



DISPUTE RESOLUTION SERVICE

D00018087

Decision of Independent Expert

O2 Worldwide Limited

and

Chameleon Web Services Limited

1. The Parties:

Complainant: O2 Worldwide Limited
20 Air Street,
London,
W1B 5AN
United Kingdom

Respondent: Chameleon Web Services Limited
Old Bank Buildings
Upper High Street
Birmingham
West Midlands
B64 5HY
United Kingdom

2. The Domain Name:

o2help.co.uk

3. Procedural History:

18 October 2016 11:29 Dispute received
18 October 2016 11:46 Complaint validated
18 October 2016 11:50 Notification of complaint sent to parties
04 November 2016 01:30 Response reminder sent
09 November 2016 11:25 No Response Received
09 November 2016 11:26 Notification of no response sent to parties
21 November 2016 01:30 Summary/full fee reminder sent
23 November 2016 08:24 Expert decision payment received

As required, I, Tony Willoughby, the Expert assigned to this case, 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.

4. Factual Background

The Complainant is a member of a United Kingdom-based group of companies, which has traded under the name O2 since 2002. It is one of the most prominent companies operating in the telecommunications field in the United Kingdom.

The Complainant whether directly (or indirectly through associated companies) is the owner of the O2 trade mark. It is the proprietor of numerous trade mark registrations for the mark, including by way of example European Union Trade Mark Registration No. 002109627 O2 (word mark) in classes 9, 35, 36, 38 and 39 covering *inter alia* a variety of telecommunications goods and services. The mark was applied for on 28 February, 2001 and registered on 13 May, 2004.

The Domain Name was registered on 1 February, 2014 and is connected to a website of the Respondent featuring a 2014 copyright notice. The home page headline reads "HELP- BROADBAND PROBLEMS" alongside an image of a hand pressing a "Help" button. There then follows in the body of the page text reading:

"Here you can find some answers to common questions/problems on O2 Broadband, SKY Broadband and Apple products.

This is an unofficial broadband support site, and is not affiliated with O2, SKY or Apple in any way. If you find any of the information

useful, you are welcome to link to this site.”

The site provides (or appears to the Expert to provide) information on a wide variety of topics relating in particular to the Complainant’s telephone and broadband products, Sky’s broadband services and Apple iPhones. Some of the information and advice is provided directly by the Respondent, while some of it is provided by way of links to other websites. The website features banner advertisements for other organisations.

5. Parties’ Contentions

The Complainant contends that its trading name and registered trade mark, O2, is confusingly similar to the Domain Name. Proof of ‘confusing similarity’ is a necessary prerequisite for a successful complaint under the Uniform Domain Name Dispute Resolution Policy, the policy applicable to the generic Top Level Domains and certain other country code Top Level Domains, but not for complaints under the Nominet Dispute Resolution Service Policy (“the Policy”). Proof of ‘similarity’ is sufficient.

The Complainant contends that the Domain Name in the hands of the Respondent is an Abusive Registration on a number of grounds, which are dealt with in Section 6 below. Essentially the primary allegation is that the Domain Name identifies the Complainant, not the Respondent and that the Respondent has selected the Domain Name to exploit the value of the Complainant’s trade mark unfairly.

The Respondent has not responded to the Complaint

6. Discussions and Findings

Preliminary Issue

The Complaint was filed on 18 October, 2016. Thus the version of the Policy applicable to the dispute is version 4, which applies to all disputes filed on or after 1 October, 2016. Regrettably, the Complainant’s representative filed the Complaint using nomenclature and paragraph numbering applicable to version 3. In this decision the Expert uses the nomenclature and numbering of the current version.

General

Pursuant to paragraph 2.1 of the Policy, for the Complainant to succeed in this Complaint it must prove to the Expert on the balance of probabilities that:

- I. It has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

II. The Domain Name, in the hands of the Respondent, is an Abusive Registration

Paragraph 2.2 of the Policy provides that the Complainant is required to prove both the above elements are present on the balance of probabilities.

“Abusive Registration” is defined in paragraph 1 of the Policy as 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. is being used or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Rights

The Complainant has demonstrated that it has registered trade mark rights in respect of its O2 brand and that the Domain Name at the third level is similar, featuring as it does the Complainant's name trade mark with the addition of the dictionary word, “help”, which is a word widely used on websites to indicate access to website assistance services.

It being permissible for the Expert to exclude from consideration the first and second levels of the Domain Name (“.co.uk”), which serve no purpose other than a technical one, the Expert finds that the name or mark in respect of which the Complainant has rights is similar to the Domain Name.

Abusive Registration

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors, “which may be evidence that the Domain Name is an Abusive Registration.”

The Complainant contends that the Respondent registered the Domain Name “primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly associated with acquiring or using the Domain Name.” (Paragraph 5.1.1.1 of the Policy)

The Complainant further contends that the Respondent registered the Domain Name “primarily as a blocking registration against a name or mark in which the Complainant has Rights.” (Paragraph 5.1.1.2 of the Policy)

The Complainant further contends that the Respondent registered the Domain Name “primarily for the purpose of unfairly disrupting the business of the Complainant.” (Paragraph 5.1.1.3 of the Policy)

Further, the Complainant relies upon paragraph 5.1.2 of the Policy, asserting that there are “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 authorized by, or otherwise connected with the Complainant.”

While the Complainant has sought to throw the kitchen sink at the Respondent, the Expert is satisfied on the balance of probabilities that the Respondent registered the Domain Name for the purpose for which it is using it, namely as described in Section 4 above. The Complainant asserts and the Respondent has not denied that the Respondent will be deriving revenue from the banner advertisements on the Respondent’s website.

The Complainant asserts and the Expert accepts that visitors to a site connected to the Domain Name, if using the Domain Name in the browser, are likely to believe erroneously that they are visiting a website of or authorised by the Complainant. The Domain Name indicates help from the Complainant. The fact that visitors may immediately appreciate that the site, a site offering assistance in relation to certain products having no connection with the Complainant, is not what they were expecting is no answer to the Complaint. By using the Complainant’s trade mark in the Domain Name, the Respondent will have obtained for itself an opportunity for commercial gain, namely revenue generated by visitors expecting to be visiting a website of or authorised by the Complainant and responding to the banner advertisements. It is the use of the Complainant’s trade mark in the Domain Name which is the attraction.

It is possible, of course, that the Respondent set up its website connected to the Domain Name in the hope that the Complainant would make an offer to purchase the Domain Name at a profit (Paragraph 5.1.1.1 of the Policy), but there is currently no evidence to support that allegation. Nor is there any evidence to suggest that the Respondent deliberately set out to block the Complainant (Paragraph 5.1.1.2 of the Policy) or unfairly disrupt the Complainant’s business (Paragraph 5.1.1.3 of the Policy). If those are effects of the Domain Name registration, they are, in the view of the Expert, incidental and not indicative of a primary aim on the part of the Respondent.

In the absence of any explanation from the Respondent seeking to justify its adoption of the Domain Name, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the

Policy. The Expert finds on the balance of probabilities that the Respondent registered the Domain Name and has been using it to take unfair advantage of the Complainant's Rights.

7. Decision

The Expert directs that the Domain Name be transferred to the Complainant.

Signed: Tony Willoughby

Dated 8 December, 2016