

DISPUTE RESOLUTION SERVICE

D00017668

Decision of Independent Expert

UAB "TELE2"

and

Vaidas Go

1. The Parties:

Complainant: UAB "TELE2"
Sporto g. 7A
LT-09200
Vilnius
Vilnius
Lithuania

Respondent: Vaidas Go
23 Montalt Road
Coventry
West Midlands
CV3 5LT
United Kingdom

2. The Domain Name:

pildyk.co.uk

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, 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.

01 July 2016 17:25 Dispute received

04 July 2016 12:54 Complaint validated

04 July 2016 12:58 Notification of complaint sent to parties

21 July 2016 02:30 Response reminder sent

26 July 2016 09:47 No Response Received

26 July 2016 09:47 Notification of no response sent to parties

04 August 2016 16:09 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is a Lithuanian telecommunications company that provides mobile communication services in Lithuania. It is part of one of the largest European telecommunications operators, Tele2.
- 4.2 The Complainant sells pre-paid SIM cards under the mark PILDYK and has done so for a number of years.
- 4.3 The Complainant has a European Union registered trademark for the word mark PILDYK. This was registered as of 5 April 2013.
- 4.4 The Complainant also owns the domain name Pildyk.lt (a Lithuanian domain name) which was registered in September 2001 and a website linking to this domain name is used by the Complainant to provide pre-paid telecommunications services.
- 4.5 The Complainant has advertised its pre-paid telecommunications services under the name PILDYK on a YouTube channel. It also has a well visited Facebook Page. The word Pildyk is the imperative form of the Lithuanian word, “Pildyti” which means, “to fill”.
- 4.6 The Respondent is an individual called Vaidas Go whose address is in the West Midlands.
- 4.7 The Domain Name was registered as of 15 May 2012.

- 4.8 The Domain Name does not currently link to an active website. It has recently been used to link to a website in Lithuanian from which SIM cards can be purchased. After a SIM card is purchased on the website linked to the Domain Name the user is directed to another Lithuanian language website at www.emigintai.co.uk. The domain name emigintai.co.uk is also owned by the Respondent.
- 4.9 No Response has been filed by the Respondent.

5. Parties' Contentions

Complainants' Submissions

Rights

- 5.1. The Complainant sets out the test for Rights from the Policy and submits that this should be a low-level test to ensure that the Complainant has a bona fide basis for making the Complaint. The Complainant also quotes from paragraph 2.2 of the Experts' Overview as to what must be shown to establish Rights.
- 5.2. The Complainant submits that it has earlier rights in respect of the mark Pildyk i.e. Rights which are identical to the Domain Name. In support of this the Complainant relies on the following:
- 5.2.1. The Complainant's registered EU trade mark for the mark PILDYK;
- 5.2.2. The use by the Complainant of the mark Pildyk for telecommunication services, inter alia providing its clients with SIM cards, in Lithuania, for more than nine years (since 19 January 2003);
- 5.2.3. The Complainant's prepaid telecommunication services website at www.pildyk.lt;
- 5.2.4. The Complainant's YouTube Channel which shows a total of 963,000 views as of 16 April 2012;
- 5.2.5. The Complainant's Facebook page bearing the mark Pildyk which shows a total of 199,702 users.
- 5.3. In addition the Complainant exhibits results from the UK search engine google.co.uk showing that a search against PILDYK reveals

only entries about the Complainant on the first page of results together with an entry from the free encyclopaedia Wikipedia which describes the Complainant's business and the adoption of the mark PILDYK.

- 5.4. In addition, the Complainant points out that it registered the domain name pildyk.lt more than 11 years ago on 14 September 2001.

Abusive Registration

- 5.5. The Complainant contends that the Domain Name is an Abusive Registration for the reasons that I will summarise in the following paragraphs.

- 5.6. The Complainant contends that as the Respondent is clearly Lithuanian or connected with Lithuanian he would have had knowledge of the Complainant's Rights. The Complainant says this for the following main reasons:

- 5.6.1. The mark PILDYK is a Lithuanian word. It is the imperative of a Lithuanian word, "Pildyti" which means, "to fill" in English;

- 5.6.2. The Respondent is clearly Lithuanian given that the name, "Vaidas" is a Lithuanian name (and the Complainant exhibits an extract from Wikipedia to demonstrate this) and given the fact that the main webpage for which the Domain Name is linked is in the Lithuanian language; and

- 5.6.3. After the purchase of a SIM card from the website to which the Domain Name is linked the customer is directed to another website which is also in the Lithuanian language and is clearly targeted at Lithuanian.

- 5.7. The Complainant contends that there will be confusion as to the identity of the person/entity behind the Domain Name given the following main factors:

- 5.7.1. The fact that the Domain Name is identical to the name or mark in which the Complainant has Rights;

- 5.7.2. The Domain Name is being used to sell SIM cards which is exactly the same business as the Complainant uses the mark PILDYK has used the mark Pildyk for a number of years;

5.7.3. It is extremely likely that, “initial interest confusion”, amongst end users will result.

Respondent’s Submissions

5.8. The Respondent has not filed a Response.

6. Discussions and Findings

6.1. Paragraph 2(a) of Nominet’s Dispute Resolution Policy (“the Policy”) requires that the Complainant must prove, on the balance of probabilities, that:

- *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Rights

6.2. The definition of Rights in 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.

6.3. This has always been treated in decisions under Nominet’s DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.4. I have no doubt that, on the balance of probabilities, the Complainant has Rights in the word or mark PILDYK. The Complaint is the registered proprietor of an EU trade mark for the mark PILDYK. It is also clear that the Complainant has been using the mark PILDYK in relation to its offering of prepaid telecommunication services (i.e. prepaid SIM cards) in Lithuania for a number of years. It has owned the Lithuanian Domain Name pildyk.lt for over nine years and has

amassed an impressive amount of advertising at least on social media in this time.

- 6.5. As the name or mark in which the Complainant has Rights differs only from the Domain Name by the addition of the first and second level suffix.co.uk in the Domain Name I therefore conclude that the Complainant has Rights in a name or mark which is identical to the Domain Name.

Abusive Registration

- 6.6. Abusive Registration is defined in Paragraph 1 of the Policy as a domain name which either:
- a. 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
 - b. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.7. This definition requires me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.
- 6.8. Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.
- 6.9. The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.
- 6.10. In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's Rights. In some cases where the name in which the Complainant has Rights is particularly well known this will be fairly obvious and straightforward while in other cases where the name in which the Complainant has Rights is less well known

and/or where there are other meanings or uses which can be made of the name this will require substantial evidence from the Complainant.

- 6.11. The position on knowledge has been summarised by Nominet's Appeal Panel in the earlier case of Verbatim Limited -v- Michael Toth DRS04331 and it is convenient to reproduce the following paragraphs from the Appeal Panel's decision here:

In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

First, some knowledge of the Complainant and/or its brands/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.

Secondly, "knowledge" and "intention" are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.

Thirdly, "intention" is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.

Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.

Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of

probabilities, the relevant degree of knowledge or awareness was present.

Accordingly, in the view of this Panel, for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name.

- 6.12. The approach that I therefore intend to take in this case is to look at the overall question of whether the Respondent's registration or use of the Domain Names constitutes an Abusive Registration. Bound up with that, and indeed central to it, will necessarily be the question of the Respondent's knowledge of the Complainant's Rights.
- 6.13. In making this overall assessment the nature of the name or mark in which the Complainant has Rights is also clearly a factor here. The more descriptive or generic that name or mark is then the more likely it is that the Respondent simply happened upon the Domain Name as a "good domain name" without necessarily having any knowledge of the Complainant's Rights. Obviously the more well-known and unique that name or mark is then the less likely it is that the Respondent did not register the Domain Name with the Complainant's Rights in mind.
- 6.14. In this case, the Domain Name contains the word or mark PILDYK. While I note that this is based on the Lithuanian word, "to fill" there is no suggestion that it is descriptive or that it would be the kind of word or mark that one would naturally wish to adopt in relation to telecommunication services.
- 6.15. The various documents that the Complainant has provided show that the Complaint has used the word PILDYK in relation to prepaid SIM cards for some time. Further, it is reasonable to infer (at least on the balance of probabilities) from these documents, not least of which the Google searches which show the Complainant's business occupying all of the top ten spaces in a Google search against PILDYK, that the name PILDYK has become reasonably well known in relation to the sale of prepaid SIM cards at least in Lithuania.
- 6.16. Given what I have said above about the word PILDYK I would conclude that PILDYK is towards the end of the scale such that the registration of a Domain Name which included the word or mark PILDYK will give rise to a prima facie case that the Domain Name

was an Abusive Registration. Put another way, given the nature of the mark PILDYK and the extensive use that the Complainant has clearly made of it, it is difficult to think of a set of circumstances in which a third party (particularly one with Lithuanian connections) could have registered or used a Domain Name consisting of or containing PILDYK for use in connection with a business similar to the Complainant's without knowledge of the Complainant.

- 6.17. In this case the website to which the Domain Name has recently pointed is a website which appears to offer goods which compete with the Complainant's offering. Additionally, it is clear that the Respondent is Lithuanian or at least has Lithuanian connections given his name (which would appear to have its roots in Lithuanian) and the fact that both the website which the Domain Name points and the website to which another of the Respondents' Domain Names points i.e. emigranti.co.uk is also in Lithuanian.
- 6.18. Taking into account all of these factors it is an irresistible inference that the Respondent knew about the Complainant's Rights when it registered and used the Domain Name and the clear impression that one gets from the website to which the Domain Name has been recently linked is that it is designed to take advantage of the Rights which the Complainant has in the name or mark PILDYK.
- 6.19. The Respondent has not put in a Response and indeed it is difficult to think of a credible explanation for the Respondent's conduct. I therefore have no hesitation in finding that on the balance of probabilities the Domain Name is an Abusive Registration.

7. Decision

I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. I also find that, on the balance of probabilities, the Complainant has established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

Signed

Dated 1st September 2016