

## **DISPUTE RESOLUTION SERVICE**

**D00019518**

**Decision of Independent Expert**

**Orange Brand Services Limited**

and

**Goldfish Telecoms**

### **1. The Parties**

Complainant: Orange Brand Services Limited  
3 More London Riverside  
London  
SE1 2AQ  
United Kingdom

Respondent: Goldfish Telecoms  
Arcon House  
Rochdale  
Manchester  
OL16 4BL  
United Kingdom

### **2. The Domain Name**

orangewifi.co.uk ('the Domain Name')

### **3. Procedural History**

Nominet checked that the complaint received on 13 November 2017 complied with its UK Dispute Resolution Service ('DRS') Policy ('the Policy'). It then notified the Respondent and invited it to file a response. That response was received on 15 November. The Complainant was invited to reply to the response but did not do so.

Mediation was attempted but ended unsuccessfully and, on 18 December, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 19 December.

On the same day I, Mark de Brunner, agreed to serve as an expert under the Policy. 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 into question my independence in the eyes of one or both of the parties.

### **4. Factual Background**

I have visited the web pages at the Domain Name and the web pages to which the Complainant's domain names <orange.com> and <orange.co.uk> resolve. From that limited research, the complaint, the response and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant is part of a group of companies that sells telecommunications services under the 'ORANGE' mark. It is a wholly-owned subsidiary of Orange SA.

Telecommunications services were first marketed under the ORANGE name in 1994. The Orange Group has since become one of the largest operators of mobile and internet services in Europe and Africa and a leading global supplier of corporate telecommunication services. In 2016, the international BRANDZ survey assessed ORANGE as being worth around US\$18 billion, making it the fifty third most valuable brand in the world.

By the end of that year, there were around 180 million customers of the ORANGE brand and the Group was running telecommunications and IT operations for consumers in some 29 countries and supporting business to business telecommunications in 220 territories worldwide. Global revenues amounted to some 40 billion euros.

The Orange Group holds around 2,000 trade mark registrations, in over 185 territories, for the ORANGE mark, and a related logo:



Attached to the complaint is a selection of European and UK trade marks in the name ORANGE of which the Complainant is the registrant.

Rights in the ORANGE brand are licensed to members of the Orange Group and, on a franchise basis, to some non-Orange Group entities operating telecommunications networks.

The Complainant's corporate website is at <orange.com>, which makes extensive use of the ORANGE name.

The domain name <orange.co.uk> currently resolves to a web page at <ee.co.uk/orange>. Among the text there is the following wording:

Orange email has now closed

Upgrade from Orange to EE today

Looking to upgrade? As an existing Orange customer, you're in the right place to get the best deals on EE.

A linked page confirms that 'Orange email' closed on 31 May 2017.

The Respondent sells Wi-Fi services that allow businesses offering Wi-Fi to their customers to collect customer data and use it for targeted marketing.

The Domain Name was registered on 26 June 2015. It resolves to a web page headed with a logo that is repeated on other, linked, pages:



The web site home page contains a graphic describing the essentials of the system that the Respondent supplies:



The 'Contact Us' page shows two physical addresses: one for 'Orange WiFi (Head Office)' in Manchester, at the address shown on Nominet's records; and another for 'Orange Wifi (Egypt)', based in Sharm El Sheikh.

## 5. Parties' Contentions

### *Complaint*

The Complainant says it has rights in a name which is identical or similar to the Domain Name.

It argues that the Domain Name is an abusive registration for the following reasons, all of which are principally to do with the use to which the Domain Name has been put.

- (i) The Complainant has not authorised the Respondent's use of the name in which the Complainant has rights.
- (ii) The Respondent is using the ORANGE mark in relation to goods and services which are identical to those protected by the Complainant's trade marks.
- (iii) The Domain Name is effectively a blocking registration.
- (iv) The Respondent's use of the Domain Name is exploiting the Complainant's reputation and goodwill in the telecommunications industry in a manner that is highly likely to cause the Complainant loss. As such, it is unfairly disrupting the Complainant's business.

- (v) People or businesses are likely to be confused into believing that there is a connection between the Domain Name and the Complainant.
- (vi) The Respondent is acting in bad faith.

*Response*

The Response is short and I reproduce it in full:

Yet again the BIG boys are getting all pathetic and trying to bully small businesses. We do not sell mobiles. All we sell are Social Wifi software via web.

They need to grow up and worry about how much business they are losing to massive competitors and not a one man band.

I will NOT bow down to the pathetic idiots. Orange Wifi is mine and get stuffed !!!!!

*Reply*

There has been no reply to that response.

## 6. Discussion and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it has rights in respect of a name or mark which is identical or similar to the Domain Name; and that
- the Domain Name, in the hands of the Respondent, is an abusive registration.

### *Rights*

In the field of telecommunications, the Complainant has long-established registered rights in the name ORANGE. It will also have accrued significant goodwill and therefore unregistered rights in that name. I do not regard the closure of the 'Orange email' service in May 2017, or the invitation to customers to 'upgrade from Orange to EE', as making any material difference to those rights.

Ignoring the .co and .uk suffixes as generic characteristics of the domain name register, the Domain Name is made up of the name in which the Complainant has rights and a short extension relevant to the field of telecommunications.

I conclude that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name.

### *Registration*

As defined by the Policy, an abusive registration is a domain name which:

- 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
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration and the complaint reflects several of those factors. The Complainant says that this is an abusive registration 'principally' because of the way the Domain Name has been used (rather, I take it, than because of the circumstances obtaining when the Domain Name was registered). The Respondent does not attempt to address those key elements of the complaint though it does imply that its line of business differs significantly from the Complainant's in that it sells software rather than hardware.

There is a section (3.3) of the *Experts' Overview* dealing with the Policy's reference to use of a domain name which has confused or is likely to confuse. In the round, that part of the *Overview* looks to cover precisely the facts before me:

If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue.... In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with...a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name...

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)... The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However...generally condemned...are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity.

As an appendage to a domain name, 'wifi' is entirely appropriate to the field of telecommunications. I do not accept as valid the Respondent's distinguishing between a complainant selling hardware and a respondent selling software. It seems plain from the evidence before me that both the Complainant and the Respondent sell telecommunications services that could involve both hardware and software. In my judgement, there is significant scope for 'initial interest' confusion caused by the Respondent's choice of domain name. Once at the website, it would be too late to clear up the confusion anyway but, in any event, there is nothing there – certainly not the orange-coloured, mostly lower-case lettering of the header – which could even be regarded as an attempt at that.

In this respect, it is notable that the web page containing contact details displays just two addresses, one in Europe and another in Africa – the two continents in which the Complainant has become one of the largest operators of mobile and internet services.

The conclusion seems unavoidable, that the Respondent is using the ORANGE name to make use of the Complainant's goodwill – exploiting the Complainant's rights in the name in a way that can only be unfair.

The Complainant argues that the Domain Name is an abusive registration primarily because of the use to which it has been put. But in my judgement the circumstances at registration itself were such as to cast doubt on its nature. On that basis, both registration and use of the Domain Name have taken unfair advantage of the Complainant's rights.

For completeness, I can now review the arguments advanced by the parties.

I agree with the Complainant that

- (i) the Complainant has not authorised the Respondent's use of the name
- (ii) the Respondent is using the ORANGE mark in relation to goods and services which are identical to those protected under the Complainant's trade marks
- (iii) the Domain Name is, effectively, a blocking registration
- (iv) the Respondent's use of the Domain Name is exploiting the Complainant's goodwill and unfairly disrupting its business
- (v) people or businesses are likely to be confused into believing that there is a connection between the Domain Name and the Complainant.

I disagree on the question of bad faith:

- (vi) under the DRS Policy it is not necessary to establish or identify bad faith in order to conclude that a domain name is an abusive registration. Here, though the complaint refers to the Respondent's bad faith there is no evidence of that specifically advanced and I make no such finding.

It is harder to analyse the response in the same way but, for the avoidance of doubt, I reject the Respondent's implication that the reason the complaint should not succeed is that the Respondent's business is dwarfed by the Complainant's. That seems to me fundamentally misconceived: under the DRS the decision on the character of a domain name registration turns not on the relative size of the parties but on the application of the Policy to the facts as set out in the evidence put before the expert, and I have proceeded on that basis.

## **7. Decision**



I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an abusive registration.

I therefore direct that the Domain Name be transferred to the Complainant.

**Mark de Brunner**

**15 January 2018**