

**DISPUTE RESOLUTION SERVICE**

**D00012661**

**Decision of Independent Expert**

**O2 Holdings Ltd**

and

**GROVE ENTERPRISE**

**1. The Parties:**

Complainant: O2 Holdings Ltd  
260 Bath Road  
Slough  
SL1 4DX  
United Kingdom

Respondent: GROVE ENTERPRISE  
GROVE ENTERPRISE, YORK  
YORK  
N YORKS  
YO12 3AA  
United Kingdom

**2. The Domain Name(s):**

o2deals.co.uk

### 3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

28 March 2013 14:09 Dispute received  
28 March 2013 14:18 Complaint validated  
28 March 2013 14:26 Notification of complaint sent to parties  
18 April 2013 02:30 Response reminder sent  
23 April 2013 08:17 No Response Received  
23 April 2013 08:18 Notification of no response sent to parties  
03 May 2013 12:16 Expert decision payment received

### 4. Factual Background

#### The Complainant

The Complainant is a leading provider of mobile telecommunications services in the UK and internationally. It was launched under the O2 brand on 1 May 2002, having previously operated as part of British Telecom.

The Complainant has produced a witness statement from its Head of Brand Management dated September 2010 setting out information about the Complainant's promotion and usage of the O2 brand since its launch in 2002. The statement was originally prepared for an unrelated domain name complaint under the Uniform Domain Name Dispute Resolution Policy. The witness statement records that as of the end of 2009 the Complainant's total UK customer base totalled 21.3 million. As of 31 March 2003 (which is the closest date to the date on which the Domain Name at issue in this matter was registered) the Complainant's customer base was 12.050 million. Its turnover as of that date was £3.451 million.

The Complainant owns numerous UK and Community trade mark registrations for, or including, the element "O2" or "The O2". These include the following registrations which predate registration of the Domain Name:

2264516	Filed on 19 March 2001	O2 text mark	Registration covers, inter alia, telecommunications services
2271228	Filed on 29 May 2001	O2 text mark	Registration covers, inter alia, internet portal services and telecommunications portal services

2279371	Filed on 31 August 2001	Stylised O2 mark (O2)	Registration covers, inter alia, mobile communications apparatus
2296255	Filed on 22 March 2003	Stylised O2 mark (O2)	Registration covers, inter alia, mobile communications apparatus

The Complainant has consistently used its trade marks in advertising campaigns since early 2002 and as a result of its extensive advertising and promotion the O2 brand has received a high level of brand recognition. Advertising Awareness studies for the period October 2002-April 2004 put the Complainant second in the mobile user sector. A Brand Awareness study conducted for May 2002- April 2004 for the same sector put the Complainant third. In 2003/4 the Complainant was awarded "Business Superbrand" status by the Superbrands organisation which noted *"By the end of the launch phase.... O2 had become a well-known brand, achieving levels of recognition on a par with its rivals."* In 2010 the Complainant was ranked by Millward Brown Optimor 70th in the world's most valuable brands.

In addition to its advertising the Complainant also sponsors and supports many music festivals and events. The Complainant is also well known for its music venues, including The O2 arena in London.

### The Respondent

The Respondent registered the Domain Name on 22 April 2003. The registration was updated on 7 April 2013. The Domain Name resolves to a website (the Respondent's Website). A screenshot of the Respondent's Website as of 19 March 2013 is annexed to the Complaint. It shows that the Respondent's Website features an invitation to supply free "Pay as you Go" O2 sim cards (possibly as part of a tariff package). The Respondent's Website also refers to "other spectacular o2 deals" for which a link is provided. The banner on the website reads as follows;

"O2deals.co.uk  
The home of the free SMS o2 simplicity sim card and other o2 offers".

The Complainant's stylised O2 mark is shown in the banner headline and in an apparent image of an O2 sim card.

A search carried out by the Expert on 1 June 2013 confirmed that the Respondent's Website took the same form as it had in March 2013.

The Respondent has not submitted a Response to the Complaint. There is no information before the Expert about when the Respondent began to make active use of the Domain Name or whether its use has changed over time.

## 5. Parties' Contentions

The Complainant contends as follows:

1. The Complainant has Rights in the O2 mark which predate the Domain Name.
2. The Domain Name is confusingly similar to the Complainant's Rights. The Complainant regularly provides offers to its clients. It is natural to describe such offers as "deals" and in the context of the O2 trademark the word "deals" is descriptive and adds very little.
3. The Respondent has no connection to the Complainant and is not authorised to use its trade marks. There was no reason for the Respondent to register the Domain Name except to refer to the Complainant and to benefit from its well known mark or to interrupt or block the Complainant's business.
4. The Respondent's Website uses imagery from the Complainant's own branding, including the O2 logo which appears to be based on a sim card. It is inevitable that consumers coming across the Respondent's Website will wrongly assume a formal connection with the Complainant. Bearing in mind the extensive rights the Complainant has in the O2 mark, it is impossible to imagine how the Domain Name would not cause confusion to any relevant consumer. As such it is a reasonable assumption that the Respondent intentionally registered the Domain Name to attract for commercial gain internet users to the Respondent's Website by creating a likelihood of confusion with the Complainant as to source, sponsorship, affiliation or endorsement.
5. The Respondent intended to disrupt the Complainant's business. There is a real possibility of disruption in view of the fact that the Respondent is using the Complainant's branding on its website and appears to be offering free O2 sim cards.
6. Alternatively, the Domain Name must have been acquired primarily for the purposes of selling, renting or otherwise transferring the registration to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent's out of pocket costs. The fact that the Respondent has used the Complainant's brand imagery to attract traffic serves to confirm this and to confirm some form of illegitimate intention must have been present in the purchase and ongoing use of the Domain Name.

The Respondent has not filed a Response to the above contentions.

## 6. Discussions and Findings

Under Paragraph 2 of the Nominet Dispute Resolution Service Policy (the Policy) In order for the Complainant to succeed, it must establish on the balance of probabilities, both:

that it 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.

### Rights

Rights are defined in Paragraph 1 of the Policy as follows;

*"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning."*

The Complainant has established that it owns registered trade marks in the O2 mark in the UK (and elsewhere). These registrations confer Rights on the Complainant as defined in the Policy. Some of the registrations predate the registration of the Domain Name in April 2003 (see section 4 of this Decision).

In addition to the registered rights, the Expert finds that the Complainant's extensive promotion and use of the O2 marks have conferred unregistered rights in the goodwill that these activities have generated. The O2 mark is a well known mark associated with the Complainant's products and services. The information provided by the Complainant, set out in section 4 of this Decision, demonstrates that significant goodwill had been generated as at April 2003 when the Domain Name was registered. The continued expansion of the Complainant's business since that date has consolidated and increased the goodwill and the underlying unregistered Rights.

Under Paragraph 2 of the Policy, having established Rights in these marks, the Complainant must establish that the marks are identical or similar to the Domain Name. In examining this issue it is customary to ignore the usual "www" prefix and the ".co.uk" suffix. Here, the Domain Name is not identical to the O2 mark. The difference is the addition of the word "deals". The Expert accepts the Complainant's submission that, in the context of the O2 trademark, the word "deals" is descriptive of a feature of the Complainant's business. The introduction of the word into the Domain Name does not make it dissimilar to the O2 mark in which the Complainant has Rights.

The Expert therefore finds that the Complainant's O2 mark is similar to the Domain Name for the purposes of the Policy.

It follows that the Complainant has established on the balance of probabilities that it has Rights in respect of names or marks, which are identical or similar to the Domain Name. The first criterion under the Policy has been satisfied.

### Abusive Registration

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

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

The Complainant asserts that (i) the initial registration of the Domain Name by the Respondent in April 2003 and (ii) the subsequent use amount to an Abusive Registration under the Policy. Considering each of these submissions in turn:

### *Registration*

Paragraph 3a of the Policy provides non-exhaustive guidance about what may amount to Abusive Registration. This includes the following matters:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C. for the purpose of unfairly disrupting the business of the Complainant;

The issue here is whether the Domain Name was registered in a manner which at the time when the registration took place in April 2003, took unfair advantage of or was unfairly detrimental to the Complainant's Rights in its O2 mark.

There is no *direct* evidence before the Expert that the Respondent registered the Domain Name with an intent to take advantage of or unfairly disrupt the business of the Complainant. Instead, the Expert is invited to infer that, given the well known status of the Complainant's O2 mark, the Respondent must have been aware of the Complainant and/or its marks when it registered the Domain Name in 2003 and to have intended to take advantage of the Complainant's Rights or to cause disruption. The Complainant points out that there is no connection between the Respondent and the O2 mark which could provide a legitimate explanation for the registration.

The Expert finds these submissions to be compelling. By 2003 the Complainant had already secured some of its trade mark registrations and, as set out in section 4 of this Decision, had acquired a significant share of the mobile telecommunications market coupled with a developing market profile. In the absence of any contradictory evidence from the Respondent, the Expert finds that the Complainant has established on the balance of probabilities that the Respondent would have been aware of the Complainant at the time the Domain Name was registered.

The Respondent has not offered a credible explanation (or indeed any explanation) for its choice of Domain Name. The Domain Name comprises the mark O2. This is not a generic term in everyday use. It is a phrase with trade mark (or brand) significance and a strong association with the Complainant.

In these circumstances, and especially in the light of the well known nature of the Complainant's mark, the Expert infers that the motivation for the registration of the Domain Name was to exploit an association with the Complainant's business. This motivation is inherently unfair to the Complainant's Rights in its mark because it is parasitical on the success of the Complainant's business and trading reputation. It was also a foreseeable consequence that it would cause unfair disruption to the Complainant's business. The Expert finds that the initial registration of the Domain Name was an Abusive Registration on the ground that it took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

As an alternative submission the Complainant makes the specific contention that the Respondent was motivated to register the Domain Name for the purposes of selling, renting or otherwise transferring the registration to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs (Paragraph 3aiA of the Policy set out above). There is no evidence that the Respondent wishes to sell the Domain Name save for the general contention of bad faith on the part of the Respondent. This in itself is insufficient. This submission fails because the Complainant has not made its case out on the balance of probabilities.

*Use*

Paragraph 3a of the Policy provides non-exhaustive guidance about what may amount to Abusive Registration. This includes the following:

- ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

Although there is no direct evidence of confusion the Expert finds that the Complainant has made out its case on the balance of probabilities under Paragraph 3a(ii) of the Policy. The use of the Domain Name evidenced by the screenshot captured in March 2013 is likely to confuse consumers into the mistaken belief that the Domain Name is linked to, or endorsed by, the Complainant.

The Respondent is using the O2 mark in the same field of business activity as that in which the Complainant operates. The extensive goodwill and recognition enjoyed by the Complainant's O2 brand in connection with mobile telecommunications services make it inevitable that consumers will associate the O2 mark with the Complainant. The look and feel of the Respondent's Website exacerbates the likelihood of confusion. The fact that it features the Complainant's brand imagery and trade marks reinforces the impression that the Respondent's Website and its business are legitimately connected to the Complainant.

It is also likely on the balance of probabilities that the Respondent's use has diverted custom away from the Complainant causing unfair economic detriment to the Complainant's Rights. This will also constitute Abusive Registration.

In conclusion, the Expert finds that the Complainant has satisfied the requirements of Paragraph 2 of the Policy and the Complaint succeeds.

For these reasons the Expert finds that the registration of the Domain Name by the Respondent was an Abusive Registration.

## **7. Decision**

The Domain Name to be transferred to the Complainant.

**Signed: Sallie Spilsbury**

**Dated 3 June 2013**