

Nominet UK Dispute Resolution Service

DRS 00286

Turkcell Iletisim Hizmetleri A.S. -v- Zafer Metin Atas

Decision of Independent Expert

1. **Parties:**

Complainant: Turkcell Iletisim Hizmetleri A.S.

Address: Turkcell Plaza
Mesrutiyet Cad. No:153
Tepebasi
Istanbul

Postcode: 80050

Country: Turkey

Complainant's Authorised Representative: Mr Murat Turhan
Turhan – Turhan Law Firm

Respondent: Zafer Metin Atas

Address: Icerenkoy pasabahce st. b blok d:8 kadikoy
Istanbul

Postcode: 81120

Country: Turkey

Respondent's Authorised Representative: Mustafa Goluoglu
Pelikan Law Firm

2. **Domain name:**

turkcell.co.uk (“the Domain Name”)

3. **Procedural Background:**

The Complaint was received in full by Nominet on March 6, 2002. Nominet validated the Complaint and notified the Respondent of the Complaint on March 11, 2002. Nominet informed the Respondent that he had 15 working days (until April 2, 2002) to lodge a Response. A Response was received on April 2, 2002 and forwarded to the Complainant on April 3, 2002 with an invitation to the Complainant to make any further submission in reply to the Response by April 10, 2002. The Complainant filed a Reply within this time limit, which was forwarded to the Respondent on April 10, 2002. The dispute

was not settled by Informal Mediation and on May 1, 2002 the Complainant was invited to pay the fee to obtain the Expert Decision pursuant to paragraph 6 of the Nominet UK Dispute Resolution Policy (“the Policy”). The fee was duly paid.

On May 20, 2002, Nick Gardner, the undersigned (“the Expert”), confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

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

The Response, as forwarded to the Expert by Nominet, does not comply with all of the procedural requirements set out at paragraph 5 of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”). In particular, the Respondent has failed to:

1. send the Response to Nominet in hard copy (paragraph 5.c. of the Procedure);
2. tell Nominet whether any legal proceedings have been commenced or terminated in connection with the Domain Name (paragraph 5.c.iv. of the Procedure); and
3. conclude with the statement set out at paragraph 5.c.v. of the Procedure and the signature of the Respondent or his authorised representative.

Paragraph 15.c. of the Procedure provides that “If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure, the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate.” The Expert does not consider any of the above matters to be material deficiencies in this particular case, having regard to the substantive context of the Response, so will treat the Response as compliant.

It is convenient to note here that whilst the parties have complied with the procedural requirement that all communication should be in English, some of the material submitted has been difficult to follow in this regard. The Expert does not consider that these difficulties affect the substantive issues.

5. The Facts:

The Complainant is Turkcell Iletisim Hizmetleri A.S., a large Turkish telecommunications company, specialising in the provision of mobile services using GSM technology. The Complainant’s shares are traded on the Istanbul and New York Stock Exchanges. The Complainant operates a website at www.turkcell.com.tr. It has been established since 1993.

On March 29, 2000 the Respondent registered the Domain Name. The website at the Domain Name currently redirects browsers to the website at <http://www.aria.com.tr>.

6. The Parties' Contentions:

Complainant

- A. The Complainant has Rights in respect of a name or mark which is identical to the Domain Name (paragraph 2.a.i. of the Policy)
1. The name "Turkcell" in which it has rights through its trade mark registrations is identical to the domain name. In establishing its trade mark rights the Complainant relies upon its three Turkish trade mark registrations, and two trade mark applications – one for a Community trade mark and the other for a United States trade mark.
 2. The Complainant further relies on goodwill and reputation in the name "Turkcell" based on its turnover (USD 2.225 billion in 2002), its advertising spend (USD 414 million in 2002), its listing on the New York Stock Exchange and the number of subscribers to its services (approximately 11 million), amongst other factors.
- B. The Domain Name, in the hands of the Respondent, is an Abusive Registration
1. As far as the Expert is able to determine, the Complainant does not submit that the Domain Name is an Abusive Registration under paragraph 3.a.i.A. of the Policy (Domain Name registered or otherwise acquired for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly associated with acquiring or using the Domain Name).
 2. The Complainant does appear to allege that the Domain Name is an Abusive Registration under paragraph 3.a.ii. of the Policy (Respondent 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).
 3. The Complainant also relies upon paragraph 3.a.i.C. of the Policy (Domain Name registered or otherwise acquired primarily for the purpose of unfairly disrupting the business of the Complainant). In making this assertion, the Complainant relies on the redirection by the Respondent of the Domain Name to the website at www.aria.com.tr. According to the Complainant, Aria is a competitor of the Complainant (as evidenced by a press release

dated November 15, 2002, available for viewing at the “Press Bulletins” section of this website). The Complainant suggests that the unfair disruption consists of the Respondent wilfully creating the dangerous impression that the Complainant and Aria are part of the same business, or that the Complainant and Aria are running a joint campaign or that the Complainant “supports” Aria in some way.

C. In its Reply, the Complainant responds to the arguments put forward by the Respondent (and outlined below), as follows:

1. The Complainant company was founded in 1993, and not 1996.
2. TURKCELL is a proper noun. This is evidenced by the Complainant’s trade mark registrations.
3. The Respondent does not own any rights in the TURKCELL name and did not claim any such rights in his Response.
4. Acquiring a domain name which consists of a widely known and recognised brand or name constitutes bad faith.
5. The Respondent is aware of the Complainant’s brand. This is evidenced by its redirection of the Domain Name to the website of one of the Complainant’s competitors.

Respondent

The Respondent’s Response is very difficult to follow. However, as far as the Expert is able to determine, the points the Respondent seeks to rely upon can be summarised as follows:

1. The Respondent was one of the first web designers in Turkey and his services have become very popular. He also runs one of the best Turkish cinema websites (under another domain name, not relevant to this dispute).
2. The Complainant should have applied for the Domain Name in 1996 when the Complainant company was founded.
3. The Respondent is a genius for foreseeing in 2000 that the Complainant would be successful and that he could benefit from his ownership of the Domain Name.
4. The Respondent chose the Domain Name because a cell “is the smallest unit of life” and the word ‘Turk’ “is the property of all Turk”. ‘Turkcell’ cannot be the property of a company.
5. The Respondent will be trying to start up a company in the United Kingdom.

6. According to the Respondent, hundreds of instances of the use of the word 'Turkcell' can be found on the Internet, although no details are given.
7. The Complainant is not a large or well-known company – if it was, it would not have needed to “[write] for lines to tell how big Turkcell is”.
8. Turk Telecom’s application to stop a company called Turk Telecom Netherlands from using a name that incorporated the words ‘Turk Telecom’ was rejected by the Dutch courts.

The Respondent has also submitted that “the respondent should fight against the white ill cells that are called TURKCELL in abnormal white blood cells”. The Expert was unable to make any sense of this submission.

7. Discussion and Findings:

General

To succeed in its Complaint the Complainant must prove to the Expert on the balance of probabilities 1) that it has Rights in respect of a mark identical or similar to the Domain Name, and 2) that the Domain Name, in the hands of the Respondent, is an Abusive Registration (paragraph 2.a. of the Policy).

Complainant’s Rights

Under paragraph 1 of the Policy, “Rights” are defined as including, but not limited to rights enforceable under English law. Paragraph 1 goes on to state that a Complainant cannot rely on rights in a name or term which is wholly descriptive of its business.

As far as registered Rights are concerned, the Complainant has sought to rely on three Turkish trade mark registrations which it says are dated September 9, 1996. The Complainant has supplied copies of the registration certificates for these marks, together with certified translations. So far as the Expert is able to determine, one of these is for the Turkcell logo, one is for the name “TURKCELL 0532 Kesintisiz iletisim kaynagn” and one is for the Complainant’s corporate name. None of these certificates gives the date of registration.

The Complainant has submitted a copy of the notice of publication of an application for a United States trade mark. This notice is dated July 4, 2001. According to the Complainant, the application was made on January 18, 2001. As far as the Expert is able to tell, this application is for a logo incorporating the word “Turkcell”.

Finally, the Complainant has supplied a copy of a letter from the Office for Harmonization in the Internal Market (“OHIM”) dated January 30, 2002. This letter states that OHIM have received the Complainant’s application for a logo

Community trade mark incorporating the Complainant's full name and that the application has been given a filing date of January 4, 2002.

Regarding unregistered rights, the Complainant has relied upon its goodwill and reputation in the name "Turkcell". Under English law, rights in an unregistered mark are enforceable on the basis of the common law action of "passing off". Such rights are acquired not through registration, but through the use of a mark which comes to function as a badge of recognition to which the goodwill of a business attaches.

The Respondent appears to assert that the Complainant cannot have Rights in the name "Turkcell" because it is descriptive of the Complainant's services. Under English law, where a trader uses a mark or a name which is descriptive of its products or services, the trader must show that the public understands that the products or services come from him when they see the mark so that the mark has in this way acquired a "secondary meaning" – see *Reckitt & Coleman v. Borden* and *Reddaway v. Banham*.

The Expert finds that whilst the name "Turkcell" may consist of descriptive elements, the acquired goodwill in that name has in any event given that name trade mark significance in Turkey, if not beyond. The filed evidence establishes on the balance of probabilities that the name "Turkcell" denotes the goods and services of the Complainant to a large number of people. That is to say, that the Complainant has educated the Turkish public to understand that goods or services sold under the "Turkcell" name come from the Complainant.

Further, even if the name is descriptive or generic, under paragraph 4.a.ii. of the Policy, this defence will only avail a Respondent who adduces evidence that fair use is being made of the Domain Name in question. The Respondent has not adduced any such evidence.

The Expert therefore finds that the evidence submitted by the Complainant to show its goodwill and reputation in the name "Turkcell" is sufficient to establish that it has Rights in that name, which is identical to the Domain Name. In this regard the Policy makes clear that "Rights" includes "but is not limited to, rights enforceable under English law". The Expert does not therefore find it necessary to consider whether the Complainant's rights would be sufficient to be enforceable in English proceedings.

As far as the registered trade marks are concerned, the Expert discounts the United States and OHIM applications as both of these were made after the Respondent registered the domain name. The Turkish marks are not identical to the Domain Name. In the light of the Expert's finding with respect to the Complainant's unregistered mark, the Expert considers it is unnecessary to express a view as to whether the any of these registered marks are similar to the Domain Name.

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 at paragraph 3.a. of the Policy. The list is as follows:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name:
 - A. primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. primarily for the purpose of unfairly disrupting the business of the Complainant;
- ii. Circumstances indicating 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;
- iii. In combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making Abusive Registrations; or
- iv. It is independently verified that the Respondent has given false contact details to us.

As the Expert understands the Complaint, the Complainant does not seek to argue that the Domain Name is an Abusive Registration on the basis of paragraphs 3.a.i.A.. The Complainant instead relies on paragraph 3.a.ii. and 3.a.i.C. of the Policy.

The Expert accepts the Complainant's evidence that the Domain Name redirects to the site of one of the Complainant's competitors. The Respondent has not put forward any explanation for this redirection.

No evidence has been placed before the Expert as to any attempt by the Respondent to sell the Domain Name, nor of any pattern by the Respondent of making Abusive Registrations. Although it is not clear, it appears to the Expert that the Complainant does not argue the registration falls within paragraph 3(a)(i)A of the policy. The Expert has not found it necessary to consider this ground further.

In the absence of credible explanation from the Respondent, the Expert concludes that the undisputed redirection to a competitors site, means that the registration falls within paragraphs 3.a.i.C. and/or 3.a.ii. of the Policy.

The Expert finds that the Respondent has not demonstrated that the Domain Name is not an Abusive Registration by reference to any of the non-exhaustive factors listed at paragraph 4.a. of the Policy. The Expert further finds that none of the other submissions which the Respondent has made go any way to showing that the Domain Name is not an Abusive Registration.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration.

8. Decision:

In the light of the foregoing findings, namely that the Complainant has Rights in respect of a name which is identical 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 be transferred to the Complainant.

Nick Gardner

31st May 2002