

# Nominet UK Dispute Resolution Service

**DRS 15947**

British Telecommunications PLC

and

Sapphire Brands

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## Decision of Independent Expert

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### 1 Parties

Complainant: British Telecommunications PLC

Address: 81 Newgate Street  
London

Postcode: EC1A 7AJ

Country: United Kingdom

Respondent: Sapphire Brands

Address: Seaton House  
17 Seaton Place  
St. Helier

Postcode: JE1 1BG

Country: Jersey

## 2 Domain names

<bt2sip.co.uk>	<btcatchup.co.uk>
<btcatchuptv.co.uk>	<bthoo.co.uk>
<btiptv.co.uk>	<btondemand.co.uk>
<btondemandtv.co.uk>	<btpad.co.uk>
<bttosip.co.uk>	<btwho.co.uk>
<plusnetcatchup.co.uk>	<plusnetcatchuptv.co.uk>
<plusnetiptv.co.uk>	<plusnetondemandtv.co.uk>
<plusnettv.co.uk>	

## 3 Procedural History

- 3.1 On 22 May 2015 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 the same day. No response was received. The complainant requested referral of the matter for expert decision under the Procedure, and on 23 June 2015 paid the applicable fee.
- 3.2 I was appointed as expert on 26 June 2015. I have made the necessary declaration of impartiality and independence, confirming that I am independent of each of the parties and that 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.
- 3.3 On 15 July 2015 I made a request to the complainant under paragraph 13(a) of the Procedure for Annexes 1, 2 and 4 which I had been unable to access. In addition I requested any further evidence on the question whether the complainant has rights in respect of the five domain names containing the string “plusnet”.
- 3.4 The complainant answered the request on 21 July 2015. There was no response from the respondent.

## 4 Factual background

- 4.1 The complainant is a well-known telecoms business. “BT” and “Plusnet” are well known brands in the UK in communications and internet services.
- 4.2 The respondent registered the domain names between 16 February and 17 December 2012.

## 5 Parties' Contentions

### *Complainant*

- 5.1 The complainant says it has registered over a thousand trade marks comprising or incorporating the letters BT, and that it owns the UK trade mark "BT". It argues that this is a well-known household name. The complainant considers that the domain names amount to a false representation of an association or connection with BT.
- 5.2 The complainant explains that in 2013, it announced and launched "BT Sport" services providing a range of live sporting events and related content via TV channels operated under the names BT Sport1 and BT Sport2 among others.
- 5.3 The complainant says in the complaint that it is the owner of Plusnet PLC and its corresponding intellectual property rights. In response to my request under paragraph 13(a) of the Procedure (see paras. 3.3-3.4), it says both it and Plusnet PLC are wholly owned subsidiaries of BT Group PLC.
- 5.4 The complainant argues that the dominant and only distinctive part of the domain names is "BT" or "Plusnet". The other elements are entirely descriptive words or acronyms. The complainant argues that mere addition of generic words to a trade mark does not render the resulting domain name distinguishable from its trade mark, and that where a domain name wholly incorporates a trade mark there is similarity.
- 5.5 The fact that the respondent is not using any of the domain names does not, the complainant argues, remove the potential for confusion which would inevitably arise if the domain names are put to use.
- 5.6 The complainant argues that there is no legitimate, non-commercial or fair use possible for the domain names by the respondent. Any use of the domain names by the respondent would take unfair advantage of the complainant's rights. The respondent is unjustly benefiting from the complainant's reputation and taking unfair advantage of its trade mark rights, or at least has the potential to do so.
- 5.7 The complainant argues that the respondent (or a company associated with it) routinely engages in patterns of activity within the meaning of paragraph 3(a)(iii) of the Policy. The complainant argues that the respondent is well aware of its rights and continually makes efforts to confuse and divert BT and Plusnet customers.

### *Respondent*

- 5.8 There is 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 Patent Office of its UK trade mark registration for the mark “BT”.
- 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 ten of the domain names. 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.
- 6.5 The inclusion of additional characters does not make any of the domain names dissimilar to the mark.
- 6.6 Four of the domain names (<btondemandtv.co.uk>, <btondemand.co.uk>, <btcatchuptv.co.uk> and <btcatchup.co.uk>) include additional strings of characters, each of which appears to refer to on-demand or catch-up television, a service provided by the complainant under the BT brand. A fifth domain name, <btiptv.co.uk>, also includes the letters “tv”. The inclusion of these additional characters does not, therefore, make those domain names dissimilar to the complainant's BT mark.
- 6.7 Two of the domain names (<bt2sip.co.uk> and <bt2sip.co.uk>) contain the three letter string “sip”. The abbreviation SIP can as I understand it refer to a voice-over-internet telecommunications protocol, so that those characters may arguably bring to mind the complainant's services in some consumers' minds. Again therefore, the inclusion of the additional characters does not make those domain names dissimilar to the complainant's BT mark.
- 6.8 Three of the domain names (<bthoo.co.uk>, <btwho.co.uk> and <btpad.co.uk>) contain only three letters in addition to the complainant's BT mark. Their inclusion does not make those domain names dissimilar to the complainant's BT mark, given their built-in similarity to it (see para. 6.4).
- 6.9 In those circumstances, I am satisfied that the complainant has rights in respect of a mark similar to the ten domain names containing the two-letter string “bt”.

- 6.10 But the complainant has produced no evidence that it has a name or mark similar to the string “plusnet” contained in the other five domain names.
- 6.11 The complainant says in the original complaint that it owns Plusnet PLC and all that company's intellectual property, but has produced no evidence of Plusnet PLC's intellectual property.
- 6.12 In addition, it appears from the complainant's response to my paragraph 13(a) request that Plusnet PLC is in fact owned by a separate company, BT Group PLC, and not by the complainant itself. The complainant cannot be treated for the purposes of the DRS as having any rights Plusnet PLC may hold, simply because the two companies are owned by a common parent.
- 6.13 Paragraph 1.1(a) of the DRS Experts' Overview (Version 2) says —
- The Complainant should be the owner/licensee of the Rights in the name or mark, which the Complainant contends is identical or similar to the domain name in dispute. Surprisingly often, complaints under the DRS Policy (“the Policy”) are lodged in the names of persons and entities not demonstrably the proprietor of the relevant Rights.*
- 6.14 This appears to be just such a case, and that so far as five of the domain names are concerned, the complaint has been lodged in the name of an entity not demonstrably the owner of relevant rights.
- 6.15 It is of course open to the holder of any trade mark or other rights in respect of the name or mark “PLUSNET” to bring a complaint under the DRS in respect of these five domain names, if it wishes to do so.
- 6.16 But no evidence is before me that the complainant in this case, BT Communications PLC, owns or has any interest in any trade mark for the mark “PLUSNET”, or any other rights in that name.
- 6.17 I am not therefore satisfied that has rights in respect of a name or mark which is similar to the five domain names that contain the string “plusnet”.
- 6.18 That being so, I need go on to consider only whether the ten “bt” domain names are abusive registrations.

#### *Abusive Registration*

- 6.19 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.

6.20 Under paragraph 3(a)(ii) of the Policy, circumstances indicating that the respondent is using or threatening to use the domain name in a way likely to confuse people into believing it is connected with the complainant may be evidence of abusive registration.

6.21 No evidence has been produced that any of the domain names has been used for the purposes of a website, or for e-mail.

6.22 But as paragraph 1.3 of the DRS Experts' Overview says —

*some Experts have found that in certain circumstances, e.g. where the name is a known brand and the Respondent has no obvious justification for having adopted the name and has given no explanation, the non-use itself can constitute a threatened abuse hanging over the head of the Complainant.*

6.23 The complainant's "BT" trade mark is a very well-known brand.

6.24 Five of the domain names (<btondemandtv.co.uk>, <btondemand.co.uk>, <btcatchuptv.co.uk>, <btcatchup.co.uk> and <btiptv.co.uk>) not only contain the complainant's mark as their first and arguably dominant element, but contain additional strings of letters which mean that, read naturally as a whole, they refer to the complainant and its services.

6.25 The respondent has not given any justification for having registered those particular domain names, and there is no obvious explanation for it.

6.26 In those circumstances it is reasonable to regard the respondent's registration of these five domain names as in itself a threatened abuse of them.

6.27 Under paragraph 3(a)(iii) of the Policy, it may be evidence of abusive registration if the complainant can demonstrate that the respondent is engaged in a pattern of registrations corresponding to well-known names or trade marks in which the respondent has no apparent rights, and the domain name in question is part of that pattern.

6.28 The complainant has produced evidence that the respondent has registered a total of ten domain names corresponding in part to the well-known BT trade mark.

6.29 In addition, although it has not established rights in the name or mark "PLUSNET", that is also a well-known brand in the UK in the field of internet services; and the complainant has produced evidence that the respondent has registered a total of five domain names corresponding in part to it.

6.30 It does therefore seem on the face of it that the respondent is engaged in a pattern of registrations corresponding to well-known names or trade marks in which it has no apparent rights.

6.31 Paragraph 3.5 of the DRS Experts' Overview suggests experts have taken two approaches to the question whether any particular domain name forms part of such a pattern. On one approach —

*There must be evidence to justify the linking of the domain name in issue to the other objectionable domain names. The link may be found in the names themselves and/or in the dates of registration, for example.*

6.32 On the other approach —

*If the domain name in issue is a well-known name or mark of the Complainant and the Respondent is the proprietor of other domain names featuring the well-known names or marks of others, the pattern is likely to be established, even if there is no obvious link between the names or the manner or their dates of registration.*

6.33 In my view, on either approach the remaining five domain names (<bt2sip.co.uk>, <btosip.co.uk>, <bthoo.co.uk>, <btwho.co.uk> and <btpad.co.uk>) appear to form part of that pattern.

6.34 The five remaining domain names are linked to the other objectionable domain names because they all relate to the complainant's trade mark "BT" (as do five of the other domain names forming the pattern) and because they all relate to brands used by the BT Group (as do all ten of the other domain names forming the pattern). The link is therefore found in the names themselves.

6.35 In addition they are to some extent linked by date, all 15 domain names in this case having been registered in 2012.

6.36 In any event, the five remaining domain names relate in part to a well-known mark of the complainant, and the respondent owns other domain names (i.e. all ten other domain names which are the subject of this complaint) featuring the well-known names or marks of others.

6.37 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 in relation to the ten "bt" domain names. The respondent has provided no explanation for its registration of those domain names.

6.38 In those circumstances I am satisfied on the balance of probabilities that those domain names, in the hands of the respondent, are abusive registrations.

## **7 Decision**

7.1 I find that —

- the complainant has rights in a mark which is similar to ten of the domain names (<bt2sip.co.uk>, <btcatchup.co.uk>, <btcatchuptv.co.uk>, <bthoo.co.uk>, <btiptv.co.uk>, <btondemand.co.uk>, <btondemandtv.co.uk>, <btpad.co.uk>, <btosip.co.uk> and <btwho.co.uk>); and that
- those ten domain names, in the hands of the respondent, are abusive registrations.

7.2 The complaint is upheld as regards those domain names. I direct that they be

transferred to the complainant.

- 7.3 The complaint is dismissed as regards the other five domain names (<plusnetcatchup.co.uk>, <plusnetcatchuptv.co.uk>, <plusnetiptv.co.uk>, <plusnetondemandtv.co.uk> and <plusnettv.co.uk>).

Carl Gardner

28 July 2015