse, mislead or deceive - Respondent having no connection with name or trade mark – evidence occurring more than 3 years before date of complaint not able to be considered - transfer

#### **1. Parties**

Complainant:

Insure & Go Insurance Services Limited  
Mr Adam Taylor  
10th Floor, Maitland House, Warrior Square  
Southend on Sea  
Essex  
United Kingdom

Respondent:

1 Cover NZ Limited  
c/o Bendall and Cant Limited  
7th Floor, Southern Cross Building Cnr High & Vict  
Auckland  
New Zealand

#### **2. Domain Name/s**

insureandgo.co.nz ("the Domain Name")

#### **3. Procedural history**

- 3.1 The Complaint was lodged on 6/10/2009 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 9/10/2009. The domain was locked on 7/10/2009, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 The Respondent filed a Response to the Complaint on 2/11/2009 and the DNC so informed the Complainant on 2/11/2009. The Complainant filed a Reply to the Response on 11/11/2009. The DNC informed the parties on 2/12/2009 that informal mediation had failed to achieve a resolution to the dispute.


- 3.3 The Complainant paid Domain Name Commission Limited the appropriate fee on 15/12/2009 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

#### **4. Factual background**

##### *The Complainant*

- 4.1 The Complainant is Insure & Go Insurance Services Limited, a company incorporated in the UK on 21 August 2000. The Complainant operates a travel insurance business via a website at “*www.insureandgo.com*” and is the successor in title to a partnership of its shareholders that commenced the business in 1999.
- 4.2 As at December 2002, the Complainant had gross insurance premiums of £5 million increasing to £11 million in December 2003 and £21 million in December 2004. By December 2006 gross premiums were £49 million and £43 million by December 2007. In the 2004 calendar year, the Complainant sold 550,855 new insurance policies and estimates that as at December 2004 it had insured around 1 million people. In the 2008 calendar year new insurance policies sold by the Complainant were 809,299 with the number of insured being substantially more than that.
- 4.3 The Complainant spent some £2.25 million in 2004 on marketing and promotion. In 2005 the figure increased to £2.5 million and by 2008 the figure was over £5.75 million. In 2004, the Complainant ran a national television campaign, a radio campaign on Kiss, LBC and Magic 105.4, three popular UK radio stations. Also in 2004, there was substantial marketing on outdoor posters, on underground and bus networks in the UK. Its online marketing costs that year were (£874,589). The Complainant has produced examples of substantial press advertising which it undertook for its INSUREANDGO trade mark in the UK national newspapers during 2004. These included The Daily Express, The Daily Telegraph, The Evening Standard, The Sunday Times, The Mail on Sunday and The Daily Mail. In addition, consumer travel articles about the Complainant’s travel insurance policies and referring to its trade mark INSUREANDGO were written in 2004 in The Mail on Sunday, The Independent on Sunday, The Guardian, The Daily Telegraph and The Insurance Times.
- 4.4 At The Insurance Times Awards in 2004 in the UK the Complainant won highly commended for Advertising Campaign of the Year, was winner of the Large Broker of the Year category and also received highly commended for its Broker/Intermediary Marketing Campaign of the Year.
- 4.5 The Complainant has trade mark registrations in the UK, EU, Australia and New Zealand for marks comprising and including INSUREANDGO. The earliest Community Trade Mark dates from December 2001. The

others are registered with effect from 2005 and 2006. In New Zealand, the Complainant has two trade mark registrations as follows:

Mark	No.	Application Date	Class	Specification
	745990	6/4/06	36	Insurance services; home insurance; travel and holiday insurance; life insurance; vehicle insurance; vehicle breakdown insurance; insurance for buildings and contents; commercial insurance; pet insurance; computer insurance
INSUREANDGO	745991	6/4/06	36	Insurance services; home insurance; travel and holiday insurance; life insurance; vehicle insurance; vehicle breakdown insurance; insurance for buildings and contents; commercial insurance; pet insurance; computer insurance

- 4.6 Amongst the copies of advertising produced by the Complainant for the period prior to December 2004 were advertisements in the UK for travel insurance to UK travellers covering travel to both Australia and New Zealand.

*Respondent*

- 4.7 The Respondent is a company incorporated in New Zealand on 14 December 2004, the day before it registered the domain name on 15 December 2004. The directors and shareholders are Benjamin Gower and Peter Storey both of London. The Respondent has not provided any details about itself. However, the Complainant has produced evidence showing that the shareholders and directors of the Respondent were also directors and shareholders of the following associated companies:

Country	Name	Directors	Shareholders
UK	1Cover Limited	Benjamin Gower	B Gower
		Peter Storey	Benjamin Gower
			P Storey
			Peter Storey
	Kiss Technology Limited	Benjamin Gower	Benjamin Gower
		Peter Storey	Peter Storey
Australia	1Cover Holdings Limited	Benjamin Gower	Not-For Profit Company

		Peter Storey	
	CoverDirect Pty Limited	Benjamin Gower	1Cover Holdings Ltd
		Peter Storey	
	1Cover Pty Limited	Benjamin Gower	1Cover Holdings Ltd
		Peter Storey	
	Kisstral Holdings Pty Limited		Benjamin Gower
		Peter Storey	Peter Storey
NZ	1 Cover NZ Limited	Benjamin Gower	Benjamin Gower
		Peter Storey	Peter Storey

4.8 One of the UK Companies House annual returns produced by the Complainant for 1 Cover Limited, an associated UK registered company, self-describes Messrs Gower and Storey as IT consultants.

4.9 The Complainant has also provided evidence that this associated UK company 1 Cover Limited previously operated a website at [www.1cover.co.uk](http://www.1cover.co.uk). Screenshots taken from this website on 30 January 2006 state:

**“1 Cover**

1 Cover Ltd is a UK (Central London) based travel insurance company offering excellent online policies at highly competitive prices. We have many years of experience in providing low cost travel insurance to residents of the UK, and cover many thousands of people every year ensuring that they can enjoy their travels without worry of any problems. ....

1 Cover also provides travel insurance in other countries including **Australia**. If you would like to see our other websites, please visit our group website at [www.1cover.com](http://www.1cover.com). ....

**Travel insurance from 1cover.co.uk**

Unfortunately we are currently unable to issue new policies however we will have a new policy available soon. Please note if you have a policy with our Australian or New Zealand companies, you will need to contact them directly for inquiries as we are unable to help with those policies from the UK – see [www.1cover.com.au](http://www.1cover.com.au) or [www.1cover.co.nz](http://www.1cover.co.nz).

1 Cover provides cheap, instant, online travel insurance to customers in the UK and across the world.”

4.10 A screenshot from the website [www.1cover.com.au](http://www.1cover.com.au) dated 30 January 2006 and produced by the Complainant contained a note “Are you in Australia? If not, please click the relevant flag below to go to your local 1 Cover website”. Then there appeared “UK” with the Union Jack flag and “NZ” with the New Zealand flag – enabling web browsers to click on those, presumably to be taken to the local 1 Cover website in the

UK or New Zealand. i.e. "1cover.com.au" (as referred to in the website extract above).

- 4.11 The Complaint states that as at 15 January 2009, the Respondent used the Domain Name for a directory of sponsored links to (mainly UK) travel insurance websites competing with the Complainant. But one of the listed sites was in fact the Complainant's own website *www.insureandgo.com*. The Domain Name was described in its own meta tags (produced as part of the Complaint) as at that date as a "parked domain".
- 4.12 On 21 January 2009, the Complainant's solicitors sent a cease and desist letter to the Respondent seeking transfer of the domain name. The letter noted that the Complainant had just succeeded with a complaint under the .au Domain Name Dispute Resolution Policy in respect of the separate domain name *www.insureandgo.com.au*. A WIPO Panellist had held that the Domain Name was a bad faith registration. That domain name was held by an associated company CoverDirect Pty Limited and the domain name in issue there had been transferred to the Complainant.
- 4.13 No response was received to the cease and desist letter. The Complainant subsequently filed this Complaint.

## **5. Parties' contentions**

- 5.1 A brief summary of the parties' contentions is as follows:

### **a. Complainant**

- 5.2 As to *Rights*, the Complainant relies on its two New Zealand trade mark registrations for INSUREANDGO and also other registered trade marks in other countries. It notes that under the Policy, "Rights" are not limited to rights enforceable under New Zealand law. It also relies on common law rights as a result of its extensive trading and marketing.
- 5.3 The Complainant says that the Domain Name is identical to the Complainant's trade marks.
- 5.4 As to *Unfair Registration*, the Complainant says it has no association with the Respondent and has not authorised or licensed the Respondent to use its trade mark (Policy Para 5.1).
- 5.5 *Blocking* – Policy, para 5.1.1(b). The Complainant asserts that the Respondent intended to prevent the Complainant from reflecting its trade mark in the Domain.
- 5.6 *Disruption* - Policy, para 5.1.1(c). The Complainant asserts that the Respondent registered the Domain for the purpose of unfairly

disrupting the business of the Complainant by diverting business intended for the Complainant.

- 5.7 *Confusion* – Policy, para 5.1.2. 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.
- 5.8 *Pattern* – Policy, para 5.1.3. The Respondent is part of a group of companies, including Cover Direct Pty Limited which has been found to have acted in bad faith in relation to the Domain Name "www.insureandgo.com.au". The Respondent also owns or owned other domain names reflecting well-known trade marks namely "www.gosure.com.au" and "www.gosure.co.nz".
- 5.9 *Other Factors*. The Respondent has not responded to the assertions of unfair registration.

**b. Respondent**

- 5.10 The Respondent asserts as follows:
- 5.11 INSUREANDGO is wholly descriptive.
- 5.12 The Domain Name was registered on 15 December 2004 but the Complainant's New Zealand trade marks were filed on 6 April 2006, almost 16 months after the Domain Name was registered.
- 5.13 The Complainant has not established any common law rights in New Zealand.
- 5.14 By reason of its registration of the Domain Name almost 16 months before the Complainant sought registration of its New Zealand trade marks, the Respondent has common law rights of its own that are superior to any rights of the Complainant.
- 5.15 The Respondent accepts that the Domain Name is similar to the Complainant's New Zealand trade mark registrations but says that due to the descriptive nature of the name INSUREANDGO, the use being made of the Domain Name is not misleading or confusing.
- 5.16 As to unfair registration, there is no substantiation of the Complainant's reputation or goodwill in New Zealand.
- 5.17 No evidence has been lodged to support assertions as to the intention of the Respondent and the Respondent denies those assertions:

"The Domain Name was registered by the Respondent to describe the services that it provides. Furthermore the Domain Name was registered prior to the

Complainant applying to register its New Zealand trade marks. The Complainant fails to explain how the Respondent could have the intentions asserted at the time of registering the Domain Name in circumstances where the complainant had no rights to the name at that time.”

5.18 As to assertions as to the Respondent’s state of mind, the Respondent says that the Complainant could have no knowledge of this. The Respondent:

“...denies the assertion that the use of the Domain Name is intended to create a likelihood of confusion or that its motive was to attract the Complainant’s business. No evidence of such intention is provided by the Complainant and the assertions are denied by the Respondent. The Domain Name describes the services provided by the Respondent and the Domain Name was registered by the Respondent for this purpose. Furthermore, the Complainant has no business presence in New Zealand. As it is not possible to attract business that does not exist, the claim is without merit.”

5.19 The Respondent relies on factors that show that the Domain Name is not an Unfair Registration. It says that the Domain Name has been used since January 2009 “in connection with a genuine offering of services (para 6.1.1 of the Policy)”. The Complaint is dated 30 September 2009 and the Domain Name had been used by the Respondent for a period of nine months prior to the Complaint. Further the Domain Name was registered almost five years before the Complaint was lodged.

5.20 The Domain Name describes the services provided by the Respondent (para 6.1.2 of the Policy).

5.21 The Domain suffix *.co.nz* is designed to indicate a reference to business in New Zealand. The Complainant has provided information detailing its reputation in the UK but no information is provided that indicates that New Zealand consumers would be aware of the Complainant or that consumers would be misled into thinking that there is any affiliation or association between the Respondent and the Complainant.

5.22 The Domain Name was not registered by the Respondent in bad faith or for the purposes suggested by the Complainant.

5.23 The Respondent does not and has never had any intention to interfere with the operations of the Complainant. The Domain Name has been used by the Respondent for some time and the Respondent’s business activity in New Zealand will be interrupted and detrimentally affected if it is forced to stop using the Domain Name.

**c. Reply**

5.24 The Complainant subsequently filed a Reply. The key assertions in the Reply were as follows.

- 5.25 As to *Rights*: INSUREANDGO is not wholly descriptive in that a customer seeking travel insurance would not look specifically for the category INSUREANDGO in a business directory or yellow pages. Further, the fact that registered trade marks were obtained in New Zealand shows that the marks are not wholly descriptive.
- 5.26 The fact that the Respondent registered the Domain Name prior to registration of the Complainant's New Zealand trade marks is irrelevant as Rights must be established as at the date of the Complaint.
- 5.27 In any event the Complainant is entitled to rely on common law rights (which long predate the registration of the Domain Name) irrespective of where they were located. The Policy states that Rights "includes, but is not limited to, rights enforceable under New Zealand law".
- 5.28 The Complainant "fails to see the relevance to Rights of the question as to whether New Zealand consumers have been deceived".
- 5.29 As to *Unfair Registration*, it is said that the Respondent misleadingly states that the Complainant relies on the assertion that it has acquired substantial reputation and goodwill in the name INSUREANDGO in relation to Unfair Registration. However this statement was made in relation to Rights.
- 5.30 The Complainant rejects the Respondent's claims that it was not possible for the Complainant to know the Respondent's intentions. It asserts that the DRS would be unworkable if the Complainant or Expert were not entitled to draw inferences of a Respondent's intentions from relevant facts and here the evidence of *mala fides* is overwhelming
- 5.31 The Respondent was clearly aware of the Complainant's business when it registered the domain name and this is not denied. The Complainant relies on findings of bad faith in the Australian WIPO case in respect of "*www.insureandgo.com.au*" against Cover Direct Pty Limited, a company owned by the owners of the Respondent.
- 5.32 In these circumstances, the Complainant asserts that it was disingenuous for the Respondent to claim that it could not have intentions ascribed to it because the New Zealand trade marks were not registered until after the Domain Name.
- 5.33 The Respondent's claim that it registered the Domain Name to describe the services it provides is implausible.
- 5.34 The Respondent did not expressly deny receiving the cease and desist letter of 21 January 2009 and it is not clear therefore why the Respondent claims it had not had an opportunity to deny assertions of Unfair Registration.

- 5.35 As to the claim that “since January 2009” the Respondent had been using the Domain to offer insurance services, as at 15 January 2009, the Respondent was still using the Domain for a directory of sponsored links. The Complainant sent its cease and letter on 21 January 2009. This suggests that the change of use to a site offering insurance services was motivated by the cease and desist letter.
- 5.36 Para 6.1.1 of the Policy does not apply as the offering of goods and services was not “genuine” for the reasons stated.
- 5.37 Para 6.1.2 of the Policy does not apply as the Domain is neither generic nor descriptive and the Respondent’s use of it was and is unfair.
- 5.38 The Respondent’s suggestion that the suffix .co.nz is intended to indicate a reference to business in New Zealand but yet the Respondent does not deny that the site and the Domain primarily contain links to UK sites and so the Respondent was clearly using it to target the UK.

## 6. Discussion and findings

- 6.1 In order to succeed with a Complaint, the Complainant must prove to the Expert “on the balance of probabilities” (para 4.2) that:

“4.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

4.1.2 The Domain Name, in the hands of the Respondent is an Unfair Registration.”

### (1) *Rights*

- 6.2 The Policy defines Rights in an inclusive not exclusive way:

“**Rights** includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant’s business”

- 6.3 An immediate threshold issue raised by the Respondent is its contention that the term INSUREANDGO is wholly descriptive of the Complainant’s business and therefore cannot be relied on to sustain the Complaint.
- 6.4 In *Equity Access Pty Limited v Westpac Banking Corporation* (1989) 16 IPR 431, 448, Hill J in the Federal Court of Australia provided a helpful commentary on the continuum of marks that exists – with purely descriptive marks at one end and fancy names at the other end. (This commentary has previously been considered and applied by a DRS Expert in DRS 108 *BOP Memorials v Jones & Company Funeral Services*). Hill J stated:

“Just as the distinction between descriptive and fancy names is not a distinction of law so too it is wrong to see the distinction in black and white terms. The reality is that there is a continuum with at the extremes purely descriptive names at the one end, completely invented names at the other and in between names that contain ordinary English words that are in some way or other at least partly descriptive. The further along the continuum towards the fancy name one goes, the easier it will be for a plaintiff to establish that the words used are descriptive [i.e. distinctive] of the plaintiff’s business. The closer along the continuum one moves towards a merely descriptive name, the more a plaintiff will need to show that the name has obtained a secondary meaning, equating it with the products of the plaintiff (if the name admits of this – a purely descriptive name probably will not) and the easier it will be to see a small difference in names as adequate to avoid confusion.”

- 6.5 The test for determining “whether the words were merely or purely descriptive” was “whether the words were applicable to any business of the like kind” (ibid at 446).
- 6.6 Applying this test, the Expert finds that the term INSUREANDGO is not wholly descriptive. The mark comprises a clever allusion to the steps of insuring and then going on holiday. But it equally carries other allusions of insuring and then the insured getting on with other activities *or* insuring quickly and efficiently, such as can often be achieved by completing and paying for a policy online. Where (as here) more than one allusion can be taken from a mark, the less likely it is to be wholly descriptive.
- 6.7 In no sense can the mark be said to be wholly descriptive of travel insurance services or travel insurance services available online nor is it “equally applicable to any business of like kind”. The Expert also agrees with the Complainant’s counsel that confirmation of this conclusion can be drawn from the fact that IPONZ would not have allowed the word mark INSUREANDGO to have been registered in class 36 for (inter alia) “travel and holiday insurance” if it were wholly descriptive.
- 6.8 Returning then to the definition of Rights, the Respondent contends that the Complainant had no rights because its trade mark registrations in New Zealand were filed 16 months after registration of the Domain Name. Further, it says that the Complainant has not established any common law rights to the mark in New Zealand. Rather the only material relied on by the Complainant is the evidence of use of the name or mark in the UK and there is no evidence to suggest that New Zealand consumers are aware of the Complainant.
- 6.9 The Appeal Panel in DRS 334 (*The Country Channel Limited*) noted that the definition of Rights in the Policy is an inclusive one designed to give wide scope to the type of Rights that might conceivably be relied on by a Complainant. The Panel noted that it is not an absolute pre-

requisite that right are enforceable under New Zealand law. It noted too that the definition of Unfair Registration contains two limbs as follows:

“means a Domain Name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- (ii) has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”

6.10 The Appeal Panel stated that where the Domain Name was being attacked under limb (i), then the Rights must have existed as at the date of registration or acquisition. The Appeal Panel noted:

“This definition makes it clear that where, as here, the Domain Name is attacked under limb (i) (i.e. as having been registered or acquired in a manner that took unfair advantage of or was unfairly detrimental to the Complainant's Rights), the Rights must have existed *as at the date of registration or acquisition*. The definition as a whole also presupposes pre-existing rights of some nature in order for unfair advantage or unfair detriment to arise through the acts of registration or acquisition (limb (i)) or use or likely use (limb (ii)). In most cases, a Complainant will need to demonstrate that the Rights exist and are enforceable *in New Zealand* in order to demonstrate such unfair registration.”

6.11 It is notable that the Appeal Panel applied the careful condition “in most cases”. This was to allow for the fact that the definition of Rights clearly and specifically allows reliance on Rights other than those that are enforceable in New Zealand. Further and importantly, it is to be noted the second requirement of the Policy in 4.1.2 is that:

“The Domain Name *in the hands of the Respondent*, is an Unfair Registration.”

6.12 This specifically recognises that there can be circumstances specific to the Respondent which makes registration of the Domain Name in issue unfair and where Rights not necessarily enforceable under New Zealand law can be relied on.

6.13 It is clear from the Reply, that the Complainant makes two separate assertions. First, it is entitled to rely on registered trade mark rights in New Zealand, even though they are registered with effect from a date after the Domain Name is registered because all that is required is that the Rights must be established as at the date of the Complaint.

6.14 Secondly and in any event, the Complainant says it is entitled to rely on common law rights which predate the registration of the Domain Name irrespective of where those common law rights are located. Those common law rights relied on are principally in the UK (although the WIPO Australian decision also relied on by the Complainant records

that the Complainant also established some Australian rights in 2003). This is coupled with the later assertions in relation to Unfair Registration that the Respondent was clearly aware of the Complainant's business when it registered the Domain Name.

6.15 The Expert finds as follows in relation to the Rights relied on:

(a) *Registered trade marks*

6.16 Plainly the Complainant does have two registered trade marks in New Zealand for the word mark and a logo in respect of inter alia travel insurance. These rights took effect from 6 April 2006. The Complainant also had a Community Trade Mark for INSUREANDGO logo mark with effect from 24 December 2001.

(b) *Common law rights*

6.17 The Complainant has clearly shown that in the UK as at December 2004 it had achieved a substantial common law reputation and awareness of its mark INSUREANDGO. This was as a result of the ongoing use and promotion of its website "*www.insureandgo.com*" from 1999 as well as the major publicity undertaken in the UK during the course of 2004 and noted earlier.

6.18 In relation to New Zealand, the only evidence of that reputation extending to New Zealand is that cover was offered in 2001 and 2003-4 to travellers travelling to both Australia and New Zealand.

6.19 By 2008, these common law rights to INSUREANDGO in the UK had become well established. At that point, the Complainant was in its 10<sup>th</sup> year of trading in the UK offering travel insurance.

6.20 Both of these different Rights plainly do qualify as Rights under the definition in the Policy. As the Complainant correctly notes in respect of the common law rights, the Policy does not require that the Rights be enforceable under the New Zealand law for them to be relied on.

6.21 The key issue is whether these Rights are sufficient to sustain the complaints of Unfair Registration and this is dealt with shortly.

(2) *Rights identical or similar to the Domain Name*

6.22 The Complainant's common law rights and the registered word mark are identical to the Domain Name. The registered logo marks are similar to the Domain Name.

(3) *Unfair Registration*

6.23 The various grounds of complaint fall into two categories:

- (a) Those that fall within limb (i) of the definition of Unfair Registration and relate to the actual registration of the Domain Name;
- (b) Those that fall within limb (ii) and relate to use of the Domain Name.

6.24 In relation to the grounds, neither party has mentioned or referred to paragraph 5.4 of the Policy which provides that in making a decision, the Expert “shall not take into account any evidence of acts or omissions amounting to Unfair Registration or use which occurred more than three (3) years before the date of the Complaint”.

6.25 This therefore rules out any consideration of the registration of the Domain Name in the first place as this took place on 15 December 2004 almost five years before the Complaint.

6.26 Had para 5.4 of the Policy not been in place, the Expert would have found that the Domain Name had been registered primarily as a blocking registration or for the purposes of unfairly disrupting the business of the Complainant under paras 5.1.1(b) and (c) of the Policy.

6.27 However, as a result of para 5.4, the only grounds of complaint as to Unfair Registration that can be considered are those relating to use of the Domain Name - all of which occurred within the period less than a year before the Complaint. Notably the Complainant has relied on paragraph 5.1.2 of the Policy relating to use of the Domain Name – recognising of course that the grounds listed in paragraph 5 of the Policy are non-exhaustive.

6.28 Para 5.1.2 of the Policy states:

*“Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.”*

6.29 The Complaint is that the website operating at the Domain Name is a scheme 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.

6.30 The Complaint states that the Respondent had the Complainant and its business in mind when registering and *using* the Domain Name. Inter alia it says that the Respondent’s group operates in the UK on-line travel insurance market. Its controllers are British IT consultants who live (or lived) in the UK and so it is inconceivable that they were unaware of the existence of one of their major competitors. The Complainant further says:

- The website and the domain included a number of links to UK insurance sites as well as the Complainant's own site; and
- Following the Complainant's cease and desist communication, the Respondent did not permanently cease use of the Domain Name but instead switched it from a parking page to a travel insurance website diverting traffic to its own site.

Finally, the Complainant states:

"The use of the domain comprising the Complainant's trade mark is intended to create a likelihood of confusion in the minds of the public as to an association between the Respondent and the Complainant. The name of the Domain appears prominently on the top of the homepage and in the meta title – meta description adding to confusion of Internet users"

- 6.31 As noted earlier, the Respondent denies this assertion and claims that the Domain Name describes the services provided by the Respondent and that the Domain Name was registered by the Respondent for this purpose. Furthermore, it says that the Complainant has no business presence in New Zealand. As it is not possible to attract business that does not exist it is said that the claim is without merit.
- 6.32 The Expert finds that for the following reasons taken together, the Complainant has shown that the Domain in the hands of the Respondent is an Unfair Registration (para 4.1.2 of the Policy) because it "has been used ... in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights" (limb (ii)):
- (a) As found earlier, the Complainant had achieved a substantial common law reputation in the mark INSUREANDGO in the UK as at December 2004 when the Domain Name was registered in New Zealand. It already had a CTM registration for INSUREANDGO logo at that date. By the end of 2008, the common law reputation was more extensive as a result of some 10 years trading as an online travel insurance business;
  - (b) The Complainant also has two New Zealand registered trade marks for INSUREANDGO in class 36 covering insurance services including travel insurance. These were registered after the New Zealand Domain Name. The Respondent was put on notice of these registered trade marks when the Complaint was served. Although the Respondent has claimed that it is a prior owner of rights in the name by virtue of its registration of the Domain Name, it has not taken any steps to challenge the registered trade marks or to seek a declaration of invalidity;
  - (c) The Respondent's shareholders and directors, Messrs Gower and Storey are both UK residents and were the parties responsible for:

- (i) the incorporation in Australia of Cover Direct Pty Limited and 1 Cover Pty Limited on 18 August 2003;
  - (ii) the incorporation of 1 Cover Limited in the UK on 8 March 2004;
  - (iii) the incorporation of the Respondent (1 Cover NZ Limited) on 14 December 2004.
- (d) At the time of the registration, the Respondent and in particular its UK resident directors and shareholders would have been well aware of the Complainant and its common law rights in the UK in the INSUREANDGO mark as a result of the extensive use over a period of five years and the extensive marketing described earlier. The Expert notes the specific wording in the Policy (para. 4.1.2) that the Domain Name "*in the hands of the Respondent*" is an Unfair Registration. By January 2009, the Respondent through its directors and shareholders would have been well aware of the Complainant;
- (e) The assertion made by the Respondent's solicitors in the Response is that "the Domain Name was registered by the Respondent "*to describe the services it provides*". But this does not square with the actions of the Respondent and its shareholders and directors. The name chosen for the Respondent and all associated companies in Australia and the UK was "1 Cover" with "CoverDirect" also being used in Australia. If the Domain Name were chosen to describe the services it provides, it is somewhat surprising that the Respondent were not also incorporated as Insure and Go NZ Limited, the same name as the Domain Name it registered. Significantly, it did not choose that name.
- (f) Further the trade mark INSUREANDGO is not a descriptive term and has readily achieved trade mark registration in Europe, the UK, Australia and New Zealand. The mark does not automatically suggest itself for use for travel insurance and indeed no evidence was put forward by the Respondent to show any descriptive use of any other party or by the Respondent or its associated companies other than in the registration of the Domain Name. (The Expert notes the findings of a WIPO Panelist under the auDRP that registration by Cover Direct Pty Limited of "*insureandgo.com.au*" was intended to disrupt the expansion of the Complainant's business.)
- (g) It is also significant that after registration of the Domain Name the Respondent did not use the Domain Name insureandgo.co.nz but rather 1cover.co.nz. This is clearly shown in the extract from the website referred to earlier at para. 4.9 of this decision which states "*Please note if you have a*

*policy with our Australian or New Zealand companies, you will need to contact them directly for inquiries as we are unable to help with these policies from the UK – see [www.1cover.com.au](http://www.1cover.com.au) or [www.1cover.co.nz](http://www.1cover.co.nz).”*

- (h) The Domain Name was registered in December 2004 but appears to have been parked. No evidence has been produced as to what use was made of the site prior to January 2009 nor has the Respondent given any evidence to clarify this issue. The first evidence of the site is on 15 January 2009 which shows use of the Domain as a comparison site with links to various UK travel insurance websites competing with the Complainant. There was also a listing for the Complainant;
- (i) At the time of *this use*, the Expert has found that the Complainant already had a substantial reputation in the mark for INSUREANDGO in the UK as a result of its promotion and use over 10 years of trading. Further it has produced evidence showing that it offers travel insurance coverage to travellers to Australia and New Zealand. Members of the public in the UK and elsewhere who know of the Complainant and INSUREANDGO and who do a search engine search to find its website will encounter the Domain Name amongst the results. They are likely to think, if intending to travel to New Zealand, that the Domain Name is a site connected with or operated by the Complainant that offers New Zealand-specific travel insurance. Clicking on the website as at 15 January 2009 produced links to other competitor travel insurance sites that were not the Complainant – although one of the sites listed was the Complainant. Website browsers in the UK (and elsewhere) familiar with the Complainant and clicking on the Domain Name would initially be confused into thinking that this was operated by the Complainant. The fact that these linked sites were almost all UK sites indicates that the Respondent was seeking to tap into Internet users in the UK;
- (j) In late January 2009, the Respondent suddenly began to use the website for providing quotations and for selling travel insurance. Not only did this use the Domain Name but also prominently on the website was a logo mark comprising a globe and the words INSURE AND GO. The insurance quotations provided however were “1 Cover Comprehensive” and “1 Cover Frequent Traveller” policies. The Respondent has provided evidence showing that sales of policies were made from the site (as part of its claim that this was genuine use);
- (k) The Expert agrees with the Complainant in its Reply that the Respondent has not denied receipt of the cease and desist letter sent on 21 January 2009 and that the sudden change of use of the site in late January 2009 to a site providing insurance

services appears to have been motivated by the cease and desist letter. The Respondent had owned the Domain Name for four years prior to that date without any active use. The timing of the change in use to actively soliciting travel insurance policies is unlikely to have been coincidental.

- (l) This active use of the Domain Name from 29 January 2009 onwards prominently used the INSUREANDGO trade mark. The Expert finds that this new and active use of the Domain Name from late January 2009 was also use that was an Unfair Registration. Members of the public in the UK and elsewhere who were familiar with the Complainant and sought to find its website on a search engine search and encountered the domain name would, when clicking on the Domain Name, very likely believe the site to be operated by or connected with the Complainant. This is because of prominent use of the INSUREANDGO mark.
- (m) The fact that the Domain Name has a *.co.nz* suffix does not mean that the Domain Name itself will be visited solely by New Zealand residents. The Internet is a global network and users, assisted by search engines, have for a number of years been increasingly savvy in visiting websites that are country specific – particularly when looking for information that is specific to that country. The fact that the Domain Name is offering online travel insurance itself predicates a potential audience that is not solely New Zealand-based but will include persons who wish to travel to New Zealand. No doubt this was one of the reasons why the Policy does not require that Rights be confined solely to those that are enforceable in New Zealand. It is why, in this case, the Complainant is able to sustain the Complaint by relying on common law rights that are predominantly but not wholly existing in the UK.
- (n) Although the Complainant has not raised this point, the prominent use of INSUREANDGO on the homepage would also constitute infringement of the Complainant's New Zealand registered trade mark. The new use arising as from 29 January 2009 would not sustain any defence of prior continuous use. Insofar as the site appears to be directed to travellers based in the UK, it would very likely also be infringement of the UK and CTM registrations. However these findings are not necessary for the Expert to reach a decision;
- (o) In all the circumstances, the Expert finds that the Domain Name is an Unfair Registration in the hands of the Respondent.

(4) *Not an Unfair Registration*

- 6.33 It is, however, necessary to go on and deal with the Respondent's reliance in respect of all of the grounds of the Complaint that it is not an Unfair Registration. The Respondent says that it has used the Domain Name "since January 2009" in connection with the genuine offering of services thus relying on para 6.1.1 of the Policy. It has supplied in the body of the Response (without any supporting documentation) revenue figures generated by the Domain Name for the period March 2009 – September 2009. This totals \$7,088.48. The Respondent says that this was nine months prior to the Complaint on 30 September 2009.
- 6.34 The Complainant challenges this on the basis that such use arose after the cease and desist letter sent to the Respondent's contact email address listed in the Respondent's Details. Further it says that the use was not "genuine".
- 6.35 The Expert finds that the Respondent has not established the grounds in paragraph 6.1.1 of the Policy to show that the Domain Name is not an Unfair Registration. The Domain Name was registered on 15 December 2004. The sudden change in use of the Domain Name in January 2009 appears to have occurred after the cease and desist letter had been sent by the Complainant's solicitors. The Respondent does not expressly deny receiving the cease and desist letter and in its Response simply refers generally to use "since January 2009". Sales figures provided show no sales in January or February with the first sales occurring in March. The figures show minute sales totalling just \$7,088 over 7 months. The Expert is satisfied that this was not a genuine offering.
- 6.36 The Respondent also relies on paragraph 6.1.2 of the Policy namely that the Domain Name is "generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character".
- 6.37 The Expert has already found that the Domain Name is not wholly descriptive for the purposes of Rights. The Expert further finds that the Domain Name is not generic or descriptive and that the Respondent is not making fair use of it in a way which is consistent with its generic or descriptive character. No evidence has been advanced to show any earlier use of INSUREANDGO as a descriptive term by either the Respondent or any other third party. The fact that trade mark registrations have been obtained in the EU, UK, Australia and New Zealand for INSUREANDGO is further clear indication that the Domain Name is not generic or descriptive.

**7. Decision**

- 7.1 For the foregoing reasons the Expert finds that the Complainant has Rights in the name INSUREANDGO and that the name or mark is

similar to the Domain Name. The Expert further finds that the Domain Name in the hands of the Respondent is an Unfair Registration.

7.2 Pursuant to paragraph 13 of the Policy, the Expert directs that the Domain Name be transferred to the Complainant.

**Place of decision**

**Date** 25 January 2010

**Expert Name** Mr Andrew Brown QC

**Signature**