

**DISPUTE RESOLUTION SERVICE**

**D00012488**

**Decision of Independent Expert**

**TELEPERFORMANCE**

and

**Mr Raj Tappu**

**1 The parties:**

Lead Complainant: TELEPERFORMANCE  
21/25 rue BALZAC  
PARIS  
ILE DE FRANCE  
75008  
France

Respondent: Mr Raj Tappu  
2 Carlyle Gardens  
London  
Middlesex  
UB1 2BN  
United Kingdom

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

teleperformance.org.uk

**3 Procedural history:**

The Complaint was lodged with Nominet on 18 February 2013. Nominet validated the Complaint and informed the Respondent on 18 February 2013 that the Dispute Resolution Service (“DRS”) had been invoked and that the Respondent had 15 working days to submit a response. A response reminder was sent to the Respondent on 7 February 2013. No response was received by 12 March 2013 and a Notification of No Response was sent to parties on that date. On 22 March 2013 Nominet sent a summary/full fee reminder to the Complainant and on 25 March 2013 the Complainant paid Nominet the

appropriate fee for a decision of an Expert pursuant to Paragraph 21(a) of the Nominet DRS Procedure ("the Procedure").

On 2 April 2013 Nominet appointed Gill Grassie ("the Expert"). The Expert has confirmed to Nominet that she knows of no reason why she could not properly accept the invitation to act as the Expert in this case, and further confirmed that she knows of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

#### **4 Outstanding formal/procedural issues**

The Respondent has not submitted a response to Nominet in time (or at all) in compliance with paragraph 5(a) of the Procedure.

Paragraph 15(b) of the Procedure provides that "*if, in the absence of exceptional circumstances, a party does not comply with any time period laid down in the policy or the Procedure, the expert will proceed to a decision on the complaint*".

Nominet has attempted to try and bring the complaint to the Respondent's attention. There do not appear to be any exceptional circumstances involved, and in accordance with paragraph 15(b) of the Procedure, a decision will be made on the Complaint notwithstanding the absence of a response.

#### **5 Factual Background**

The Domain Name was registered by the Respondent on 6 August 2012. The Complainant is a French company which operates as a leading provider of call centre activities on a global basis. It was incorporated under the laws of France on 14 February 1974. It is the owner of numerous registered trade marks for the word TELEPERFORMANCE in various countries and notably in the UK. The latter were registered on 10 February 1989 and 27 April 1990. It also owns various domain names including teleperformance.com, teleperformance.org, teleperformance.biz and teleperformance.info. These were registered at various times between 1995 and 2003. It changed its name from SR Teleperformance to Teleperformance on 16 June 2006. The Domain Name is not used by the Respondent and it directs to the registrar Crazy Domain's holding page.

The Complainant's representative wrote to the Respondent on 13 December 2012 by registered letter to which it did not receive a reply. The letter requested transfer of the Domain Name to the Complainant. The Respondent continues to maintain the registration of the Domain Name.

#### **6 Parties' contentions**

The parties' contentions can be summarised as follows:-

## The Complaint

### The Complainant's Rights

- 6.1 The Complainant alleges it has Rights in a mark which is identical or similar to the Domain Name. It alleges as follows:-

The name Teleperformance is the Complainant's company name. It states that it is a worldwide leading provider of customer experience and serves companies around the world. As a group it states that it operates about 98,000 computerised workstations, across 250 contacts centres in 49 countries, mainly in the United Kingdom and conducts programs in more than 66 different languages and dialects on behalf of major international companies operating in various industries. It states that it is an important French group enjoying great notoriety all over the world in call centre activities. The Complainant refers to various WIPO UDRP decisions which it says recognise the well-known character of its company. It changed its business name from SR Teleperformance to Teleperformance on 1 June 2006. It owns numerous trade marks in various countries and notably in the UK for the word "Teleperformance"; and owns the domain names as listed above.

### 7 Abusive registration

- 7.1 The Domain Name incorporates the whole of the TELEPERFORMANCE trade mark and is confusingly similar to the TELEPERFORMANCE trade mark. The Respondent has no rights or legitimate interests in respect of the Domain Name as he does not need to use it since his name is completely different and has nothing to do with the term Teleperformance. The Complainant has never authorised the Respondent to use its trade mark Teleperformance or to apply for any domain name incorporating this term. There is no apparent connection between the Complainant and the Respondent. The Respondent owns no registered trade mark for the word Teleperformance.
- 7.2 The Domain Name was registered and is being used in bad faith by the Respondent. The Complainant argues this is due to its well-known character as referred to above. It alleges that the Respondent could not ignore the existence of the Complainant's company and its websites when it registered the Domain Name. The name Teleperformance is a fancy and distinctive name. Furthermore the Respondent did not reply to the above cease and desist letter. The Respondent intended to lead people to believe he has a connection with the Complainant. The Domain Name directs to the Registrar crazydomains holding page and so the Respondent has no apparent interest in holding the Domain Names. The Complainant alleges that it appears that the Respondent only registered the Domain Name to make internet users believe he is a partner of the well-known company Teleperformance. The Complainant refers to the *Broadwood International v. Mark Page* DRS case (D00009662) as support for this. That case dealt with initial interest confusion.
- 7.3 Also since there is no connection between the Respondent and the Complainant, the Respondent's registration of the Domain Name is likely to confuse people or businesses into believing that it is registered to, operated by or otherwise connected with the Complainant. In the

circumstances the Complainant alleges that the registration of the Domain Name is an Abusive Registration under Nominet's DRS Policy Section 3(a)(i)(B) and requests that the Domain Name is transferred.

## **Respondent**

As above the Respondent has not replied to either the cease and desist letter sent by the Complainant nor to the Complaint itself. It therefore has not taken the opportunity to refute any of the allegations made or otherwise to challenge the basis of the Complaint.

## **8 Discussions and findings**

### **General**

Paragraph 2 of the Policy requires that the Complainant must prove, on the balance of probabilities, that

“(i) the Complainant 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.

### **Rights**

Rights are defined in Paragraph 1 of the Policy as follows “*rights enforceable by the Complainant whether under English law or otherwise*” .

The Complainant is the registered proprietor of the trade mark for the word Teleperformance in various jurisdictions including in the UK and has made substantial use of this mark on a global basis and in the UK. The Expert therefore has no difficulty in concluding that the Complainant has Rights in the mark Teleperformance.

For the avoidance of doubt the Expert has not taken any account of the content of the various WIPO UDRP decisions referred to by the Complainant in support of its assertion that it has Rights.

### **Identical or confusingly similar**

Ignoring the first and second level suffix, as the Expert must do, the Domain Name is identical to the mark in which the Complainant has Rights.

### **Abusive Registration**

Having concluded that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name the Expert must now go on to consider whether the Domain Name is in the hands of the Respondent an Abusive Registration.

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) *has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.*

The Complainant has not asserted that the Domain Name has been used to link to an active website or otherwise. Paragraph 1 (ii) of the Policy above therefore does not apply because there has been no use as such of the Domain Name.

The Complainant therefore must demonstrate on the balance of probabilities that paragraph 1(i) of the Policy above applies.

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The ones which seem pertinent here are as follows:-

*“3(a)(i) Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

*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;*

- (ii) *Circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;”*

Notably Paragraph 3(b) of the Policy states:

*“(b) failure on the Respondent's part to use the Domain Name for the purposes of email or a website is not in itself evidence that a Domain Name is an Abusive Registration.”*

The Complainant expressly relies upon Paragraph 3(a)(i)B. It also alleges that the Respondent has no rights or legitimate interests in respect of the Domain Name and that the Domain Name was registered and is being used in bad faith. Notably however it does not rely upon Paragraph 3(a)(i)C(ii).

The Complaint is not set out in the clearest manner. Although it purports to specify a number of grounds for this being an Abusive Registration, notably that the Respondent has no rights or legitimate interest in respect of the Domain Name, that the Domain Name has been registered and used in bad faith and initial interest confusion, ultimately the Complaint seems to rely solely upon ground 3(a)(i)(B) of the Policy. That ground under the policy is that the Domain Name has been registered primarily as a blocking registration. The Expert only proposes to deal with the Complaint based on that ground. In any event she considers that paragraph 3(a)(1)(C)(ii) would not be applicable as it appears there has been no “use” of the Domain Name as such.

In order to succeed in a Complaint made under any head of paragraph 3(a)(i) of the Policy, including therefore 3(a)(i)(B), “knowledge” and “intention” are pre-requisites. This is in accordance with the *Verbatim* case (DRS04331). At the time that the Respondent registered the Domain Name on 6 August 2012, the Expert, based on the evidence presented, finds on the balance of probabilities that the Complainant was already well established on a global basis. In addition the name Teleperformance is an invented one and as the Complainant says is fancy and distinctive. It seems highly unlikely that the Respondent would have chosen to register the Domain Name without prior knowledge of the Complainant’s existence and their name and brand. In any event the Respondent has chosen not to reply either to the Complainant’s letter before action or to the Complaint. Thus on the balance of probabilities the Expert is of the view that the Respondent would have known of the Complainant at the time that it registered the Domain Name and thus had the requisite knowledge and intention.

The Respondent has not and is not using the Domain Name. It directs to the register Crazy Domain’s holding page. The Complainant asserts therefore that the Respondent has no apparent interest in holding the contested Domain Name and alleges that the Respondent has no rights or legitimate interest in respect of the Domain Name. Once again the Expert finds that on the evidence on a balance of probabilities that these assertions are established.

As regards whether the Domain Name is a blocking registration it is necessary for the Expert to be satisfied that the registration takes unfair advantage of or is causing unfair detriment to the Complainant’s Rights. The Expert refers to the previous DRS decision in the *Proctor & Gamble Company v. Anne-Marie Morgan* (DRS02572). This case dealt with the domain name pringles.co.uk (“the Pringles Domain Name”). In that case as is the position here with Teleperformance, Pringles clearly was an inventive name. It was also the case that the Respondent was held to have been aware of Pringles denoting the Complainant’s products when it registered the Pringles Domain Name. Neither had it established a legitimate business under the domain name. The Pringles Domain Name pointed to a web hosting page. Although the Respondent did file a Response and alleged that it had a legitimate interest in the domain name, it did not put forward a credible explanation in circumstances where the brand was a famous one to properly support its position. The Expert held there that it was a blocking registration.

In this case of course no such explanation has been put forward at all.

Also in the *embroidme.com Inc v. Martyn Young* (DRS 03813) case reliance was placed upon a blocking registration as being the ground for transfer. That case refers in turn to two previous DRS cases which discuss what is required to establish a blocking registration. In the case of the later decision of *Thomas Cook (UK) Limited v. Whitley Bay* (DRS00583) the Expert defined what was required for a blocking registration as follows:

*“It seems to be that there are two critical features of a “Blocking Registration”. The first is that it must be against the name or mark in which the Complainant has Rights. The second one is one of motivation. Where the registration is alleged to be a “Blocking Registration”, a Complainant, if it is to succeed must prove on the balance of probabilities that a Respondent’s principal objective in the registering or retaining of the disputed domain name was to prevent the Complainant from doing so. The absence of any use of the site by the Respondent for a legitimate business and*

*other purpose of its own may assist in establishing the motivation, but the absence of any such use does not necessarily rule out legitimate interest.”*

Here of course the disputed Domain Name is not being used for a legitimate or any other purpose. It would appear however that this alone is not sufficient to establish there is no legitimate interest. In the Embroidme.com case there was no direct evidence of the Respondent’s motivation albeit it had not used the Domain Name. Paragraph 3b of the Policy specifically does not allow the Expert to rely solely upon the Respondent’s failure to use the Domain Name as evidence of an Abusive Registration. In the Embroidme.com case however the Expert went on to find that it was a blocking registration on the basis of the uniqueness of the mark and *“the fact that the Complainant was a worldwide franchise operation with plans to expand in the UK”*. The Expert held on those facts that he would find it difficult to conceive of any legitimate reason why the Respondent would have wanted to register the domain name except to prevent the Complainant from having it. In addition the Respondent had not offered to rebut that finding by for example showing that he had put the Domain Name to legitimate use.

In this case the Expert has found that the Respondent, on the balance of probabilities, would have known of the existence of the Complainant and its brand name before registering the Domain Name. Furthermore she has have found that the brand name TELEPERFORMANCE is a unique and fancy word, and is also well-known on a global basis. Thus like the Expert in Embroidme.com case it seems difficult to conceive of any legitimate reason why the Respondent would have wanted to register the Domain Name except to prevent the Complainant from having it. In those circumstances I find that the Respondent’s registration and use of the Domain Name constitutes an Abusive Registration, under paragraph 3a(i)(B) of the Policy.

## **9 Decision**

The Expert finds that the Complainant has established for the purposes of the Policy 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. The Complainant therefore succeeds and I direct that the Domain Name be transferred to the Complainant.

**Signed .....**

**Dated .....**

GILL GRASSIE

16 APRIL 2013