

# World Trademark Review Daily

**O2 obtains transfer of 2 out of 3 domain names  
International - Hogan Lovells International LLP**

**Cybersquatting**

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**O2 Holdings Limited** is a leading provider of mobile and broadband services to consumers and businesses in the United Kingdom. The O2 brand was launched in May 2002. Complainant O2 Holdings Limited, the IP holding company of the O2 Group, filed three complaints under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) with the [World Intellectual Property Organisation](#) (WIPO) against (among others) Huanglitech of China, StudMedia of Ukraine and Flashfire Marketing of Canada concerning the domain names '02videos.com', 'o2porn.com' and '02sexy.com'. Although the complainant successfully recuperated the first two domain names (Cases [D2011-1785](#) and [D2011-1787](#)), it was unable to obtain the transfer of '02sexy.com', as it failed to establish the respondent's lack of rights or legitimate interests and bad-faith conduct in accordance with Paragraphs 4(a)(ii) and 4(a)(iii) of the UDRP (Case [D2011-1786](#)).

To be successful in a UDRP procedure, a complainant must evidence that:

- the domain name is identical, or confusingly similar, to a trademark or service mark in which it has rights;
- the respondent has no rights or legitimate interests in respect of the domain name; and
- the domain name has been registered and is being used in bad faith.

The three decisions were issued by the same single-member panel within a few days of each other. The domain names in question were registered on October 21 2009 ('02videos.com'), December 3 2011 ('o2porn.com') and March 28 1999 ('02sexy.com'). The websites to which these domain names resolved were all related to pornographic content.

Concerning the first limb of the UDRP, the complainant owned an impressive list of registered O2 trademarks and submitted the necessary evidence. Proof that the domain names were confusingly similar to the complainant's marks was therefore easily satisfied. The complainant argued that it had such an enormous reputation in its brand - and, in particular, the core brand O2, whether used on its own or in combination with a suffix - that any domain name or website featuring O2 would be associated with the complainant; it was irrelevant whether O2 was written using a capital 'O', a numeral '0' or a lower case 'o'. The complainant added that this would arise in any case, regardless of its registered trademarks by virtue of the common law goodwill attaching to the O2 brand.

None of the respondents replied to the complaints, although the respondent in the '02sexy.com' case sent some emails directly to WIPO.

The panel stated that there could be no dispute that the domain names were confusingly similar to the complainant's registered trademarks and to its common law trademarks. According to the panel, the core O2 brand had been taken and all that had been added was a generic term. In addition, the fact that the prefixes were either a lower case 'o' or a numeral '0' was considered too subtle and thus irrelevant. Consequently, the panel considered that the complainant had established the first element of the UDRP.

Despite the confusing similarity, the complainant still had to prove that the respondents had no rights or legitimate interests in the domain names under the second limb referred to above. In general, while the overall burden of proof rests with complainants, panels have recognised that this may result in the often impossible task of proving a negative, requiring information that is often primarily only within the knowledge of the respondent. Therefore, complainants are simply required to make out a *prima facie* case that respondents lack rights or legitimate interests. Once such *prima facie* case is made out, it is the respondent who carries the burden of demonstrating rights or legitimate interests in the domain name.

Although the complainant did not specifically refer to the respondents' lack of rights or legitimate interests, in the cases relating to '02videos.com' and 'o2porn.com', the panel used the content of the websites to which the domain names were pointing and the fact that the domain names contained the core trademark of the complainant to infer the respondent's lack of rights or legitimate interests.

Concerning '02sexy.com', despite having defaulted, the respondent had sent emails to WIPO and the panel decided to take these into consideration. In these emails, the respondent stated that:

- it had owned the domain name long before O2 was even incorporated;
- there was a continuance of ownership from 1999; and

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- it had never claimed any affiliation with the complainant or any other UK-based company.

The panel preferred to decide the issue of whether the registrant had any rights or legitimate interests as part of the bad-faith criterion, but noted that it was possible that the spoken articulation of the prefix would, and was intended to, be verbalised as 'oh too sexy', and that it was the likely manner in which '02sexy.com' would be spoken or understood.

As far as bad faith was concerned, the complainant argued that it used its brand in a very broad sphere of telecommunications services and products, and that any person seeing the domain names would assume that they were, or could be, in some way associated with the complainant.

The panel stated that it was not difficult to conclude that the domain names '02videos.com' and 'o2porn.com' were registered in bad faith, given that any person who came across them would immediately assume that they were owned and operated by the complainant. In addition, according to the panel, the front pages of the corresponding websites featuring clearly adult content could only be seen as extremely damaging to the commercial interests of the complainant, and thus concluded that these domain names were being used in bad faith.

The panel therefore ordered '02videos.com' and 'o2porn.com' to be transferred to the complainant, although it was unsure whether it was technically possible for 'o2porn.com' to be transferred, given that it had expired during the administrative proceeding. In such circumstances, if a respondent does not renew the domain name in question, the complainant has the option to do so, as set out in the [Expired Domain Deletion Policy](#). In this case, the parties had been notified of the pending expiry of the domain name, but neither apparently wished to renew it. However, given that the domain name now appears to be in the name of the complainant, it seems likely that the latter was ultimately prepared to renew it in order to allow the transfer order to proceed. The alternative would have been cancellation, which would have left the respondent (or any other third party) free to re-register the domain name, and put the complainant in the undesirable position of having to file another complaint in relation to the same domain name.

Concerning '02sexy.com', the panel found that there was simply insufficient material to justify the complainant's assertion that the domain name was registered to capitalise on its goodwill and that it was being used in bad faith, in particular because it was registered some three years before any of the complainant's marks were being used. The panel noted that the complainant had not addressed the point of whether any of the renewals of the domain name '02sexy.com' had potentially been made in bad faith (although the majority of panels tend not to accept that the mere renewal of a domain name may be treated as a new registration for the purpose of assessing bad faith), and that it had also not addressed the content of the respondent's emails. Finally, the panel took into account the fact that the complainant potentially had an ability to obtain remedies in other fora.

These decisions, and in particular the decision relating to '02sexy.com', highlight the fact that, although faster and cheaper than court proceedings, the UDRP is not simply an easy alternative. Complaints that may appear very similar on the face of it may have different outcomes.

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