

## DISPUTE RESOLUTION SERVICE

D00015680

### Decision of Independent Expert

Google Inc.

and

IDN Property Services Ltd T/A Google Home

#### 1. The Parties

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

Respondent: IDN Property Services Ltd T/A Google Home  
Monomark House  
27 Old Gloucester Street  
London  
WC1N 3AX  
United Kingdom

#### 2. The Domain Name

<googlehome.me.uk>

#### 3. Procedural History

The Expert has confirmed that he is independent of each of the parties and that to the best of his 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 a such a nature as to call in to question his independence in the eyes of one or both of the parties.

02 June 2015	15:02	Dispute received
02 June 2015	15:35	Complaint validated
02 June 2015	15:42	Notification of complaint sent to parties
19 June 2015	02:30	Response reminder sent
24 June 2015	09:57	No Response Received
24 June 2015	09:57	Notification of no response sent to parties
03 July 2015	12:30	Expert decision payment received
06 July 2015	10.51	Expert appointed

#### **4. Factual Background**

The Complainant is a Delaware, United States corporation with its principal place of business in Mountain View, California. It is a provider of an Internet search engine and related services.

The Complainant is the owner of trade mark registrations for the mark GOOGLE in numerous territories throughout the world. Its registrations include UK trade mark number 2410931 for GOOGLE filed on 12 January 2006 for goods and services in a variety of classes.

The Domain Name was registered on 27 October 2011.

Based on the Complainant's evidence, on 19 March 2015 the Domain Name resolved to a website at "http://googlehome.me.uk". The website was headed "GOOGLE HOME" and sub-titled "IDN Property Services". The "Welcome" panel on its home page stated: "Welcome to our Google Home's website. Google Homes offers an ideal solution to UK landlords wanting more from their property investment."

#### **5. Parties' Contentions**

##### Complainant

The Complainant provides evidence of its trade mark registrations for the mark GOOGLE in numerous territories worldwide. It states that it was founded in 1997 and operates one of the most widely recognised Internet search engines in the world. It states that it offers a wide variety of search, indexing, storage and related services, including services related to the real estate business. It provides evidence of the recognition of the GOOGLE brand worldwide, including evidence that the brand has been ranked among the world's top five most valuable brands since 2001 and was valued at \$68 billion in 2014.

The Complainant submits for the purposes of the Nominet DRS Policy ("the Policy") that it has Rights in respect of a name or mark which is identical or similar to the Domain Name. It contends that the Respondent has merely added the term "home" to the Complainant's mark GOOGLE, which does not give the impression of any independently coined term. Instead, given the fame of the Complainant's mark, the Domain Name would give the impression to Internet users either that it leads to a home page of the Complainant or that it leads to a

page which is endorsed by or affiliated with the Complainant that relates to real estate.

The Complainant further submits for the purposes of the Policy that the Domain Name in the hands of the Respondent is an Abusive Registration.

The Complainant contends that the Respondent was not commonly known by the name "Google Home" prior to registering the Domain Name and that there is no evidence of its prior trading under that name.

The Complainant submits that owing to the extensive use and notoriety of the Complainant's GOOGLE trade mark, it is inconceivable that the Respondent registered the Domain Name without actual knowledge of that mark. Because of the fame and distinctiveness of the GOOGLE mark, Internet users are likely to believe that the Domain Name is connected with the Complainant and, as a result, the Respondent is trading off the valuable goodwill associated with the GOOGLE mark by falsely claiming an association with it. As a minimum, the Respondent is taking advantage of "initial interest confusion" to divert Internet users to its website. The Complainant also submits that given the Respondent's incorporation of the whole of the Complainant's famous GOOGLE mark, it is impossible to conceive of any legitimate use to which the Respondent could put the Domain Name.

Accordingly, the Complainant submits that the Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant (paragraph 3(a)(ii) of the Policy).

The Complainant further contends that the Respondent has sought payment from the Complainant for the Domain Name in excess of the Respondent's documented out-of-pocket costs connected with its acquisition. The Complainant exhibits an (inconclusive) exchange of correspondence with the Respondent in which the Complainant offered to pay the Respondent \$100 for the Domain Name to cover its registration/maintenance fees, to which the Respondent replied: "We are happy to give you the domain name if you give us a good offer taking into running this business for 2 years now."

In the light of this, the Complainant also contends that the Respondent registered the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to 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 (paragraph 3(a)(i)(A) of the Policy).

The Complainant seeks a transfer of the Domain Name.

#### Respondent

No Response has been filed by the Respondent in these proceedings.

## **6. Discussion and Findings**

The Complaint falls to be determined according to the Policy and the Nominet DRS Procedure (“the Procedure”). Under paragraph 2 of the Policy:

- “(a) *A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, that:*
- (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
  - (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.*
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*

Under paragraph 1 of the Policy the term “Rights”:

*“... means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.”*

Also under paragraph 1 of the Policy, the term “Abusive Registration” means 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.”*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 4 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

### Rights

The Complainant has established that it is the owner of trade mark registrations worldwide for the mark GOOGLE for goods and services in various classes. The Expert also accepts the Complainant’s evidence of the extensive fame of the Complainant’s mark worldwide.

The Domain Name comprises the term “google”, which mirrors the Complainant’s mark, the term “home”, and the formal suffix “.me.uk”, which is typically to be disregarded for the purposes of comparison. The Expert accepts the Complainant’s submission that the descriptive term “home” does nothing to distinguish the Domain Name from the Complainant’s well-known mark and that,

on the contrary, it suggests an association between the Complainant's mark and the Domain Name, as leading either to a home page of the Complainant's or to a page offering property services endorsed by or affiliated with the Complainant.

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

In the absence of any rebuttal on the part of the Respondent, the Expert accepts the Complainant's submission that the Respondent was not commonly known by any name corresponding to the Domain Name prior to its registration of the Domain Name.

The Expert also accepts the Complainant's submission that it is inconceivable that the Respondent could have been unaware of the Complainant and its GOOGLE trademark at the date it registered the Domain Name.

Since the Respondent has failed to participate in these proceedings, it has provided no explanation for its choice of the Domain Name, whether in accordance with the circumstances set out in paragraph 4 of the Policy or otherwise.

The Expert also accepts that owing to the notoriety of the Complainant's GOOGLE mark it is difficult to conceive of any legitimate use to which the Respondent could put the Domain Name.

In the circumstances, the Expert is drawn inescapably to the conclusion that the Respondent registered and has used the Domain Name with the intention of taking unfair advantage of the Complainant's goodwill in its valuable mark GOOGLE by misleadingly attracting Internet users to its website by falsely creating an association with the Complainant's mark. Specifically, the Expert finds 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 (paragraph 3(a)(ii) of the Policy).

The Expert is unable to conclude that the Respondent registered the Domain Name primarily for the purpose of selling to the Complainant for a sum in excess of its documented out-of-pocket costs. However, this does not affect the outcome of the case in the light of the Expert's finding under paragraph 3(a)(ii) above.

In the circumstances, for the reasons set out above, the Expert finds that the Domain Name was both registered and has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration.

## **7. Decision**

The Complainant has established that it has Rights in a name or mark that is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore directs that the Domain Name <googlehome.me.uk> be transferred to the Complainant.

**Signed: Steven A. Maier**

Dated: 10 July 2015