



DISPUTE RESOLUTION SERVICE

D00016910

Decision of Independent Expert

Yahoo! Inc.

and

sanjay soni

1. The Parties:

Lead Complainant: Yahoo! Inc.

701 First Avenue

Sunnyvale

Santa Clara

94089

United States

Respondent: sanjay soni

A-133 gzb

A-133 gzb

gzb

Uttar Pradesh

201001

India

2. The Domain Name(s):

yahoosupportnumbers.co.uk

yahoosupports.co.uk

3. Procedural History:

I can 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 in to question my independence in the eyes of one or both of the parties.

05 January 2016 10:02 Dispute received

05 January 2016 12:47 Complaint validated

08 January 2016 10:39 Notification of complaint sent to parties

27 January 2016 01:30 Response reminder sent

01 February 2016 11:51 No Response Received

01 February 2016 11:51 Notification of no response sent to parties

03 February 2016 09:31 Expert decision payment received

4. Factual Background

The Complainant needs little introduction. It is a US company incorporated in Delaware with offices in various other countries and commenced use of the domain name yahoo.com as its primary domain in January 1995. Its trade mark YAHOO! has been in use since 1994 and has been acknowledged in various guides/rankings as one of the most valuable brands in the world.

It has an extensive trade mark portfolio, including many Community Trade Mark registrations for the mark YAHOO!.

Both Domain Names were registered on 3 October 2015. They are directed to websites which purport to offer support services to the Complainant's customers. The Complainant asserts that the Respondent is pretending to be the Complainant and further, that it has deceived the Complainant's customers into giving the Respondent access to the Complainant's customers' computers and/or personal information and is defrauding such customers for financial gain. The Complainant has been notified by the Consumer Protection Bureau, Office of the Attorney General, and Illinois of an example whereby a customer in the US was defrauded of \$499.99 by an organisation in the US which purported to be the "Yahoo Customer Support Phone Number" which the Complainant believes to be connected with the Respondent.

5. Parties' Contentions

In support of its claim to Rights, the Complainant relies upon its registered trade mark. It asserts that the Domain Names will be seen by internet users as its mark coupled with descriptive words.

In support of the claim that the Domain Names are Abusive Registrations the grounds relied upon by the Complainant are:

- (i) that they are disrupting the business of the Complainant;
- (ii) that they will confuse or are likely to confuse people into believing that they are registered to, operated, authorised or connected to the Complainant;

6. Discussions and Findings

a. General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Names; and
- (ii) the Domain Names in the hands of the Respondent are Abusive Registrations (as defined in paragraph 1 of the Policy).

Notwithstanding the failure by the Respondent to file a Response, the burden of proof as set out above remains on the Complainant, however the Expert is entitled to take into consideration when making his determination that the Respondent, despite having the opportunity to do so, has not availed himself of the opportunity to rebut the allegations that have been made by the Complainant.

b. Complainant's Rights

The DRS Policy defines Rights as follows:

"Rights means rights enforceable by the Complainant whether under English law or otherwise and may include rights in descriptive terms which have acquired a secondary meaning".

In my view the Complainant has shown that it has Rights as a result of its trade mark registration(s) and as a result of the extensive use and promotion of the mark YAHOO!.

For the purpose of analysing whether the Domain Names are identical or similar to the name or mark in which rights are claimed, one should ignore the .co.uk suffix. The comparison is therefore between 'YAHOO!' on the one hand, and 'YAHOOSUPPORTNUMBERS' and 'YAHOOSUPPORTS' on the other. I accept that the addition of descriptive words does little to dispel the similarity between the mark and the Domain Names and in my opinion the Complainant has established that it has Rights in a mark similar to the disputed Domain Names.

a. Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainant asserts that the Domain Names are an Abusive Registration for the reasons identified above.

The 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration.

In most circumstances where a respondent has registered a domain name that is identical or similar to a name or mark in which the complainant has rights, the name or mark is well known or distinctive and the complainant and mark were known to the respondent, one would be unlikely to have a great deal of difficulty in concluding, as many Experts have previously, that the relevant domain name would be an abusive registration and indeed that is the case here. On the basis of the evidence that has been submitted by the Complainant, I am satisfied that the use being made of the Domain Names by the Respondent deceives the Complainant's customers. It would be difficult to conceive of circumstances more abusive than in the present case where the Domain Names contains the Complainant's trade mark and the Respondent is in effect pretending to be the Complainant. There is no question in my mind that the Respondent's use of the Domain Names falls foul of paragraph 3(a)(i)(C) of the Policy, namely *it was registered "for the purposes of unfairly disrupting the business of the Complainant"* and paragraph 3(a)(ii) of the Policy, namely *"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". Given the seriousness of the allegations that have been made by the Complainant, I have factored into my analysis that despite being given the opportunity to rebut those allegations, the Respondent has not done so and as such I have not been provided with any information or evidence that would enable me to reach a contrary conclusion.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name which is similar to the Domain Names <yahoosupportnumbers.co.uk> and <yahoosupports.co.uk> and that the Domain Names in the hands of the Respondent are Abusive Registrations. The Complaint therefore succeeds and I direct that the Domain Names be transferred to the Complainant.

Signed Simon Chapman

Dated 03 March 2016