

DISPUTE RESOLUTION SERVICE

D00009968

Decision of Independent Expert

AVAYA INC

and

OFFICE COMMS LTD

1. The Parties:

Complainant: Avaya Inc
211 Mount Airy Road
Basking Ridge
New Jersey 07920
USA

Respondent: Office Comms Limited
Unit 44
Tondu Enterprise Park
Bridgend
CF32 9BS
United Kingdom

2. The Domain Name:

avayadirect.co.uk

3. Procedural History:

01 July 2011 20:23 Dispute received
04 July 2011 10:23 Complaint validated
04 July 2011 10:43 Notification of complaint sent to parties
21 July 2011 02:30 Response reminder sent
21 July 2011 10:00 Response received
21 July 2011 10:00 Notification of response sent to parties
26 July 2011 02:30 Reply reminder sent
29 July 2011 10:43 Reply received

29 July 2011 10:45 Notification of reply sent to parties
29 July 2011 10:45 Mediator appointed
03 August 2011 16:37 Mediation started
18 November 2011 16:28 Mediation failed
18 November 2011 16:29 Close of mediation documents sent
29 November 2011 13:40 Expert decision payment received

Cerryg Jones, the undersigned, (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual Background

The Complainant, Avaya Inc, is a multinational global business communications company which supplies a variety of communication products and services. The Complainant is the registered proprietor of various national marks (which include the UK and the USA) and CTM marks consisting of, or incorporating, the mark AVAYA, in relation to communication products and services dating back to 2003. It also runs a network of authorised channel partners throughout the world via its business Avaya Connect.

The Respondent also supplies IT and communications services. It was incorporated on 6 March 2003. Its director is Mark Ford. Mr Ford is also the sole director of a company called Avaya Direct Limited, which was incorporated on 4 August 2010. Avaya Direct Limited trades from the same address as the Respondent.

The Complainant sent a letter of complaint to Avaya Direct Limited on 21 April 2011, and subsequently filed a complaint with the Company Names Tribunal against this company seeking that the Tribunal make an Order requiring Avaya Direct Limited to change its name.

5. Parties’ Contentions

Complainant’s submissions

Rights

The Complainant refers to its global business and multiple trade mark registrations for, or incorporating, the mark AVAYA. It says that its trade mark rights predate the Registrant’s 2010 registration of the disputed domain name (“Domain Name”), and that its business under the AVAYA mark has been extensive and continuous since early 2000 in the field of communication and information technology. The Complainant points to its 2000 registration of avaya.com, as well as several UK domains from the same date including avaya.co.uk, avaya-telephone-systems.co.uk, avaya-tenovis.co.uk, avayashop.co.uk, avayacommunications.co.uk, and avayaphones.co.uk. Evidence filed with the Complaint supports these submissions.

The Complainant says it currently employs approximately 19,000 people worldwide, including around 3,400 research and development professionals; that it has approximately 5,400 patents or patents pending; and about 9,200 channel partners worldwide. Evidence filed with the Complaint shows that the Complainant has received various awards and recognition as a global leader by industry and technology experts in its field.

Abusive registration

The Complainant alleges the domain name is an Abusive Registration for the following reasons:

- 1 The Domain Name is identical to a name in which the Complainant has rights. The addition of the generic term “direct” to the AVAYA mark fails to differentiate the Domain Name from the AVAYA mark. Various DRS decisions and UK judgments are referred to in support of this submission.
- 2 That it can be inferred that the Registrant deliberately chose to incorporate the AVAYA mark into its Domain Name, in view of the fact that the Registrant’s goods and services are similar or identical to the business operated under the AVAYA mark.
- 3 That the Registrant adopted the Domain Name for the purposes of funnelling internet traffic from the Domain Name to its website at www.officecoms.co.uk as all visitors to the Domain Name are redirected immediately and automatically to www.officecomms.co.uk. The Complainant contends that redirection is evidence of unacceptable action and abusive registration, and refers to the decision of DRS 00002193 in support.
- 4 That the Registrant’s redirection was calculated to cause confusion and involved taking unfair advantage of, and causing detriment to, the Complainant’s Rights. Through the redirection, the Registrant improperly benefits from an association with the Complainant’s business. Consumers will access the Registrant’s website when searching for the Complainant, and once at the site, they will mistakenly believe that the Registrant’s website is associated with, or otherwise connected to, the Complainant, because of the fame of the AVAYA mark.
- 5 That there is no legitimate justification for the Registrant’s adoption and continued use of the Domain Name.
- 6 That the Complainant has not authorised the Registrant to use the AVAYA mark and the Registrant is not known by the Domain Name.
- 7 Given the widespread use and fame of the AVAYA mark, the Registrant must be aware that in registering the Domain Name it misappropriated the AVAYA Mark.
- 8 That the Registrant is merely using the Domain Name to trade on the goodwill and reputation of the AVAYA mark, and its use constitutes trade mark infringement.

The Respondent’s Response

The Respondent makes the following submissions:

- 1 That it is an Avaya dealer in the UK and is currently in the process of building a website ordering portal which will configure an Avaya telephone system from the telephone lines and user numbers.
- 2 That Mr Ford asked before starting this project (which has so far cost over £200,000) “...if there would be any issues the answer was no but this was a few

years ago and that why we have the company Avaya direct.co.uk company registration number 07336062”.

- 3 That there are other websites and companies setup with the same name as Avaya product, including “IPOffice”. The Respondent submits that some of these companies sell Avaya products and some do not.
- 4 That the Respondent is not attempting to imitate the Complainant and that its new website makes that clear.
- 5 That the Respondent has sold the Complainant’s products “...even before it was Avaya when it was *the Index*”; that it is the best product in the marketplace for the Respondent’s target market; that all the Respondent’s engineers are fully trained by Avaya and have completed all the latest courses; that the Respondent promotes the Complainant’s products and has over 1500 Avaya customers in the UK; and that all the Respondent’s engineers wear “...the Avaya logoed shirts which Avaya supplied”.
- 6 That the Respondent has also just completed five seminars in the UK where over 3000 people visited from the medical sector for the purposes of demonstrating how an Avaya system could benefit their business.
- 7 That the Respondent is an Avaya Connect registered partner.

The Complainant’s Reply

The Complainant makes the following submissions in Reply (omitting those which have already been made in the Complaint):

- 1 The Complainant denies the allegation that Respondent had the authority to register and use the Domain Name. The Complainant has not acquiesced to use of the Domain Name by any third party including the Registrant. In support, the Complainant has filed with its Reply an affidavit of the Complainant’s Senior Director and in-house counsel Russell Binns.
- 2 The Respondent has not requested the Complainant’s permission to register or maintain the Domain Name nor sought permission to link such a domain name to a website.
- 3 The Respondent has not supplied any evidence of other UK registered trade marks validly using the mark AVAYA in relation to relevant goods and services. In the circumstances, the Respondent’s assertions should be rejected.
- 4 The Respondent has not provided any evidence relating to any valid use of the AVAYA mark by the Respondent or any other company it refers to.
- 5 Even if the Respondent deals legitimately in the Complainant’s goods, this does not confer on it the right to use a domain name which consists solely of the trade mark of the Complainant, in the absence of the Complainant’s permission.
- 6 The incorporation of a company comprising the term AVAYA does not give rise to any registered or unregistered trade mark rights or goodwill in the mark AVAYA.

6. Discussions and Findings

1 Under paragraph 2 of the Policy, the Complainant is required to prove to the Expert on the balance of probabilities that (a) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and (b) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

2 An 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.

3 Rights are defined under paragraph 1 of the Policy as:

“rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

4 There is no doubt in my view that the Complainant has acquired enforceable rights in respect of a name or mark which is identical or similar to the Domain Name under the rules of the DRS. This finding is based on the fact that the Complainant is the registered proprietor of a number of marks for AVAYA, or for marks which incorporate that mark, and has traded extensively under that mark or its close variations. In fact, the Respondent does not appear to challenge the similarity between the Domain Name and the Complainant's AVAYA marks.

5 The next issue to be determined is whether or not the Domain Name, in the hands of the Respondent, is an Abusive Registration. This means either that it was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or that the Domain Name has subsequently been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

6 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under the Policy is as follows so far as relevant to this Complaint:

Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant;

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.

7 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration so far as relevant to this Complaint is that, before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

- 7.1 *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;*
- 7.2 *been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
- 8 The fact that the Respondent appears to be a genuine trader in the Complainant's goods, and has taken steps to promote the Complainant's goods, does not in itself entitle the Respondent to adopt the trade marks of the Complainant in the Domain Name in the absence of differentiating content which would make it reasonably clear that the Respondent is independent of the Complainant. In my view, the addition of "direct" is wholly insufficient to give any independent distinctiveness to the Domain Name. "Direct" is commonly used in trade and does nothing in my view to dispel the initial impression that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- 9 I note that Mr Ford suggests in his Response that he asked (an unidentified person) whether there would be "...any issues..." in respect of the Domain Name and that, in the absence of a negative response, he proceeded to register the company name Avaya Direct Limited. Presumably by parity of reasoning this led the Respondent to suppose that his registration or use of the Domain Name was legitimate under the rules of the DRS. However, the Respondent has not adduced any evidence to substantiate this assertion. The Complainant on affidavit denies giving the Respondent any such permission. In my view, it is telling that on receipt of the letter of complaint, the Respondent made no mention of this, or the answer that was purportedly given by the Complainant. On the basis of the material before me I find that the Complainant did not grant the Respondent permission to use the Domain Name. It follows that, in my view, the use of the Domain Name to redirect internet traffic to www.officecoms.co.uk is evidence of an abusive registration as the Respondent has not obtained any licence to use the AVAYA trade mark in the manner it has within the Domain Name.
- 10 Again, the Respondent did not provide any evidence to support his assertion that other businesses use the name "Avaya". In any event, even if that were true, that does not provide any justification for the Respondent's registration or use of the Domain Name.
- 11 The Respondent states that it is not attempting to imitate the Complainant and that its new website makes that clear. However, that does not alter the fact that the Respondent's choice of domain name is inherently deceptive. Once internet users access the Respondent's website the damage is done, whatever disclaiming content is present on the website to disabuse such users of their initial confusion.
- 12 It is also a well established principle of the DRS that mere registration of a company name which is identical or similar to a disputed domain name does not by itself confer legitimacy on the domain name. This is especially so where the company name and disputed domain name incorporate without consent a third party registered trade mark or where other facts and matters which might otherwise legitimise such use of the trade mark are absent (such as descriptiveness, or use of one's own name, or other exceptions permitted by the UK Trade Marks Act).

- 13 Accordingly, I have reached the clear view that the Domain Name in the hands of the Respondent constitutes an Abusive Registration.

7. Decision

In the light of the foregoing findings, namely that the Complainant 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, I direct that the Domain Name be transferred.

Signed: Cerryg Jones

Dated: 3 January 2012