

# DISPUTE RESOLUTION SERVICE

D00016471

## Decision of Independent Expert

Plusnet plc

and

Sapphire Brands

### 1. The Parties:

Lead Complainant: Plusnet plc  
PP C5A BT Centre, 81 Newgate Street  
London  
EC1A 7AJ  
United Kingdom

Respondent: Sapphire Brands  
Seaton Hse 17 Seaton Place  
St. Helier  
Jersey  
JE1 1BG  
United Kingdom

### 2. The Domain Names:

plusnetcatchup.co.uk  
plusnetcatchuptv.co.uk  
plusnetiptv.co.uk  
plusnetondemandtv.co.uk  
plusnettv.co.uk  
("the Domain Names")

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

04 September 2015 15:22 Dispute received  
07 September 2015 11:45 Complaint validated  
07 September 2015 13:33 Notification of complaint sent to parties  
24 September 2015 02:30 Response reminder sent  
29 September 2015 09:08 No Response Received  
29 September 2015 09:15 Notification of no response sent to parties  
02 October 2015 10:32 Expert decision payment received

### **4. Factual Background**

The Complainant, which is owned by British Telecommunications plc ("BT"), has traded as a broadband provider under the name "Plusnet" since 1997. It spent some £11 million on marketing in each of the last two financial years. The Complainant's revenues exceeded £270 million last year and, as of August 2015, it had some 950,000 customers.

The Complainant owns Community Trade Mark No. 4265989 for PLUSNET, filed on 1 February 2005, in classes 9, 38 and 42.

The Respondent registered the Domain Names on 14 December 2012. There is no evidence that they have ever been used for websites.

BT announced its BT Sport broadcast services in May 2013 and the Complainant launched a TV service in May 2015.

### **5. Parties' Contentions**

#### Complaint

A summary of the Complaint is as follows:

The Complainant has acquired a considerable goodwill and reputation in the trade mark "Plusnet".

The dominant and only distinctive part of the Domain Names is the "Plusnet" element. The other elements are entirely descriptive words or acronyms. Mere addition of generic words to a trade mark does not render the resulting Domain Names distinguishable from the trade mark.

The Respondent is part of a deliberately labyrinthine network of companies, which is designed to confuse customers as to the source of the telecommunications goods and services which those companies offer for sale.

In 2013, the telecommunications regulator Ofcom fined Supatel Ltd, a company connected with the Respondent, for mis-selling ISP services.

The Respondent was well aware of the Complainant's rights when it registered the Domain Names.

As the Complainant's trade mark is well known and recognised, there can be no conceivable *bona fide* offering of goods or services by a third party without impacting on those rights. There is no possible legitimate, non-commercial or fair use possible for the Domain Names.

The Respondent has set out to confuse and divert the Complainant's customers to its own services.

The Respondent has engaged in a pattern of activity which is contrary to paragraph 3(a)(iii) of the Policy. The Respondent has registered other domain names comprising the name of a telecoms provider plus similar generic terms to those in the Domain Names, for example talktalkcatchuptv.co.uk and btcatchuptv.co.uk.

### Response

No Response was filed.

## **6. Discussions and Findings**

### General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

### Complainant's Rights

The meaning of "Rights" is clarified and defined in the DRS Policy in the following terms:

***"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"***

The Complainant has established Rights in the term “Plusnet” arising from its registered trade mark. The Complainant has also demonstrated Rights in the form of unregistered trade mark rights in that name deriving from its extensive use thereof.

The trade mark is similar to the Domain Names, each of which consists of the Complainant’s trade mark followed by a range of generic terms.

#### Abusive Registration

Is the Domain Name an Abusive Registration in the hands of the Respondent? Paragraph 1 of the DRS Policy defines “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 took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”*

For the following reasons, taken together, I consider that the Domain Names were registered in a manner which took unfair advantage of, or was unfairly detrimental to, the Complainant’s Rights:

1. The Domain Names are dominated by the Complainant’s distinctive trade mark.
2. The Complainant asserts that the Respondent is part of a group of companies which compete with the Complainant to some degree. The Complainant has provided no supporting evidence but, on the other hand, the Respondent has not appeared in the proceedings to deny the link.
3. Whether or not the Respondent or its group compete with the Complainant, I find it difficult to conceive of any legitimate reason why the Respondent would wish to register the Domain Names and there is no explanation from the Respondent. In my view, on the balance of probabilities, the Domain Names were registered in order to profit at the Complainant’s expense from the Complainant’s potential involvement in internet broadcasting / TV-related services (which did in fact occur in 2015 with the launch of “YouView TV from Plusnet”).
4. The Domain Names are part of a clearly illicit pattern of other domain names registered by the Respondent consisting of the name of a well-known telecommunications business plus generic terms relating to TV / internet broadcasting, similar to those included in the Domain Names.

## **7. Decision**

I find that the Complainant has Rights in a mark which is similar to the Domain Names and that the Domain Names are, in the hands of the Respondent, Abusive Registrations. I therefore direct that the Domain Names, plusnetcatchup.co.uk, plusnetcatchuptv.co.uk, plusnetiptv.co.uk, plusnetondemandtv.co.uk and plusnettv.co.uk be transferred to the Complainant.

Signed: Adam Taylor

Dated: 20 October 2015