Decision for dispute CAC-UDRP-102501

Case number	**CAC-UDRP-102501**
Time of filing	**2019-06-04 11:47:03**
Domain names	**airtelvodafone.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Vodafone Group Plc**

Complainant representative

Organization	**Boult Wade Tennant LLP**

Respondent

Organization	**See PrivacyGuardian.org**

OTHER LEGAL PROCEEDINGS

The Complainant answers 'not applicable' to this question, and the Panel is not aware of any such proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of multiple trade marks in respect of the string VODAFONE, such as EU trade mark 2966018 (in multiple classes including class 38 for various telecommunications and online services) registered in 2005, and a mark in its seat (the United Kingdom) in class 9, for mobile telephones, dating from its foundation in 1984 (registration number 1223053). The Complainant has a large number of marks across jurisdictions, including various marks in the country of apparent residence of the respondent, China, again in classes 9 and 38 in particular: see for example mark 775205 first registered in 1993 for the text VODAFONE.

The Complainant has entered into a joint venture with another telecommunications company, Bharti Airtel, and in that context operates a service known as 'Airtel-Vodafone' in the Channel Islands (Jersey and Guernsey).

FACTUAL BACKGROUND

The Complainant is a company with its seat in the United Kingdom, with operations in the UK and in many other nations. It is active in the telecommunications field and has been since the 1980s, having announced its services under the name VODAFONE in 1984 and began operations the following year.

The Respondent, an individual with an address in Baoding, China, registered the disputed domain name on 2 October 2018.

PARTIES CONTENTIONS

No administratively compliant response has been filed. The Respondent never accessed the online platform, and post sent to the address provided was returned as undeliverable. E-mail correspondence through one of the addresses supplied was, in so far as can be ascertained, relayed.

The Complainant asks that the disputed domain name be transferred to itself. It sets out the operations of the company over the course of more than three decades, argues that the disputed domain name is confusingly similar to the text in which it has rights, denying that the Respondent has any licence or association with it, and alleges that the disputed domain name was registered and is being used in bad faith.

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).

The disputed domain name consists of two distinctive strings: AIRTEL and VODAFONE. (The TLD .com is, as is typical in proceedings under the Policy, disregarded).

It is clear that the Complainant has rights in respect of the trade mark VODAFONE, as noted above. Is the disputed domain name <AIRTELVODAFONE.COM>, however, confusingly similar to this mark? This is a situation where a mark is accompanied by another - and in this case, related - mark. As the Complainant sets out, a joint venture between itself and another company (Bharti Airtel) operates under the brand 'Airtel-Vodafone' in two jurisdictions [Jersey and Guernsey, which are 'Crown dependencies' in a complex relationship with the United Kingdom (neither part of the UK nor sovereign states as generally understood)].

There are cases decided under the Policy where the use of a third-party trade mark (text B) has not displaced confusing similarity with a Complainant's mark (text A); see for instance WIPO Case No. D2014-1996, SAS v. Nadia Michalski, <DECATHLON-NIKE.COM>. There is also, moreover, extensive authority in support of the proposition that where 'text B' is descriptive of the services provided by a Complainant under 'text A', Panels will find confusing similarity under paragraph 4(a)(i) while considering whether the interaction between text A and text B is relevant at a later stage (e.g. in terms of legitimate interests and bad faith); see WIPO Jurisprudential Overview, version 3.0, para 1.8.

In the present case, the Complainant has provided uncontradicted evidence of the joint venture in which it participates, and the use of the term 'Airtel-Vodafone' in connection with these operations, including a website at the domain name <AIRTEL-VODAFONE.COM> for which the Complainant is the registrant. As such, the case for confusing similarity is particularly strong in respect of this Complaint.

It is not necessary, in light of the above findings, to address other issues such as company names.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, 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).

The Complainant declares that the Respondent has no connection with or affiliation to itself, nor has it (the Respondent) received any licence or authorisation to use any of the Complainant's marks. The Respondent has not participated in these proceedings, and the Panel is unable to ascertain any possible rights or legitimate interests in respect of the disputed domain name. Indeed, the record of the use of the disputed domain name by the Respondent, as discussed in further detail under bad faith, below, confirms the extreme difficulty of such being the case. Moreover, the similarity between the disputed domain name and the Complainant's domain name (differing only by a hyphen), and the associated possibility for user confusion, would require a particularly careful assessment of the presence of legitimate interests (e.g. steps taken to clarify

the differences between Complainant and Respondent) - if such were arguable (which is not the case here).

BAD FAITH

The Complainant has, 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).

The Complainant points to a number of decisions by other Panels applying the Policy, such as CAC Case 101997, Vodafone Group Plc v. IBN7 Media Group, <VODAFONEIDEA.COM>, where the well-known nature of the text VODAFONE has been accepted. It is difficult to see the registration of the distinctive names of two telecommunications companies (who operate a joint venture under, in effect, the same text as the disputed domain name) as anything other than bad faith registration, given the fame of their activities and marks.

While the disputed domain name does not currently resolve to an active website, the Complainant has supplied a copy of the former content of such a website, which was made unavailable shortly before the commencement of proceedings. This evidence, which again has not been challenged by the Respondent due to the failure to participate in proceedings, indicates that the content in question included text and image links (likely to have been for consideration, e.g. as pay per click links) to gambling and sexually explicit websites. At the very least, this points to an intent to attract Internet users to the Respondent's website for commercial gain, which is, where a likelihood of confusion is created, one of the examples of bad faith set out in the paragraph 4(b)(iv) of the Policy.

The Panel also notes and places due weight upon various other submissions of the Complainant, including the use of a privacy protection service by the Respondent, and the extensive record of cases where the presence of 'pornographic' material on a website is considered as evidence of bad faith in so far as this 'tarnishes' a mark.

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.

The Panel notes and welcomes the inclusion in the Complaint (and an Annex) of a statement from the above-mentioned joint venture confirming the appropriateness of the Complaint being made by the Complainant (one of the two parties to the venture) and the agreement, which is consistent with the existing terms between the parties (where the Complainant is the registrant of pertinent domain names), that if transfer was to be ordered by this Panel, such transfer would be in favour of the Complainant.

This is material information because, in the absence of such information, various panels have ruled differently as regards whether the appropriate remedy is transfer or cancellation. (See the analysis in Bettinger and Waddell, Domain Name Law and Practice: An International Handbook, Oxford University Press, 2nd edition, 2015, para IIIE.257; see further the reviews of authorities, confined to decisions of the WIPO AMC, in WIPO Case No. D2016-2194, Philip Morris USA Inc. v. Whoisguard Protected, Whoisguard, Inc. / MARK JAYSON DAVID, <PALLMALL-MARLBORO.COM> and WIPO Case No. D2015-1507,Kabbage, Inc. v. Oneandone Private Registration et al, <KABBAGEFUND.COM>. However, where a complaint is brought jointly, or where the appropriate written consent is included in a complaint, it is normally appropriate, without difficulty, for transfer to be the most appropriate remedy (where requested by the complainant).

PRINCIPAL REASONS FOR THE DECISION

The reasons are set out in further detail, above. The disputed domain name consists of the Complainant's mark and a third party mark. The Respondent, who has failed to participate in the proceedings, is not found to have any rights or legitimate interests in respect of the disputed domain name. Its registration of the disputed domain name, which is confusingly similar to the Complainant's long-established and very well-known mark, is likely to have been in full knowledge of the Complainant's activities (including the joint venture which has a name very closely resembling the disputed domain name). Although not currently operating a website, the Respondent previously published an extensive range of advertising links for sexually explicit websites and gambling websites, unconnected with the Complainant's activities but exploiting the likely

confusion between the Complainant's actual domain name for the joint venture and the disputed domain name. The Panel is satisfied that all aspects of the Policy have been made out and that transfer to the Complainant is appropriate, in light of the explanations provided regarding the relationship with the holder of the third party mark.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AIRTELVODAFONE.COM**: Transferred

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2019-07-21

Publish the Decision