

# Nominet UK Dispute Resolution Service

**DRS 03733**

## **Mercer Human Resource Consulting Inc v IMO International Limited**

### **Decision of Independent Expert**

#### **1. Parties**

Complainant: Mercer Human Resource Consulting Inc  
Address: 1166 Avenue of the Americas  
New York

Postcode: 10036  
Country: US

Respondent: IMO International Limited  
Address: 2<sup>nd</sup> Floor  
145-157 St John Street  
London

Postcode: EC1V 4PY  
Country: GB

#### **2. Domain Name**

mercer.co.uk

#### **3. Procedural Background**

The Complaint was lodged with Nominet on 13 June 2006. Nominet validated the Complaint and notified the Respondent of the Complaint on 13 June 2006 and informed the Respondent that it had until 5 July 2006 to lodge a Response. A Response was received from the Respondent on 29 June 2006. Nominet forwarded the Response to the Complainant's representatives on 29 June 2006 and informed them that they had until 10 July 2006 to file a Reply. A Reply was received on 10 July 2006 and, on 12 July 2006, Nominet informed the parties that the next stage in the Dispute Resolution Service was Informal Mediation. Nominet wrote to the parties on 1 August 2006 informing them that it had not been possible to achieve a resolution of the Complaint by Informal Mediation and invited the Complainant to pay the fee to obtain an Expert Decision by 15 August 2006. On 14 August 2006 the Complainant paid Nominet the appropriate fee for a decision of an Expert pursuant to paragraph 7 of the Nominet UK Dispute Resolution Service Policy ("the Policy").

On 16 August 2006 the undersigned David King ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as Expert in this case and further confirmed that he knew of no matters which ought to be brought to the attention of the parties which might appear to call into question his independence and/or impartiality. Nominet appointed the Expert in this matter on 21 August 2006.

#### **4. Outstanding Formal/Procedural Issues (if any)**

The Expert is not aware of any outstanding formal or procedural issues.

## **5. The Facts**

The Complainant and its associated company, Mercer Human Resource Consulting Limited ("Mercer-UK"), offer a full range of employee benefits, actuarial, compensation, communication, personal financial counselling and other key human resources consulting services in the UK, Europe, the United States, Canada and elsewhere around the world.

Mercer-UK was incorporated in England and Wales on 10 July 1970 under company number 00984275. The company was first registered in the name of William M Mercer – MPA (U.K.) Limited and, following changes of name to William Mercer Fraser Limited in 1986 and to William Mercer Limited in 1993, the name of the company was changed to Mercer Human Resource Consulting Limited on 5 April 2002.

Mercer-UK is the owner of UK Trade Mark Number 2352832, registered on 7 January 2004, and Community Trade Mark Number 004803251, filed on 9 February 2005, for the mark MERCER. Both Trade Marks are for classes 9,35, 36, 38, 41, 42 and 44.

The Complainant is the owner of US Service Marks for MERCER under Numbers 2902605 registered on 16 November 2004, 2907461 registered on 7 December 2004 and 2945426 registered on 3 May 2005. The Complainant is also the owner of the US Service Mark for MERCER BENEFITSUITE under number 3060178 registered on 21 February 2006. A stylised version of the Service Mark MERCER was registered in the US in the name of William M. Mercer Incorporated on 22 October 2002.

The Complainant is the registrant of the domain names mercer.com, which was registered on 7 January 1992 and mercerhr.com, which was registered on 3 April 2000.

On 1 November 2004, the Domain Name was registered in the name of the Respondent.

A print-out of the Domain Name as at 25 May 2006 comprises a Domain Name Purchase Enquiry Form, in which anyone interested in purchasing the Domain Name is invited to make an offer to purchase it for a minimum of £500, 730 euros, \$920 or equivalent. A print-out as at 5 July 2006 comprises a Domain Name Purchase Enquiry Form inviting offers to purchase the Domain Name for a minimum of £995, 1450 euros, \$1830 or equivalent.

## **6. The Parties' Contentions**

### Complainant

The Complainant has complained as follows:

The Domain Name is identical to the Complainants' distinctive and well-known trademark MERCER, which has been used extensively and exclusively in the U.K. for approximately 30 years, and in Europe, Canada, the U.S. and elsewhere around the world for many years as well. Mercer Human Resource Consulting Limited ("Mercer-U.K."), owns both U.K. Trade Mark Registration No. 2352832 and Community Trade Mark No. 004803251 for the mark MERCER. The MERCER.CO.UK domain name is also confusingly similar to the corporate name of the Complainants, which is Mercer Human Resource Consulting, Inc. ("Mercer-U.S.") and Mercer Human Resource Consulting Limited. The Respondent has no right or legitimate interest in the Domain Name.

The Complainants offer a full range of employee benefits, actuarial, compensation communication, personal financial counselling and other key human resources consulting services. They also advise on investment issues. The Complainants have become well and favourably known to members of the public in the U.K. and throughout Europe, in the United States, Canada, and elsewhere around the world, as well as to members of the human resources and financial services community in the U.K. and elsewhere around the world, as leaders in those fields. Complainants' roots extend as far back as 1937 through the establishment of an employee benefits department of Marsh & McLennan, Inc., their parent. The name MERCER was adopted in 1959, when Marsh & McLennan acquired William M.

Mercer Limited, a Canadian firm, founded by William Manson Mercer in 1945. In 1975, Mercer-U.S. became a wholly owned subsidiary of Marsh & McLennan Companies, Inc. The company has grown over the years to over 14,000 employees in offices in 140 cities in 40 countries.

Since 1959, the Complainants have operated under the name MERCER, and have used the name and mark MERCER and variants thereof to identify and distinguish their services from those of others.

For over 40 years ago, the mark MERCER and variants thereof have been extensively used, advertised and promoted by the Complainants throughout the world. Such names and marks have been prominently presented on advertisements, informational literature and other promotional materials, including on the Internet. Attached as Exhibit A is a printout of the Complainants' websites, which advertise the MERCER mark and name. Additionally, Complainant Mercer-U.K. owns both U.K. Trade Mark Registration No. 2352832 for the mark MERCER and Community Trade Mark (CTM) No. 004803251 for the mark MERCER. Further, Mercer-U.S. is the owner of several registrations in the United States for the mark MERCER (Registration Nos. 2902605, 2907461, 2945426, 2638066, and 3060178). Copies of the U.K. certificate of registration, the CTM status report, and the U.S. certificates of registration are attached as Exhibit B.

The mark MERCER has been extensively and continuously advertised and promoted by Complainants worldwide for many years, and in the U.K., since at least 1976. Indeed, Complainant Mercer-U.K. has had its company name registered at Companies House since before Respondent's registration of the MERCER.CO.UK domain name. Attached as Exhibit C is a printout of the Companies House record for Complainant Mercer-U.K., Company No. 00984275, showing a date of incorporation in 1970. Substantial amounts of time, effort, and money have been expended over the years in ensuring that the purchasing public in the U.K. and around the world associates such marks exclusively with Complainants. Indeed, Complainants have expended several million dollars on marketing and advertising their MERCER mark and services and products worldwide, including in the U.K. In 2006, Complainants' budget for advertising and marketing their services in connection with the mark MERCER again exceeded several million dollars worldwide.

Since long prior to Respondent's registration of the domain name MERCER.CO.UK and as a result of the Complainants' efforts, the MERCER mark and variants have acquired wide recognition symbolizing the immense goodwill that the Complainants have created throughout the U.K. and the world.

In addition, Mercer has registered and advertises and conducts business on the Internet through numerous domain names containing the name and mark MERCER or variants thereof, including, inter alia, MERCER.COM, which was registered on January 7, 1992, and MERCERHR.COM, which was registered on April 3, 2000. The Complainants maintain active websites on the Internet on which they promote their financial and human resource services under the domain name MERCER.COM and MERCERHR.COM. See Exhibit A.

The MERCER mark and variants have acquired an extraordinary degree of consumer recognition in the minds of the purchasing public, are distinctive, well known, if not famous, and serve uniquely to identify Complainants' services and related products. Through widespread and favourable public acceptance and recognition, the mark MERCER enjoys tremendous goodwill and has become an asset of incalculable value as a symbol of the Complainants' services and products.

The Complainant has attached to the Complaint as Exhibit D the declaration of David Goldenberg, General Counsel to the Complainants, verifying the foregoing information.

The Domain Name is confusingly similar and identical to the Complainants' distinctive and well known, if not famous, mark MERCER and represents a taking of the mark MERCER in its entirety as a domain name. In addition, the Domain Name represents a substantial portion of Complainants' corporate identity, i.e., Mercer Human Resource Consulting, Inc. and Mercer

Human Resource Consulting Ltd., and is identical to the Complainants' mark MERCER, as well as their service mark, domain name, and trade name in the U.K. The Complainants also commonly refer to themselves as "Mercer" without the terms "Human Resource Consulting." Further, the mark MERCER is used throughout the world by the Complainants, and on the Internet 24 hours a day, seven days a week. Clearly, the consuming public inevitably and immediately associates the domain name MERCER.CO.UK with the Complainants. Accordingly, the Domain Name is confusingly similar and identical to the mark MERCER in which the Complainants enjoy exclusive rights.

The Respondent has no right to or legitimate interest in the Mark MERCER or the Domain Name.

Long prior to the registration of the subject domain name, the Complainants established the mark MERCER as a strong and distinctive indication of source for their financial and human resources consulting services. The mark is exclusively used in the U.K., throughout Europe, in the U.S., Canada, and elsewhere around the world by the Complainants and their authorized representatives.

The Complainants have never authorized the Respondent or its predecessors to utilize any of their marks, nor do the Complainants have any relationship or association whatsoever with the Respondent. Any use to which the Respondent might put the Domain Name would violate the Complainants' trademark rights.

The only activity, which the Respondent has engaged in with respect to the Domain Name is that of openly offering to sell the domain name to interested buyers for no less than "£500, €730, \$920 or equivalent," an amount that is surely in excess of the Respondent's out-of-pocket costs directly associated with acquiring the domain name. Attached as Exhibit E is a printout of the Respondent's "mercer.co.uk - Domain Name Purchase Enquiry Form," which specifies the offer amount.

On April 24, 2006, the Complainants placed the Respondent on notice of their rights in and to the MERCER mark and their extensive and exclusive use of such mark in the U.K. The Complainants demanded that the Respondent transfer MERCER.CO.UK to them. The Respondent has not offered any plausible, legitimate purpose for its registration of the Domain Name. In response to the Complainants' demands that it transfer the infringing Domain Name, the Respondent indicated that it was not willing to transfer the Domain name. There is simply no justification for the Respondent's registration, use, and offer of sale of the Domain Name.

The Respondent's registration and use of the Domain Name constitutes an Abusive Registration. As reflected in the Domain Name WHOIS record attached as Exhibit F, the Respondent registered the Domain Name on November 1, 2004. In view of the long, exclusive, and extensive use by the Complainants and the substantial fame associated with the mark MERCER as of the Domain Name registration date, there can be no doubt that the Respondent was well aware of the Complainants' rights and registered the Domain Name either despite this knowledge or because of this knowledge. This knowing attempt by the Respondent to prevent the Complainants from registering their own mark as a domain name in itself serves as evidence of an Abusive Registration as it is a blocking registration against a name or mark in which the Complainants have rights..

The Respondent has not engaged in any legitimate use of the Domain Name. The Respondent's requirement of no less than "£500, €730, \$920 or equivalent" to sell the Domain Name without any legitimate interest in the MERCER mark whatsoever is further evidence of an Abusive Registration.

Overall, the circumstances indicate that the Respondent has registered the Domain Name for the purpose of depriving the Complainants of the benefit and use of the Domain Name with the hope of harassing the Complainants and causing them to expend corporate resources to track down the cybersquatter. The Respondent's actions represent conduct directed at Complainants to deprive them of the use of the Domain Name. The circumstances indicate

that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainants.

The Expert has read all the documentation supplied with the Complaint.

### Respondent

The Respondent has responded to the Complaint as follows:

The term "mercer" is a common surname and is a generic term in that it relates to and is descriptive of the entire group of people with this name. This name is widespread, there are a huge 42,100,000 listings for this name on Google for example, and although the prominent and sponsored matches produced relate to various commercial entities the vast majority of listings to the extent of many millions can be seen to relate to its use as a surname. The origins of the use of this name as part of the Complainant's trading name and other businesses presumably stems from the fact that it is a related surname. Indeed an examination of the company history provided on the Complainant's website at [www.mercerhr.com](http://www.mercerhr.com) confirms this to be the case. The company history text states "...Our company took the name of "William M. Mercer" in 1959, when Marsh & McLennan acquired William M. Mercer Limited, a Canadian firm founded by William Manson Mercer in 1945".

In this fashion the name "mercer" has been adopted for example as part of the trading name by 241 separate businesses here in the United Kingdom alone (ISS company data) and no doubt many hundreds of others globally. For example there are more than 3000 registered .com domain names containing the term "mercer" as well as 224 "mercer" related .co.uk domain names and a further 523 registered by people with the name mercer.

So whilst the Complainant may be able to demonstrate that it has some relation to the name that forms the Domain Name, so too can countless other parties due to its generic and descriptive nature and its highly common occurrence as a surname. The Respondent contends that, whilst the term "mercer" is as the Respondent has now discovered the subject of a recent trademark registered by Mercer Human Resource Consulting Limited in some of the many trademark classes, the fact that it is first and foremost a generic term should necessarily outweigh this detail in consideration. Mercer is a surname and generic and descriptive regardless of any trademarks that there may now be on the term, equally such as the term "water" subject to a number of trademarks itself remains generic and descriptive in spite of this fact, as do therefore the domain names [water.co.uk](http://water.co.uk) and [mercer.co.uk](http://mercer.co.uk).

The trading name of the Complainant is "Mercer Human Resource Consulting Inc." and the name of their UK Limited company is "Mercer Human Resource Consulting Limited". A large amount of evidence suggests that the Complainant is overwhelmingly known as "Mercer Human Resource Consulting" by both themselves and those familiar with it and not by the form "Mercer" as the Complainant alleges. On the parent companies group homepage at [www.mmc.com](http://www.mmc.com) the Mercer Human Resource Consulting Inc. sector is referred to as "Mercer Human Resource Consulting Inc.", the term "Mercer" on its own is not used at any time.

The principal UK website for their company - <http://www.mercerhr.co.uk> uses the full company title of "Mercer Human Resource Consulting" both in their logo and as their trading name. The page title used throughout their website being "Mercer Human Resource Consulting: human resources management issues & HR Strategy". (See Appendix 3). Their international homepage with .com domain name [www.mercerhr.com](http://www.mercerhr.com) (NOT [www.mercer.com](http://www.mercer.com)) also uses the same full title and logo "Mercer Human Resource Consulting" (see Appendix 2).

Mercer Human Resource Consulting have registered a variety of domain names reflecting their various Mercer related business here in UK. When all the active websites of these numerous domain names are visited e.g. [www.mercerdotpen.co.uk](http://www.mercerdotpen.co.uk) and [www.mercer-pen.co.uk](http://www.mercer-pen.co.uk) the same full company name of "Mercer Human Resource Consulting:" is solely referred to (see Appendix 5). Even when one clicks on the "About" link of any one of the companies numerous web sites and pages, the description of the company includes the full

trading name “Mercer Human Resource Consulting” and never at any point is referred to by the term “mercer” on it’s own (see Appendix 4).

The text on the about page from their websites reads for example:

*“**Mercer Human Resource Consulting** is the global leader for trusted HR and related financial advice, products, and services. In our work with clients, we make a positive impact on the world every day. We do this by enhancing the financial and retirement security, health, productivity, and employment relationships of the global workforce. **Mercer Human Resource Consulting** has more than 15,700 employees serving clients from more than 190 cities and 41 countries and territories worldwide.....”*

The full version of this text can be viewed in Appendix 4, but it is clearly apparent that they have made the effort to deliberately describe themselves as “Mercer Human Resource Consulting” and choose to reiterate the company name in full each time it is mentioned throughout the text never choosing to adopt an abbreviation of “Mercer”. This provides a clear indication that this is how the company is currently known, prefers to be known and has chosen to be known and that the term “mercer” alone is not used with reference to or applicable as a description of the company. Furthermore at no point on any of their websites is the Complainant referred to as Mercer <sup>TM</sup> or Mercer ® either in text or logo form.

Through the companies numerous websites and web pages there is only one single instance where the term “mercer” is used alone. At the one single web page residing at the [www.mercer.com](http://www.mercer.com) URL. Following apparently recent changes the text “mercer” is present in the logo area, (again without <sup>TM</sup> or ®) however all the remainder of the content and links on this page reflect longer full business names e.g. “Mercer Delta Organizational Consulting” and “Mercer Human Resource Consulting” as do all the destination pages of these links when these are followed.

It must be emphasized that this [www.mercer.com](http://www.mercer.com) URL is not the companies’ principal business website as they have tried to imply in their complaint but effectively a single placeholder page which contains in itself no active content, consisting solely of links to their various businesses. The principal company webpage resides at [www.mercerhr.com](http://www.mercerhr.com) which as can be seen has full and detailed content. (Mercer HR is a registered trademark of theirs). There are around 50 other URLs in use by Mercer Human Resource Consulting all which reflect their true company name, corporate identity and trading name of Mercer Human Resource Consulting in logos, titles and identity. At no point, not even on one single web page as above is there business even so vaguely referred to as “mercer” here in the UK.

***In response to the complainant’s allegations of abusive registration:***

The Respondent did not register the domain name “for the purposes of selling, renting.... to the Complainant or to a competitor. As has now been firmly established this company trades under the name of “Mercer Human Resource Consulting, Inc”. Furthermore the Respondent was not at all aware of this US based company or it’s UK branch - Mercer Human Resource Consulting Limited. These are not well known companies generally and although may be more widely known to those working in the in the field of Human Resources especially in the United States, it is not generally well known in this country and the Respondent and its employees are not involved in or related to this area of Human Resources in any way. The Respondent has at no point approached the Complainant or any of its competitors about the sale or lease of the Domain Name. The first time the Respondent became aware of Mercer Human Resource Consulting, Inc company was following various threatening letters it had previously received from Ms. Doreen Costa; letters that demanded the transfer of the Domain Name to the Complainant and threatened legal action and costs and fines of \$100,000 USD for the use of the Domain Name if the Respondent did not transfer it to them immediately.

The Respondent registered the Domain Name along with a number of other surnames as initially part of a project to offer a service of email @ a particular domain name e.g. [bill@mercer.co.uk](mailto:bill@mercer.co.uk) to customers for a yearly charge, a project that the Respondent was going to integrate with its web-hosting services and also offer sub domains at a particular domain

name for hosting etc. e.g. <http://bill.mercer.co.uk>. This project however has not as yet transpired and the Respondent now uses it solely with Google advertisements. This is done on a page and in a format which makes it obvious the content is advertisements and the Respondent's logo, company name and business activities are clearly displayed on the page at [www.mercer.co.uk](http://www.mercer.co.uk) and it could not conceivably be in any way confused with the business of Mercer Human Resource Consulting, Inc. or seen as passing off as them. Advertising represents a legitimate and fair use of the Domain Name as does the Respondent's planned earlier email/hosting idea. The Domain Name is also now offered for sale. The resale of registered domain names is now well established and is as we have been informed is confirmed as an acceptable practice by Nominet UK.

The Respondent strongly contests that the name is a well known trademark. Although registered, the mercer mark has never been used or applied to any extent by the Complainant, whose trading style is always presented as "Mercer Human Resource Consulting, Inc" and a variety of other variations on this for other areas of the company, not "Mercer". Any goodwill or identification of the Complainant and its services applies to this full company name and this alone and unequivocally not the term "mercer" by itself. It would be clearly incorrect to say, as the Complainant alleges, "the consuming public inevitably and immediately associates the domain name mercer.co.uk with" the Complainant. Furthermore to say the term "mercer" is either "distinctive" or known "widely" and also "exclusively" or "uniquely" by the public as the Complainant's business is false. The Respondent would suggest based on the evidence one could ask numerous members of the general public about this company and it is highly unlikely that any will have heard of this company let alone associate it exclusively with the term mercer. They are much more likely to associate mercer with a friend or acquaintance of this name. This is an attempt by the Complainant to put the Domain Name in the same category as a well known mark such as Coca-Cola® and thereby infer the Respondent must have been familiar with the mark because of the clear notoriety of it. This is not the situation however and the mercer mark is not a "world famous trademark" as the Complainant alleges. It is not even apparent that it has ever even been utilised at all by the Complainant never mind having been extensively promoted.

Possibly the Complainant is looking to rebrand itself to "Mercer" in the future as part of its own branding strategy, hence the interest now in this and the reason it is trying to obtain by coercion the Domain Name that the Respondent has registered and used legitimately. However it is clear any potential planned use or development of a mercer mark by the Complainant does not apply to the Respondent's registration of the Domain Name either now or at the time of registration. The Respondent feels that the Complainant is using the DRS procedure in bad faith and has been dishonest and deliberately misrepresented the facts in the Complaint.

The Expert has read all the documentation supplied with the Response.

#### Complainant

The Complainant has replied to the Response as follows:

In the Response, it was alleged that: "Mercer is a surname and generic and descriptive regardless of any trademarks that there may now be on the term."

The Respondent's argument, that "Mercer" is a surname and generic and descriptive regardless of any trademarks that there may now be in the term, represents a fundamental misunderstanding of U.K. trademark law. The fact that the U.K. Patent Office has issued a registration to Complainant for the mark MERCER is prima facie proof that the mark in question is inherently neither generic nor descriptive, since neither generic nor descriptive marks may be registered. Furthermore, regardless of whether MERCER is also used by others as a surname, the fact that the U.K. Patent Office issued a registration for the mark indicates that the mark as used by Complainant is distinctive and has acquired a distinctive character. Therefore, the Complainant's U.K. Registration No. 2352832 for the mark MERCER provides presumptive evidence of the Complainant's exclusive rights in and to the mark MERCER.

Even if the Respondent is correct that “Mercer” is used by others as a surname, that fact is irrelevant to the case at hand because the Respondent does not, and has never, claimed that its surname is MERCER, or that it is using MERCER to connote a surname. Indeed, the Respondent has yet to provide any explanation whatsoever as to the derivation of the Domain Name or why it chose to register the Domain Name in the first place, since it is quite apparent that the Respondent bears no relation to the name or mark MERCER.

There is no point of differentiation between the Respondent’s registration and use of the MERCER name and mark, and the Complainant’s long prior use of its MERCER trademark. The Complainant is unaware of any business besides that of the Complainant, in the U.K. or elsewhere that solely uses the term MERCER as its business or trade name. All businesses known to the Complainant that have incorporated the term MERCER into their business or trade names have differentiated themselves from Complainant with additional words or elements (e.g., the U.K. accounting firm of “Mercer & Hole”). The Complainant is unaware of any third-party uses of the term MERCER per se, and the Respondent has failed to provide any evidence of such use. Accordingly, there is no doubt that consumers and Internet users would likely be confused into believing that Respondent is somehow affiliated with, sponsored by, or connected to Complainant and/or the Complainant’s services.

It is alleged in the Response that “the name ‘mercer’ has been adopted for example as part of the trading name by 241 separate businesses here in the United Kingdom....there are more than 3000 registered .com domain names containing the term ‘mercer’ as well as 224 ‘mercer’ related .co.uk domain names and a further 523 registered by people with the name mercer.”

The Complainant has not been able to verify the truth of, or factual basis for, any of these claims, as the Respondent failed to provide any evidence to support such allegations in its Response. Therefore, no weight should be given to the Respondent’s unsubstantiated claims.

Even if there are many other businesses that use the term MERCER as part of their trade names, the Complainant appears to be the only one that uses the term “MERCER” by itself to identify the company and its services. The Respondent’s unidentified third-party uses of the term MERCER cannot be given persuasive value in a vacuum, or without identification of the complete name, nature of the business, and context of use. Absent such facts, the mere existence of other uses of the term MERCER with other words and phrases is irrelevant to the current issues.

The Respondent has alleged that a large amount of evidence suggests that the Complainant is overwhelmingly known as “Mercer Human Resource Consulting” by both itself and those familiar with it and not by the form “Mercer”.

This allegation is false and is belied by the evidence. In fact, the Complainant routinely refers to itself as MERCER, as do those who are familiar with the Complainant’s business. The Respondent fails to distinguish between a complete corporate name on the one hand, and a trademark and service mark on the other hand. Here, the Complainant’s full corporate indicator is “Mercer Human Resource Consulting, Inc.” Its trade name and service mark is MERCER, per se. The Complainant’s U.K. website, located at <http://www.mercerhr.co.uk/>, confirms that it deliberately emphasizes and uses the trademark MERCER to refer to itself and its services. See Exhibit A

The Complainant’s logo, which appears prominently on the top left-hand side of the web site, explicitly emphasizes the term MERCER by including it in large, bold typeface using upper-case letters. The terms “Human Resource Consulting,” which appear below the large MERCER mark, are significantly smaller, and use a plain font with lower-case letters. This logo is quite clearly calculated to emphasize the term MERCER in Complainant’s business name. See Exhibit A.

Further, contrary to the Respondent’s assertions, the text on the Complainant’s U.K. web site does indeed refer to the Complainant as “Mercer.” The headline in bold green lettering under the menu buttons states: “UK FTSE350 pension disclosures - New Mercer report,” referring to

the Complainant's new pension report. In the "News Briefs" section, there is a link to an article titled "Unilever UK scheme taps Mercer for advice," referring to the Complainant. When one clicks on that link, the website visitor is directed to a press release that consistently refers to the Complainant solely as "Mercer." See Exhibit B.

There is also a section in the Complainant's U.K. web site entitled "Mercer Events," referring to events affecting the Complainant. On the bottom of the web site page, there is a link for "Mercer's Client Extranet," which refers to the Complainant's client extranet. Finally, there are other such links throughout the page which intentionally use the term "Mercer" to refer to the Complainant, including a link to "How Mercer can help in: United Kingdom." See Exhibit A.

In addition, there is an abundance of third-party evidence that demonstrates that the Complainant is commonly referred to as simply "Mercer." Attached as Exhibit C are printouts of U.K. news stories referring to the Complainant simply as "Mercer." For example, there is a story dated June 28, 2006 from Reuters in London entitled "Few top firms use derivatives in pensions-study" which refers to the Complainant several times simply as "Mercer." In another article by BBC News entitled "Moscow is world's costliest city," the article refers to the Complainant's annual report and goes on to refer to the Complainant simply as "Mercer" no less than five (5) times throughout the short article. Included in Exhibit C is another article that refers to the Complainant as "Mercer" from the U.K. newspaper, The Guardian, entitled "Pension reform makes it wise to save again."

There are also numerous articles that pre-date the Respondent's registration of the Domain Name on November 1, 2004, that refer to the Complainant as simply "Mercer." For example, in an article in the U.K. newspaper, The Guardian, entitled "Inside Track: Mercer HR Consulting," and dated September 11, 2004, the Complainant is referred to as simply "Mercer" five (5) times throughout the article. See Exhibit D. Other articles which refer to the Complainant as simply "Mercer" from the Telegraph and the Daily Mail are also included, all of which pre-date the Respondent's registration date. Therefore, it is clear that both the Complainant and those familiar with it refer to it as "Mercer."

The Complainant refutes the Respondent's allegation that the MERCER.COM URL is not the Complainant's principal business website. The MERCER.COM website represents the Complainant's main business website and is the address intended to be used and actually accessed first, before linking to the Complainant's various businesses. See Exhibit E. To suggest that the Complainant's MERCER.COM website is not used by the Complainant in any significant way is patently incorrect. In fact, the MERCER.COM website is visited by Internet users approximately 50,000 times each month. See Exhibit F. Because of this, the MERCER.COM website serves as one of the Complainant's main promotional vehicles. It is the centre and core of the Complainant's Internet presence.

Further, it is significant that Complainant refers to itself simply as MERCER on its main business website at MERCER.COM. As can be seen in Exhibit E, the Complainant purposefully and explicitly singles out the word MERCER as its trademark of choice for all of its consulting services. When accessing the MERCER.COM website, the viewer is greeted by the MERCER trademark on the title of the page, on the top of the page, and in the introduction. See Exhibit E.

Moreover, MERCER.CO.UK is the local equivalent of the Complainant's MERCER.COM domain name and website, and visitors to the Respondent's web site would likely assume that they are reaching the same company that operates MERCER.COM.

The evidence establishes that the Complainant has registered and used MERCER per se and owns exclusive trademark rights in such term.

In the Response, it was further alleged that this was not an abusive registration because use of the Domain Name for Google advertising constitutes a "legitimate and fair use" of the domain name MERCER.CO.UK.

The Complainant replies that the Respondent's registration constitutes an abusive registration because it clearly registered the Domain Name with a view to blocking the Complainant and with the ultimate objective of provoking an offer to purchase the Domain Name at a price far in excess of the Respondent's out of pocket expenses. Accordingly, it is clear that the Respondent registered the domain name primarily with a view to selling it to the Complainant at a profit. The fact that the Respondent uses the Domain Name for the purposes of Google advertising does not protect it from the fact that its main objective is to sell the domain name for a profit. As proof of this, the Respondent makes an explicit offer for sale of the Domain Name on the MERCER.CO.UK web site, asking for no less than "£995, €1450, \$1830 or equivalent, and the price of this domain name may be much higher." See Exhibit G. This is the corresponding value to the name or goodwill in the MERCER domain name as determined by the Respondent. Such a purchase price might only be commanded because MERCER is identified with the Complainant and its fame and goodwill. The Respondent has utterly failed to explain the derivation of their claimed domain, or any connection between the term MERCER and their business, or that they have conducted a legitimate business now identified by the name MERCER. Such offer of sale therefore represents not only a bad faith registration, but also an abusive one.

Further, it is clear that Respondent registered the Domain Name to block the Complainant, and for the purpose of unfairly disrupting the business of the Complainant. The Complainant has had to expend large sums of money in defending against the Respondent's act of cyber-squatting, and in seeking proper transfer of the subject Domain Name.

Finally, the Respondent's registration constitutes an abusive registration because any use by Respondent of the MERCER.CO.UK domain name, identical to the Complainant's famous mark, constitutes an opportunistic attempt to attract visitors via the Complainant's famous mark. The Respondent is profiting from the Complainant's goodwill in the mark MERCER insofar as visitors are attracted to the MERCER.CO.UK website because of the Complainant's famous mark, and insofar as visitors click on any of Respondent's Google advertising links. The more that visitors click on the Respondent's links, the more revenue that is generated for the Respondent through Google's advertising program. This blatant and deliberate opportunism takes unfair advantage of, and is unfairly detrimental to, the Complainant's rights and goodwill in its famous MERCER mark.

The Expert has read all the documentation supplied with the Reply.

## **7. Discussion and Findings:**

### General

The Complaint has been filed in the name of the US Company, Mercer Human Resource Consulting Inc but refers to "the Complainants" in the plural to include the UK Company, Mercer Human Resource Consulting Limited. Attached to the Complainant as Exhibit D is a declaration by David Goldenberg, the General Counsel to Marsh and McLennan Companies Inc, which is the parent company of and trades as Mercer Human Resource Consulting Inc and Mercer Human Resource Limited. The Expert is satisfied that it is appropriate to take into account the evidence supplied in respect of the parent company and its trading companies.

Paragraph 2 of Nominet's Dispute Resolution Policy ("the Policy") requires that, to succeed, the Complainant must prove to the Expert, on the balance of probabilities, both that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in paragraph 1 of the Policy.

### Complainant's Rights

The term "Rights" is defined by the Policy to include, but not is not limited to, rights enforceable under English law, but a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business. It is appropriate to discount the domain suffix <.co.uk> which is of no relevant significance and wholly generic.

The Expert disagrees with the Respondent's submission that the name Mercer is generic and descriptive. The fact that Mercer is a common name does not make it generic or descriptive within the terms of the Policy. The evidence submitted indicates that the Complainant and Mercer-UK have substantial rights in the name MERCER both in respect of registered trade marks and established goodwill. Articles in leading UK newspapers commonly refer to the Complainant as "Mercer" and, in the Complainant's websites, prominence is given to MERCER.

The Expert finds that, for the purposes of the Policy, the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

#### Abusive Registration

Paragraph 1 of the Policy defines "Abusive Registration" as a Domain Name which either:

"i was registered or otherwise acquired in a manner, which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights;  
OR

ii has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3 of the Policy. It is apparent from the Complaint, that the Complainant relies on factors 3 a i A, B and C. The Expert will consider these factors in turn.

Under paragraph 3 a i A, it may be evidence of Abusive Registration if circumstances indicate that the Respondent has registered the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket expenses directly associated with acquiring or using the Domain Name.

The Complainant points to the Respondent's Domain Name Purchase Enquiry Forms as evidence of Abusive Registration under paragraph 3 a i A. In response the Respondent states that it was not aware of the Complainant or Mercer-UK and that it registered the Domain Name initially as part of a project to offer an e-mail service @mercero.co.uk. Although the Complainant's mark MERCER may not be widely known by the public at large, the Expert is satisfied that it has a high profile in the business and financial community in Europe and North America. The evidence indicates that mercero.com is the Complainant's principal website and that it was registered in 1992. Whilst there is no direct evidence that the Respondent's primary purpose in registering the Domain Name was to sell it at a profit to the Complainant or a competitor of the Complainant, the Expert finds it difficult to believe that the Respondent was not aware of the Complainant's website when it registered the Domain Name in 2004. Furthermore, the Respondent has not produced any evidence of demonstrable preparations to use the Domain Name as an e-mail service or why it chose to register the name Mercer. In the Expert's view, the Respondent would not be able to rely on paragraph 4 a i A of the Policy as evidence that its registration is not Abusive.

Under paragraph 3 a i B, it may be evidence of Abusive Registration if circumstances indicate that the Respondent registered the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights. It will always be the case that, in domain name disputes, the Complainant has been prevented from registering the domain name in question. There is no evidence that the Respondent registered the Domain Name primarily for this purpose.

Under paragraph 3 a i C, it may be evidence of Abusive Registration if circumstances indicate that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. There is no evidence that the Respondent registered the Domain primarily for this purpose or that the Complainant has suffered any actual disruption to its business.

The Respondent has not provided little information regarding the nature of its business. The print-outs of the Domain Name websites inviting offers for the Domain Name refer to "IMO™ - Internet Corporate Identity & Naming Specialist". The Respondent has also used the Domain Name with Google advertisements. The Expert has already concluded that the name MERCER has a high profile in the business and financial community. It follows that this has probably attracted visitors to the Domain Name website thereby resulting in a profit to the Respondent with each click on the related Google links, thereby taking unfair advantage of the Complainant's Rights.

The Expert concludes that, on the balance of probabilities, the Respondent registered the Domain Name for the purpose of making a financial gain to the detriment of the Complainant's Rights. It is apparent that the Respondent believed that the Domain Name would attract potential purchasers, which would include the Complainant. Taking into account all the circumstances, the Expert considers that the Complainant has proved its case on the balance of probabilities.

## **8. Decision**

In light of the above findings, namely that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name [www.mercer.co.uk](http://www.mercer.co.uk) be transferred to the Complainant, Mercer Human Resource Consulting Inc.

David King

24 August 2006