

Nominet UK Dispute Resolution Service

Complainant Reference Number:1770

YAHOO! INC

Decision of Independent Expert

1. Parties:

Complainant Type	Business
Complainant:	Yahoo! Inc
Address:	701 First Avenue Sunnyvale
Postcode:	CA 94089
Country:	US
Respondent	Simon Charles Smith
Address:	95 Rathbone Road Smethwick Worley
	West Midlands
Postcode:	B67 5JF
Country	GB

2. Domain Name:

yahho.co.uk (“the Domain Name”)

3. Procedural Background:

The Complaint was lodged with Nominet on 24 January 2003. Nominet validated the Complaint on 29 January and informed the Respondent of the Complaint, by notification dated 29 January 2003, sent by post and by e-mail, that it had 15 working days within which to lodge a Response. No Response was received. Mediation was accordingly not pursued. The Complainant was informed and by letter dated 28 February 2003, the Complainant paid Nominet the appropriate fee for a decision of an expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On 5 March 2003, Antony Gold, the undersigned, (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case.

4. Outstanding Formal/Procedural Issues (if any):

It is first necessary to deal with the fact that no response has been made by the Respondent. Under paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”), the Respondent is required to submit a response to Nominet within 15 days after the commencement of proceedings. Paragraph 15b of the Procedure provides that the Expert will proceed

to a Decision on the Complaint if, in the absence of exceptional circumstances, a party does not comply with any time period laid down in the Procedure. There is no evidence before the Expert to indicate the presence of exceptional circumstances and a decision is accordingly made on the Complaint notwithstanding the fact that no response has been provided by the Respondent.

Paragraph 15c of the Procedure provides that if, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or the Procedure, the Expert will draw such inferences from the Party's non-compliance as he or she considers appropriate. Whilst it is not intended to draw any adverse inferences from the Respondent's failure to respond to the Complaint, the starting point for this decision is that the facts asserted by the Complainant are correct.

5. The Facts:

The Complainant is a global internet communications, media and commerce company that delivers a branded network of searching, directory, information, communication and shopping services, and other online services and features. The Complainant is the owner of the trade mark and trade name YAHOO! and the domain name yahoo.com.

The Complainant is the owner of numerous Community Trade Marks registrations for the YAHOO! mark. Such marks include registration number 1076181, with the priority date of 13 August 1998, in classes 9, 16, 35, 39, 41 & 42. Another example is CTM registration 693127, with a priority date of 28 May 1997, in classes 3, 11, 15, 20, 24, 26, 29, 30, 34, 35, 36, 38, 39 & 42. The Complainant is also the owner of several US trade mark registrations for the YAHOO! mark. Further, the Complainant also owns US trade mark registrations and applications for the mark DO YOU YAHOO!? including registration number 2, 286, 753 issued on 12 October 1999, in classes 16, 25, 28 & 35. A further registration for this mark is number 2, 237, 197, issued on 8 August 2000, in class 42.

The YAHOO! mark has been used since 1994. The Complainant has submitted an Interbrand report which asserts that the YAHOO! brand has a brand value of nearly US\$3.8 billion.

The Complainant submits that the www.yahoo.com website had more than 213 million unique users and more than 101 million active registered members in December 2002. The yahoo.com domain name was registered on 18 January 1995, and has been used to identify the Yahoo! website since on or about that date. The yahoo.co.uk domain name is one of the Complainant's sites which is specific to a particular region, namely to the UK, where the Respondent is located. The Complainant asserts that domain name yahoo.co.uk has been used to identify the Complainant's UK and Ireland website since the launch of that site on 23 September 1996.

A Whois search shows that the Respondent registered the Domain Name on 9 July 1999. The Complainant has Community Trade Mark and US trade mark registrations for YAHOO! which predate the Respondent's registration of the Domain Name. The Complainant's registration of the yahoo.com and yahoo.co.uk domain names also pre-dated the Respondent's registration of the Domain Name.

The Complainant states that the Respondent used the phrase "DO YOU YAHHO?" on the website at the Domain Name (the "Respondent's Website"). The Complainant further states that the Respondent's Website offers services which compete directly with the services offered by the Complainant, such as search services via a search engine, email services and banner advertisements. The Complainant believes that the Respondent does not offer search engine services and email services directly, but rather is a commission-paid affiliate of third parties that supply such services.

The Complainant states that, on 18 October 2000, the Respondent's Website displayed a link that was called "Take me to Yahoo now!", but that this link did not connect users to the Complainant's website.

The Complainant states that the Respondent's Website now includes inflammatory materials which include racist, anti-Semitic, and white supremacist views. The Complainant states that the Respondent's website also displays an Amazon.com affiliate link.

The Complainant notified the Respondent of its objections to the Respondent's ownership of the Domain Name by a letter dated 18 November 2002, from the Complainant's UK trade mark attorneys, Eric Potter Clarkson. This letter was sent to the Respondent's last known address. The Complainant states that it has not received any response to this letter from the Respondent.

6. The Parties' Contentions:

Complainant:

The Complainant asserts that:

1. The Domain Name is identical or similar to a name or mark in which it has rights.
2. The Domain Name is an Abusive Registration because:
 - (1) The Domain Name has been registered primarily for the purposes of unfairly disrupting the business of the Complainant. It is doing this by diverting traffic from the Complainant's site. The Complainant relies on evidence attached to the Complaint detailing statements made on the Respondent's Website on 10 May 2000 - "last month I got 134 dollars for just having the banner below on my site" and "get your [*free stuff*] from my tacky web page now!! And that's an order !!!...".

The Complainant asserts that the Respondent offered on the Respondent's Website directly competing search services via a search engine box and directly competing e-mail services, as well as banner advertisements.

It is asserted that the Domain Name is a typographical misspelling of the Complainant's YAHOO! mark. The Complainant states that such registrations comprised of a typographical misspelling of a mark constitute "typosquatting" following reported decisions under the Uniform Dispute Resolution Policy devised by ICANN ("the UDRP") (being similar to, it says, the Policy). The Expert assumes that this is an argument to support the diversion of traffic argument, that is that the Respondent has chosen the Domain Name to attract users who mis-type the yahoo.co.uk web address.

In support of the Complainant's assertion of a deliberate diversion of internet traffic, the Complainant attaches to the Complaint a copy of the "Hate Mail" section of the Respondent's Website, where an internet user stated that he reached the Respondent's Website via a spelling error. It is apparent from that page that the Domain Name is a typographical misspelling of the YAHOO! mark.

- (2) The Respondent's registration and use of the Domain Name are likely to cause confusion and to deceive consumers into mistakenly believing that the Respondent's Website is offered, authorised or sponsored by the Complainant or is otherwise affiliated with the Complainant. The Domain Name is confusingly similar to and is a typographical misspelling of the Complainant's YAHOO! mark. It is asserted that this is "typosquatting" following the decisions reported under the UDRP. The Complainant quotes a series of UDRP cases in support of this assertion. In respect of the likelihood of confusion, the Complainant attaches evidence of the Respondent's statement made on its web site - "this could be the best MISTAKE you ever made, coming to [*this*] page". It is asserted that this is a direct acknowledgement by the

Respondent that “Yahho” is a confusingly similar, typographical misspelling of the YAHOO! mark. At the same time, the Respondent’s Website has also used the Complainant’s famous and federally registered mark DO YOU YAHOO?, asking “do you YAHHO?”. Finally, the Respondent’s Website was titled “search-reference-mail-yahho index”. The Complainant claims this was another reference to Yahoo!’s services provided on its websites.

The Complainant attaches evidence of a complaint received from an individual who had accessed the Respondent’s website via a typographical error when trying to reach Yahoo!’s website. The Complainant states that this use of the Domain Name is likely to cause confusion due to the similarity between the Domain Name and the Complainant’s websites and mark and brand, and will deceive consumers into mistakenly believing that the Respondent’s Website is offered, authorised or sponsored by or is otherwise affiliated with the Complainant.

- (3) The Complainant asserts that the Respondent is not using or has not demonstrated an intent to use the Domain Name in connection with a bona fide offering of goods or services. It is asserted that misappropriation of the Complainant’s famous YAHOO! mark in the Domain Name and the use of that name to offer competing search engine services, to display banner advertisements and to promote racist and anti-Semitic/white supremacist political views does not constitute a bona fide offering of goods and/or services. The Complainant further submits that the Respondent has not been commonly known by the Domain Name. It is also submitted that the Respondent is not making legitimate non-commercial or fair use of the Domain Name.
- (4) It is asserted that the Respondent is tarnishing the Complainant’s YAHOO! mark through the Respondent’s Website page entitled “you are having honest opinion”, which consists of inflammatory political materials espousing racist/anti-Semitic/white supremacist views.
- (5) Lastly, the Complainant has stated that thirty UDRP decisions involving the YAHOO! mark have been issued in the Complainant’s favour and that the Panellists in at least twenty one of these cases have expressly found that the YAHOO! mark is famous. The Complainant then goes on to set out the details of these decisions.

For the reasons stated above, the Complainant states that the Respondent’s use of the Domain Name takes unfair advantage of, and is unfairly detrimental to, the Complainant’s rights. On more general grounds, it is submitted that the Respondent misappropriated the Complainant’s goodwill when it registered the Domain Name and has harmed Yahoo!’s reputation and tarnished the YAHOO! mark.

Respondent:

As explained above, the Respondent has not provided any response.

7. Discussion and Findings:

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert on the balance of probabilities, both that it has rights in respect of a name or mark identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in paragraph 1 of the Policy.

Complainant's Rights

The Complainant in this case has asserted that it has rights in the words YAHOO! and that this name is confusingly similar to the Domain Name. It is asserted that the Domain Name is also a typographical misspelling of the Complainant's registered YAHOO! mark. In considering whether or not a name or mark is identical or similar to a domain name, it would usually be appropriate to disregard the domain suffix, that is the '.co.uk'.

The Expert considers that the Domain Name is not identical to the Complainant's mark but is similar. The Domain Name is similar in that, it is made up of the same alphabetical letters, put together in the same order. The Domain Name has only one letter different to the Complainant's mark, that being an additional 'H' as the fourth letter rather than 'O'. There is, in addition, a phonetic similarity between the Domain Name and the Complainant's name. The exclamation mark at the end of the Complainant's YAHOO! mark makes little or no difference to the way in which the mark is pronounced and is not the most significant or memorable part of the mark.

From the evidence submitted by the Complainant, it appears that the Complainant does have goodwill in the word YAHOO!. The Complainant is also the registered proprietor of various registered trade marks for YAHOO!. Accordingly, the Expert finds that the Complainant has rights in respect of a name or mark which is similar to the Domain Name.

Abusive Registration

The Complainant also has to show that the Domain Name is an Abusive Registration. 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. One of these is circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name: "*primarily for the purpose of unfairly disrupting the business of the Complainant*" (Paragraph 3(a)(i) (of the Policy).

It seems clear that the Respondent has registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant. However, whether this was the Respondent's primary purpose in registering the Domain Name requires further consideration. The Domain Name gives no indication as to the kind of goods/services that the Respondent is intending to offer. Users would not type in the Domain Name and know what goods or services the Respondent's Website would offer. For this reason, it seems that by registering the Domain Name, the Respondent could have no purpose other than to intend that the Domain Name be confused with the YAHOO! mark, thereby intending primarily to divert business from the Complainant. The Respondent's Website offers services such as search engine services, e-mail services and banner advertisements, which directly compete with those offered by the Complainant. Accordingly, consumers may be confused into believing that such services are provided by, or somehow linked to, the Complainant, particularly when used in conjunction with the Domain Name. This is therefore likely to unfairly disrupt the business of the Complainant.

The Respondent's link "take me to Yahoo! now!" that did not connect users to the Yahoo! website is further evidence of the Respondent's purpose to unfairly disrupt the business of the Complainant. In

the absence of any response as to why such a link did not connect users to the Yahoo! website, this is the only conclusion that can be drawn.

The nature of the material on the Respondent's Website will be offensive to some internet users, in particular the page entitled "You are having honest opinion". On this basis, it is accepted that the Respondent has unfairly disrupted the business of the Complainant.

Accordingly, it is found that the Domain Name is an Abusive Registration on the basis of the grounds set out in paragraph 3.a.i.C. of the Policy.

The second submission of the Complainant is that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant under paragraph 3.ii. of the Policy. Primarily, this is because "yahoo!" and "yahho" are confusingly similar. In further support of this assertion, reference is made to the Respondent's use of "do you YAHHO?" compared to the Complainant's federally registered mark "DO YOU YAHOO!?". It is accepted that such use, along with the fact that the Respondent's site is accessed through the Domain Name, which is very similar to the YAHOO! mark, is likely to confuse consumers into thinking that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. In relation to the Respondent's use of the heading "search-reference-mail-Yahho Index", the Expert finds that the use of this alone is not likely to cause confusion. However, when viewed in conjunction with the other similarities detailed above, this strengthens the Complainant's case that the Domain Name is being used to confuse people into thinking that there is a link between the Respondent's Website and the Complainant.

The evidence attached by the Complainant regarding a complaint from an individual who accessed the Respondent's Website via a typographical error indicates how the Domain Name may be confused with the Complainant's sites by a user making a typographical error. It is evident that the Domain Name is intended to be a typographical misspelling of the YAHOO! mark through the statement on the Respondent's Website that "this could be the best MISTAKE you ever made coming to this page".

Accordingly, the Expert is of the view that the Domain Name is an Abusive Registration on the basis of the grounds set out in paragraph 3(ii) of the Policy.

It should, however, be noted that, in relation to the evidence provided by the Complainant that registrations of a typographical misspelling of a mark constitute "typosquatting", and that the trade mark is famous, the Expert does not consider it relevant, useful or necessary to consider the numerous UDRP cases cited. These UDRP decisions are not directly relevant to decisions made under the Policy because the tests applied under the UDRP for determining complaints differ in a number of respects from the tests applied under the Policy.

The Respondent's position

Before concluding, it is necessary to consider the grounds in paragraph 4 of the Policy which indicate grounds by which a Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration. Paragraph 4i states that "*before being informed of the Complainant's dispute, the Respondent has:*

A. 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;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

C. made legitimate non-commercial or fair use of the Domain Name."

and under Section 4ii that *“the Domain Name is generic or descriptive and the Respondent is making fair use of it”*.

The Complainant asserts, in relation to paragraph 4.i.A., that the Respondent is not using or has not demonstrated an intent to use the Domain Name in connection with a bona fide offering of goods or services. This ground is not made out insofar as the Respondent does appear to be offering email and search engine services. Whilst the Respondent may be providing such services to users who had intended to access the Complainant’s websites, this does not prevent the services being offered from being genuine.

In addition, the Expert finds that there is not enough evidence provided to hold that the Respondent has not been commonly known by the Domain Name (paragraph 4.i.B of the Policy). However, paragraph 4 of the Policy sets out arguments for use by the Respondent as to why its registration of the Domain Name is not an Abusive Registration. The Complainant does not need to prove that each (or even any) of the grounds in paragraph 4 do not exist in order to bring a successful Complaint.

In relation to paragraph 4.i.C, the Complainant asserts that the Respondent is not making legitimate non-commercial or fair use of the Domain Name. The Expert agrees.

In relation to the other grounds of paragraph 4, it is not easy to second-guess what the Respondent might have said, had it filed a Response. However, there is nothing on the facts which are known which would suggest that the Respondent might have been able to avail itself of any of the grounds in the paragraphs 4i or 4ii of the Policy.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration as defined by paragraph 1 of the Policy.

8. Decision:

In the light of the findings that the Complainant has rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name yahho.co.uk be transferred to the Complainant.

Antony Gold

Date