

DISPUTE RESOLUTION SERVICE

D00015906

Decision of Independent Expert

British Broadcasting Corporation

and

Identity Protect Limited

1. The Parties:

Complainant: British Broadcasting Corporation
Broadcast Centre
201 Wood Lane
BC2/B6
London
W12 7TP
United Kingdom

Respondent: Identity Protect Limited
PO Box 795
Godalming
Surrey
GU7 9GA
United Kingdom

2. The Domain Name:

televisionlicensing.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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

07 May 2015 12:58 Dispute received
08 May 2015 08:29 Complaint validated
08 May 2015 08:37 Notification of complaint sent to parties
28 May 2015 02:30 Response reminder sent
02 June 2015 10:59 No Response Received
02 June 2015 10:59 Notification of no response sent to parties
08 June 2015 12:17 Expert decision payment received

4. Factual Background

The Complainant is funded by television licence fees, which are regulated under the Communications (Television Licensing) Regulations 2004. Since 1991, the Complainant has had the sole authority, under statute, to issue television licences in the United Kingdom, the Channel Islands and the Isle of Man, including responsibility for licence fee collection and enforcement. Since February 6, 2009, the Complainant has been the registered proprietor of the United Kingdom trade mark TV LICENSING (with image), No. UK0002479504A. A television licence can be purchased and contact details may be updated, *inter alia*, by visiting the Complainant's official website at <www.tvlicensing.co.uk>. The <tvlicensing.co.uk> domain name appears on all bills sent by the Complainant to customers for television licences.

The Domain Name was registered in the name of the Respondent, a privacy service, on November 17, 2013. The identity of the Respondent's customer is not known to the Complainant. At first the Domain Name resolved to a website offering television licensing services similar to those offered by the Complainant, including the provision of television licences for £291, an amount exceeding the prescribed fee of £145.50. In some cases the prescribed fee was not passed on to the Complainant, with the consequence that those customers remained unlicensed after having applied for and paid for a new or renewed television licence through the Respondent's website. Unlicensed use of television equipment is a criminal offence under section 363 of the Communications Act 2003.

Following an approach by the Complainant to the relevant Internet Service Provider on November 17, 2014, the Respondent's website was disabled but was subsequently revived through a different Internet Service Provider, with a disclaimer on the home page: "We are not affiliated with the british broadcasting corporation, the uk government or any official body". When the Complainant learned of this, it approached the new Internet Service Provider, which disabled the website on January 21, 2015.

As of February 24, 2015, the Complainant had received 82 expressions of dissatisfaction from customers of the Respondent, all of whom had been exposed to the risk of a significant period of unlicensed use after having paid the Respondent for a licence. Most of the expressions of dissatisfaction were received after the disclaimer appeared on the Respondent's website.

5. Parties' Contentions

Complainant

The Complainant says the Domain Name is identical or similar to the Complainant's TV LICENSING trade mark, since "TV" is widely understood to be an abbreviation of "television".

No other body or persons are authorised to sell a television licence or to use the Complainant's TV LICENSING trade mark without the Complainant's express consent. The Complainant has not authorised the Respondent to sell television licences or to use its TV LICENSING trade mark and has never had a relationship with the Respondent.

The Complainant submits that there is a likelihood of confusion, which has manifested itself in actual confusion on the part of the public, that the Domain Name is connected with or actually is the official TV LICENSING mark.

The Complainant also considers that the Domain Name has been registered primarily to prevent the Complainant from registering it. The Respondent would have been aware of the Complainant's official domain name <tvlicensing.co.uk> because it appears on all television licence bills and a simple Google search would reveal it.

The Complainant further contends that the Respondent's activity under the Domain Name unfairly disrupts the Complainant's business by charging almost double the normal licence fee or by providing change of address details services, which in many cases are not actioned for the customer by the Respondent.

It is said that this disruption is causing damage to the Complainant's ability to collect a licence fee. There have been instances where the Respondent has not only charged an almost double premium for providing a television licence but then has not requested a licence for the customer and therefore the Respondent has not passed on the licence fee to the Complainant. Accordingly such customers remain unlicensed.

The complaints which the Complainant has received from members of the public are relied upon as evidence of the confusion caused amongst the public by registration and/or use of the Domain Name. This confusion is exacerbated by the similarity of the Respondent's website (in terms of its look, feel and layout) to that of the Complainant's official website <www.tvlicensing.co.uk>.

The disclaimer latterly introduced by the Respondent has done very little to reduce the confusion caused amongst members of the public, as evidenced by complaints received after the insertion of the disclaimer, which demonstrate that members of the public believed the Domain Name was under the Complainant's control when it was not.

The Complainant submits that the Respondent has purposely tried to deceive members of the public into believing that the Domain Name is under the Complainant's control and that the services offered are those provided by the Complainant. Transfer of the Domain Name to the Complainant will prevent

further harm to members of the public and allow the Complainant to continue with its statutory obligations effectively.

Respondent

As noted above, there was no Response.

6. Discussions and Findings

Paragraph 2 of the Nominet DRS Policy requires that, for the Complainant to obtain transfer to it of the Domain Name, it 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 at issue; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The absence of a Response does not lead to an automatic finding in favour of the Complainant, however appropriate inferences may be drawn pursuant to paragraph 15c of the Nominet DRS Procedure.

Rights

The Complainant has provided evidence of its United Kingdom registration of trademark No. UK0002479504A comprising the words TV LICENSING together with the depiction of a tick emerging from a circle. The dominant element of the mark is the words TV LICENSING.

I accept the Complainant's submission that "TV" is widely understood to be an abbreviation of "television". The Domain Name <televisionlicensing.co.uk> conveys the same meaning as the words of the Complainant's mark. The inconsequential ".co.uk" suffix may be ignored. Accordingly, I am satisfied that the Complainant's mark is similar to the Domain Name.

The Complainant has established this element.

Abusive Registration

Abusive Registration is defined in Paragraph 1 of the Policy 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 the Domain Name is an Abusive Registration, including paragraph 3(a)(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."

As stated in paragraph 3.3 of the DRS Experts' Overview Version 2:

“The ‘confusion’ referred to in paragraph 3(a)(ii) of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”?

...

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. 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 an Internet user guessing the URL for the Complainant’s web site will use the domain name for that purpose.

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.”

I consider that the Complainant’s TV LICENSING trademark is well known because the Complainant is the sole authorised provider of television licences and has long been using that mark and the corresponding domain name. Accordingly, people who know of the trademark and become aware of or guess the Domain Name, including people who have previously dealt with the Complainant, are likely to be confused into believing that the Domain Name belongs to the Complainant.

Further, people who were aware of the Complainant and that the Complainant provides television licences, upon arriving at the website to which the Domain Name resolved before it was suspended for the second time, and upon seeing the image and reading the text as it was, both prior to and after the addition of the disclaimer, were likely to be confused into believing that it was a site operated by the Complainant. Indeed the Complainant has demonstrated that some were actually confused in this way.

Accordingly I am satisfied that the Complainant has proved, on the balance of probabilities, that the Respondent has used the Domain Name in a way which has confused and is likely to confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant and that the Domain Name has thus been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. Accordingly I find that, in the hands of the Respondent, the Domain Name is an Abusive Registration.

7. Decision

I find that the Complainant has proved, on the balance of probabilities, that it has rights in a mark which is similar to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent.

I therefore direct that the Domain Name <televisionlicensing.co.uk> be transferred to the Complainant.

Signed: Alan Limbury

Dated: June 19, 2015