

DISPUTE RESOLUTION SERVICE

D00016918

Decision of Independent Expert

Yahoo! Inc.

and

Divya Taneja

1. The Parties:

Complainant: Yahoo! Inc.
701 First Avenue
Sunnyvale
Santa Clara
CA 94089
United States

Respondent: Divya Taneja
C,40-44 Lajpat Nagar
New Delhi - 110024
India

2. The Domain Name(s):

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

05 January 2016, the Dispute was received.

06 January 2016, the Complaint was validated.

06 January 2016, the notification of the Complaint was sent to the Parties.

25 January 2016, the Response reminder was sent.

28 January 2016, no Response was received.

28 January 2016, the notification of no Response was sent to the Parties.

03 February 2016, the Expert decision payment was received.

4. Factual Background

- 4.1 The Respondent registered the Domain Name on 12 August 2015.
- 4.2 The Complainant is a US company incorporated in Delaware which provides, among other things, web directory services. It has its registered office in California, with offices throughout the Americas, Asia Pacific ('APAC') and the Europe, Middle East and Africa ('EMEA') regions.
- 4.3 The Complainant is the proprietor of a number of Community trade mark registrations for *YAHOO!* (the 'Name') (e.g. Reg Nos. 176396, 693127, and 1076181) (the 'Mark'), such trade marks having been registered prior to the registration of the Domain Name.

5. Parties' Contentions:

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

- 5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons below.

The Complainant's Rights

- The Complainant submitted that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.
- The Complainant submitted that "*the YAHOO! mark has been in continuous use since at least 1994*", and it "*either directly, or indirectly operates many other sites under the [Mark].*"
- The Complainant submitted that it has been continuously ranked as one of "*the most trusted, powerful, and valuable global brands*" and it referenced various branding indexes in support (e.g. the "*2015 Siegel+Gale Global Brand Simplicity Index*", and "*2014 and 2015 100-top Most Powerful Brands by Tenet Partners*").
- The Complainant contended that the Domain Name incorporates the entirety of the Mark, combined with the words "*help*" and "*number*" that are highly related to its customer services, noting that it provides support services free of charge for its products and has an online support portal, "*Yahoo! Help*", at *help.yahoo.com*.

- The Complainant contended that the distinctive component of the Domain Name is the string of characters, “YAHOO”, and that the distinct combination of letters will be seen by Internet users as the Mark “*coupled with the merely descriptive or generic phrase “Help number”.*” Further, the Complainant contended that the exclamation point in the Mark “*cannot technically even be included in the Domain. The exclamation point also makes no difference in how the mark is pronounced.*”
- The Complainant submitted that the addition of the ccTLD string “.co.uk” generally does not negate the similarity of the Domain Name with the Mark.

Abusive Registration

- The Complainant submitted that the Domain Name, in the hands of the Respondent, is an Abusive Registration as the Domain Name has been used and/or was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.
- In this regard, the Complainant submitted that the Respondent registered the Domain Name for the purpose of unfairly disrupting the Complainant’s business (paragraph 3 a. i. C. of the Policy).
- The Complainant contended that the Respondent’s registration and use of the Domain Name was and is intended to “*mislead and deceive unsuspecting users by falsely creating an impression of a commercial connection or affiliation with Yahoo*” and this “*diverts traffic from legitimate free Yahoo! Help resources for*” the Respondent’s own financial gain.
- The Complainant further submitted that the Respondent is using the Domain Name in a way that 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 (paragraph 3 a. ii. of the Policy).
- The Complainant stated that the Respondent uses the Domain Name to make its social media pages on the website pointed to the Domain Name (the ‘Website’) “*appear legitimate.*”
- The Complainant submitted that the Website was not only developed in a way that is likely to cause confusion when visiting the site based on its title, layout, and design, but has been used through search engine optimisation as evidenced by the keywords in the meta data, and in social media, to spoof the Complainant’s identity.
- In particular, the Complainant contended that the Domain Name is being used specifically to divert traffic intended for the Complainant

by “*deceiving Yahoo users into mistakenly believing that they may obtain YAHOO! Help such as recovering their password, through*” the Domain Name. Further, the Complainant submitted that the Respondent utilises “*deceptive descriptions and keyword search optimization in meta data on the Domain, and displays the Domain in the context of social media spoofing Yahoo’s established identity to divert traffic to*” the Domain Name.

- The Complainant contended that the Respondent had “*already caused actual confusion spoofing Yahoo’s identity*” in relation to a ‘.com’ domain name, noting that it had been contacted by the Consumer Protection Bureau, Office of the Attorney General, Illinois, in the United States regarding a complaint from a person who had dialed the help number advertised on the ‘.com’ domain name website.
- The Complainant further noted that, while there was a disclaimer on the Website which stated that the Respondent was “*an independent service provider or remote tech support for third party products*”, that disclaimer was not sufficient to prevent the referenced confusion.
- The Complainant contended that “*there is no genuine product offering by Respondent, but rather, only a fraudulent scheme to compromise end-users’ computers by taking remote access and deceiving them into providing personal information for their own financial gain using scare tactics, or other deceptive means spoofing Yahoo’s identity.*”
- The Complainant submitted that the Respondent is engaged in a pattern of registering domain names corresponding to well known names or trade marks in which the Respondent has no apparent rights, and the Domain is part of that pattern (paragraph 3 a. iii of the Policy).
- In so making its submission, the Complainant referenced “*YAHOO SUPPORT NUMBER, YAHOO PHONE NUMBER, and YAHOO CUSTOMER CARE*” registrations, which it submitted are the “*subject of parallel proceedings before Nominet UK and WIPO.*” The Complainant contended that the above-referenced domain names incorporate well-known third-party trade marks and are under “*common ownership, or management and control.*”

The Response:

5.2 No response to the Complaint was provided by the Respondent.

6. Outstanding formal/procedural issues

6.1 Although Nominet sent the Complaint to the Respondent as mentioned in section 3 above, no response has been provided by the Respondent to the Complaint. As no exceptional circumstances have been raised by the Respondent as to why no response has been received, the Expert has

proceeded to a Decision (as per paragraph 15 b. of the Nominet DRS Procedure (the ‘Procedure’)).

- 6.2 While noting paragraph 15 c. of the Procedure (which states that in such circumstances, the Expert will draw such inferences as he considers appropriate), the Expert has drawn no inferences from the Respondent’s failure to respond in this case, and has based his Decision on the facts and evidence before him.
- 6.3 It is important to note that the Complainant does not automatically receive the remedy it has requested merely because the Respondent has not responded to the Complaint (see, for example, Nominet DRS *equazen.co.uk* (DRS 02735) decision).

7. Discussions and Findings

General

- 7.1 To succeed in the Complaint, the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities:

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.

- 7.2 Addressing each of these limbs in turn:

Rights in respect of a name or mark which is identical or similar to the Domain Name

- 7.3 The Expert considers that, for the reasons set out below, the Complainant has Rights in a name or mark which is identical to the Domain Name.

- 7.4 Paragraph 1 of the Policy defines ‘Rights’ as:

[...] 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 must have the Rights in question at the time of the complaint (Nominet Appeal decision, *ghd.co.uk*, DRS No. 03078).

- 7.5 The Expert notes that, as referred to by the Complainant and summarised at paragraphs 4.3 and 5.1 above, the Complainant is the proprietor of a number of trade mark registrations in respect of the Name. The Expert also notes the Complainant’s statement that “*the YAHOO! mark has been in continuous use since at least 1994.*” As a consequence, the Expert considers that, through longevity in the market place and its reputation (noting, for example, the brand

awareness references provided by the Complainant), the Complainant has developed considerable goodwill and reputation in the Name/Mark.

- 7.6 While the Expert notes that the Domain Name also includes in its string the words “*help*” and “*number*”, in agreement with the Complainant, such words are merely descriptive and do not sufficiently distinguish the Domain Name from the Name/Mark. In addition, that the Domain Name does not include the Complainant’s exclamation mark or “.co.uk” suffix does not sufficiently distinguish the Domain Name from the Name/Mark.
- 7.7 Given those factors, the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Name/Mark which is similar to the Domain Name.

Abusive Registration

- 7.8 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.
- 7.9 Paragraph 1 of the 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;*
- 7.10 *In relation to i. above*, the Expert considers that the Domain Name was an Abusive Registration at the time the Domain Name was registered.
- 7.11 The Policy, at paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, the Expert considers that the factor set out at paragraph 3 a. i. C. is relevant (where the Respondent has registered the Domain Name primarily "*for the purpose of unfairly disrupting the business of the Complainant*").
- 7.12 While it may be helpful to consider the Respondent’s intentions at the time the Domain Name was registered (or indeed in relation to his subsequent use of the Domain Name), as the Respondent has not replied to the Complaint, the evidence available to the Expert is that provided by the Complainant.
- 7.13 In relation to the above factor, the generally held view amongst DRS Experts is that, in cases of this sort, the Respondent should have had knowledge of the Complainant and/or its Rights when registering the Domain Name. As referenced above, given the Complainant's Mark and goodwill and reputation in the Name/Mark, the Expert considers that the Respondent would have been well aware of the Complainant and its Name/Mark at the time of the Domain Name registration on 12 August 2015.

- 7.14 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name with the intention of benefitting from the Complainant's reputation and goodwill to attract to the Website users who would be looking for the Complainant and its services (the purpose of which would be to disrupt unfairly the business of the Complainant).
- 7.15 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 7.16 *In relation to (ii) above*, the Expert also considers that the Domain Name was an Abusive Registration as a result of its manner of use by the Respondent.
- 7.17 The Expert considers that paragraph 3 a. ii. of the Policy is relevant, whereby a factor which may be evidence that the Domain Name is an Abusive Registration is:

Circumstances indicating that the Respondent is using [...] 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;

- 7.18 As evidenced by the Complainant, the Respondent on the Website erroneously purports to provide “*Yahoo Technical Support*”, passing off its support services as those of the Complainant's. Further, while the Expert notes the disclaimer on the Website that the Respondent is an “*independent service provider or remote tech support for third party products*”, the Expert considers that anyone accessing the Website would likely be confused, at least initially, into thinking that the Website is the Complainant's or is somehow commercially connected with the Complainant.
- 7.19 In this regard, the Expert is not persuaded by an argument that a person accessing the Website would soon realise such a mistake (because of, for example, the Respondent's disclaimer) as the damage to the Complainant's business would already have been done. Indeed, the Expert considers that it is likely that at least some persons accessing the Website would have done so only because of the Complainant's goodwill and reputation in the Mark/Name.
- 7.20 The Expert considers that the use of the Domain Name, as referenced above, has taken unfair advantage of the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the Name/Mark to generate web traffic to the contact numbers set out on the Website. It is also unfairly detrimental to the Complainant as such users will consider that the services are those of the Complainant, which they are not.
- 7.21 The Expert has considered whether there is evidence before him to demonstrate that the Domain Name is not an Abusive Registration but does

not consider there is. Indeed, the Expert considers that there is no obvious justification for the Respondent having registered the Domain Name.

- 7.22 Finally, the Complainant also submitted that the Respondent is engaged in a pattern of registering domain names corresponding to well known names of trade marks in which the Respondent has no apparent rights. However, the Expert considers that the Complainant has provided insufficient evidence at this time to support such a claim.
- 7.23 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

8. Decision

- 8.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of the Name/Mark which is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: Dr. Russell Richardson

Dated: 7 March 2016