

DISPUTE RESOLUTION SERVICE

D00009158

Decision of Independent Expert

British Telecommunications plc

and

bc chika

1. The Parties:

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

Respondent: bc chika
Dalespark Drive
Manchester
M27 0FP
United Kingdom

2. The Domain Name(s):

mybt.co.uk

3. Procedural History:

11 October 2010 Dispute received
12 October 2010 Complaint validated; notification sent to parties
03 November 2010 No response received
11 November 2010 Expert decision payment received
16 November 2010 Michael Silverleaf appointed as expert

4. Factual Background

4.1 The complainant is British Telecommunications plc, which trades as BT. It has used that name since at least 1991. The name BT is extremely well known to the public in the UK and, indeed, elsewhere, as a provider of telecommunications services and associated services and goods.

4.2 The complainant is one of the world's leading providers of communications solutions and services operating in 170 countries including the United Kingdom. Its principal activities include networked IT services, local, national and international telecommunications services, and higher-value broadband and internet products and services. The complainant has also registered worldwide over 1000 trade marks comprising or incorporating the letters BT, covering a wide range of goods and services. The complainant is the registered proprietor of a number of registrations for the trade mark BT in the UK. The complainant's mark BT was described by Aldous LJ in his judgment in the case of *British Telecommunications plc v One in a Million* ([1999] 1 WLR 903) as "a well known household name" referring to the complainant.

4.3 The complainant has in consequence acquired a very substantial reputation and goodwill in the UK and elsewhere in the name and mark BT. The effect of that reputation and goodwill is to make use of the name and mark BT in relation to communications and internet services by third parties likely to cause members of the public to associate those services with the claimant.

4.4 The respondent registered the Domain Name on 8 March 2006. As it has not responded to the complaint, the only information I have about it is contained in the explanations of what appears and has appeared on the website at the Domain Name which has been provided by the complainant in its complaint. That information is that the respondent is offering website development and hosting services under the name MyBt.co.uk. The site originally contained links to third party sites and holding pages apparently linked to the respondent. There was no indication on the webpage at that stage that the site was not linked in some way to the complainant. There is no indication in the material before me when the respondent first started to use the Domain Name in this way.

4.5 On 28 May 2010 the complainant wrote to the respondent pointing out its rights and requiring deletions from the website to remove infringements of the complainant's trade marks. There was no response to this letter. On 1 July 2010 the complainant wrote to the registrar for the Domain Name asserting its rights and asking the registrar to suspend or cancel the respondent's services. The registrar declined to do so. Following these communications, the content of the

website at the disputed domain changed. It now includes a heading to the right of the title MyBt.co.uk which states “This website is for web development and has nothing to do with British Telecom”. From this it is possible to deduce that the respondent is aware of the complainant’s complaints even though the respondent has not responded to the complainant’s correspondence.

4.6 The complainant itself has now started to use the name MyBT as part of a self-service area on the main BT website for customers to access their accounts. The effect of the existence of the Domain Name in third party hands is that the complainant cannot direct customers to this part of its site without them having to navigate from other BT home pages. The complainant also uses the name mybt as a subdomain for services for BT staff members to access online services both from its intranet and externally. The complainant considers that the respondent’s use of the Domain Name could give rise to confusion with either of these services it offers under the name mybt.

5. Parties’ Contentions

5.1 As I have noted above, there has been no response to the complaint so that I have only the complainant’s contentions to consider. The track and trace information on the Royal Mail website indicates that the special delivery posting of the complaint to the respondent was not deliverable.

5.2 The complainant says that the dominant and distinctive part of the Domain Name is the mark BT. The addition of “my” to it is generic. Accordingly, it says the addition does not distinguish the Domain Name from its well-known trade mark. Nor, it says, does the disclaimer suffice to displace the initial interest confusion which will result from the use of the mark BT in the Domain Name. It points out that its mark is so well known and recognised that there can be no conceivable use of it which does not impact on its rights. The complainant relies upon WIPO decision D2000-1397 in *Nike Inc. v B B de Boer* in which it was held that the complainant’s name in that case was so well known that it would be difficult to find anyone in any field of endeavour who could show a legitimate right or interest in a domain name containing its trade mark. Accordingly, the complainant submits that there can be no legitimate non-commercial or fair use which could be made of the Domain Name, either under paragraph 4(a)(i)(C) of the DRS Policy or otherwise. Nor, the complainant asserts, is there any genuine offering of goods or services by the respondent to satisfy the conditions of paragraph 4(a)(i)(A).

5.3 The complainant further asserts that the respondent is actively preventing the complainant from taking ownership of the Domain Name and thus intentionally depriving the complainant of making use of a name which corresponds to the complainant’s trade mark for its own legitimate interests. The complainant says that it does not matter that the respondent is not demanding money from the complainant, it is nevertheless holding the complainant to ransom by using the Domain Name in this way. Consequently, the complainant says the respondent’s registration of the Doman Name is abusive under paragraphs 3(a)(i)(A) and (B) and 3(a)(ii) of the DRS Policy.

6. Discussion and Findings

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008. Paragraph 1 of that policy defines an Abusive Registration 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. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”

6.2 Paragraph 1 of the DRS Policy also defines “Rights” for the purposes of this procedure as including but not limited to those enforceable under English law. Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and
- (b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.3 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the domain name is an Abusive Registration. The relevant factors for the purposes of the present case are

“(a)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; ...

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.”

The remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.4 Clause 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. These include the following which are relevant to the present case:

“(a)i. Before being aware of the Complainant's cause for complaint (not necessarily the ‘complaint’ under the DRS) the Respondent has:

A. used or made demonstrable preparations to use the Domain Name as a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

...

C. made legitimate non-commercial or fair use of the Domain Name.

...

6.5 According to the Appeal Panel decision in the *Seiko* case (DRS 00248) whether a registration is an abusive registration under the DRS Policy is independent of whether a domain registration is an infringement of trade mark and should be decided under the terms of the DRS Policy alone. The same decision also makes clear, however, that the relevant principles of English law should be applied in determining whether the Complainant has Rights under the Policy and that the Policy is founded on the principle of intellectual property rights which should be taken into account.

6.6 The first question in any DRS complaint is whether the complainant has Rights. This, as has been said in many cases, is a low threshold test. In the present case the mark BT is a well-known, household name there can be no doubt that the complainant has demonstrated that it has Rights as defined by the DRS Policy.

6.7 It is a pre-requisite of a finding that a domain name is an Abusive Registration under paragraph 3 (other than paragraph 3(a)(iv)) of the DRS Policy that the respondent had some prior knowledge of the complainant's rights in the Domain Name: see the Appeal Panel decision in *Verbatim* (DRS 4331). The requisite knowledge can be inferred from the notoriety of the complainant's rights. It seems to me that this is the case here. It is not possible that there is anyone in the UK who has any knowledge of communications or the internet who is unaware of the respondent and its name and mark BT.

6.8 Next, I have to consider whether the registration or use of the Domain Name are abusive in accordance with the DRS Policy. While the complainant alleges that the respondent registered the Domain Name either for the purpose of selling or transferring it or as a blocking registration, I do not think that I have any basis for inferring that this is so. The only information I have is that the respondent registered the Domain Name over 4 ½ years ago and that it has been using it for an indeterminate period to offer website development and hosting services. These facts do not suggest that the respondent is guilty of conduct of the kind prohibited by either paragraph 3(a)(i)(A) or (B) of the DRS Policy.

6.9 The conduct I have identified does, however, suggest that the respondent is guilty of using the Domain Name in a manner which is likely to confuse people into believing that the Domain name is connected with the complainant contrary to paragraph 3(a)(ii) of the DRS Policy. Such a likelihood can be inferred from the notoriety of the complainant's mark, the nature of the services offered by the respondent, which are closely associated with the complainant's business and the apparent acceptance by the respondent that the likelihood exists from the placing of the disclaimer on the website. I accordingly conclude that there is such a likelihood.

6.10 Finally, I have to consider whether there is anything in the circumstances of the present case which might make the provisions of paragraph 4(a)(i)(A) or (C) of the DRS Policy applicable rendering the use of the Domain Name unobjectionable. The complainant says there is not. The respondent's use of the Domain Name is plainly commercial. The respondent cannot therefore rely on paragraph 4(a)(i)(C).

The only question is whether use was made of the Domain Name in connection with a genuine offering of goods or services before the respondent became aware of the complainant's complaint. Given that I have concluded that the respondent must have been aware of the complainant's rights when registering the Domain Name, it seems to me to follow that any offering of web development services on a website under that name cannot have been genuine. The respondent either did or ought to have realised that such an offering would confuse the public into making a false connection with the complainant. It is plain that the respondent now recognises the possibility of confusion because of the disclaimer that has appeared on the website since the complainant's initial correspondence. It seems to me that the respondent must have realised the possibility beforehand. The appearance of the disclaimer rather than an objection to the complainant's complaint is evidence of this. Accordingly, the respondent must have realised that there was a risk of confusion when offering services under the Domain Name and the offer was accordingly not genuine within the meaning of paragraph 4(a)(i)(A) of the DRS Policy. The current presence of the disclaimer has no impact on the initial interest confusion that the Domain Name inevitably creates.

6.11 I accordingly conclude that the registration of the Domain Name is an Abusive Registration.

7. Decision

7.1 I direct that the registration of the Domain Name is transferred to the complainant.

Michael Silverleaf

06 December 2010