

Nominet UK Dispute Resolution Service

DRS 13943

British Telecommunications PLC

and

Samuel Jackson

Decision of Independent Expert

1 Parties

Complainant: British Telecommunications PLC

Address: Intellectual Property Department, BT Legal C5, BT Centre
81 Newgate Street
London

Postcode: EC1A 7AJ

Country: United Kingdom

Respondent: Samuel Jackson

Address: 68 Angel Street
Hadleigh

Postcode: IP7 5EY

Country: United Kingdom

2 Domain names

<btsportextra.co.uk>
<btsportfootball.co.uk>
<btsportgolf.co.uk>
<btsportlive.co.uk>
<btsporthome.co.uk>
<btsportonline.co.uk>
<btsporthorses.co.uk>
<btsportrugby.co.uk>
<btsportbetting.co.uk>

3 Procedural History

- 3.1 On 6 March 2014 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent on 7 March 2014. The respondent made no response. The complainant requested referral of the matter for a full expert decision under the Procedure, and on 31 March 2014 paid the applicable fee.
- 3.2 I was appointed as expert on 14 April 2014. I have made the necessary declaration of impartiality and independence.

4 Factual background

- 4.1 The complainant is a well-known telecommunications company. It provides telephone, broadband internet and television services in the UK and abroad. It is well known in the UK simply as “BT”.
- 4.2 The domain names were registered by the respondent on 19 May 2013.

5 Parties’ Contentions

Complainant

- 5.1 The complainant says it has UK and Community trade marks for the mark BT, and a UK trade mark for the mark BT SPORT.
- 5.2 It says that on 9 May 2013, it announced its “BT Sport” service offering a range of television sports channels, and that this was followed by a major advertising campaign.

- 5.3 It argues that because of the high profile announcement of “BT Sport”, the respondent must have been aware of its rights when he registered the domain names. It says the respondent has not denied that he knew about its rights when he registered the domain names.
- 5.4 The complainant says that the registration of the domain names on 19 May 2013, days after the announcement of its “BT Sport” service earlier that month, was an attempt to trade off and profit from the complainant’s goodwill and reputation in the BT and BT SPORT marks by offering the domain names for sale.
- 5.5 The complainant says that, in e-mail correspondence in February 2014, the respondent wrote that he did intend to sell the domain names as he “thought they would be a popular target for anyone wishing to make a review forum for sports which BT broadcast”.
- 5.6 It argues that the website connected to each domain name prominently features the domain names as being for sale, and that this shows that the respondent registered the domain names in order to sell them for a profit.
- 5.7 The complainant says the respondent has no possible legitimate, non-commercial or fair use for the domain names.
- 5.8 The complainant says the respondent's use of the domain names is likely to cause confusion.
- 5.9 It says the registration and any use of the domain names will take unfair advantage of its rights, and that this will damage its reputation.
- 5.10 The complainant says the circumstances surrounding the respondent’s registration of the domain names are such that, in the hands of the respondent, they are abusive registrations.

Respondent

- 5.11 The respondent has provided no response.

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show 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

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has produced documentary evidence from the UK Intellectual Property Office of its registration of a UK trade mark, and from the Irish Patents Office of its registration of an Irish trade mark, both in relation to the mark BT SPORT.
- 6.4 At the third level (i.e. disregarding “co.uk”), the complainant's trade mark is the first, and arguably conceptually dominant, element of each of the domain names. It makes up more than half of the characters in seven of the domain names, half of the characters in one of them (<btsportbetting.co.uk>) and just under half in another (<btsportfootball.co.uk>).
- 6.5 In any event, the inclusion of the complainant's mark at the beginning of each of the domain names means that similarity to the complainant's mark is built in to each of them.
- 6.6 The inclusion of additional characters does not make any of the domain names dissimilar to the mark.
- 6.7 Three of the domain names (<btsportfootball.co.uk>, <btsportrugby.co.uk>, <btsportgolf.co.uk>) include additional strings of characters, each making up the name of a sport (football, rugby and golf). The inclusion of the additional characters does not, therefore, make those domain names dissimilar to the complainant's mark.
- 6.8 The domain name <btsporthorses.co.uk> contains a string making up the additional word “horses”, which has a clear connection in many people's minds to the sport of horse racing. Again, therefore, the inclusion of the additional word does not make that domain name dissimilar to the complainant's mark.
- 6.9 The domain name <btsportbetting.co.uk> contains a string making up the additional word “betting”, which is likely to be read by many internet users as referring to any activity many people associate with sport, and with watching sport. The inclusion of the additional word does not, therefore, make that domain name dissimilar to the complainant's mark.
- 6.10 The domain names <btsportlive.co.uk>, <btsporthome.co.uk> and <btsportonline.co.uk> each contains a string making up an additional word which is likely to be read by many internet users as particularly connected with watching

sport using services such as the complainant's. Someone interested in sport may well want to watch it live, at home and (if they are an internet user finding this domain name) online. The inclusion of these additional words does not, therefore, make any of these domain names dissimilar to the complainant's mark.

6.11 The domain name <btsportextra.co.uk> contains a string making up the additional word "extra". Conceptually this implies the offer of something additional to, but not different from, the first and arguably dominant element of the domain name – which is the complainant's mark. Nor is the additional word free of associations with sports broadcasting: two well-known UK sports broadcasters offer the services "5 Live sports extra" and "Sky Sports Xtra". The inclusion of the additional word does not, therefore, make this domain name dissimilar to the complainant's mark.

6.12 In those circumstances, I am satisfied that the complainant has rights in respect of a mark which is similar to each of the domain names.

Abusive Registration

6.13 Under paragraph 1 of the Policy, abusive registration means a domain name which either:

- 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 took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

6.14 Under paragraph 3(a)(i)(A) of the Policy, circumstances indicating that the respondent has registered a domain name primarily for the purposes of selling to the complainant for more than his costs of acquiring or using the domain name may be evidence of abusive registration.

6.15 The complainant has produced evidence, in the form of screen captures, showing that the respondent has offered each of the domain names for sale.

6.16 The respondent must have had the complainant in mind at the time he registered the domain names, given how well known the complainant is, and particularly given that he registered the domain names shortly after the complainant launched "BT Sport".

6.17 It isn't obvious what legitimate use can be made of the domain names by any potential buyer other than the complainant.

- 6.18 But even if I'm wrong about that, the fact that some legitimate use might be made of any of the domain names, if read in a way that's not immediately obvious, would not affect my view about the respondent's intentions at the time of registration. The fact that he registered nine domain names similar to the complainant's mark all at the same time, none of which has obvious potential for legitimate use other than by the complainant, suggests the respondent had the complainant in mind as the potential buyer.
- 6.19 It's hard to see why anyone would register the domain names for the purpose of selling them, unless he hoped to make a profit.
- 6.20 For those reasons, in my view the complainant has established a prima facie case that the respondent registered all nine domain names primarily for the purposes of selling them to the complainant for a profit.
- 6.21 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using a domain name in a way which has confused or is likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.
- 6.22 In my view the similarity between the complainant's mark and each of the domain names is likely to cause some initial interest confusion on the part of internet users. Given the similarity between each of the domain names and the complainant's mark, in my view it is likely a speculative visitor to a website connected to any of the domain names would hope and expect that it is connected with the complainant.
- 6.23 Admittedly none of the domain names is identical to the complainant's mark, without adornment – which according to paragraph 3.3 of the DRS experts' overview is the type of case in which a finding of abuse because of initial interest confusion is most likely. But nor is this a case in which any of the domain names can be said to be conceptually far away from the complainant's mark. On the contrary: in each of the domain names, as I explained at paragraphs 6.6 to 6.11 above, the complainant's mark has had appended to it a word that has some sort of association with the complainant's commercial activity.
- 6.24 For those reasons, in my view the complainant appears to have used each of the domain names in a way likely to confuse people into believing it is connected with the complainant.
- 6.25 It is for the complainant to make good its case. However, for the reasons I have given the evidence before me establishes a prima facie case of abusive registration. The respondent has provided no response.
- 6.26 In those circumstances I am satisfied on the balance of probabilities that at the

time of their registration each of the domain names took unfair advantage of the complainant's rights; and that each of them has been used in a manner which took unfair advantage of the complainant's rights. I am satisfied that each of the domain names, in the hands of the respondent, is an abusive registration.

7 Decision

- 7.1 I find that the complainant has rights in a mark which is similar to each of the domain names; and that each of the domain names, in the hands of the respondent, is an abusive registration.
- 7.2 The complaint is upheld. I direct that all the domain names be transferred to the complainant.

Carl Gardner

8 May 2014