



NOMINET

Dispute Resolution Service

D00018555

HP Inc.

and

Jainendra Upadhyay

Decision of Independent Expert

1 Parties

Lead complainant: HP Inc.
Address: 1501 Page Mill Road
Palo Alto
Postcode: CA 94304-1112
Country: United States

Second and third Complainants: HP Hewlett Packard Group LLP
Hewlett-Packard Development Company LP
Address: 11445 Compaq Centre Drive West
Houston
Postcode: Texas 77070
Country: United States

Respondent: Jainendra Upadhyay
Address: 20-22 Wenlock Road
London
Postcode: N1 7GU
Country: United Kingdom

2 Domain names

<hp-help.co.uk>
<hp-printer-help.co.uk>

3 Procedural History

- 3.1 On 16 February 2017 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”). Nominet notified the respondent on the next day. There was no response. The complainant requested referral of the matter for expert decision under the Policy, and on 17 March 2017 paid the applicable fee.
- 3.2 I was appointed as expert on 23 March 2017. I have made the necessary declaration of impartiality and independence, confirming that I am independent of each of the parties and that 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

4 Factual background

- 4.1 The complainant is a well-known computer and printer manufacturer. The domain names were registered by the respondent on 15 March 2016.

5 Parties’ Contentions

Complainant

- 5.1 The complainant says it owns trade marks for the mark HP.
- 5.2 The complainant says it has acquired valuable goodwill and reputation in the HP trade mark over the past fifty years.

- 5.3 It says the first, dominant and most significant element of the domain names is the HP trade mark. The additional terms “printer” and “help” do not, it argues, do anything to distinguish the domain names from the mark.
- 5.4 The complainant says the domain names resolve to websites which purport to offer repair, maintenance and support services for HP printers. It says the services offered by respondent compete directly with its own.
- 5.5 It argues that the websites connected to the domain names are inherently confusing and likely to confuse people into believing they are associated with the complainant. This it says is exacerbated by oral misrepresentations made over the telephone by the respondent and his representatives.
- 5.6 It says the domain names are likely being used to promote a technical support scam to obtain from unsuspecting customers personal and sensitive data when accessing their computers remotely.
- 5.7 The complainant argues that the domain names were registered or acquired for the purpose of unfairly disrupting the business of the complainant
- 5.8 It says the respondent is using the domain names in a way which has confused or is likely to confuse people or businesses into believing that they are connected to the complainant.
- 5.9 It argues that the domain names are part of a pattern of registrations where the respondent is the registrant of domains which correspond to well-known trade marks (as it happens, in the field of computer technology) in which the respondent has no apparent rights.

Respondent

- 5.10 The respondent has made no response.

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show 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

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has produced documentary evidence from the UK Intellectual Property Office and the US Patent and Trademark Office of the second complainant's UK and US trade marks in respect of the mark HP. At the third level (i.e. disregarding ".co.uk") the domain names each include the mark, and in each case the string of characters corresponding to the mark represents the first and arguably dominant element of the domain name.
- 6.4 In my view the addition in the domain names of strings that read naturally as including the words "help" and "printer help" does not make them dissimilar to the complainant's marks. On the contrary, by adding strings that read as including words that suggest helplines, those additional letters naturally lead the reader to infer a reference to the complainant's support services—and therefore reinforce the similarity.
- 6.5 In those circumstances, I am satisfied that the second complainant has rights in respect of a mark similar to the domain names.

Abusive registration

- 6.6 Under paragraph 1 of the Policy, abusive registration means a domain name which either:
- 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 took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.7 Under paragraph 5.1.2 of the Policy, circumstances indicating that the respondent is using a domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.8 The appeal panel in DRS 16416 *WWE v Daniel Raad* decided that (while these are not absolute rules) if:
- a website is linked to a domain name;
 - the website is used to sell only the genuine goods or services of a third party;
 - the third party alleges the domain name is an abusive registration, and

- the third party has relevant rights,

then:

- use of the mark in unadorned form is likely to amount to an abusive registration;
- use of the mark is also likely to amount to abuse if combined with terms that results in a domain name which would readily be considered to be that of the owner of the mark, but
- use is less likely to amount to abuse if the mark is combined with terms that result in a domain name which would not readily be considered to be that of the owner of the mark.

- 6.9 The appeal panel's decision in that case is not binding on me, but does have persuasive force.
- 6.10 The domain names include the complainant's mark, and the complainant has produced evidence that services being offered via the domain names relate to the complainant's products. The complainant's mark in the domain names is combined with terms that result in domain names which would in my view readily be considered to be those of the complainant. Some confusion is therefore likely between the domain names and the complainant.
- 6.11 In my view therefore, the respondent appears in the circumstances to have used the domain name in a manner which has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.
- 6.12 I make no finding on whether the respondent may be, as suggested by the complainant, using the domain name as part of any kind of "scam".
- 6.13 Under paragraph 5.1.3 of the Policy, it may be evidence of abusive registration if the complainant can demonstrate that the respondent is engaged in a pattern of registrations corresponding to well known names or trade marks in which the respondent has no apparent rights, and the domain name in question is part of that pattern.
- 6.14 The complainant has produced evidence that the respondent registered in March and June 2016 three domains corresponding in part to well-known technology trade marks.
- 6.15 It does therefore seem on the face of it that the respondent is engaged in a pattern of registrations corresponding to well known names or trade marks in which it has no apparent rights.
- 6.16 Paragraph 3.5 of the DRS Experts' Overview suggests experts have taken two approaches to the question whether any particular domain name forms part of such a pattern. On one approach —

There must be evidence to justify the linking of the domain name in issue to the other

objectionable domain names. The link may be found in the names themselves and/or in the dates of registration, for example.

6.17 On the other approach—

If the domain name in issue is a well-known name or mark of the Complainant and the Respondent is the proprietor of other domain names featuring the well-known names or marks of others, the pattern is likely to be established, even if there is no obvious link between the names or the manner or their dates of registration.

6.18 In my view, on either approach the domain names appear to form part of the pattern.

6.19 Both domain names are linked to the other objectionable registrations because they all relate to famous technology marks. In addition they are linked by date to one of the other domains, which was also registered on 15 March 2016.

6.20 The respondent has given no explanation of the pattern of registrations it has been involved in.

6.21 It is for the complainant to make good its case. However, for the reasons I have given the evidence before me establishes a prima facie case of abusive registration in respect of both domain names. The respondent has provided no explanation for its registration of them.

6.22 In the circumstances I am satisfied on the balance of probabilities that each of the domain names, in the hands of the respondent, is an abusive registration.

7 Decision

7.1 I find that the second complainant has rights in names or marks which are similar to the domain names; and that the domain names, in the hands of the respondent, are abusive registrations.

7.2 The complaint is upheld. I direct that the domain names be transferred to the second complainant, HP Hewlett Packard Group LLP.

Carl Gardner

14 April 2017