

# DISPUTE RESOLUTION SERVICE

**D00016908**

## Decision of Independent Expert

Yahoo! Inc.

and

Prakhar Rastogi

### 1. The Parties

Complainant: Yahoo! Inc.  
701 First Avenue  
Sunnyvale  
Santa Clara  
94089  
United States

Respondent: Prakhar Rastogi  
Uttar Pradesh  
India

### 2. The Domain Names

yahoocustomercare.co.uk  
yahoophonenumbr.co.uk  
yahoosuport.co.uk

(‘the Domain Names’)

### **3. Procedural History**

Nominet checked that the complaint received on 4 January 2016 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 so mediation was not possible and, on 27 January, 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 3 February.

On the same day I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I have confirmed 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 into question my independence in the eyes of one or both of the parties.

### **4. Factual Background**

I have visited the websites at the Domain Names and the Complainant's main website at yahoo.com. From those visits, the complaint and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant is a US technology company with offices throughout the Americas, the Asia Pacific region, Europe, the Middle East and Africa. Through a range of digital services, including a web portal and email, it seeks to build value, and ultimately make money, by creating personalised experiences for internet users.

The 'YAHOO!' mark has been in continuous use since at least 1994 and 'Yahoo' is regularly judged to be a recognisable global brand. The complaint cites several brand ranking indices that include Yahoo in the top few entries.

In Europe, the Complainant has at least ten entries, across at least 45 classes, in the Office for Harmonization in the Internal Market's Register of Community Trade Marks, for the word YAHOO! (Certified copies of the Complainant's Community trade marks are attached to the complaint.) All of these registrations were effective before August 2015, with the earliest in the year 2000.

The Complainant registered <yahoo.com> in January 1995 as its primary domain name. Since September 1996 it has been using <yahoo.co.uk> for its UK and Ireland website. The Domain Names were all registered in August 2015 (<yahoocustomer care.co.uk> on the 22<sup>nd</sup>, <yahoophonenum ber.co.uk> on the 8<sup>th</sup> and <yahoosupport.co.uk> on the 5<sup>th</sup>).

At the time of the complaint, the websites to which the Domain Names resolve pointed to a prominent ‘toll-free’ telephone number and contained a ‘disclaimer’ in the following terms:

We are an independent service provider remote tech support for third party products. Third party trademarks Logo, brand name, Product and services are used as references for informational purpose. only. In one way we sponsor their product or services. Thus. We retry disclaim and sponsorship. a Dilation and endorsement of or by a d such third. (*sic*)

On the web page at <yahoocustomer care.co.uk> there was text saying that the service being offered is a more concise form of help than would be available through the Complainant’s own tutorials. Text at the website at <yahoophonenum ber.co.uk> said that callers to Yahoo’s own telephone help can be left waiting too long. The web page at <yahoosuport.co.uk> referred to help ‘dealing with performance breaks or error codes hindering the functioning of Yahoo email and other services’.

Between September and November 2015, the Complainant’s legal advisers wrote to a succession of hosting service providers, saying that the websites at the Domain Names contained content that took advantage of their client’s rights. On each occasion, as the hosting service gave the Respondent the opportunity to defend its position, the Respondent chose to move the websites to another hosting service provider.

## **5. Parties’ Contentions**

### *Complaint*

The Complainant says it has rights in the name Yahoo and that the Domain Names, being made up of that name, plus merely a generic or descriptive modifier, are similar to the name in which it has rights.

It argues that the Domain Names are abusive registrations because the Respondent:

- (i) registered them for the purposes of unfairly disrupting its business.
- (ii) is using the Domain Names in a way that has confused or is likely to confuse people or businesses into believing that they are connected with the Complainant, and is doing so for its own financial gain at the expense of the Complainant and its users. It says that the Respondent is not offering a genuine service through the websites at the Domain Names but instead is using them to get personal information and remote access to computers for the purposes of fraud. The Complainant refers to a complaint made by a Yahoo user to the Consumer Protection Bureau at the Office of the Attorney General, Illinois. The person making the complaint could not log in to her Yahoo account and so searched for ‘Yahoo

Customer Support Phone Number'. The top link apparently led to a website at <yahoo-support-number.com>. She dialed the phone number shown and spoke to someone who took remote control of her computer, charged her 499.99 US dollars and got her bank details.

- (iii) is engaged in a pattern of registering domain names corresponding to well-known names in which it has no apparent rights – including

gmailhelpdesknumber.com  
kindlesupport.co.uk  
kindlesupport.org

and the Domain Names are part of that pattern.

- (iv) has moved the websites at the Domain Names between hosting providers after being threatened with termination of hosting services, rather than defend his position. The Complainant's implication is that the Respondent's position is indefensible because the registrations are abusive.

#### *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 Names; and that
- the Domain Names, in the hands of the Respondent, are abusive registrations.

#### *Rights*

The Complainant has been using the Yahoo name, including in the UK, for around twenty years and in doing so has established a global reputation in its brand. It has a range of Community trade mark registrations for the name Yahoo. It clearly has both registered and unregistered rights in Yahoo.

Ignoring the .co.uk suffix as simply a characteristic of Nominet's domain name register, the Domain Names combine the name Yahoo with the modifiers 'customercare', 'phonenumber' and 'support', respectively. Those seem to me to be generic qualifiers (one containing a minor typographical error) that, in context, do nothing to diminish the distinctive quality of the word Yahoo. The Yahoo name appears to me to be similar to the Domain Names.

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

### *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 contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration and the complaint here reflects three of those factors: that the Domain Names were acquired primarily for the purpose of unfairly disrupting the Complainant's business; that the Respondent is using the Domain Names in a way which has confused or is likely to confuse people into believing that there is some connection with the Complainant; and that the Respondent is engaged in a pattern of registrations where he is the registrant of domain names corresponding to well known names in which he has no apparent rights and the Domain Names are part of that pattern. The Complainant then points to the Respondent's decision to move hosting service provider rather than defend its position, as an indication that even he recognises that the Domain Names are abusive registrations.

I can take each of those arguments in turn, but look at the first two together because much of the evidence and argument on them is inter-related.

### Unfair disruption and confusion

The complaint makes the general point that, in use, the Domain Names are likely to be disruptive to the Complainant's business. It includes much detail about the content of the web pages to which they resolve, arguing that, despite the disclaimer that appears on each of the landing pages, the overall effect is to create the impression that the Domain Names are connected with the Complainant. Despite the fact that the main example of actual confusion offered here, of the customer searching for 'Yahoo Customer Support Phone Number', leads to a website at <yahoo-support-number.com> rather than to the Domain Names, the potential for disruption and confusion feels undeniable. Even if the disclaimer were effective in countering any confusion, by then it would be too late.

It is difficult to take a firm view about why the Domain Names were registered in the first place – and specifically whether or not that was to disrupt the Complainant's business – because the evidence of illegitimate activity contained in the complaint is not linked directly to these Domain Names and this Respondent. It appears to me at least possible that the Respondent is

offering a genuine service to Yahoo customers that does not rely on disrupting Yahoo's business. But that does not dispose of the charge that the Respondent is using the Domain Names in a way that is going to confuse internet users into thinking they are going to a website that is run by or in some way connected with the Complainants.

### Pattern

There is a mass of detailed evidence intended to demonstrate the common registrant behind a number of domain name registrations said to be affecting the Complainant's business. The main difficulty with this line of argument is that the complaint appears to have been formulated in relation to disputes involving more than one respondent and different top level domains (notably .uk and .com) - with the effect of losing the connection between these specific Domain Names and other registrations. The complaint describes lots of smoke without pinpointing the source of any relevant fire.

### Response when challenged through hosting service provider

I note the Respondent's changing of his hosting service providers, when those providers were contacted by the Complainant's legal representatives. That may help establish an implication that the Respondent feels he does not have a strong defence against the claim that the Domain Names are abusive registrations, although I do not regard it as a significant factor in the judgement to be made here – which in fact seems to me clear cut without this additional factor.

### Overall

Cases decided within the DRS show that it is not automatically abusive to include in a domain name a name in which someone else has rights. It will depend upon the facts. Section 3.3 of the *Experts' Overview* says:

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...

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). ... However, the activities of typosquatters are generally condemned...as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity.

This seems to me to cover the situation here. The mis-spelling of 'support' in one of the Domain names is typical of typosquatting and the 'appendages' to the Yahoo name ('customercare', 'suport/support' and 'phonenumber') are appropriate to the Complainant's field of activity. It does not matter that any confusion is dispelled on arrival.

Whatever the Respondent's underlying motivation, it seems plain that, in both registering and using the Domain Names, he has taken the Complainant's Yahoo brand and implied a connection with the Complainant. Whether or not the disclaimer is effective in belatedly removing any confusion, that takes advantage of the Complainant's rights and in my judgement the advantage taken is plainly unfair.

## **7. Decision**

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

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

**Mark de Brunner**

**27 February 2016**