

DISPUTE RESOLUTION SERVICE

D00013116

Decision of Independent Expert

O2 Holdings Ltd

and

Money Mast

1. The Parties:

Lead Complainant: O2 Holdings Ltd
260 Bath Road
Slough
SL1 4DX
United Kingdom

Respondent: Money Mast
Apartdo 1295
Ec Praia Do Carvoeiro
Algarve
8400 908,
Portugal

2. The Domain Name:

o24g.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.

24 July 2013 17:18 Dispute received
25 July 2013 13:47 Complaint validated
25 July 2013 13:49 Notification of complaint sent to parties
02 August 2013 12:01 Response received
02 August 2013 12:02 Notification of response sent to parties
07 August 2013 02:30 Reply reminder sent
12 August 2013 08:58 Reply received

12 August 2013 09:20 Notification of reply sent to parties
12 August 2013 09:21 Mediator appointed
15 August 2013 11:58 Mediation started
27 August 2013 13:37 Mediation failed
27 August 2013 13:38 Close of mediation documents sent
29 August 2013 Acknowledgement of receipt of Respondent's submission of a Further Statement
02 September 2013 12:14 Expert decision payment received

4. Factual Background

The Complainant is an international telecommunications company having its origins in a divestment from British Telecom dating back to 2001. Since 2002 it has used the name O2 or O₂, being the chemical symbol for a molecule comprising two oxygen atoms. The scale of the company is that it spends tens of millions of British pounds per year on advertising.

Mobile telephone technology has progressed from its first generation through a technically defined second generation, known popularly as 2G, and more recently a third generation, 3G, which is in widespread use. A fourth generation, 4G, is currently being rolled out and promises very high data transfer rates through the use of high radio frequencies and advanced technology for fitting bits of data into the spectrum. The Complainant is in the process of developing its 4G telecommunications service.

The Complainant owns registered trademarks for variously O2 or O₂, or expressions containing O2 or O₂, including nine United Kingdom trademarks, one United States trademark, and eight European Community trademarks. An example is Community trademark for O2, registration number 2109627, registered May 13, 2004, classes 9, 35, 36, 38, 39.

5. Parties' Contentions

Complainant

The Complainant's contentions, which include a comprehensive witness statement dated September 29, 2010 and stated to have been used in its previous cases in respect of the Domain Names o2prepaid.com (under the UDRP) and o2telecom.co.uk (under the DRS), include the following:

The Complainant is well-known by its brand and trademark. It is the owner of registered trademarks for O2 or O₂ and has produced copies of the relevant registration documents.

The Complainant says it would naturally call its forthcoming 4G service "O24G".

The Complainant observes that the Domain Name does not resolve to an active website and invites the Expert to infer that it must have been registered in anticipation of the Complainant's intentions. It is suggested that the Respondent has no reason to register the Domain Name except to capitalise on the Complainant's well-known brand and trademark or to disrupt the Complainant's business.

The Complainant contends in the alternative that the Domain Name was acquired primarily for the purposes of selling, renting or otherwise transferring for profit to the Complainant or to a competitor of the Complainant.

The Complainant submits that the registration and/or use of the Domain Name is bound to cause confusion with the Complainant in the minds of Internet users as to the source, sponsorship, affiliation or endorsement of the Respondent's website or location or of a product or service on the Respondent's website.

The Expert is invited to conclude that the Domain Name is an Abusive Registration in the hands of the Respondent.

Respondent

The Respondent's contentions include the following:

The Respondent has no interest in becoming a mobile telephone operator.

The Respondent says that its proprietor wants the Domain Name in connection with a business plan and has never sought to part with it for financial reward. The plan is to set up a business in Portugal for the harvesting of rain water domestically into tanks for purposes such as irrigation. It is said that the business will target expatriate English-speaking people and there are plans to expand the business into the United Kingdom. The name of the business is to be "O2 4 Gardens", for which the chosen Domain Name is the disputed Domain Name, o24g.co.uk.

The Respondent suggests that O2 is another name for water and the term 4g is not unique to the telecommunications industry.

The Respondent points out that it has a website at babygem4.wix.com/o2-4-gardens and that it has a relationship with another company that has an Internet location at the website shop.septictank.co.uk/Rainwater-Harvesting.

Complainant's Reply

In reply to the Response, the Complainant makes a number of contentions that, in addition to reiterating the Complaint, include the following:

The Complainant casts doubt on the veracity of the Response, on the basis that the Respondent's business plans were not disclosed when it was first contacted in February 2013 and that they are without supporting evidence and appear to be fabricated.

The Complainant's use of the 4G network was made public in December 2009. The Domain Name was registered on March 22, 2011.

The Complainant observes that the Respondent appears to have a connection with the telecommunications industry that is revealed at the websites moneymast.co.uk and phonemastcompany.co.uk, Money Mast being the name associated with the registrant of the disputed Domain Name.

The Complainant disputes the suggestion that O2 is another name for water; correctly it is H₂O.

The Complainant submits that the use of a .co.uk domain appears unusual for a business targeted at the Portuguese market.

The Complainant casts doubt on the genuineness of the Respondent's website depicting rainwater collection, claiming that it uses material copied from shop.septictank.co.uk/Rainwater-Harvesting and graf-water.com/rainwater-harvesting.html, and appears to be a sham.

On the basis of telephone enquiries to the number provided by the business located at moneymast.co.uk, the Complainant believes that the Respondent works in Shropshire and does not now live in Portugal.

6. Discussions and Findings

Procedural

On August 29, 2013, DRS acknowledged the receipt of a Further Statement, being a non-standard submission, from the Respondent. In accordance with paragraph 13 of the Nominet Dispute Resolution Service Procedure, the Respondent attached a summary Explanatory Paragraph that alone was forwarded to the Expert and to the Complainant.

Having considered the Explanatory Paragraph, the Expert in this case declines to receive the full Further Statement. This Decision will therefore proceed to determination on the basis of the Complaint, Response and Reply as they stand.

Paragraph 2(a) of the Policy requires the Complainant to prove, on the balance of probabilities, that:

- "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".

Complainant's Rights

The Expert is satisfied that for the purposes of paragraph 2(a)(i) of the Policy, the Complainant, O2 Holdings Ltd., has Rights in the expression O2, that being the distinctive component of its company name and the subject of a number of registered trademarks in the United Kingdom, Europe and the United States.

The disputed Domain Name is o24g.co.uk, of which the domain designation ".co.uk" need not in this case be taken into consideration. What remains is "o24g", an enigmatic expression that could be read as a whole or in various groupings of o, 2, 4 and g. Capitalisation or otherwise is of no significance as .co.uk domain names are not case sensitive. The Complainant asserts in effect that the Domain Name can be read as its well-known name and trademark O2, linked directly to 4G, meaning 4G technology.

Internet users are commonly led to websites through search results or links. In this Expert's view, a user searching with terms related to telecommunications and having even a passing familiarity with telecommunications company names, presented with the Domain Name o24g.co.uk, would associate the expression with the Complainant's name and trademark O2 and the concept of 4G telecommunications. Accordingly, within the meaning of paragraph 2(a)(i) of the Policy, the Domain Name is found to be similar to a name or mark in which the Complainant has Rights.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".

Paragraph 3 of the Policy sets out circumstances that may be evidence that the Domain Name is an Abusive Registration. Paragraph 3 of the Policy reads in part:

“3. Evidence of Abusive Registration

- 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;
- (...)”.

Whilst it is for the Complainant to prove its case on the balance of probabilities, paragraph 4 of the Policy provides a non-exhaustive list of factors that may be taken into account as possible evidence that a Domain Name is not an Abusive Registration. In this case it is appropriate to cite paragraphs 4(a)(i) and 4(a)(ii) of the Policy:

“4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:
 - i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:
 - A. used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;
 - B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
 - C. made legitimate non-commercial or fair use of the Domain Name; or
 - ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it;
- (...)”.

Since the Respondent has set out to justify the use or intended use of the Domain Name for business purposes, the provisions of paragraph 4, and particularly paragraph 4(a)(i)(A), of the Policy will be considered first.

The Respondent refers to its business plan in terms of a concept, now delayed, with a website described as under construction. There is no evidence of a current offering of goods or services. The website babygem4.wix.com/o2-4-gardens, to which the Expert is directed,

depicts the simulated burial of a water tank. The Expert does not find sufficient evidence of a genuine offering of goods or services to satisfy paragraph 4(a)(i)(A) of the Policy.

There is no claim by the Respondent to have been commonly known by the Domain Name or similar, or that the use of the Domain Name is non-commercial (paragraphs 4(a)(i)(B) and 4(a)(i)(C) of the Policy).

The chemical abbreviation O2 for molecular oxygen, as such, is generic. The expression 4G for fourth generation telecommunications is generic. The combination o24g, in the present context, is found not to be generic because it comprises the Complainant's name and registered trademark in combination with a widely recognised description of an element of its business: it would be readily perceived as indicating 'the 4G service offered by O2'. The Respondent is found not to satisfy paragraph 4(a)(ii) of the Policy or to have any other basis on which to show under paragraph 4 of the Policy that the Domain Name is not an Abusive Registration.

Paragraph 1 of the Policy, in defining Abusive Registration, distinguishes between (i) the circumstances and motivation surrounding the act of registration of the Domain Name, and (ii) the purpose for which it has subsequently been used. In the present case the Domain Name has in effect been parked and, other than that, there does not appear to have been active usage for email or other Internet purposes. Paragraph 3(b) of the Policy provides that non-use is not, in itself, evidence that the Domain Name is an Abusive Registration. The primary question to be considered therefore is whether the Respondent, at the time of registering the Domain Name, took unfair advantage of the Complainant's Rights.

On the totality of the evidence, the linkage between the Respondent, its company name Money Mast, the websites moneymast.co.uk and phonemastcompany.co.uk, and the telecommunications industry, is transparent. The Expert finds it more probable than not that the Respondent, when registering the Domain Name on March 22, 2011, would have been aware of the Complainant's name, which had been in use since 2002; would have been aware of impending 4G technology; and would have been aware of the Complainant's likely interest in 4G technology, which was announced in December 2009. If the Respondent was not aware of any of these things, then given its area of business and expertise, it ought reasonably to have been aware.

In the terms of paragraph 3(a)(ii) of the Policy, there is Abusive Registration if the Respondent is using or threatening to use the Domain Name in a way that has confused or is likely to confuse people or businesses into believing that the Domain Name is endorsed by the Complainant. The word "threatening" in the context does not require belligerent language; an expression of intent may be sufficient. The illustrations provided in paragraph 3 of the Policy are in any case non-exhaustive and Abusive Registration may be found otherwise. Irrespective of the Respondent's degree of commitment to the business plan, its proprietor reveals his intentions thus: "I wish to continue to own the [domain] name for my own business venture"; and later, "I really want to use the domain name O24g.co.uk as it is a much shorter abbreviation for emails and the website".

Furthermore, as discussed in the Dispute Resolution Service – Experts' Overview (2009), "the English Courts have clearly held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name. The prevailing approach under the DRS is consistent with this."

Having regard to all the evidence, the Expert finds Abusive Registration of the Domain Name by the Respondent on the grounds of intention to confuse Internet users into thinking, at least initially, that the Domain Name is connected with the Complainant.

Inevitably the Respondent's intended use of the Domain Name would have the effect of unfairly disrupting the Complainant's business and constitutes an additional ground for a finding of Abusive Registration in the terms of paragraph 3(a)(i)(C) of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in respect of the name and registered trademark O2; that the disputed Domain Name o24g.co.uk is similar to the Complainant's name; and that the disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name o24g.co.uk is ordered to be transferred to the Complainant.

Signed Clive Trotman

Dated September 12, 2013