

## Cases & Controversies

Court: WIPO Arbitration and Mediation Center

Case: *Google Inc. v. Eamonn Smyth*

Date: August 11, 2011

Written by: Kyom Bae

Complainant, Google Inc. (“Google”), of California, filed the claim for a transfer of the domain name <googlehire.com> registered by Respondent, a resident of Swindon, United Kingdom, pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”).

### Background Information

Complainant operates the internet search engine at its domain name <google.com>, which was registered on September 15, 1997. Complainant’s website is one of the most popular destinations on the internet, receiving approximately 581 million worldwide visitors per month. It generated advertising revenues of \$28,236 million in 2010. Complainant owns numerous trademark registrations of the GOOGLE mark in many countries, including the United Kingdom.

Respondent registered the disputed domain name on January 21, 2010. The domain name currently resolves to a website that does not have any substantive content except a number of sponsored listings and links to other websites.

### Complaints

First, Complainant argues that the domain name <googlehire.com> is nearly identical or confusingly similar to Complainant’s trademark as the incorporation of a suffix “hire” does not eliminate the confusingly similar aspect of the domain name. Complainant alleges that Respondent used its trademark to attract internet users for commercial benefit. Additionally, the domain name incorrectly suggests that Respondent is associated with Complainant.

Second, Complainant claims that Respondent has no rights or legitimate interests in the domain name. Complainant has not granted any license or authorization to Respondent to use its trademarks in any manner. According to Complainant, Respondent registered the domain name to resell it, not to carry out any business. Therefore, the registration of the domain name is for neither a *bona fide* offering of goods or services, nor a legitimate non-commercial or fair use. Complainant alleges that there is no legitimate reason for Respondent to have registered the domain name other than to use the fame of the GOOGLE mark to generate web-traffic and to confuse internet users. The term “googlehire” is neither a natural word nor common name; furthermore, Respondent has never been known by the GOOGLE mark or by any similar name.

Last, Complainant claims that Respondent registered and used the domain name in bad faith. It contends that Respondent was aware of the well-known GOOGLE mark at the time of registration of the domain name. Nevertheless, Respondent registered the name intentionally to attract the visitors for commercial gain. Complainant argues that Respondent misled the visitors and created a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website.

Furthermore, because the Respondent's website does not carry out any business, the sole purpose of registration was to prevent Complainant from registering it and to derive profits by offering the domain name for sale.

### Responses

Respondent did not reply to Complainant's claims.

### Discussion and Findings

Complainant has the burden of proving the following three elements under the UDRP in order to be entitled to transfer the disputed domain name: (1) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (2) Respondent has no rights or legitimate interests in respect of the disputed domain name; and (3) the disputed domain name has been registered and is being used in bad faith.

Respondent is required to submit a Response to the Complaint within twenty days of the date of commencement of the administrative proceedings. If Respondent fails to submit a response, the Panel is to decide the dispute based upon the Complaint, and, absent any exceptional circumstances, is entitled to draw adverse inferences from Respondent's failure.

#### (1) Identical or Confusingly Similar

The Panel found that the disputed domain name is confusingly similar to the GOOGLE mark and the <google.com> domain name. In order to satisfy the threshold test for "identical or confusingly similar," the trademark needs to be recognizable within the domain name, with the addition of common, dictionary, descriptive, or negative terms typically being considered as insufficient to prevent internet user confusion. The Panel found that this threshold test is satisfied.

The GOOGLE mark is an invented word, in which Complainant has rights, and has acquired widespread fame and reputation. The mark is instantly recognizable as the dominant or principal component of the disputed domain name. The addition of the term "hire" in the domain name does not eliminate the confusingly similar aspect of the domain name. Neither would the suffix ".com" be sufficient to avoid the similarity since it is a requirement of registration.

#### (2) Rights or Legitimate Interests

Complainant is only required to make out a *prima facie* case that Respondent lacks rights or legitimate interests. Once Complainant establishes a *prima facie* case, Respondent carries the burden to prove the rights or legitimate interest in the domain name. Absent a response, the Panel is entitled to draw inferences against Respondent.

Respondent registered the domain name in January 2010, which is long after Complainant began using its famous GOOGLE mark. Complainant has never been associated or affiliated with Respondent. Nor has Complainant given any authority or license to Respondent to use the trademark. Furthermore, Respondent is not using the domain name for a *bona fide* offering of goods or services or for making non-commercial or fair use of the domain name; Respondent does not carry out any business activities. Thus, the use of the trademark to derive advantages from internet user confusion is not legitimate.

### (3) Registered and Used in Bad Faith

The Panel found that Respondent was clearly aware of the reputation and fame of the GOOGLE mark when he registered the domain name. In the absence of any response from Respondent, his choice of the domain name, which was confusingly similar to Complainant's trademark, was to derive unfair monetary gain and cannot have been accidental. The Panel found that such an act constitutes bad faith registration and use.

### Decision

The Panel ordered the disputed domain name <googlehire.com> be transferred to Complainant per the UDRP.