

DISPUTE RESOLUTION SERVICE

D00022211

Decision of Independent Expert

O2 Worldwide Limited

and

Yeats

1. The Parties:

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

Respondent: Yeats
London
WC2
United Kingdom

2. The Domain Name(s):

billing-o2.co.uk

3. Procedural History:

The Expert has confirmed (1) he is independent of each of the parties; and (2) to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, which need to be disclosed because they might be of such a nature as to call into question his independence in the eyes of one or both of the parties.

08 January 2020 14:51 Dispute received
09 January 2020 11:46 Complaint validated
09 January 2020 11:50 Notification of complaint sent to parties
28 January 2020 01:30 Response reminder sent
31 January 2020 14:14 No Response Received
31 January 2020 14:14 Notification of no response sent to parties
11 February 2020 15:09 Expert decision payment received

4. Factual Background

The Complainant is the IP holding company of the O2 Group of telecommunications companies. It owns many trade mark registrations for and including the element O2.

It is not clear whether the Respondent “Yeats” is an individual or a separate legal entity of some kind. For the purposes of this decision the former will be assumed. The Respondent is the registrant of the Domain Name. The Domain Name is currently suspended, and whilst its registration date of 19 March 2019 is provided through a WHOIS search result, the Expert has no information about how it has been used since registration.

5. Parties’ Contentions

The Complainant

The Complainant relies upon a witness statement which is 63 pages long, first provided in connection with a previous (unconnected) UDRP dispute, although here without exhibits (which the Complainant says is in order not to provide more material than is necessary). It offers to provide further material if required. The witness statement has been drafted in connection with a different set of facts. However, other than a change of ownership of IP rights within the O2 Group subsequent to those proceedings under which the IP rights were assigned to the current Complainant (which is explained in the Complaint), the witness statement provides substantial support for the extent and nature of the Rights upon which the Complainant relies. The Complainant has previously relied upon the same witness statement in two DRS disputes, in both of which it succeeded. This Complaint is not defended by the Respondent. Therefore, the Expert proposes only to summarise that material briefly.

Rights

The Complainant together with the other companies within the O2 Group is one of the most important players in the mobile telecommunications field. The O2 brand is extremely well-known in the telecommunications sector, as well as the

entertainment and music sectors. It operates through its website www.o2.co.uk and owns a large retail shop network within the UK and elsewhere.

The Complainant exhibits many of its trade mark registrations from both UK and international databases, including many trade marks for the O2 brand itself.

In a recent survey the O2 brand was ranked as one of the top 180 most valuable brands in the world.

The Complainant's Rights pre-date the registration of the Domain Name, and the Complainant says that those are confusingly similar to the Domain Name. O2 is the dominant and distinctive element of the Domain Name, and the addition of "billing" in the Domain Name is descriptive of the kind of billing services (allowing payment of bills, or providing information about billing) which customers would expect the Complainant to provide as part of its various business activities.

Abusive Registration

There is no legitimate reason for the Respondent to register the Domain Name, except to refer to the Complainant. The Respondent must be intending to benefit in some way from the Complainant's brand, or to interrupt or block the Complainant's business in the UK. The lack of content in the use of the Domain Name reinforces this lack of legitimate reason for registration. Alternatively, the intended use could be to damage the Complainant either by the Domain Name being sold to a competitor, or possibly used for phishing.

Any use of the Domain Name for the purposes of an active website would be bound to lead to consumers being confused as to the source, sponsorship, affiliation or endorsement of that website, or product or service on that website.

The Complainant therefore seeks transfer to itself.

The Respondent

The Respondent has not replied to these proceedings.

6. Discussions and Findings

In order to succeed in its Complaint, in accordance with the Policy, the Complainant needs to establish:

- "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."*

The Complainant needs to establish both elements on the balance of probabilities.

The definition of Abusive Registration under the Policy is as follows:

“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”.*

The definition of Rights under the Policy is 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.”

Rights

The Complainant has provided ample evidence of the substantial extent of its reputation in the O2 brand, and its registered rights in the same. The Expert agrees with the Complainant that the addition of “billing” within the Domain Name can only be ancillary to the O2 brand itself, and likely to be regarded by consumers as descriptive. As is noted in Paragraph 2.3 of the Experts Overview, such additional elements do not usually trouble experts when looking at similarity.

In this case, although the Domain Name and the Complainant’s brand O2 are not identical, the Expert has no difficulty in deciding that the Complainant has Rights in the name or mark O2 which is similar to the Domain Name.

Abusive Registration

The Complainant relies upon each of the following paragraphs of the DRS Policy as evidence of an abusive registration:

“3 (a)(i): There are 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; or*
- 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.*

3(a)(ii): There are circumstances indicating that the Respondent is using 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 Complainant’s submissions are in summary that the Respondent had no reason to register the Domain Name except to capitalise in some improper way from the Complainant’s Rights in the O2 mark. The Domain Name must therefore fall within one or other of the paragraph 3(a)(i) grounds. Further, there is no way in which the Respondent could use the Domain Name without it falling foul of paragraph 3(a)(ii).

The Respondent has not replied to the Complaint, but the Complainant must still establish its case on the balance of probabilities. In this case, the Expert has sympathy with both of the Complainant’s contentions, in the absence of any alternative explanation from the Respondent. Indeed, the Expert cannot conceive of any legitimate grounds for the Respondent registering the Domain Name when the only elements it contains are the well-known and distinctive brand O2 and a reference to a service or function quite clearly connected and ancillary to the Complainant’s primary businesses. The registration of the Domain Name by the Respondent is therefore abusive and the Complaint succeeds.

7. Decision

The Expert finds that the Complainant has Rights in the name or mark O2 which is similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Complaint therefore succeeds and the Domain Name should be transferred to the Complainant.

Signed: Bob Elliott

Dated: 2 February 2020