Decision for dispute CAC-UDRP-104446

Case number	CAC-UDRP-104446
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Domain names	youswitch.biz

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	uSwitch Limited

Complainant representative

Organization	Thomsen Trampedach GmbH

Respondent

Organization	FreeSatServices

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies on its UK registered trade mark no. 2230283 for the word mark: “USWITCH.” That mark was applied for on 20 April 2000 and registered on 23 August 2002 in 12 classes 1,4,7,9,11,32,35, 36, 37,38, 39 and 40. Those specifications appear to be broad class headings.

It also relies on its rights arising from use of that mark in trade.

FACTUAL BACKGROUND

The Complainant is a company called USWITCH Ltd, company no. 3612689. It was incorporated as, and originally called, Rumi Ltd, until 21 February 2000 when it changed its name to the current name, USWITCH Ltd. It is a consumer energy price comparison service at <uswitch.co.uk> and <uswitch.com.> The internet archive shows use domains in use from late 2000 onwards and records websites offering links for every kind of service from energy, home phones, mobiles and broadband, insurance products and credit products. The panel visited the internet archive on 30 May 2022.

The disputed domain name <youswitch.biz> was registered almost 15 years ago on 9 December 2007. The internet archive

shows the disputed domain name in continuous use since early 2010. A 21 July 2013 snapshot shows a login screen for wholesale users. The 27 December 2021 snapshot shows a screen about technical support for ADSL and also has a link to www.uk-wholesale.co.uk/ with information about business telecommunications, phone, broadband, and while it has a link to "extras" which also says gas and electricity, when clicked on by the panel on 30 May 2022, that also resolved to the same content about business telecommunications, phone and broadband.

The Respondent itself was incorporated as Freesat Services Ltd, company no. 05561036 and changed its name to YOUSWITCH Ltd on 8 January 2008 and then to MY SWITCH Ltd in 2009. The Respondents say their business provides support for the "Yolanda Origin Unified Switch" and they used the disputed domain name to route DNS traffic from the Switches and for email. Their "YOU" was an abbreviation for Yolanda Origin Unified.

Both parties accept that a dispute arose between them in 2009 and the outcome of that dispute was that the Respondent changed its name on 14 December 2009 to MYSWITCH Ltd. The records show however that it retained ownership of the disputed domain name. On 25 May 2022, the Panel requested evidence from the parties on the terms of the 2009 compromise. On 27 May 2022, the Complainant responded that "they are not in possession of any record relating to any discussion, agreement or understanding between themselves and My Switch Ltd." On 29 May 2022, the Respondent made a further statement but was unable to provide documentary evidence as it is in storage and the owners are currently abroad.

In any event, relations were peaceful until 7 December 2021, when the Respondent received a cease-and-desist e-mail from BrandProtection@novagraaf.com on behalf of a company called RVU which said it has a website online at www.rvu.com. That website shows various price comparison brands including "Confused," "Money," "Mojo" and what appears to be the Complainant's site but where there is a Logo mark used which is "U Switch" but where the letter U is in white surrounded by a black box. If you click on it, as the panel did on 30 May, the same Logo is there in White, the box around the U is White and the U is see-through.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to its trade mark and says the test for confusing similarity typically involves a side-by-side comparison of the domain name and the relevant trade mark in order to assess whether the mark is recognizable within the disputed domain name; this may include a more holistic aural or phonetic comparison of the complainant's trademark and the dispute domain (see WIPO Overview 3.0, at 1.7). Multiple prior UDRP panels have held that phonetic similarity with the relevant trademark is sufficient to find a domain confusingly similar, especially when one considers that consumers might unintentionally type the phonetic version of the trademark shown in the disputed domain when looking for the complainant's brand (see WIPO Case No. D2011-1355 – groundforcepumps.com; WIPO Case No. D2006-0020 – mirival.com). The distinctive part of the disputed domain name is phonetically identical with the Complainant's trade mark, at least when pronounced in standard English: "you" is pronounced in an identical manner to the letter "u", while the term "switch" appears both in the disputed domain name and in the trade mark. Given that the .biz ending, like all other gTLD endings, is generally irrelevant to the assessment of confusing similarity (see e.g. WIPO Case No. D2006-0561 - playboyatthepalms.com), the disputed domain is confusingly similar to the Complainant's mark.

The Complainant submits that the Respondent has no legitimate interest in respect of the disputed domain name. Firstly, the Respondent has, to the Complainant's knowledge, neither used nor made demonstrable preparations to use the disputed domain name in connection with the bona fide offering of goods or services. The disputed domain name is currently used to automatically redirect visitors to the www.uk-wholesale.com website, which in itself is used for legitimate commercial purposes. The disputed domain name is thus not directly used for the offering of goods or services. However, should the Panel determine that the fact that the disputed domain name redirects to a domain that in turn is used for the offering of goods and purposes means that disputed domain name is itself used for this purpose, the Complainant maintains that this use is nevertheless not bona fide. The services offered at uk-wholesale.com consist mainly of reselling telecom and broadband services to business customers located in the UK. These services fall squarely within the list of services for

which the Complainant's trademark is registered in Nice class 38, namely "provision of telephony services" and "Internet service provider facilities, broadband". It follows from the nature of the UDRP process, which is intended to provide a simplified procedure for trademark owners to remedy bad faith domain name registrations, that a bona fide offering of goods and services cannot be found where an intent to exploit a complainant's mark can be inferred from the fact that there is a complete overlap between the goods or services promoted through the domain and the complainant's trademark registration (see e.g. WIPO Case No D2001-1021 – brucetrail.com, where the Panel cited Nutrisystem.com, Inc. v. Easthaven, Ltd. (sweetsuccess.com), CPR Case No. 012 as authority for the position that a complainant's trade mark rights cannot bar a respondent from using a domain incorporating that mark for commercial activities that are different from those pursued by the complainant). It is thus unsurprising that multiple UDRP panels have considered that a respondent will be unable to demonstrate rights or legitimate interests where the respondent is using the domain name to sell goods or services intentionally competitive with the complainant (see e.g. WIPO Case No D2011-0312 – maharajas-express.com; WIPO Case No D2010-0203 – cathkidston.net). Given that the services sold via the disputed domain name in the present case are directly competitive with those of the Complainant, the Complainant submits that no legitimate interest can be claimed by the Respondent.

Further, the fact that both Complainant and Respondent are located in the UK means that UK law concepts may be relevant to the Panel's decision (see WIPO Overview 3.0 at 4.15). Under Section 10(2)(b) of the Trade Marks Act 1994, a trade mark registered in the UK is infringed when a sign similar to the trademark is used, without the consent of its proprietor, in a confusing manner and in connection with goods identical to those for which the trademark is registered. The use of the disputed domain name, which was first registered in 2007 (5 years following the registration of the Complainant's mark) for the provision of telecommunications services is thus likely to constitute an infringement of the Complainant's mark under UK law. Previous panels deciding under the UDRP have repeatedly held that a deliberate infringement of another's trademark rights does not entail a bona fide offering of goods or services (see e.g. WIPO Case No. D2016-0725 - segawayboard.com; WIPO Case No. D2014-0236 – tigrismed.com; WIPO Case No. DTV2007-0003 – oorah.tv), and the Complainant submits that the Panel should follow this reasoning in the present dispute.

The Complainant is not in possession of any information that would suggest that the Respondent is commonly known by the disputed domain name, and any notion of the domain being used for non-commercial fair use must be rejected since the use of the domain is clearly commercial in nature.

The Complainant submits that the disputed domain was registered and is being used in bad faith. As mentioned above, the disputed domain name was registered in 2007, 5 years after the registration date of the Complainant's trademark. The Respondent is located in the UK and the domain is furthermore being used to promote telecommunications services to UK businesses consumers. This suggests that it is highly likely that the Respondent was aware of the Complainant's rights when the disputed domain name was registered, with the likely motive of benefiting from the reputation and recognizability attached to the Complainant's mark, well known amongst a substantial portion of the UK public.

That the disputed domain name was registered in bad faith is supported by the fact that the use made of the domain since its registration is clearly recognizable as bad faith use. Paragraph 4(b) of the Policy provides that bad faith registration and use may be found where the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent's web site or other online location by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the website or location in question. The Complainant submits that the Respondent's intent to profit from Internet user confusion for commercial gain can be inferred, on a balance of probabilities, form their use of the disputed domain to drive web traffic to uk-wholesale.com (see e.g. WIPO Case No D2010-0415 – mylondon2012.com). As was referred to above in the discussion of the first UDRP element, the disputed domain name is confusingly similar to the Complainant's trademark from a phonetic perspective, meaning that consumers looking for the Uswitch brand in the .biz gTLD may mistakenly type in "youswitch.biz" due to its phonetic similarity. The fact that consumers may realize that the domain is not affiliated with the Complainant upon being redirected to the uk-wholesale.com site is not relevant for the purposes of the Policy (for this established view see e.g. WIPO Case No D2006-1134 - .com, citing FANUC Ltd v Machine Control Services, Forum File No FA000200000093667). The web traffic generated by the confusion inherent in the disputed domain is diverted to the uk-wholesale.com website, which benefits as a result. That the automatic redirection of web traffic to uk-wholesale.com would result in financial gain to the Respondent is a reasonable inference the Complainant invites the

Panel to make.

The Complainant is unaware of any alternative justification for the Respondent's use of the disputed domain, which leaves registration and use in bad faith as the most likely explanation for the domain on a balance of probabilities.

RESPONDENT:

The disputed domain name <youswitch.biz> was registered on 9 December 2007. The main use of the domain name has never been for a website, the purpose was to point the IP addressed for the Yolanda Origin Unified Switches to a server in the data centre. In addition to providing a constant email domain name. The only meaningful use of the website was a recruitment campaign for staff to work alongside a company that supplies our Unified Switches. The Respondent does not and has never directly sold to consumers as our audience is communication providers like UK Wholesale Direct LTD and British Telecom, who use the equipment which we support and maintain. The disputed domain name has been using in good faith by the Respondent for 15 years.

This matter is extremely prejudicial. The Complainant tried the same stunt in 2009 and a compromise was reached which meant we had to change our company name but keep the domain name. We defended ourselves at the time and although we vigorously denied that it infringed their trademark we agreed that we would change the company name to My Switch LTD on the understanding that we would retain the domain name YOUswitch.biz as it was very important to the business for both emails and the IP address routing of the YOU switches. We see their complaint as harassment by a predatory large corporate throwing its weight around. For the claimant to now not accept this compromise and 13 years after the agreement was made and we upheld our end of the deal by changing our company name to My Switch Limited (which we feel is wrong that we should have had to do, the industries are not the same and there is zero confusion) is unfair, wrong and in bad faith.

We are only a small business and both me and my partner are based in the UAE. We do have the legal correspondence from USWITCH and our response and compromise from 2009 as this was done through paper post which we retained in a storage file. This file is currently stored at a storage unit within the UK only me and my partner have access to this and we can't travel to the UK for the next 60 days due to our business obligations within the UAE. However, we do have these documents and are very happy to present them but don't feel that we should be penalised by being unable to reach them within the 20 days. The panel will see from publicly available records on the government website that the Respondent did change its name to My Switch in December 2009 in accordance with the compromise made with the Complainant. Although this is not as strong evidence as the documents themselves, it clearly indicates that we would have no reason to do this if it wasn't for the Complainant 's legal team threats of trademark infringement and the compromise we made.

The Complainant was fully aware in 2009 that we vigorously disagreed that trademark law enabled them to stop us using a generic word such as YOU or Switch in a company name or domain name.

Our use is completely legitimate as the Complainant already know from 2009. The domain name has been in constant use for 15 years by the legitimate company My Switch LTD which was formally You Switch Limited. As we originally made clear to the claimant in 2009, the word switch is a generic product and to include a generic word in a trade mark and then aggressively disrupt all other businesses with a similar sounding words offends the spirit of the law.
USWITCH wish to aggressively enforce its trade mark for the word switch and all similar sounding words, however the meaning of the word switch as they use it is as a service is for a price comparison website.

The most popular use of the word switch is as a product e.g a light switch, a computer network switch, or as in our case our Unified Switch the Yolanda Origin Unified Switch.

It makes perfect legitimate sense for our company to both be called YOUswitch and use the domain name YOUswitch for our: Yolanda Origin UnfiedSwitch. The problem comes as the word SWITCH is a generic word. The problem with the trademark is further magnified as they use the letter U to form the word USWITCH. This means that they also want to protect

another generic word YOU, the letter U, EWE (which is an adult female sheep). The Complainant would have absolutely no idea how a Yolanda Unified Switch works. To further compound this USWITCH register the trademark under lots of classes of business that they have not, do not, and we very much doubt will ever have an interest in other than to compare just about any industry or product under the sun on their price comparison website. The true nature of business of USWITCH is limited to and always has been for 22 years as a price comparison website. They do not make switches, raise or sell female sheep, nor make and support network switches, light switches or any other kind of switch. The Complainant registered a huge range of classes but they don't offer anything other than a price comparison website.

The Respondent only provides goods/services to corporations and not to the general public at all. The same is true of UK Wholesale Direct LTD. As the Complainant points out, the disputed domain name reinforces this as it ends in .BIZ which would indicate business, this is very different to the consumer energy market audience of the Complainant.

Overzealous targeting of any similar sounding words in industries which are not related to the activity of USWITCH is predatory, unfair and bad faith in our opinion. USWITCH would like to cast an unacceptably wide net using their trade mark across just about every market they can think of and prey on smaller companies over legitimate domain names that do not infringe and clearly cause no genuine confusion to the public. The most likely motivation is that the Complainant employs an external company to hunt out any infringement, which has a need to justify their ongoing fees.

Many companies use the common descriptive word such as: Switch.co.uk; tyouswitch.com; HUESWITCH; activateyourswitch.com; ayou-switch.com; helpyouswitch.com. Switch.com is a lighting company, with absolutely nothing to do with a price comparison website. The Complainant could claim that their registration includes class 11 "apparatus for lighting". Just as it is in our case this would be an abusive over reaching. See also https://switchd.co.uk/ This company does have a very similar name and is a price comparison website, but instead USWITCH has decided to attack us.

In the complaint they point out that there was a page forward to a company that we supply services to called UK Wholesale Direct LTD, they pretend that UK Wholesale direct is a broker for telecoms services and therefore in their class of business. Again, this is not true, UK Wholesale Direct is a business communications provider, not a consumer price comparison website. USWITCH are not a telecommunications provider, they are a price comparison website. If USWITCH was or was intending to be a telecommunications provider they would need to apply for a license from the UK's Office of Communication, there is no request for a licenses logged nor has there ever been.

Our web logs demonstrate there is no traffic and no confusion at all with the USWITCH website. The domain name YOUswitch.biz receives absolutely no traffic at all (not surprising the domain isn't used for a website). Zero visitors, zero web searches, zero paid adwords, how on earth can the argument be made under trademark law that the domain is causing confusion to the public! This can be confirmed independently using a tool such as SEMRUSH.
The Respondent has continued to operate the disputed domain name, in good faith since making the compromise of changing the company name but retaining the domain name in 2009. Taking the domain name away from it would cause significant harm and cause huge disruption to its emails and the YOU Switches which use the DNS routing of this domain name.

Not surprisingly there are also many examples of domain names using the generic and descriptive word also, even one which is actually in the same class of business as the Complainant, interestingly they have not been able to successfully enforce their mark despite them being a price comparison website. Please see www.switchd.co.uk.

The genuine competitors of the Complainant are:

comparethemarket.com

switched.co.uk

moneysupermarket.com

The Complainant provides their service to homes of residential energy consumers. The Respondent and UK Wholesale Direct provide products exclusively to commercial organisations and not residential consumers.

The disputed domain name was registered and is used in good faith. This complaint is made with extreme prejudice given that it is 13 years after the Complainant challenged both the domain name and company name and a compromise was agreed that included that the domain name would remain with the Respondent as it caused no harm or confusion and would be harmful and disruptive to its DNS routing of its YOU switches and e-mail use.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Decision

The Complainant's word mark is USwitch. The disputed domain name is <youswitch.biz>. Identity is a very strict test and is not met. The suffix is always ignored so the .biz is not relevant. For similarity, we are looking at USwitch versus youswitch. They are not entirely visually similar however, the first part of a mark being the most important to consumers, and online and generally that is important. One can distinguish between them. Both use the common word Switch. But not in a conceptually identical way as the Complainant refers to a change whereas the Respondent refers to online routing. They are phonetically similar however. I find the Complainant's has rights in a name or mark that is confusingly similar to the disputed domain name.

However, not all rights are the same. No-one can own a number or dictionary word to the exclusion of the rest of the world. They are inherently lacking in the distinctiveness required for trade mark law. Trade marks are badges of origin that enable the public to identify the goods and services of a trader so they can make a repeat purchase safe in the knowledge that the quality should be the same the second time around. An ordinary word or number cannot function in that way for obvious reasons. That is, unless they have what we call "acquired distinctiveness" or secondary meaning so that they are so famous that it is the brand that the relevant public bring to mind and not the dictionary term. Sometimes that is not really possible with a number or a common word –so that in their original meaning, they remain the property of and available to, all. This forms the basis of the prohibition on descriptive and generic marks which recognises that many traders want to use descriptive terms for their informational values and that no one trader should be able to monopolise them. Those selecting such terms as marks have to tolerate confusion and the Policy reflects this by protecting such as fair or legitimate use. Furthermore, consumers are not easily confused by such terms as they understand they are common ordinary terms, employed by many undertakings, with a low degree of distinctiveness.

This is the point that the Respondent is making in the response –is if you select a common word or a number/highly descriptive mark, you cannot expect any exclusivity in it and small differences must be tolerated. See Tire Discounters, Inc. v.

TireDiscounter.com, The Forum 679485 (“Because the mark is merely descriptive, small differences matter”). Indeed, the Respondent relies on the fact that the online registers show many using marks.

The Complainant suggests English law gives it rights which are absolute but the position is not that simple. It may be registered but in the view of the Panel on the present evidence, its rights are weak and non-exclusive. It selected a highly descriptive mark and must live with the consequences. This can impact bad faith and legitimate and fair use and will be discussed further below. The Complainant also suggests that it would have a claim for trade mark infringement in the UK. However, the mark is a common word and highly descriptive or generic and there is no evidence whatsoever of acquired distinctiveness and just a bare assertion. I do not accept that the Complainant or its registered mark are well-known or marks with a reputation for the same reason. No evidence that would support that was submitted. It follows from that that I do not accept that the Respondent must have been aware of them when it registered the disputed domain name. Then there are the many years of what would be considered honest concurrent use which may also give rise to an estoppel. More importantly it is not clear to me on the evidence that the Complainant has itself put its mark to genuine use in any class other than class 35.

In the law of passing off or common law trade mark rights arising from use under English law, the same applies and the seminal case is the famous Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd (1946) 63 RPC 39 (where a trader adopts words in common use for his trade name some risk of confusion is inevitable, and that risk must be run by him unless the first user is allowed unfairly to monopolise the words).

However, this is not a trade mark infringement case or a passing-off case or an opposition. We are not concerned with anything other than the Policy. It can be important to understand how the issues would look in trade mark law however, given that the Policy is based on international trade mark norms.

The real issue in this case is whether the Respondent has a right/legitimate interest in use of the disputed domain name. Under the UDRP (the Policy) at Paragraph 4(c)the Respondent can show any of:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

However, Paragraph 4(c) is not exhaustive and includes the language, “[a]ny of the following circumstances, in particular but without limitation…” The position is that the Complainant must made a prima facie case and then the Respondent should rebut it.

The disputed domain name has been used for many years since it was registered almost 15 years ago in connection with a website so this is not a case of passive holding. This is not a typosquatting case either. The Respondent said it had its own reasons for wanting it, due to its reference to the Yolanda Origin Unified Switch. It has years of use and this implicates all elements of paragraph 4(c) of the Policy. Before 2009 it was known by it. It has used it before and for 13 years after that point as its domain name and the indirect use can be bona fide. I find it is making a fair and legitimate use. Many traders want to use the common word Switch for its informational properties and this fair use is protected at law and by the Policy. The Complainant has a descriptive and common word and has no exclusivity in that word and must tolerate small differences. This Panel finds that the Respondent had a legitimate right/interest in the disputed domain name.

As to Bad Faith

The evidence was less than satisfactory in relation to the 2009 dispute but the record shows that the disputed domain name remained with the Respondent and the Complainant has not produced any evidence to suggest that there was any limit imposed on their use of it.

The Panel does not find that the Complainant is a well known mark nor that there is acquired distinctiveness. No evidence as to that was submitted. It is a serious threshold and does not follow from the mere passage of time otherwise all marks over 5 years might qualify and they do not.

The Respondent has come forward with a valid explanation for its selection of the disputed domain name, it was selected to refer to the Yolanda Origin Unified Switch. It had every right to make that selection given it included two common descriptive terms used in their original forms and for their informational values. The parties' activities are in very different fields and no evidence of any confusion has been produced. The Complainant's relevant public is domestic energy consumers and the Respondent's is wholesale for business telecoms.

The Panel does not find that the Respondents registered or used the disputed domain name in bad faith. The Complaint is refused.

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". Weber-Stephen Products Co. v. Armitage Hardware, WIPO Case No. D2000-0187. That includes and this is a case of reverse domain name hijacking or RDNH. This is defined under the Rules as "using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name." (see WIPO Overview 3.0, section 4.16). Panels have consistently found that the mere lack of success of the complaint is not in itself sufficient to constitute RDNH. Section 4.16 of the WIPO Overview 3.0 sets out a number of the circumstances which UDRP panels have considered as supporting a finding of RDNH. These include: facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, unreasonably ignoring established Policy precedent notably as captured in the WIPO Overview 3.0, filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis and basing a complaint on only the barest of allegations without any supporting evidence. In the present case, the Complainant should have appreciated that establishing registration and use in bad faith in respect of a domain name which had first been registered 15 years ago was likely to involve difficult considerations. The panel finds that this is a case of RDNH.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **YOUSWITCH.BIZ**: Remaining with the Respondent

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2022-05-31

Publish the Decision