

DISPUTE RESOLUTION SERVICE

D00009629

Decision of Independent Expert

British Telecommunications plc

and

Yes Talk Ltd

1. The Parties

Complainant: British Telecommunications plc
BT Group Legal
Intellectual Property Department
BT Centre, PP C5A
81 Newgate Street
London
EC1A 7AJ
United Kingdom

Respondent: Yes Talk Ltd
3 Harvest Fields Way
Fouroaks
Sutton Coldfield
B75 5TH
United Kingdom

2. The Domain Names

btphonesystems.co.uk ('the first domain name')
bttelephoneengineer.co.uk ('the second domain name')
btversatilityshop.co.uk ('the third domain name')

These are here referred to collectively as 'the domain names'.

3. Procedural History

In September 2010, the Complainant raised a complaint (DRS 9123) relating to the domain names and naming the Respondent as Telecom Services 4U Ltd, then shown on Nominet's records as the registrant. Nominet advised the Complainant that, as that company had been dissolved, the complaint was invalid. When Nominet's records were subsequently updated to show the registrant of the domain names as Yes Talk Limited, the Complainant raised the current complaint against this Respondent.

Nominet checked that this complaint, dated 24 February 2011, complied with its UK Dispute Resolution Service Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint, inviting it to file a response. As no response to the complaint was received by 28 March, Nominet told both parties that, if it received the appropriate fee, the case would be referred for an expert decision.

On 5 April 2011 I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

4. Factual Background

I have visited the websites at the domain names. From those visits, the complaint and the routine administrative information supplied by Nominet, I accept the following as facts.

The Complainant provides communications services (including networked IT and internet) in 170 countries, including the UK. It has more than 1,000 trademarks comprising or including the letters BT, covering a range of goods and services. In the UK, the company has used the trademark 'BT' (letters written in a distinctive style) since 1991. It also holds a UK trademark registration for the word 'versatility'.

In certain circumstances, the Complainant gives permission for use of its trademarks by third parties. One of the Complainant's licensees, D2 Communications Limited, had the necessary permission. The director of the Respondent company is a former employee of D2 Communications. He does not have permission, in his own right, to use the Complainant's trademarks.

The domain name btphonesystems.co.uk was registered on 1 September 2008. Registration of the other two domain names, bttelephoneengineer.co.uk and btversatilityshop.co.uk, followed on 10 February 2009 and 23 September 2009 respectively.

The first domain name points to a web page headed 'BT Telephone Systems' with a rubric that reads 'refurbished kit, installations and manuals'. One of the tabs ('Telephone Solutions') takes traffic to a website at telecomsolutions4u.co.uk. The landing page of that website contains logos for, among others, Samsung, Blackberry, Toshiba, Vodafone, Panasonic, Sony Ericsson, Nokia, O₂ and BT Wholesale. It also refers to being able to offer telephone tariffs to suit the customer, including voice tariffs from T-Mobile, Orange, Vodafone, O₂ and Blackberry.

The second domain name takes traffic to a parking page headed 'Yes Talk Limited'. At the time of the visit the page simply listed what appear to be businesses:

Yes Talk Limited
BT Versatility Shop
Comms Warehouse
Telephone System Engineer
Telephone System Provider
Birmingham Electrics
UK Online Design
Yes Office Clearance
Yes Hosted PBX

- each with an 0800 telephone number.

The third domain name points to a welcome page introducing BT Versatility Shop as 'specialists in new and refurbished equipment'. On the left hand side, visitors can 'shop by category'. Most of the equipment appears to be BT branded but, under the cordless and corded handset headings, the links take traffic to a listing that includes goods supplied by Plantronics and JPL.

5. Parties' Contentions

Complainant

The Complainant says it has rights in names that are identical or similar to the domain names at issue. It argues that many of the factors identified in the Policy as potentially being evidence of abusive registration are present here:

- (i) the domain names were acquired with a view to transferring them at a profit.
- (ii) they were acquired as blocking registrations.
- (iii) use of the domain names is confusing or likely to confuse people into believing the domain names are connected with the Complainant. In particular, though the Respondent may be sourcing BT products from legitimate sources and acting as a reseller, that does not make the use of the first domain name acceptable - because there is no attempt to make clear to potential customers that the site is not connected with the Complainant. The Respondent is, instead, riding on the Complainant's goodwill and reputation.
- (iv) the Respondent is engaged in a pattern of registrations corresponding to well known names in which it has no apparent rights and the domain names here are part of that pattern. The Respondent has around 50 domain name registrations, showing that it is trading in domain names. Some names are merely descriptive but there is no justification for names incorporating third party trademarks and this is evidence of a pattern within the terms of paragraph 3 a iii of the Procedure (*sic*).

The Complainant also argues that

- (v) *btversatility.co.uk (sic)* combines 'BT' with the word 'versatility' and the fact that the Complainant holds UK trademark registrations for each of these 'renders that entire domain name infringing, even if split into constituent elements'.
- (vi) there is no legitimate non-commercial or fair use of the domain names.

Respondent

There has been no response to the complaint.

6. Discussion and Findings

General

Paragraph 15 b of the Procedure says that, in the absence of exceptional circumstances, if a party does not comply with any time period laid down in the Policy or Procedure, the expert will proceed to a decision on the complaint. There has been no response to the complaint within the time allowed by the Procedure and I am aware of no exceptional circumstances that would make it unreasonable to proceed to a decision.

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it has rights in respect of a name or mark which is identical or similar to the domain names; and that
- the domain names, in the hands of the Respondent, are abusive registrations.

Rights

The Complainant is an international business, with trademark registrations for the name 'BT' and the word 'versatility'. I accept that the name 'BT' is well known in the UK. 'Versatility', as the name of a product line, is less well known. But nevertheless, overall, the Complainant evidently has both registered and unregistered rights in the names 'BT' and 'versatility'.

The first and second domain names are a combination of a name in which the Complainant has rights and some generic descriptors – 'phone systems' and 'telephone engineer'. The third domain name combines two of the names in which the Complainant has rights with the generic word 'shop'.

The generic additions stop the domain names from being identical to the names in which the Complainant has rights but they do not prevent them from being similar. In my view the presence of the Complainant's marks within each domain name creates a similarity for the purposes of the low threshold 'rights' test. I conclude that the Complainant has rights in respect of names which are similar to the domain names.

Registration

As defined by the Policy, an abusive registration is a domain name which:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration. The Complainant's main arguments reflect those factors: that the domain names were registered to transfer at a profit, or as blocking registrations; that they are likely to cause confusion; and that they are part of a pattern of abusive registrations. On their own terms, however, these arguments do not appear to me to be very persuasive, still less conclusive:

- (i) there is an assertion that the domain names were registered with a view to transferring them at a profit but (even if this were conclusive - which it is not: paragraph 4 d makes clear that domain dealing of itself is not objectionable under the Policy) there is no evidence to back it up.
- (ii) as a matter of fact, the registration of the domain names does block anyone else from registering them but decisions under the Policy have long reflected the view that there needs to be something more – evidence of an intention to block – for this to be a material consideration. There is no direct evidence of intention here.
- (iii) the Complainant offers no evidence of actual confusion. That said, there is clearly potential for internet users to believe wrongly that the Respondent is somehow connected with the Complainant. I acknowledge the force of the Complainant's argument that there is nothing in the material at the domain names to counter the inaccurate impression that there may be such a connection.
- (iv) the Complainant offers a list of domain name registrations, some of which are purely generic (and accepted by the Complainant as being legitimate) while others incorporate well known names or marks. But in the absence of any evidence about the circumstances of the registration or use of those domain names, I decline to draw an adverse inference. As an aside, the reference in the complaint to paragraph 3 a iii is presumably intended as a pointer not to the Procedure but to the Policy.

Turning to the Complainant's other contentions:

- (v) it is doubtless possible to argue – as the Complainant does - that btversatility.co.uk combines ‘BT’ with the word ‘versatility’, rendering the entire domain name infringing, even if split into constituent elements. But whatever the merits of that argument, the third domain name, ignoring the .co.uk suffix, is not btversatility but btversatilityshop. There is therefore a generic addition that must be taken into account and that could, conceivably, make all the difference to the character of the registration.
- (vi) I accept that there is no non-commercial use of the domain names, but whether any other use is ‘fair’ is for me to decide under the terms of the Policy.

It seems to me that none of these arguments helps much with the question of whether the incorporation of the Complainant’s trademarks within the domain names amounts to the Respondent’s taking unfair advantage of or being unfairly detrimental to the Complainant’s rights. This question does however arise regularly in connection with domain names registered by ‘resellers’ (that is, businesses that simply buy and sell goods, as opposed to sellers who are also the manufacturers or suppliers of those goods) and there is an emerging consensus about the approach to be taken under the Dispute Resolution Service.

From its analysis of two earlier appeal decisions, the appeal panel in *Toshiba Corporation v Power Battery Inc. (toshiba-laptop-battery.co.uk - DRS 7991)* identified four underlying principles in reseller cases:

- (1) It is not automatically unfair for a reseller to incorporate a trademark into a domain name and the question of abusive registration will depend on the facts of each particular case.
- (2) A registration will be abusive if the effect of the respondent’s use of the domain name is falsely to imply a commercial connection with the complainant.
- (3) Such an implication may be the result of ‘initial interest confusion’ and is not dictated only by the content of the website.
- (4) Whether or not a commercial connection is implied, there may be other reasons why the reseller’s incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent’s website.

This strikes me as a fair and persuasive summary of the key factors likely to be significant in such cases.

Here it seems to me that the incorporation of the Complainant's trademarks within the domain names does arguably imply a connection between the Respondent and the Complainant – and there is little in the web pages at the domain names to counter that impression. The clearest case is the second domain name, which strongly implies that what is on offer is a BT telephone engineer when, so far as I can tell from the complaint, that is not what is actually available through the website. The domain name therefore misrepresents the position in an attempt to attract business on the back of the Complainant's rights. That cannot be fair. But, that second domain name example aside, any judgement about an implied commercial connection is – necessarily – finely balanced.

More tellingly, each of the domain names at issue points, at least in part – directly or indirectly – to the Complainant's competitors. Had there been a response in this case, it may be that the Respondent would have sought to advance arguments about the extent of such redirection and the weight that should be attached to it here. But there has been no response and, based on the evidence before me, my assessment (like that of the appeal panel in the Toshiba case) is that the references here to goods or services offered by competitors of the Complainant are conclusive of the question whether the registration or use of the domain names takes unfair advantage of the Complainant's rights.

Overall, then, the Respondent is incorporating the Complainant's trademarks within domain names, attracting internet traffic on the back of the Complainant's goodwill and presenting that traffic with commercial offerings that include goods or services from competitors of the Complainant. That use of the domain names clearly takes advantage of the Complainant's rights and that advantage can only be unfair.

7. Decision

I find that the Complainant has rights in respect of names which are similar to the domain names and that the domain names, in the hands of the Respondent, are abusive registrations.

I therefore direct that the domain names be transferred to the Complainant.

Mark de Brunner

9 May 2011