

## DISPUTE RESOLUTION SERVICE

DRS 08371

### Decision of Independent Expert

**Talktalk Telecom Limited**  
and

**Helio Braganca**

#### 1. The Parties:

Lead Complainant: Talktalk Telecom Limited  
Address: Northbank House, 1 Siemans Rd  
Irlam  
Manchester  
Postcode: M44 5AH  
Country: United Kingdom

Second Complainant CPW Brands Limited  
Northbank House, 1 Siemans Rd  
Irlam  
Manchester  
Postcode: M44 5AH  
Country: United Kingdom

Respondent: Helio Braganca  
Address: 3 Maple Walk  
Bolton  
Lancashire  
Postcode: BL3 1AY  
Country: United Kingdom

#### 2. The Domain Name:

The domain name in dispute is <talktalktechnology.co.uk>

### **3. Procedural History:**

On 9 March 2010 the Complaint was filed by the Complainants.

On 7 April 2010 the Response was filed by the Respondent.

On 14 April 2010 a Reply was filed by the Complainant.

James Bridgeman was appointed as Expert. The date of appointment was 13 May 2010.

### **4. Factual Background**

The Complainants are part of Carphone Warehouse Group PLC group of companies which consists of two distinct businesses: Carphone Warehouse and TalkTalk Group.

Carphone Warehouse is an independent retailer and distributor of mobile phones and services with over 2,400 stores in 9 countries. TalkTalk Group is the fixed-line business and is currently one of UK's largest broadband providers serving over 4.1m broadband customers and over 1.1m voice-only and narrowband customers.

The Complainants' group also owns a number of other well known fixed-line businesses including Onetel, AOL Broadband and Tiscali.

The Lead Complainant, Talktalk Telecom Limited trades under the name TALKTALK and has acquired common law rights in the use of the mark TALKTALK. It was incorporated on 10 January 2003. The Complainants have provided evidence that the Second Complainant is the registered owner of the following registered trade marks:

- i. Community trade mark number 2783223, dated 19 July 2002, word mark for "TALK-TALK" in class 9;
- ii. UK trade mark number 2521130, dated 15 July 2009, word mark for "TalkTalk" in classes 9 and 38;
- iii. UK trade mark number 2509170, dated 19 February 2009, word mark for "TalkTalk Technology" in class 38.

There is very little information available about the Respondent. According to the WhoIs the Respondent is the registrant of the disputed domain name and the domain name was registered on 19 December 2008.

## 5. Parties' Contentions

### COMPLAINT

The Complainants submit that they launched the residential landline service branded TALKTALK in February 2003 with the principal website for the business at the <talktalk.co.uk> domain address. In November 2004 the Complainants launched TALKTALK BROADBAND. From 2004, the Complainants expanded the TALKTALK service across Europe in Belgium, France, Germany, Ireland, Spain Switzerland and The Netherlands.

The Complainants submit that in April 2006, they launched a free broadband service amidst a massive amount of publicity. By December 2006 over 750,000 customers had ordered free broadband from the Complainants. In October 2007, the Complainants announced their one millionth customer.

At an employee presentation on 17 December 2008, the Complainants announced that the division of the Complainants' business which handles its telecommunications infrastructure and network was to be named TALKTALK TECHNOLOGY. The Complainants have submitted slides from the presentation as an exhibit to the Complaint.

As of September 2009, the Complainants estimate that their market share of the UK broadband business under the TALKTALK brand was 10% equating to 1.6 million customers.

The Complainants submit that their brand marketing spend from 2006 to date totals some £50 million. The Complainants have submitted a breakdown of their marketing spend since 2008 comprising £12.7 million TV, £2 million press advertising, £.4 million radio and £11.7 million other including a radio advertising spend of some £200,000 in July 2007.

In support of their arguments that they have established a significant reputation in the use of the TALKTALK mark the Complainants have furnished examples and illustrations of marketing activities including outdoor advertising in 2005 and 2008, TV spot schedules 2004 to 2005, TV script 2007, and radio advertising script 2003. Furthermore, the Complainants submit that their TALKTALK products and services generated extensive press coverage and have provided sample press cuttings from 2004 to date.

The domain name in dispute, <talktalktechnology.co.uk> was registered on 19 December 2008 (two days after the presentation mentioned above announcing the naming of the Complainants' TALKTALK TECHNOLOGY division. According to a Whois print out submitted with the Complaint dated 4 March 2010. the registrant's name was given as "N/A" and the administrative contact was the Respondent.

The Respondent is a family relation of an employee of the Complainants.

The Complainants further submit that a gTLD domain name <talktalktechnology.com> was also registered on 19 December 2008 by the Respondent and the Complainants have furnished Whois details for that registration also.

The Complainants have furnished evidence that as of 3 March 2010 both the disputed domain name and the Respondent's gTLD <talktalktechnology.com> resolved to an identical "under construction" webpage that was headed "The Technology Blog Links".

On 9 July 2009 the Complainant sent a cease and desist communication to the Respondent. The Respondent replied on 4 August 2009, stating that he was aware that "talktalk is a trade mark product" of the Complainants' group, but that his domain name was "talktalktechnology" and therefore not a trade mark of the Complainant. He also stated that he was on the final stage of developing his website and as such would not transfer the domain names to the Complainants.

In reply on 24 August 2009, the Respondent stated that he was "well aware of the brand TalkTalk" but added that he had come across numerous companies using the name "Talk Talk" within their company name. He reiterated that he would not transfer the domain names to the Complainants. The Complainants have furnished copies of the correspondence that ensued between the Parties in an annex to the Complaint.

In these proceedings the Complainants rely on their rights at common law in addition to their rights in the above-mentioned registered trade marks. The Complainants submit that by virtue of the extensive trading and marketing activities outlined above, the Complainants have acquired substantial reputation and goodwill in the names TALKTALK and TALKTALK TECHNOLOGY such that they are recognised by the public as distinctive of the Complainants' business. The Complainants submit that their TALKTALK TECHNOLOGY trade mark has become a household name in the United Kingdom.

The Complainants submit that disregarding the .co.uk extension, the disputed domain name is identical to the Complainants' TALKTALK TECHNOLOGY trade mark and similar to the Complainants' TALKTALK trade mark.

The Complainants submit that the disputed domain name wholly incorporates the Complainants' trade mark and differs only by addition of the descriptive word "technology". The Complainants argue that the term "technology" fails to dispel the connection between the disputed domain name and the Complainants' trade mark; and submit that it in fact reinforces the link because the Complainant is a technology business and one of the divisions of the Complainants' group is actually called TALKTALK TECHNOLOGY. In support of this argument the Complainants cite the decision of the Appeal Panel in DRS 3027 (epson-ink-ink.co.uk).

The Complainants submit that the disputed domain name is an Abusive Registration. The Complainants state that they have no association with the Respondent and have never authorised or licensed the Respondent to use their trade marks.

The Complainants further submit that the Respondent intended to block the Complainants use of the disputed domain name. The Complainants submit that the Respondent was clearly aware of the Complainants and their business when he registered the disputed domain name; that the Respondent specifically admitted in his email of 4 August 2009 that he was aware that "TalkTalk" was a trade mark of the Complainants' group; that the disputed domain name includes the Complainants' famous distinctive trade mark "TalkTalk" which long predates the registration of the disputed domain name; that it is inconceivable that the Respondent registered the disputed domain name independently of the Complainants' trade mark; and that it is unlikely to be a coincidence that the Respondent chose to register a domain name that comprises the Complainants' TALKTALK trade mark plus the word "Technology" which is the exact name of a division of the Complainants' organisation just two days after the new name was announced at a presentation. The Complainants submit that the Respondent must also have known that the Complainants would have wanted to acquire the disputed domain name for themselves.

The Complainants submit that the disputed domain name <talktalktechnology.co.uk> comprises an unusual combination of words and the Respondent can have no genuine reason for registering the disputed domain name.

The Complainants argue that despite the Respondent's claim in his email of 4 August 2009 that his website was in the final stage of construction, the Respondent has offered no explanation for his registration of the disputed domain name in response to the Complainants' cease and desist letter. Furthermore the Complainants argue that it is significant that the Respondent failed to respond to the Complainants' email of 30 September 2009 which specifically requested an explanation. The Complainants submit that the Respondent's use of "The Technology Blog Links" on the under construction page was clearly designed to try and provide a bogus justification for registering the disputed domain name and the Respondent has not seen fit even to mention this in correspondence.

The Complainants submit that further or in the alternative, the Respondent registered the disputed domain name for the purpose of unfairly disrupting the business of the Complainant contrary to paragraph 3aiB of the DRS Policy.

The Complainants argue that the registration by the Respondent of both the disputed domain name and the gTLD <talktalktechnology.com> constitutes a pattern for the purposes of paragraph 3aiii of the DRS Policy. Both domain names correspond to the Complainants' well known trade mark, in which the Respondent has no rights.

The Complainants further submit that even if, contrary to the Complainants' submissions, the disputed domain does not fall within any of the factors in

paragraph 3a of the DRS Policy, the disputed domain name is nonetheless an Abusive Registration because it was registered and/or used in a manner which took unfair advantage of or was unfairly detrimental to the Complainants' rights. The Complainant again invokes the matters stated above in connection with paragraph 3a1B of the DRS Policy.

## RESPONSE

In his Response the Respondent states that some of the assertions stated by the Claimants to be facts are untrue.

He accepts that the name TALK TALK TECHNOLOGY is a trademark of TalkTalk Group but states that the trademark was not filed in until the 19th of February 2009.

The Respondent denies that he ever had any "secondary intention" when choosing the disputed domain name and states that despite the similarity of the domain name to the TALKTALK brand, he was also unaware of TALKTALK TECHNOLOGY being a part of the Complainants' corporate group.

The Respondent denies that the disputed domain name is confusingly similar to the Complainants' TALK TALK trade mark. The disputed domain is <talktalktechnology.co.uk> which was available, unregistered and not a trademarked brand of the Complainant when registered.

There are other registered domain names, where the addition of descriptive words is the only element differing from the brand. The Respondent cites as an example the domain name "talk.co.uk" which he submits is a registered domain name of Talk Internet Limited.

The Respondent argues that the brand "Talktalk" is also used by several other companies and has furnished examples in an annex to the Response.

The Respondent asserts that he had already started to work on the idea of developing a technology blog website to be established at the address of the disputed domain name, prior to receiving any notice of dispute.

The Respondent asserts that he has never officially launched the website for several reasons including alleged intimidation by legal members of the Complainant and certain family related issues.

The Respondent states that the disputed domain name was acquired to assure it was available in order to proceed with his business idea and the Complainant should have done the same in order to prevent any disappointment.

The Respondent accepts that he registered both the <talktalktechnology.co.uk> and <talktalktechnology.com> domain names on 19 December 2008 and states that they were both registered by him with the sole intention of developing a technology blog.

The Respondent alleges that the Complainants are using the DRS in bad faith because they know that they do not have any valid grounds for a complaint but simply wish to harass the Respondent or to have a chance to obtain a desirable domain name.

The Respondent argues that the disputed domain name is generic and descriptive and that the Respondent is making fair use of it. The reason the Respondent chose the disputed domain name was purely related to the nature of the business intended by the Respondent. Because the Respondent proposed to establish a website for people to “talk” about technology related topics the Respondent initially wanted to register “talktechnology” as the primary name for his proposed website but unfortunately, that domain name was already taken.

The Respondent asserts that it was merely a coincidence that he registered the domain name two days after the internal presentation of the Complainants’ plans to use the TALK TALK TECHNOLOGY name for one of its divisions. Despite having a family relationship with an employee of the Complainants, he has never been given any information with regards to this subject and the Respondent’s relative was unaware of his registration of the domain name.

The Respondent concludes his Response by pointing out that he specifically stated in his email on the 4th August 2009, that he would happily place a notification on the website stating that the disputed domain is not in any way related to the Complainants’ brand or business activities.

#### REPLY

In Reply the Complainants submit that the Complainants can and do own unregistered as well as registered trade mark rights in the names TALK TALK and TALK TALK TECHNOLOGY and there is no obligation on the Complainants to establish rights at the date of registration of the domain name rather than at the date of the Complaint.

The Complainants submit that for the purposes of the DRS Policy, it is irrelevant that the Complainants had not registered the disputed domain name or that disputed domain name was not identical to the Complainants’ registered trade marks.

With regard to the Respondent’s reference to the <talk.co.uk> domain name registration by the third party, the Complainants submit that there is no evidence that the word TALK is a trade mark of the third party but, even if it were so, this Complaint is concerned with the similarity between the Complainants’ trade mark and the disputed domain name, not between the Complainants’ own domain name and trade mark and a third party trade mark.

For the most part, the companies identified by the Respondent are either part of the Complainants’ group, dormant, in the process of being struck off or dissolved. As to

the remainder, just because their name includes the words “TALK TALK” does not of itself mean that they are trading under that brand, as claimed by the Respondent. Even if they are, that does not assist the Respondent. It does not affect the validity of the Complainants’ registered or unregistered trade marks. Nor does it affect the overwhelming likelihood that the Respondent registered the disputed domain name to target the Complainants’ trade mark.

The Respondent’s claim that it was unaware of the Complainants’ proposed TALK TALK TECHNOLOGY brand is implausible given the registration of the disputed domain name just two days after the internal presentation announcing the renaming of the relevant division of the Complainants in which a family member of the Respondent’s is employed – a fact not disputed by the Respondent. It is highly unlikely that this is simply a coincidence, as claimed by the Respondent.

The Complainants submit that in any event, the Respondent was clearly and admittedly aware of the Complainants’ TALKTALK trade mark. It is inconceivable that the Respondent registered the disputed domain name independently of the Complainants’ mark.

The disputed domain name is neither generic nor descriptive. The Respondent has provided no evidence in support of his claim to the contrary.

If the Respondent had really intended to launch a technology discussion site, TALK TALK TECHNOLOGY is far from an obvious name to choose – particularly given the Respondent’s admitted knowledge of the Complainants’ well-known and distinctive TALK TALK brand. In any case, it is clear that the Respondent had no such plans and that this is simply an attempted *ex post facto* justification for registering the disputed domain name. Otherwise the Respondent would have offered the explanation when first confronted and asked about this by the Complainants.

Furthermore, Complainants cite the DRS Expert Overview at para 4.3 and submit that the Respondent has produced no evidence in support of his belated claim:

“Most abusive registrants do not respond to complaints, but those who do will commonly assert the existence of plans, which are designed to defeat the complaint. Experts will generally view purported ‘plans’ which are totally unsupported by any contemporaneous evidence with a heavy measure of scepticism.”

The Complainants deny using the DRS in bad faith or to harass the Respondent or to simply to obtain a “desirable” domain name.

The Complainants respectfully suggests that the Respondent’s offer of a disclaimer in his email of 4 August 2009 is irrelevant. Such a disclaimer would not have prevented any future initial interest confusion but, in any case, the Respondent’s clear registration of this domain name in an abusive manner cannot be offset simply by an offer of a future disclaimer.



## **6. Discussions and Finding**

Paragraph 2.a of the DRS Policy provides that a Respondent must submit to proceeding if a Complainant asserts to us, according to the Procedure, that:

- i. The Complainant 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.

Paragraph 2.b of the DRS Policy provides that the Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

### **Complainants' Rights**

The Complainants are members of the same group of companies and have furnished evidence of trade mark use of the words TALKTALK by which the Complainants have probably acquired rights at common law and evidence of the Second Complainant's ownership of Community and UK trade mark registration for

- i. Community trade mark number 2783223, dated 19 July 2002, word mark for "TALK-TALK" in class 9;
- ii. UK trade mark number 2521130, dated 15 July 2009, word mark for "TalkTalk" in classes 9 and 38;
- iii. UK trade mark number 2509170, dated 19 February 2009, word mark for "TalkTalk Technology" in class 38.

### **Identical or Similar**

The disputed domain name consists of the element "talktalk", the descriptive term "technology" and the .co.uk ccTLD extension.

The words "talk talk" are the dominant element of the Complainants' TALK TALK and TALK TALK TECHNOLOGY trademarks and the disputed domain name.

The Complainants have therefore established to the satisfaction of this Expert on the balance of probabilities that the Complainants have rights in both the TALK TALK and the TALK TALK TECHNOLOGY trade marks, which are identical or similar to the disputed domain name.

## **Abusive Registration**

An Abusive Registration as defined in paragraph 1 of the DRS Policy means 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 Complainants' Rights; or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainants' Rights;

Paragraph 4 of the DRS Policy sets out how a Respondent may establish that a registration is not abusive and provides a non-exhaustive list of factors which may be evidence that the domain name is not an Abusive Registration including at paragraph 4.a.i,A: "Before being aware of the Complainants' cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has...used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services..."

On the evidence the Respondent chose and registered the disputed domain name merely two days after the Complainants' plan to launch the TALK TALK TECHNOLOGY brand. This strongly points to the domain name having been chosen and registered because of its confusing similarity with the Complainants' trademark and proposed branding. This Expert accepts the Complainants' submission that the addition of the descriptive word "technology" does not serve to distinguish the disputed domain name from the Complainants' trademark and in the particular circumstances of this case actually serves to add to the likelihood of confusion because the Complainants are using the TALK TALK trade mark on technology related goods and services.

The Respondents argument that he chose and registered the disputed domain name in order to establish a website to facilitate communications about technology is implausible and unsupported by any evidence of any demonstrable preparations for such use.

In the circumstances, this Expert finds that on the balance of probabilities the Respondent chose and registered the disputed domain name because of its similarity with the Complainants' TALK TALK trademark and more particularly with the Complainants' planned TALK TALK TECHNOLOGY branding of certain products. In choosing, registering and using the disputed domain name the Respondent's primary intention was on the balance of probabilities to take predatory advantage of the Complainants' marks and reputation and consequently the registration and use amounts to an Abusive Registration for the purposes of the DRS Policy.

## **7. Decision**

For reasons given above, I hereby decide and direct that the disputed domain name <talktalktechnology.co.uk> be transferred to the Lead Complainant.

**Signed .....**

**Dated 31 May 2010**

**James Bridgeman**