

DISPUTE RESOLUTION SERVICE

D00013746

Decision of Independent Expert

O2 Holdings Limited

and

Resham Talawila

1. The Parties

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

Respondent: Resham Talawila
11 Stokesay Court
Peterborough
Cambridgeshire
PE3 6SL
United Kingdom

2. The Domain Name

o2-uk.co.uk ('the Domain Name')

3. Procedural History

Nominet checked that the complaint dated and received on 16 January 2014 complied with its UK Dispute Resolution Service ('DRS') 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 and invited him to file a response. No response was received. Informal mediation not being possible, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 19 February.

On 20 February 2014 I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I confirm 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

From the complaint and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant is the intellectual property holding company for the O2 group of companies. The group is a multinational provider of telecommunications services. In the UK, the Complainant was created from the demerger of BT's mobile telecommunications business. The group has been trading under the O2 brand since 1 May 2002.

It is clear from a detailed witness statement by the Head of Brand Management for Telefónica Europe plc, part of the O2 group, that, by the time of the Domain Name registration, the O2 group had established significant goodwill in the O2 brand. In sterling equivalent terms, group turnover runs into billions of pounds and there is a multi-million pound investment in marketing annually. At the end of 2008, the group had more than 45 million customers across Europe. According to a survey to which the witness statement refers, the O2 brand has been ranked in the top 100 most valuable brands in the world.

Through the Complainant, the group has registered rights in the name O2 in the UK, across Europe and in the United States of America. Those rights reflect trade mark registrations dating back to 2002 (in the UK), to 2004 (in Europe) and to 2010 (in the United States).

The Respondent is an individual who used to be an authorised affiliate of the Complainant. The affiliation was suspended in August 2012.

The Domain Name was registered on 5 May 2012. As at 16 January 2014 it resolved to a webpage that invited users to search for mobile phone deals by handset brand, by type of contract (monthly or pay-as-you-go) and by network.

Mail has been returned from the address on Nominet's record.

5. Parties' Contentions

Complaint

The Complainant points to the substantial reputation it enjoys in the O2 brand and to the extensive registered rights it has in the O2 name across the UK, continental Europe and the United States.

It says the Domain Name is an abusive registration because there is no legitimate reason for the Respondent to have acquired it. The Respondent must have registered the Domain Name in order to sell it to the Complainant (or a competitor of the Complainant) at a profit, to use it as a blocking registration or to disrupt the Complainant's business. The Complainant also asserts that confusion is inevitable. The complaint refers in passing to the registration's falling foul of paragraph 3(a)(iv) of the Policy, which relates to circumstances where it has been independently verified that the Respondent has given false contact details to Nominet.

Response

There has been no response.

6. Discussion and Findings

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 Name; and that
- the Domain Name, in the hands of the Respondent, is an abusive registration.

Rights

The Complainant has invested heavily in its brand since 2002. It evidently has both unregistered and registered rights in the name 'O2'.

It is conventional to ignore the .co.uk suffix as simply a generic feature of the domain name register. On that basis, the Domain Name comprises the name 'O2' and the descriptor 'uk', separated by a hyphen. It seems clear that, in this context, the descriptor is simply a generic, geographical tag.

I conclude that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name.

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 includes a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration and the complaint refers to many of these. Broadly, though, the Complainant's contentions fall into three categories.

First, there are the claims that the Respondent registered the Domain Name in order either to sell it to the Complainant (or a competitor of the Complainant) at a profit, or to use it as a blocking registration. These claims are essentially speculative. The Complainant offers no direct evidence of the Respondent's motive here.

Secondly, the Complainant points to the potential for the use of the Domain Name to disrupt its business and to cause confusion. Here, the complaint is on firmer ground. The website to which the Domain Name resolves presents visitors with a search page that appears to lead ultimately to competitors of the Complainant. So a name in which the Complainant has rights is being used to draw in internet traffic that may then be redirected to businesses with which the Complainant is in competition.

The *Experts' Overview* (section 3.3) refers to a similar situation:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue...

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site 'operated or authorised by, or otherwise connected with the Complainant'. This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in

any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with... a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant.

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration.

The question is whether the addition of the 'uk' descriptor in the Domain Name reduces the risk that internet users looking for the Complainant will experience initial interest confusion. In my judgement, it does not. If it has any effect at all, it merely implies that whatever content there might be at the website will be relevant to traffic from the UK or to traffic looking for UK-based goods or services.

Finally, the complaint suggests it has been independently verified that the Respondent has given false contact details to Nominet. But the reference is fleeting and I suspect it was included in error. Though there is evidence that mail has been returned from the address on Nominet's record, I do not think there is any basis for concluding that the Respondent has given false contact details.

I should deal with one other point. The Complainant says that the Respondent was once one of its authorised affiliates but that the relationship is suspended. Given that the Respondent appears to have been affiliated with the Complainant at the point the Domain Name was registered, it might be argued that the relationship is evidence that the registration is legitimate. But expert decisions in many DRS cases have established that there is a difference between a domain name that suggests merely that what is on offer at a website relates to a complainant's services and a domain name which leads the internet visitor wrongly to conclude that a website is run or endorsed by a complainant. It does not follow from the Respondent's affiliation with the Complainant that the original registration was necessarily legitimate.

The Complainant has essentially made out a case that registration was inappropriate, because – despite any connection at the time – the Respondent was not entitled to hold himself out as the Complainant; that the use of the Domain Name was likely to cause confusion; and that the Respondent has used a name in which the Complainant has rights to attract traffic and divert it to competitors of the Complainant. All of that amounts to the Respondent's having taken unfair advantage of the Complainant's rights. That case demands an answer. In the absence of a response, the complaint succeeds.

7. Decision

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the Domain Name be transferred to the Complainant.

Mark de Brunner

3 March 2014