

DISPUTE RESOLUTION SERVICE

D00013310

Decision of Independent Expert

British Telecommunications Public Limited Company

and

Mr Qureshi

1. The Parties:

Complainant:

British Telecommunications Public Limited Company
81 Newgate Street
London
EC1A 7AJ
United Kingdom

Respondent:

Mr Qureshi
63 Barn Hill
Wembley
Middlesex
HA9 9LL
United Kingdom

2. The Domain Names:

btvision.co.uk
btsporthd.co.uk
btvhd.co.uk
btvisionhd.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.

16 September 2013: Dispute received
17 September 2013: Complaint validated
17 September 2013: Notification of complaint sent to parties
04 October 2013: Response reminder sent
09 October 2013: No Response Received
09 October 2013: Notification of no response sent to parties
21 October 2013: Summary/full fee reminder sent
24 October 2013: Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Names were registered on the following dates:

btvision.co.uk: 27 March 2013
btsporthd.co.uk: 13 May 2013
btvhd.co.uk: 13 May 2013
btvisionhd.co.uk: 13 May 2013

Based on the Complainant's submissions (see section 5 below) and a review of the materials annexed to the Complaint, set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant is a long established and very well known provider of communications services, including broadband and internet services and broadcasting.
- b. The Complainant is very well known under the shorthand "BT".
- c. The BT VISION internet-provided television subscription service was launched by the Complainant in 2006, and has been widely advertised in the UK.
- d. BT TV, an umbrella name for the BT VISION and BT SPORT services, was first used by the Complainant in May 2013.
- e. On 9 May 2013, the Complainant announced the roll-out of its BT Sport service, to be launched in August 2013. The service is available on channels which include BT Sport HD 1 and BT Sport HD 2. Since 9 May 2013, BT Sport has been heavily advertised and promoted.

- f. The Complainant owns UK and Community (European) trade mark registrations for BT, BT VISION and BT SPORT and a pending UK trade mark application for BT TV.
- g. The Complainant owns the domain names *btsport.co.uk*, *btsport.com* and *btsport.ie*.
- h. The Respondent registered the Domain Name *btivision.co.uk* on 27 March 2013; and the remaining three Domain Names on 13 May 2013.
- i. Only the Domain Name *btsporthd.co.uk* has an active website. Initially that website featured the image of a footballer and the wording "BIG TIME SPORT HD COMING SOON". Subsequently, after the Complainant's solicitors wrote to the Respondent, this was changed so as to feature the image of a skier with the wording "BIG TIME SPORT HOLIDAY DESTINATIONS".

5. Parties' Contentions

Complaint

The Complainant's submissions are as follows:

The Complainant has rights in respect of names and marks which are identical or similar to the Domain Names:

(1) The Complainant is one of the world's leading providers of communications solutions and services operating in 170 countries, and the major provider of telecommunications networks and services in the UK. The Complainant provides services to large corporate and public sector customers with operations across the world in a wide range of sectors such as banking and financial services, consumer packaged goods, logistics, pharmaceuticals and manufacturing. In the UK its principal offerings include networked IT services, local, national and international telecommunications services, higher-value broadband and internet products and services, broadcasting services including on demand TV and recently in the UK and Southern Ireland the provision of television sports channels. The Complainant contributes around £3bn annually to the UK Exchequer.

(2) The Complainant has registered over 1,500 trade marks comprising or incorporating the letters BT, covering a range of goods and services. In particular, the Complainant is the registered proprietor of registrations for the trade marks BT, BT VISION, BT SPORT and a pending application for BT TV in the UK (copies of the relevant registration certificates being annexed to the Complaint).

(3) The Complainant has registered the domain names *btsport.co.uk*, *btsport.com* and *btsport.ie*.

(4) The Complainant has used the trade mark and trading style BT continuously since 1991. Prior to that, the Complainant had already come to be

known by the general public and business people as “BT” even though its house mark previously was BRITISH TELECOM. The trade mark “BT” has been described by Lord Justice Aldous (in his judgement in the Court of Appeal in the case of British Telecommunications plc v. One In a Million Limited) as a “well known household name” referring exclusively to the Complainant. A tier one sponsor of the London 2012 Olympic Games, Lord Coe, Chairman of LOCOG stated “It is inconceivable that we could deliver the 2012 Games without BT on board. We needed someone we can trust, who could provide the technical know-how and the creative solutions to ensure our London 2012 Games are the very best they can be. BT gives us this.”

(5) Consequently, the extensive promotion and use of the BT marks have conferred unregistered rights in the goodwill that its activities have generated. The Complainant has acquired a significant goodwill and reputation in the BT name alone and with other names such as BT VISION, BT SPORT and BT TV, and its use by any third party in connection with any goods or services, whether alone or as part of another name, is likely to be considered by customers as use by or in some way connected with or authorised by the Complainant.

(6) The Complainant continually advertises its goods and services in major TV advertising, online and press campaigns. BT VISION, BT SPORT and BT TV have featured and continue to feature in the Complainant’s major TV advertising, online and press campaigns.

(7) The BT VISION subscription IPTV service was launched by the Complainant on 5th December 2006. BT VISION set top boxes are provided to customers by the Complainant on which over 50 Freeview channels are accessible besides on demand TV. The BT VISION service has been widely advertised in the UK and has become a well known trade mark in the UK broadcasting field. BT VISION HD is delivered by BT over the internet.

(8) BT TV, the umbrella name of BT VISION and BT SPORT was first used in May 2013. BT TV provides on demand content, 18 extra channels and four live sport channels through IPTV signals. There also are the two channels BT Sport 1 and BT Sport 2 (both channels also in HD) on the digital terrestrial platform, where over 50 Freeview channels are also accessible.

(9) On 9th May 2013, BT announced the roll out of its BT Sport service offering a range of sports channels to be launched on 1st August 2013. Based in the former International Broadcast Centre at the Queen Elizabeth Olympic Park in London, the BT Sport services are available on the BT Sport Channels, BT Sport 1 and BT Sport 2 and BT Sport HD 1 and BT Sport HD 2. BT TV, Sky and Virgin Media, via the BT Sport online player and the BT Sport mobile app. Since the roll out on 9th May 2013, BT Sport has been the subject of a massive advertising campaign on TV, online and in national newspapers and magazines. By 12th August 2013, less than 2 weeks after the launch of BT Sport, the 1 million subscriber mark for BT Sport had been passed. By 16th August 2013, over 10,000 commercial premises, including pubs, clubs and betting shops had subscribed to BT Sport. Consequently, BT Sport very rapidly has acquired a considerable and very valuable reputation in the UK.

The Domain Names, in the hands of the Respondent, are abusive registrations because:

(1) The Respondent registered 3 of the Domain Names (as far as indicated by the WHOIS information available to the Complainant) on 13 May 2013, and *btvision.co.uk* two weeks later [in fact, it was on 27 March 2013]. Only *btsporthd.co.uk* (and *btsporthd.com*, also registered by the Respondent on 13 May 2013 and the subject of a separate UDRP complaint by the Complainant) is active. Content on the site featured Premier League sporting images (as illustrated on the copy web page annexed to the Complaint). *btvisionhd.co.uk*, *btvision.co.uk* and *btvhd.co.uk* are “parked for free” on the Go Daddy website.

(2) There is no connection between the Respondent and the BT mark which could provide a legitimate explanation for the Domain Names.

(3) The Respondent’s use of the Domain Names is likely to cause public confusion and will be actionable as trade mark infringement under Section 10(2) of the UK Trade Marks Act 1994. In addition, BT, BT VISION and BT SPORT are well known trade marks within the UK and wider European Community due to the Complainant’s market leading position. The Respondent’s use of the Domain Names will take unfair advantage or, or be otherwise detrimental to the distinctive character of the BT, BT SPORT, BT VISION and BT TV trade marks in the UK contrary to Section 10(3) of the Trade Marks Act 1994.

(4) The Complainant believes it would be highly unlikely that the Respondent was not fully aware of the use of the BT Sport name by the Complainant prior to the registration of *btsporthd.co.uk* on 13 May 2013. The Complainant therefore considers that the registration of the Domain Names by the Respondent on 13 May 2013, 4 days after the roll out of the BT Sport service is a deliberate attempt to trade off the reputation of the Complainant’s goodwill and reputation in the BT Sport name and amounts to a false representation of an association or connection with BT, constituting an act of passing off.

(5) On 31st July 2013 CMS Cameron McKenna LLP, solicitors acting on behalf of the Complainant wrote to the Respondent alerting him to the Complainant’s rights in the BT Sport name and requiring that the Respondent undertake to assign the Domain Names to the Complainant (a copy being annexed). In his response (also annexed), the Respondent explains that *btsporthd.co.uk* is an abbreviated form of “Big Time Sport Holiday Destinations”. As an accurate abbreviation of “Big Time Sport Holiday Destinations” would be BTSHDHD, the Complainant considers the Respondent’s explanation for his registration of *btsporthd.co.uk* to be disingenuous. The Respondent said he had updated his website holding page to “reflect a more accurate representation of the services that we will be looking to offer” (a copy of the updated page being annexed).

(6) As the Complainant has only just discovered the registrations of *btvhd.co.uk*, *btvision.co.uk* and *btvisionhd.co.uk*, these were not mentioned in CMS Cameron McKenna LLP’s letter nor the Complainant’s subsequent letter to the Respondent, to which no response has been received. In this further letter, the Complainant advised the Respondent that as its UK trade mark registrations for both BT SPORT and BT cover “entertainment services” which include “sport, recreation and events”,

the Respondent's proposed activities under the *btsporthd.co.uk* domain name would infringe these registrations. The Complainant also advised the Respondent that checks it had conducted had revealed both *bigtimesporthd.co.uk* and *bigtimesporthd.com* to be available for registration. As of this date, these domain names are still available for registration.

(7) The Respondent's claim that the letters "HD" in the *btsporthd.co.uk* (and *btsporthd.com*) domain registrations stands for "Holiday Destination" is disingenuous, "HD" being a very well known abbreviation for "High Definition".

(8) As the Respondent has not agreed to cease use of the *btsporthd.co.uk* domain name, and has failed to respond to the Complainant's letter of 15 August 2013 within the 10 day deadline given or otherwise, and particularly bearing in mind the registration of the additional domain names consisting of or containing the Complainant's trade marks, the Complainant believes that the Respondent will infringe the Complainant's registered trade mark rights and attempt to pass off its business as associated with the Complainant's business, or assist others to do so by selling one or more of the Domain Names.

(9) The press announcement of the BT SPORT channels on 9th May 2013 was very high profile, and was covered on all national News Channels including the BBC and ITV, and featured in all national newspapers. The Complainant had registered *btsport.co.uk* (and *btsport.com* and *btsport.ie*) prior to the press announcement. Consequently, the Complainant believes that the Respondent's act of registering the Domain Names merely days following the press announcement was in bad faith and a calculated attempt to trade off or to profit immediately or in the future, from the Complainant's goodwill and reputation in its BT SPORT, BT VISION and BT TV trade marks. The fact that the updated home page of the Respondent's website at www.btsporthd.co.uk may dispel confusion, does not render the Respondent any less blameless for that initial confusion caused by adoption of the identical or closely similar Domain Name in the first instance.

(10) Where, as in this case, the Complainant's trade marks are so well known and recognised, then there can be no conceivable bona fide offering of goods or services that can be made by a third party without impacting on those rights.

(11) The registration and any use of the Domain Names will take unfair advantage of the Complainant's rights in the trade marks identical to or closely similar to the Domain Names, namely BT, BT SPORT, BT VISION and BT TV. This is detrimental to the Complainant's brand value. Furthermore, there has been no genuine offer by the Respondent to satisfy paragraph 4 a i A of the Policy.

(12) The Complainant considers that the Respondent will unjustly benefit from the Complainant's reputation and take unfair advantage of the Complainant's trade mark rights.

(13) The Respondent has registered over twenty *.co.uk* domain names, three of which are identical or closely similar to the Complainant's trade marks (a list of *.co.uk* domain names registered by the Respondent being annexed to the Complaint). This suggests that the Respondent could be engaged or has the

potential of being engaged in the business of registration and resale of domain names. The majority of the domain names correspond to “foods” which emphasises further the lack of justification on the part of the Respondent for registering the Domain Names which are identical to or closely similar to the Complainant’s trade marks and clearly are related to TV and sport.

(14) Due to the high profile announcement of the Complainant’s BT SPORT service which featured use of the BT VISION and BT TV trade marks, the Respondent would not have been unaware of the Complainant’s trade marks when he registered the Domain Names. In expressing an intention to continue to use the *btsporthd.co.uk* domain name despite being advised of the Complainant’s rights, and continuing to-date to use the domain name in respect of a live website, in the Complainant’s view, the Respondent is determined to trade off the goodwill and reputation of the Complainant’s business in the BT, BT SPORT, BT VISION and BT TV names and potentially infringe the Complainant’s trade marks. Therefore, the Complainant concludes that the circumstances surrounding the Respondent’s registration of the Domain Names are such that the Domain Names in the hands of the Respondent are abusive in accordance with paragraphs 3 a I A, B, 3 a ii, iii of the Policy and that the use by the Respondent is not a legitimate, non-commercial or fair use or would not be so.

Response

The Respondent has not filed a response.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities (here, in relation to each of the four Domain Names) that:

- i it 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 (as defined in paragraph 1 of the Policy).*

Complainant’s Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the nature of legally protectable goodwill in the names BT, BT VISION, BT SPORT, and BT TV; as well as Rights in the nature of registered trade marks for BT, BT VISION and BT SPORT. Disregarding the generic *.co.uk* suffix, and taking into account that “HD” is a well-known acronym for high definition television, each of the Domain Names is similar to the relevant name and mark in which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "Abusive Registration" as:

"A Domain Name which 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 a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The main factors under paragraph 3a which are relevant to this case are 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;**
- 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;"*

In considering whether the Domain Names are Abusive Registrations, it must firstly be taken into account that the Complainant's name and marks BT, BT SPORT and BT VISION are well-known and the Respondent must have been aware of them at the time when the Domain Names were registered; and during their subsequent use, in particular of the Domain Name *btsporthd.co.uk*.

The intent of the Respondent is made clear by the fact that the initial content of the website at *www.btsporthd.co.uk* had a prominent image of a footballer in the strip of a Premier League team. When the Complainant's solicitors wrote to the Respondent about the Domain Name *btsporthd.co.uk*, he claimed that his reason for registering it was that it stood for "Big Time Sport Holiday Destinations" and he planned to enter the market of "encompassing sporting events and participation of sports by families during their planned vacations". This attempted justification is simply not credible, for a number of reasons. Firstly, if that had been the case, the natural shorthand would have been BTSHD, not "BT Sport HD". Secondly, it is

not consistent with the image on the initial version of the Respondent's website, nor with the accompanying wording which was "BIG TIME SPORT HD". The latter would make no sense if it has genuinely been intended to refer to "holiday destinations" since "HD" is not known or used by members of the public, either at all or commonly, as an abbreviation with that meaning.

Thirdly, the Respondent cannot credibly claim to have registered and used the Domain Name *btsporhd.co.uk* without knowing that it corresponded directly with the HD (high definition) BT Sport channel and would be understood in that way. This conclusion is reinforced by the Respondent having also registered the Domain Names *btvision.co.uk* and *btvisionhd.co.uk*, both of which correspond to the name of another of the Complainant's services, namely BT Vision. It is also pertinent that the Respondent registered the Domain Name *btsporhd.co.uk* (as well as *btvhd.co.uk* and *btvisionhd.co.uk*) just four days after the high profile announcement by the Complainant of its forthcoming BT Sport television services. This timing is very unlikely to have been coincidental.

Taking everything into account, I find that the Respondent registered the Domain Names in full knowledge that they corresponded closely with the names of existing and planned services of the Complainant; and did so with the intent of either selling the Domain Names to the Complainant for an inflated price or using them to gain a commercial advantage by attracting traffic to corresponding websites as a result of people being misled into believing that such websites belonged to the Complainant.

In light of the above, it is clear that the Respondent's registration and use of the Domain Names has taken unfair advantage of and/or been unfairly detrimental to the Complainant's Rights, and that the Domain Names are therefore Abusive Registrations.

7. Decision

Having found that the Complainant has Rights in respect of names and marks which are identical or similar to the Domain Names, and that the Domain Names in the hands of the Respondent are Abusive Registrations, the Expert directs that the Domain Names *btvision.co.uk*, *btsporhd.co.uk*, *btvhd.co.uk* and *btvisionhd.co.uk* be transferred to the Complainant.

Signed: **Dated: 18 November 2013**
(Jason Rawkins)