

## DISPUTE RESOLUTION SERVICE

D00008690

Decision of Independent Expert

ITV Consumer Limited

and

Lian Hua

### 1. The Parties:

Lead Complainant: ITV Consumer Limited  
The London Television Centre  
Upper Ground  
London  
SE1 9LT  
United Kingdom

Complainant: ITV Network Ltd  
The London Television Centre  
Upper Ground  
London  
SE1 9LT  
United Kingdom

Complainant: ITV Plc  
The London Television Centre  
Upper Ground  
London  
SE1 9LT  
United Kingdom

Respondent: Lian Hua  
Room 2004, Town B1 Chang Yuan Tian Di Su Zhou Street  
Hai Dian District  
Beijing  
00080  
China

## 2. The Domain Name(s):

itviplayer.co.uk

## 3. Procedural History:

The Complaint was validated by Nominet on 10 June 2010, and was sent to the Respondent on the same date. Nominet informed the Respondent that he had until 1 July 2010 to respond to the Complaint.

No Response was filed. On 2 July 2010 the Complainant was notified that it had until 16 July 2010 to pay the requisite fee for an Expert Decision, which it duly paid.

I was thereafter contacted by Nominet and asked to confirm that I was able to provide an Expert Decision. I responded to Nominet confirming that I was able to provide a decision.

## 4. Outstanding Procedural Matters

The Respondent has not submitted a response to the Complaint. From the papers that have been submitted to me by Nominet, it is apparent that they have sent the Complaint to the Respondent using the contact details held on Nominet's Register.

When registering a .uk domain name applicants agree to be bound by Nominet's Terms and Conditions. Clause 4.1 of those terms and conditions states that the registrant of the domain name shall:-

*"4.1 give and keep us **notified of your correct** name, postal address and any phone, fax or e-mail information and those of your contacts (if you appoint any, see condition 5.2). This duty includes responding quickly and correctly to any request from us to confirm or correct the information on the **register**"*

In addition paragraph 2(e) of the Dispute Resolution Service Procedure (the "Procedure") states that:-

*"e. Except as otherwise provided in this Procedure or as otherwise decided by us or if appointed, the Expert, all communications provided for under this Procedure shall be deemed to have been received:*

*i. if sent by facsimile, on the date transmitted; or*

*ii. if sent by first class post, on the second Day after posting; or*

*iii. if sent via the Internet, on the date that the communication was transmitted;*

*iv. and, unless otherwise provided in this Procedure, the time periods provided for under the Policy and this Procedure shall be calculated accordingly."*

In light of the above it is my view that Nominet has done everything that it is obliged to do to bring the Complaint to the attention of the Respondent.

I now move on to consider the consequences of the Respondent not submitting a response.

The Procedure envisages just such a situation and provides in Paragraph 15 that:-

*“c. If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate.”*

I am not aware of any exceptional circumstances to explain why the Respondent should not have responded to the Complaint, and as such believe it appropriate to proceed to a Decision.

I will draw such inferences from the Respondent's failure to respond as I think appropriate, but must keep in mind that there may be a number of reasons why a respondent might fail to serve a response, for example that they have nothing useful to say.

## **5. Factual Background**

The Complainant operates and owns rights in a commercial television network in the UK. It also operates a website based video on demand service under the title 'ITV Player' which is accessible at the web address [www.itv.com/itvplayer](http://www.itv.com/itvplayer). It also makes its content available via third party digital broadcasters under the brand 'ITV NET PLAYER'. It had a turnover in 2009 of £1.879 billion.

It is the proprietor of various trade marks, and for present purposes the most relevant is a UK registration for 'ITV PLAYER' No 2500190, filed on 15 October 2008 (almost two months before the Domain Name). The Complainant also holds a number of domain name registrations, including for present purposes [itviplayer.co.uk](http://itviplayer.co.uk).

The video on demand services offered by the Complainant have been extensively referred to in various press, both before the registration of the Domain name and afterwards.

The Domain Name was registered by the Respondent on 3 December 2008. Whilst it is unclear from the Complaint what use the Domain Name was put to at the time of registration, it is presently directed to a third party website which provides links to providers of telecommunication and broadcasting services.

The Complainant's solicitors had difficulty accessing the Respondent's website and believe that this was because a virus on the Respondent's website was attacking its IT infrastructure.

## **6. Parties' Contentions**

I would summarise the contentions as follows –

### **The Complaint**

The Complainant asserts that it has rights in the Doman Name because it is identical to, or at least highly and confusingly similar to, a name or mark in which the Complainant has rights, and relies upon its extensive use of the 'ITV' mark and other marks including 'ITV PLAYER' and its registered rights in those marks.

It asserts that the Domain Name is an Abusive Registration because –

- i) Given the widespread reputation of the Complainant's trade marks, it must have been clear to the Respondent that consumers would associate the Domain Name with the Complainant, and confer an unfair advantage on the Respondent.
- ii) The Respondent is redirecting the Domain Name to a third party website which offers paid and sponsored links to goods and services which are identical and/or similar to, or highly connected or relevant to those for which the Complainant uses their marks.
- iii) The Respondent's use of the Domain Name dilutes the distinctiveness of the Complainant's marks, and consumers will confuse the Domain Name and the services offered on the Respondent's website with those of the Complainant. The Respondent will receive income for click through services, thereby taking unfair advantage of the Complainant's rights.
- iv) The Respondent's use of the website diverts consumers away from the Complainant's website who will suffer the dissemination of a malicious computer virus that the Complainant believes to be infecting the Respondent's website, thereby damaging the Complainant's reputation.
- v) The Respondent has no legitimate interest in the Domain Name; the Complainant has not consented to the use of its marks; the Respondent is not related to the Complainant; is not making bona fide use of it; and is not commonly known by the Domain Name.
- vi) It is to be assumed from the Respondent's conduct that he registered the Domain Name for the purposes of transferring it to the Complainant or to a competitor for valuable consideration.
- vii) The registration of the Domain Name blocks the Complainant from registering and using the domain name itviplayer.co.uk.

The Complainant requests that the Domain Name be transferred to it.

### **The Response**

No Response was filed.

## **7. Discussions and Findings**

### **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 which is identical or similar to the Domain Name; and
- (ii) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

The Complainant must make out its case to the Expert on the balance of probabilities.

### **Complainant's Rights**

The DRS Policy defines Rights as follows -

*"Rights includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business"*

The Policy requires such Rights to be in a name or mark identical or similar to the Domain Name. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one must ignore the .co.uk suffix. The comparison is therefore between 'ITV PLAYER', which I think is the closest name or mark used by the Complainant on the one hand, and 'ITVIPLAYER' on the other. The only difference between the two is the additional letter 'I', and in my opinion the mark is similar to the Domain Name. As a result of the UK trade mark registration and the extensive use of the mark, the Complainant has in my view established that it has Rights in a mark similar to the disputed Domain Name.

### **Abusive Registration**

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

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above.

The Policy defines an Abusive Registration as -

"a Domain Name which either:

- (iii) *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*
- (iv) *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. An extract from that list is as follows -

*"3 a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*

*i. 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;*

*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 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;"*

The Complainant has asserted that the Respondent registered the Domain Name, for the purpose of transferring it to the Complainant or a competitor for valuable consideration. It has also alleged that the Respondent is maliciously disseminating a virus via the website to which the Domain Name is pointing. In my opinion there is no evidence to support either allegation. No demand for money has been made by the Respondent, and my own experience of accessing the website to which the Domain Name is pointing does not accord with the Complainant's allegation concerning a virus. It also does not submit any supporting evidence for this allegation.

However, it is clear from the evidence that has been submitted that in or about October 2008 there was extensive publicity surrounding the naming of the Complainant's video on demand service. In my view, and in light of the similarity of the Domain Name and the timing of its registration, it is highly likely that the Domain Name was registered by the Respondent with full knowledge of the Complainant's use or intended use of the mark 'ITVPLAYER'. I suspect that the addition of the letter 'I' was because the BBC's comparable service was called the 'BBC iPLAYER'.

In my view the use that the Respondent has put the Domain Name to and the very close similarity between the Domain Name and the Complainant's mark, is such that it does unfairly disrupt the business of the Complainant by diverting users of the Complainant's service, and offering links to competing services. Further, the use of the Domain Name is likely to confuse people into believing that the Domain Name is registered to or, operated by or otherwise connected with the Complainant.

I am unaware of any grounds that the Respondent could rely upon to show that the Domain Name is not an Abusive Registration.

## **8. Decision**

For the reasons set out above, I find that the Complainant does have Rights in respect of a name or mark which is similar to the Domain Name <itviplayer.co.uk>, and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds.

The disputed Domain Name should be transferred to the Complainant.

**Signed Simon Chapman**

**Dated 11 August 2010**