

DISPUTE RESOLUTION SERVICE

DRS 20934

Decision of Independent Expert

O2 Worldwide Limited

Complainant

and

Alan Haynes

Respondent

1 The Parties

Complainant:	O2 Worldwide Limited
Address:	20 Air Street London W1B 5AN United Kingdom

Respondent:	Alan Haynes
Address:	Sheraton House Lower Road Chorleywood Hertfordshire WD3 5LH United Kingdom

2 The Domain Name

o2travel.co.uk (the "Domain Name").

3 Procedural History

I 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, which need be disclosed as being of such a nature as to call into question my independence in the eyes of one or both of the parties.

18 December 2018	Dispute received
19 December 2018	Complaint validated
19 December 2018	Notification of complaint sent to parties
19 December 2018	Response received
19 December 2018	Notification of response sent to parties
26 December 2018	Reply reminder sent
27 December 2018	Reply received
27 December 2018	Notification of reply sent to parties
3 January 2019	Mediator appointed
3 January 2019	Mediation started
29 May 2019	Mediation failed
29 May 2019	Close of mediation documents sent
4 June 2019	Expert decision payment received
1 July 2019	Expert requests further statement from Complainant
16 July 2019	Notification of 17.1 request sent to the parties
19 July 2019	Further submission received from Complainant
22 July 2019	Expert notified of further submission from Complainant
23 July 2019	Respondent requested to make any submissions in reply
23 July 2019	Submissions in reply received from Respondent

4 Factual Background

- 4.1 The Domain Name was registered by the Respondent on 5 December 2008.
- 4.2 The Complainant, O2 Worldwide Limited, operates a mobile telephone network and provides related products and services under the O2 brand.
- 4.3 The Respondent is a travel agent who was director, company secretary and majority (or possibly sole) shareholder of a travel agency named O2 Travel Limited, which was incorporated on 25 November 2009 and dissolved on 10 April 2018, according to the public records of Companies House.
- 4.4 The Domain Name currently points to a pay-per-click parking page.

5 Parties' Contentions

Complaint

- 5.1 The Complaint is supported by a number of exhibits, including in particular a 63 page witness statement of uncertain date (the manuscript date is illegible) which appears to have been drafted and executed for the purposes of unrelated UDRP proceedings in respect of the domain name *O2prepaid.com*.
- 5.2 Some text (it is unclear how much) is missing from the start of the Complaint.

- 5.3 The Complainant describes itself as "one of the most important players in the mobile telecommunications field". It asserts that it has a large retail network within the UK and also operates through its website at URL *www.o2.co.uk*. The Complainant says that it owns the O2 brand which was ranked as one of the top 180 most valuable brands in the world and that it has won many awards. It says that it owns many registered trade marks for or including the elements "O2" and "The O2". A list of such UK and EU trade marks is set out in Annex 3, though the proprietor of those marks is not in any instance identified.
- 5.4 Entries from the IPO and OHIM registries, which appear to have been downloaded eight years ago in 2011, are also annexed to the Complaint. However, none of those trade marks are in fact registered to the Complainant. They are all registered to an entity named O2 Holdings Limited.
- 5.5 The Complainant says that it has, in addition, acquired certain rights previously owned by a US company, Locus Telecommunications, in the O2 mark in the United States. The Complainant says that "any rights in this mark are now owned by the Complainant". No evidence of such ownership of the O2 mark in the United States is provided.
- 5.6 The Complainant contends that its "earlier" rights are confusingly similar to the Domain Name. It asserts that "it is undoubted" that anybody would assume that the Domain Name related to a website operated by it, for example relating to its roaming policy or informing people how to use their mobile phones abroad. It says that a person looking for information on the travel policy of O2 (it is not explained which entity this is intended to refer to) would logically visit a website using the Domain Name. It is said that this is particularly the case because the O2 element is the dominant and distinctive element in the Domain Name.
- 5.7 The contentions set out above are said to constitute the rights asserted by the Complainant, though plainly the submissions summarised at 5.6 above in fact relate to the question of Abusive Registration.
- 5.8 As to Abusive Registration (as defined in the Policy, see 6.2 below), the Complainant puts its case on a number of bases, in addition to that mentioned above. The Complainant's submissions are unstructured and muddled. However, its case appears to be that:
- 5.8.1 the Respondent has no legitimate interest in the Domain Name because his name "does not appear to relate to the Domain Name in any way";
 - 5.8.2 the Respondent had no reason to register the Domain Name except to refer to the Complainant, or to benefit from the Complainant's O2 mark, or to "interrupt or block" the Complainant's business in the UK;
 - 5.8.3 the fact that the Domain Name directs to a pay-per-click page "appears to show" that the Domain Name was registered with the object of "generating income off the reputation of the Complainant";
 - 5.8.4 the Respondent is attempting to "generate income off the confusion" between the Domain Name and the Complainant's O2 brand;
 - 5.8.5 the Domain Name was acquired primarily for the purpose of selling, renting or otherwise transferring it to the Complainant or to a competitor of the Complainant;
 - 5.8.6 the Domain Name has never been used for a legitimate website, but only for click-through advertising; and

- 5.8.7 the Domain Name was registered to attract internet users to his website for commercial gain by creating a likelihood of confusion as to the "source, sponsorship, affiliation or endorsement".
- 5.9 The Complainant contends that the Domain Name is therefore an Abusive Registration by reference to the circumstances set out in paragraphs 3(a)(i)(A), 3(a)(i)(B), 3(a)(i)(C), and 3(a)(ii) of the DRS Policy. Those references are unhelpfully to a now out-of-date version of the Policy, which has not been in force since September 2016.

Response

- 5.10 The Response is as pithy as the Complaint and its exhibits are prolix. The Respondent points out that the Complainant was only formed on 15 July 2015. He says that the Domain Name was registered "around the time" he incorporated O2 Travel Limited in 2009, and that that company traded profitably for a number of years before he "sold the goodwill" prior to its dissolution in April 2018.
- 5.11 He says that he is the director of another travel company, Ultimate Destinations (UK) Limited, which was incorporated on 6 March 2012. He says that he was a sole trader from 1 April 1994. It is not explained under what or whose name he traded in that regard.
- 5.12 The Respondent says that his plan and intention is to set up "a travel website" using the Domain Name "with O2 being aspirational/to dream, oh to travel".
- 5.13 The Respondent says that he is not somebody who registers domain names to sell them on and that he considers that the Complaint is an example of a big company "bullying, trying to muscle in on the travel industry".

Reply

- 5.14 The Complainant acknowledges that it was incorporated only in July 2015, but asserts that "the trade marks rights and the goodwill in the mark O2" were previously "held" by O2 Holdings Limited and, before that, by O2 Limited from 2001 and "transferred to O2 Worldwide Limited". No evidence of any such assignments or transfer is provided. Nonetheless, the Complainant asserts that "the rights" in O2 predate registration of the Domain Name and that "as such, it is clearly the case that the Complainant predates the registration of this Domain Name".
- 5.15 Further, it asserts that it "has rights in relation to travel, in class 39, that predate the registration of this domain name". Again, no evidence is provided. It contends that inclusion of the word "travel" in the Domain Name and the Complainant's "earlier marks" in relation to travel services "clearly demonstrates that the Complainant had earlier rights at the point of registration of this domain".
- 5.16 The Complainant repeats its earlier contention that the Respondent is generating advertising revenue from the Domain Name "which is likely being driven by confusion created with the Complainant's prior trade mark rights and goodwill in the mark O2". It says that the Domain Name is not being used for "legitimate business purposes".
- 5.17 The Complainant is sceptical about the Respondent's intended use of the Domain Name, pointing out that he could have used the character string "ohtotravel" if he had been acting entirely in good faith.

- 5.18 The Complainant acknowledges that a company named O2 Travel Limited has been incorporated, but has not been able to find any evidence of a successful business being operated under that name.
- 5.19 The Complainant rejects the allegation of bullying.

Further submission from Complainant pursuant to Rule 17.1

- 5.20 On 1 July 2019 the Expert made a request, pursuant to paragraph 17.1 of the Policy, for the Complainant (a) to provide a further statement and/or document(s) to explain and evidence on what basis it claims to own the requisite rights in the O2 name or mark, given that the evidence of registered trade marks relied on in the Complaint identified the owner in each case as O2 Holdings Limited, not the Complainant; and (b) to provide a complete copy of the Complaint in light of the text missing from the copy filed with the DRS.
- 5.21 On 19 July 2019 the Complainant's representative apologised for "the oversight and the confusion caused regarding the ownership of the trade mark registrations cited". The Complainant said that it was "the successor of O2 Holdings Limited regarding the ownership of the O2 brand". It says that "as of 31 December 2015 the majority of the trade marks rights owned by O2 Holdings Limited were transferred to O2 Worldwide Limited, and the goodwill passed from O2 Holdings Limited to O2 Worldwide Limited following the transfer".
- 5.22 Accordingly, it said that the registered trade marks listed in Annex 3 to the Complaint "are in fact now owned by O2 Worldwide Limited following the assignment of these rights".
- 5.23 Updated registration details from the UK IPO, EU IPO and US PTO registers were provided, all of which this time identified the Complainant as the relevant proprietor.
- 5.24 No complete copy of the Complaint was provided.

Response to Complainant's 17.1 statement

- 5.25 On receipt of the above further statement, on 22 July 2019 the Expert invited the Respondent to make any further submissions in reply. On 23 July 2019 the Respondent provided a brief further submission.
- 5.26 The Respondent contended that he has never laid claim to the O2 brand. He has rights only in the O2Travel brand which he contends is a trading name of Ultimate Destinations. A link is provided to the ABTA website page of Hays Travel Limited which describes Ultimate Destinations (UK) Limited as "also trading as O2 Cruise, O2 Ski, O2 Travel, Ultimate Cruise, Ultimate Destinations".
- 5.27 The Respondent says that when O2 Travel Limited was dissolved he "moved the Domain Name to Ultimate Destinations" and has taken steps and incurred costs to develop that brand. No evidence of any such steps or costs is provided.
- 5.28 The Respondent contends that the Complainant is using "expensive solicitors to batter people into submission" and says that "they made me a derisory offer for the Domain, which I found didn't even cover my costs and time that I have invested in the brand".

6 Discussions and Findings

General

- 6.1 To succeed under the DRS Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (Policy, 2.1.1), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (Policy, 2.1.2).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

"Abusive Registration means 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) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's rights

- 6.3 Paragraph 2.1.1 of the Policy requires the Complainant to prove that it *"has Rights in respect of a name or mark which is identical or similar to the Domain Name"*. "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"* (Policy, 1).
- 6.4 The Complainant appears to rely on both registered and unregistered rights in the O2 mark. All the Complainant has to say on the latter point is that it is "the successor of O2 Holdings Limited regarding the ownership of the O2 brand". No further explanation, let alone any evidence of any transfer of trading goodwill, is provided.
- 6.5 However, given that it has, belatedly, provided evidence that it owns a number of registered UK and EU trade marks in the O2 mark, the question of unregistered rights, and in particular the extent to which they attach to the Complainant and not one of the predecessor corporate entities, is moot. The updated copy entries from the UK and EU IPO suffice to demonstrate that the Complainant is the proprietor of the O2 registered trade mark in various forms and classes.
- 6.6 In addition to the O2 mark, the Domain Name incorporates the suffix TRAVEL. The dominant part of the Domain Name in a trade mark or distinctive sense is the word O2. TRAVEL is a descriptive dictionary word.
- 6.7 As the Experts' Overview (available on the DRS website) makes clear, such *"additional elements rarely trouble experts"*. There are numerous decisions which have found that the inclusion in a domain name of such suffixes (or prefixes) after (or before) a mark is insufficient to distinguish it from the mark in which the complainant has rights. Examples include: *O2help.co.uk* (DRS 18087), *michelinpossible.co.uk* (DRS 20122), *aramcoshares.co.uk* (DRS 20131), *pepsicofinance.co.uk* (DRS 20512), *veluxblind.co.uk* (DRS 06973) and *ihateryanair.co.uk* (DRS 08527).
- 6.8 It is well established under the DRS that the first and second level domains (i.e. *co.uk*) may be ignored for the purposes of similarity.

- 6.9 The Complainant has therefore satisfied paragraph 2.1.1 of the Policy and demonstrated that it has Rights in a name or mark which is identical or similar to the Domain Name.

Abusive registration

- 6.10 The Complainant puts its case on Abusive Registration on four bases:
- 6.10.1 registration primarily for the purpose of selling the Domain Name to the Complainant (Policy, 5.1.1.1);
 - 6.10.2 registration primarily to block Complainant's use of mark (Policy, 5.1.1.2);
 - 6.10.3 registration primarily unfairly to disrupt Complainant's business (Policy, 5.1.1.3); and/or
 - 6.10.4 use or threatened use causing confusion or likelihood therefore (Policy, 5.1.2).
- 6.11 Paragraph 5.1.1.1 of the Policy includes as a factor which may be evidence that a domain name is an Abusive Registration circumstances indicating that the respondent has registered or otherwise acquired the domain name primarily for the purposes of selling, renting or otherwise transferring it 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.
- 6.12 The Complainant makes no substantive case, beyond a mere assertion, in this regard. No evidence is provided that this was a motivation, let alone a primary motivation, for the Respondent's registration of the Domain Name. Nor is there any circumstantial evidence from which such an inference may be drawn, for example an unsolicited demand for payment by the Complainant in return for transferring the Domain Name to it.
- 6.13 Paragraph 5.1.1.2 of the Policy includes as a factor which may be evidence that a domain name is an Abusive Registration circumstances indicating that the respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the complainant has Rights.
- 6.14 Again, no case is made in this regard, beyond the Complainant's mere assertion that the Domain Name "is clearly an attempt to block the Complainant's business in the UK, and/or interrupt it". Again, no evidence is provided that this was, or may have been, the Respondent's motivation at the time he registered the Domain Name.
- 6.15 Paragraph 5.1.1.3 of the Policy includes as a factor which may be evidence that a domain name is an Abusive Registration circumstances indicating that the respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the complainant's business.
- 6.16 The Complainant does not explain or evidence how or why this was the Respondent's primary purpose in registering the Domain Name.
- 6.17 Paragraph 5.1.2 of the Policy includes as a factor which may be evidence that a domain name is an Abusive Registration circumstances indicating that the respondent is using or threatening to use the domain name in a way which is confusing 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.
- 6.18 This factor appears in reality to be the only, or at least the main, focus of the Complainant's case. The Complainant puts it a number of different ways, but is essentially arguing that the

Respondent is obtaining a financial benefit from pay-per-click advertising by trading on the Complainant's reputation and/or confusing internet users in his use of the O2 mark in the Domain Name.

- 6.19 The Respondent does not challenge the Complainant's assertion that he is deriving financial benefit from his use of the Domain Name. His explanation that he intends to set up a travel website "with O2 being aspirational/to dream, oh to travel" is implausible. His reliance on an ABTA website describing his company Ultimate Destinations (UK) Limited as also trading inter alia as O2 Cruise, O2 Ski and O2 Travel does not assist his cause, tending to suggest, as it does, that the Respondent is cavalier in his use of marks owned by others, particularly where the Complainant has EU and UK registered trade marks for O2 in class 39 for the provision of information relating to transport and travel.
- 6.20 No evidence is provided by the Respondent of any trading goodwill attached to his company O2 Travel Limited, or indeed of it having traded at all, before its dissolution in April 2018.
- 6.21 The factors which may be evidence of Abusive Registration set out in section 5 of the Policy are non-exhaustive. Ultimately, in this regard, the question is whether the Domain Name was registered or used in a way which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. The use of such a well known brand to generate pay-per-click advertising would seem to take unfair advantage of the Complainant's Rights in that mark. The Respondent has failed to prove any legitimate use of the Domain Name (in the sense of it not being an Abusive Registration under the Policy).
- 6.22 The Complainant has therefore, on the balance of probabilities, demonstrated Abusive Registration pursuant to paragraph 2.1.2 of the Policy.

7 Decision

- 7.1 The Expert accordingly finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name, and that the Domain Name is, in the hands of the Respondent, an Abusive Registration.
- 7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

David Engel

Signed

Dated 31 July 2019