

DISPUTE RESOLUTION SERVICE

D00017204

Decision of Independent Expert

Google Inc.

and

Divya Taneja

1. The Parties:

Lead Complainant: Google Inc.
1600 Amphitheatre Parkway
Mountain View
California
94043
United States

Respondent: Divya Taneja
C,40-44 Lajpat Nagar-II
New Delhi
Delhi
110024
India

2. The Domain Name(s):

gmailsuport.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

11 March 2016 09:20 Dispute received

14 March 2016 11:55 Complaint validated

14 March 2016 12:15 Notification of complaint sent to parties

04 April 2016 02:30 Response reminder sent

07 April 2016 10:17 No Response Received

07 April 2016 10:18 Notification of no response sent to parties

20 April 2016 17:37 Expert decision payment received

25 April 2016 Keith Gymer appointed as Expert wef 28 April 2016

4. Factual Background

The Complainant, Google Inc., is the well-known U.S. multinational technology company specialising in Internet search and related services.

Since 1998, the Complainant has used the trade mark GMAIL in connection with the provision of email and electronic messaging services. The GMAIL service has become one of the most popular web-based email services, claiming over one billion active users as of February 2016. The GMAIL email service integrates with various other products and services provided by the Complainant.

The Complainant owns trade mark registrations for and including the term GMAIL, which include, by way of example, the following EU and UK National Trade Mark registrations, which are effective in the United Kingdom:

- EUTM 004316841 for GMAIL, filed 29 March 2005 in Classes 9 & 42;
- EUTM 010857514 for GMAIL, filed 4 May 2012 in Classes 9, 38, 42 & 45;
- UKTM 2493281 for GMAIL, filed 14 April 2004 in Class 38; and
- UKTM 2442046 for GMAIL, filed 19 December 2006 in Class 38.

The Complainant has also registered domain names for and including the term GMAIL, with the primary website for the GMAIL service being located at gmail.com.

According to the Nominet WhoIs records, the Respondent registered the Domain Name on 24 August 2015. The URL www.gmailsupport.co.uk is redirected to <http://www.email-help.co.uk/>, which is a site claiming to offer “Email Technical Support” [sic], including “Gmail Technical Support”.

5. Parties' Contentions

Complainant

The Complainant bases its Complaint on the following grounds:

A. The Complainant has rights in respect of a name or mark that is identical or similar to the Domain Name.

The Complainant is a well-known technology company specialising in Internet-related services and products. It has used the trade mark GMAIL since 1998 in connection with the provision of email and electronic messaging services.

The Complainant owns many trade mark registrations for and including the term GMAIL, including those listed at 4 above, which are effective in the United Kingdom.

As a result of the extensive use, promotion and advertising of the GMAIL service by the Complainant, the mark GMAIL would be associated with the Complainant by almost all Internet users worldwide. By way of example:

- the GMAIL service ranked second in PC World's "100 Best products of 2005," received an "Honorable Mention" in the Bottom Line Design Awards of 2005, and was declared the best webmail by Forbes Magazine in 2006;
- the app for the GMAIL service has been downloaded and installed by more than 1 billion users;
- According to the web traffic and ranking analysis company Alexa, the website at gmail.com is currently ranked in the top 3,000 most visited websites on the Internet globally;
- The GMAIL page on the popular social media platform, Facebook, has received more than 1.8 million 'likes'.

The Respondent registered the Domain Name on 24 August 2015, after the Complainant had obtained numerous trade mark registrations throughout the world, including in the United Kingdom, for the trade mark GMAIL.

The Domain Name is confusingly similar to the trade mark GMAIL:

It contains an exact reproduction of the trade mark GMAIL, as the dominant and distinctive element of the Domain Name, together with the word "suport" (a misspelling of the word "support"). The combination is descriptive as the website accessed via the Domain Name purports to offer technical support services to users of Complainant's GMAIL service. The inclusion of the word "suport" in the Domain Name does not therefore change the confusing similarity between the Domain Name and the trade mark GMAIL (cf. Decision in DRS16905 Yahoo! Inc. v Alfa Infosystem 'yahoocontact.co.uk; yahoosupport.co.uk').

Further, the .co.uk suffix does not change the confusing similarity between the Domain Name and the trade mark GMAIL. It is well established that, in comparing a domain name to a trade mark, the TLD suffix is ignored (see Dispute Resolution Service – Experts’ Overview, version 2, para 2.3).

It should therefore be beyond doubt that the Domain Name is confusingly similar to the trade mark GMAIL in which the Complainant has rights.

B. The Domain Name, in the hands of the Respondent, is an Abusive Registration

At the time the Respondent registered the Domain Name on 24 August 2015:

- it was well known that the Complainant was using the trade mark GMAIL around the world and in the UK in connection with the provision of email and electronic messaging services; and
- The Complainant’s earliest UKTM 2493281 for GMAIL, filed on 14 April 2004, was more than 11 years old.

The Respondent is using the Domain Name to direct to a website that purports to offer technical support, including password recovery services, to users of the Complainant’s GMAIL service, and instructs users to call a UK free phone number for assistance (0800-058-8229).

By advertising purported password recovery services, the Respondent is engaged in a “phishing scheme”, a practice “intended to defraud consumers into revealing personal and proprietary information” – in this case, users’ confidential GMAIL passwords (see the Decision of the NAF in FA1504001617405, Google Inc. v. Akhil Mishra / Rajeev / Latika Sharma / Satyendra Kumar Pandey/ Satendra Kumar / Jameet / Sayni Rana ‘gmailhelpsupport.com and others’ in respect of .com domain names used in almost identical circumstances to the Domain Name.)

It is beyond doubt that the Respondent selected and registered the Domain Name with the trade mark GMAIL and the Complainant’s GMAIL service in mind. It would also have been evident to the Respondent that Internet users would assume that any website at the Domain Name is operated by, or authorised by, or otherwise connected with the Complainant.

For these reasons, and the reasons set out below, the Domain Name is clearly an “Abusive Registration” under Article 1(i) and 1(ii) of Nominet’s Dispute Resolution Service Policy.

- (i) The Respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights (Policy, Article 3(a)(i)(B))

The Respondent has prevented the Complainant from incorporating the Domain Name into a portfolio of domain names that closely reflect its trade mark GMAIL. The Domain Name has therefore been registered by the Respondent as a blocking registration against a trade mark in which Google has rights.

(ii) The Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant; (Policy, Article 3(a)(i)(C))

The Respondent is engaging in a “phishing scheme”, a practice “intended to defraud consumers into revealing personal and proprietary information” – in this case, users’ confidential GMAIL passwords, which has the potential to cause significant and irreparable harm to the Complainant’s goodwill and reputation in the GMAIL service.

(iii) The Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (Policy, Article 3(a)(ii))

The ‘confusion’ in this context is confusion as to the identity of the person/entity behind the domain name i.e. will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that “the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”? (see Dispute Resolution Service – Experts’ Overview, version 2, para 3.3).

Given the association of the trade mark GMAIL with the Complainant, it is inevitable that an Internet user will assume that the Respondent’s registration and/or use of the Domain Name has been authorised by Complainant, contrary to the fact.

Internet users typically visit websites by way of search engines. There is then a significant risk that an Internet user may click on the link to the website at the Domain Name believing that it will lead to a support website operated or authorised by the Complainant. That consumers may subsequently realise that the Respondent’s website is not operated or authorised by the Complainant once on the website is immaterial. The initial interest confusion that is likely to have occurred as a result of the Respondent’s registration and use of the Domain Name is sufficient for the Domain Name to be considered an Abusive Registration (see Decision of Appeal Panel in DRS 03027 EPSON Europe BV v Cybercorp Enterprises ‘epson-printer-cartridges.co.uk and others’).

(iv) The Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the

Respondent has no apparent rights, and the Domain Name is part of that pattern (Policy, Article 3(a)(iii))

The Respondent has registered at least one other domain name containing a well-known trade mark. The Respondent appears to use the domain name yahoohelpnumber.co.uk for an corresponding website targeting users of Yahoo!'s email services.

The Complainant therefore suggests that the Respondent is engaged in a pattern of registering domain names that correspond to well-known trade marks in which the Respondent has no apparent rights.

(v) The Respondent has no legitimate right to register or use the domain name (Policy, Article 4)

The Respondent is not using the Domain Name in connection with a genuine offering of goods or services. The Respondent has registered and is using the Domain Name to perpetrate a fraud on users of Google's GMAIL service. The Respondent does not have any legitimate right to register or use the Domain Name. The Respondent is not a licensee of or in any other way affiliated with the Complainant, who has not consented to the registration or use of the Domain Name by the Respondent.

In conclusion, it is evident that:

- the trade mark GMAIL is well-known worldwide, including in the UK, is a highly distinctive mark, and would be associated with the Complainant by almost all Internet users worldwide;
- the Respondent selected and registered the Domain Name with the trade mark GMAIL in mind and for the sole purpose of perpetrating a fraud on users of Complainant's GMAIL service;
- the Domain Name is an Abusive Registration under Paragraphs 1(i) and 1(ii) of Nominet's Dispute Resolution Service Policy; and
- the Respondent will be unable to demonstrate that the Domain Name is not an Abusive Registration.

Remedy

The Complainant requests the transfer of the Domain Name.

Respondent

The Respondent offered no Response to the Complaint.

6. Discussions 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 which is 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 has asserted valid earlier registered trade mark rights in the mark GMAIL.

The disputed Domain Name comprises the identical mark "gmail" with the addition of the element "suport", being an evident misspelling of "support", together with the SLD domain suffix .co.uk. It is obvious that ordinary English readers will perceive the domain name to be read as "GMAIL support" – i.e. that "suport" is simply a descriptive reference to the provision of support for the Complainant's GMAIL services.

Consequently, the Expert finds that the Complainant has Rights in respect of a name or mark, which is identical or similar to the Domain Name, and that the conditions of Paragraph 2a.i. of the Policy are met.

Abusive Registration

The Complainant also has to show that the disputed 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 a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant's submissions, the following examples appear to be principally applicable in this case:

3a.i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;
3a.ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;
3a.iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

...

Paragraph 4 of the Policy additionally provides observations on “How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration”, of which the following may be considered pertinent to the present Complaint:

- 4.a.i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), 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;...

The factors listed in Paragraphs 3 and 4 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In accordance with the Policy Paragraph 2b, it is for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

The Respondent made no Response, and provided no challenges to the Complainant's evidence and assertions, and offered no explanations to demonstrate why the Domain Name should not be considered an Abusive Registration.

In the Expert's opinion, the evidence of the nature of the associated website, which is linked using the Domain Name, itself clearly supports the Complainant's concerns and contentions. It appears poorly constructed, with many obvious spelling errors and does give the impression of being a rather crude effort at a “support” website intended to dupe gullible users of the popular GMAIL service. The Complainant suggests that this could be for the purpose of phishing for users passwords. It might also be a subterfuge to get users to allow hackers, masquerading as “support” engineers, access to install malware and demand

“ransom” payments for removing alleged viruses, which is a frequently reported scam.

The site does include somewhat spurious “Disclaimers”, such as:

Disclaimer

We are an independent service provider remote tech support for third party products. Third party trademarks . Logo, brand name. Product and services are used as references for informational purpose. only. In one way we sponsor their product or services. Thus. We retry disclaim and sponsorship. a Dilation and endorsement of or by a d such third

and

Disclaimer email-help.co.uk is a leading Third Party Gmail Tech Support Services Providers across uk. Gmail technical Support is an independent services providers of online remotely access customer tech support for resolve all mail account issues. All other outsider trademarks logo, brand name, product and services are use only for references for instructive purpose.

However, these do nothing to dispel the reasonable suspicions on which the Complaint is founded.

The Expert therefore considers, on the balance of probabilities, that the Complainant has made out its case, at least under Articles 3(a)(i)(C) and 3(a)(ii) of the Policy; that the registration and use of the disputed Domain Name by the Respondent has taken unfair advantage of, and been unfairly detrimental to, the Complainant’s Rights; that the Domain Name is therefore an Abusive Registration; and that the conditions of Paragraph 2a.ii. of the Policy are met.

7. Decision

Having found that the Complainant has Rights, and that the disputed Domain Name, gmailsuport.co.uk, is an Abusive Registration in the hands of the Respondent, the Expert orders that the disputed Domain Name should be transferred to the Complainant.

Signed: Keith Gymer

Dated: May, 2016